effect, in relation to the grant of an injunction, of the comparative cost and inconvenience of drains on the plaintiff's property to avert actual damage is another matter.

Appeal dismissed with costs.

Solicitors for the appellant, *Simmons, Wolfhagen, Simmons & Walch.*

Solicitors for the respondents, *Ewing, Hodgman & Seager.*

B. L.

[HIGH COURT OF AUSTRALIA.]

MAY . . . . . APPELLANT;

AND

HIGGINS . . . . . RESPONDENT.

Patent—Application—Combination—Improvement of integer of old combination—Want of novelty.

The improvement of one of the integers in an old combination which does not make the combination substantially a new thing does not entitle the inventor of the improvement to a patent for the combination with the improved integer incorporated in it although he may be entitled to a patent for the improved integer.

APPEAL from the Commissioner of Patents.

Matthew John Higgins applied for a patent for an "improved starting device for distance handicap races." The device was applicable to horse-races in which the handicapping is by distance, and its general principle was to have an elastic cord (called in the specification a "tensional barrier") stretched across the racecourse at each of the points where the horses were to start. Each of the

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elastic cords was secured on the inner side of the course to a post by a pin passing through a loop at the end of the cord, the other end being firmly attached to a post on the outer side of the course. The pins securing the inner ends of the elastic cords were fastened to a wire running along the inner side of the course, having a spring at one end and stretched tightly from the other end, so that when that other end was released all the pins were drawn out at the same time and the elastic cords simultaneously flew back across the course and left the course open.

The application was opposed by John May on the grounds that the applicant had obtained the invention from him, that the invention had been previously patented in the Commonwealth, that the invention was not novel, and that the invention had been described in a prior publication in the Commonwealth. The Commissioner of Patents dismissed the opposition and granted the patent.

From that decision the opponent now appealed to the High Court.

Other facts are stated in the judgments hereunder.

Mann, for the appellant. The thing for which a patent is claimed here is a combination. Ordinarily where a combination is claimed the combination itself is the novelty. But where a person invents an improvement of an old combination which consists of the discovery of a new part which is added to the old combination, then he must either by disclaimer or by the form of his claim make clear what is old and what is new: *Kynoch & Co. Ltd.* v. *Webb* (1); *Harrison* v. *Anderston Foundry Co.* (2); *Parkes* v. *Stevens* (3). It may be that the respondent has invented an improvement on an integer of an old machine, namely, the means of releasing the barriers, but the improvement is not such as to make the whole combination substantially a new thing, which is the only case in which he would be entitled to patent the combination: See *Moore and Hesketh* v. *Phillips* (4); *In re Newton's Application* (5).

Schutt, for the respondent. The only question raised before the

(1) 17 R.P.C., 100, at p. 110.
(2) 1 App. Cas., 574, at pp. 577, 580.
(3) L.R. 8 Eq., 358, at p. 365.
(4) 4 C.L.R., 1411, at p. 1426.
(5) 17 R.P.C., 123.

Commissioner was whether the invention disclosed had been anticipated. With regard to that, it is not material to inquire whether the claim is for a combination or not, but the only question is whether that which the respondent seeks to patent, however it may be described, is substantially the same thing as what was known before. Assuming that it is a claim for a combination, the combination is one in which a new integer, entirely different from what was used before, has been substituted, making the combination a new one substantially different from the old one.

GRIFFITH C.J. The subject matter of the patent applied for in this case may conveniently be described in the words of the fifth claim of the specification :—" Improved starting device for distance handicap races comprising a series of portable tensional barriers each formed on its inner or release end with a hook adapted to enter a recessed socket and engage a pin passing therethrough, the retaining pins being connected with short cords or the like with a tensional wire running alongside the track through guides and connected at one end with a spring and at the other end with a release lever." The object of the spring, of course, is that on its being released the tensional wire may fly back and set free the retaining pins, and so allow the barriers to fly across the course.

It appears that a device had been in use for some time which was precisely similar, except that instead of a tensional wire being used for releasing the pins that result was procured by pulling a wire which released them.

The claim, however, is for the whole device—the cross barriers, the securing by pins and the means of withdrawing the pins. The only novelty, if there is any at all, is the use of a tensional wire instead of a wire pulled by hand. The substitution of the tensional wire for the wire pulled by hand may or may not be an improvement. It was sought to support the claim as being one for a combination, and it can only be supported as a combination. A combination is not an invention unless the combination is substantially a new thing. In this case the only new thing is the substitution in one integer of an old machine of a slightly

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different mode of applying power. That is substantially different from what is claimed. The machine for which the patent is claimed is not new; it is old, but it is alleged that one of the parts has been improved. It is possible that that alteration is both valuable and novel, and so may be patentable. It is fair, therefore, that, although the applicant is not entitled to the patent which he claims, he should be allowed to put forward a claim for what may be patentable. A similar case came before this Court in *Moore and Hesketh* v. *Phillips* (1), and I think a similar order may be made in this case, that is, that the grant ought not to be made unless the applicant within a fixed time asks for leave to amend his specification. Otherwise he would, by prior publication, lose the benefit of the asserted invention of the substitution of the tension wire for the wire pulled by hand.

BARTON J. I agree.

ISAACS J. The respondent here was the applicant for a patent, and has claimed a composite machine. The only new operation about it, if there is anything new, is the mode of releasing the barrier. The objection is that the machine as claimed is not novel. It is, and must be, conceded that that objection is good as to all but the mode of releasing the barrier unless the machine as claimed is a different machine from the one existing previously by reason of its being a combination.

A true combination of parts, whether the parts be old or not, is a new unit, and is patentable, other requisites being present. It is the combination itself that is the novelty. For that there is a very recent authority which may be cited, namely, *Mercedes Daimler Motor Co. Ltd.* v. *F.I.A.T. Motor Cab Co. Ltd.* (2), where Lord Parker said :—" For a combination to be patentable it is not necessary that any single subordinate integer should be new. It is sufficient that the combination as a whole should be new and useful, provided it required inventive ingenuity to combine the various elements for the purpose in view." I am assuming that there was invention here. Then comes the question whether the

(1) 4 C.L.R. 1411.

(2) 32 R.P.C., 393, at p. 413.

presence of this feature makes the whole thing a combination. It appears to me that it is a mere improvement of one previously existing integer. It is not a new integer giving a better result, nor the substitution of a totally different integer, the presence of which is such as to make the whole machine an essentially different machine, a new unit. It is, I think, at best an improvement upon a prior integer not altering the essential character of the machine. Then, if that is the case, the whole machine as claimed is not a true combination, and, if the inventor has a meritorious invention, it is in respect of the improvement only, and that should be separately claimed.

RICH J. I agree.

Appeal allowed. Decision appealed from reversed. Declare that the grant ought not to be made unless the respondent within four months asks for leave to amend his specification. The time for sealing the patent to be extended until one day after the time for appealing from the decision on that application. Respondent to pay £9 9s. *for appellant's costs of opposition, and the costs of this appeal.*

Solicitor for the appellant, *Angus A. Sinclair.*
Solicitor for the respondent, *F. B. Waters.*

B. L.