

[HIGH COURT OF AUSTRALIA.]

GUM AND ANOTHER APPELLANTS ;

APPLICANTS,

AND

STEVENS RESPONDENT.

OPPONENT,

ON APPEAL FROM THE SUPREME COURT OF

VICTORIA.

Patent—Application—Opposition—Want of novelty—Want of invention—Patents H. C. OF A.

Act 1903-1921 (No. 21 of 1903—No. 24 of 1921), sec. 56.

1923.

An application for a patent for an improved lubricating device for vehicles was opposed on the ground of want of novelty. The Commissioner of Patents having granted the application, the Supreme Court of Victoria on appeal held that there was no novelty either of idea or of means in the alleged invention, and, being satisfied that the patent if granted would obviously be bad, held that a patent should not be granted. On appeal to the High Court,

MELBOURNE,

Oct. 10, 31.

Knox C.J.,
Isaacs and
Starke JJ.

Held, that a patent was properly refused.

Per Isaacs J. : There is nothing in the decision in *McGlashan v. Rabett*, (1909) 9 C.L.R., 223, which excludes the consideration of invention in the relevant sense when the novelty of a new application of an old device is challenged by way of objection to the grant of a patent.

Per Starke J. : An objection to the grant of a patent on the ground of want of novelty in the invention is not precluded merely because the same facts may also establish want of subject matter.

Linotype Co. v. Mounsey, (1909) 9 C.L.R., 194, and *McGlashan v. Rabett*, (1909) 9 C.L.R., 223, explained.

Decision of the Supreme Court of Victoria (*Mann J.*) affirmed.

H. C. OF A. APPEAL from the Supreme Court of Victoria.

1923.

—

GUM

v.

STEVENS.



—

Thomas Samuel Gum and Bertram Gordon Gum applied for a patent for an "improved lubricating device for vehicles." The claim in the complete specification was substantially as follows: (1) in an improved lubricating device for vehicles a valve or nipple which is adapted to pass grease or lubricating material from a grease-gun, syringe or pump into a lubricating duct and is inserted in the arm of the axle, and a duct communicating therefrom to the lubricating recess or area of the turned portion of the axle; (2) in an improved lubricating device for vehicles a lubricating duct consisting of a hole drilled into the arm of the axle towards the centre and a hole drilled diagonally from the lubricating area of the turned axle to meet the hole in the arm; (3) in an improved lubricating device for vehicles a valve or nipple inserted in the end of the axle, and an oil duct extending from the valve to the lubrication area of the axle substantially as described and illustrated in certain drawings. The application was opposed by William Vincent Stevens on the grounds, substantially, (1) that the invention had been patented in the Commonwealth on an application of prior date and (2) that the invention was not novel. The Commissioner of Patents decided that a patent should be granted, and in the course of his reasons he said:—"The invention of the applicants consists in a combination, and it differs from the inventions cited by the opponent in that the duct is formed in a particular way with a valve or nipple which is adapted to pass grease or lubricating material from a grease-gun, syringe, or pump. It is a combination which, according to the evidence, is new, and was unknown to the opponent at the date of the application for the patent. For these reasons, and acting upon the principle that the grant of a patent should not be refused unless it is quite clear that the patent, if granted, would be obviously bad (*McGlashan v. Rabett* (1)), I am of opinion that the patent should be granted."

The opponent appealed from that decision to the Supreme Court, and *Mann J.* allowed the appeal, reversed the decision of the Commissioner and refused the application for a patent, holding as to each of the claims that there was no novelty either of idea or of means, and being satisfied that the patent if granted would obviously be bad.

From that decision the applicants now appealed to the High Court. H. C. OF A.
1923.

Sproule, for the appellants. The objection of want of invention is not open under sec. 56 of the *Patents Act* upon an application for a patent. It is so stated in the head-note to *McGlashan v. Rabett* (1), and that rule has ever since been acted on to the extent that evidence is not submitted upon the question of want of invention. [Counsel also referred to *Linotype Co. v. Mounsey* (2); *Spencer v. Jack* (3); *Stamp v. W. J. Powell Pty. Ltd.* (4).]


GUM
v.
STEVENS.


[ISAACS J. referred to *Morgan & Co. v. Windover & Co.* (5).]

Owen Dixon K.C. and *Dixon Hearder*, for the respondent, were not called upon.

Cur. adv. vult.

The following written judgments were delivered :— Oct. 31.

KNOX C.J. The appellants applied for the grant of a patent for an invention for an improved lubricating device for vehicles. This application was opposed by the respondent, but the Commissioner ordered that the patent should be granted. This decision was reversed on appeal to the Supreme Court. *Mann J.* held that there was no novelty either of idea or of means in the alleged invention. He was satisfied that the patent if granted would obviously be bad, and that therefore the grant ought not to be made. I agree in his conclusion, and have nothing to add to the reasons expressed by him.

In my opinion the appeal should be dismissed.

ISAACS J. In my opinion the judgment of *Mann J.* was perfectly correct. I only wish to add a few words on the contention for the appellants that invention is entirely foreign to the question of novelty in this case.

Mr. *Sproule* put his point very clearly, and relied on that portion of the head-note to *McGlashan v. Rabett* (1), which says :—“ On an

(1) (1909) 9 C.L.R., 223.
(2) (1909) 9 C.L.R., 194.
(3) (1864) 11 L.T.(N.S.), 242.

(4) (1918) 24 C.L.R., 339.
(5) (1890) 7 R.P.C., 131.

H. C. OF A.
1923.
GUM
v.
STEVENS.
Isaacs J.

application for a patent of an invention it is not open to an opponent under sec 56 of the *Trade Marks Act 1903* " (meant, obviously, for *Patents Act 1903*) " to take the objection that the alleged invention does not involve any real exercise of the inventive faculty." We were informed that that statement has regulated the practice in the Patents Office. It is therefore very important to understand the matter. The statement in those broad terms is liable to be misunderstood, but it is quite easy to see how misunderstanding can arise. The words "invention" and "novel" are words of flexible and variable meaning. In *British United Shoe Machinery Co. v. A. Fussell & Sons Ltd.* (1) *Fletcher Moulton* L.J. says:—"The word 'invention' is used in at least three senses in connection with these subjects, and . . . these three senses are quite distinct. First of all we say that to support a patent there must be 'invention.' There it means an inventive act. Then we talk about a person getting a monopoly for an 'invention.' There it means a thing which is new and that has required an inventive act to produce it. There is also an intermediate sense in which it is used, that is to say, you sometimes speak of a patentee's 'invention,' meaning the particular inventive act which this inventor has performed." Now, there it must not be taken that *McGlashan v. Rabett* (2) decides that, when "novelty" is under consideration, there must be an absolute exclusion of "invention" in all its senses. "Novelty" or "newness" is also capable of being misunderstood and of being misapplied by reason of its flexibility of meaning. For present purposes it will be sufficient to refer to the case of *Tatham v. Dania* (3). There *Willes* J., delivering the judgment of the Court (*Bovill* C.J., *Willes* and *Keating* JJ.), said (4):—"I apprehend if a patentee would succeed it is necessary for him to show not merely newness in the sense of doing a thing which has not been done before, but that he must show newness in the shape of *novelty by producing a thing which requires some exertion of mind that could properly be called invention.* To apply an old tool to a new material could not be the subject of a patent, although all mankind had been previously using another sort of tool which produced a much inferior

(1) (1908) 25 R.P.C., 631, at p. 651.

(2) (1909) 9 C.L.R., 223.

(3) (1869) Griffin's Pat. Cas., 213.

(4) (1869) Griffin's Pat. Cas., at p. 214.

effect, and although therefore the application of the other tool had the merit in it that it produced a useful result in the easier working of a material to which that tool has not been applied before, but inasmuch as the tool has been used for an analogous purpose to that which all mankind knew it was useful for before, although the *application was new you would not say the application was a novelty in the sense of invention so as to sustain a patent.*" This is supported by the judgments in *Clark v. Adie* (1). There is nothing in the judgments in *McGlashan v. Rabett* (2) which excludes the consideration of "invention" in the relevant sense when the "novelty" of a new application of an old device is challenged by way of objection to the grant of a patent.

The appeal should be dismissed.

STARKE J. An application was made by Thomas Samuel and Bertram Gordon Gum for letters patent for an "improved lubricating device for vehicles." It was granted by the Commissioner of Patents, but, on appeal to the Supreme Court of the State of Victoria, *Mann J.* reversed the decision of the Commissioner, and refused the application. And from the decision of *Mann J.* the applicants have brought an appeal to this Court.

Substantially, the invention claimed by the applicants was a lubricating device for vehicles, which consisted of a valve or nipple inserted in the arm of the axle adapted to pass lubricating material from a grease-gun, syringe, or pump, into lubricating ducts communicating with the lubricating area of the turned portion of the axle. Ducts as a means of supplying lubricant to the bearing surface of the axles of vehicles were known and used prior to the date of the application. Further, a lubricating device for vehicles which consisted of a common form of screw-top grease-cup, adapted to pass lubricating material into ducts communicating with the lubricating area of the turned surface of the axle, was also known. Moreover, as *Mann J.* says, "there was at the date of the application another well-known force-feeding device known as a grease-gun or syringe, the gun when in use being connected with the grease duct by means of a

H. C. OF A.
1923.

GUM

v.

STEVENS.

Isaacs J.

(1) (1877) 2 App. Cas., 315, at pp. 326, 328-329, 333-334.

(2) (1909) 9 C.L.R., 223.

H. C. OF A.
1923.
GUM
v.
STEVENS.
Starke J.

nipple screwed into the mouth of the duct.” And indeed, the applicants in their provisional specification refer to the valve or nipple described by them, as of the ordinary well-known type. The substitution of the valve or nipple claimed by the applicants, for the cup, was therefore an obvious method of carrying out the same object, and by means of a device perfectly well known for lubricating purposes. There is certainly no subject matter in the so-called invention of the applicants.

But the learned counsel who appeared for them rightly said that the grounds of opposition to the grant of a patent did not cover want of subject matter, but want of novelty (*Patents Act* 1903-1909, sec. 56). And he relied upon the decisions of this Court in *Linotype Co. v. Mounsey* (1) and *McGlashan v. Rabett* (2). But I think these cases have been misunderstood. There is no very clear line of demarcation between subject matter and novelty. In deciding whether there is subject matter for the alleged invention, there are, as is pointed out by Mr. *H. Fletcher Moulton* in his work on *Patents*, at p. 17, three questions for consideration: “Firstly, is it a manufacture? Secondly, is it new? Thirdly, is it a new manufacture or, in other words, does it involve invention?” As *Griffith C.J.* remarked in the *Linotype Co.’s Case* (3), “proof of want of novelty is sufficient to support an objection for want of subject matter, but it does not cover the whole ground open under that objection.” Consequently, an objection to the grant of a patent on the ground of want of novelty in the invention is not precluded merely because the same facts may also establish want of subject matter.

The invention in the present case was, as already shown, lacking in novelty, and the appeal ought to be dismissed.

Appeal dismissed with costs.

Solicitor for the appellants, *B. L. Bodycomb*.

Solicitor for the respondent, *F. B. Waters*.

B.L.

(1) (1909) 9 C.L.R., 194.

(2) (1909) 9 C.L.R., 223.

(3) (1909) 9 C.L.R., at p. 202.