

5/1931

IN THE HIGH COURT OF AUSTRALIA.

Cowper

v.

Paper Sacks Pty., Ltd., and anor.

REASONS FOR JUDGMENT.

Judgment delivered at Sydney

on the 22nd. June 1931.

The appellant is the proprietor of Letters Patent 21809/25 for improvements in paper bags, and he applied under Sec. 71 of the Patents Act 1903-1921 to amend his complete Specification by way of disclaimer correction or explanation. The Commissioner refused the application, and an appeal is now brought to this Court, pursuant to Sec. 75 of the Act.

It is not material in this case to consider whether the amendments proposed by the patentee were by way of disclaimer correction or explanation (see Minerals Separation Ltd. v. Potter's Sulphide etc Ltd 8 C.L.R. 779), because Sec. 78 of the Act provides that no amendment shall be allowed that would make the Specification, as amended, claim an invention substantially larger than or substantially different from the invention claimed by the Specification before amendment. The Specification of the invention states that it relates to paper bags of the kind adapted for heavy service - that is, for containing such heavy charges or for standing such rough usage as would necessitate a single layer of paper for forming the walls thereof being of such a thickness that it would be cracked or seriously weakened by folding. The Specification in describing the invention sets forth three main elements:

1. Making the walls of the bag of a plurality of plies of paper.
2. Closing the bag and reinforcing the closure by means of strips of material.
3. Providing an opening, or, as it is called, a valve, in the bag, for the purpose of filling it.

It seems a simple even if it be a useful invention, but the inventor in his Specification made no less than twenty eight claims to protect it. And, worse still, he endeavours, in his separate claims, to cover "every possible permutation and combination of elements entering into the invention" by reference to and incorporation of other claims. Thus, to take Claim 10 as an illustration: "A paper bag as claimed in any of the preceding claims characterised in that a valve is provided in an end which is closed".

Many hundreds of permutations and combinations of elements entering into the invention are thus sought to be protected. No doubt this is the result of Sec. 61 of the Australian Patents Act, which provides:

"Where the complete Specification contains two or more claims in respect of the invention the invalidity of any one claim shall not affect the validity of any other claim or the validity of the patent so far as it relates to any valid claim".

The object of a claim is to give a clear statement of the invention claimed, but the method adopted in this case and rendered possible by the provisions of Section 61, fails to achieve that object and affords no protection whatever to the public. It is a method that the Commissioner of Patents might usefully check. (Patents Regulations Cl. 13, Bancroft's Application 23 R.P.C. 89). However, the question is whether the amendments proposed claim an invention substantially larger than or different from that claimed by the Specification. The main amendment is that set forth in amended Claim 1 as follows:

"A paper bag of the kind adapted for heavy service having its walls composed of a plurality of closely nested tubes of paper the plies of which are relatively movable at the places subjected to bending and having both of its ends closed by means of reinforced sewn or stapled seams which are formed by collapsing the nested tubes and making a reinforced sewn or stapled seam parallel and adjacent to each end thereof by sewing or stapling through the combined thickness of the walls of the bag and of reinforcing strips overlaid on either side of such closures and having the said plies of paper attached to one another only by the said end closures and having at one corner of the closed bag a valve formed by infolding a part of the multiply wall of the bag prior to the operation of forming the adjacent closure".

element or
Now this claim combines every/feature in the invention: it is, in truth, a claim for a combination. But where is any claim to such an invention found in the unamended Specification? Let me take a few illustrations. Claim 1 in that Specification is for a paper bag having its walls composed of a plurality of plies of paper which are relatively movable at places subjected to bending and having one or both of its ends closed by means of sewing stapling or the like. The reinforcing strips and the valve, mentioned in the amended Claim, are not part of this Claim. Claim 10 in that Specification is for a paper bag as claimed in any of the preceding claims characterised in that a valve is provided in an end which is closed. But there is no claim here to any other feature: it is merely the application of that feature (the valve) in a certain description of bag. Claim 19, on which most reliance was placed, is for a paper bag as claimed in any of the preceding claims characterised in that the bag is formed of a nested series of tubes, such tubes being attached to each other only at the closures at the ends of the bag. Here again, all that is claimed is a nested series of tubes attached to each other only at the closures of the end of the bag, and the application of that feature in a certain description of bag. Further illustrations are unnecessary: all the claims in the unamended Specification are open to the same observations, and none of them foreshadow or set forth the combination in the amended Claim 1. The amended Claims other

than that already mentioned are for substantially subordinate parts of the combination proposed by the amendment: they do not disclaim correct or explain anything in the unamended Specification, but claim something new or different from that set forth in that Specification.

The Commissioner was quite right in my opinion in holding that the amendments proposed by the patentee claim an invention substantially different from the invention claimed by the Specification, and therefore this appeal should be dismissed.

C O W P E R

v

PAPER SACKS PROPRIETARY LIMITED

J U D G M E N T

DIXON J.

The question upon this appeal is whether an amendment should be allowed under Part IV Div 4 of the Patents Act 1903- 1921 of a specification for an invention for improvements in paper bags for which a patent has been granted. An amendment may not be granted unless it ~~is~~ by way of disclaimer, correction, or explanation, and it does not make the specification, as amended, claim an invention substantially larger than, or substantially different from the invention claimed by the specification before amendment. (sec 71 and sec 78). If the amendments sought were granted, the specification would describe and claim an invention consisting in

the combination of a number of elements in a paper bag of a kind adapted for heavy service. The elements combined would be these:-

1. The bag would be composed of a number of tubes of paper.
2. The tubes would be nested closely one within another.
3. The plies or sheets of paper would be relatively moveable inter se where the bag was subject to bending.
- 4 Both ends of the bag would be closed.
- 5 They would be closed by means of reinforced sewn or stapled seams formed by collapsing the nested tubes and making such seam by sewing or stapling through the combined thickness of the walls of the bag.
- 6 The seam would be parallel to the end of the bag and adjacent to the end.
- 7 The seam would be reinforced by strips overlaid on each side.
- 8 The plies or sheets of paper would not be attached to one another

save at the ends.

- 9 At one corner of the closed bag a valve would be formed.
- IO It would be formed by folding in a part of the wall of the bag composed of the plies or sheets of paper.
- II The valve would be folded in before that end of the bag was closed.

The specification would also include additional claims adding other elements to a paper bag constructed with these characteristics. Although there can be little doubt as to the nature of the invention disclosed by the specification as it would be amended if the application were granted, it is by no means easy to discover from the unamended specification what is the invention it ascertains and claims. The difficulty does not arise from

the body of the specification, but from the nature and number of the claims with which it ends. The advance in the art of constructing heavy bags as containers of quantities of heavy material which is described and ascertained in the body of the specification is clear enough. The specification states the disadvantages of employing single sheets of thick paper, the expense of the paper, its tendency to break where folded, the necessity of closing it by pasting down the ends, the stiffness and consequent imperfection of valves made by folding in. It then proceeds as follows:- " With the object of avoiding these defects the walls " of the bag, according to the present invention, are made of " several plies of lightweight paper, the plies being moveable " relatively to each other at least at the places subjected to bending -g,

" and it has been found that the walls when so made may be folded
" without causing any substantial weakening thereof, that a valve
" made by folding the walls of the bag is sufficiently flexible
" to give a satisfactory closure, and that the strength and
" durability of the bag under rough handling are greatly increased
" over a bag made from a single sheet of substantially the total
" weight of the sheets used. " The specification goes on to

describe changes which are prescribed or recommended in the mode
of constructing a bag because of the alteration from a single
sheet of thick paper to a number of sheets of thinner paper.

The bag is to be closed by sewing, stapling or the like, instead of
by pasting. The valve is to be formed at the junction of the
side wall of the bag and the end closure, and it is to be formed

by folding in the wall of the bag at that point : further, a number of plies of paper are to be folded in . The stapling may be reinforced by a tape which may be adhesive , and may be placed on both sides. A preferred construction is by nesting tubes one within another, and leaving them unattached save at the ends. The valve is formed before the closing of the bag. The specification mentions some minor matters and enlarges on the advantages afforded by the method of construction described. The invention so far disclosed might be briefly but not inaccurately described as a paper bag for rough usage constructed of a number of sheets of comparatively thin paper attached together at one or both ends and not otherwise, so that, in bending, the sheets are capable of separate movement, and

so that a valve may be made by folding in the walls of the bag, which may include some subsidiary improvements that are necessitated by or occasioned by the use of a number of sheets of thinner paper instead of one sheet of thick paper. But the specification ends with twenty eight claims. The first of these claims a paper bag of the kind before referred to in the specification (which I take to mean "suitable for heavy " service, for containing material of great weight, and for withstanding " rough usage") having its walls composed of a plurality of plies of paper which are relatively moveable at the places subjected to bending, and having one or both of its ends closed by means of sewing, stapling or the like. Most of the remaining claims commence with the words

" a paper bag as claimed in claim (giving the number of or
" otherwise referring to one or more previous claims) characterised
" in that ". Then follows a statement of some element or

attribute not before referred to in the claims. If these claims
are treated as relating to one invention only they do no more than
progressively restrict the area of the monopoly for that invention
by progressively increasing the elements in which it consists.

But although a patent may be granted for one invention only, it is
not competent for any person in any proceeding to take any objection
to a patent on the ground that it comprises more than one invention
and if the specification contains two or more claims in respect of
the invention, the invalidity of any one claim does not affect the

validity of any other claim or of the patent, secs 6I and 65. In

the security afforded by these provisions the applicant has been able

to urge that amongst the claims in his specification he has claimed

an invention consisting in a bag constructed with the eleven character-

istics or elements for which his amended specification would claim a

combination. The claim by which this is said to be accomplished is the

19th which claims for " a paper bag as claimed in any of the preceding

" claims characterised in that the bag is formed of a nested series of

" tubes such tubes being attached to each other only by the closures

" at the ends of the bag." It may be conceded that by a judicious

synthesis of the characteristics to be found in the preceding claims,

a bag may be discovered in this claim possessing ^{the} features for which a

combination claim is now sought. In my opinion it does not follow

that the specification as amended would not claim an invention

substantially different from that claimed by the specification as it stands. In the first place the description " a paper bag as claimed in " any of the claims preceding the 19th " includes bags constructed according to a very large number of differing descriptions. The invention claimed by the 19th claim appears to me to reside, not in combining with the nested tubes attached only at the ends the other elements which make up the eleven features for which a combination claim is now sought, but in giving the characteristic of a nested series of tubes attached only at the ends to all or any of the bags which may result from the previous claims separately or in association.

In the next place it appears to me that a claim for a combination of the

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eleven features enumerated seeks protection for an invention which consists in combining for the first time these eleven integers whether or no any or all of them had been previously used or known. This appears to me to be an advance in the construction of bags substantially different from that disclosed by the 19th claim, consisting as it does in adding the specific features distinctly claimed by the 19th claim to bags of very many differing modes of construction notwithstanding that one of such modes involves the use of the other elements in combination. The divergence is still greater if, instead of concentrating on the 19th claim and the kinds of bag which may be discovered among those within the general words of the clause, the whole specification including the claims is read

for the purpose of discovering what in substance is the single invention for which protection was sought by the unamended specification. That invention was not a combination of integers possibly old. On the contrary it depended primarily upon the use of many sheets of thinner paper in place of one sheet of thick paper and upon the consequences which ensued from that use. No doubt some of the devices which according to the specification were made practicable or necessary by the use of a number of sheets of paper were combined with that method of construction. But nowhere is it claimed in the specification that the merit of the inventor lies in effecting the combination.

In my opinion the amendments sought would, if allowed, make

the specification as amended claim an invention substantially different from the invention claimed by the specification before amendment.

For these reasons I think the appeal should be dismissed with costs.

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NORMAN LETHERIDGE COWPER.

V.

PAPER SACKS PTY.LTD. AND ANOR.

JUDGMENT.

EVATT J.

JUDGMENT.

EVATT J.

The appellant unsuccessfully sought leave from the Commissioner to amend a specification dated 17th. February 1925, and now appeals to this Court.

Our decision necessarily turns upon the true nature of the inventions described and monopolies claimed in the original specification. It is headed "Improvements in Paper Bags". The inventor ^{res} declares his invention and the manner in which it is to be performed "to be fully described and ascertained in and by" the words and figures used, prior to the declaration of claim to 28 consecutively numbered heads of monopoly. Side by side with this description and these claims, we have to set the description and the 12 claims to monopoly contained in the proposed amendment.

The matter is conveniently tested by amended claim no.1. It is a claim of monopoly to a paper bag, which combines a large number of separate features. It was clearly shown by Mr. Stanley Lewis that

this combination as such was not described or ascertained in the body of the original specification or in the drawings attached thereto. It is said, however, that if the combination now selected and given such prominence was claimed as a monopoly in the original 28 heads of claim, the mere failure to describe and ascertain it should not be deemed a bar to the amendment.

Was new claim 1 included in any of the 28 old claims?

Five of the old claims were *as follows*:—

"1. A paper bag of the kind hereinbefore referred to having
"its walls composed of a plurality of piles of paper which are
"relatively movable at the places subjected to bending and hav-
"ing one or both of its ends closed by means of sewing, stapling
"or the like.

"7. A paper bag, as claimed in any of the preceding claims
"in which closure is effected by sewing, characterized in that
"a reinforcing strip is associated with the closure.

"10. A paper bag, as claimed in any of the preceding claims,
"characterized in that a valve is provided in an end which is
"closed.

"12. A paper bag, as claimed in Claims 10 or 11, characteris-
"ed in that the valve is formed by folding in the wall of the
"bag.

3.

"19. A paper bag, as claimed in any of the preceding claims
"characterised in that the bag is formed of a nested series
"of tubes, such tubes being attached to each other only by
"the closures at the ends of the bag."

New claim no. 1 is:-

"A paper bag of the kind adapted for heavy service
"having its walls composed of a plurality of closely nested
"tubes of paper the piles of which are relatively movable at
"the places subjected to bending and having both of its ends
"closed by means of reinforced sewn or stapled seams, which
"are formed by collapsing the nested tubes and making a re-
"inforced sewn or stapled seam parallel and adjacent to each
"end thereof by sewing or stapling through the combined thick-
"ness of the walls of the bag and of reinforcing stripe over-
"laid on either side of such closures and having the said
"piles of paper attached to one another only by the said end
"closures and having at one corner of the closed bag a valve
"formed by infolding a part of the multiply wall of the bag
"prior to the operation of forming the adjacent closure."

The argument of the appellant is that new claim no.1 is
contained
~~completely contained~~ in old claim 19. The latter claim (it is said) is
for a "paper bag, as claimed in any of the preceding claims", with
a new feature superadded.

~~Now~~ It is not possible to derive new combination claim
no.1 from any of the old claims unless it is present in old claim

19. It is ^{contained} ~~not possible to get to the essence~~ in 19, ^{only} if 19 is treated as a claim to a monopoly in respect of a bag which contains the feature emphasized in 19 (which is included in new claim 1), together with all the other elements making up new claim 1.

The only way in which a claim to such a combination can ~~possibly~~ be read into or constructed out of the old claims is by treating the latter in consecutive order from No. 1 to No. 19 as including monopoly claims to all the bags which would embody or combine any or all of the features described as the claims increase in number. By way of illustration, old claim 7 when it claims a "paper bag as claimed in any of the preceding claims etc." would be treated as a claim for a monopoly to all the various bags combining any one or more or all of the features included in claims 1 to 6 inclusive, with the added feature mentioned in claim 7 itself.

Now if such combinations were treated as having been claimed, it follows at once that, claim 1 is a claim to a monopoly

for 2 types of bags, claim 2 is a claim to a monopoly for 2 types of bags, claim 3 is a claim to a monopoly for 4 types of bags, claim 4 is a claim to a monopoly for 8 types of bags, claim 5 is a claim to a monopoly for 16 types of bags, claim 6 is a claim to a monopoly for 32 types of bags, claim 7 is a claim to a monopoly for 64 types of bags, and so on.

Thus, the 64 bag monopolies claimed in claim 7 would include every bag containing the characteristic feature of 7 in combination with every possible combination of bag containing one, two or more of the features in claims 1 to 6.

Proceeding along the list to claim no. 19, that claim would (upon the basis described) represent a claim to 34,816 combinations of bags each one of which contains the characteristics of claim 19. Claim no. 28, according to the same process, would be a claim to many hundred of thousands of combinations.

It is true that of the 34,816 combinations which, upon the hypothesis suggested, lie hidden in the simple phrasing of ^{claim} ~~claim~~

there would, as a mathematical necessity, be discoverable one bag corresponding to the combination now described in new claim no. 1, and the argument for the appellant involves the contention that new claim no. 1 should be regarded as a repetition of the claim of monopoly for the 34,816 combinations of bags made in old claim 19, accompanied by an implied disclaimer in respect of 34,815 combinations.

The overwhelming inference however, is that it was never intended to claim ~~any~~ this enormous number of combinations ~~which~~ in old claim 19. No one can fairly impute such an intention to the claimant. For the same reasoning applies to claim 19 as to claim 28, where the words used are the same and where the result of the hypothesis is quite preposterous.

In new claim no. 1 therefore
 The appellant is not ~~therefore~~ really disclaiming anything included in his old claim, and the combination now stressed was not one of the "improvements in paper bags" he originally claimed. Neither is he correcting or explaining his prior description or ascertainment of his invention. On the contrary, he

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is claiming a fresh combination, quite different to and distinct from any claim of invention made in the first specification. The Commissioner's decision was in my opinion correct.

The appeal should be dismissed.