

*Paper Sacks & Ppty Ltd*  
*v*  
*Cooper*

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*Reasons for Judgment*  
*of*  
*Mr Justice Rich*

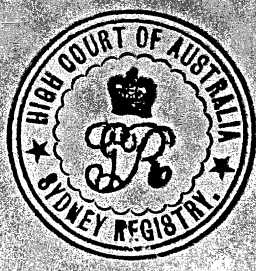
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*Reasons dismissed with costs &c*



*Judgment delivered in*  
*Sydney on 11/7/95*

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PAPER SACKS PROPRIETARY LIMITED.

AND

COWPER.

JUDGMENT.

MR JUSTICE RICH.

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*to replace copy*  
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*to Messrs. Millemore*  
*Solicitors*  
*SHB*  
*11/7/33*

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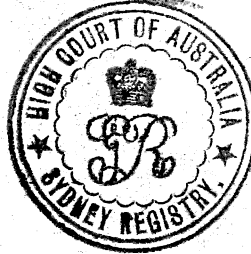
PAPER SACKS PROPRIETARY LIMITED.

PETITIONER.

and

N. L. COWPER.

RESPONDENT.



JUDGMENT.

RICH J.

This is a petition under section 86 (4)(b) for the revocation of letters patent dated as of 17th February 1925 granted to the Bates Valve Bag Co. in respect of an alleged invention for improvements in paper bags. The purpose of the invention is to provide a container which will resist a considerable amount of rough usage or will hold heavy charges, such as cement. The bag described by the specification consists of several plies of light weight paper fastened together only at the ends so that at the places subjected to bending they are

2.

relatively moveable. The ends are fastened by sewing or stapling or the like. A valve is or may be provided for the purpose of filling and closing the bag. The valve is made at an end of the bag where the multiply walls are fastened by sewing <sup>or</sup> stapling and it is formed by ~~the~~ folding in ~~the~~ the wall of the bag at this point. An orifice is thus made into which the material is poured. When the bag is filled its contents fall or press against the infolded paper and so close the valve or funnel. The petitioner claims that the patent should be revoked on the grounds that in the state of knowledge at the date of the patent the alleged invention possessed no subject matter, that it was not novel, that it had been anticipated, that before the

21

application for the letters patent it had in Australia been actually communicated to the public and that the specification is insufficient and ambiguous. Before any detailed consideration of the nature of the alleged invention and of the specification ascertaining it, some description is necessary of the state of common knowledge. Many substances are so fine that they tend to escape through containers of jute or other woven material which is also not so impervious to moisture as paper. For these and other reasons the use of paper bags is desirable, if the objections to paper on account of its weaknesses can be overcome. If strength and durability are sought in the stoutness and thickness of the paper other troubles are <sup>encountered</sup> ~~as~~ countered. The paper is less flexible. It cracks where it bends. Effective fastening is

33

less easy. Pasting or gumming is not a satisfactory means of closing paper containers and the thicker the paper the less secure it becomes.

Stapling or sewing is, of course, an obvious alternative but unless

it has the aid of the <sup>f</sup>ictional contact of the several plies of the thinner paper, <sup>ich</sup> what it is claimed is given by the alleged invention,

does not appear to be satisfactory.)

The use of several plies of paper to give strength was well known.

The use of sewing and stapling among other fastenings of paper was well

known. The use of a sleeve valve in bags of any material was well

known. The device of forming it by infolding the wall of the bag

was well known. But it does not appear that a form of construction

had been adopted in which several plies of paper had been left quite

free in their relative movement except at the two ends of the container. A patent was obtained in 1910 by one Priem for a multiply paper container but in his invention this freedom of relative movement was prevented because all the sheets of paper were fastened together down the side of the bag as well as at the ends. It appears from a patent granted in 1922 in respect of bag making mechanism invented by Bates, one of the inventors of the subject patent, that the manufacture of paper bags by making tubes to be cut into suitable lengths was known. But several such tubes, one within another, so far as appears, had not been fastened solely at the ends. The invention now in question professes to have as an object the remedying of some of the defects disclosed by this state of practice and

57

knowledge.

✓ The specification ascribes to the bag the ~~subject~~ of the invention four characteristics which it must have and then adds two further characteristics the addition of either or both of which will presumably make a further improved container. The first essential characteristic is that it shall consist of several plies of light weight paper. The second is that the plies of paper shall be moveable relatively to each other. The third is that it shall be closed by sewing stapling or the like. The fourth is that the various plies shall be held in frictional contact. In the course of stating these <sup>four</sup> elements the specification explains the advantage each gives. The first two permit bending and folding without

68



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weakening. They give a flexibility which enables the formation of a valve by folding which will close satisfactorily. The multiply sheets are stronger and more durable than a single sheet of weight equal to their joint weight. The sewing stapling or the like avoids the necessity of pasting each ply of the several plies of paper. In multiply walls it does not introduce the weakness it would in a single thickness. Although the specification may not contain a categorical statement to that effect, it is clear from its whole tenor that the fastening should be at each end and only there. Further it likewise appears with sufficient clearness that the frictional contact (the fourth of the elements I have extracted) is at the seams: it "compensates for any weakening of the plies due to perforations formed in closing". The

85

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✓ use of sewing or stapling to ~~close~~ close paper bags of several plies is justified by the specification thus, - first, the weakening effect of the line of perforation is less with the multiplies, second, bending along the line of perforations, which further weakens single walls, has little effect on the more flexible multiplies, third, the frictional contact of one ply with another along the line of the closures furnishes a strengthening feature which is absent from similar closures in single walled bags."

✓ These four elements having been briefly mentioned in the specification it proceeds to state the fifth. This is to be manifest<sup>ed</sup> in "a further embodiment of the present invention" and consists in providing in the bag at the junction of the end fastening with the vertical side

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9.

wall of the bag a valve formed by folding in the wall of the bag. The sixth element consists in the further addition that the valve itself shall be composed of a plurality of plies of paper so infolded i.e. that one only of the plies shall not be folded in to form the valve.

Besides these features upon which the specifier concentrates there is a number of other matters which enter into "preferred constructions" of the invention and find a place in some of the claims.

It is preferred to apply at the ends to be closed a tape on both sides to reinforce the place of stitching or stapling. It is preferred to use adhesive tape. It is preferred in making the bag to apply the adhesive tape immediately in advance of the needle so that the adhesive material adheres to the thread as well as the juxtaposed paper.

104

10.

To prevent ravelling and give strength, it is preferred to extend the tape beyond the walls of the bag at each corner particularly at a corner where there is a valve. It is preferred to construct the bag by folding layers of paper to make a nest of tubes each outside the others. It is preferred to have vertical bellows folds at each side of the collapsed bags: the valve is then made in one of the bellows folds which is folded down to form so to speak a horizontal channel. Last, a preference is expressed that involves an implication upon which the petitioner places great reliance. "It is preferred", the specification runs "to make the layers of which the bag is composed entirely separate except for the end closures. This allows the free play of

115

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one layer with respect to the other and reduces to a minimum the tendency to crack and furthermore it allows the removal of one layer without destroying the entire bag. Also "It is preferred" to construct these layers from tubes <sup>which are</sup> ~~with one~~ nested one within the other and are entirely unconnected to each other except by the end closing seams. It is obvious that this preference implies that the invention may be embodied in bags where complete relative movability between the plies is limited by a junction between the plies at other places besides the closed ends. Much of the utility of the bag arises from the degree of relative movability of the plies which it allows. The petitioner, therefore, suggests that actually this important point did not appeal to the inventors or specifiers and therefore should not ~~be~~ now be

12

relied upon as affording or contributing to subject matter. I do not so understand the specification. I think relative movability of plies strongly appealed to the inventors but they considered that its presence was a matter of degree. They in effect say the highest degree is obtained by joining the plies only at the end closures but that less degrees of relative movability are within their invention. The claiming clauses of the specification amount in number to no less than twenty eight. They are constructed upon the "chain" principle and in the claims which succeed the first the formula adopted is, - "a paper bag<sup>as</sup> claimed in any of the "(or some specified)"preceding claims, characterised by" such and such additional feature which is described.

Some proceedings arising out of an application to amend the specification (which was substantially unsuccessful) were taken to the Privy Council. In the course of these proceedings the effect of this form of claim was discussed. The petitioner contends that it was decided in this Court that the invention claimed by each of the claims expressed in this form consisted not in combining the various features contained in that claim and the preceding claims, but in giving to a bag having features referred to in the preceding claims the new feature described in that claim.

The respondent on <sup>the</sup> ~~that~~ other hand contends that the course of the argument in the Privy Council shows that their Lordships considered each of the "chain" claims to amount to an ordinary combination claim.

or a series of combination claims. The difference between these two views of the claims appears to me to be of less practical importance in considering whether the patent should be revoked than upon the question which ~~facts~~ fell to be decided in the former proceedings, namely, whether a proposed amendment containing a combination claim composed of many integers did or did not claim an invention substantially larger than or different from the invention claimed by the original specification. Which ever view is taken of the effect of the form of claim I think the claims will be found to cover a combination of ~~the~~ all the essential<sup>be</sup> features which can reasonably<sub>^</sub> relied upon as affording subject matter and none of the other questions in the case

161



15.

is much affected by the distinction.

✓ I proceed to state the effect of the more material of the c

claims. The first as I read it is a claim for a bag adapted for heavy

✓ service (i.e. for containing charges too heavy or <sup>for</sup> standing usage too

rough for a single ply not so thick as to be liable to crack) construct

ed with three features. These features are (i) plurality of plies of

paper (ii) relative movability at places subjected to bending (iii)

closure of one or both ends by sewing stapling or the like.

The second claim adds the feature that the plies are relatively moveabl  
near the closure.

The seventh claim adds the feature that the closure is effected by

sewing with a reinforcing strip. The eight and ninth add to this the

173

16.

adhesive character of the reinforcing strip and the use of adhesive tape. The tenth and eleventh add the valve at a closed end formed by sewing stapling or the like. The twelfth and fifteenth claims add the formation of the valve by infolding the wall of the bag and doing so at the end of a bellows fold. The fourteenth claim introduces the bellows fold and the sixteenth the method of folding it <sup>in</sup> to form a valve. The nineteenth claim adds to a bag made with the features comprised in any of the ~~the~~ previous claims the construction by a nested series of tubes attached to each other <sup>only</sup> at the ends where the bag is closed. The twentieth claim begins a new chain. The features which it claims are (i) plurality of plies (ii) relative movability at places

174

17.

✓ subjected to bending (iii) a valve formed by infolding the wall (iv) at the junction of the wall with the end closure. The method of fastening by sewing stapling or the like is not claimed as an integer in the combination. The twenty-second claim adds to this combination the bellows fold and the position of the valve at the junction of the bellows fold with the closure. The twenty-fifth claim adds the use in the valve of the plurality of the plies of paper which are relatively moveable.

✓ In considering whether, in all this aggregation, subject matter for an invention is to be found it is necessary first to determine in what, if any, respect the patentees' bag was new.

In addressing myself to this question I commence from the statement of common knowledge made earlier in this judgment. I take into

19

18.

account what is disclosed by Priem's specification and by the specifi-

✓ cations of the 1906 and 1922 patents granted to Bates one of the

✓ inventors of the subject <sup>invention</sup> ~~patent~~ and, for what it is worth, the specifica-

✓ tion of the American invention ~~in 1912~~ <sup>alleged to have been</sup> of one Sanders published at the

Public Library Perth Western Australia on the 23rd September 1912.

I attach little importance to the testimony given about the so called

rubbish bag said to have been multiply sewn and that given about a

bag said to have been used by a firm in Brighton(Victoria) named

Hayball Bros. I do not think this evidence can be relied on as giving

a dependable account of the real construction of the bags. At any rate

I am not prepared to act upon it.

207

Evidence was given about a number of other bags e.g. a so called catalogue bag, a coke bag, a nailbag, a bag used in the laboratory of Elliott Bros. Sydney, bags for tea coffee and the like, and a bag seen at Simpson & Mann's manufactory. <sup>(Sydney)</sup> While this evidence illustrates common knowledge, none of it would afford a satisfactory basis for formulating a method of construction for any specific bag. All of it in combination would fall short of supplying a design embodying the features relied upon as supporting subject matter of the invention now in question.

Another matter going to common knowledge is a machine known as Strachan & Henshaw's. It is used in Melbourne to make block bottom bags. It adjusts the sheets of paper into the necessary form to make these bags. Mr Gibson who saw the machine said in effect that there

219

was no adjustment which could be readily made so as to paste the plies of paper at the bottom of the bag together if desired. The machine as operating was pasting the outer sheet to itself. Mr Gibson then went on to say that that is an unsatisfactory closure of a bag for carrying a heavy load. I have treated these matters as going to common

✓ knowledge as well as to prior user in <sup>the</sup> ~~a~~ strict ~~er~~ sense, but in either aspect they are open to the observations made by Astbury J. in Boyce

✓ v. Morris Motors Ltd. (44 R.P.C.105 at p. 135 ~~1-24~~) "When a patent, "especially one of a simple character, has proved a commercial success,

✓ "evidence of alleged prior user requires and ought to receive <sup>thereof</sup> careful "scrutiny, and evidence of something that was nearly, but not quite,

"a prior user is not relevant as such to an allegation of want of

"subject-matter in a subsequent patent".

It cannot, however, be said that any of these are <sup>an</sup>new ~~in~~ the present invention.

I think the patentees' bag exhibits an association of features which <sup>was</sup>~~was~~/new. It associates multiplies of light weight paper, fastening at the ends, sewing or stapling, frictional contact of all the plies at the sewn or stapled fastening, and relative movability adjacent thereto and elsewhere, by allowing complete absence of a fastening of the plies at any other point. This arrangement permits conveniently the bellows fold and the infolded valve; and the fact that they can be accommodated and are in fact used, as well as claimed as further integers, cannot be disregarded. It is no part of a patentee's duty in his specification to explain either how he reached his invention

24

✓ (British United Shoe Machinery Company Ltd. v. Fussell & Sons Ltd (25

R.P.C.631 at pp.651 -652) or the exact mechanical principles upon which it depends. But it does appear from the specification that the specifiers saw that strength and flexibility could best be achieved by seeking the highest degree of relative movability in manifold plies that seams at the ends would give this; that sewing of manifold plies gave a strong closure and yet allowed the bag to open out when filled. Next, before deciding whether or not this advance discloses sufficient subject matter for a grant, it is desirable to consider the utility of the alleged invention. Now, it cannot be denied that the respondent's bag has achieved a most remarkable <sup>commercial</sup> success in Australia. Indeed its success accounts for the importance that both parties give to these 256



23.

✓ revocation proceedings. In my opinion three matters contribute to ~~A~~ and have brought about this commercial success. The first factor is that a bag constructed according to the alleged invention has proved very efficient. The reasons for this are explained by Mr Gibson whose evidence I accept. In the next place the actual manufacture of the ✓ bags is conducted with care ~~and~~ economy and skill. In the third place ✓ the sale <sup>and</sup> distribution has been pressed with ingenuity, enterprise and business diplomacy. But while the presence and importance of the second and third factors are undeniable, they would have been of little or no avail without the first. The fact is that no paper bag for heavy service has been able to succeed in the absence of any ✓ one of these integers: <sup>W.L.G.</sup> multiplies, high degree of relative ~~maximality~~ 268

movability, sewn or stapled seams at the ends, and infolded valve.

It remains to decide whether in these circumstances the advance by the alleged invention involves a sufficient exercise of the inventive faculties to afford subject matter.

✓ " The question whether the discovery claimed constitutes invention such as will support the validity of a grant is a question of fact to be determined in each case upon all the relevant circumstances,

✓ Ore Concentration Company (1905) v. Sulphide Corporation Ltd. (31 R.P.

C.206 at p. 226. A discovery that a known thing can be used to produce effects previously unknown although it may be a great and useful discovery does not amount to a patentable invention. It adds to nothing but knowledge. But if the addition is not merely to

280

knowledge but produces a new and useful thing or result or a new ~~an~~

✓ method of producing an old thing or result <sup>the</sup> that is subject matter, per

<sup>C.J.</sup>  
~~Lord~~ Lindley in Lane-Fox v. The Kensington and Knightsbridge Electric  
Lighting Company (Limited) (9 R.P.C. 413 at p. 416. In a well known

passage in Vickers, Sons and Co v. Siddell (7 R.P.C. 292 at p. 304

✓ Lord Herschell states the test <sup>be</sup> ~~as~~ to whether the step <sup>so</sup> was obvious that

it would at once occur to anyone acquainted with the subject and desi-

rous of accomplishing the end or whether it requires some invention to

devise it. He then says " there is no doubt about the law applicable

"to such a question, though it is often difficult to apply it to the

"circumstances of a particular case, and its application is perhaps

"most difficult when the alleged invention consists of a new apparatus

192

"combining known elements. If the apparatus be valuable by reason of  
"its simplicity, there is a danger of being misled by that very simplicity  
"into the belief that no invention was needed to produce it. But  
"experience has shewn that not a few inventions, some of which have revo-  
"lutionised the industries of this country, have been of so simple a  
"character that when once they have been made known it was difficult  
"to understand how the idea had been so long in presenting itself, or  
"not to believe that they must have been obvious to everyone". But  
✓ " a mere selection among possible alternatives is not subject matter.  
A selection to be patentable must be a selection in order to secure  
some advantage or avoid some disadvantage. It must be an adaptation

of means to ends impossible without exercise of the inventive faculty;" per Lord Parker in Clyde Nail Company Ltd. v. Russell (33 R.P.C.291 at p 306 and cf. Auster Ltd v. Perfecta Motor Equipments Ltd (41 R.P.C, 482 at p.497. "It may be only a small step but it is a step forward and that is all that is necessary", said Lord Warrington of Cliffe on behalf of the Privy Council in Canadian General Electric Co.Ld. v. Fada Radio Ltd 47 R.P.C.71 at p.90, in dealing with an integer not in itself new but given a particular use in combination with other elements of a system for a specific purpose and producing an advantageous result. Simplicity in a combination is not in itself a sufficient answer to its validity. The question is one of degree and an important element in the consideration whether there has been invention or not is, whether

315

the thing never having been done before it is a great success as regard utility and value in the market. Although these considerations are not conclusive of ingenuity they demand an answer to the question why, unless there is some ingenuity, it was never done before; see per Lord Shaw in British Vacuum Company v. London & S.W. Ry Co. (1912) 29 R.P.C. 309 at p. 330 citing Bowen L.J. in American Braided Wire Co. v. Thomson (5 R.P.C. 113 at p.125. It must be a real advance but if a development be one of utility and satisfies a long felt want in the trade, the presumption, not of law but of fact, arises that it embodies inventive ingenuity. The presumption may be displaced by evidence explaining the circumstances and the question must be answered in the

32/

end whether there is a fresh departure in inventive skill or for instance a natural development of already inchoate art, see <sup>per</sup> Lord

Haldane L.C. British Vacuum Co. v. James Robertshaw (1915) 32 R.P. C. 424, at p. 43<sup>4</sup>.

Objections of want of novelty and of subject matter often cover common ground although so far as possible they require separate consideration ; see per Lord Herschell in Vickers, Sons and Co. Ltd. v. Sidel

(7 R.P.C.292 at p.304).

If a man with some or all of the alleged anticipations before  
 ✓ him and grappling with the problem intended to be solved by the <sup>alleged</sup> inven-  
 ✓ tion ~~the subject of the present patent~~ would say "that gives me what I  
 "wish" there is neither novelty nor subject matter. But if, with all  
 this information and with common knowledge, ingenuity was required to  
 take the step disclosed by the present patent there is both novelty and  
 ✓ subject matter. Cf. the phrases quoted in Pope Appliance Corporation v.  
 ✓ Spanish River Pulp and Paper Mills Ltd. (41 R.P.C.23 at p.52).

I have come to the conclusion that the invention possesses sub-  
 ject matter. It is needless to say that it lies in the judicious  
 association of known elements or expedients; that no great departure

345



✓ from received methods is involved and that ~~it~~ called rather for a happy exercise of judgment founded upon experience and experiment than for a stroke of intuition or speculative imagination. But nevertheless there was an obstacle to ~~the~~ be surmounted. The expedients were at hand but no one had made the right selection. By a judicious choi\_ice among them based, as I think, upon an appreciation of their operation~~s~~ and mutual interaction the obstacle was surmounted. The demand ~~was~~for such a bag was there: it was implicit in the disadvantages of existing methods and practices. The invention alone seems to have answered it. In my opinion enough ingenuity was needed and is inherent in the association or combination to amount to invention. I think that subject matter exists in the first claim but more clearly in the second

tenth, twelfth, fourteenth, fifteenth, sixteenth and nineteenth claims.

I proceed to consider the alleged anticipations.

This case emphasizes the justice of the observations made by ~~Lord~~  
<sup>L.J.</sup>  
✓ ~~Justice~~ Fletcher Moulton (as he then was) in British Ore Concentration  
Syndicate Ltd v. Minerals Separation Ltd. (26 R.P.C.124 at p. 147

"It cannot be too carefully kept in mind in patent law that, in order  
"to render a document a prior publication of an invention, it must be  
"shown that it publishes to the world the whole invention - i.e. all  
"that is material to instruct the public how to put the invention in  
"practice. It is not enough that there should be suggestions which,  
"taken with suggestions derived from other and independent documents,  
"may be shown to foreshadow the invention or important steps in it.  
"Since the date of the vigorous protest by Lord Justice James against  
✓ "such a 'mosaic' of prior publications this has been a universally

371

"accepted and most salutary principle. It applies with exceptional  
 "force in cases where the alleged prior publications are the Specifica-  
 "tions of unsuccessful inventions which have accordingly never passed  
 "into public general knowledge but have rightly been forgotten.

✓ " All my <sup>past</sup> experience emphasizes in my mind the justice of this rule.  
 "The industrial and scientific problems, which face mankind, are being  
 "attacked all over the world by busy inventive minds from the most  
 "varied points of view. When some lucky inventor has been successful  
 "in solving the problem and - whether for the purposes of an action or  
 "otherwise - the records of past failure or incomplete success are  
 "searched, it is common to find that suggestions or adumbrations of each  
 "of the various steps, by which he has achieved his result, are to be  
 "found in some one or other of the works of those who have gone before  
 ✓ "him, though in different connection and forming part of a different  
 "and probably unsuccessful process. When such records are selected  
 "from a mass of antecedent publications and put in an isolated form  
 ✓ "before <sup>a</sup> the Court, there is a danger of their giving rise to a suspicion  
 "of a general lack of novelty in the successful invention. But it

"must be ~~remembered~~ remembered that these alleged prior publications  
 "are the product of a selection made with a knowledge of the success-  
 ✓ "ful invention, and that probably hundreds of proposals equally promising  
 "but which point in wholly different directions, have been ~~fully~~ rejected  
 "in the search by reason that they do so. It is somewhat as though  
 "one were to decry the merit of a prospector who had discovered that  
 "sands were auriferous by showing that after due rejection of most of  
 "the non-metallic particles from a handful of sand the gold may be made  
 "to appear visible to the naked eye."

Almost every word of this appears to be applicable not only to the paper  
 anticipations relied upon but also to the instances of prior user.

I can deal quite shortly with each of the anticipations cited. The

first relied on is an invention No 5158 of 1906 by A.D. Bates one of

✓ the inventors of the <sup>Subject Invention</sup> ~~subject patent~~. It is a single ply valve bag of

403

any material. Presumably the petitioner cited this invention in relation to the valve. But in any case I am prepared to believe that valves in containers form part of the stock of common knowledge.

It is no anticipation. As to Priem's invention, No 12,223 of 1910, it is enough to say that it missed the entire point of relative movability between the plies wherever possible and needlessly fastened the plies together vertically. The subject invention by providing a closure at each end and only at the ends makes it unnecessary to limit the relative movability of the plies at any other point. Any fixed connection of two plies at any point except the ends is therefore due to some cause or requirement which is accidental and forms no part of the subject invention which deprecates any limitation of movability. Priem's invention is no anticipation. 416

~~Another anticipation cited was an invention of one Sanders the subject of an American patent of 1912 - (No.1029893) alleged to have been published at the Perth Public Library. This citation was not pressed in argument. I am not clear that proof was offered in proper form but in any case the suggestion that it is an anticipation must fail. It relates to the making of lined paper bags - bags made with the inner and outer walls of different materials. It shows that paper bags may be made of separate rolls of paper for the inner and outer bags with freedom of relative movement but the whole objecti~~xxx~~ of the invention is different from that of the subject patent. The relative movement is to enable the bags to slip one from another as the bags are filled and expanded. Where strength is desired at the bottom of the bag the inventor directs interfolding. The invention incidentally illustrates the bellows u~~

fold. It is obviously no anticipation and no doubt was cited <sup>only</sup> for special features. No 5891 of 1922 another invention <sup>by</sup> A.D. Bates is for a process and apparatus for making and filling bags. The bag is a single ✓ ply bag of any material, expressly including paper. The invention is for a machine for the manufacture of bags. The machine produces a tube of material sewn at the longitudinal joint in the case of woven fabrics <sup>cloth or other</sup> or cloth and pasted in the case of paper. <sup>It does not provide for nested tubes</sup> It does ~~not~~ provide for closing a section cut off the tube transversely by sewing and in the case of paper provides for a reinforcing strip. Except for these features it is not in point.

The next question is whether the alleged invention was actually communicated in Australia to the public before it received protection.

✓ The <sup>e</sup> question arises from the circumstance that at or about the time the <sup>24</sup>

✓ patent was applied for, one McAuliffe, who had been entrusted by the patentees, who carried on business in the United States of America, with the task of forming a company or syndicate in Australia to exploit the

✓ invention, showed and explained it to several persons. The patent was applied for on 17th February 1925 and McAuliffe arrived here on 6th February 1925. A question of fact arises whether I am satisfied that the invention was thus explained before the 17th February 1925. McAuliffe gave evidence. His credibility was attacked on grounds which I

*beyond saying that I agree that much caution sh<sup>d</sup> be exercised in accepting his evidence* need not enter into *^* It will be sufficient for me to state my conclusions.

There are two questions - whether the bags were shown and at what dates. Upon the first question I think the bags were shown in

454



37. *Hughes,*

the Hotel Australia Sydney to *Hughes,* Williams, Randall, Corben, Humphries, Symonds, Beattie and Newman and I think a sample bag was intrusted to Randall for his closer inspection and examination. On the second question I am quite satisfied that ~~that~~ the bag was not shown to Mr Hughes until after the 17th February 1925. I am, however, satisfied that the inspection by Williams and the other persons abovenamed *except Hughes* occurred before the 17th February 1925. Apart from the statute the fact that, prior to the application, some Australian people under no obligation of secrecy arising from confidence or good faith towards the patentees knew of the invention would avoid the grant; see per Fry L.J. Humpherson v. Syer (4 R.P.C. 407 at p. 414. I cannot see that the persons to whom the bag was shown by McAuliffe were under any duty of secrecy or in any

466

relation of confidence or under any obligation of good faith. What  
McAuliffe's duty was to his principals is immaterial; the question is  
what knowledge was imparted to persons entitled to use it as members of  
the public. But in my opinion an answer to this ground of the petition  
is given by section 124 of the Patents Act 1903 - 1921. This section,  
adopted from section 5 of the South Australian Patents Act, Amendment  
Act, 1881 44 & 45 Vic. No 201, is as follows:-

"The fact that an invention has been exhibited or tested either  
publicly or privately shall not in itself be deemed a ground for  
refusing a patent.

"Provided that any public exhibition or testing must have been within  
one year of the date of the inventor lodging his application for a  
patent".

The provision is puzzling and an examination of the previous State

479

legislation which was made in the course of the argument before me

increases rather than diminishes the doubts as to the purpose inspiring

✓ <sup>it</sup> ~~this~~ enactment. Undoubtedly such provisions arose out of the desire

to allow new inventions to be displayed without risk at general exhibi-

tions of Arts and Manufactures. But I think the present federal section

must in its terms be treated as of general application and as intending

to abrogate to a wide extent and in a striking way the operation of

the principle that there should be no prior public ~~exposure~~ disclosure

or communication of the invention.

I am of opinion that the expression "exhibited publicly or private-  
ly" means submitted for inspection either by persons who may choose to  
examine it simply as members of the public or by persons individually

x91

selected or permitted to see it as members of a specified class or the like. I think the bag was submitted for inspection by persons chosen by McAuliffe individually because of their probable or prospective interest in the matter. What was done was, in my opinion, justified under section 124 as private exhibition of the invention. It was argued that all section 124 says is that exhibition shall be no ground for refusing a patent and that it was not in point when the question was one of revocation.

I do not agree with this argument. The reason for ~~reversing~~ <sup>502</sup> revoking a patent granted for an invention previously disclosed was that the invention ought not to have been granted. If notwithstanding.

502

the prior disclosure the patent was properly granted it ought not to be revoked.

The last ground of attack upon the patent was that the specification was insufficient and avoidably obscure and ambiguous.

This attack is based on the use at various places of importance in the specification of vague or inexact expressions.

The particulars of objections under this head are -

"The specification of the said Letters Patent is vague ambiguous and uncertain inasmuch as the claiming clauses thereof do not sufficiently indicate the invention or inventions in respect of which a monopoly is claimed."

No greater particularity was sought by the respondent and none vouchsafed by the petitioner.

The language was criticized which describes the purpose of the invention as being to furnish bags for "heavy" service, to contain a "heavy" charge, and to stand "rough usage". It was asked what was meant by "several" plies and a "plurality" of plies. What thickness of paper was specified? What are the places subjected to bending and what is "relative movability of the plies" there required? Does the specification make entire freedom between the plies part of the

52

invention? When it speaks of "sewing stapling or the like" what is covered by "the like"? These and similar criticisms were interspersed in the argument of other questions requiring reference to the specification and it is not easy to say exactly how far the petitioner presses this ground and on what it relies.

✓ But I think the specifier fulfilled his obligation <sup>+</sup> of describing ✓  
 ✓ <sup>2</sup>clearly the ambit of the monopoly <sup>o</sup> claimed and of explaining how to carry  
 the invention into effect.

The purpose for which the bags should be used cannot be stated in words of precision. Thickness of paper, number of plies, weight of charge and roughness of handling are all interdependent. The person who requires

es a container is expected to use some common sense or judgment in choosing the material and the number of plies in reference to the goods to be put in it and the usage it is likely to experience in the course of handling. So the places subjected to bending depend upon the dimensions of the bag, the use or absence of the bellows fold, and the nature of the charge.

(As to the words "the like" they obviously are used to prevent infringement by resort to some equivalent of sewing or stapling which the specifier cannot exactly foresee. I have already expressed my opinion upon the meaning of the specification in relation to the complete movability of the plies inter se. ¶ I have not thought it necessary to consider the validity of every claim. I do not think the Court ought

542

44. *even if it has power to do so.*  
to revoke single claims where the substance of the patent is upheld. *✓*

On the whole case I think the petition fails and should be dismissed with costs including the costs of the shorthand notes *✓* of  
*all interlocutory proceedings.*

*545*  
*✓*

*545*  
*2*  
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*50*  
*52*