

40 8 of 1925.
IN THE HIGH COURT OF AUSTRALIA.

Barnes

v.

Jose

REASONS FOR JUDGMENT.

Mr Justice Clarke



Judgment delivered at Sydney
on 20th April 1926

JUDGMENT

STARKE J.

The plaintiff is the registered proprietor of Letters Patent No. 20737 of 1929 for improved means for attaching wrist straps to watches and the like. The action is for infringement by the defendant of those Letters Patent.

It appears that watches have been secured to the wrist of the wearer by various methods. One method was by means of a strap with a cup sewn on or attached to it in which a watch might be placed; this was a somewhat cumbersome device. Another was ~~was~~ by means of straps, in various forms, attached to or passing through lugs made on the sides of watches and buckled on to the wrist. There were straps threaded through the lugs; straps looped through the lugs and stitched together, called in the evidence the "sewn-on" strap; straps simply looped on to the lugs and called the "loop-on" strap; straps looped on the lugs and fastened with a stud attached to the strap, called the "stud-on" strap; straps with a metal plate placed in a pocket, formed by the strap and a piece of leather sewn on to the strap, and bent over so as to form a sort of hook: this type is called the "hook-on" strap. All these forms were commonly known and more or less used in Victoria before the date of the Letters Patent sued on. I must also refer to another strap called the "Tab" strap. It is made with a metal clip placed between the strap and its lining. One end of the clip projects beyond the lining and is bent over so as to form a tab or hook, whilst at the other end is a prong, which is passed through the lining and bent over so as to ~~form~~ fasten the clip to the strap. It is not certain when these "Tab" straps first came into Victoria, but the witnesses Bright and Cutler satisfy me that they were being offered for sale and sold in Victoria before the end of 1928. They ~~did~~ not prove very satisfactory, and do not appear to have been much used. The fact, however, that men of standing such as Bright and Cutler remember them well enough satisfies me that these straps were commonly known and were used to some extent in their trade. The existence of the English specification (Exhibit 'O') relating to this form of strap, and the dates stated upon it (which it was agreed I might regard as facts) do not, I think, render this conclusion improbable. The applicant for an English patent might have offered for sale and sold these straps in Victoria before the end of 1928, and have been satisfied with the pro-

tection that he would or could obtain on the grant of an English patent.

The "sewn-on" strap, said one of ^{the} witnesses, is the neatest and most suitable strap you can get on a watch. But both lugs and straps broke or got out of repair, and, according to the witnesses, watchmakers and jewellers had little facility for fastening lugs with straps on them to the watches, or for stitching straps on to the lugs. Repairs were nevertheless effected, sometimes by watchmakers and jewellers, and, not infrequently, I gather, by the owners of watches themselves. Straps were available, as we have seen, that did not require stitching. Metal staples or clips, or rivets or fasteners, were well-known and were commonly used for fastening the straps to the lugs in repair work. The witness Cutler gave a good illustration of this kind of work. He just slit the stitching joining the outer and inner sides of a strap, looped the strap round the lugs, and then clamped the outer and inner sides of the strap together by a small metal clip having points or prongs at each end. The ends or prongs of the clip were concealed within the outer and inner sides of the strap, but the plate of the clip would be on the wrist when the strap was buckled together. Again, the witness Bright explains how he used to reinforce wrist straps by metal clips or strips across the straps. The carrying out of repairs and reinforcements in the manner indicated was part of the knowledge of a competent and skilled workman in the trade.

The invention claimed by the plaintiff may now be considered. The invention is thus described in his Specification:

"According to my invention a metal plate having projecting tongues or points is concealed between the outer layer and the lining, and is located near the end of the strap. When the end of the strap has been passed through a loop of the watch, the tongues are passed through holes in the strap or around the side edges thereof and their ends bent down to prevent return."

He gives three methods of construction: they are illustrated in Figures 3, 4, and 5 of the drawings accompanying the specification. In all three the metal plate is concealed within the strap, but in two (Figures 3 and 5) the tongues or prongs are not concealed within the strap, whilst in the third (Figure 4), both the metal ^{plate} ~~strap~~ and the tongues or prongs are concealed within the strap. There are only three claims. The first is for a watch strap comprised of an outer layer and an inner lining, a metal plate adapted to be concealed between the layer and lining and having integral tongues passing through holes near the end of the strap and bent closely upon the inner surface thereof. This claim is for a strap made

according to the method illustrated in Figure 3. The second claim is the employment of a metal clip adapted to be concealed between the outer layer and the lining of the strap and having projecting tongues whereby the strap after it has been passed through the lug of a watch may be fastened. This claim extends to all three methods of construction. So does Claim 3, which claims in combination a metal plate and a strap comprised of an outer layer and a lining between which the plate is concealed, and tongues projecting from the plate whereby the strap may be fastened.

Straps for wristlet watches, with linings, were well known, metal staples clips rivets and fasteners were well known, and had been used for the purpose of fastening straps which had been passed through the lugs of watches. But it was desired to conceal the plate of the metal clip, which was unsightly and was discoloured by the sweat exuding from the body of the wearer. The problem, if problem it were, was how to conceal this plate. The plaintiff ^{concealed} ^{placing it} ~~did it by concealing the plate of the metal clip~~ between the outer layer and the lining of the strap.

An invention may be the result of a happy accident, without the exercise of any particular skill or knowledge, but there must be some advance on previous knowledge: the public must be told something they did not know before, the invention must not be obvious. It is easy, I know, to minimise an invention: it is easy to be wise after an event. But I should have thought, almost without evidence, that what is claimed in this case as an invention is but an ordinary development in the making of wristlet straps which any ordinary person skilled in that trade would have perceived and accomplished, had he been required to put out of view or conceal the metal plate of the clip. And the evidence of the state of prior knowledge satisfies me that the invention which the plaintiff claims in his specification constitutes no advance on prior knowledge or practice, and is but a natural development in the making of straps for wristlet watches and required no inventive skill. In short, the invention claimed is wanting in subject matter. The "stud-on" strap concealed the base of the stud between the strap and a small piece of leather sewn on to the strap, which is comparable to the lining referred to in the specification. The "hook-on" strap concealed the metal hook in a pocket, formed by the strap and a piece of leather sewn on to the strap, which is also comparable to the lining referred to in the specification. The "tab" strap concealed

the base of the tab or metal clip between the outer layer of the strap and the lining. Then Cutler, in his repair work, put the plate of the metal clip on the outside and concealed the tongues or prongs within the strap; the plaintiff reverses the position, but this did not, I think, require any ingenuity beyond the skill and knowledge of a competent workman. The evidence given by Cutler and Bright as to the use of metal staples and clips for the purpose of fastening straps passed through the lugs of watches is also relevant, and assists my conclusion.

It was urged that the plaintiff's strap was one of great utility, and satisfied a "long felt want" in the trade, and that there could be no stronger evidence of subject matter. It was also said that the plaintiff only arrived at his strap after considerable thought and manipulation. I doubt the latter assertion, but I think the plaintiff's strap was useful, and met with the approval of watchmakers and jewellers, and proved to be popular. Watchmakers and jewellers considered in their business any form of strap brought under their notice, imported or local, and used the forms which they considered suitable for their purpose; but the evidence does not make it clear, to my mind, that they put forward any form of strap ~~ex~~ to manufacturers, or devoted much attention to the matter: they left it to the strap manufacturers to develop their industry in their own way. A "long felt want" overstates, I think, the requirements of the trade. At any rate, the plaintiff's strap largely superseded the use of any other strap but that which is sewn on. But after all, invention or subject matter is a question of fact to be decided upon all the evidence before the Court. And in my judgment there is no subject matter in the invention claimed by the plaintiff, and I so find.

A "Silver Stitch" strap is mentioned in the evidence, but that strap was not, I think, introduced into or used in Australia before the date of the plaintiff's Letters Patent. Further, I should add that I am not prepared to accept without corroboration the defendant's statement that he, before the date of the Letters Patent, saw straps or effected repairs to straps attached to wristlet watches or otherwise in which the metal plate of a clip or fastener was concealed between the outer layer and lining of the strap in precisely the same way as in the strap made by the plaintiff. I think he saw the various straps to which I have referred as forming part of the common knowledge of the trade, and, doubtless,

straps on which clips or rivets or fasteners had been used in repairs.

The infringement in this case would have been established - the fact was hardly disputed - if the invention claimed by the plaintiff had subject matter. But as, in my judgment, the patent fails for want of subject matter, the action will be dismissed with costs, including the shorthand notes, and the costs, if any, of discovery.

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