No 11 of 1935

IN THE HIGH COURT OF AUSTRALIA.

STERN

V.

VAIL

REASONS FOR JUDGMENT.

Judgment delivered at Melbourne

on Tuesday, 8th December, 1936.

H. J. GREEN, Government Printer, Melbourne.
C.5000.

STERN V. VAIL

JUDGMENT STARKE J.

This is an action for the infringement of Letters Patent relating to a hair wave retaining clip and method of manufacturing the same. Hair wave retaining clips had been in use before the date of the Letters Patent sued on. One form is known as the "Wella" clip, and another as the "Lady Jane" clip. They were clips made of metal by means of dies. They were formed with the jaws or clipping elements curved and flanged with inner rows of engaging teeth lying opposite one another. The clipping elements were formed with finger grips with a hinge upon them, and the elements were fitted together by a hinge pin and a helical spring to maintain in closed position the engaging teeth. Both the "Wella" and the "Lady Jane" clips had an uneven number of teeth, oppositely disposed, but the teeth in the "Wella" clip did not engage so closely as those of the "Lady Jane" clip. The clip described by the plaintiff in his Complete Specification follows generally this method of construction, but his invention, according to his Specification, consists of a new and novel combination or arrangement of parts. It is thus stated in the first claim:

"A hair wave forming and retaining clip construction of the type specified and which embodies in combination the following features namely:- a pair of jaws or clipping elements adapted to be pressed together under the influence of a spring and each fashioned with an out-turned flanged lower portion angularly set in relationship with its main body portion at 90 (ninety) degrees to 110 (one hundred and ten) degrees; inwardly projecting hair engaging teeth formed integrally with the said pairs of clipping elements and set in oppositely disposed rows each row of teeth being disposed relatively to the main body portion of its respective clipping element at an angle thereto of between 90 (ninety) to 95 (ninety-five) degrees; and oppositely disposed inwardly projecting rib formations associated with the said pair of clipping elements and adapted to be in abutment when the said clipping elements are in closed position; and oppositely disposed jaws or clipping elements slightly bow-shaped (in opposite directions) longitudinally; all as and for the purposes set forth and substantially as described in the specification."

A combination may not contain any feature new in itself and yet be patentable. The Specification puts forward each of these features as new in itself, but, new in itself or not, it is important to consider the state of knowledge as to each feature, because the question whether the choice and combination of features involves invention is affected by that knowledge. (Cf Fletcher Moulton on Patents 1st ed. p. 43, Waterhouse's Patent 23 R.P.C. at pp 476-77) , The out-turned flange in the "Wella" and in the "Lady Jane" clip, was set angularly in relationship to

its main body, and to set it at 90 to 110 degrees, as directed by the patentee, is merely analogous to former practice, and involves no special or peculiar advantages. It is an angular arrangement which any ordinary person skilled in ~~the trade~~ this class of manufacture could have made had he wished to do so. The setting of the rows of teeth disposed relatively to the main body portion of the clipping element at an angle thereto of between 90 and 95 degrees stands in the same position, whether the claim covers both an even ~~or~~ and an uneven number of teeth, or either arrangement. It was suggested that a special advantage existed in the case of an even number of teeth set oppositely each other because "one only set of piercing dies" could be used in manufacture, whereas an uneven number of teeth necessitated the use of "two different dies or sets of piercing dies". But the evidence of the witnesses Lewis and Moodie satisfies me that it was common engineering knowledge that only one die was required to make two inter-engaging jaws. There was nothing new in the idea, nor in its execution. A rib formation adapted to be in abutment when the clipping elements are in closed position had not, prior to the Letters Patent, been used in hair wave clips. The advantage of the rib, according to the Specification, is to maintain the finger grips in their set angular relationship a sufficient distance apart, so that when the finger grips are pressed towards each other there is secured a maximum opening of the jaws and engaging teeth. A rib formation had been frequently used in connection with metals to stiffen them and give them greater strength and rigidity. But it had not been applied, at all events in hair wave clips, to maintain the set angular relationship of finger grips so as to secure a maximum opening of the jaws and teeth. In itself, it is a small improvement, and lies within the limits of development in the manufacture of hair wave clips. It is such a development as an ordinary person skilled in ~~the trade~~ this class of manufacture might naturally have made had he needed it. (Blakey and Co. v. Latham and Co. 6 R.P.C. at p. 189, Waterhouse's Patent supra). Lastly, a feature of the combination is oppositely disposed jaws or clipping elements slightly bow-shaped (in opposite directions) longitudinally. The advantage of these bow-shaped jaws is that they give a more even pressure over the whole length of the clip - and consequently a firmer and better wave in the hair. "It makes", however, according to the witness Stom, "very little

difference"; and in that view I agree, despite the evidence of the witnesses Smith and Miller, who are not so experienced in the use of hair clips as is the witness Stom. At best, this bow-shaping of the clipping elements is in itself a small improvement, and also lies within the limits of development in the manufacture of hair wave clips. It is another development which an ordinary person skilled in ~~that trade~~ this class of manufacture might naturally have made had he needed it.

But the advance made by the combination as a whole must be considered. A patentee cannot make a combination within the meaning of the patent law by calling it a combination. (Bamlett v. Picksley Griff. at p. 44). He cannot obtain a combination for old features or improvements within the limits of development in manufacture, unless the union of the separate parts gives some special advantages or some special results, and not merely the combination of the advantages of the separate parts. (Cf. Klaber's Patent 23 R.P.C. at p. 469, British Celanese Ltd. v. Courtaulds Ltd 52 R.P.C. at p 193, Allen v. Oates Ltd 15 R.P.C at p. 303, British United Shoe etc Ltd v. Fussell Ltd 25 R.P.C. at p. 657, Fletcher Moulton on Patents 1st ed pp 41-42). Now the only advances that can be suggested in the present case are, to my mind, the rib formation which maintains the angular relationship of the finger ~~clips~~ grips so as to secure a slightly wider opening of the jaws and teeth, and the bow-shaped jaws or clipping elements which make "very little difference" in the evenness of pressure over the whole length of the clip. But these advantages, such as they are, appear to me to be advantages of the separate parts and not of the union of the various parts claimed by the patentee, and they involve no ingenuity beyond the capacity of a person ordinarily skilled in ~~the~~ this class of manufacture ~~of hair clips~~. And even if these advantages do flow from the union of all the parts - from the combination as a whole - still I think, and find as a fact, that the development does not constitute an invention. It is within the limits of development in the manufacture of hair clips, and a development that any competent workman in ~~that trade~~ this class of manufacture could naturally have made had he needed it.

It was urged during the argument that I should find invention on the part of the plaintiff because he experimented in the course of

developing his clip; that it satisfied a long felt want; and that it was a commercial success. But the plaintiff's mechanical knowledge was, I think, somewhat limited. And there was no long felt want: the trade and the public took the clips offered to them in the ordinary course of business, especially ~~if they~~ those which were cheaper than other clips, as was that of the plaintiff. The commercial success achieved by the plaintiff was due to the fact that his clip was cheaper than other clips, rather than to its special and peculiar advantages over other clips. (Cf Paper Sacks Ltd v. Cowper, 53 R.P.C. at p. 54).

The second claim in the Specification is for a method of construction of hair clips wherein each clipping element was formed with the same number of engaging teeth so as to effect a balanced arrangement. But, as I have said, any ordinarily skilled person or engineer who wanted a clip with inter-engaging jaws and the same number of teeth on each clipping element and a balanced arrangement would have known how to construct such a clip. It was a matter of common knowledge to engineers and ordinarily skilled persons, and was used in other branches of manufacture.

The third claim is for a method of manufacture of a hair clip with an even number of teeth on the clipping elements. A question arose on the issue of infringement as to the construction of this claim. But it is not important for my present purpose whether the material to form the clipping elements was to be pierced in one operation or in two operations. Either method would have been within the knowledge and capacity of an ordinarily skilled person who wanted to pierce material so as to construct a hair clip according to Claim 2.

Claim 4 must follow the fate of Claim 1.

None of the plaintiff's claims have sufficient subject-matter for the grant of Letters Patent, and the plaintiff's action therefore fails. But I would add that if the issue of infringement were material, I should have had no doubt that the defendant had taken the plaintiff's clip. He became possessed in New Zealand of a clip manufactured by the plaintiff, and he used this clip as a pattern for the dies he made. The clips made and sold by the defendant are identically the same as those made by the plaintiff. It was urged, however, that the plaintiff's clip and the defendant's clip were not made according to the

invention claimed by the plaintiff. The Complete Specification required that when the engaging teeth were in closed position, the two rib formations should be in abutment - Claim 1 uses the words "adapted to be in abutment" - and the rib formations do not actually abut the clipping elements in either the plaintiff's or the defendant's clip. But they are so close together that I think they are covered by the words in the claim "adapted to be in abutment". Another contention was that the Complete Specification and Claim 3 required two operations for piercing the material to form the clipping elements, whereas the plaintiff and the defendant each used only one operation. Both the language of the Specification and Claim 3 lend colour to this argument, but it implies the use of more than one piercing die, which is quite inconsistent with the passages in the Specification showing that the plaintiff's method involves the use of only one set of piercing dies. Despite the somewhat doubtful language of the Specification, there is no doubt, I think, that a competent workman would know that only one operation was directed and how to perform it. These arguments would not displace my conclusion that the defendant would have infringed the Letters Patent if subject-matter had been established.

Finally I should add that the claim in the pleadings for passing off was abandoned at the trial.

The result is that the action is dismissed with costs.

Certify that particulars of objections were reasonable and proper.

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