

IN THE HIGH COURT OF AUSTRALIA

Zoukra

v.

Insular Lamps  
(Sydney) Limited

REASONS FOR JUDGMENT

3/1937

Judgment delivered at

on 5th April 1937

ON APPEAL FROM THE SUPREME COURT OF  
NEW SOUTH WALES IN ITS EQUITABLE  
JURISDICTION.

BETWEEN

ERNEST GABRIEL ZOUKRA  
(Plaintiff) APPELLANT

and

INSULAR LANPS(SYDNEY)LIMITED  
(Defendant) RESPONDENT



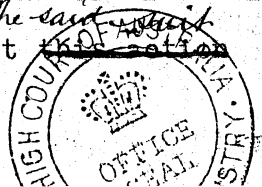
Before Their Honours the Chief Justice, Mr. Justice Starke  
and Mr. Justice Dixon.

~~Tuesday~~ the fifth day of April in the year one thousand nine  
hundred and thirty eight.

~~WHEREAS~~ by statement of claim filed on the third day of April  
one thousand nine hundred and thirty six the abovenamed  
appellant commenced a suit in the Supreme Court of New South  
Wales in its Equitable Jurisdiction against the abovenamed  
respondent to restrain it from infringing the letters patent  
of the appellant dated the thirteenth day of March one thousand  
nine hundred and thirty five and numbered 21780 of 1935 in  
respect of an invention for an improved sanitary closet AND  
WHEREAS the said suit came on to be heard before the Honourable  
Harold Sprent Nicholas Judge in Equity on the sixteenth  
seventeenth eighteenth nineteenth and twenty-third days of  
November one thousand nine hundred and thirty six AND WHEREAS  
on the fourth day of December one thousand nine hundred and  
thirty six the said Court did order inter alia that the said  
suit be and the same was thereby dismissed out of the said  
Court AND WHEREAS on the eighteenth day of January one  
thousand nine hundred and thirty seven the appellant filed  
a notice of appeal to this Court from so much of the judgment  
of the Honourable Harold Sprent Nicholas Judge in Equity of  
the said Supreme Court given and pronounced on the fourth day  
of December one thousand nine hundred and thirty six as deals

with ambiguity and costs and from the whole of the order and decree made and pronounced in pursuance of such judgment AND WHEREAS the respondent did on the thirty first day of March one thousand nine hundred and thirty seven file notice of cross appeal from so much of the said judgment order and decree as deals with subject matter and costs. AND WHEREAS the said appeal and cross-appeal came on to be mentioned on the twenty-ninth day of ~~July~~ <sup>the</sup> twenty sixth day of August and sixteenth day of November one thousand nine hundred and thirty seven respectively AND WHEREAS the said appeal and cross-appeal came on to be heard before this Court on the thirty first day of March and the first and fourth days of April one thousand nine hundred and thirty eight AND WHEREAS on the eighth day of April one thousand nine hundred and thirty eight the appellant pursuant to the option given by this Court gave notice to the District Registrar of this Court at Sydney that he elected that an enquiry should be had as to the loss and damage sustained by the appellant by reason of the infringement by the respondent of the said letters patent WHEREUPON AND UPON READING the certified copies of documents transmitted by the Master in Equity of the said Supreme Court to the New South Wales District Registry of this Court and also Exhibit "E" referred to in the index of such documents AND UPON examining appellant's exhibit "D" and respondent's exhibit "14" AND UPON HEARING what was alleged by Mr. G. B. Thomas with whom was Mr. D. F. Kelly of Counsel for the appellant and by Mr. Gordon Wallace of Counsel for the respondent THIS COURT DID ORDER that the said appeal should stand for judgment and the same standing in the list this day for judgment accordingly THIS COURT DOTH ORDER that this appeal be and the same is hereby allowed and that the cross-appeal aforesaid be and the same is hereby dismissed AND THIS COURT DOTH FURTHER ORDER that the said judgment of the Supreme Court be and the same is hereby

set aside AND THIS COURT DOTH FURTHER ORDER that the respondent its servants agents and workmen be and it and they and each of them are hereby restrained during the continuance of the said letters patent numbered 21780 from infringing the rights of the appellant in respect of the said letters patent AND THIS COURT DOTH FURTHER ORDER that it be referred to the Master in Equity of the said Supreme Court to make an enquiry into the loss and damage sustained by the appellant by reason of the infringement by the respondent of the said rights of the appellant in respect of the said letters patent AND THIS COURT DOTH FURTHER ORDER that the respondent pay to the appellant the amount of such loss and damage as and when ascertained by the said Master in Equity AND THIS COURT DOTH FURTHER ORDER that the respondent be and it is hereby ordered to deliver up to the appellant all infringing sanitary closets as are in its possession power or control AND THIS COURT DOTH FURTHER ORDER that it be referred to the proper officer of this Court to tax and certify the costs of the appellant of an incidental to this appeal and to the respondent's cross-appeal and to the proper officer of the said Supreme Court to tax and certify the costs of the appellant in the said Supreme Court of the said suit AND that the Costs of the appellant of this appeal and of the cross-appeal and of the said suit when so taxed and certified be paid by the respondent to the appellant or to his Solicitor Mr. Neville Wharncliffe Montagu after service upon the respondent of a copy of the certificates of taxation respectively AND THIS COURT DOTH FURTHER ORDER that the sum of Fifty pounds paid into the said Supreme Court by the appellant by way of security for the costs of this appeal together with interest accrued due thereon (if any) be paid out of Court to the appellant or his Solicitor AND THIS COURT DOTH FURTHER ORDER that <sup>the said</sup> ~~the said~~ be and the same is hereby remitted



to the said Supreme Court with a direction to do what is right consistently with this judgment.



THE COURT

*J. G. Hardman*  
DISTRICT REGISTRAR

ZOUKRA v. INSULAR LAMPS (SYDNEY) LIMITED.

Order.

Appeal allowed with costs. Cross appeal dismissed with costs. Judgment of Supreme Court set aside. Injunction restraining defendant from infringing plaintiff's letters patent No. 21780 of 1935. Order for delivery up of infringing articles. Plaintiff to give notice to District Registrar within three days whether he elects that an account should be taken of gains and profits made by defendant by reason of defendant's infringement and the amount thereof paid to the plaintiff by the defendant or that an enquiry should be had as to the loss and damage sustained by the plaintiff by reason of such infringement and the amount thereof paid to plaintiff by defendant and order for an account or an enquiry in accordance with any election so made. Defendant to pay costs of action. Action remitted to Supreme Court <sup>to</sup> do what is right *consistently with the judgment.*

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*Jugan*  
This is an appeal from a judgment of Nicholas J. in an action for the infringement of patent No.21780/35 relating to sanitary chemical closets. The learned judge gave judgment for the defendant upon the ground that the claims in the patent were ambiguous. The plaintiff appeals to this court.

The defendant has served a notice of cross appeal in which it submits that the learned judge was wrong in deciding that there was subject matter in the alleged invention in respect of which the patent was granted. The defendant, however, supports the judgment of the Court, which dismissed the action with costs, and does not seek any variation of that judgment. What is called a notice of cross appeal is really an intimation that the defendant will support the judgment by an argument which failed before the trial judge.

The patent relates to a chemical closet. Such a closet has a tank containing chemical liquid which renders faecal matter innocuous. The excreta are deposited upon a tray which is then immersed in the liquid, and, when the closet is again used, the tray again comes into a position suitable for use. The fluid, owing both to its own nature and to its content in the form of added matter, is very objectionable, and it is important that it should not splash upon the person using the closet or upon the seat or the lid of the seat of the closet.

The plaintiff's specification describes a closet in which the receiving tray is moved vertically up as the lid of the closet is opened and vertically down as the lid of the closet is closed. This tray is sloped towards the back in such a manner that the deposited matter is sluiced out of it by the chemical fluid. Another feature described in the specification consists in the application of a retarding device which prevents the tray from descending suddenly into the liquid and therefore prevents splashing. The evidence shows that closets which had been designed before that of the plaintiff involved the risk of objectionable splashing, and also that the immersion of working parts of the tray in the liquid produced a risk of clogging and accordingly made the operation of the receiving tray or pan unreliable, so that when the closet was opened for use the tray

might not be in the proper position. The plaintiff's closet, it is contended, overcomes these difficulties by means of the apparatus described in the specification.

It is convenient first to deal with the question of subject matter.

The patent relates to combinations of well known integers. Every element or co-operating part in the plaintiff's apparatus is, in itself, a well known mechanical thing. The operation of the apparatus depends simply and entirely upon the well known methods in which levers <sup>guide</sup> rods and pneumatic cylinders have been used for many years. A sufficiently <sup>detailed</sup> analysis of the apparatus shows that every element in it is old. But the claims are claims for combinations. It is therefore useful, before examining the question of subject matter, to refer to an important principle in the light of which a claim for a combination should be considered. That principle has been recently stated by the Court of Appeal in *Albert Wood and Amcolite v. Gowshall Ltd.*

54 R.P.C. 37 at p. 40 - " The dissection of a combination into its constituent elements and the examination of each element in order to see whether its use was obvious or not is, in our view, a method which ought to be applied with great caution since it tends to obscure the fact that the invention claimed is the combination. Moreover, this method also tends to obscure the ~~fact that the invention claimed is the combination~~ facts that the conception of the combination is what normally governs and precedes the selection of the elements of which it is composed and that the obviousness or otherwise of each act of selection must in general be examined in the light of this consideration. The real and ultimate question is: Is the combination obvious or not? "

Accordingly, in the case of a patent for a combination, the appreciation of the possibility and practicability of using well known elements in combination for the purpose of achieving a desired but hitherto unachieved result, and the selection of elements appropriate for that purpose, are the matters in relation to which the question arises whether there is any inventive ingenuity in the act of the person who, it is alleged, has made an invention which is challenged on the ground of <sup>lack of</sup> each subject matter.



It is contended for the defendant that no inventive act was required for the purpose of devising or designing the plaintiff's closet. The objectionable features of other closets were obvious enough, and it is contended that the means adopted by the plaintiff for overcoming them were such as would readily suggest themselves to any skilled workman. The defendant relied upon *Acme Bedstead Co.Ltd. v. Newlands Bros.Ltd.* (not yet reported). But in that case the Court was of opinion that the evidence showed that, when a defect in a design was pointed out, the means of correcting the defect was obvious, requiring no inventive ingenuity. The evidence in the present case, however, discloses a different position. The means of removing the objection which other closets were open to was not obvious. The construction of a really sanitary closet which would be available for use in unsewered districts was an obviously desirable objective. The closets which had been made before the plaintiff's did not secure this objective. Evidence given not only by witnesses called on behalf of the plaintiff but also given for the defendant shows that thought had been given to the problem which existed but that efforts to solve it had failed. According to the evidence the plaintiff's invention for the first time disclosed a means whereby a receiving tray could be made to descend vertically into the liquid, the motion being retarded in such a way as to prevent splashing, and the tray being so attached to guiding supports as to have no working parts in the liquid which could become clogged with paper or other material. Another closet, "The Sanitas", was described in a specification known to the plaintiff. This closet was never actually in use in Australia. It had a receiving tray the ascent and descent of which was operated by the opening and closing of the seat of the lid, but this tray moved in a circular manner and was suspended upon pivots. It would therefore strike the surface of the liquid irregularly and sometimes would oscillate in such a way as to splash the seat or the lid - which was very objectionable. The vertical movement devised by the plaintiff got rid of that oscillation and irregularity, and a plunger, operating in a cylinder <sup>and</sup> gradually expelling air as the lid descended, brought about the

result that the tray descended gradually and gently into the liquid so that no splashing took place. In view of the evidence called by the defendant to which reference has been made it is very difficult to hold that no ingenuity was involved in the plaintiff's invention even upon the basis, assumed in the defendant's favour, that the knowledge by the plaintiff of the Sanitas specification is a relevant fact. There was ample evidence upon which the learned judge could reach the conclusion that there was subject matter in the invention disclosed in the description contained in the specification and no reason has been shown for disturbing the decision with reference to this aspect of the case.

It has, however, been urged more particularly that the claims of the patent are invalid because, even if an inventive idea has been disclosed in the plaintiff's specification, the claims are so expressed as not effectively to claim that inventive idea with a method of putting it into operation.

Claim 1 is as follows :-

" An improved sanitary closet of the chemical type comprising a fluid tank, a seat on said tank, a seat cover hinged to said seat, an anti-splash receiving tray positioned in said tank under the said seat and supported from above said seat and having mechanical means associated with said tray and the seat cover whereby the said tray is moved vertically in the tank to assume a receiving position out of the tank liquid under the seat opening when the seat cover is raised, and when said cover is closed said tray is vertically submerged into the tank liquid. "

It will be observed that this claim makes no reference to any retarding mechanism. It is contended that the claim is bad because it refers to an anti-splash receiving tray without stating how the receiving tray is to be made anti-splash in character. The evidence meets this objection. It shows that any competent sanitary engineer would understand that an anti-splash tray was a tray which would receive matter deposited upon it without splashing. The anti-splash referred to in connection with a tray is to be distinguished from the provision against any splashing which might be caused by the sudden immersion of a tray in the liquid.

It is further objected, however, that the reference to vertical movement is so vague that it cannot be said to refer to and to be limited to any inventive element in the plaintiff's apparatus. The claim merely says with respect to this attribute of the invention that there is to be some "mechanical means associated with the said tray and the seat cover whereby the said tray is moved vertically in the tank to assume a receiving position...when the seat cover is raised, and when said cover is closed said tray is vertically submerged into the tank liquid". It is not contended for the plaintiff that, apart from vertical movement, there is subject matter in clause 1. The words quoted only state that the tray is to be moved vertically up and down, that is, out of and into the liquid. The claim does not describe or refer to any means of achieving this end. There is no indication whatever in the claim of any means of distinguishing a successful method of achieving vertical movement from an unsuccessful method. Some methods, it is not disputed, would be unsuccessful. It cannot be said that there is any invention in the mere idea of vertical movement in itself. Accordingly it should be held that claim 1 does not claim any real invention.

Claim 2 is as follows:-

"An improved sanitary closet of the chemical type comprising a fluid tank with suitable overflow outlet and ventilating means, a seat affixed on said tank, a seat cover hinged to said seat, and an anti-splash receiving tray positioned in said tank under said seat and supported from a bracket or the like above said seat, vertical guide devices at one or both sides of said tank connected to the said bracket or the like for ensuring vertical movement thereof, a fulcrum rod or the like connected to the said bracket or the like and the seat cover and having a suitable tracking or abutment surface on the tank top so that opening of the seat cover causes the said rod to elevate the bracket or the like and the tray, and closing of said seat ensuring depression of said parts, and means associated with said bracket or the like for retarding and controlling the rate of depression movement thereof."

This claim adds many details to those mentioned in claim 1. The criticism of the claim has been particularly directed to the words "or the like" which appear in connection with the references to <sup>a</sup>bracket and <sup>a</sup>fulcrum rod. It has been argued that these words make the claim so vague that it cannot be supported because they have the effect of purporting to include an indefinite number of devices which can be substituted for those which are actually mentioned in the claim. This objection, however, cannot be sustained. The words "or the like" are not unknown in patent <sup>claims</sup> cases. Cf. *Beston v. Watts* 24 R.P.C. 219. Moreover a claim is construed so as to cover not only precisely what is claimed but also all that can fairly be described as coming within the scope of the invention. No patentee is held so exactly to what he has claimed as to protect him from nothing but exact imitations of his machine unless his claim is so framed. In the latter case the patentee must stand by what he has said. The words "or the like" in the present case do not extend the monopoly claimed but assert and claim that mechanical parts "like" those specified are within and are covered by the claim.

A claim is not a description but a marking out of the invention and general words may be introduced where no ambiguity is caused. In the present case the patentee claims the machine or apparatus "an improved sanitary closet" comprising several specified parts and he adds, as to some parts, "or the like" mechanical parts. The claim would be so construed whether the words "or the like" were added or not. Ambiguity is not created by the inclusion of such words.

Claim 6 refers with great particularity to the devices "substantially as herein described and explained and as illustrated in the drawings." It is as follows:-

" An improved sanitary closet consisting of a tank such as 7, with overflow outlet device 8-9 and vent pipe such as 10, a seat such as 11, a hinged cover such as 13, a tray such as 14, with open end such as 15, supporting rods such as 16, cross bracket such as 17, fulcrum rod such as 18, guide rods such as 19, guide tubes such as 20, pneumatic plunger cylinder device such as 22, cover loop such as 23, roller such as 24 and track such as 25 substantially as herein described and explained and illustrated in the drawings. "

The criticism of this claim has been directed to the words "such as". These words, however, only identify the particular parts of the apparatus and, when read with the concluding words "as illustrated in the drawings", limit the claim to the precise apparatus which is shown in the drawings together with any mechanical equivalents of the various parts of the apparatus. The criticism of the claim does not show that it is invalid, and it ought to be held to be valid.

Claim 7 is as follows:-

" The combination and arrangement together of the mechanical parts or integers as and for the purposes set forth constituting an improved sanitary closet substantially as herein described and explained and illustrated in the drawings. "

It has been objected to this claim that a claim cannot be good if it merely claims whatever has been disclosed in the specification, it being left to the Court to determine what the specification has disclosed. It is true that such a claim would not be good, because a patentee must, in addition to describing the manner in which his invention is to be performed, end his specification with "a distinct statement of the invention claimed": Patents Act 1903-1936. Claim 7, however, contains the words "as illustrated in the drawing". Accordingly the claim is definite and precise and it is not open to the objection mentioned. Claim 7 should therefore be held to be valid.

Claims 3, 4 and 5 relate to closets "according to claims 1 and 2" but possessing certain further specified characteristics. In view of the conclusion already reached that claims 2, 6 and 7 are good and of the fact that the defendant has infringed these claims, it is not necessary to examine claims 3, 4 and 5.

It is now necessary to consider the decision of the learned trial judge that the patent was void for ambiguity, that is, for ambiguity in the claims.

Reference has already been made to one matter which led the learned judge to this conclusion, namely, the reference in claims 1 and 2 to an anti-splash receiving tray, and it is not necessary to repeat what has already been said on this subject. His Honour, however, also held that the claims were ambiguous for the reason that the plaintiff had "nowhere stated what details, if any, of the construction must be adhered to and what are its essentials." Accordingly the learned judge said in accordance with this view that "the patentee has not in the specification given the persons interested that information which they are entitled to have."

It should be observed, however, that the objection raised is not an objection of insufficiency. The defendant did not allege that the description in the specification was insufficient to enable the persons to whom the specification was addressed to understand how the subject matter of the patent, namely a chemical closet, was to be made. The objection of ambiguity is an objection that the invention is not so described and ascertained as to enable the public to understand the scope of the monopoly granted by the letters patent: *No-Fume Limited v. Frank Pitchford and Company Limited* 52 R.P.C. 28 at p. 34. If the words of a claim are clear and intelligible having regard to the particular subject matter the objection of ambiguity must fail. It may be that the claim is a claim to a monopoly of something which is not disclosed at all or which is disclosed only in part, but such an objection is not an objection that the claim is ambiguous. In this patent every claim when read in conjunction with the specification can be readily understood and the objection of ambiguity accordingly fails.

The result is therefore that the appeal should be allowed with costs and that the cross appeal should be dismissed with costs. The judgment of the Supreme Court should be set aside, an injunction against infringement granted, and an order made for the delivery up of infringing articles. The plaintiff may have at his option (to be exercised by notice to the District Registrar within three days) an account of defendant's gains and profits or an enquiry into loss and damage sustained by the

plaintiff by reason of the infringement. The action will be remitted to the Supreme Court which will deal with any proceedings under this judgment, The defendant must pay plaintiff's costs in the Supreme Court.

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