

12.03/1942

IN THE HIGH COURT OF AUSTRALIA.

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MONIER INDUSTRIES LIMITED.

V.

HUME PIPE COMPANY (AUSTRALIA) LIMITED

**ORIGINAL**

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REASONS FOR JUDGMENT.

*(Delivered orally)*

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Judgment delivered at MELBOURNE

on 25/2/43

MONIER INDUSTRIES LIMITED.

v.

HUME PIPE COMPANY (AUSTRALIA) LIMITED.

REASONS FOR JUDGMENT.

LATHAM C.J.  
RICH J.  
STARKE J.

MONIER INDUSTRIES LIMITED.

v.

HUME PIPE COMPANY (AUSTRALIA) LIMITED.

REASONS FOR JUDGMENT.

LATHAM C.J.

RICH J.

STARKE J.

This is an appeal from a decision of the Deputy Commissioner of Patents refusing an application by an applicant for a patent for leave to amend the complete specification. The application for a patent was opposed, the opposition was dismissed, and the opponent appealed to this Court. The Court made an order to the effect that the grant ought not to be made in respect of four claims, that it ought to be made in respect of two claims and that as to four other claims it ought not to be made "unless the respondent company", that is to say the applicant, "within two months applies for, and on such application obtains leave to amend the specification with regard to" these four claims, Nos. 3, 6, 7 and 8. The Deputy Commissioner refused to allow amendments for which application was made. Amendments were asked for in the body of the specification, as well as in the claims. An appeal is now before this Court from the decision of the Deputy Commissioner refusing to allow the amendments. Requirements in respect of amendments are set out in Sections 71 and 78 of the Patents Act. These requirements must be satisfied and, as it has been pointed out, the amendments themselves must be plain in meaning and not ambiguous: see *Cowper v. Paper Sacks* 1932 A.C. 709.

Regulation 102 provides that an opponent in amendment proceedings is limited to certain objections. It is not necessary in this case to determine whether Regulation 102 is valid or not, and the Court leaves that question open, because the whole matter can be determined without a consideration of Regulation 102.

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The invention relates to machines for the manufacture of concrete pipes and the like. The nature of the invention has already been explained in the reasons for judgment of the Court in the decision given in the earlier proceedings between these parties, and it is not necessary to repeat the description there given.

The amendments for which application was made were plainly intended to conform with the order in that case, the order being read in the light of the reasons given by the learned Judges for the decision.

It is, however, objected that the amendments proposed ought not to be allowed by reason of the provisions of Section 78 of the Patents Act, which 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". It is contended on behalf of the opponent that the amendments to the claims widened the claims so that they became substantially larger than before. In particular, in the amendment to Claim 1, though alterations are made which introduce what the Court regarded as an essential feature of the invention (namely, a reference to the pivotal mounting of a chassis on a base in such a manner that it may be rocked longitudinally about the pivotal axis), the references which before were in the claims to mould-supporting and rotating rollers are omitted in this amended claim, so that, it is contended for the opponent, the invention now claimed is substantially larger than the invention originally claimed.

A claim does not stand in vacuo. It may be read in conjunction with the specification - not for the purpose of either expanding or limiting the claim. But the specification may be used for the purpose of reaching an understanding of the claim, at least when the reading of the specification in conjunction with the claim makes the meaning clear beyond doubt. In this case the

claim /

claim was introduced by the words "In a machine for the manufacture of concrete pipes". The specification shows that only machines which contain rotating moulds transversely positioned in relation to the axis are contemplated. But an application has been made, which this Court has undoubtedly power to grant, for amendments including express references to these features, mention of which has been omitted. The Court has power to grant those amendments and to grant them in the form in which they appear on pages 53 and 54 of the appeal book. Those amendments meet the contention of the respondent. They certainly, so far as they operate at all, limit and restrict the ambit of the claim, and therefore no further objection to them on the part of the opponent is open. Opposition has been fully heard. These are more limited claims than previously made. We are of opinion that there is no need for advertising the amendments.

The amendment proposed to Claim 2 is also proposed to be changed as appears on page 54 of the transcript, and that amendment again meets the contentions which have been made. The amendment should be allowed in this form.

Counsel has appeared for the Commissioner for the purpose of assisting the Court by drawing attention to some considerations affecting the form of the order made in the earlier case. He has pointed out that a phrase there used, "the final application for a patent", is meaningless, and the Court is indebted to the Commissioner for pointing this out. The form of the order otherwise appears to be quite correct in this case, though in a case where the opposition has not been fully heard it would almost certainly be wise to make an order in another form. In the present case, however, the opposition having been fully heard and the result being that amendments are granted with the direction that the patent is to be issued in a more limited form than that previously applied for, there is no objection to the matter being dealt with at once.

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The appeal should be allowed and the amendments allowed in the form to which I have referred with these new amendments in claims 1 and 2. The other amendments in the claims are really dependent upon the amendments in the earlier claims. Therefore the amendments in all the claims should be allowed. No objection has been raised to the amendments in the body of the specification. Those amendments also should be allowed, and an order should be made that the patent should be issued upon the application as amended.

As far as the costs of the Commissioner are concerned, while in some cases it is perfectly proper that the Commissioner should obtain his costs, for the reason that he is protecting the interests of the public, and for the further reason that a party is frequently applying to the Court for an indulgence, in this case, although the representative of the Commissioner has been of assistance to the Court, yet it would be hard to make either party pay the costs of the Commissioner. We cannot see any reason why either the appellant or the respondent should be made pay the costs. Therefore no order should be made as to the costs of the Commissioner.

The opinion of the Court is that there should be no order as to the costs of the appeal, but that the appellant should have the costs of the proceedings before the Commissioner. Amendments allowed. Direct that a patent be issued upon the application as amended. Time for sealing the patent extended for one month from today. Liberty for the Commissioner to attend upon the settling of the order.

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