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IN THE HIGH COURT OF AUSTRALIA

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In the Matter of Letters Patent
No. 10679/32 granted to J.B.Crump.

REASONS FOR JUDGMENT

ORIGINAL

Judgment delivered at Melbourne.....
on Monday, 11th April 1949.

RE CRUMP'S PATENT - EX PARTE HUGHES & ANOR.

JUDGMENT.

DIXON J.

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RE CRUMP'S PATENT - EX PARTE HUGHES & ANOR.

JUDGMENT.

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This is an application by petition under sec. 84 of the Patents Act 1903-1946 for the extension of letters patent. The letters patent were granted to J.B. Crump and date from 24th December 1932. The invention is described as an improved reversible disc plough. The ground of the application is that the patentee has been inadequately remunerated and, further, that as such he has suffered loss or damage by reason of the hostilities in the late war. The letters patent were assigned on 18th December 1940 to the present applicants who had previously held a licence, apparently exclusive, for the exercise of the invention. With respect to the ground that the patentee has been inadequately remunerated, it is the duty of the court in considering its decision to have regard to the nature and merits of the invention in relation to the public and to the profits made by the patentee as such and to all the circumstances of the case. With respect to the ground that the patentee has suffered loss or damage by reason of hostilities, the court in considering its decision may have regard solely to the loss or damage so suffered by the patentee: cf. sec. 84(4) and (6).

The petitioners are a firm of machinery merchants and manufacturers and have manufactured ploughs which in many respects are in accord with the invention disclosed in the specification and with certain improvements. The history of the ploughs produced since the invention was first put into operation shows, throughout of the patent, the life/a comparatively small production, which became smaller in the first year of the war and again in the two last years of the war. The effect of hostilities was apparently to reduce an output which was at no time large. It is a case in which it is difficult to

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distinguish markedly the years of hostilities from the prewar and post-war periods. Apart from the question of hostilities, to warrant an extension of letters patent the invention must have merit. The merit may be found in the degree of inventiveness displayed by the invention, but the practical utility of the invention is perhaps a matter to which more weight should be given. In Re Robinson's Patent, 1918 25 C.L.R. 116, at p. 121, Isaacs J. said that he understood the words "merits of the invention in relation to the public" to mean the value or advantage or benefit of the particular invention as described in the patent of the particular specification, the invention as it stands completed and ready to be put into use. His Honour said: -

"Its merits may have been properly recognized in the past, or they may not for some reason have been recognized by practical adoption on the part of the public, but the merits of the invention in itself so far as the public has gathered, or will probably in the future gather, advantage from it, must be considered by the Court as one of the necessary elements in forming its conclusion. The merit of an invention in relation to the public means 'the merit of utility', of 'public utility' that is, an actual substantial benefit to the public, for which the petitioner claims he has not been fully or equitably paid."

In the recent case of Elkington's Patent, 1946 63 R.P.C. 50 at p. 55, Cohen J. stated the questions which must be answered in reaching a decision on a petition for extension. In effect he said that the first was whether the invention had sufficient merit to bring the patent out of the class the life of which might be extended under the section. If that were answered in the affirmative the second was whether the patentee (an expression including successive patentees throughout the term of the patent) had been adequately rewarded for the invention. If that were answered in the negative the third is whether the inadequacy of reward was due to any default on the part of the patentee: cf. per Sargant J. in re Fleming's Patent, 1919 36 R.P.C. 55, at p. 70, where his Lordship stated the questions in a somewhat different and perhaps less exact form. His Lordship said:-

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"There are three main questions with which I have to deal. (1) Is the invention one of more than ordinary utility? (2) Has it been adequately remunerated? (3) Is any absence of remuneration due to no fault of the patentee? On each and every of these questions the burden of proof lies on the petitioners."

The invention as described in the specification relates to an improved reversible disc plough which is suitable for ordinary ploughing in level country and for hillside use and can also be used for orchard or vineyard ploughing. The statement in the specification of the invention, before the invention is described by reference to the drawings accompanying the specification, is as follows:-

"The improved plough is of the type in which the discs are reversible about a vertical axis and it has for its object to provide a plough of this kind which will be easy to control and in which the discs can be swung laterally of the longitudinal centre line of the implement and the width of the furrow adjusted by the operator while the implement is travelling.

The principal features of the improved plough are:-

(a) the construction wherein the discs are reversible about separate vertical axes and are coupled together so as to be moved in unison and at all times maintained in parallel relationship,

(b) improved means for reversing the discs and for adjusting the cutting angle or breast cut of the discs,

(c) the construction wherein the discs are carried by a rearwardly extending swinging arm whereby they can be swung laterally to either side of the longitudinal centre line of the plough,

(d) means for partly rotating the discs during the movement of the swinging arm to automatically regulate the cutting angle of the discs and the width of the furrow,

(e) an improved form of seat which is adjustable to provide a comfortable level seat for the operator when working on a hillside, and

(f) an improved adjustable draught which can be reversed when the discs are reversed and otherwise adjusted to suit conditions"

The petition prayed simply that the letters patent might be extended for a further term as the court might think fit. But before the hearing of the petition, apparently in consequence of some communications made to the patentees' advisers by the Commissioner of Patents, an investigation was made of prior inventions dealing /

dealing with the same matter. The result was that the patentees' advisers came to the conclusion that it was impossible to support claims in respect of features lettered (a), (b) and (d) in the specification. The petition, however, was supported on the ground that the patentees were nevertheless entitled to an extension of the period of their patent in respect of the features in the invention lettered (c), (e) and (f). Of these^{the} feature upon which they placed most reliance as supporting the petition is that lettered (f). Apart from the disclosure of prior inventions obtained from a search in the patent journals, no evidence of the prior art was placed before the court.

The instrument the subject of the alleged invention is a disc plough mounted on two wheels and was intended to be horse-drawn. It is furnished with a shaft to go between two horses. The swingletree is not attached directly to the shaft. The chief merit claimed for the invention lies in the method of adjusting it so that the draught or pull may be on one side or the other of the centre of the plough. This is accomplished by a pivot which is forward from the swingletree. From this pivot a bar goes to the swingletree which is pivoted on the bar. This bar can be swung by the driver to one side or other of the shaft. A cross bar behind is furnished with a means of checking the degree to which it is swung. By swinging it over the driver is able to adjust the centre of the pull of the horses in the case of a team of two. So that the discs may be pulled directly along the furrow one of the horses may proceed along the previous furrow and the other on the unploughed earth and the shaft will not bear over against either of them. The point of this part of the invention is simply to enable the draught or pull of the horses to be centred one side of the plough.

Another feature of the plough is directed to enable the driver to adjust his seat so that in ploughing on a hillside or other slope his seat may be horizontal. This is done by attaching
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the seat to a semi-circular steel band and by providing an attachment which the driver may slide along the band.

The third feature of the invention upon which reliance is placed in support of the petition is a pivot at the rear of the wheels behind which the disc ploughs are trailed. The disc ploughs are attached by an arm to the pivot and may be swung to the right or left by a hand lever. The lever is kept in position by a ratchet in the ordinary way. The purpose of swinging them to the right or the left is to allow ploughing to be done close to a fence or tree or the like.

When the whole specification is looked at it will be found that these three matters are but features of an entire plough containing many features but forming, and considered as, a mechanical unit.

There are nineteen claims appended to the specification. Of these it is conceded that 1, 4, 5, 6, 8 and 9 are invalid. But among the remaining claims it is said that it is possible to find a separate protection for each of the three features to which I have referred. Although I think that there is some difficulty in the reference in most of these claims to a "reversible disc plough as claimed in any of the preceding claims", I am not prepared to say that the petitioners are wrong in this contention. The question remains, however, whether sufficient merit can be found in these separate features to give a foundation for an application to extend the life of the patent so far as it relates to them.

The burden of establishing a meritorious advance on the prior art lies upon the petitioners, and I think that, to discharge the burden in such a case as the present, it really was incumbent upon them to explain how at the date of their invention the matter stood. The material in evidence before me is hardly adequate to enable me to form a definite and satisfactory opinion. But it would seem that attempts had been made to place the point at which

the tractive power from the horses was applied on one side or the other of disc ploughs. It does not appear, however, that the attempt was ever made in the case of a two-wheel plough. On behalf of the petitioners it was stated at the bar that the problem was quite different in the case of a three-wheel plough without a pole, to which apparently the former attempts were directed. In the case of the three-wheel plough, where two wheels run behind one another in the furrow they form an anchor so to speak for the plough and tend to keep it straight. This function could not be performed by a plough of two wheels, the wheels being placed opposite one another on an axle.

I am content to accept this statement and assume that the absence of a pole in the invention disclosed in the prior patent cited and the fact that the plough was a three-wheel and not a two-wheel implement is a distinguishing feature. But at the same time I cannot think the merit of this part of the invention was high. Common sense shows that to centre the draught at a point on one side and not in the middle was an obvious expedient and the means by which it is done could hardly have been far to seek. They do not appear to involve any great ingenuity. In saying this I do not cast any doubt upon the existence of some invention or upon the simplicity and ease with which the contrivance could be manipulated. The convenience of a seat which can be moved so as to keep horizontal no doubt should not be disregarded, but that feature too seems to me to have no high degree of practical utility. It is said that another type of instrument has simply a broad metal semi-circular band for the driver to sit upon, so that he can slide into an upright position. To present the public with a means of sliding a formed seat along a band is no great contribution to agricultural art. Less stress was placed by the applicant upon the swinging tail to the plough, that is the pivoting of the arm which bears the discs. No doubt that serves a definite purpose. When the patent was applied for it is plain that all three features were regarded

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as points of advantage in a plough which as a whole presented a combination of new features giving the totality a definite utility and making it an improved reversible disc plough. Separated out they remain features contributing, no doubt, separate advantages to an implement, but they could not be described as outstanding or conspicuous inventions. On the contrary, they appear to me at best to be inventive steps of a very ordinary character.

I turn now to the question of inadequacy of remuneration. I do not propose to state the history in detail of the exploitation of the invention. It is enough to say that 37 ploughs said to incorporate at least two of the features claimed were produced in 1935-36, 15 the following year, 27 in the years 1937-38, 32 in 1938-39, 9 in 1939-40, 21 in 1940-41, 17 in 1941-42, 4 in 1942-43, none in 1943-44, 7 in 1944-45, 7 in 1945-46, and 15 in 1946-47.

The applicants were not in a position to show more than the gross profits made from the sale of these ploughs. They therefore felt themselves to be in difficulties in satisfying the requirements laid down in Robinson's Case (supra) with respect to proof of inadequacy of remuneration. They were, however, prepared to call oral evidence and to produce their books in order to make a full disclosure. But during the hearing I intimated that I was satisfied that they had made no greater gross profit than they disclosed and that upon such a small output I thought that it was hardly necessary for them to establish what their net profits had actually been. In other words the adequacy of their remuneration did not appear to me to turn on the question of how strictly they had proved the amount of money they had derived from the exercise of the patent; for it seemed clear that it could not have derived very much.. It turned rather on a consideration of the merits of the patent in relation to the surviving claims and on the reason why their output had been so small.

The question, however, whether the failure to derive a greater gain from exploiting the invention was to be attributable

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to the patentees presents more difficulty. I shall not go into the facts, which are stated sufficiently in the affidavit. It does, however, appear to me that before the outbreak of war no every energetic measures were taken to spread a knowledge of the invention or to push the sale of the plough. I recognise that upon the outbreak of war conditions changed. The demand for agricultural implements was not so much affected as the availability of raw materials and labour. There is one not unimportant consideration. In the plough which has been manufactured and advertised and sold the applicants have not embodied the swinging tail. The reason is that by a further invention a vertical movement has been given to the discs which is inconsistent with the pivoting of the tail bearing the discs. Further, the feature described as the adjustment of the draught has not been embodied in the simple form described in the invention for the extension of which the application is made. It has been adapted to a further invention, the purpose of which is to transmit by leverage a downward force to the discs. This invention has made it necessary to place the swingletree below the shaft and attach it to the horizontal arm forming the arrangement of levers.

The chief merit claimed by the petitioners has been for the draught adjustment. I am ready to believe that from a practical point of view this is more advantageous to the user of the implement than either of the other two features, but on consideration of the whole of the foregoing matters I am unable to reach the conclusion either that the invention has sufficient merit to bring the letters patent within the class of patents the life of which may be extended under the section or that the inadequacy, if any, of the reward is not due to the default on the part of the patentees. I say "inadequacy of the reward if any". I do so because I think it is very difficult in a case such as this, where the particular features relied upon form part only of a total implement, to say that those particular features are adequately rewarded by the commercial transactions which covered the total implement. What part they

play in creating, or for that matter in repressing, a demand for the whole must be the subject of speculation. What credit is due to them for the merit of the implement as a whole must, in such a case as this, be almost equally difficult to discover.

In my opinion the petition should be dismissed. The petitioners must pay the taxed costs of the Commissioner.