ORIGINAL

IN THE HIGH COURT OF AUSTRALIA

HUTCHINSON

V.

THE COMMISSIONER OF PATENTS

REASONS FOR JUDGMENT

Judgment delivered at SYDNEY

on WEDNESDAY, 23rd NOVEMBER 1955

J. J Gourley, Govt. Print., Melb.

C.7163/51

ORIGINAL

63/54

CHARLES BUTLER HUTCHISON

v.

THE COMMISSIONER OF PATENTS

JUDGMENT (ORAL)

WILLIAMS J.
KITTO J.
TAYLOR J.

CHARLES BUTLER HUTCHISON

v.

THE COMMISSIONER OF PATENTS

JUDGMENT (ORAL)

WILLIAMS J.
KITTO J.
TAYLOR J.

WILLIAMS J: This is an appeal, as it is called, by the applicant under sec. 47 of the Patents Act 1903-1950 from a decision of the Deputy Commissioner of Patents under sec. 46 of that Act refusing to accept the application and specification of the appellant for the grant of Letters Patent for an alleged invention for an improved sheet for building and other industrial purposes.

The ground on which the Deputy Commissioner refused the application was that the alleged invention lacked novelty because of the disclosures in the specification of a prior Patent No. 19268/24, dated the 21st August 1924.

The specification filed in support of the application describes the alleged invention in these terms. "The combination sheet consists of a combination of metal particles as a minute lamination with a solid but pliant hydrocarbon such as bitumen or asphalt or other pliant cementitious materials (all of which are hereinafter embraced by the term "bituminous substance") alone or as a coating or lamination with some other material or substance. For most purposes the bituminous substance is applied as a lamination to some other material or substance, such as paper or textile or felt or composition boards or asbestos cement sheets or concrete. The metal particles are applied to the bituminous substance in a spraying operation. The metal particles can be of any metal or alloy adaptable to spraying. For most purposes lead or aluminium or zinc or copper is employed."

The sheet may, therefore, comprise either two or three layers of material, the top layer in each case consisting of metal particles of lead, aluminium, zinc or copper, which are applied to the bituminous substance immediately below by "a spraying process".

The first claim is for "a combination sheet consisting of a combination of metal particles as a lamination with a solid but pliant bituminous substance."

The second and third claims are for a method of forming the top layer of the sheet by spraying the metal particles on to the bituminous substance beneath, whether that substance is, as in the case of the second claim, the only other layer, or, as in the case of the third claim, is itself superimposed on some other substance.

The layer or layers above the bottom substance are described in the specification as laminations and it is contended that the essence of the invention lies in the conception of the combination of the metallic top layer with the bituminous substance beneath it so that the former constitutes a lamination with the latter.

But the word "lamination" can only mean, in the context of the specification, that the sheeting is an article consisting of a series of layers superimposed one upon the other and stuck together by the adhesive qualities of the bitumen so as to form a composite article, the top layer consisting of a coating of metallic material and the layer or layers below consisting of the substances already mentioned. And indeed, in the body of the specification, coating and lamination are used in one sentence interchangeably.

article
An/identical in all essential respects is, it seems to me, disclosed in the prior specification. The roofing material there described is a composite article and has the same series of layers, the top layer being called the surface coating. This surface coating consists of what

are called bronzing powders the ingredients of which are fine particles of metals, such as aluminium bronze or copper bronze or gold bronze, and these particles are sifted on to the bituminous substance below by passing that substance under what is called a "vibrating box" and by this process a complete surface coating is formed over that substance. The specification states that, as the metal is opaque, this coating keeps the weather away from the substance below and prolongs the durability of the roof. It is sufficient to refer to the first claim in this specification. It reads: "A roofing comprising a base of roofing material having a surface coating comprising finely flaked metallic particles." This combination is in all essential respects exactly the same combination as that described in the first claim of the appellant's specification. Suppose we substitute the words "forming a surface coating over" for the words "as a lamination with" in the latter claim. It would then read "a combination sheet consisting of a combination of metal particles forming a surface coating over a solid but pliant bituminous substance." It would still describe the same article, and would be in essence the same claim, but it would be even more apparent, if that be possible, that this article would be identical with the article described in the first claim of the prior specification.

The test for ascertaining whether the disclosures in a prior specification are sufficient to destroy the novelty of a subsequent patent is well known, though it is stated from time to time in different words. It is an anticipation if the disclosure in the prior specification is such that a person of ordinary skill and knowledge grappling with the particular problem solved in the patent attacked would say "This gives me what I wish". Pope Appliance Corporation v. Spanish River Pulp & Paper Mills, Limited, (1929) A.C. 269 at pp. 275-276. In the present

case it seems to me that such a person would be bound to say "This prior specification does give me what I wish". There is, therefore, in the present case a disclosure in the prior specification of the alleged invention described in the first claim of the appellant's specification so plain and clear that the Deputy Commissioner was justified in refusing to accept the application in respect of this claim.

The second and third claims remain to be considered. It is true that in these claims the appellant provides for the metal forming the uppermost layer to be sprayed on to the bituminous substance and that this process is not disclosed in the prior specification. But this is merely to substitute a more modern but well known process for the clumsier process suggested in the prior specification. In the body of his specification the appellant does not suggest that there is anything novel in providing that the top coating should be done by a spraying operation. If there had been, it would have been necessary, in order to provide consideration for the grant of the monopoly, that a suitable method of carrying out the operation should have been explained. But it is clear from the body of the specification that the appellant is referring to the spraying operation as a convenient process that was well known to everybody engaged in the trade. Accordingly all he need say was, "Well, in order to make the article I have described, I recommend that you spray the metal particles on to the bituminous substance." The first claim covers the article however manufactured. If the first claim fails for want of novelty or, in other words, if the description of an article which forms the first integer in the second and third claims, is of an article which is not novel, then it is clear that the mere additional provision in these claims that the upper layer of that article should be formed by a well known process of manufacture cannot supply inventive ingenuity and that these claims, though narrower than the first claim, must also fail.

For these reasons it seems to me that the Deputy Commissioner was right in rejecting the application altogether and that in doing so he kept well within the principles laid down by this Court in McDonald v. Commissioner of Patents, 15 C.L.R. 713. I think that Mr. Macfarlan said everything that could be said in support of the appeal but I am left with the clear opinion that it is obvious that no patent could be granted pursuant to the application.

KITTO J: I am of the same opinion. I have nothing to add.

TAYLOR J: I agree.

WILLIAMS J: The appeal is dismissed with costs.