

IN THE HIGH COURT OF AUSTRALIA

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MENTMORE MANUFACTURING CO.

LIMITED

V.

B&F LIMITED

**ORIGINAL**

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**REASONS FOR JUDGMENT**

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1962

MENTMORE MANUFACTURING CO. LIMITED

v.

B. & F. PTY. LIMITEDORDER

ORDER that the defendant be restrained from infringing by himself, his servants or agents Claims 1 and 3 of the plaintiff's letters patent No. 209869 during the continuance thereof or any extension thereof. ORDER that the defendant make and file a sufficient affidavit stating what articles were on the date of this judgment in his possession or power made in infringement of the said claims and accounting for the same. ORDER that the defendant within fourteen days after the filing of the said affidavit deliver up to the plaintiff or destroy or render non-infringing the articles which by such affidavit appear to be in his possession or power.

Reserve for further consideration the question of what order should be made requiring the defendant to pay damages or account for profits.

Further ORDER that the defendant's counterclaim be dismissed. Defendant to pay to the plaintiff its costs of the suit and of the counterclaim.

MENTMORE MANUFACTURING CO. LIMITED

v.

B. & F. PTY. LIMITED

JUDGMENT

TAYLOR J.

MENTMORE MANUFACTURING CO. LIMITED

v.

B. & F. PTY. LIMITED

The plaintiff, which is a company incorporated in England, is the registered proprietor of letters patent of the Commonwealth of Australia numbered 209,869 and it seeks to restrain the defendant, a company incorporated in New South Wales, from infringing the same. The letters patent relate to "Improvements in or relating to writing instruments having a retractable writing point" and the various claims have as their priority date 6th May 1953. It should be added that the plaintiff has expressly limited its title to relief to infringements and threatened infringements of claims 1 and 3 as set out in the complete specification. By its defence the defendant denies the infringements alleged and counter-claims for revocation of the letters patent upon a number of grounds. Particulars of the defendant's objections were delivered in accordance with s. 117 of the Patents Act 1952-1960 but at the hearing some of these objections were abandoned or not supported in any way. It is sufficient at the moment to say that objection 6 - "that the invention, so far as claimed in any claim, is not useful" - was abandoned whilst objection 1 - "that the plaintiff was not a person entitled to apply for the said letters patent" - in the terms in which it is alleged, is not now relied upon. Further, the defence of laches and acquiescence which was raised by the defence was expressly disclaimed. In effect, the objections which were ultimately relied upon related in substance to lack

invention, and the width and uncertainty of the claims upon which the plaintiff relies.

The specification recites that writing instruments having a retractable writing point "are already known which comprise a tubular casing housing a cartridge carrying the writing point, generally a rotatable ball, and mechanism at the end of the casing remote from the point including a pressbutton or stud which, when pressed inwardly of the casing, causes either the projection of the writing point through an aperture in the opposite end of the casing or the retraction of the point to a position within the casing, dependent upon whether the point was initially housed within the casing or projected externally thereof, respectively". It is said to be the object of the invention to provide a writing instrument of this general character having an improved actuating mechanism of a simple and reliable character which shall be relatively cheap to produce. The invention is stated to be a writing instrument having a retractable writing point comprising a tubular casing adapted to contain a cartridge carrying the writing point at one end, a spring located within the casing and adapted to urge the cartridge axially thereof from one position in which the point is exposed externally of the casing for writing purposes to another position in which the point is retracted within the casing, an axially displaceable and rotatable element adapted to engage the cartridge, and stop means within the casing which will support the said element in one or other of two different axial positions, respectively corresponding to the positions of the cartridge, dependent upon the rotational adjustment of the element relative to the stop means. and which comprises two parts

the invention is described in the specification and it is clear from this description and the drawings which accompany it that the spring located within the casing will continue to urge the cartridge rearwards from the writing end until the constituent member, described as "an axially displaceable and rotatable element", which engages the rear end of the cartridge, comes to rest in one of two positions. What position this element will occupy may be determined by pressure upon a stud projecting at the rear end of the tubular casing. If the writing point of the instrument be retracted, pressure upon this stud will cause an operating member of which the stud forms the rearmost part to advance through an annular member which is fitted tightly in the upper end of the casing. This will, in turn, bear upon the "axially displaceable element" which is described as a "spider element" and is, in form, a ring with three equally spaced external projections therefrom and, when the writing point is in a retracted position, these projections are accommodated in grooves which travel lengthwise along the inside of the annular element. When the spider element, under pressure from the operating element, is advanced to the forward end of the annular element, it will be partially rotated and, when pressure on the stud is released, the projections on the spider element will come to rest on the upper end of the annular element and the rearward urge of the spring-loaded cartridge will be arrested at this point and the ball point of the instrument will be projected in writing position. Upon pressure on the stud when the instrument is in this position, the spider element will be lifted clear of the upper end of the annular element and

grooves in the annular element and the spider element will travel rearwards under the urging of the spring already referred to. In the form of instrument particularly described the partial rotation of the spider element is caused by the inter-action of a series of tooth-like projections on the forward ends, both of the operating element and the annular element. These tooth-like projections are so placed in relation to one another that the projections on the spider element are passed by partial rotation from the advancing operating element to the forward end of the annular element where they come to rest with the writing point of the instrument projecting and so that, when it is wished to retract the writing point and further pressure is applied to the stud, the combination of the series of teeth on both the operating element and the annular element will pass the projections on the spider element to the lengthwise grooves in the annular element, whereupon the spider element will bear down on the toothed end of the operating element and travel rearwards until it comes to rest.

It remains to be said that the tooth-shaped projections both on the operating element and the annular element do not have uniform flanges; one flange is more or less vertical and the other is sloping. The effect of this is that the operating element, once advanced, does not automatically retract and to achieve this the form of writing instrument described includes a minor spring housed in the operating element which has the effect of forcibly retracting that element. However, the plaintiff's pen may be operated without a second spring and neither

adapted to urge the cartridge axially thereof from one position in which the point is exposed externally of the casing for writing purposes to another position in which the point is retracted within the casing, an axially displaceable and rotatable element adapted to engage the cartridge, and stop means within the casing which will support said element in one or other of two different axial positions, respectively corresponding to the positions of the cartridge, dependent upon the rotational adjustment of the element relative to the stop means, and which comprises two parts movable axially relative to each other to cause partial rotation of the element relative to the stop means."

"3. An instrument according to claim 1 or 2 wherein said two parts comprise an operating member having a cylindrical portion disposed co-axially within an annular member as a relatively close fit."

It was admitted that in or about January 1961 the defendant, without the consent or authority of the plaintiff, sold at Sydney to St. James Tobacco Distributors Ltd. an identified writing instrument with a retractable writing point and this instrument became part of the evidence in the case. Evidence was given concerning it and it is clear that it bears an extremely close resemblance in detail to the form of pen described in the specification. There are, however, some differences. The so-called annular element in the plaintiff's pen is replaced by a series of projections formed on the inside of the tubular casing, two pairs of which have tooth-like formations at their upper end, and the series of projections are so placed as to form four equidistant longitudinal grooves between them. It is within these projections that the operating element is movable axially by pressure on a stud at the rear end of the casing. The operating element bears, as in the plaintiff's pen, tooth-like projections and these come into contact with a four-pronged spider element. But the tooth-like projections on the operating element are symmetrical and the effect of this is that



element to free it from the impact which it makes when it is fully advanced. But, apart from those matters, the operating mechanism of the defendant's pen is identical with that described in the body of the specification.

There is to my mind no doubt that the defendant's pen is fairly and squarely within claims 1 and 3. It contains for all practical purposes the same integers used in the same combination and for the same purpose. The slight variations to which I have referred - that is to say, the provision of the projections on the interior of the tubular casing in substitution for a closely fitting annular element and the alteration in the shape of the tooth-like projections on the operating element - were in my view immaterial and did not, as was contended, make the combination in the defendant's pen in any sense a new or different combination, or operate to remove it beyond the description contained in the claims in question. Consequently, I am of the opinion that, unless the objections raised to the validity of the claims are to succeed either in whole or in part, the plaintiff is entitled to relief substantially in the form in which it is sought.

The first objection which should be considered is that the complete specification does not comply with the requirements of s. 40 of the Patents Act. Particulars were given with respect to this allegation and they are to the effect that the objection relates "to the ambiguity of the claims of the invention and their lack of definition and their lack of a proper description of the invention and of the best method of performing same known to the plaintiff". In particular it was alleged that:

(a) "the said...displaceable and rotatable"

(c) the "stop means" referred to in claims 1 and 12 and all the claims are not fully described".

As far as (a) is concerned, I think it is sufficiently clear that "the axially displaceable and rotatable element adapted to engage the cartridge" is descriptive of a constituent part which will take up one of two positions within the tubular casing dependent partly upon its axial displacement and partly upon its rotary movement in relation to the "stop means" in the course of its operation and, as such, it is, in my view, a sufficient description. Objection (b) was not the subject of any independent argument since the plaintiff relies only upon claims 1 and 3 and it is unnecessary to pursue it. With respect to objection (c), I think the "stop means" are in the context of the claim sufficiently described by the concluding words of claim 1 - "and which comprises two parts movable axially relative to each other to cause partial rotation of the element relative to the stop means". It was contended, however, that the word "which" in this phrase did not refer to the "stop means" mentioned earlier in the claim but in my view it sufficiently appears that it does. The description, follows immediately upon the earlier words "and stop means within the casing which will support said element in one or other of two different axial positions ... dependent upon the rotational adjustment of the element relative to the stop means" and it is clear that the words "and which" which follow immediately thereafter are used to introduce a description of the "stop means" which will so support the said element. The stop means will support the element in one of two different axial positions. The position at which it will be supported at any time will depend upon its rotational adjustment with respect to those stop means. The rotational

The language may be open to the charge that it is obscure but, in my view, it provides, upon examination, a sufficiently precise description of the "stop means" referred to in the first claim. The matter is, perhaps, made a little clearer by the language of the third claim which refers to an instrument according to claim 1 "wherein said two parts (i.e. those parts which comprise the "stop means") comprise an operating member having a cylindrical portion disposed co-axially within an annular member as a relatively close fit". Even, therefore, if I thought that the first claim was open to the objection raised by paragraph (c) above I would not be prepared to uphold the objection in relation to the third claim.

During the course of the argument the defendant applied for leave to amend the particulars given by it in order to allege with particularity that the claims relied upon were not fairly based upon the invention described in the body of the specification. This application, coming as it did at such a late stage, was refused but it is a matter which, upon further reflection, I feel bound to take into account whether it is raised by the pleadings or not (see per Lord Roche in The Mullard Radio Valve Co. Ltd. v. Philco Radio and Television Corporation of Great Britain Ltd. and Others (53 R.P.C. 323, at p. 325)). Moreover, I now have little doubt that it was a matter which was open to the defendant upon the objections in the form in which they were delivered. But in support of those objections counsel for the defendant advanced all those matters which would have directly related to his proposed amendment. Indeed, in the course of his concluding address, he said as much. In effect, in addition to the matters to which reference has already been made, he pointed out that the claims relied upon extended to any writing instrument having the features therein

invention described in the body of the specification, which in describing one form of writing instrument constructed in accordance with the invention provided for partial rotation by the inter-action of tooth-like projections on the forward ends of the operating and annular elements, but was altogether too wide as a monopoly claim. To my mind this contention is not without some force but, upon consideration, I am satisfied that the particular method described in the specification for producing partial rotation is not of the essence of the invention; what is of the essence of the invention is that partial rotation of the element adapted to engage the cartridge shall result from the relative axial movement of the stop means and in my view claims so limited, as are both claims, are not too wide.

The further objection was raised that the invention had been anticipated by each of three foreign patent specifications and one abridgement of a foreign specification, which were published and available for public perusal at the Patents Office prior to 6th May 1953. In my view, however, the inventions claimed in each of these documents was extremely remote from the invention claimed by the plaintiff and I forbear to describe them. Nevertheless, it is said that the claims relied upon by the plaintiff are cast in such a wide manner as to embrace these earlier inventions. Evidence was given on this point and I think it is clear that none of them is covered by the plaintiff's claims. The nearest to, or perhaps I should say, the least remote from, the plaintiff's claims is what was called the Mable Todd specification but it was, I think, demonstrated by the evidence that what might be described as the "stop means" in the writing instrument described in that

engage the cartridge, which I very much doubt, its partial rotation was not caused by any relative axial movement of the stop means. Nor is it possible to say that, having regard to what was contained in these earlier publications, the invention claimed by the plaintiff was obvious and did not involve an inventive step. Rather, consideration of the form of the combinations which were the subject of the earlier publications helps to reveal both the novelty and comparative efficiency of the manner in which the combination the subject of the plaintiff's claims overcame the problems involved in the construction of a retractable writing instrument. I should add that the defendant in its objections also relied upon the existence of prior common knowledge to support its allegations of obviousness and lack of novelty but no evidence was adduced capable of supporting an objection on this ground. On the contrary, a comparison of the combination described in the claims under consideration with such evidence as there was concerning earlier writing instruments with a retractable writing point convinces me that its adoption was truly the result of an inventive step and that it was not, as was contended, a mere workshop improvement. This view is confirmed by the evidence of Mr. Davey whose evidence on the point I entirely accept.

In the result, I am of the opinion that the plaintiff should succeed in this suit and that appropriate relief should be granted.