No. 3 of 1961.

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IN THE HIGH COURT OF AUSTRALIA

SHEPHERD

v.

ALANDEE PTY. LTD. AND OTHERS

ORIGINAL

REASONS FOR JUDGMENT

Judgment delivered at MELBOURNE

on WEDNESDAY, 12TH FEBRUARY 1964

A. C. Brooks, Government Printer, Melbourne
C.7639/60

GEORGE FREDERICK SHEPHERD

v.

ALANDEE PTY. LIMITED and SURECAST PRODUCTS PTY. LIMITED

JUDGMENT McTIERNAN J.

GEORGE FREDERICK SHEPHERD

v.

ALANDEE PTY. LIMITED and SURECAST PRODUCTS PTY. LIMITED

This matter is an application under s. 86 of the Patents Act 1952-1962. The applicant is the patentee of an invention which is described in the Letters Patent as an "improved caster". The term of the patent ended on 26th July 1960. An extension for a period of four years was granted by an order made on 26th October 1960 by the Commissioner of Patents pursuant to s. 95 of the Patents Act 1952-1960. The amendments of the specification which the patentee asks the Court to direct are specified in the notice of motion. The effect of them, if granted, would be to give the complete specification a new consistory clause and to recast the claims. The object of the amendments is to avoid the invalidation of certain claims by copies of specifications deposited in the Patents Office Library at Canberra. The defendants in a pending action for infringement rely upon those specifications by way of defence and as a ground of their counter-claim for revocation. Besides these defendants there are two other objectors to the application. The Commissioner of Patents, who appears pursuant to s. 86(2), also opposes the application. The action was begun on 7th April 1961; the defence and counter-claim were delivered on 21st June. The action has not proceeded further. The present application was initiated soon after the patentee received a copy of the defence and counter-claim.

The patentee does not desire any amendment to the part of the specification which reads thus:

> "This invention relates to caster wheels and has particular though not specific reference to caster wheels for use with articles of furniture to provide freedom of movement of the

same upon a floor or like supporting surface.

Caster wheels or casters of the usual swivelling type commonly used on articles of furniture have certain disadvantages, mainly arising from the necessarily small diameters of the rollers, which sink into and depress the surface of a carpet or floor covering and thus impede free and smooth running of an article of furniture. Moreover, the small rollers cause undue wear and damage of the carpet or floor covering, particularly if the article is subjected to frequent movement.

If the roller be increased in size to avoid such disadvantages, the caster increases in height to an abnormal extent and becomes unduly large and bulky. Moreover, the distance of the axis of the roller from the vertical pivotal axis of the caster is correspondingly increased, thus augmenting the leverage effect of the weight on the roller upon the pivotal axis and tending to cause binding and excessive frictional resistance to swivelling movements, thereby adversely affecting the sensitivity of self-alignment of the caster.

The principal object of this invention is to provide a compact caster of neat appearance having great mechanical strength and free running characteristics and having a supporting wheel or roller of considerably greater diameter than the usual roller, while eliminating the above recited disadvantages of casters of usual type or construction."

He desires to delete the following part of the specification:

"With the above stated principal object in view the present invention comprises a caster having the rotary floor-engaging element rotatably mounted on an inclined axis offset from and turnable about the vertical swivel axis.

In a practical arrangement, the caster comprises a rotary floor-engaging element in the form of a substantially hemi-spherical hollow section and a relatively fixed complementary hollow hemi-spherical section, the sections forming a spherical shell into which the vertical spindle of the caster extends and in which are housed the vertical swivel bearing and the inclined axle bearing of the rotary floor-engaging element. Thus the bearing of axle of the floor-engaging element and vertical spindle are located within the spherical shell to provide a compact construction which contributes to the use of a relatively large floor-engaging element. Moreover the assembled spherical shell comprised of the rotatable and relatively stationary hemi-spherical section gives the caster a finished appearance, while providing a dust proof construction."

For these two paragraphs he desires that there be substituted two new ones reading thus:

> "With the above stated principal objective in view there is provided according to this invention a caster having a hollow floor engaging element rotatably mounted on an inclined axis offset from and turnable about the vertical swivel axis of the caster, said element in conjunction with a relatively fixed complementary hollow section forming a shell having a bearing into which bearing the vertical swivel axis extends and a bearing for said floor engaging element.
>
> In one practical arrangement of the caster the abovementioned hollow floor engaging element comprises a roller section, and the latter and the complementary relatively fixed hollow section are each substantially hemispherical to form a spherical shell in which are housed the bearing for the vertical swivel axle or spindle of the caster and the bearing for the inclined axle of said roller section. The housing of the above-mentioned bearings within the spherical shell provides a compact dustproof construction which contributes to the use of a relatively large floor engaging roller and gives a finished appearance to the caster."

There are drawings illustrating the "practical arrangement" as described in the specification as it stands. The new description of the "practical arrangement" which would follow the new consistory clause, if inserted, is not illustrated by any drawings. It is not proposed to interfere with the following statement in the specification:

> "In use, and as a consequence of the comparatively large diameter of the supporting roller and the closeness of its axle to the vertical swivel axis, a caster constructed as described travels easily over a supporting surface and readily tracks with and follows the direction of travel of an article of furniture to which it is attached. Moreover, the complete enclosure of the bearings excludes dust from the same, while the provision for lubrication ensures a maximum of service."

There are eight claims in the specification as it stands. It seems necessary to quote them and the proposed new claims. The existing claims read thus:

> "1. A caster having a rotary floor engaging element rotatably mounted on an inclined axis offset from and turnable about the vertical swivel axis of the caster.

2. A caster as claimed in Claim 1, wherein the rotary floor-engaging element comprises a roller of substantially hemi-spherical hollow form or section and the line of floor-contact of the roller is always normal to plane through the vertical axis.

3. A caster as claimed in Claim 2, wherein the substantially hemi-spherical hollow roller in conjunction with a relatively fixed complementary hollow hemi-spherical section forms a spherical shell, into which the vertical axle of the caster extends and in which are housed the vertical swivel bearing and the bearing of the hemi-spherical hollow roller.

4. A caster as claimed in Claim 3, having a supporting member or block rotatably mounted on the vertical axis, an inclined extension projecting from the supporting member or block, an axle inclined to horizontal fixed to the inclined extension and forming the journal for the hemi-spherical hollow roller and the fixed mounting for the complementary hollow hemi-spherical section, and retaining means preventing displacement of the supporting member or block from the vertical axis and of the substantially hemi-spherical hollow roller from the inclined axle.

5. A caster as claimed in any of the Claims 2, 3 or 4, wherein the substantially hemi-spherical hollow roller is provided with an outstanding peripheral floor-engaging portion or tread rim.

6. A caster comprising a roller section, an axle inclined to horizontal on which the roller section is journalled, and means operatively connecting the inclined axle to the vertical swivelling spindle or axle of the caster to permit castering movements of the roller section.

7. A caster according to Claim 6 and wherein the inner ends of the bearings housing the inclined axle and swivelling spindle are closed to provide self lubrication for said axle and spindle.

8. A caster constructed and operating substantially as herein described and as illustrated by the accompanying drawings."

The amendment, if made, would leave only claim 8 standing, which then would be 6. The five proposed new claims are as follows:

"1. A caster having a hollow floor engaging element rotatably mounted on an inclined axis offset from and turnable about the vertical swivel axis of the caster, said

element in conjunction with a relatively fixed complementary hollow section forming a shell having a bearing into which bearing the vertical swivel axis extends and a bearing for said floor engaging element.

2. A caster according to claim 1 wherein the said floor engaging element and the relatively fixed complementary hollow section are each substantially hemispherical to form a spherical shell housing the bearings.

3. A caster as claimed in claim 2 wherein said floor engaging element is formed with an outstanding peripheral floor engaging portion or tread rim.

4. A caster according to claim 1 or claim 2 and wherein the inner ends of the bearings for said floor engaging element and the relatively fixed complementary section respectively are closed to provide self lubrication for said element and section respectively.

5. A caster comprising a hollow rotary floor engaging roller section having an axle inclined to the horizontal and offset from and turnable about the vertical swivel axle or spindle of the caster, and a complementary relatively fixed hollow section forming with said roller section a shell housing a bearing into which the vertical swivel axle or spindle extends and a bearing for the inclined offset axle of said roller section."

Briefly stated, the objections put forward to making these amendments to the specification are that the conduct of the patentee in relation to the patent is such that the Court should decline to exercise its discretion under s. 86(1) by allowing the amendments; and that s. 78, made applicable by s. 86(3), contains provisions which prevent the Court from allowing the motion.

In order to deal with the objection that there are no merits in this application warranting a favourable exercise of the discretion of the Court it is necessary to state these facts.

In August 1945 the patentee applied in the United States of America for a patent in respect of the same type of caster. A copy of the file kept in the Patents Office there relating to the application shows that it was rejected because

of the existence of specifications on which the objectors in the present matter rely. It appears from the file that the applicant was granted a patent on 11th October 1949. There are only two claims in the patent. They read as follows:

> "1. A caster comprising a rotatable hemispherical roller having its edge portion enlarged to form a peripheral floor-engaging tread and a recess within said enlarged portion, a complementary hemispherical member marginally fitting within said recess and forming, together with the rotatable hemispherical roller, a spherical shell, said complementary hemispherical member having an aperture therein, an attachment member, a spindle secured to said attachment member and extending through said aperture, a bearing sleeve rotatably fitting said spindle, a lug projection integral with the bearing sleeve, an axle secured to said lug projection and offset from and inclined with respect to said spindle, a hollow boss on the rotatable hemispherical roller rotatably fitting the axle, said spindle having a collar and said hollow boss having a circumferential flange, and a retaining member disconnectably fixed to said lug projection and engaging said collar and flange to maintain the roller on the axle and the spindle in the bearing sleeve.
>
> 2. A caster comprising a rotatable hemispherical roller having its edge portion enlarged to form a peripheral floor-engaging tread and a recess within said enlarged portion, a complementary hemispherical member marginally fitting within said recess and forming, together with the rotatable hemispherical roller, a spherical shell, said complementary hemispherical member having an aperture therein, an attachment plate, a spindle secured to said attachment plate and extending through said aperture, a bearing sleeve rotatably fitting said spindle, a lug projection integral with the bearing sleeve, an axle secured to said lug projection and offset from and inclined with respect to said spindle, an axial sleeve integral with the rotatable hemispherical roller rotatably fitting the axle, a circumferential flange on said spindle and on said axial sleeve, and a retaining plate disconnectably fixed to said lug projection and engaging said circumferential flanges to maintain the roller on the axle and the spindle in the bearing sleeve."

In September 1945 the patentee made a similar application for a patent in the United Kingdom. The patent granted on this application is limited to a caster with a spherical shell. The claims in the specification are as follows:

"1. A caster comprising a hollow spherical shell formed of two complementary hemispherical sections, one of which is fixed and the other is rotatable and comprises a floor-engaging roller, a supporting member depending into the hollow spherical shell, a horizontally swivelling member housed within the spherical shell and rotatably mounted upon the supporting member, and an inclined member secured to the horizontally swivelling member and rotatably carrying the floor-engaging roller and supporting the fixed hemispherical section.

2. A caster as claimed in claim 1, wherein the supporting member comprises a vertically disposed axle extending into the interior of the spherical shell through an aperture in the fixed hemispherical section and pivotally connected with the horizontally swivelling member, and the inclined member comprises a sloping axle offset from the vertically disposed axle and rotatably supporting the hemispherical floor-engaging roller.

3. A caster as claimed in claim 2, having retaining means preventing displacement of the horizontally swivelling member from the vertically disposed axle and of the hemispherical floor-engaging roller from the inclined axle, comprising a locking member or plate secured to the horizontally swivelling member and engaging a flange on the vertically disposed axle and a flange on a bearing sleeve integral with the hemispherical floor-engaging roller.

4. A caster as claimed in claim 2 or claim 3, wherein the horizontally swivelling member comprises a sleeve rotatably fitting the vertically disposed axle and having a projecting inclined lug to which the sloping axle and the locking plate or member are detachably fixed.

5. A caster as claimed in any one of the preceding claims, wherein the hemispherical floor-engaging roller is formed with a peripheral floor-engaging rim which is circumferentially recessed to accommodate the edge or margin of the fixed hemispherical section.

6. A caster as claimed in any one of the preceding claims 2 to 5 inclusive, wherein the bearings of the vertically disposed and sloping axles are closed at the lower ends to retain lubricant, and the lower ends of the axles are tapered to form points to support end thrust with minimum friction.

7. A caster constructed and operating substantially as herein described and as illustrated by the accompanying drawings."

It was reasonable for the patentee to conclude from the limited scope of the monopoly given him by the

English and American patents that claims 1, 6 and 7 of the present Letters Patent had been anticipated and were unjustly wide. In my view it is a matter strongly adverse to him in this motion that he delayed for so long a time to take any steps to amend the specification. He forwarded his English and American patents to the Commissioner in connection with his application to extend the term of the patent. However, none of the specifications which were cited against his application in the Patent Offices in the United Kingdom and in the United States was brought to the notice of the Commissioner. In my view this omission is capable of being regarded as a breach of good faith and should, I think, count against the patentee in the present motion. A material matter is also the long and unexplained delay in bringing the present application. For these reasons I feel that I ought not to exercise the discretion under s. 86 by allowing the motion.

Further I am not prepared to hold that s. 78 presents no obstacle to the allowance of the proposed amendments. But in the view which I have taken that I ought in the exercise of my discretion refuse the motion, it is not necessary to discuss the issues which the provisions of s. 78 raise.

In my opinion the motion should be dismissed with costs, including reserved costs, and the applicant should pay the costs of the Commissioner of Patents.