IN THE HIGH COURT OF AUSTRALIA

BOLLA AND ANOTHER

V.

OBIEHANKO COMPANY PTY. LIMITED

ORIGINAL

REASONS FOR JUDGMENT

Judgment delivered at Sydney

on Thursday, 3rd October, 1968

A. C. Brooks, Government Printer, Melbourne

C.5072/66

BOLLA AND ANOTHER

v.

OBIEHANKO & COMPANY PTY. LIMITED

ORDER

Action for infringement dismissed with costs; counterclaim dismissed with costs; defendant's action for damages dismissed with costs. Set-off as to costs. Usual order with respect to exhibits.

BOLLA AND ANOTHER

v.

OBIEHANKO & COMPANY PTY. LIMITED

JUDGMENT McTIERNAN J.

BOLLA AND ANOTHER

v.

OBIEHANKO & COMPANY PTY. LIMITED

These proceedings are an action for infringement of letters patent No. 265399, and a counterclaim seeking both a revocation of such letters patent and a declaration and injunction in relation to certain alleged threats. The first-named plaintiff, Bolla, was, at the time of the commencement of these proceedings, the registered legal owner and proprietor of the letters patent and held his rights under the letters patent on trust for the second-named plaintiff, Gamma Design Engineering Pty. Limited. Since the commencement of the proceedings Gamma Design Engineering Pty. Limited has become the registered proprietor of the letters patent. The patent specification is entitled: "A jig for a hole saw and means to actuate a hole saw in the jig". The term of the letters patent granted in accordance with the Patents Act 1952-1962 commences on 2nd December, 1963, and the patent specification bears a priority date of 30th November, 1962.

The object of the invention claimed is described as being "... to provide a jig which will support a hole saw and hole saw actuating means in a selected position in relation to a work piece...More particularly but without limitation thereto the invention provides means for making, with the aid of the jig, a truly circular hole in a pipe in situ and at any accessible position around the circumference of the pipe". For some time prior to the making of the alleged invention by Bolla the need, particularly in the plumbing industry, for a contrivance to achieve this purpose was apparent. This need arose partly because of the advantages of and recent advances in the field of self-formed plumbing. For instance, in order to attach a new type

of saddle branch connection or pipe joint to a pipe without the expense and inconvenience of most means then used in pipe jointing practice it was necessary that a machine be available that would contain among its features some degree of portability and a capacity to make a hole in a pipe with a high degree of accuracy of dimension and of position. This was particularly necessary in relation to pipes of spun cast iron.

The machine designed by Bolla and manufactured by Gamma Design Engineering Pty. Limited is defined, for purposes of these proceedings, in claims 1, 2, 6 and 9 of the patent specification. The integers of the apparatus are set forth in claim 1 and claims 2, 6 and 9 each add another integer to those set forth in claim 1. Claim 1 is as follows:

> " A jig to support a hole saw and hole saw actuating means in a selected position in relation to a work piece, said jig comprising a saddle adapted to be seated on a work piece, means to secure the saddle on the work piece, a saw guide having a circular hole therein mounted in the saddle, two posts fixed to the saddle in parallel spaced relationship, a crosshead slidably mounted on the posts, a motor mounted on the crosshead having a driving connection to a hole saw located in operative position relative to said saw guide and means to move said crosshead in a hole cutting operation."

The further claims relevant in these proceedings refer to a "jig to support a hole saw and hole saw actuating means in a selected position in relation to a work piece according to claim 1...." and then add respectively, "...wherein the saddle is adapted to be mounted on and secured to a pipe" (claim 2), "...wherein the saw guide mounted in the saddle is interchangeable" (claim 6), and, "...wherein the driving connection of the motor to a hole saw includes a reduction gear box" (claim 9).

One embodiment of these claims is illustrated as follows:

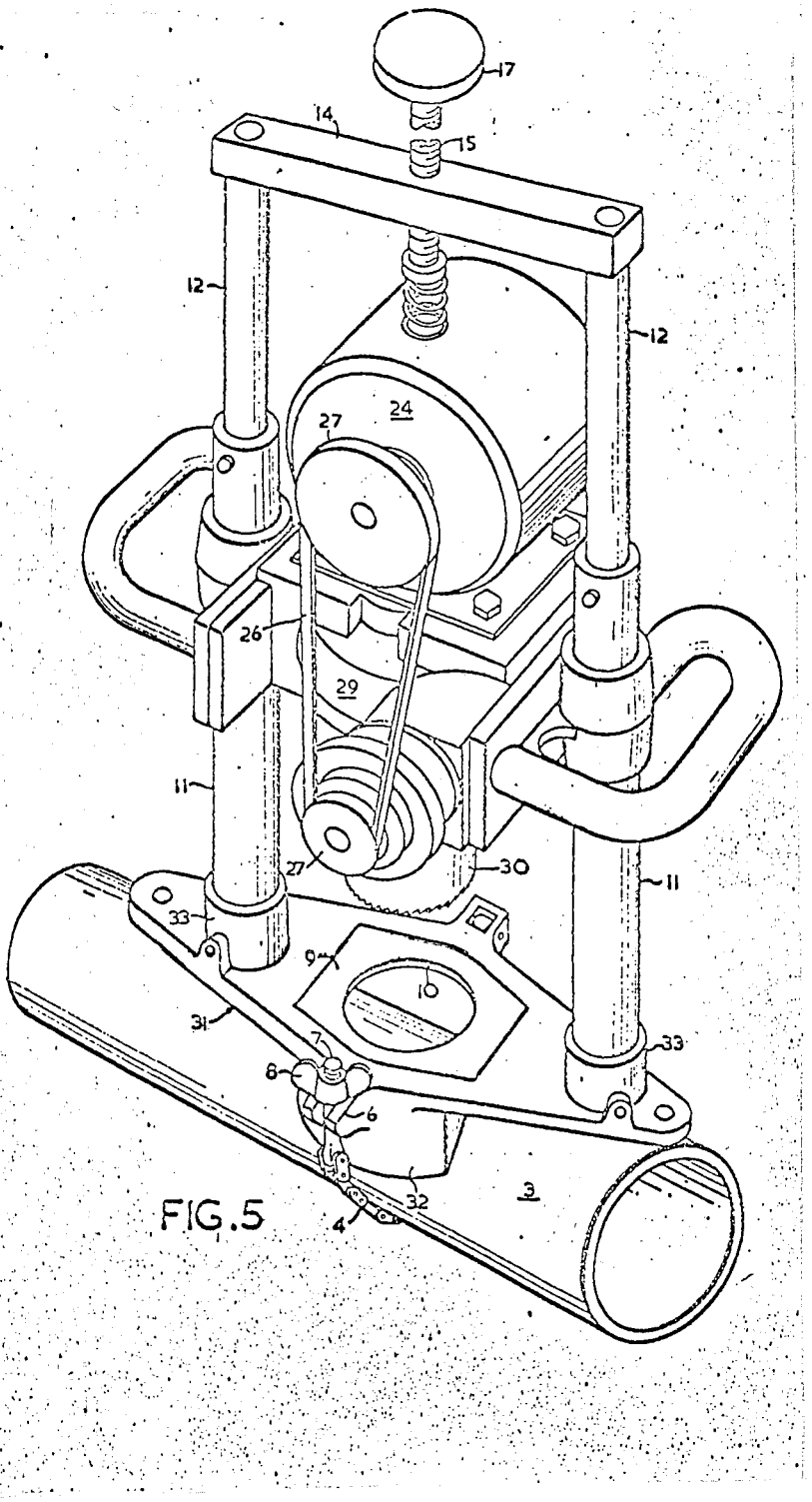


FIG.5

The first substantial issue in the case is whether the claims relied upon by the plaintiffs as having been infringed by the defendant are valid. These claims are claims 1, 2, 6 and 9. The ground relevant to this issue that was stated in the Particulars of Objection, and relied upon at the hearing, was that the invention claimed was obvious and did not involve any inventive ingenuity having regard to what was known and used in Australia on or before the priority date of the patent. Section 100 (1)(e) of the Patents Act 1952 (as amended) provides that a patent may be revoked on this ground.

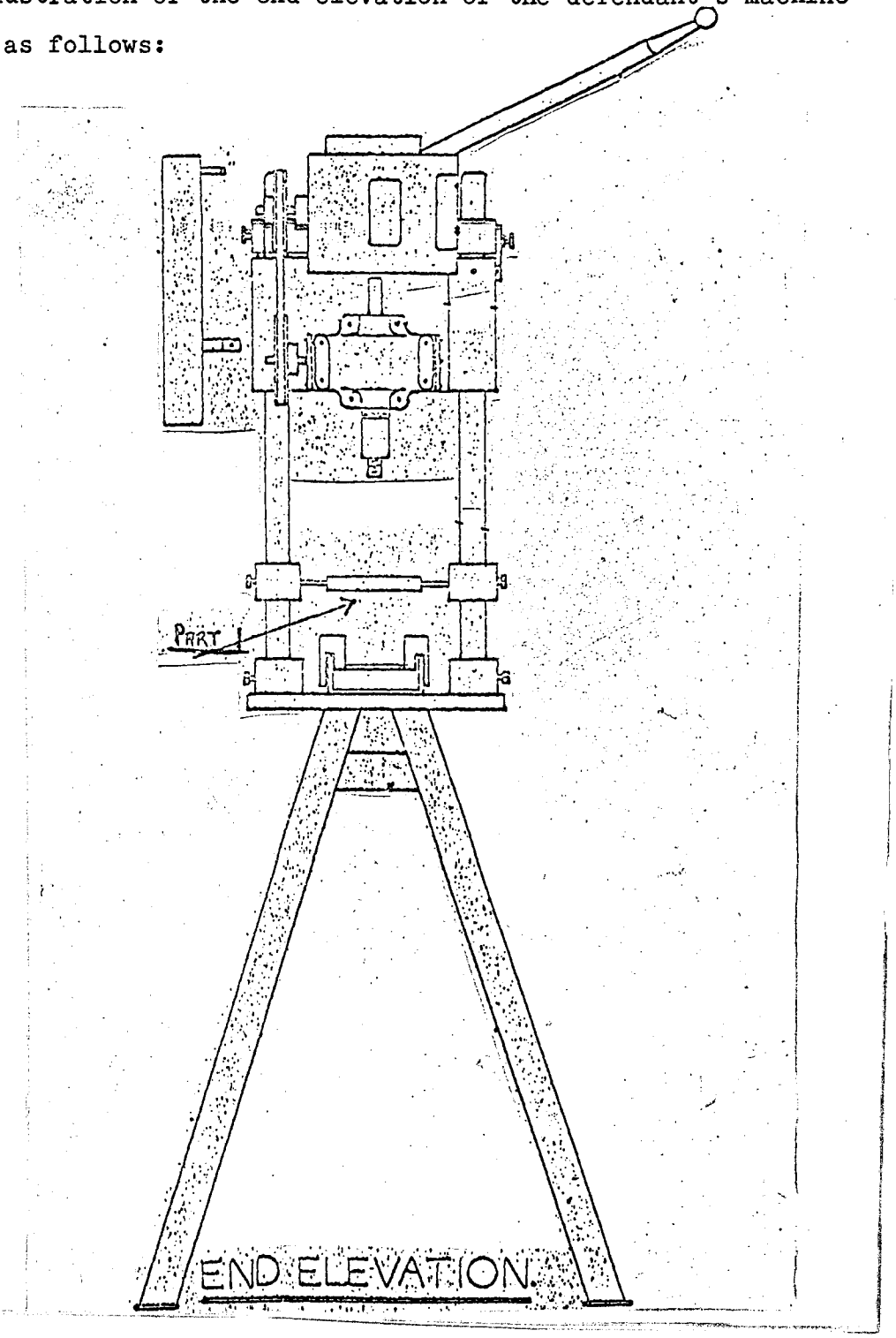
It is conceded by the plaintiffs that the machine defined in the relevant claims consists of a number of integers which in themselves were well known at the priority date of the patent specification. The plaintiffs' case in brief is that the inventiveness lies in the successful combination of such integers. Much evidence was led and this proved, inter alia, that it was part of the common general knowledge in the art at the priority date that hole saws could be used to cut holes in cast iron; that standard drilling machines could be used to drive hole saws; that portable power driven drilling tools could be used to drive hole saws; and, that a form of drilling machine to drill holes in cast iron pipes existed. The evidence also establishes, in my opinion, that some combinations of various of the individual integers referred to in the claims would have formed part of the common general knowledge in the plumbing trade at the relevant time. At this time hole saw attachments were used in drilling machines which had means for securing in position the material to be cut. Hole saw attachments had also been used in electric power driven machines which were portable. The expert workman in the plumbing field would also have been aware of the characteristics of a machine used largely by certain public authorities to drill holes in gas and water main pipes.

This machine and others available at the relevant time show the combination of a saddle clamp, a chain attachment as a means for attaching the saddle clamp to a pipe, and posts on the saddle upon which a drilling machine is mounted. In my judgment, however, a knowledge of the integers and previous combinations of some of them for related purposes at the priority date would not lead the expert workman in this field to adapt, as an obvious workshop variation or modification, a conventional hole saw to achieve the combination of integers set out in the relevant patent claims. The invention defined in the claims contains the feature of portability, a feature which could not be achieved for the relevant purpose to the same extent at the priority date by the use of other cutting instruments, such as a radial drill or conical cutter. There is no inventiveness, however, in either conceiving or formulating the idea of making a portable hole saw. Hole saws had been used for cutting metals, including steel and cast iron, but a particular difficulty presented to the inventor of the machine defined in these claims was that it was required to cut a hole in the curved surface of cast iron pipes. When the surface being cut is curved the hole saw at certain stages of the operation may be cutting at only two points on its circumference rather than at all points as it does when cutting a flat piece of material. The effect of this unequal application of pressure on the thin metal of the hole saw blade during a cutting operation may be to cause distortion in its normally round shape. A further difficulty presented by a curved surface is that in order to cut holes in a relatively large pipe of a diameter almost equal to that of the pipe, the length of the metal sides of the hole saw blade must be increased to an extent that may reduce its rigidity in relation to the work piece. Several features were combined in Bolla's invention to overcome these, and other, problems. Such features

included the arrangement of the jig, the shape of the saddle, the insertion of a metal ring in the saddle to act as a saw guide, and the dimensions of the chuck and spindle of the machine. In my opinion, a cylindrical sleeve or guide, for instance, would have occurred to a skilled engineer at the relevant time as being a means of supporting the teeth of the hole saw blade during a cutting operation, but that the manner in which such a guide is held rigidly in the appropriate position in relation to the work piece by being positioned in a type of saddle, which in turn performs other functions, both alone and as part of the jig, would not have been obvious to a skilled engineer in the appropriate art at the priority date. Further, it involved more than workshop modification to conceive and formulate a machine achieving the required portability, accuracy, rigidity, and efficiency by slidably mounting an electric motor driving a hole saw of certain strength and dimensions at necessary speeds on the end of a short spindle, on to posts fixed to a saddle adapted to be seated on a work piece and secured by means of a chain devise to, for example, a pipe, with the saddle having a cylindrical saw guide mounted within it to direct and support the hole saw. The essence of the invention lies in the combination of the several integers, some of which perform both independent and interdependent functions. It is my judgment that inventive ingenuity was involved in combining the integers mentioned in claim 1 of the patent specification to produce the machine defined therein so as usefully to solve the problem of cutting holes in spun cast iron pipes in situ with accuracy of dimension and position. Therefore, in my opinion, the defendant has not established that Letters Patent No. 265399 are invalid and should be revoked.

The second issue raised in these proceedings is whether the defendant has infringed the letters patent

by offering for sale and selling a jig for a hole saw and means to actuate a hole saw in the jig made in infringement of claiming clauses 1, 2, 6 and 9 of the specification of the letters patent. To resolve this issue it is necessary to compare the alleged infringing object with these claims in the patent specification. The machine alleged to be an infringement has several features that are similar to essential elements of the plaintiffs' machine as defined in the claims. One general difference in the use of the machines is that the defendant's machine may not be used to cut holes in pipes that are already installed in buildings without dismantling such pipes. An illustration of the end elevation of the defendant's machine is as follows:



A difference in construction and operation between the two machines appears in the means used for securing the machine and the pipe or work piece rigidly in position relative to each other.

One essential feature of all of the relevant claims of the plaintiffs' patent is a jig comprising "... a saddle adapted to be seated on a work piece". During the course of the evidence in the case various uses of the word "saddle" in engineering and plumbing were referred to. I find that the word "saddle" is generally applied to a support or attachment which is shaped to touch the object which it is supporting or to which it is attached at more than one point or plane. In order for the "saddle adapted to be seated on a work piece" to perform its essential function in the plaintiffs' machine, and thus give it utility, the "saddle" must be shaped so as to assist in ensuring rigidity of the work piece in its position during a cutting operation. An attachment with a flat base would not prevent lateral movement of the work piece. The"saddle" must be "adapted to be seated on a work piece" in a manner similar to those mentioned in the body of the specification. It is said there: "Referring to Figures 1 to 4 the saddle is a rectangular frame of side members...joined by top end members...The bottom edges of the side members are adapted to 'seat' on the article (i.e. a pipe) to be cut. The ends may be reinforced by inverted 'V' or arcuate plates...." Later it is said: "...Various modifications may be made within the scope of the invention. For example the saddle illustrated in Figures 1 to 4 may be replaced by that illustrated in Figure 5. The saddle of Figure 5 consists of a double triangular frame... with conjoined base parts. This frame has downset parts...which together form an inverted 'V'...." These descriptions illustrate some forms of "saddle" embodying the essential features of it that are defined in the relevant claims. All of these features are not present in any part of the defendant's machine. In my

opinion, the portion of the defendant's machine which is marked as "Part 1" in the above illustration is not correctly described as a "saddle", is not "adapted to be seated on a work piece", and does not perform the same functions as the "saddle" defined in the relevant claims of the plaintiffs' patent. Therefore, the alleged infringing machine does not contain all the essential integers set out in the relevant claims and it does not consist of substantially the same parts operating in substantially the same way as in the patented invention.

The claim by the defendant in the counterclaim for damages cannot be sustained. In my opinion it has not been established that even if an unjustifiable threat within the meaning of s. 121 of the Patents Act 1952-1966 had been made by the plaintiffs to the defendant, that the defendant has sustained any recoverable damages by reason of it. Further, the damages claimed, even if otherwise recoverable have not been shown, to my satisfaction, to have been sustained by reason of the alleged unjustifiable threats.

For these reasons I am of opinion that the plaintiffs' action should be dismissed with costs; that the defendant's counterclaim for the revocation of the abovementioned claims should be dismissed with costs; and, that the cross-action under s. 121 should be dismissed with costs. I order that there be a set-off as to costs.