

IN THE HIGH COURT OF AUSTRALIA

THOMAS WALKER LIMITED

THOMAS WALKER LIMITED
AND ANOTHER

V.

FASHION BUTTONS PTY. LTD.

F. B. METAL CORROPTION PTY.LTD.
AND ANOTHER

REASONS FOR JUDGMENT

ORIGINAL

Judgment delivered at MELBOURNE

on 19TH APRIL 1974

RM73/30063

THOMAS WALKER LIMITED

v.

FASHION BUTTONS PTY. LIMITED

THOMAS WALKER LIMITED AND
H. ARENDSSEN & SONS PTY. LTD.

v.

F. B. METAL CORPORATION PTY.
LTD. AND BRUCE LEIGHTON NEIGHBOUR

JUDGMENT

STEPHEN J.

THOMAS WALKER LIMITED

v.

FASHION BUTTONS PTY. LIMITED

THOMAS WALKER LIMITED AND
H. ARENDSSEN & SONS PTY. LTD.

v.

F. B. METAL CORPORATION PTY.
LTD. AND BRUCE LEIGHTON NEIGHBOUR

In each of these two actions Thomas Walker Ltd., the registered proprietor of Australian letters patent No. 220191 entitled "Improvements in fastening devices for wearing apparel", alleges infringement and seeks appropriate relief. In action No. 14 of 1970 it is the sole plaintiff and Fashion Buttons Pty. Ltd. is the defendant; in action No. 20 of 1970 its exclusive licensee, H. Arendsen & Sons Pty. Ltd., joins it as a plaintiff and there are two defendants, F. B. Metal Corporation Pty. Ltd. and its managing director, Mr. B. L. Neighbour, who is alleged to have procured and directed the acts of infringement complained of and to have himself done some of those acts. By consent these two actions have been tried together.

The plaintiffs allege that claims 1, 2, 5 and 6 of the patent have in each case been infringed by the manufacture and sale in Australia by the defendant companies of what are described as fastener sets. These consist of the familiar little metal fasteners commonly used on the waistband

of men's trousers to fasten together the garment at the top of the fly; the complete specification refers to them as fastening devices for detachably connecting the ends of a trouser waistband and they operate by the engagement of a bar with a hook.

The defendants in each action deny infringement and allege invalidity, counter claiming for revocation. Although some issues arise for decision in one only of the actions it will be convenient to deal at the one time with both actions in these reasons for judgment, only distinguishing between them when the need arises.

The invention the subject of the patent is concerned essentially with one part only of the fastener set, the hook. Hitherto fastener sets, we are told, have suffered from a disadvantage associated with the conventional design of the hook of which the tongue formed part; the hook was composed of a tongue integral with a base part or shaft by which it was attached to the garment and a backplate might also be employed as well. When such hooks were attached to the outer face of garments the tongue projected considerably because of the thickness of the base part or shaft of the hook and the spacing of the tongue away from that base part; the hook thus became liable to crushing and distortion. This the invention seeks to overcome by a device having a shallower profile than the conventional hook. The specification then describes a number of forms which, according to the invention, the fastening device may take. Each consists of a flat tongue to be secured to garments by clenchable prongs, there being provided spacing means which also operate as stops for the bar and which may take the form of a folded over section of the tongue or may consist of rearwardly projecting parts of that tongue.

The invention is, then, the use of a tongue instead of a complete hook consisting of both tongue and shaft, one thickness only of metal being present, instead of two, on the outside face of the garment. The conventional hook employs the curved section between tongue and shaft as its spacing means and as a stop for inward movement of the bar; when the hook is replaced by a tongue only, these two roles must be assumed by other mechanisms. This the invention does by use of portion of the tongue, either in folded over form or as projecting parts.

The four claims said to be infringed are as follows:

Claim 1

1. A fastening device for wearing apparel comprising a flat front tongue adapted to be secured to the outer face of a garment, in combination with a back-plate adapted to be applied behind the material of the garment so as to lie behind the front tongue and to be secured to said tongue by means of clenchable prongs, either the front tongue or back-plate being provided with spacing means which, when the device is secured to a garment, is located beneath one end portion of the front tongue and in contact with the material of the garment and which elevates said tongue so as to form together with the associated back-plate the equivalent of a hook for engagement with a staple, bar or eye member, said spacing means also forming a stop intermediate the length of the front tongue for limiting inward movement of the staple or like co-operating member.

Claim 2

2. A fastening device, as claimed in Claim 1, in which the spacing means is integral with the front tongue and separates one end of the main portion of the latter from the front face of the material to which the device is attached.

Claim 5

5. A fastening device adapted to be secured to wearing apparel by means of clenchable prongs, comprising a flat plate forming a front tongue one end portion of which is provided with rearwardly-extending projecting parts which, when the device is secured to a garment, are adapted to seat upon the outer face of the material so as to be engageable with a staple or like member, at least some of said projecting parts forming stop means disposed intermediate the length of the front tongue for limiting the inwards movement of the staple or like member.

Claim 6

6. A fastening device, as claimed in Claim 5, in which the projecting parts include a rearwardly-extending spacing lug or flange and shouldered rearwardly-extending integral prongs, the portions of said prongs below said shoulders being adapted to be passed through the material of the garment and to be clenched over in order to secure the device in place.

These claims refer to five principal elements of the hook - the tongue; clenchable prongs which attach the tongue, and back plate if any, to the material of the garment; spacing means, which keep the tongue away from the material of the garment, thus providing space for the bar to enter the hook; a stop which limits the inward movement of the bar after it enters the hook; and, in the case only of claims 1 and 2, a back plate positioned behind the material and attached to the tongue by the clenched prongs.

In claims 1 and 2 the inclusion of a back plate results in something akin to the conventional unitary hook but composed of two parts, the tongue not being integral with, but being connected to, the back plate by the prongs which, because the material of the garment lies between these two parts of the hook, must necessarily pass through that material, thus also serving the purpose of attaching the entire "hook" to the garment. What is stated to be an object of the invention, the provision of "an improved and simplified fastening device which can be made much shallower than can the usual hook type of fastener", is in this case attained by having the back plate behind the material of the garment. Where, as in claims 5 and 6, no back plate is involved, what might be described as the shaft of the conventional unitary hook is entirely dispensed with, the material of the garment instead playing that role, and the desirable quality of shallowness then arises because there exists no shaft.

On the issue of infringement counsel for the defendants very properly conceded, after the close of evidence, that the dealings of the two corporate defendants in the allegedly infringing fasteners and of which the plaintiffs' pleadings made complaint were no longer a matter in issue. The important outstanding question on the issue of infringement is, therefore, whether the defendants' fasteners do in fact infringe claims 1, 2, 5 or 6 of the plaintiff's patent.

Claims 1 and 2 differ only in that in claim 1 the spacing means may be integral either with the tongue or with the back plate whereas in claim 2 it must be integral with the tongue. The defendants relied upon five matters as supporting their denial of any infringement. Each involves interpretation of the claims and the defendants contend that when properly interpreted the claims do not extend to their design of fastener. I turn now to consider each of these five matters.

It was, said the defendants, an essential feature of claims 1 and 2 that the spacing means should also serve the purpose of stopping the further inward movement of the bar into the hook. In the case of their fastener the spacing means does not have this dual role and, accordingly, there was no infringement. Claim 1 refers to

"said spacing means also forming a stop intermediate the length of the front tongue for limiting inward movement of the staple or like co-operating member"

and it is true that the defendants' fastener not only has spacing means in the form of shouldered prongs but also a shoulder on

each side of the tongue just in advance of the shouldered prongs. If the bar to be inserted in the hook is only fractionally longer than the width of the tongue it, or, rather, the upward curving ends of it which attach it to the plate of which it forms a part, will be stopped by those shoulders before reaching the shouldered prongs; if it is slightly larger again it will pass over those two shoulders and will then be stopped by the shouldered prongs. The defendants rely upon what is said to be the purposive force of the words "for limiting" and say that the claim is expressly confined to tongues which are so designed that the stopping of the inward movement of the bar is achieved by the spacing means, that is, by the shouldered prongs.

I do not so read claim 1. A tongue designed in all respects conformably to claim 1 save that its spacing means did not form such a stop as is there described might not infringe; but this is not that case. Here the spacing means does form "a stop" precisely as described in the claim; that bars of a particular dimension may not reach it, so as to be stopped by it, but are instead stopped earlier in their inward movement by a prior and additional stopping device which has been added in the defendants' design of fasteners, appears to me to be of no moment. That fastener nevertheless conforms precisely to the description in claim 1 which, like the invention as a whole, is concerned with the design of a tongue and not with that of whatever bar may be used in conjunction with it.

This claim should not, I think, be construed as limiting the area of claimed monopoly to those hooks which do not possess stopping devices additional to the stopping device provided

by the spacing means. To add to the claimed design of the tongue an additional stopping device which will, given a particular dimension of bar, rob the spacing means of its dual function, for which it is well designed, of stopping the bar as well as of spacing the tongue away from the material and back plate will not escape the area of claimed monopoly.

The second matter relied upon is the use of the word "flat" in the description of the front tongue in claim 1. Because the tongue of the defendants' fastener is very slightly canted up towards its extremity it is said to be outside the ambit of the claims. The more ready engagement of a bar in the hook which this canting up makes possible shows, it is said, that the departure from flatness is not simply effected in an endeavour to avoid infringement - Commonwealth Industrial Gases Ltd. v. M.W.A. Holdings Pty. Ltd. (1970) 44 A.L.J.R. 385 at p.388.

A reading of the specification as a whole and, indeed, of each of the claims appears to me to reveal that the element of flatness of the front tongue is referred to in contradistinction to the curved shape of the conventional hook and perhaps also to contrast it with designs having cranked up tongues, in which the lower part is attached to the garment and back plate so that the bar may slide under the cranked up part until it reaches the point of cranking, which point acts both as a stop and as a spacing means. In the present case the minor deviation from flatness of the tongue of the defendants' fastener, scarcely visible to the eye, does not alter in any way the essence of the plaintiffs' invention which it incorporates. The tongue of the defendants' hook is substantially the

same as that described in claims 1 and 2 in this respect and infringes the plaintiffs' monopoly. Precise flatness of the tongue is no inherent quality of the invention performing any useful function or playing any part in the fastening operation and minor departures from flatness will not take a tongue out of the ambit of monopoly claimed. The same considerations apply to the "dimple" which appears as a depression near one end of the tongue of the defendants' hook.

Claim 1 describes the spacing means as "located beneath one end portion of the front tongue" and it is said that the defendants' spacing means are not "beneath" the tongue. These spacing means consist of two prongs projecting down from the top surface of the tongue on either side and on one view are to the side of and not immediately underneath any part of the tongue. But this depends upon what is regarded as the precise limits of the top surface of the tongue; if it extends to that part of the prongs before they bend over at a right angle to the plane of the tongue it would be accurate to describe the prongs as beneath a portion of the tongue. However even if this view be not adopted the prongs, and the spacing means which they incorporate, are at a lower level than the top of the tongue and in that sense are beneath it; "beneath" may mean "in a lower position" or "below" rather than "immediately underneath" and, if the tongue is spoken of as being viewed from above, the prongs will then extend "beneath" it in this sense, those parts of the prongs which incorporate the spacing means being in turn beneath, although not directly under, the top of

the tongue. The defendants' hook is in my view one of which it may properly be said that its spacing means are, when the device is secured to a garment, beneath one end portion of the front tongue.

Next it was said that, whereas in claim 1 the spacing means must be integral either with the tongue or with the back plate and in claim 2 must be integral with the tongue alone, there ~~are~~ two spacing means on the defendants' fastener, one, the shouldered prongs, being integral with the tongue and the other, a cranking of the back plate, being integral with the back plate; hence the defendants' fastener is substantially different from the monopoly claims. The complete specification, read as a whole, makes it plain that the space which the spacing means creates is a space between the bottom surface of the tongue and the outer surface of the material to which the fastening device is attached. Only the spacing devices on the prongs of the defendants' fasteners serve this function, the cranking of the back plate does not do this work and is not a relevant spacing means such as claim 1 refers to. Even if it were, the addition of a second spacing means would not serve to remove the defendants' fastener from the ambit of the monopoly claimed in claim 1.

Finally, claim 1 refers to the tongue and back plate, when secured together with prongs and their incorporated spacing means, as forming "the equivalent of a hook". For the defendants it was contended that expert evidence denied to their fastener the qualities of a hook because it was not rigid, the

tongue instead being to some extent capable of movement when fixed by the two prongs to the base plate. Certainly hooks, to fulfil their function, will normally have a degree of rigidity but it seems to me to be wrong to say of an assembled device which is in the shape of a hook but is capable of some slight amount of movement within itself, that amount depending to a degree upon the tightness with which its components are clenched together by its connecting prongs, that it thereby loses the quality of equivalence to a hook. Again the fact that the tongue is no shorter than the back plate, a matter referred to by counsel for the defendants, does not in my view prevent the assembly as a whole from forming the equivalent of a hook.

These were the five matters relied upon by the defendants on the issue of infringement of claims 1 and 2 and in my view none of them provide an answer to the charge of infringement. They all turn upon the ordinary meaning of ordinary words and to the extent that it was sought to call in aid expert evidence I have not been assisted by it.

As to claims 5 and 6 some of the foregoing matters apply equally to them and with the same result; but in addition those claims make use of the phrase "rearwardly-extending" to describe projecting portions of the tongue. It was said on behalf of the defendants that in its context "rearwardly" must mean extending in the same plane as the tongue but from the end opposite to its tip; so understood the design of the tongue would bear little resemblance to the defendants' fastener and

there would then be no infringement. It might be added that so understood these two claims would, on their face, be nonsense. However I see no reason for so interpreting this phrase.

Claim 5 describes a flat plate forming a "front tongue" and this tongue has, apparently, two ends since the claim refers to "one end portion" of the front tongue. Thus the flat plate which makes up the tongue is contemplated as having ends and also, no doubt, sides, the description "tongue" suggesting a degree of elongation; being a three dimensional object its front will then be one of its two flat faces, the other will be its back or rear. The claim goes on to speak of the rearwardly projecting parts seating "upon the outer face of the material" and thus elevating the tongue above the material and forming a means of stopping the inwards movement of the "staple or like member"; it seems to follow naturally from this that these projecting parts are to be at right angles to the flat faces of the tongue. In this context the description of the projecting parts as "rearwardly-extending" means that they extend in a direction opposite to the front surface of the flat plate, that is, the surface away from the material onto which the tongue is to be fixed. So construed the reference to rearwardly-extending presents no difficulties and the tongue of the defendants' fastener answers the description contained in claim 5.

As to claim 6 the same may be said of its reference to "rearwardly-extending integral prongs". However the subject-matter of claim 6 is a tongue having in addition to prongs a "rearwardly-extending lug or flange". The plaintiffs contended

that the "dimple" indented into what I regard as the front face of the tongue of the defendants' fastener was a "lug" within the meaning of this claim; it was not contended that it was a "flange". The term "lug" is, I think, one on which expert evidence is both admissible and useful and in this case that evidence is that in relevant metal-forming terminology a lug is a protrusion from an edge or surface, a discrete projection generally rectangular and roughly square in shape. I would not be disposed to regard the underside of the dimple as a lug in this sense. The Oxford Dictionary in its many meanings of lug includes that of "an appendage by which an object may be lifted or suspended" and the word in its engineering use appears to derive from the Scottish and north country synonym for "ear" and is defined in the fifth edition of the Concise Oxford Dictionary (1971), in its mechanical sense, as "a projection from a casting etc. by which it may be fixed in place". No expert witness in fact described the underside of the dimple as a lug and I do not think it can be so described. It not being contended that it constitutes a "flange", it follows that the defendants' fastener does not fall within claim 6 although falling within claim 5.

It follows that I find that there has been infringement of claims 1, 2 and 5 of the plaintiffs' patent by the defendant companies. The defendant Neighbour, in his answers to interrogatories, admitted that at the relevant time he was the managing director of F. B. Metal Corporation Pty. Ltd.

and in that capacity was responsible for the sales of fasteners complained of by the plaintiffs in action No. 20 of 1970 and authorized and procured certain advertisements of fasteners. There was also evidence that he had taken an active personal role in the acts of infringement complained of, including the manufacture of the defendants' fasteners. In those circumstances he will be liable for infringement of the plaintiff's patent having expressly authorized acts of infringement - Reitzman & Anor v. Grahame-Chapman and Derustit Ltd. (1950) 67 R.P.C. 178 at p.185.

I turn now to the question of validity of the patent.

The attack on validity took a number of forms. I will deal first with that alleging lack of utility.

Of claims 5 and 6, which make no reference to the use of back plates, it was said that fasteners made in accordance with those claims would not perform their task of fastening. The absence of a back plate meant that there was no substitute provided for the shaft of the conventional hook, accordingly a bar inserted between material and tongue would not remain there once any tension was brought to bear; instead the tongue would pivot at the point where it is secured to the material, thus releasing the bar. Expert evidence, involving practical experiments, was given on both sides but did little to add to what is obvious; the effectiveness of the tongue in retaining the bar in place depends, in the absence of a back plate, upon the stiffness of the material of the garment to which it is fixed; unless quite stiff the bar will not long be retained in place. Even with quite stiff material the bar is prone to

slip out. I think the defendants' objection is well taken; claims 5 and 6 are in respect of fastening devices, not merely components of such devices, and it is for wearing apparel that the fasteners are intended, "especially for detachably connecting the ends of a trouser waistband". The fasteners in claims 5 and 6 are manifestly unsuitable for that purpose, the object of the invention is not attained and these claims are accordingly invalid.

Claims 1 and 2 are also attacked upon the ground of inutility but in a quite different respect. It is said that these claims are so phrased as to include both devices which have all the defects found in prior art and also devices which will not work at all as fasteners. The latter point turns upon the failure to include the bar portion of the fastener in these claims, the former upon what is said to be the absence of limits to the claim which will ensure that it does not extend to tongues which are in fact as bulky and as liable to be crushed as was the prior art.

The failure to include the bar component in claim 1 appears to me to be of no substance. The claim recognizes the existence of the bar component as an essential part of the fastener but is concerned only to claim in respect of the tongue since it is with that component of the fastener that the invention is concerned. To have included some claim to monopoly in respect of a bar when the invention does not relate to that component would have been wrong; to refer to the bar in explaining its interaction with the tongue, as does claim 1, is all that is required and no ground of inutility emerges.

The other point, that the claimed monopoly area includes devices no less bulky and no less liable to crushing than was the prior art, also in my view fails. The advantages claimed for the invention do not arise from any particular mode of manufacture or from the use of particular materials. They arise simply because, with the omission of one thickness of metal, the shaft of the conventional hook, from the outside of the garment, there will necessarily be a reduction in the extent to which the fastener projects beyond the surface of the garment. Assuming that a conventional unitary hook fastener and a fastener conforming to claim 1 are each made of the same material then, so long as the advantage to be gained by the absence of a shaft in the latter is not, as it were, wilfully discarded by the use of some very thick spacing means, it will be less bulky and less prone to be crushed than the unitary hook simply because it will project less above the surface of the garment. Much was made of the fact that claim 1 would embrace designs of spacing means providing no more resistance to crushing than the curve between the shaft and tongue of a conventional hook. This mistakes the nature of the invention which is not concerned with any novel crush-resisting quality of the spacing means but only with the attainment of a lower profile for the tongue.

That it would be possible wilfully to so fashion a tongue in conformity with claim 1 that it projected further from the garment than would a conventional hook is irrelevant. It was said, for example, that the tongue might be so fabricated as

not to be parallel with the back plate or that very large spacing means might be employed, either of which courses would destroy the advantage claimed for the invention. However patent specifications are not to be tested for validity by reference to their possible wilful misapplication. As was said by Menzies J., although in a somewhat different context, in Welch Perrin & Co. Pty. Ltd. v. Worrel (1961) 106 C.L.R. 589 at p.602, a specification should not be construed in a way which "any sensible person would appreciate would lead to unworkability" and see British Thomson-Houston Co. Ltd. v. Carona Lamp Works Ltd. (1922) 39 R.P.C. 49 at p.89 and Leggatt v. Hood's Original Darts Accessories Ltd. and Hood (1951) 68 R.P.C. 3 at p.9 per Evershed M.R.

I accordingly conclude that the attack upon claims 1 and 2 based on inutility fail.

It was then said that no inventive step was involved. It has perhaps already emerged from earlier parts of this judgment that my view is that the substitution of a tongue, comprising only one thickness of metal, for the conventional hook with both tongue and shaft is both novel and inventive. No doubt the creation of a hook shape by the attachment together of several components has long been employed in various fields and the defendants are correct in saying that to substitute for a unitary hook with its own integral spacing means a hook consisting of two plates with separate means involves no inventive step. But to so describe the present case is to misstate the nature of the invention; it fails to recognize that the inventive step is the reduction in amount of metal projecting from the front of the garment to one thickness only.

The evidence satisfies me that the prior art in Australia consisted of fasteners involving unitary hooks and that these did have the disadvantage that they protruded from the surface of the garment and were crushed quite readily in the course of pressing. The plaintiffs have not in fact marketed in Australia any fasteners made in accordance with the patent in suit but two designs of fasteners which dispense with the shaft of the hook on the outside surface of the garment have for some time been in use in Australia. One is marketed by the plaintiffs and does not infringe the patent in suit since it has a cranked front tongue, the crank acting as both spacing and stopping means; the other is the allegedly infringing fastener. The former has had considerable commercial success due to it having overcome to a large degree the problems of protrusion and crushing which affected the prior art. It has supplied a want and this is in itself some indication of an inventive step - Commonwealth Industrial Gases v. M.W.A. Holdings Pty. Ltd. at p.386 and cases there cited by Menzies J.

It appears from the evidence that part of this success is attributable to a quality not referred to in the specifications of the patent in suit. By the use of two connected components, the tongue and back plate, the resulting composite article is capable of some movement within itself, some hinging as it was described in evidence. This apparently permits of some deflection downwards of the tip of the tongue under pressure without the same likelihood of permanent distortion as exists in the conventional unitary hook, thereby assisting in avoiding permanent distortion.

The fact that this feature is not referred to in the specification and may be accidental will not of itself detract from the inventiveness involved in the concept of a lower profile.

The marketing by the defendants of their infringing article incorporating the relevant features of claim 1 is in itself strong evidence of its merits and, in that sense, of the existence of an inventive step.

For these reasons I conclude that the defendants have failed to establish any want of inventive step.

Next it was said that fasteners incorporating the features the subject of the present claims were marketed in Australia as early as 1956. If sustained this would have been fatal to validity. This ground of defence was first raised by way of amendment almost three years after the institution of proceedings; following a chance luncheon meeting in a Sydney club, it emerged that a Mr. Phillips possessed a pair of English-made trousers fitted with a fastener incorporating the features claimed in the patent in suit but with a cranked tongue and which he believed he had purchased in Sydney in 1956. Mr. Phillips gave evidence before me and the trousers in question were tendered as an exhibit. The sole question is whether they were, in fact, purchased so long ago as to ante-date the patent in suit. If they were their incorporation of the features of the patent in suit would render it invalid.

The point is not to be resolved simply upon the evidence of Mr. Phillips, a gentleman who gave his evidence very fairly and whose honesty I do not question for a moment; following the giving of his evidence the parties were stirred to great activity

in endeavours on the one hand to support and on the other to destroy that testimony. This led to the calling of a number of witnesses and ultimately to the taking of evidence in England from witnesses who were or had been employed by the English manufacturer of Mr. Phillips' trousers.

I do not intend to enter into all the details of this mass of testimony, which provided each side with ample scope for demonstration of the fallibility of human recollection. I have studied afresh that whole body of evidence; there emerges clearly enough from it a number of relevant facts. First, Mr. Phillips' recollection of events some sixteen or seventeen years old is necessarily imperfect and the affair of the purchase of a pair of trousers, even the first purchase of expensive English sports trousers, is not of a nature calculated particularly to impress itself indelibly upon the memory. He identifies the date of purchase by reference to a trip of Europe to visit a trade fair at Hanover made shortly afterwards, in 1957, the date of which he has checked from his then current passport. However he has been on a number of world trips since then, has visited the Hanover trade fair on a number of occasions and owns a number of pairs of the same brand of English sports trousers, some very old, some bought in Sydney and some overseas. His recollection of the number of overseas trips which he made in 1957 proved, understandably enough, to be imperfect. The accuracy of his recollection is, I think, open to some doubt; however it was supported by the evidence of a witness who had for many years been employed in Scotland by the manufacturers of that brand of trousers and who said that for some time before 1957 similar

fasteners had been fitted to that brand of trousers. As a result of his cross-examination I found him a not altogether satisfactory witness, somewhat partisan and unreliable in matters of detail. Arrayed against this testimony is an impressive body of evidence to the effect that in 1956 Mr. Phillips' brand of trousers were not fitted with the design of fastener which is attached to the trousers produced by him and tendered in evidence. That evidence both oral and in the form of written records satisfies me that it was not until some considerably later date that any trousers of the brand purchased by Mr. Phillips were fitted with fasteners of the type which his trousers now bear. That evidence was of a very convincing nature when properly understood and I accept it in preference to the evidence of Mr. Phillips and to that of the defendants' other witness, the former employee of the Scottish trouser manufacturers.

It follows that the defendants have failed to establish, as they must, that at the priority date of the patent in suit fasteners incorporating features of the patent in suit were on sale in Australia.

The defendants relied upon two U.S. letters patent as showing that the plaintiffs' alleged invention was obvious. As to one of them it certainly establishes the prior knowledge of the uses of shouldered prongs, but there is no dispute as to the existence of prior knowledge of shouldered prongs and it in no way affects the patent in suit, which makes no claim to monopoly in respect of the use of such prongs. Neither

of these patents was directed to the problem solved by the patent in suit, bulkiness of the tongue, and neither discloses, to my mind, information which would render obvious the plaintiffs' invention.

It was also said that the plaintiffs' claims suffer from undue width of claim; that, in the words of Latham C.J. in Radiation Ltd. v. Galliers & Klaerr Pty. Ltd. (1938) 60 C.L.R. 36 at p.41, "the claim made is wider than the invention disclosed, and in that case the claim will be bad". Essentially this submission rests upon the view that the plaintiffs' invention is concerned with the particular spacing means employed. Latham C.J. had prefaced the passage quoted above by the observation that it was always necessary first "to ascertain what invention is claimed by the plaintiffs". Once it is appreciated that the present invention is not concerned with the discovery of particular spacing means the objection of undue width is not maintainable.

Finally insufficiency of description was relied upon but only in relation to claims 5 and 6 and in view of my conclusion on these claims on the ground of lack of utility I need not further pursue this aspect.

It follows that I find claims 1 and 2 to be valid but claims 5 and 6 to be invalid. The plaintiffs sought an injunction, an order for delivery up of infringing fasteners and the choice of either damages or an account of profits. The claim to an injunction was resisted upon the ground that the patent had not been worked in Australia either by the patentee or by its licensee. The term of the letters patent

expired in March of this year, soon after receipt of the parties' written submissions and in all the circumstances the proper course appears to be to refuse any injunction. However the plaintiffs will be entitled to an order for destruction or delivery up of infringing fasteners, that is to say, of fasteners manufactured during the term of the letters patent, and their inability to deal in infringing fasteners in consequence of that order will have the same commercial effect as would any injunction to which the plaintiffs might be entitled. The plaintiffs' failure to use the patent, while it might have enabled the defendants to seek the grant of a compulsory licence, does not otherwise affect the plaintiffs' monopoly or the relief to which they are entitled. There will, in each action, be an order for delivery up or destruction of infringing articles, each restricted to claims 1 and 2 of the specification.

The plaintiffs also seek in each action damages or, at their option, an account of profits and I will order an enquiry accordingly, subject to the like restriction to claims 1 and 2 of the specification. Questions of the entitlement of the respective plaintiffs to damages and how those entitlements may be affected by the failure to work the patent and by the existence of the exclusive licence in favour of the second-named plaintiff in action no. 20 of 1970 may best be left for determination at that stage. These considerations were adverted to in a short discussion before me, which was confined to whether either of the plaintiffs could be shown to have any claim in law to damages. I am not satisfied that either plaintiff is necessarily disentitled to damages; since it may be that an election in favour

of an account of profits will be made, which will make it unnecessary to determine finally the question of entitlement to damages and of the quantum of those damages, I do not propose to say more on this aspect.

On the counterclaim I will order revocation of the letters patent so far as concerns claims 5 and 6.

As to costs I think that, subject to the two qualifications referred to below, the proper order will be that in each action the plaintiff or plaintiffs recover from the defendant or defendants four fifths of its or their taxed costs, such costs to include discovery, interrogatories, transcripts of evidence and the costs reserved by the order of Menzies J. on the hearing of the defendants' application to amend Particulars of Objections. The first qualification relates to the taxed costs of and incidental to the application for the taking of evidence in the United Kingdom; the whole of the plaintiffs' costs of and incidental to that application and to the subsequent examination in the United Kingdom, reserved by my order made the 3rd day of July 1973, will, when taxed, be paid by the defendants to the plaintiffs. The second qualification relates to the defendants' taxed costs applicable to the further cross-examination of the witness Cutler by counsel for the plaintiffs on 8th June 1973, which shall be payable by the plaintiffs to the defendants.

IN THE HIGH COURT OF AUSTRALIA
VICTORIA REGISTRY

32

No. 14 of 1970

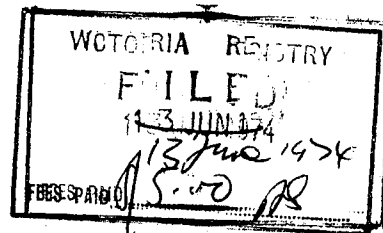
B E T W E E N

THOMAS WALKER LIMITED Plaintiff

- and -

FASHION BUTTONS PTY.
LTD. Defendant

O R D E R



COLTMAN, WYATT & ANDERSON
Solicitors,
379 Collins Street,
MELBOURNE

62-5861

GF/LT

IN THE HIGH COURT OF AUSTRALIA

VICTORIA REGISTRY

No. 14 of 1970

B E T W E E N :

THOMAS WALKER LIMITED

Plaintiff

and

FASHION BUTTONS PTY. LTD.

Defendant

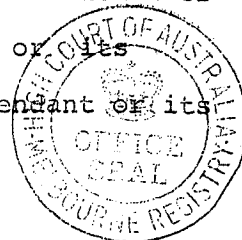
BEFORE THE HONOURABLE MR. JUSTICE STEPHEN

THURSDAY THE 13th DAY OF JUNE 1974

THIS ACTION by the Plaintiff for infringement of Australian Letters Patent No. 220,191 and Counterclaim by the Defendant for revocation of the said Letters Patent coming on for Trial before this Court at Melbourne on the 1st, 2nd, 14th, 15th and 16th days of May 1973 and the 8th day of June 1973, and evidence having been taken and transcribed at Birmingham in the United Kingdom on the 24th day of July, 1973 before a Special Examiner pursuant to the Order made herein by the Honourable Mr. Justice Stephen on the 3rd day of July 1973 and the transcript thereof and the Exhibits referred to therein having been filed in this Court pursuant to the said Order and this Action and Counterclaim coming on for further hearing on the 23rd, 24th, 25th and 26th days of October 1973 and UPON READING the pleadings herein and the transcript of the said evidence taken at Birmingham and upon reading the evidence and reading and examining the Exhibits tendered herein AND UPON HEARING Mr. King one of Her Majesty's Counsel and Mr. Lyons of Counsel for the Plaintiff and Mr. Bannon one of Her Majesty's Counsel and Mr. Simos of Counsel for the Defendant THIS COURT

DID ORDER on the 26th day of October 1973 that this Action and Counterclaim should stand for judgment AND this Action and Counterclaim having come on for judgment before this Court at Melbourne on the 19th day of April 1974 when Reasons for Judgment were delivered without any final Order having been made, with liberty being reserved to each party to speak to the minutes of the final Order and having been adjourned to enable the Plaintiff to make an election pursuant to Section 113 (1) of the Patent Act 1952-1969 AND the Plaintiff having this day made an election for damages AND this Court having this day ORDERED that this Action and Counterclaim should stand for judgment and the same standing for judgment this day accordingly at Melbourne THIS COURT DOTH ORDER as follows :

1. That an inquiry be made as to what damages have been sustained by the Plaintiff by reason of infringement by the Defendant between the 2nd July 1964 and the 20th March 1974 of claims 1 and 2 of the complete specification of the said Letters Patent.
2. That the Defendant do pay to the Plaintiff the sum found due on the making of the said inquiry.
3. That the Defendant within fourteen days from the date hereof do make by its proper officer and file and serve a sufficient Affidavit stating what articles being infringements of the said claims 1 and 2 which were made in or imported into Australia between the aforesaid dates were in the possession custody or power of the Defendant on the 19th day of April 1974 and accounting for the same.
4. That the Defendant do within seven days after the filing of the last mentioned Affidavit deliver up to the Plaintiff or to an agent in Sydney appointed by the Plaintiff or its Solicitors by notice in writing served on the Defendant or its



Solicitors within fourteen days of the date hereof or destroy in the presence of such agent such of the infringing articles referred to in such Affidavit as appear therefrom to be still in its possession custody or power.

5. That the said Letters Patent be revoked so far as concerns claims 5 and 6 of the complete specification thereof, and that the Plaintiff shall lodge at the Patent Office a disclaimer of the said claims.

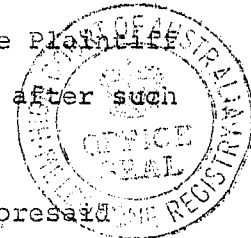
6. That the Plaintiff's costs of and incidental to the application for the taking of evidence in the United Kingdom reserved by the aforesaid Order of the 3rd July, 1973 herein (including the costs of transcribing and transmitting such evidence and including, by way of reimbursement, any fees and charges already paid by the Plaintiff pursuant to paragraph 3 of the said Order herein of the 3rd July, 1973) be taxed.

7. That the Defendant's costs applicable to the further cross-examination of the witness J.C. Cutler of Melbourne on the 8th June, 1973 be taxed.

8. That save and excepting the costs provided for in paragraphs 6 and 7 hereof, the Plaintiff's costs of and incidental to this Action and Counterclaim, such costs to include discovery, interrogatories, transcripts of evidence and the costs reserved by the Order herein of the Right Honourable Mr. Justice Menzies made at Sydney on the 18th April, 1973, be taxed.

9. That upon the taxation of the costs referred to in paragraphs 6, 7 and 8 hereof the costs referred to in paragraph 7 hereof be set-off against the total of the costs referred to in paragraph 6 hereof and four-fifths of the costs referred to in paragraph 3 hereof and that the Defendant pay to the Plaintiff the balance of the said total costs still remaining after such set off.

10. That the costs of and incidental to the aforesaid



inquiry be reserved.

11. That each party have liberty to apply further herein both generally as it may be advised and, after ascertainment of damages pursuant to paragraph 1 hereof, as to the award of interest upon the amount of damages so ascertained or part thereof to the date of entry of judgment.

BY THE COURT

Peter Secombe
Distric
DEPUTY REGISTRAR

