

PULBROOK BROS. PTY. LIMITED

v.

C. W. DONNEY & SON PTY. LIMITED

ORDER

Application for orders in terms of paragraphs 1 and 2 of the summons for directions refused.

Orders as sought in paragraphs 3 to 9 inclusive accordingly, substituting the figure 8 for the figure 6 in paragraph 4(a).

Order as sought in paragraph 10 accordingly substituting the figure 2 for the figure 3 in that paragraph.

Petitioner to pay respondent's costs of the summons.

PULBROOK BROS. PTY. LIMITED

v.

C. W. DONNEY & SON PTY. LIMITED

JUDGMENT

BARWICK C.J.

PULBROOK BROS. PTY. LIMITED

v.

C. W. DONNEY & SON PTY. LIMITED

The petitioner (Pulbrook Bros. Pty. Limited) seeks revocation of letters patent No. 427,924 granted to C. W. Donney & Son Pty. Limited (the respondent) upon a number of grounds. The petitioner alleges that the respondent was not the assignee of the actual inventor of the device to which the letters patent relate; that the device was not novel in Australia at the priority date; that it was obvious and involved no inventive step and that the complete specification did not comply with s. 40 of the Patents Act, 1952 as amended (the Act). The respondent, by its statement of defence, puts all but formal matters in issue.

Upon a summons for directions in the suit, the petitioner seeks:

- (i) An order for inspection of certain items and articles in the said interrogatories.
- (ii) Orders with respect to drawings, photographs, models and apparatus.

The parties at my direction put their submissions in writing. Perusal of the documents thus filed indicates quite clearly the basic divergence between them and the basis upon which the petitioner seeks to support the majority and significant items of the petitioner's interrogatories.

The petitioner has constructed the interrogatories it seeks to administer upon the theory that an applicant for a patent in Australia is bound to disclose to the Patent Office his whole knowledge of the prior art and also presumably the precise aspect of the claimed invention which is novel in relation to that prior art. This view the petitioner bases on certain American authorities which are cited in the petitioner's submissions, e.g. Minnesota Mining & Manufacturing Company v. Norton Company & Ors., 280 F. Supp. 674 (1968) and W.R. Grace & Co. v. Park Manufacturing Company, 378 F. Supp. 976 (1974).

But, in my opinion, an applicant for letters patent in Australia has no such obligation. What is said to be the law in the United States of America in those cases is not the law in Australia. The obligation of the applicant is set out in Part IV of the Act. The applicant's duty is to describe and define the monopoly he claims. He is to do so for the benefit of the public and not for the benefit of, or for the better or easier exercise of the functions of, the Patents Office: see per Fletcher Moulton L.J. in British United Shoe Machinery Company Ltd. v. A. Fussell & Sons Ltd., 25 R.P.C. 631 at pp. 651-2.

The question whether the claimed invention has novelty depends in no wise upon the knowledge of, or the information in the possession of, the applicant: nor upon his opinion whether it be new or inventive. Such questions are for the Court to decide in the event of any challenge to the validity of the grant. They are to be decided upon the

evidence of objective facts independently of the views or convictions of the applicant.

These considerations render interrogatories 3-18 inclusive and 20-25 inclusive untenable. Quite evidently from their terms they seek information only relevant if the petitioner's view of the relevant law is correct.

Interrogatories 1 and 2 seem to be both irrelevant and to involve a comparison of a physical object with the specification as properly construed. But it is trite law that the grantee cannot be so required to place a construction upon the specification.

Interrogatory 19 seems to me to serve no purpose but to form a basis for interrogatory 20 et seq. It also involves, in my opinion, a construction of the specification.

Being of these opinions, I refuse to make an order that the respondent answer any of the interrogatories dated 13th May, 1976, or for the inspection sought in paragraph 2 of the summons for directions. As I understand the submissions of the parties, there is no objection to the making of the orders sought in paragraphs 3-9 inclusive, substituting the figure 8 for the figure 6 in paragraph 4(a). There is also no objection to an order in terms of paragraph 10, substituting the figure 2 for the figure 3 in that paragraph.

The petitioner must pay the costs of the summons for directions, the only substantial matter in contest being the propriety of the interrogatories upon which the petitioner has wholly failed.

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FULBROOK BROS. PTY. LIMITED

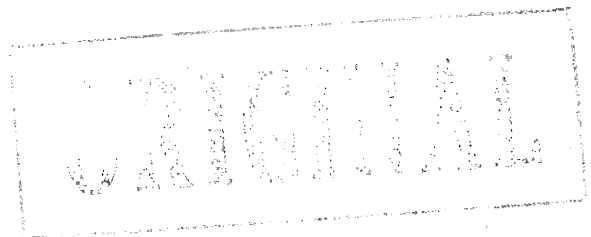
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**REASONS FOR JUDGMENT**

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Judgment delivered at ..... SYDNEY .....  
on ..... 27 January 1977 .....

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IN THE HIGH COURT OF AUSTRALIA

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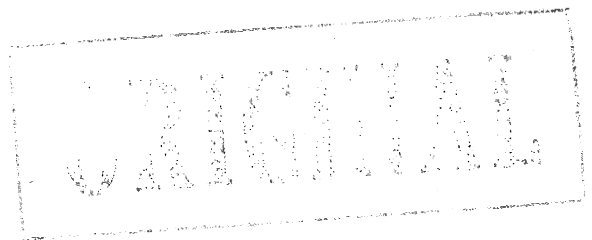
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## REASONS FOR JUDGMENT

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