

Privy Council Appeal No. 121 of 1931.

Norman Lethbridge Cowper - - - - - *Appellant*

v.

Paper Sacks Proprietary, Limited, and another - - - *Respondents*

FROM

THE HIGH COURT OF AUSTRALIA.

JUDGMENT OF THE LORDS OF THE JUDICIAL COMMITTEE OF THE
PRIVY COUNCIL, DELIVERED THE 28TH JULY, 1932.

Present at the Hearing :

LORD TOMLIN.
LORD THANKERTON.
LORD MACMILLAN.
LORD WRIGHT.

[*Delivered by* LORD TOMLIN.]

The appellant is the registered legal owner of letters patent No. 21809/25 of the Commonwealth of Australia.

His appeal is by special leave against a judgment of the High Court of Australia which affirmed a decision of the Commissioner of Patents dismissing an application of the appellant for leave to amend the specification and drawings of his letters patent.

The patent law of the Commonwealth is regulated by the Patents Act, 1903-1921.

By section 71 of the Act an applicant or a patentee may by request in writing left at the Patent Office seek leave to amend his complete specification by way of disclaimer correction or explanation stating the nature of the amendment and the reasons for it.

The next succeeding sections up to and including 79 regulate the proceedings following upon an application under section 71 and in particular section 78 of the Act provides that no amend-

ment shall be allowed that would make the specification as amended claim an invention substantially larger than or substantially different from the invention claimed by the specification before amendment.

The original specification of the patent in question was headed "Improvements in Paper Bags." It contained the following description of the invention :--

"This invention relates to paper bags of the kind adapted for heavy service, that is, for containing such heavy charges or for standing such rough usage as would necessitate a single layer of paper, for forming the walls thereof, being of such a thickness that it would be cracked or seriously weakened by folding.

Paper bags having walls composed of a thick single layer of an expensive quality of paper have been used for such heavy service, but even such expensive paper has not given satisfaction, frequently rupturing along the lines of the side folds, and the cheaper grades of paper are entirely unsuitable for making single-walled bags for such heavy service.

The closure of such bags has been effected by pasting down the ends, which has been considered to be the only practical method of effecting a satisfactory closure thereof.

In single-walled bags of this kind, especially those intended to receive cement and similar products, it has been customary to provide valves therein, whereby the material may be readily introduced into the bag after both ends are closed. Such valves, when made by in-folding the wall of the bag, are so stiff that they do not always close perfectly when the bag is filled, and thus the closure which they effect is liable to be only an imperfect one.

With the object of avoiding these defects the walls of the bag, according to the present invention, are made of several plies of light weight paper, the plies being movable relatively to each other at least at the places subjected to bending, and it has been found that the walls when so made may be folded without causing any substantial weakening thereof, that a valve made by folding the walls of the bag is sufficiently flexible to give a satisfactory closure, and that the strength and durability of the bag under rough handling are greatly increased over a bag made from a single sheet of substantially the total weight of the several sheets used.

It is impractical, however, to close such bags by the method heretofore used for closing bags of the single-ply type, that is, by pasting down the ends, since each ply would have to be folded and pasted separately to effect a strong and secure closure.

According to the present invention, the closure of the multi-ply bags is effected by sewing, stapling, or the like, such manner of closure being especially adapted for bags of this nature, since the walls are not weakened by such type of closure, as would be the case with bags of the kind hereinbefore referred to having single-ply walls of heavy paper. For instance, bending along the line of the seam formed by the closure does not materially weaken multi-ply walls of light-weight paper, and the various plies are held in frictional contact, which compensates for any weakening of the plies due to perforations formed in closing.

According to a further embodiment of the present invention the multi-ply-bag having the plurality of plies forming its walls relatively movable at the places subjected to bending is provided with a valve which is formed at the junction of the side wall of the bag with the end closure, such valve being formed by folding in the wall of the bag at such point.

The invention further consists of a paper bag of the kind hereinbefore referred to having a valve formed at the junction of the side wall and the

closure, such valve being formed of a plurality of plies of paper which are relatively movable."

After this description there followed a reference to drawings consisting of 19 figures. The drawings were expressed to "illustrate by way of example an embodiment of the invention."

The bag illustrated in the drawings is described as consisting of a tubular body closed at one end by a seam preferably reinforced by a tape with a valve provided in one corner at the end of the seam and with the other end also closed in a similar way with a seam reinforced by a tape. There followed a statement that in some instances the reinforcing tape might be omitted and it might be used only on one side but that it was preferred to use reinforcing elements on both sides and that the element should be adhesive tape on at least one side of each seam.

The bag was further described as being made of a plurality of layers of papers. It was stated that it was preferred to construct these layers from tubes "which are nested one within the other and are entirely unconnected to each other except by the end closing seams," and that preferably these tubes had their sides infolded in the manner known as "bellows-fold."

The specification then proceeded as follows:—

"Preferably the tubes are constructed one within the other in continuous form by progressively folding superposed sheets of paper and pasting their edges together. These nested tubes are folded in at the sides and collapsed, and bags are formed by sewing seams across the tubes and severing the tubes into bag lengths, either before or after sewing."

The making of the valve is next described. It is formed prior to the closure of the end of the bag. It is said to be most easily formed by beginning with the sides of the tubes separated so that the inner crease of the bellows fold is straightened out. After the bending in of the material at the appropriate point to form the valve "the bag is collapsed."

The specification also stated (amongst other things), that it was preferred to extend the reinforcing tape beyond the wall of the bag at each corner and that the seam ends were more secure if the extending ends of the tape were secured together by sewing and adhesion.

A method of forming a valve where the bellows fold is not present was then described. Next there is described as shown in figure 8 a bag with bellows fold but without a valve and with a filling opening and a filling tube.

The specification further pointed out (*inter alia*) that closing by sewing or stapling was particularly suitable for bags having walls composed of a plurality of layers of paper, that to obviate the disadvantage which resulted from vent openings in the valved end of the bag for the escape of air during filling a wide binding tape might be applied over the valved end of the bag and fastened thereto "by sewing or the like." and also that a modified form of valve might be formed by cutting the material

so that at the corner at which the valve was to be formed such material extended "beyond the end of the bag proper."

With regard to the reinforcing tape the specification contained this further passage :—

"The reinforcing tape is preferably applied immediately in advance of the needle, so that the adhesive material adheres to the thread as well as to the juxtaposed paper. This tape is very advantageous in preventing the excessive weakening of the bag by the strain of the thread against the walls of the bag between the perforations. The extension of this reinforcement beyond the walls of the bag is also advantageous in guarding against the ravelling of the seam, and is particularly effective for this purpose when the adhesive material adheres to the thread in the manner stated. Nevertheless, this feature, as well as the bellows fold of the tubes and the particular form of valve shown, is not necessary under all circumstances."

After the description of the invention in the body of the specification there followed 28 claims. They were claims of the kind which are sometimes known as "chain" claims. Each claim after the first refers to one or more of the earlier claims and seeks to add to it or them some further characteristic.

For the purposes of this appeal it is only necessary to set out claims 1, 7, 10, 12 and 19. They were as follows :—

"1. A paper bag of the kind hereinbefore referred to having its walls composed of a plurality of plies of paper which are relatively movable at the places subjected to bending and having one or both of its ends closed by means of sewing, stapling or the like.

"7. A paper bag, as claimed in any of the preceding claims in which closure is effected by sewing, characterised in that a reinforcing strip is associated with the closure.

"10. A paper bag, as claimed in any of the preceding claims characterised in that a valve is provided in an end which is closed.

"12. A paper bag, as claimed in Claims 10 or 11, characterised in that the valve is formed by folding in the wall of the bag.

"19. A paper bag, as claimed in any of the preceding claims characterised in that the bag is formed of a nested series of tubes, such tubes being attached to each other only by the closures at the ends of the bag."

The application for the patent in question was dated the 17th February, 1925, and acceptance was on the 13th July, 1925.

On the 7th November, 1929, the appellant being then registered owner of the patent applied to amend the specification and drawings, his reasons for making the amendment being stated in the following words :—

"To disclaim certain parts of the invention claimed, to disclaim an alternative form of the invention as illustrated in Figure 8 of the drawings and described in the letterpress relating to the said Figure 8, to better explain certain particulars of the invention, to delete certain claims, to omit the said Figure 8 of the drawings and the said letterpress relating to the said Figure 8 and to make consequential variations in the text to the specification."

The amendments applied for were very extensive. Substantial portions of the body of the specification were practically re-written, the whole of the 28 claims were struck out and figure 8

of the drawings and the relevant part of the text of the specification relating thereto were eliminated. Twelve claims were substituted for the original 28 claims.

The Commissioner of Patents refused the application on the ground that the amendments practically amounted to the re-writing of the whole of the specification and the formation of a new claim.

An appeal to the High Court failed upon the ground that the amendments would have made the specification as amended claim an invention substantially different from the invention claimed by the specification before amendment.

At the date when the application for amendment was launched there was no action for infringement or proceeding for revocation pending, but after the decision of the High Court the respondents, Paper Sacks Proprietary, Ltd., instituted proceedings for the revocation of the letters patent. Such proceedings were stayed pending the determination of the appellant's present appeal against the decision of the High Court.

After the matter had been opened before their Lordships' Board the appellant's Counsel under pressure of the criticisms levelled against his amendments asked leave to substitute some new amendments in place of his original amendments.

The application was opposed by the respondents who urged that having regard to sections 80 and 81 there was no jurisdiction in their Lordships' Board to grant the application and such leave could only be given by the Judge having seisin of the revocation proceedings. The two sections in question are in the following terms :—

“80. Except as provided in the next following section the provisions of sections 71 to 79 do not apply when and so long as any action for infringement or proceeding for revocation of a patent is pending.

“81. In an action for infringement of a patent and in a proceeding for revocation of a patent the Court Justice or Judge may at any time order that the patentee shall subject to such terms as to costs or otherwise as the Court Justice or Judge may impose be at liberty to apply under the last preceding section for leave to amend his specification by way of disclaimer and may direct that in the meantime the trial or hearing of the action be postponed.”

Now it was not disputed that upon an application properly instituted under section 71 any Court having seisin of the matter would be free if no such proceedings as are mentioned in section 81 had in the meantime been begun and remained pending to give leave to the applicant to modify his amendments and if thought proper to sanction the modified amendments, but it was urged that this power ceased the moment any proceeding of the kind mentioned in section 81 was launched.

Their Lordships were unable to accept the view urged by the respondents upon the effect of sections 80 and 81. In their Lordships' judgment it is not the result of these sections that any limitation is imposed upon the jurisdiction of a Court having

seisin of an application properly launched under section 71 because at some date subsequent to the application under section 71 an action for infringement or a proceeding for revocation has been instituted.

Taking this view of the matter their Lordships authorised the appellant to bring in new amendments upon the footing that success on the new amendments would not improve his position in the matter of costs. In these circumstances it was unnecessary for their Lordships to express any opinion upon the original amendments and the new amendments became the sole matter for consideration.

By the new amendments all the original amendments to the body of the specification with certain exceptions are swept away. The exceptions are as follows :—

- (1) The word “valved” inserted by the original amendments as shown in red on p. 16, l. 11 of the record before the words “paper bags” in the sentence “this invention relates to paper bags,” *et seq.* is left standing.
- (2) The reference to another patent No. 8891/22 inserted by the original amendments as shown in red on p. 16, ll. 25, 26 and 27 of the record down to and including the words “single ply paper” in l. 27 is left standing.
- (3) There are left struck out in accordance with the original amendments certain phrases indicating a preferred form or an illustrated form of the invention such as the words “according to a further embodiment of the present invention” (*see* p. 17, l. 28 of the record). “It is preferred to construct” (*see* p. 18, l. 32 of the record) and “it is preferred to make” (*see* p. 23, l. 12 of the record).
- (4) The striking out of figure 8 in the drawings is adhered to in the new amendments and consequently the passages referring to such figure in the body of the specification struck out by the original amendments remain struck out (*see* p. 18, l. 2 and p. 19, ll. 30–37 (both inclusive) of the record) and
- (5) The substitutions made by the original amendments of “in” for “of” (p. 21, l. 31 of the record) and of “the valve” for “such material” (p. 21, l. 32 of the record) are retained in the new amendments.

The new amendments get rid of 6 of the 12 claims of the original amendments and make some alterations in the first of the 12 claims being one of the six claims retained. The six retained claims as amended read as follows :—

“1. A paper bag of the kind hereinbefore referred to having its walls composed of a plurality of nested tubes of paper the plies of which are relatively movable at the places subjected to bending and having both of its ends closed by means of reinforced sewn seams, which are formed by collapsing the nested tubes and making a reinforced sewn seam parallel

and adjacent to each end thereof by sewing through the combined thickness of the walls of the bag and of reinforcing strips laid on either side of such closures and having the said plies of paper attached to one another only by the said end closures and having at one corner of the closed bag a valve formed by infolding a part of the multi-ply wall of the bag prior to the operation of forming the adjacent closure.

2. A paper bag, as claimed in Claim 1 having the end closures effected without bending over the end or ends of the bag.

3. A paper bag, as claimed in Claim 1, having its sides folded in to form a bellows fold.

4. A paper bag as claimed in Claim 2 having its sides folded in to form a bellows fold.

5. A paper bag, as claimed in Claim 1, in which the said reinforcing strips are extended beyond the valve and the sewing is continued along such extended portion.

6. A paper bag as claimed in Claims 3 or 4, characterised in that before the infolding operation the material of the valve at the corner where the valve is formed extends beyond the end of the bag proper whereby when the wall of the bag is infolded to form the valve, said projecting portion will give added length to the valve substantially as herein described and illustrated with reference to Figures 18 and 19."

Now it may be said at once with regard to (1) the striking out of figure 8 and the passages in the specification relating to it, and (2) the substitutions on p. 21 of the record to which reference has already been made that these are amendments to which there can be no objection. The first is "disclaimer" and nothing else. The second is "correction" and nothing else.

As, however, no debate was directed to these matters, presumably the parties attach little or no importance to them. The real contest was waged about claim 1 of the new amendments. On the one hand it was conceded that if claim 1 could not be supported as an allowable amendment all the other 5 claims were equally inadmissible and on the other hand it was not disputed that if claim 1 was allowable the remaining 5 claims could not be objected to.

The appellant's case on claim 1 is shortly this, that claim 1 is merely one form of the invention comprised in the forms which can be found in a combination of the claims Nos. 1, 7, 10, 12 and 19 of the original specification and that therefore to ask for claim 1 of the new amendments is merely to disclaim everything else which is to be found in the original claims.

The respondents on their part deny that claim 1 of the new amendments is to be found in the old claims at all. They say such claim is in fact a claim for an invention substantially larger than or substantially different from any invention originally claimed and that in any case there is such ambiguity in it that it ought not to be allowed as an amendment.

Having regard to the pending proceedings for revocation their Lordships desire to refrain from expressing on this appeal any view in relation to the original specification which might seem to affect in one direction or the other the question to be resolved in those proceedings.

Now an applicant for amendment has upon him the burden of showing that his amendment falls within one or other of the three categories of disclaimer, correction, or explanation, and that he is not claiming an invention which is substantially larger than or different from that originally claimed. This necessarily involves that his amendment must be unambiguous otherwise the onus upon him cannot be discharged.

It has been said that the number of combinations possible under the claims of the original specification is so great that the selection of one of them is an operation of such complication and difficulty as in itself to amount to new invention or at any rate to something more than disclaimer of all the combinations other than the one selected.

Their Lordships do not think it necessary to express any view upon the question of invention by selection or upon the question whether the number of combinations possible under the original specification can make any difference in principle to the power of disclaimer.

It is enough for the purpose of the present appeal to say that in their Lordships' judgment the language of claim 1 of the new amendments is of import too doubtful to enable the appellant to discharge the onus that is upon him. He fails in their Lordships' opinion to establish with sufficient certainty either that this claim is merely one of those already covered by some one or more of the old claims upon which he relies or that it does not comprise an invention substantially larger than or substantially different from that covered by the unamended specification.

The following matters are among those which have led their Lordships to the conclusion indicated. The specification in its body deals with the bellows fold. The passages relating to the bellows fold in such body are left standing by the new amendments. Claim 14 in the original specification which related to bellows fold has gone, but in all the figures retained the bellows fold is shown. There is no disclaimer of bellows folds and it is not clear whether the new claim is intended to cover a bag whether it has a bellows fold or not. The closure of the ends of the bag is expressed to be by "reinforced sewn seams." The body of the specification uses, in reference to the seams, the phrases "sewing or stapling" and "sewing or the like." Claim 12 of the original claims refers to a seam formed by "sewing, stapling or the like." It is not made clear that the seam referred to in new claim No. 1 is intended to be confined to a seam formed with thread.

Again the seam is a "reinforced" sewn seam. The body of the specification refers to a reinforcing tape and to an adhesive material which is to adhere to the thread by which the tape is sewn on. Claim 8 of the original specification was for a bag characterised in that adhesive material is provided which is adapted to unite the reinforcing strip to the wall of the bag and to adhere to the sewing thread. This claim is eliminated and the

question now arises as to what is meant by "reinforced" having regard to the passages which still stand in the body of the specification and that question cannot be clearly answered.

The reinforcing strips are expressed to be laid on either side of the closures. This is language of ambiguity which may mean on one of the sides or on both sides.

The seams are to be formed by collapsing the nested tubes. It may be questioned whether there is anything in the body of the specification which contemplates the formation of the seams by collapsing the bags or even if there is whether such a process is found within the ambit of the five old claims on which the appellant relies. Further, the formation of the valve by infolding the multi-ply wall of the bag "prior to the operation of forming the adjacent closure" is a claim which seems to go beyond anything covered by the five original claims.

The body of the specification under the new amendments (restored as it thereby is substantially to its original condition) when read with claim 1 of the new amendments, introduces, in their Lordships' opinion, such elements of inconsistency and doubt as make it impossible to accept the view that the appellant has discharged the onus upon him.

In their Lordships' judgment therefore the appeal in regard to its real substance fails, but the amendments upon the two minor matters already indicated may properly be allowed and to this extent the order of the High Court should be varied. Leave therefore should be given to amend the specification in the following respects and in the following respects only, viz. :— (1) by striking out figure 8 and the reference to it in the body of the specification at p. 18 of the record l. 2 and the description of such figure at p. 19 of the record ll. 30 to 37 both inclusive, and by altering the figure 7a on p. 18 of the record l. 1 to 8; and (2) by substituting "in" for "of" at p. 21 of the record l. 31 and the words "the valve" for the words "such material" at p. 21 of the record l. 32.

Their Lordships will humbly advise His Majesty accordingly. The appellant must pay the costs of the appeal.

In the Privy Council.

NORMAN LETHBRIDGE COWPER

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