

The Wanganui Sash and Door Factory and Timber Company
Limited - - - - - *Appellants*

v.

Roland Moore Maunder and another - - - - - *Respondents*

FROM

THE COURT OF APPEAL OF NEW ZEALAND.

JUDGMENT OF THE LORDS OF THE JUDICIAL COMMITTEE OF
THE PRIVY COUNCIL, DELIVERED THE 24TH JANUARY, 1930.

Present at the Hearing :

THE LORD CHANCELLOR.
LORD MERRIVALE.
LORD HANWORTH.
LORD THANKERTON.
LORD RUSSELL OF KILLOWEN.

[*Delivered by* LORD RUSSELL OF KILLOWEN.]

In this case the defendants to the action appeal from an order of the Court of Appeal of New Zealand reversing a judgment of Mr. Justice Reed in their favour.

The action was brought for infringement of New Zealand Letters Patent No. 34845. The main defence relied upon was invalidity of the patent based on want of novelty and want of subject matter.

The Letters Patent were originally granted in 1914, but in the month of November 1924 the patentee obtained leave to amend his complete specification and it is upon a consideration of the specification as so amended that the rights of the parties fall to be decided.

The first step is to construe the specification and ascertain what it is that the patentee claims as his invention.

The specification is entitled "Reinforced Concrete Tiles for Building Purposes." The patentee states that his invention

consists in the manner of constructing the concrete tiles so as to produce a tile with certain specified qualities. He then proceeds thus :—

“ This is effected by the combination, with the concrete material employed, of a proportion of flax tow (finely chopped). The concrete is formed by a mixture of pumice sand or finely crushed pumice and cement on a basis approximately of $3\frac{1}{2}$ of pumice to one of cement by measurement, and the tow is added in sufficient quantity to be distributed evenly and fairly thickly throughout the whole mixture to bind it. A sufficient quantity of fibre being by weight four and one-half pounds of fibre to one bag (126 lbs.) of Portland cement.

The mixture may be made in any approved manner, the tiles being moulded in moulds of the required shape and size, usually in slabs of five-eighths of an inch in thickness.”

The words of the claim are as follows :—

“ A tile for use in the covering or formation of walls, composed of a mixture of pumice sand, cement and finely divided flax tow moulded into the required shape and size, substantially as described.”

Their Lordships are of opinion that upon the true construction of this document what the patentee claims is a tile for covering or forming walls made of a mixture of pumice sand, cement and finely divided flax tow ; and that the essence of the invention is the mixture, made by combining with a concrete (formed of pumice sand and cement) a proportion of flax tow as a reinforcing material.

The proportions of the ingredients of the mixture are only mentioned in the specification as “ approximate ” and “ sufficient,” and could only be treated as referred to in the claim by virtue of further indefinite words, viz., “ substantially as described.” Their Lordships are of opinion that the proportions are not claimed by the patentee : but that upon the true construction of the patent, the patent (if valid) would be infringed by the manufacture of a tile composed of a mixture of the three ingredients in any proportions.

It is, however, to be observed, in this connection, that the plaintiffs themselves in manufacturing their “ Konka ” tiles (which is their trade name for their patented article) make a substantial departure from the proportions given in the specification.

In the result the real claim of the patentee is for making tiles for a particular use composed of a mixture of the three ingredients, viz., (1) pumice sand, (2) cement, and (3) finely divided flax tow.

Whether any inventive step was taken by the patentee in making a tile composed of that mixture is a question to be answered by the Court after consideration of the evidence placed before it as to the state of affairs existing at the date of the patent in relation to common knowledge and other relevant matters.

The evidence in the present case establishes to their Lordships’ satisfaction three matters, viz. : (1) that in 1914 the

formation of concrete by mixing cement and pumice sand was well known : (2) that at the same date the reinforcement of such concrete by the addition of a binding material was well known ; and (3) that at the same date the use of tow as a reinforcing material in sheets of plaster of paris was well known.

The patentee's alleged invention goes a step further, in using finely divided tow as a reinforcement of a sheet of concrete. Was there any inventive step in doing that, or in making a tile out of a mixture of the three ingredients ?

In the view of their Lordships, the evidence of the plaintiffs' own witnesses compelled the trial judge to answer this question in the negative, and this notwithstanding the fact that the Konka tile did in the long run achieve a commercial success. The oral evidence was read and considered many times before their Lordships and no useful purpose will be served by analysing it again. It will be sufficient to cite a few samples. The plaintiff Frederick George Beavan said :—

“ If I had made a thin sheet of concrete in 1910 it must have at once occurred to me that I must have a binding or reinforcing material. If the thought occurred to him to make a thin sheet of concrete then that must have happened to any builder. There is a difference in idea between reinforcing a sheet of concrete and reinforcing a sheet of plaster. The difference is that it is a difference of materials and used for a difference of purpose. I admit now that they are both for strengthening. The principle must be the same. There is no novelty in the idea of reinforcing with fibre. There is a novelty in reinforcing a thin sheet of concrete. The novelty lies in the reinforcing of a thin sheet.”

Robert William Green stated that if a builder conceived the idea of thin concrete sheets then it must occur to him that to reinforce them he would have to use fibre or some such thing. Albert Edward Dare (a practical plasterer) stated that the use of fibre for reinforcement was well known in the trade and had been for many years.

“ I have used it myself on wall boards. I suppose I used it 20 years ago. The fibre in Konka boards is for the same purpose as the fibre in plaster boards.”

Walter Mitchell (another practical man) gave the following evidence :—

“ There is no inventing when you select Portland cement rather than plaster of paris because you want to use the material outside. It is common knowledge that pumice is light too. So there is no inventiveness to choose that as an aggregate. Tow as a binder in plaster of paris is no different from tow as a binder in concrete.”

From the evidence, of which these extracts form part, their Lordships are satisfied that no inventive step was taken by the patentee.

This view is strengthened by a consideration of two documents, viz., Millar's book on Plastering and Tyree's specification.

Millar, in addition to references to chopped tow as a strong material capable of being used with advantage for thin plaster

work, deals (at p. 379) with what he calls "External slabs." They are described as made of Portland cement with coke breeze or pumice stone as an aggregate. It is stated that the foundation for the slabs is thin wire-netting or perforated metal sheets, "tow being employed for acute angles." Their Lordships understand this to mean that when a slab or tile has to be constructed with an angle, e.g., to be fitted at a corner, the mixture of pumice and cement of which the slab or tile is composed should be reinforced by the addition of tow. This would appear to be nothing less than a direction (by a book of acknowledged authority) to the trade to reinforce a slab composed of cement and pumice by adding a third ingredient, namely, tow.

Tyree's specification (which is dated in 1906) seems also of importance in this connection, because all the three ingredients of the plaintiffs' mixture are included therein. The sides of Tyree's hollow blocks (see his drawings, Fig. 2 and Fig. 4) are thin sheets of reinforced concrete, made out of a material composed of a matrix, an aggregate, and a reinforcing material. According to Tyree's specification the matrix may consist of Portland cement, the aggregate may consist of pumice and the reinforcing material may consist of fibre which has been thoroughly shredded. The material so produced Tyree calls a fibrous cement mixture. No proportions are given, but it is stated that the proportions may vary within wide limits.

Their Lordships, in view of the oral evidence given and of the information given and contained in the documents above referred to, are of opinion that Mr. Justice Reed arrived at a correct conclusion when (as he states) he found it—

"impossible to say in view of the public knowledge existing at the time that any exercise of invention was necessary to the first production of this patented building sheet."

Their Lordships are unable to agree with the reasoning of the judgment of the Court of Appeal which appears to them to confuse results flowing from the invention with the invention itself. The invention here claimed was making a tile out of a new substance, viz., pumice sand, plus cement, plus flax tow. Assuming that neither flax tow nor any other fibre had before been used as a reinforcer of a concrete composed of cement and pumice sand, the evidence satisfies their Lordships that in employing it for that purpose the patentee took no inventive step, and they are of opinion that the patent in suit is invalid accordingly.

Certain authorities were cited in argument, but inasmuch as the decision in this case turns solely on the effect of the evidence before the Court, it seems unnecessary further to refer to them.

Their Lordships will humbly advise His Majesty that this appeal should be allowed and the judgment of the Supreme Court of New Zealand restored and that the respondents should be ordered to pay the costs of the appellants before this Board and in the Court of Appeal.



In the Privy Council.

THE WANGANUI SASH AND DOOR FACTORY
AND TIMBER COMPANY, LIMITED,

vs.

ROLAND MOORE MAUNDER AND ANOTHER.

DELIVERED BY LORD RUSSELL OF KILLOWEN.

Printed by
Harrison & Sons, Ltd., St. Martin's Lane, W.C. 2.
1930.