FIREBELT PTY LTD V BRAMBLES AUSTRALIA LTD

(Inventive step)

[2002] HCA 21 (Gleeson CJ, McHugh, Gummow, Hayne and Callinan JJ, 23 May 2002)

Background
Firebelt Pty Ltd (Firebelt), was the grantee of an Australian petty patent under the Patents Act 1990 (Cth), in respect of an invention entitled "A Side-Loading Refuse Vehicle".
Brambles Australia Ltd, carried on a business under the name "Cleanaway", using a side-loading refuse and recycling collection vehicle in the region of the second respondent, the Cooloola Shire Council (the "Council").

The proceeding
Firebelt instituted proceeding in the Federal Court alleging infringement of the petty patent. Cleanaway and the Council denied infringement and set up a defence under the Crown Use provisions of the Act. These provisions allow the Crown to utilise an invention subject to remuneration of the patent holder. Cleanaway also sought revocation of the petty patent on several grounds of invalidity.

The primary judge
Dowsett J rejected a number of grounds on which revocation of the patent was sought, in particular that the invention was not:
" a 'manner of manufacture' within the meaning of s. 6 of the Statute of Monopolies (s. 18(1)(a) of the Act);
" novel (s. 18(1)(b)(I) of the Act).
" useful (s. 18(1)(c) of the Act);
More importantly, Dowsett J. found that as compared with the prior art base, as it existed before the priority date of the petty patent, the invention did not involve an inventive step or that it was obvious to a skilled addressee in the art. (s. 18(1)(b)(ii) of the Act).

In the High Court, Firebelt pointed to the great commercial success of the invention as evidence that the invention was not obvious. Whilst the court acknowledged that the presence of a known need and the subsequent commercial success may lead to a conclusion that there was an inventive step, the evidence in this case was weak.
It was noted that this issue was not agitated in the application for special leave. An application by Firebelt to supplement its grounds of appeal was rejected, not only because of the lateness of the application but because of the little weight of the evidence.

The court held that contrary to Firebelt's contention, the trial judge and the full court did state the appropriate principles in relation to combination patents and evidence was properly accepted which, consistent with those principles, supported the revocation of the petty patent for want of inventiveness.
It was decided that the claims being in relation to a combination of known integers, the question was whether the evidence supported a conclusion that it had been shown to be obvious to place those integers in the interactive combination claimed in the petty patent. The court concluded that the evidence supported such a finding.

Conclusion
The appeal was dismissed and the result was that the order for the revocation of the petty patent stood.