

The defendants used a colourable variation from our patent and infringed the combination; *Proctor v. Bennis*. (1); *Machine Co. v. Murphy* (2).

Johnston Q. C., and *Heighington* for the respondents referred to *Murray v. Clayton* (3); *Harris v. Rothwell* (4) in support of their argument that defendant's book was merely an improvement on that of the plaintiffs and not an infringement.

The judgment of the court was delivered by—

KING J.—This action was brought to restrain defendants from making, using or selling counter check books alleged by the plaintiffs to be an infringement of a patent of which they were the assignees granted February 15th, 1882, to one Carter. Upon the trial, before Mr. Justice Burbidge, the action was dismissed.

The subject of plaintiffs patent is called "The Paragon Black leaf check book," and was before the Court in *The Grip Printing and Publishing Co. v. Butterfield* (5) It is a book for use in shops for the making of duplicate entries by means of carbonized paper. In his specification the patentee said :

I am aware that black leaves are used in other forms of books used in transferring writing from one page to another, but they are either loose in the book and are therefore easily lost, and are dirty to handle, or are placed in the centre of the book and the leaf numbered on either side of it, which latter arrangement is faulty from the fact that the space left on each side of the black leaf when the leaves are torn out causes the black leaf to curl up and become unsatisfactory in its operation.

As a matter of fact the Muma & MacKay book, which was prior to the Carter patent, had the black leaf, with the composition on but one side, bound into the book next to the cover; and it had these in combination with the perforated fly-leaf which is also an element in the Carter combination.

(1) 36 Ch. D. 740.

(3) 7 Ch. App. 570.

(2) 97 U. S. R. 120.

(4) 35 Ch. D. 416.

(5) 11 Can. S. C. R. 291.

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The object of the Carter invention is thus stated in the specifications :

The object of the invention is to provide a check book in which the black leaf used in transferring writing from one page to another need not be handled and will not have a tendency to curl up after a number of leaves have been torn out, and it consists essentially of a black leaf check book composed of double leaves, one half of which are bound together, while the other half are folded in as fly leaves, both being perforated across so that they can readily be torn out, the black leaf being bound into the book next to the cover and provided with a tape bound across its end, the said black leaf having the transferring composition on one of its sides only. What I claim as my invention is : In a black leaf check book composed of double leaves one-half of which are bound together, while the other half folds in as fly leaves both being perforated across so that they can readily be torn out, the combination of the black leaf bound into the book next to the cover and provided with the tape bound across its end, the said black leaf having the transferring composition on one of its sides only.

When the book is opened for use the black leaf is found lying on top of the double folded leaf. The first thing to be done is to disengage the free, or fly leaf, part of the double leaf and place it on the top of the black leaf; this done the black leaf lies between the two parts of the folded double leaf, and is ready for use. The purpose of the tape was to enable the salesman to throw back or raise the black leaf, and so disengage the fly leaf without soiling the fingers, and also to raise it again when tearing out the under leaf from the stub without soiling the fingers, a matter of some importance when certain goods were to be handled. It appears, however, to have been very soon found in practice that there was no practical advantage in the use of the tape, and at an early period the patentee and his assignees discarded it and manufactured and put upon the market as the patented article, "The Paragon Black leaf Counter Check book" without the tape, discontinuing the manufacture of the patented article. The books so manufactured and put upon the market are found by the learned judge to be substan-

tially similar to the Muma & MacKay book of 1871, which was in use in Canada from that time down to the granting of the plaintiffs' patent. In neither of these books is there tape, but in either of them the black leaf may be raised for the several purposes for which it is required to be raised without touching the carbon and therefore without soiling the fingers. This may be effected either by bending back the flexible book at the point of binding, and so causing the free ends of the leaves to fall apart, or by making use of the upper or clean side of the black leaf to move it away from the margin sufficiently to get at the leaf lying under it, or, as stated in the evidence, by the aid of the fly leaf if it is extended. A very slight use of the book would accustom one to these movements. In the cross examination of Mr. Ridout, a patent solicitor called by the appellant, he said in reply to the learned judge that if the patentee had had the experience when he patented it that he had subsequently he need not have put in the tape at all as he would have seen that the fly leaf accomplished the same result. This witness also stated that the tape was unnecessary and that the combination was essentially one of only two elements viz.: the carbon leaf bound in next to the cover and the perforated fly leaf, one of which (*i.e.*, the perforated fly leaf) performs a double function.

The effect of this might be to show that the patent, in that which was distinctive of it as a combination or otherwise, had no utility beyond what was found in the anterior combination, and so was without consideration. Mr. Cassels as to this says, first that the fly-leaf answers the purpose of the tape only under certain conditions; and secondly, that the defendants upon the trial admitted the utility of the plaintiffs' patent. Such an admission was indeed formally

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1894 made, and is referred to by the learned judge in giving
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 CARTER & COMPANY v. HAMILTON. Apart, however, from any question of utility, the  
 fact of the practical discarding of the tape, and of its  
 King J. apparently superfluous character, are not without im-  
 portance in another point of view presently to be  
 adverted to.

The plaintiffs' combination is therefore to be taken as useful and (so far as these books are concerned) the method of raising the carbon leaf by a tape attached to it may be taken to be a new method. Then the question is: Have the defendants infringed the plaintiffs' patent? It is claimed that they have; that they have made substantially the same combination and have varied from it only colourably. In the defendants' book there is a contrivance for turning the carbonized leaf (which in their book forms part of the flexible cover) without soiling the fingers. Their method consists in leaving a margin of about half an inch free from carbon.

The question on this is: Has the plaintiffs' combination in substance been taken? In *Proctor v. Bennis*, (1), Cotton L. J. stated the question thus:

Has the defendant, though not exactly taking the whole combination which has been patented, taken, by slight variations or by mechanical equivalents, the substance of it so as to produce the same result by practically the same means?

The answer to that depends to some extent on the nature and object of the invention.

In *Curtis v. Platt* (2), Wood V. C. says:

Where the thing is wholly novel and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object to see whether or not they are merely colourable contrivances for evading that which has been done before. When the

(1) 36 Ch. D. 740.

(2) 3 Ch. D. 136, note.

object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has a right to extend very largely the interpretation of those means which he has adopted for carrying it into effect.

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This was affirmed by Lord Westbury L.C., on appeal (1).

In *Proctor v. Bennis*, (2) the Court of Appeal commented upon *Curtis v. Platt* (1) and dwelt upon the distinction between cases of combination for an old object and cases of combination for a new object.

Cotton L. J. says :

In applying the words used by the judges in that case (*Curtis v. Platt* (1)) we must consider the nature of the case before them, (viz. : "an improvement in a machine which had been long in use for producing a certain result," and I come to the conclusion that what they meant was that where there is no novelty in the result, and where the machine is not a new one, but the claim is only for improvements in a known machine for producing a known result, the patentee must be tied down strictly to the invention which he claims, and the mode which he points out for effecting the improvement.

And see also per Bowen L. J., p. 764, and Fry L. J., at pp. 767, 768.

Now the case before us is that of a combination for an old object rather than for a new object. In substance, although not in terms, it is for an improvement in a known contrivance for producing an old result. Check books with carbon leaf carbonized on but one side and bound in next to the cover and with double perforated leaves were known contrivances with a known object prior to plaintiffs' patent. In the use of such book by salesmen they would know that, without the exercise of care, the fingers might become soiled, and any one whose business might lead to the handling of delicate fabrics at the same time would naturally use the books in a way to avoid soiling the fingers,

(1) 3 Ch. D. 138, note.

(2) 36 Ch. D. 740.

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and in doing so would make use of the mechanical aids which the book afforded. The Muma & MacKay book did afford fairly adequate means of doing this by the carbon leaf being free of carbon on one side and by the perforated fly leaf, and what is of some importance is that the practical discarding by the plaintiffs of the tape (their special device for avoiding the soiling of the fingers) and their putting upon the market "The Paragon Black leaf Counter Check book", without the tape as their patented article, with no substantial variation from the prior book of Muma & MacKay, in preference to, and in substitution for, their patented combination, goes to show that the results they sought to attain by their patented article were adequately attained by the old means, and that their patent was, in reality, not the case of a combination productive of entirely new result but a supposed improvement in the means of affecting an old object. This is also the proper conclusion upon the evidence at large. It is clear that all the results attained by the patented book are attainable (although perhaps not with equal facility) by the book which plaintiffs are manufacturing and putting on the market; and that the same results could have been effected and no doubt in practice must have been frequently effected (although perhaps with still less facility) by the persons who, prior to plaintiffs' patent, had occasion to use the Muma & MacKay book, the fly leaf (as expressed by Ridout and as found by the learned judge) performing a double function. The case therefore is not like that of *Proctor v. Bennis* (1) where the combination was a new invention with a novel result; but rather comes within the class of cases dealt with in *Curtis v. Platt* (2) where there was no novelty in the results, but where the only novelty which could be claimed was that of improvement in the application and use of certain mechanical means in order to produce in a known article the same

(1) 36 Ch. D. 740.

(2) 3 Ch. D. 136 note.

result which in it had been produced by other mechanical means. The turning over of a carbon leaf in these books without touching the carbon cannot be considered novel. The novelty introduced by plaintiffs lies in turning it over by means of an attached tape.

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We are not therefore to extend very largely the interpretation of those means which the plaintiffs have adopted for carrying their object into effect, although they are to be protected against merely colourable variations. There must necessarily be considerable similarity in the different ways of turning a leaf, and where one seeks to establish a right in respect of a mode of doing such a simple thing and for a well known purpose it seems only reasonable to confine him with some strictness to the particular means or methods which he adopts. The two ways of turning back a leaf as shown in the two check books are as diverse as one could expect considering the nature of the thing to be done. The one is not a mere colourable variation from the other, but an essentially different means for producing what appears to have been the common and well-known object.

It would be an extraordinary result if the plaintiffs could hold the field with their disused device and prevent others from trying other, and perhaps less sterile, means of effecting the same far from novel object or result. The conclusion therefore is that there has been no infringement of the plaintiffs' patent, and the appeal must be dismissed with costs.

Appeal dismissed with costs.

Solicitors for appellants: *Edgar & Malone.*

Solicitors for respondents: *Heighington, Reade & Johnston.*