

1947 *Nov. 28, 29 *Dec. 1 and 2 <hr/> 1948 *Feb. 3 <hr/>	THE COMMISSIONER OF PATENTS (RESPONDENT) ..... }  AND  WINTHROP CHEMICAL COMPANY INCORPORATED (APPELLANT) ... }	APPELLANT;   RESPONDENT.
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## ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

*Patent—Claim for patent for substance prepared or produced by chemical process and intended for food or medicine, must include claim for patent for process by which substance prepared or produced—Meaning of words “claims”, “described and claimed”, “claimed”—The Patent Act, Statutes of Canada, 1935, c. 32, ss. 34, 35, 37 (2), 40 (1), (2), (3).*

The respondent applied for a patent for an invention relating to a substance prepared by a chemical process and intended for medicine but did not claim for the process by which it was produced. The Commissioner of Patents rejected the application on the ground that by section 40 (1) of the *Patent Act*, claims for substances covered by it must be accompanied by claims for the processes by which they are prepared.

The respondent appealed to the Exchequer Court of Canada (1). The appeal was allowed. On appeal to this Court

*Held:* A claim for a substance alone, cannot under section 40 (1) of the *Patent Act*, be entertained. The applicant's specification should describe the method or process by which the substance is prepared or produced and claim a patent therefor in the manner specified in section 35.

*Per* the Chief Justice and Estey J.: There appears no reason to conclude other than that Parliament intended these words “claims” and “described and claimed” should have the same meaning and significance in section 40 (1) as in sections 34, 35 and 37 (2) of the Act, so construed it meant that the applicant's specification should describe the method or process and claim a patent therefor in the manner specified in section 35.

*Per* Taschereau and Kellock JJ.: There appears to be no reason for giving the word “claimed” (as used in section 40 (1) of the *Patent Act*) other than the ordinary meaning of the word. (*Short v. Weston*, 1941 Ex. C.R. 69 at 95) and (*Winthrop Chemical Co. v. Commissioner of Patents*, 1937 Ex. C.R. 137) followed.

*Per* Rand J.: Considering the language of section 40 (1), I think it quite impossible to say that it has not a plain and ordinary meaning which is quite consistent with the remaining provisions of the Act and is wholly without incongruity or absurdity. So reading the words “claims” and “claimed”, the subsection clearly denies any right to a patent for a substance unless there is, in addition, a claim in its technical sense for the mode or process of producing it.

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\*PRESENT:—Rinfret C.J. and Taschereau, Rand, Kellock and Estey JJ.

APPEAL by The Commissioner of Patents from the judgment of Thorson J., President of the Exchequer Court of Canada (1) holding that, section 40 (1) of the *Patent Act*, Statutes of Canada, 1935, chapter 32, is complied with if in a claim for a substance to which it applies the process of its manufacture is described in the disclosure of the specification and so defined in the claim as to be made an essential element thereof so that the claim is restricted to the substance as produced by the process so defined, even if such process is not a patentable one. There is no need of a separate claim for the process.

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*Cuthbert Scott* and *W. R. Meredith* for the appellant.

*Christopher Robinson* for the respondent.

The judgment of the Chief Justice and Estey J., was delivered by

ESTEY J.: The Commissioner of Patents rejected the respondent's application Serial No. 465,721 for a patent entitled "Basic Double Ethers of the Quinoline Series". His decision was reversed by a judgment in the Exchequer Court and this is an appeal from the latter judgment. (1).

The appellant's (Commissioner's) refusal was based upon his construction of section 40 (1) of *The Patent Act* (1935 S. of C., c. 32):

40. (1) In the case of inventions relating to substances prepared or produced by chemical processes and intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the methods or processes of manufacture particularly described and claimed or by their obvious chemical equivalents.

The appellant's contention is that an application for a patent of a substance must include a claim for a patent of the process by which that substance is produced. The respondent, on the other hand, contends that this section 40 (1) is complied with by a recital, in both the description and claim portions of the specification, of the process by which that substance is produced, but that it is not necessary to claim a patent for that process.

These respective contentions involve a construction of section 40 (1) and particularly the word "claimed" as it

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appears in that section. The appellant would construe "claimed" to mean, or as equivalent to, "the subject of a claim", while the respondent would construe it as "defined in the claim so as to be made a constituent element of the claim".

The language of section 40 (1) construed according to the grammatical and ordinary sense in which the words are used indicates that a patent for the substance separate and apart from the method or process by which it was produced could not be granted unless the word "claimed" is construed to have a meaning such as that suggested by the respondent.

Sections 34 and 35 under the heading "Specifications and Claims" set forth the requisites which an applicant must include in his specification. In the main there are two parts to the specification under these sections. That under section 35 (1) may be referred to as the description and that under section 35 (2) the claim. The description portion discloses the invention and its operation and use and such details as required in 35 (1). Section 35 (2) provides:

The specification shall end with a claim or claims stating distinctly and in explicit terms the things \* \* \* in which he claims an exclusive property or privilege.

These sections 34 and 35 provide for and indicate the reason, purpose and meaning of both the description and the claim portions of the specification. The claim sets forth precisely the subject and the limits of the "exclusive property or privilege" or the protection desired in the patent. These provisions indicate the meaning and purpose of the claim, and the word so used and understood cannot mean merely as "defined in the claim so as to be made a constituent element of the claim" as the respondent submits.

In section 37 (2) the phrase "describes and claims" appears, and again these words are used in the same sense as in section 35 and their separate significance is again apparent.

There appears no reason to conclude other than that Parliament intended that these words "claims" and "described and claimed" should have the same meaning and

significance in section 40 (1). So construed it appears that when Parliament adopted in section 40 (1) the words the specification shall not include claims for the substance itself, except when prepared or produced by the methods or processes of manufacture particularly described and claimed,

it meant that the applicant's specification should describe the method or process and claim a patent therefor in the manner specified in section 35. Under this section 40 (1) therefore a claim for "an exclusive property or privilege" with regard to the method or process by which the substance is produced may be accompanied by a claim for a patent with respect to that substance but a claim for a patent with respect to the substance alone cannot be entertained.

Moreover, this construction of section 40 (1) is consonant with the use of the phrase "patented process" in 40 (2). In this subsection Parliament is raising a presumption in favour of a plaintiff with respect to one of the essentials that must be proved in an action for infringement of his patent under section 40 (1). In this regard Parliament speaks only of the "patented process", which emphasizes the construction already placed upon section 40 (1). These subsections read together contemplate among the possible actions one for an infringement with respect to the process in which the substance is new but not patented but do not contemplate a patent for a substance only.

The respondent sought to draw a conclusion favourable to its point of view from the history of section 40 (1) and of 38A in the British statute. Section 38A was enacted into the British Act in 1919 (9 & 10 Geo. V, c. 80) in order to check the doubtful practice of patenting a substance separate and apart from the process by which it was produced. While the Canadian Act is not modelled on the British Act, in 1919 an amendment was made to the Canadian Act enacting section 17 (1) (1923 S. of C., c. 23) in language identical to that in section 38A except that the word "or" in the phrase "processes or intended" in the British Act was "processes and intended" in the Canadian Act. The British section as drafted was construed to mean that the patent of a substance could not be granted apart from the process which itself had to be

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new, patentable and claimed. *In re M's Application* (1); *In re W., K.-J., and W. Ltd.* (2) and *Sharp & Dohme Inc. v. Boots Pure Drug Company Ltd.* (3).

The British Act was amended in 1932 by striking out the word "special" where it appeared and inserting the word "particularly" between the words "manufacture" and "described", and by deleting the word "claimed" and substituting therefor the word "ascertained." The word "special" had been emphasized in the decisions just mentioned. The section as amended in 1932 has not been, upon the point here under consideration, judicially construed. The matter has been considered by learned authors who do not go so far as to say that the substance may be patented apart from the method or process by which it is produced. Indeed, in the most recent work, Meinhardt on Inventions, Patents and Monopoly at p. 193 states:

In the case of inventions relating to substances intended for food or medicine, no patent can be granted for the substance as such; a patent can, however, be obtained for a particular method or process for preparing or producing the substance.

See *Terrell on Patents*, 8th ed., p. 64; *Haddan's Compendium of Patents and Designs*, p. 94.

In the British Act, unlike in the Canadian Act, that part of the specification requiring the description of the invention uses the phrase "described and ascertained" and it may be that in amending section 38A by striking out the word "claimed" and inserting the word "ascertained" it was bringing section 38A in line with the phraseology of section 2 (2) of that Act. At the outset there was an important difference in these sections as enacted in Great Britain and Canada. These amendments have made them so different that a construction of the one is of little, if any, help in construing the other.

It is, however, significant that when the *Canadian Patent Act* was amended and consolidated in 1935 section 17 (1) was amended as in section 38A of the British Act by striking out the word "special" and inserting the word "particularly", but the word "claimed" was not struck out and the word "ascertained" inserted in lieu thereof. The retention of the word "claimed" in the Canadian Act is significant and important. It continues what is in section

(1) (1922) 39 R.P.C. 261.

(3) (1928) 45 R.P.C. 153.

(2) (1922) 39 R.P.C. 263.

35 contemplated—a specification the first portion of which is description and the second portion claim. The former describes and makes known the nature of the invention and the second sets out the subject and the limit of the monopoly asked.

Moreover, section 40 (1) in its present form was enacted into the Canadian Act in 1935 and the foregoing construction has been intimated in the Exchequer Court in both *Winthrop Chemical Company Inc. v. Commissioner of Patents* (1) and *J. R. Short Milling Co. (Canada) Ltd. v. Geo. Weston Bread & Cakes Ltd.* (2), and notwithstanding these decisions no further amendment has been made.

The history of section 40 (1) appears to support the construction already indicated rather than that suggested by the respondent.

The appeal should be allowed with costs.

The judgment of Taschereau J., and Kellock J. was delivered by

KELLOCK J.:—This appeal involves the construction of Section 40, subsection 1 of the *Patent Act* of 1935, which is as follows:

In the case of inventions relating to substances prepared or produced by chemical processes and intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the methods or processes of manufacture particularly described and claimed or by their obvious chemical equivalents.

The learned President in the court below held that the word “claimed” was to be construed as meaning “defined in the claim” and that therefore the appellant had been in error in refusing claims limited to the substance only, although the process by which it was produced was defined in the claim but was not itself the subject of claim. This conclusion was reached upon a review of the history of the Canadian and the corresponding English statutes. As pointed out by the learned President the predecessor of Section 40 (1) was Section 17 (1) of *Cap. 23* of the 1923 statutes which followed *ipsissima verba* Section 38A of the Patents and Designs Act of the United Kingdom of 1919. The subsection then had the word “special” before the word “methods” but did not have the word “particularly”

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(1) [1937] Ex. C.R. 137.

(2) [1941] Ex. C.R. 69.

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before the word "described". In 1932 the English statute was amended by striking out the word "special" and inserting "particularly" and also by striking out the word "claimed" and substituting "ascertained".

When the Canadian statute came to be revised in 1935 the substitution in the English Act of the word "claimed" for "ascertained" was not adopted. It should also be pointed out that at all times the Canadian statute applied only to substances prepared or produced by chemical processes "and" intended for food or medicine, while the English Act applied to substances prepared or produced by chemical processes "or" intended for food or medicine. It is also to be observed that what is now subsection 2 of the Canadian Act was formerly a proviso to subsection 1. The same is true of the English statute.

The learned President was of the opinion that the object of the English statute was to prevent the grant of a patent for a substance *per se*. He pointed out that by reason of the construction placed upon the word "special" in England the process itself had formerly to be a patentable process. In his view since the amendments of 1932 in England

a claim for a new substance is valid if restricted to the substance as produced by the process of manufacture defined in the claim as an integral part thereof, even if such process is not a patentable one, and that it is no longer necessary to the validity of the claim that the inventor of the new substance should also be able to claim the process of its manufacture.

In his opinion the retention of the word "claimed" in the Canadian statute, while "ascertained" had been substituted in the English Act, was without significance.

Whatever may be the correct view of the English statute it does not, I think, with respect, necessarily follow that the situation is the same under the Canadian Act, where Parliament, apparently deliberately, has not chosen to follow the course of the legislation in England.

It is admitted by counsel for the respondent that the meaning attributed by the learned trial judge to the word "claimed" is not the one which it ordinarily bears, but it is contended that as used in the subsection it should be interpreted as the learned judge below has interpreted it, particularly as what is contended to be the object of the legislation, namely, the preventing of the patenting of substances *per se*, would be attained by such a construction.

Turning to the subsection itself, it provides that in the class of case to which it relates, the claim or claims in respect of a substance may not be for a substance *per se*, but as prepared or produced by the methods or processes "particularly described and claimed".

According to the Oxford Dictionary "describe" means, *inter alia*, "to give a detailed or graphic account of" (which is said to be the ordinary current sense); "to set forth in delineation"; "to delineate". "Particular", by the same authority, means, *inter alia*, "relating to or dealing with the separate parts, elements or details of a whole; detailed, minute, circumstantial"; "a minute account, description or enumeration".

To construe the word "claimed" therefore as merely "defined in the claim" ("define" by the above mentioned dictionary, meaning "to state precisely", "to specify", "to set forth or explain the essential nature of") would not appear to add anything to the words "particularly described" but to reduce the statute to mere repetition. I see no compelling reason for so doing. On the contrary, there are in my opinion indications in the statute itself that such a meaning was not intended.

By subsection 2 it is provided that in an action for infringement of a patent where the invention relates to the "production" of a new substance, any substance of the same chemical composition and constitution is, in the absence of contrary proof, to be deemed to have been produced by the *patented* process. If the respondent is right in its contention as to the construction of subsection 1, subsection 2 would have no application to a substance within subsection 1 produced by a process not itself the subject of patent. I think it unlikely that such a result was ever intended but rather that the provisions of the two subsections are supplementary.

Again when one turns to subsection 3, the same consideration appears. It provides that in the case of a patent for an invention intended for or capable of being used "for the preparation or production" of food or medicine, the Commissioner of Patents has power to grant a licence to an applicant therefor limited to the "use of the invention for the preparation or production" of food or medicine (i.e. the process) and it is declared that in settling the

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terms of the licence regard shall be had to the desirability of making the food or medicine (i.e. the substance) available to the public at a proper price. Under this provision it is the *invention* which is to be the subject of the licence and it is the *process* which is referred to by the subsection as the invention. If, therefore, subsection 1 is to be interpreted as applying to a substance produced by a process which need not be patentable, no licence could be obtained under subsection 3 for its production. In my opinion no such effect was intended by the legislation.

In the result therefore there appears to be no reason for giving other than what counsel for the respondent admits is the ordinary meaning of the word.

Maclean J. in *Short v. Weston* (1) took the same view of subsection 1 as that to which I have come as also did Angers J. in *Winthrop Chemical Company v. Commissioner of Patents* (2). There is nothing in the judgment of this court in the *Short* case (3), which is in the contrary sense. Indeed in that case the patents in question included the substance and the process and section 40 (1) was held to have no application as the process was not a chemical process.

As pointed out by my brother Taschereau on the argument, it is impossible to give to the word "revendiqués", which is the corresponding word in the French text, any such meaning as "defined in the claim". This fact "markedly emphasizes what I have already indicated", to borrow the language of Sir Lyman Duff, C.J.C., in *The King v. Dubois* (4), at 403, where the French text of section 19 (c) of the Exchequer Court Act was similarly of assistance in the construction of the English version.

I would therefore allow the appeal with costs.

RAND J.:—Mr. Robinson has said all that can be said in support of the view on which the President of the Exchequer Court proceeded, and its insufficiency results, I think from the nature of approach to interpretation which it involves. What has been called the Golden Rule of construction is that the language of a statute should be given its grammatical and ordinary sense unless that would

(1) [1941] Ex. C.R. 69 at 95.

(2) [1937] Ex. C.R. 137.

(3) [1942] S.C.R. 187.

(4) [1935] S.C.R. 378.

lead to absurdity, repugnancy or inconsistency, in which case that sense may be modified so as to avoid the absurdity or inconsistency but no further; *Grey v. Pearson* (1), and if in any circumstances, a statute enacted by another legislature, even though it were the prototype enactment of the particular subject-matter, could be resorted to as an aid to interpretation, that must at least be only when the language is found balanced in doubt or ambiguity.

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But the converse assumption seems to lie at the bottom of the judgment from which this appeal has been taken. The approach is on the footing that the Canadian Act has been patterned after its English counterpart and that as the amendment to the latter in 1932 was followed by a somewhat similar amendment in this country in 1935, the conclusion follows that what is deemed to be the obvious meaning of the English Act should be taken to be that of the Canadian enactment. Apart from the question of such a method, there is the added objection here that the subject-matter of Section 40 in the Canadian Act is not strictly the same as that of Section 38A of the English Act. Section 40 deals with inventions "relating to substances prepared or produced by chemical processes *and* intended for food or medicine". The English Act deals with inventions "relating to substances prepared or produced by chemical processes *or* intended for food or medicine". That itself is sufficient to indicate the greatest danger of associating the amendments of the one with those of the other; and I should add to this that although the meaning of the amended section in the English statute is taken to be beyond doubt, it has not yet been construed by a court.

Considering then the language of Section 40 ss. (1), I think it quite impossible to say that it has not a plain and ordinary meaning which is quite consistent with the remaining provisions of the Act and is wholly without incongruity or absurdity. It is in these words:

40. (1) In the case of inventions relating to substances prepared or produced by chemical processes and intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the methods or processes of manufacture particularly described and claimed or by their obvious chemical equivalents.

I observe, first, as Mr. Robinson conceded, that the primary meaning of the word "claim" or "claimed" in the

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statute is the specific assertion of invention for which a patent is sought by the application. Then there is the word "include" in the fourth line, the sense of which is said to be that of "contain", but which in the first instance at least, I feel bound to take, in the particular context, as implying that the claim for the substance is one of a plurality of claims including that for the method or process. So reading these words, the subsection clearly denies any right to a patent for a substance unless there is, in addition, a claim in its technical sense for the mode or process of producing it.

The secondary meaning of "claim" or "claimed" suggested, that of "defined", arises out of the initial assumption that the intendment of the statute is to restrict the patented substance to the mode of production described or included in the specification whether or not itself patentable or claimed, the presumed effect of the corresponding English section: but, apart from the meaningless repetition of such a sense in the collocation of the word with "described", this is really an argument in policy.

Subsection (2) confirms the plain meaning of the words; it creates a procedural privilege or advantage to the holder of a patented process where the new substance is found produced by someone other than the patentee. The same confirmation arises from ss. (3) where authority to grant licenses to use the patented mode or process is conferred upon the Commissioner of Patents.

I agree that ss. (2) could, as a matter of words, be construed to have only a partial application, limited to those cases in which the process itself is patented; but why, if under ss. (1) the process may be old, in the juxtaposition of the two subsections, the procedural benefit should not have been extended to the patentee of a substance restricted in production to an old process, has not been made apparent. I agree, also, that under ss. (3) a license for the process may be deemed to imply a license for the substance itself where that likewise is the subject of patent; but if the substance could be patented along with an old process, it would be a distortion of language to say that a license could issue for the substance alone and the declared purpose of the subsection would be defeated. In both cases we are asked to displace the ordinary meaning

of language by one that is to some degree strained and artificial; in each, it is an endeavour to show that the language used can support a presumed intention. But the intention of a legislature must be gathered from the language it has used and the task of construing that language is not to satisfy ourselves that as used it is adequate to an intention drawn from general considerations or to a purpose which might seem to be more reasonable or equitable than what the language in its ordinary or primary sense indicates.

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I would allow the appeal with costs in this Court.

*Appeal allowed with costs.*

Solicitors for the Appellant: *Ewart, Scott, Kelley & Howard.*

Solicitors for the Respondent: *Smart & Biggar.*

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