

METALLIFLEX LIMITED (*Defendant*) . . . APPELLANT;

AND

RODI & WIENENBERGER AKTIEN- }
GESELLSCHAFT (*Plaintiff*) } RESPONDENT.

1960
*Apr. 27,
28, 29
Dec. 19

ON APPEAL FROM THE COURT OF QUEEN’S BENCH, APPEAL
SIDE, PROVINCE OF QUEBEC

Patents—Alleged infringement—Patent claims—Whether specifications should also be considered—Injunction—Claims for damages.

The plaintiff brought action for an injunction and damages for an alleged infringement by the defendant of a patent relating to “extensible chain bands” for use as wrist-watch straps or bracelets, consisting of three parts: sleeves, U-shaped connecting bows and leaf springs. The embodiments of the invention were defined in 3 claims. The defendant pleaded that as the claims omitted the holding connection, the bracelet was an inoperative device, and alternatively, that there had been no infringement. The trial judge found that claims 1 and 2 were invalid

*PRESENT: Kerwin C.J. and Taschereau, Fauteux, Abbott and Judson JJ.

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for lack of utility and that claim 3 was valid but had not been infringed. The Court of Appeal reversed this judgment as to claims 1 and 2, the plaintiff having abandoned its demand based on claim 3. The defendant appealed to this Court.

Held: Claims 1 and 2 of the patent were valid and were infringed by the defendant.

Claims must be construed with reference to the entire specifications, but the patentee is not allowed to expand his monopoly specifically expressed in the claims by borrowing from other parts of the specifications. However, in the present case, the plaintiff was not seeking to enlarge or expand its monopoly by reference to the specifications, but referred to them to explain the obvious. The monopoly consisted of three elements, and the particular means by which the parts were to be held together was immaterial. The specifications proposed the use of a means, but it was not essential that it should be that particular one. As was held by the Court of Appeal, the device was operative and useful and the claims were, therefore, valid. There was in the invention, sufficient creative or inventive character and sufficient novelty to constitute the subject-matter of the patent, and it was infringed by the defendant.

APPEAL from a judgment of the Court of Queen's Bench, Appeal Side, Province of Quebec¹, reversing a judgment of Ralston J. Appeal dismissed.

G. F. Henderson, Q.C., J. R. Hoffman and D. Watson, for the defendant, appellant.

Christopher Robinson, Q.C., and S. Godinsky, for the plaintiff, respondent.

The judgment of the Court was delivered by

TASCHEREAU J.:—This is an appeal from the judgment of the Court of Queen's Bench of the Province of Quebec¹, reversing a judgment of the Superior Court rendered by Mr. Justice Ralston.

In its statement of claim the plaintiff-respondent alleges that it is the owner of a Canadian patent bearing no. 505,676, dated September 7, 1954, and that as such, had the exclusive rights, privilege and liberty of making, constructing, using, and selling to others to be used in Canada, an invention entitled "EXTENSIBLE CHAIN BANDS", and that the appellant-defendant has infringed its patent, by manufacturing and selling to others "Extensible Chain Bands" similar to those protected by its patent.

¹ [1960] Que. Q.B. 391, 32 C.P.R. 102.

The appellant-defendant pleaded that the patent of the respondent is invalid, and in the alternative, alleged that if the patent were valid, which is denied, the extensible chain bands which it manufactured and sold to the public are distinctive in all relevant elements both as to structure and function, from those designated in the limitative provisions of the three claims set forth in respondent's patent, hereafter recited at length, and do not constitute in any way an infringement of the distinctive features of the latter.

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The learned trial judge dismissed the plaintiff's action with costs, cancelled and annulled the interlocutory injunction previously granted by Associate Chief Justice W.B. Scott. Mr. Justice Ralston held that claims nos. 1 and 2, although not invalid for lack of invention and of novelty, were invalid for lack of utility, that consequently there could be no infringement thereof, and that claim no. 3, although valid, had not been infringed.

The Court of Queen's Bench allowed the appeal, declared that as between the parties claims nos. 1 and 2 of the Canadian patent no. 505,676 granted to the respondent were valid, and that they had been infringed by the appellant. The Court of Queen's Bench did not deal with respondent's demands based on claim no. 3, because they had been abandoned. The Court of Queen's Bench further ordered that the interlocutory injunction granted by the Superior Court of Montreal on December 13, 1956, be declared permanent, and that the defendant-appellant cease to manufacture, produce, import, buy or sell extensible chain bands similar to and in violation of plaintiff's patent and in particular, the "Bandmaster" or "Metalliflex" type of bracelets. The Court also condemned the present appellant to pay to the plaintiff the sum of \$551.05 as damages with costs.

The present action leading to this appeal, was instituted by the respondent in December 1956, and deals with patent no. 505,676 issued to the respondent on September 7, 1954.

After the issues were joined, the appellant filed a supplementary plea on September 30, 1957, alleging that in August 1957, the Commissioner of Patents issued in favour of the present appellant a patent bearing no. 545,184 which

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granted to the appellant the exclusive right, privilege and liberty of making, constructing, using and selling to others in Canada, its invention referred to in the patent.

When the present action was instituted, the plaintiff-respondent also sued Watchstraps Inc. for infringement of its patent (no. 505,676) and claimed \$27,795 in damages. It was then agreed that the evidence in one case would be evidence in the other. The trial judge dismissed the action against Metalliflex Ltd., but maintained it in part against Watchstraps Inc. There was an appeal to the Court of Queen's Bench in both cases, but the Watchstraps case did not proceed, and judgment was delivered only in the present case. As I have stated, the Court allowed the appeal, ordered that the interlocutory injunction granted by the Superior Court be declared permanent, and that the defendant Metalliflex cease to manufacture, produce, import, buy or sell "extensible chain bands" similar to and in violation of Rodi's patent and, in particular, the "Bandmaster" or "Metalliflex" type of bracelets. This Court is therefore not concerned with the case against Watchstraps Inc.

To summarize the course of this litigation: the Court of Queen's Bench reached the conclusion that claims 1 and 2 of respondent's patent were valid, not only as regards invention and novelty, but also as regards utility, and that Rodi's patent had been infringed. As to claim no. 3, it was held valid by the trial judge, who also came to the conclusion that it had not been infringed. In the Court of Queen's Bench, the appellant Rodi (now the respondent) abandoned the demand based on claim no. 3, and restricted its argument to claims 1 and 2, which it contended to be valid, and infringed by the appellant Metalliflex.

It might be useful to state the embodiments of the invention in which an exclusive property or privilege was *claimed*. They are defined as follows:

Claim No. 1. An extensible self-retracting chain band, comprising hollow links constituted by tubular sleeves arranged transversely to the longitudinal direction of the chain band in two series, pairs of connecting links constituted by U-shaped connecting bows arranged with one limb of each pair of bows in engagement with a hollow link of one series and the other limbs of said pair of bows in engagement with two links of the other series so as to connect the hollow links together in an articulated manner in two rows with the hollow links of one row of the retracted chain band staggered in the longitudinal direction of the chain band with respect to those of

the other row, the limbs of said connecting bows having a greater width than their thickness and co-operating with spring means arranged to hold the hollow links in the said relationship while permitting said links to be pulled apart to extend the chain band, said spring means comprising a leaf spring within each hollow link interposed between one wall thereof and the limbs of the connecting bows in engagement with the link so as to force the said limbs against the opposite wall of the link.

Claim No. 2. An extensible self-retracting chain band, comprising hollow links constituted by tubular sleeves arranged transversely to the longitudinal direction of the chain band in two series, pairs of connecting links constituted by U-shaped connecting bows the limbs of which are flat on the inside, said connecting bows being arranged with one limb of each pair of bows in engagement with a hollow link of one series and the other limbs of said pair of bows in engagement with two links of the other series so as to connect the hollow links together in an articulated manner in two rows with the hollow links of one row of the retracted chain band staggered in the longitudinal direction of the chain band with respect to those of the other row, and spring means arranged to hold the hollow links in the said relationship while permitting said links to be pulled apart to extend the chain band, said spring means comprising a leaf spring within each hollow link interposed between one wall thereof and the inside of the limbs of the connecting bows in engagement with the link so as to force the said limbs against the opposite wall of the link.

Claim No. 3. An extensible self-retracting chain band, comprising hollow links constituted by tubular sleeves arranged transversely to the longitudinal direction of the chain band in two series, pairs of connecting links constituted by U-shaped connecting bows on both sides of the chain band and arranged with one limb of each pair of bows in engagement with a hollow link of one series and the other limbs of each pair of bows in engagement with two links of the other series so as to connect the hollow links together in an articulated manner in two rows with the hollow links of one row of the retracted chain band staggered in the longitudinal direction of the chain band with respect to those of the other row, the limbs of said connecting bows having a greater width than their thickness and having transverse grooves on the inside, and spring means arranged to hold the hollow links in the said relationship while permitting said links to be pulled apart to extend the chain band, said spring means comprising a bent spring plate inserted in each hollow link and extending lengthwise thereof, said spring plate having bent up ends which engage in the transverse grooves in the limbs of the connecting bows on the respective sides of the chain band.

The construction of this bracelet is simple. It consists of three parts which are sleeves, U-shaped connecting bows and leaf springs, the arrangement of which provides a relatively cheap and simple bracelet. It can be more easily adjusted in length for different wrists than the other bracelets. It is said on behalf of the appellant that although claims 1 and 2 cover a combination, the elements of which are links, bows and springs, they omit the holding connection, with the consequence that the bracelet is an inoperative device, which must necessarily fall apart, and

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that the claims should therefore be held invalid as lacking utility. The respondent's contention is that claims 1 and 2 should be construed so that something to hold the parts in their specified relationship be included as part of the normal routine of a person setting out to construct the bracket. It has been also argued, and the Court of Queen's Bench has adopted this view, that it is not sufficient to consider only the wording of the claims, but also the whole specifications, which have been described as the "Dictionary" of the Claims.

The claims, of course, must be construed with reference to the entire specifications, and the latter may therefore be considered in order to assist in apprehending and construing a claim, but the patentee may not be allowed to expand his monopoly specifically expressed in the claims "by borrowing this or that gloss from other parts of the specifications". Vide: *Ingersoll Sergeant Drill Co. v. Consolidated Pneumatic Tool Co.*¹

But here, the respondent does not seek to enlarge or expand its monopoly by reference to the specifications, but refers to them to explain the obvious. The monopoly applied for is the combination of three elements, and the particular means by which the parts are to be held together is immaterial. The appellant does not claim a holding means. This, of course, may be effected in any practical way. In the specifications, a means proposed to be used by the respondent was disclosed, but it is not essential that it should be that particular one. It is beyond question that the parts have to be held together, but the means to attain that purpose and hold together the combination, which is the invention claimed in 1 and 2, is not material.

Thus, in *The King v. Uhlemann*², it was held that the claims to a spectacle construction were valid, although it was not specified how these straps "embracing" the edges of the lenses would maintain the embrace. Vide also: *Canadian Tire v. Samson*³. In this latter case, the claims spoke of blades carried by a hub without specifying any means to retain them in position during operation. In both cases the claims were held to be valid.

¹ (1907), 25 R.P.C. 61.

² [1952] 1 S.C.R. 143, 12 Fox Pat. C. 65, 15 C.P.R. 99.

³ [1940] S.C.R. 386, 3 D.L.R. 64.

I have, therefore, come to the conclusion, as did Mr. Justice Rinfret of the Court of Queen's Bench with whom Pratte and Owen JJ. concurred, that the device, which is the subject-matter of this case, is operative and useful and that, therefore, the claims are valid.

I also agree with the Court of Queen's Bench that there is in the invention, sufficient creative or inventive character and sufficient novelty to constitute the subject-matter of the patent, and that it has been infringed by the appellant.

The appeal should be dismissed with costs.

Appeal dismissed with costs.

Attorney for the defendant, appellant: Kaufman, Hoffman & Respitz, Montreal.

Attorneys for the plaintiff, respondent: Greenblatt, Godinsky & Kingstone, Montreal.

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