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*June 16, 17
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MERCO NORDSTROM VALVE COMPANY AND PEACOCK BROTHERS LIMITED (PLAINTIFFS) ..... APPELLANTS;

AND

J. F. COMER (DEFENDANT) ..... RESPONDENT.

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

Patent—Infringement—Invention of improvement in plug valves—Specification and claims limiting invention to improved method of attaining an old object—Monopoly limited to particular mode described—No infringement unless same thing taken and same result attained in substantially the same way.

Plaintiffs claimed that defendant had infringed their rights under a patent for an invention relating to an improvement in plug valves (used, e.g., in pipe lines) of the type in which lubrication of the bearing or seating surfaces of the valve is effected by forcing lubricant under pressure into the contact joint between the plug and the valve seat in the casing. An object of the invention was to provide the valve with a system of lubricating grooves of such arrangement as to prevent leakage, with the arrangement being such as to effect the cutting off from the supply of lubricant under pressure of any grooves becoming exposed to the line fluid when the plug was being turned.

Held: Plaintiffs' patent in suit and every claim therein were limited to a tapered plug valve, while defendant did not make use of a "tapered valve" but used a cylindrical valve; and that fact was sufficient, in view of the nature of the patent, to defeat the claim for infringement, as the principle of the valves was different; defendant's type of valve was entirely different from that of plaintiffs. On this ground, the dismissal of the action by Maclean J. ([1942] Ex. C.R. 138 and 156) was affirmed. (This Court also stated that "other material differences and distinctions in important particulars" might be pointed out between the methods adopted respectively in plaintiffs' patent and by defendant to accomplish their results).

The patented invention could not be said to consist in the discovery of a new principle or of a method of attaining a new result; the specification and the claims limited the invention to an improved method of attaining an old object. In such a case the monopoly is limited to the particular mode described (*Tweedale* v. *Ashworth,* 9 R.P.C. 121, at 128, and other cases, cited). The patentee was limited by the patent claims to the precise mechanism described and there could be no infringement unless defendant had taken the same thing and attained the same result in substantially the same way.

APPEAL by the plaintiffs from the judgment of Maclean J., late President of the Exchequer Court of Canada (1), dismissing their action, which was brought

*PRESENT:—Duff C.J. and Rinfret, Kerwin, Hudson and Taschereau JJ.

(1) [1942] Ex. C.R. 138 and 156; [1941] 2 D.L.R. 10, and [1942] 1 D.L.R. 316.

for relief (declaration of validity of patent, declaration of infringement, injunction, damages, etc.) because of alleged infringement of their rights under patent no. 270,557, dated May 10, 1927, granted to the plaintiff Merco Nordstrom Valve Company, assignee of Sven Johan Nordstrom, the inventor. The plaintiff Peacock Brothers Limited was the licensee of the plaintiff Merco Nordstrom Valve Company under the patent. The invention related to an improvement in plug valves (used, e.g., in pipe lines) of the type in which lubrication of the bearing or seating surfaces of the valve is effected by forcing lubricant under pressure into the contact joint between the plug and the valve seat in the casing. An object of the invention was to provide the valve with a system of lubricating grooves of such arrangement as to prevent leakage, with the arrangement being such as to effect the cutting off from the supply of lubricant under pressure of any grooves becoming exposed to the line fluid when the plug was being turned.

Maclean J. held that there had been no infringement, and further held that, as between the parties, the patent was invalid for want of invention. (This latter question is not dealt with in the judgment of this Court, now reported, the dismissal of the action being affirmed on the ground of non-infringement).

R. S. Smart K.C. and *E. L. Medcalf* for the appellants.

E. G. Gowling and *G. F. Henderson* for the respondent.

The judgment of the Court was delivered by

RINFRET, J.—This is an action alleging that the respondent has infringed the rights of the appellants under Canadian Patent No. 270557, dated May 10th, 1927, for an invention of one Sven Johan Nordstrom relating to valves.

The learned President of the Exchequer Court of Canada dismissed the action on the ground that the appellants' patent was invalid, null and void as between the parties, and further that there had been no infringement on the part of the respondent.

The patent relates to a pipe line valve of the plug type, comprising a casing which is connected into a pipe line and has passages forming a continuation of the pipe line and a

1943

MERCO NORDSTROM VALVE CO. ET AL. v. COMER

Rinfret J.

round plug inserted in the casing, with its axis at right angle to the line or passages for closing or stopping flow through the line.

In the specification, the invention is described as being an improvement in valves, and more particularly an improvement in plug valves of the type in which lubrication of the bearing or seating surfaces of the valve is effected by forcing lubricant under pressure into the contact joint between the plug and the valve seat in the casing.

The claims are five in number. It is not necessary to reproduce each of them, as they are rather lengthy. Claim No. 4 may be chosen as typical. It reads as follows:

> A valve comprising, a casing having a passageway therethrough and a tapered valve seat formed transversely of the passageway, a tapered plug seated in the valve seat and having a hole adapted to register with the passageway, longitudinal and transverse grooves in the seating surface of the valve arranged to form when the plug is in either its closed or open position two diametrically opposed closed circuit grooves, and means for introducing a plastic substance under presssure into the grooves, the longitudinal grooves being so arranged that they are only supplied with lubricant under pressure when they are not exposed to the fluid passing through the valve, but are cut off from the supply of lubricant under pressure when they are exposed to the fluid passing through the valve.

It is important to notice that in each of the claims the invention is referred to as having "a tapered valve seat formed transversely of the passageway, a tapered plug seated in the valve seat", etc.

The respondent does not make use of a "tapered valve," but uses a cylindrical valve; and, in my opinion, in view of the nature of the patent in suit, this is sufficient to defeat the claim for infringement, as the principle of the two valves is different.

Nordstrom's invention can certainly not be said to consist in the discovery of a new principle or of a method of attaining a new result. The specification and the claims limit the invention to an improved method of attaining an old object. In such a case, the monopoly is limited to the particular mode described (*British United Shoe Machinery Company Ltd.* v. *A. Fussell & Sons Ltd.* (1); *Clarke* v. *Adie* (2); *Curtis* v. *Platt* (3); *Gillette Safety Razor Co. of Canada, Ltd.* v. *Pal Blade Corporation, Ltd.* (4)).

(1) (1908) 25 R.P.C. 631.
(2) (1877) 2 App. Cas. 315.
(3) (1863) 3 Ch.D. 135 (note).
(4) [1933] S.C.R. 142, at 150.

As was stated by Lord Watson, in *Tweedale* v. *Ashworth* (1),

> The plain object of the invention as described in the Specification is to substitute better mechanical equivalents for those already known and used as a means to the same end. It follows that, in construing the Appellant's Specification, the doctrine of mechanical equivalents must be left out of view. He cannot bring within the scope of his invention any mechanical equivalent which he has not specifically described and claimed.

A similar observation was made by Lord Davey in *Consolidated Car Heating Company* v. *Came* (2).

I agree, therefore, with the learned President, when he says, in his judgment:

> Nordstrom is limited by his claims to the precise mechanism described and he must abide by the result of his limitation, and there can be no infringement unless the defendant has taken the same thing and attains the same result in substantially the same way.

The appellants' patent, and every claim therein, are limited to a tapered plug valve. The type of valve of the respondent is entirely different.

In relation to this point, I may refer to the cross-examination of Matheson, an engineer of the appellant company:

> Q. Does your own company not make a close distinction between a tapered and cylindrical valve?—A. Certainly. We are not now making any cylindrical valve.
>
> Q. But would you not make a distinction in referring to the two types of valves?—A. Yes. We and our engineers talking between ourselves certainly make a distinction as well as we do to other mechanical details.
>
> Q. How would you classify the defendant's valve; as a cylindrical or tapered valve?—A. It is for practical purposes a cylindrical valve even though some specimens might show a slight taper.
>
> Q. The taper to which you referred showed a little over 1/1000 inch? —A. Yes.
>
> Q. Did the taper vary in the different valves you measured?—A. The other ones I examined—some other two sizes, I did not have any taper measuring instrument to use.
>
> His LORDSHIP: Are you suggesting there is a distinction between a cylindrical and tapered valve?
>
> Mr. GOWLING: Yes, my Lord.
>
> His LORDSHIP: Other than a patentable distinction?
>
> Mr. GOWLING: Yes sir. That is one of our main defences to the action, my Lord.

It appears by the evidence that the appellants have manufactured and sold, as well as taken patents on, both valves; but they have decided to sue the respondent on a patent which is specifically limited to a tapered valve.

(1) (1892) 9 R.P.C. 121, at 128. (2) [1903] A.C. 509 at 516-518.

1943

MERCO NORDSTROM VALVE CO. ET AL. v. COMER

Rinfret J.

Other material differences and distinctions in important particulars may be pointed out between the two methods adopted respectively in the appellants' patent and by the respondent to accomplish their results; but, from the viewpoint of infringement, the fundamental difference between the precise mechanism described in Nordstrom's claims and the means adopted by the respondent is, in my opinion, sufficient to dismiss the contention that Patent No. 270,557 has been and is being infringed by the respondent.

The above conclusion disposes of the appellants' action; and I do not find it necessary to decide whether, as between the parties, the letters patent of the appellants are valid. On that point, I express no opinion, so far as the present case is concerned.

The appeal should be dismissed with costs.

Appeal dismissed with costs.

Solicitors for the appellants: *Smart & Biggar.*

Solicitors for the respondent: *Herridge, Gowling, MacTavish & Watt.*