

THE SMITH INCUBATOR COM-
PANY (PLAINTIFF)

}

APPELLANT;

AND

ALBERT SEILING (DEFENDANT).....

RESPONDENT.

1936
* Nov. 17.

1937
* Mar. 19.

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

Patent—Validity—Claims—Construction of claims—Determining scope of patent monopoly—Matter embraced in the claims—Specification—Infringement.

The action was for damages, etc., for alleged infringement of the same patent that was considered in the judgment of this Court in *The King v. Smith Incubator Co. et al.*, ante, p. , and, so far as it applied, the evidence in that case was made part of the evidence in the present case.

Held: The issue as to the validity of the plaintiff's patent must follow the decision, against the validity of the patent, in *The King v. Smith Incubator Co. et al.*, supra, and on this ground the plaintiff's appeal (from the judgment of Angers J. in the Exchequer Court of Canada, dismissing the action on the ground of no infringement) must be dismissed.

* PRESENT:—Duff C.J. and Rinfret, Davis, Kerwin and Hudson JJ.
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The claims at the end of the specification in a patent must be regarded as definitely determining the scope of the patent monopoly, having regard to the due and proper construction of the expressions they contain. They must be construed in the light of the rest of the specification; that is to say, the specification must be considered in order to assist in comprehending and construing the meaning—and possibly the special meaning—in which the words or the expressions contained in the claims are used; but, on the issue either of validity or of infringement, the criterion must be determined according to the scope of the monopoly as expressed in the claims (though it is not necessary, to justify a holding of infringement, that the infringing article be found identically, or in every respect, the same as the patented article; it is sufficient if the infringer has borrowed the substance or spirit of the invention as it can be ascertained from the claims, except in details which could be varied without detriment to the successful working of it).

Discussion by Duff C.J. with regard to pertinent principles as to the requisites of a specification, the construction of claims, what constitutes the essence of infringement, and grounds on which a plaintiff in an action for alleged infringement may fail, having regard to the claims or to the specification as a whole. References to authorities. It was pointed out that, in construing and applying judgments on such subjects, it is important that the judgment be read as a whole, and, still more, that it be read in light of the issues of fact and questions of law to which the judge is addressing himself.

APPEAL by the plaintiff from the judgment of Angers J. in the Exchequer Court of Canada (1) dismissing its action. The action was for a declaration, injunction, etc., and damages for alleged infringement of plaintiff's rights under certain letters patent for alleged new and useful improvements in incubators. Angers J. dismissed the action on the ground that there was no infringement. By the judgment now reported, this Court dismissed the plaintiff's appeal on the ground of invalidity of the patent, in accordance with its decision in *The King v. The Smith Incubator Co. et al.* (2) dealing with the same patent.

O. M. Biggar K.C. and *R. S. Smart K.C.* for the appellant.
E. G. Gowling for the respondent.

DUFF C.J.—I am in complete agreement with Mr. Justice Rinfret in his reasons for judgment in *The King v. Smith Incubator Co.* (2) and in the present appeal in which I have formally concurred, as well as with those of Mr. Justice Davis in *B.V.D. Co. Ltd. v. Canadian Celanese, Ltd.* (3), with which I have also formally concurred; but, having regard to the judgment of the learned trial judge now under

(1) A note thereof is in [1936] Ex. C.R. at p. 114.

(2) *Ante*, p. 238.

(3) *Ante*, p. 221.

review, as well as to some of the observations in the factums of the appellants and the respondent in the same case, I think it advisable to say something touching upon the pertinent principles in respect of the construction of the claims as well as upon what constitutes the essence of infringement; although what I have to say on the former topic more fully appears in the judgments delivered by Mr. Justice Rinfret and Mr. Justice Davis in behalf of the Court in the above-mentioned appeals.

First of all, it is convenient to cite some passages from Hindmarch on Patents (Edition 1846) (p. *157):

The patentee is required to enrol a specification of his invention, because the public is entitled to know what the patent has been granted for, what they are prohibited from doing during the existence of the patent privilege, and what they are to become entitled to when it expires, as the consideration for the grant which has been made by the Crown on their behalf.

He then proceeds to enlarge on this general statement thus:

The vague description of an invention in the title of it contained in a patent, gives little if any notice to the public of the real nature of the manufacture they are prohibited from using, and unless some specific information were to be given to persons respecting what they are commanded by the patent to refrain from doing, they could not be punished for any violation of the patent right committed in ignorance of its nature and extent.

Whenever therefore an action is brought against a party for infringing a patent, in order to ascertain whether he is guilty of an infringement or not, it is necessary to ascertain whether the thing which is complained of as a contravention of the patent, is really or substantially described in the patentee's specification, as the whole or part of the invention for which the patent was granted. And if the specification does not sufficiently describe some art of manufacturing which is substantially the same as that used by the party charged with the infringement, no action can be maintained against him for such an alleged violation of the patent privilege.

In the case of *Morgan v. Seaward*, Mr. Baron Alderson (1) held that the patentee ought to state in his specification the precise way of doing every thing which is part of his invention; and that if any thing cannot be completely done by following the specification, then a person will not infringe the patent by doing it.

Again the author proceeds at page *161:

2. The patentee must in his specification make a full and complete disclosure of the nature of his invention, and of the manner in which it is to be performed.

* * *

In considering the requisites of a specification, it is necessary to have regard not only to the words of the proviso in the patent, but also to the object with which a specification is required, and which has already been mentioned, viz: *the furnishing of sufficient and certain information to the public respecting what they are prohibited from doing whilst the*

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privilege continues, and what they will be enabled to do after it is expired. [p. *159]

* * *

6. When an inventor applies for his patent, he describes the nature of his invention in general terms, and it is to be presumed, in the absence of any thing to show the contrary, that he has contracted to give the public the whole of his discovery, and all his knowledge on the subject, as the consideration for the privilege granted to him by the Crown. It is indeed absolutely essential for the protection of the public, that this rule should be adopted and acted upon, for patentees would otherwise be enabled to commit great frauds, by concealing the most important parts of their inventions.

The specification must therefore describe the invention according to the best of the patentee's knowledge. [pp. *165-6.]

Subject to one observation, I think, these passages are entirely in accord with the law under the modern statutes. The observation (which has no relevancy to the present appeal) is this: the words of the author at page *157 do not, in terms at all events, make allowance for cases in which precisely detailed instructions in relation to the manner in which the invention is to be put into effect, touching, for example, proportions and dimensions, might unduly limit the scope of the protection to which the patentee is entitled and where the information that would be given by such precise instructions would, through his own skill and knowledge be at the command of a competent practitioner in the art with which the invention is concerned, without the necessity of exercising invention (*British Thomson-Houston Co. Ltd. v. Corona Lamp Works Ltd.* (1)).

While the duties set forth in these passages of Hindmarch on Patents still rest upon patentees, a further duty is imposed upon them by the modern statutes. Section 14 (1) of the Canadian Act is in these terms:

14. (1) The specification shall

(a) correctly and fully describe the invention and its operation or use as contemplated by the inventor;

(b) set forth clearly the various steps in a process, or the method of constructing, making or compounding, a machine, manufacture, or composition of matter;

(c) end with a claim or claims stating distinctly the things or combinations which the applicant regards as new and in which he claims an exclusive property and privilege.

I think the general effect of this subsection is stated by Lord Halsbury, who himself was the author of the treatise

on "Patents" in the first edition of Halbury's Laws of England, in paragraph 338 of that treatise in these words:

338. In order that the public may have sufficient and certain information respecting what they are prohibited from doing whilst the privilege continues, the patentee must particularly describe and ascertain the nature of his invention. In order that, after the privilege is expired, the public may be enabled to do what the patentee has invented, he must particularly describe and ascertain the manner in which the same is to be performed; and the ambit of his invention must be circumscribed by definite claims.

But there is something more to be said about the effect of clause (c) in the subsection of the *Patent Act* quoted above. To use Lord Halsbury's language, that clause requires that the ambit of the invention must be circumscribed by a claim or claims at the end of the specification. It is to these claims that the public are entitled to look in order to ascertain the limits of the monopoly granted to the patentee, and unless these limits are prescribed distinctly in the claims themselves, without unnecessary ambiguity, vagueness or obscurity, having regard to the nature of the subject-matter, the patentee can found no title to relief upon his patent in respect of any alleged infringement; nor can he, assuming that the claims are not objectionable on the ground of ambiguity, vagueness or obscurity, obtain any title to relief in respect of any act which does not infringe the monopoly marked out by the claims when properly read. Where, moreover, as in the two cases mentioned at the outset, a claim so read embraces matter which is old in the sense of the patent law, the claim is invalid.

It is now settled law that, for the purpose of ascertaining the meaning of the claims, the language in which they are expressed must be read in light of the specification as a whole, but it is by the effect of the language employed in the claims themselves, interpreted with such aid as may properly be derived from the other parts of the specification, that the scope of the monopoly is to be determined. This, I think, is best put in a passage at the end of Lord Loreburn's judgment in *Ingersoll Sergeant Drill Co. v. Consolidated Pneumatic Tool Co. Ltd.* (1). There is a passage at the beginning of the judgment which is well known and which I do not quote, but the following passage, which is quoted in the complete statement of authorities on this

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(1) (1907) 25 R.P.C. 61, at 83-84.

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point by Mr. Justice Davis, indicates very clearly the manner in which the principle was applied:

According to Mr. Bousfield, the piston means the piston with the circumferential groove and projecting stem described on page 3 of the specification, or as altered in accordance therewith. The piston chamber also, it seems, means one complying with the description on page 2 of the specification. So as regards the passages, because the specification at page 4 describes the two passages as opening into the piston chamber at about the same point in its length, the claim must also, we are told, be read as conveying that they are to be at about the same point. Again, because, at page 6, the specification informs us that the rearward movement of the piston closes both the passages, we are to read that also into the claim. And the reason urged for so qualifying the language of the claim is that these things are essential to the success of the plaintiffs' hammer as a working hammer. That would have been a very good reason for inserting them expressly or by plain reference in the claim had it been thought safe or wise to do so, but is no reason at all for reading them into the claim when they are not there. One or two more glosses are sought to be added by Mr. Bousfield, but they are all on the same footing and need not further be discussed.

Mr. Walter put it a little differently. He attributed a very special meaning to the words "independently of the piston," and said they were put in to show that no part of the live air passage is to be in the piston, meaning by the live air passage the whole distance from the source of supply to the valve. All I can say of this is that I can extract nothing of the kind out of the words used, even when illuminated by the rest of the specification.

Accordingly it comes to this. We are asked to construe the claim with reference to the specification, not in order to understand what the former says, but to make it say things which in fact it does not say at all.

If such a process were admitted all certainty would vanish. No one in construing a claim would know how far he could rely on the words used or how to pick from the specification the qualifying phrases. Patents are not unconditional grants of a monopoly. The patentee must, in return for his privilege, say plainly what is the invention for which he asks protection, so that others may learn that and its limits. And if he chooses separately to claim a subordinate invention he must make plain the metes and bounds of that also. I think the patentee has made it plain in claim 13, if it be fairly construed, and there is no novelty if the interpretation be as I think it is.

Lord Haldane's judgment in *British Thomson-Houston Co. Ltd. v. Corona Lamp Works Ltd.* (*supra*) (1) at page 67, affords an illustration of the manner in which expressions used in the claim may be interpreted by reference to the body of the specification. *Western Electric Co. Inc. v. Baldwin International Radio of Canada* (2) is another case in which the description in the body of the specification of the invention provided a lexicon interpreting the phrases in the claim.

But, while the plaintiff in an action for infringement must fail unless he can prove an invasion of the monopoly delimited by the claim so construed, it is equally true that he may fail on the broad ground that the defendant has not taken any part of any invention in respect of which the specification "fully describes the invention and its operation or use as contemplated by the inventor," or any "process" of which the specification "sets forth clearly the various steps," or any "machine, manufacture, or composition of matter" of which the specification "sets forth clearly * * * the method of constructing, making or compounding." That such things shall be "correctly and fully" described or "set forth clearly," as the case may be, is just as essential, by force of clauses (a) and (b), to enable the patentee to protect himself against alleged infringements as is compliance with clause (c) which relates to claims only.

The court, called upon to deal with the issues in an action for infringement, may find it quite unnecessary to apply itself to the construction of the claims for the purpose of ascertaining the limits of the monopoly defined by the claims, because it is plain on the face of the specification as a whole that, on any construction of the claims, the defendant has not taken any part of any invention properly described and set forth pursuant to the requirements of section 14.

Then, the defendant may attack the specification on the ground that the monopoly delimited in the claims relates to an invention which, on the specification as a whole, is not the thing invented by the patentee. He may say that though the patentee has described in the body of his specification an invention and the manner of its working, yet his claim or claims relate to a different invention which is not fully described and set forth in the specification as a whole or in any part of it within the meaning of section 14. Obviously, the plaintiff may fail on the ground, either that the patent is invalid because of non-observance of the conditions of section 14, or that the alleged infringement does not invade the monopoly defined, or because the defendant has not taken any part of the only invention fully set forth and described in the specification, in compliance with section 14.

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The action may be defeated on (*inter alia*) any one of these grounds, and the tribunal, which is not under any obligation to write a treatise upon, or an exposition of, patent law or of any branch of patent law, will, in the ordinary course, confine itself to a discussion of the particular ground upon which it is proceeding. Hence, the importance, in construing and applying judgments on such subjects, of reading the judgment as a whole, and, still more, of reading the judgment in light of the issues of fact and questions of law to which the judge is addressing himself.

It may be that the statutory provision requiring the definition of the ambit of the monopoly claimed to be given in claims at the end of the specification has, in greater or less degree, affected in practice the application of some doctrines of patent law, such as the doctrine of mechanical equivalents and, indeed, the application of the general principle that infringement consists in taking the substance of the plaintiff's invention; but there is no good ground for a conclusion that these doctrines have been abrogated. *Electrolier Manufacturing Co. Ltd. v. Dominion Manufacturers Ltd.* (1) is a recent illustration of the proper application of the rule that, where the essence of the invention is taken, an action for infringement is not defeated by reason of the fact that the infringing structure discloses some "small variation in unimportant features or in non-essential elements."

RINFRET J. (All other members of the Court concurring)—This is an appeal from the judgment of the Honourable Mr. Justice Angers, in the Exchequer Court of Canada, dated the 29th day of January, 1936, dismissing the appellant's action for an injunction and damages for the infringement of its patent no. 217,777. The patent involved is the same as was considered in the judgment of this Court in the case of *His Majesty the King v. Smith Incubator Company* (2) delivered at the same time as the present judgment.

So far as it applied, the whole of the evidence in the former case was made part of the evidence in the present case. The issue in respect of the validity of the appel-

(1) [1934] S.C.R. 436.

(2) *Ante*, p. 238.

lant's patent must, therefore, follow the decision in *The King v. Smith Incubator Company* (1).

In his judgment, the learned trial judge in this case did not pass upon the validity of the patent already upheld by him in the judgment in the other case. But, having formally held that

the only element of novelty in the Smith patent, as set forth in the [former] case, is the method of circulating the hot air in the incubator and the method of turning the eggs periodically during the incubation process,

he found that the method in this respect used by the defendant was quite different; and, accordingly, he failed to see any infringement by the respondent.

The Smith patent having been held invalid by our judgment (1), delivered upon the information of the Attorney-General of Canada, it becomes unnecessary for us to pass upon the issue of infringement. It should only be stated that the respondent Seiling himself holds a patent covering his incubator (Canadian Patent no. 310,061); and, had there been occasion for it, we would not have been prepared to decide that his patent infringes that of the appellant.

However, for the reasons already stated in *The King v. Smith Incubator Company* (1), patent no. 217,777 must be declared invalid and void and must be set aside. As the patent is the only ground upon which the appellant can claim infringement, the foundation for his action is thereby removed; and we must decide, therefore, that the action was rightly dismissed by the learned trial judge.

In view of this result, there remains no longer any necessity of discussing at length the appellant's contention that:

There are two separate lines of authority suggesting what are * * * mutually inconsistent attitudes towards * * * the definition of the scope of a patent monopoly in the patent claims.

The appellant proceeds:

According to one of these it is proper to consider what is "the pith and substance" or the "spirit" of the invention and to give effect to the patent accordingly. The other is to regard the claims as definitely determining the scope of the monopoly which the patent purports to grant and to give or refuse them effect according to the expressions they contain when these expressions are properly construed and their meaning determined.

In our view, the rule is that the claims must be regarded as definitely determining the scope of the monopoly, hav-

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ing regard to the due and proper construction of the expressions they contain. Such was the direction given and the rule followed by this Court in *Mailman v. Gillette* (1); *Gillette v. Pal* (2); *Burt v. Autographic* (3); and *Schweyer v. New York Central* (4). And, notwithstanding the suggestion to the contrary, such was also the rule applied in *Electrolier v. Dominion Manufacturers* (5).

As often observed, of course, the claims must be construed in the light of the rest of the specification; and that is to say, that the specification must be considered in order to assist in comprehending and construing the meaning—and possibly the special meaning—in which the words or the expressions contained in the claims are used (*Ingersoll v. Consolidated* (6)). But, as was said in the *Electrolier case* (7),

infringement is a matter depending on the construction of the claims, for there it is that the inventor is required to state “the things or combinations * * * in which he claims an exclusive property and privilege.”

Generally speaking, actions for infringement are met with two distinct defences: one being that the plaintiff's patent is invalid; the other being that, whether the plaintiff's patent is invalid or not, the defendant does not infringe. And it may be that, to borrow the words of Frost (*Patent Law and Practice*, 4th Ed., Vol. 1, p. 349), “the criterion of novelty and infringement in this respect are not the same.” But, in each case, the criterion must be determined according to the scope of the monopoly as expressed in the claims; although it is not necessary, to justify a holding of infringement, that the infringing article should be found identically, or in every respect, the same as the plaintiff's patented article. It is sufficient if the infringer has borrowed the substance or spirit of the invention as it can be ascertained from the claims, except in details which could be varied without detriment to the successful working of it.

The appeal is dismissed with costs.

Appeal dismissed with costs.

Solicitors for the appellant: *Smart & Biggar*.

Solicitors for the respondent: *Riddell & Murray*.

(1) [1932] S.C.R. 724.

(2) [1933] S.C.R. 142.

(3) [1933] S.C.R. 230.

(4) [1935] S.C.R. 665.

(5) [1934] S.C.R. 436.

(6) (1907) 25 R.P.C. 61, at 82-83 (H.L.).

(7) [1934] S.C.R. 436, at 442.