
1937
 * May 6, 7.
 * June 1.

IMPERIAL TOBACCO COMPANY OF }
 CANADA LTD. AND WM. WRIGLEY } APPELLANTS;
 JR. COMPANY LTD. (PLAINTIFFS)... }

AND

ROCK CITY TOBACCO COMPANY }
 LTD. (DEFENDANT) } RESPONDENT.

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

Patent—Validity—Subject-matter—Prior art.

Plaintiffs sued because of alleged infringement of two patents, relating to means for conveniently removing wrappers (particularly of cellophane) from small packages of such articles as cigarettes and chewing gum, the alleged invention consisting in the combination of the wrapping material and a tearing strip or ribbon of the same material, though in a different colour, affixed to the wrapper, and a tab or tongue com-

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

posed of a little piece of the wrapper and ribbon, the effect of the arrangement being that when the tab is grasped the wrapper proper is readily torn and may conveniently be removed from the package.

Held: The patents were invalid for lack of subject-matter—the general idea of the alleged invention was old and, as to the means employed, it was reasonably clear that a person competently skilled in the art of devising wrappers for packages to be placed on the market for sale and faced with the problem presented could hardly fail, on reverting to the devices and methods employed in the prior art and publications, to hit upon the use of the ribbon and the tab; any difference that might exist between the patents sued upon and the disclosure in a certain prior (British) patent (Boyd) particularly referred to, was so trifling as to be of no substance in a patent sense.

Judgment of Maclean, J., President of the Exchequer Court of Canada, [1936] Ex. C.R. 229, dismissing the action, affirmed in the result.

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APPEAL by the plaintiffs from the judgment of Maclean J., President of the Exchequer Court of Canada (1), dismissing the action, which was brought for an injunction, damages, etc., by reason of alleged infringement of two patents. The material facts of the case are sufficiently stated in the judgment now reported. The appeal to this Court was dismissed with costs.

R. S. Smart K.C. for the appellants.

A. Taschereau K.C. and *J. T. Richard* for the respondent.

The judgment of the court was delivered by

DAVIS J.—This is an appeal from the judgment of the President of the Exchequer Court of Canada (1) which dismissed the appellants' action against the respondent for infringement of two patents, one no. 349,299, issued to the appellant Imperial Tobacco Company of Canada, Limited, April 2, 1935, on the application of one Van Sickels, and the other, no. 349,983, issued to the appellant Wm. Wrigley Jr. Company Limited, April 30, 1935, on the application of one Lindsey and under which patent the appellant Imperial Tobacco Company holds an exclusive licence in respect of the sale of tobacco in any form.

Both patents provide means for conveniently removing wrappers from small packages of such articles as cigarettes and chewing gum. There is a very slight difference between the patents. The alleged invention consists in the combination of the wrapping material and a tearing strip or ribbon of the same material, though in a different colour,

(1) [1936] Ex. C.R. 229; [1937] 2 D.L.R. 11.

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affixed to the wrapper, and a tab or tongue composed of a little piece of the wrapper and ribbon. In the Lindsey patent the tab projects from one side of the package. In the Van Sickels patent the tab, instead of projecting, is formed by two small slits cut into the wrapper, one on each side of the ribbon. In both patents the effect of the arrangement is that when the tab is grasped the wrapper proper is readily torn and may conveniently be removed from the package.

For the purposes of this litigation counsel for the appellants treats the patents as relating to small packages that are wrapped in cellophane instead of in paper. Cellophane, so far as the record shows, is a trade name for a grainless, transparent, moisture-proof material made of regenerated cellulose that has become of popular use as a wrapping material. This material exhibits great tenacity against rupture, but, when once a break has been made in it, it tears very readily, though in all directions. A small package of chewing gum or cigarettes that has been wrapped in cellophane and sealed offers considerable resistance to any effort of the fingers to open it, and the patents in question are alleged to disclose a new and useful device for assisting in the breaking open of such a package.

The respondent denies the validity of the patents upon the ground of lack of subject-matter and upon the ground of anticipation and alleges that in any event it has not infringed. Its cigarettes are sold in small packages wrapped in cellophane with a ribbon tab flush with the outer edge and with a slit in the wrapper along the edge of the ribbon. In the view we take of the appeal, it will be unnecessary for us to consider the question of infringement.

The appellants support the patents upon the ground of combination—the combination of the cellophane wrapper, the ribbon and the tab. Considering the patents as if they were limited in their claims to the use of cellophane as the wrapping material, which is the basis upon which the action has been fought out (although the claims are broad enough to cover a wrapper of any readily tearable material), the combination has artistic advantage and undoubtedly is attractive to purchasers of chewing gum and cigarettes. Packages wrapped according to the Lindsey patent were not put on the market in Canada by the Wrigley Company

until July, 1934, and by the time of the trial of this action in March, 1936, the company had wrapped in Canada over eighty millions of packages in this manner, and the Imperial Tobacco Company had up to the date of the trial used two hundred and sixteen millions of wrappers of the type shown in the Van Sickels patent. Though no evidence was directed to show any increase in the sales of these well-known products attributable to the use of the new wrapper, it may be assumed that there was some commercial advantage in the adoption of the idea.

The result sought to be attained through the combination is the convenient removal of the cellophane wrapper. If, however, the use of the ribbon is eliminated, the learned trial judge has assumed, and the evidence rather points to the conclusion, that the use of the tab alone would enable one to rupture the wrapper. Then the problem to which the alleged invention is addressed, viz., to make use of cellophane as a wrapper in such a manner as to avoid the difficulty of rupturing it with the fingers, with consequent irritation and annoyance to the customer, ceases to be a problem. The rupture having been effected, the wrapper can easily be removed with the fingers. In answer to this, it is said that the presence of the ribbon enables one to tear the wrapper in a straight line. This unquestionably is a neater method of unwrapping a package but if it be the sole advantage to be derived from the combination of the ribbon with the tab, as distinguished from the use of the tab alone which is not claimed as invention in the patents sued upon and was admittedly old, it is difficult (since, as we shall proceed to point out, the general idea of the alleged invention was not new) to regard the combination of the ribbon and the tab as producing an improved result of sufficient substance to establish invention.

However that may be, the general idea of the appellants, it is admitted, does not differ from that exemplified by the old, well-known method of tearing open a package of cigarettes wrapped in paper by the use of a string attached to the inside of the paper wrapper with a loose end projecting from it. Then, as to the means employed, it would appear to be reasonably clear that a person who was competently skilled in the art of devising wrappers for packages to be placed on the market for sale, and who was confronted

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with the problem that the witness Thomas says presented itself to the patentees, could hardly fail, on reverting to the devices and methods employed in the prior art and to the publications disclosed in the exhibits, to hit upon the use of the ribbon and the tab as providing an easy solution for that problem. Reference need only be made to the Boyd patent (British no. 8873—1901). That was an improvement in wrappers. Boyd used “a tape or ribbon of any suitable material, one end of which may or may not extend slightly beyond the end of the sheet” of paper or of other material suitable for wrapping. The tape or ribbon was by means of an adhesive sealed to the wrapper.

Before covers or wrappers are put round articles to be protected a slit or notch should be made on them on each side of the end of the tape or ribbon unless such tape or ribbon extends slightly beyond one end of the covers or wrappers * * * This enables any one to take hold of the tape or ribbon and by pulling it to open covers or wrappers instantly without the slightest difficulty and without injury to goods covered.

But it is contended by counsel for the appellants that the evidence establishes that the idea of the combination claimed was only hit upon after investigation and experiment extending over a year. Neither of the inventors was called as a witness and Thomas, the sole witness who was called in support of this allegation of fact, had, apparently, as the learned trial judge thought, no personal knowledge of any such investigations or experiments. We agree with the learned trial judge in his conclusion that the evidence adduced by the appellants upon this point is not satisfactory.

If the patents sued upon are not the identical thing disclosed in the Boyd patent, the difference is so trifling as to be of no substance in a patent sense.

The appeal should be dismissed with costs.

Appeal dismissed with costs.

Solicitors for the appellants: *Smart & Biggar.*

Solicitor for the respondent: *J. T. Richard.*
