

THE P. & M. COMPANY AND ANOTHER (PLAINTIFFS)	} APPELLANTS;
AND	
CANADA MACHINERY CORPORATION LIMITED AND OTHERS (DEFENDANTS)	} RESPONDENTS.

1925

*June 12, 13.
*Oct. 6.

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

Patent—Infringement—Railroad rails—Anti-creeping devices—Claim and specifications—Construction—Defence—Want of definitiveness—Anticipation.

The appellants (plaintiffs) had a patent for an anti-creeping rail device, which, as they alleged, had been infringed by the respondents (defendants), who had, subsequently to the appellants' patent, manufactured and used, in Canada, a rail anchor which, it was urged, embodied the principle of the appellants' patent. Before the appellants' patent, various contrivances had been devised and used for the prevention of creeping, usually in the form of a stay or brace between the rail and the sleeper. A favourite method of applying this mode of resistance, and which had been tried in different forms and under various patents, was by means of a cross bolt or yoke, underlying the rail, bent at either end to engage on each side with the base of the rail and kept in position by a wedge inserted on one side between the yoke and the rail, a part of the contrivance extending downwards perpendicularly to form an abutment designed to press against the contiguous sleeper and thus to overcome the creeping. The invention which was the subject of the appellants' patent consisted of a steel yoke or cross-bar in principle and not unlike those which were known and had been tried before, but, instead of a wedge for securing the apparatus to the rail, it made use of a locking device which was worked by means of torsion of the steel yoke. The device manufactured and used by the respondents, which was alleged to infringe, was of the wedge variety, the wedge being so formed that when driven into place the yoke was sprung into holding position. It was contended by the appellants that the respondents' device depended for its efficiency upon the torsion, spring or recoil of the steel yoke and that it therefore constituted an infringement.

Held, that the appellants' invention was one of mechanical detail, that the characteristic of the steel bar when sprung or twisted to resume its normal position was not the discovery of the appellants' patentees, who merely made use of a well known quality of the metal for bringing about the particular result in the specified manner; that while, if a new principle be discovered, the court will regard jealously any other method embodying that principle, yet where, as in this case, the invention consists in a particular new method of applying a well known principle, the use of other methods is not contemplated by the patentee, and that these do not fall within the ambit of the claim.

Judgment of the Exchequer Court of Canada ([1925] Ex. C.R. 47) affirmed.

*PRESENT:—Anglin C.J.C. and Duff, Mignault, Newcombe and Rinfret JJ.

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APPEAL from a decision of the Exchequer Court of Canada (1), dismissing the appellants' action involving a charge of infringement of their patent by the respondents.

The material facts of the case and the questions at issue are fully stated in the above head-note and in the judgment now reported.

Anglin K.C. and *Cassels* for the appellants.

Wilkie K.C. and *Gibson* for the respondents.

The judgment of the court was delivered by

NEWCOMBE J.—By letters patent of Canada, numbered 122, 715, of 21st December, 1909, there was granted to David Fisher Vaughan and David Lawrence Vaughan, of Riverton, New Jersey, the exclusive right, privilege and liberty of making, constructing, using, and vending to others, to be used in the Dominion of Canada, an alleged new and useful improvement in anti-creeping devices for railroad rails, a description of which is contained in the specification and drawings attached to the letters patent. Subsequently, on 12th October, 1922, the patentees assigned to one of the appellants, the P. & M. Company, all rights under this patent, and thereafter the appellant, the P. & M. Company, gave an exclusive license to the other appellant company to manufacture the invention and to use and to sell it to others. No question arises as to the constitution of the action or the title of the appellant (plaintiff) companies. They claim that the respondents (defendants) infringed their patent rights by manufacturing and using the invention, and by selling it to others to be used in Canada, and they seek a declaration of the validity of the patent; a declaration of the alleged infringement; an injunction; accounting, and damages. The substantial answer is that there was no infringement, and this defence has been upheld and found for the defendants by the learned judge of the Exchequer Court of Canada who tried the cause. It is from this finding that the appellants appeal to this court. There is a large body of evidence, mostly of a descriptive and technical character.

It appears that the movement of railroad rails under operation, which is described as creeping, has long been

known as a common fault, and many attempts have been made through numerous devices to afford a satisfactory remedy. The creeping takes place in the lengthwise movement of the rails in the direction of the traffic, and is caused chiefly by the severe stresses, jars and pounding to which the rails are subjected by the heavy locomotives, cars and loads which pass over them. The tendency to creep varies according to conditions of roadbed, grades, speed, frequency and weight of traffic. It is of course less on a single track, because there the loads, moving in opposite directions, tend in their effect to compensate for each other; but, upon double tracks, and these systems have become greatly extended, where the traffic upon each line of rails is practically all in one direction, the creeping, if not checked, develops into a cause of difficulty and of some danger in the working of the railways, especially at crossings and switches, or in localities where the nature of the soil or roadbed tends to facilitate it. Its consequences are also aggravated by the temperature and consequent expansion of the rails. Mr. Gutelius, an engineer engaged in the operation, maintenance and traffic of the Delaware and Hudson Railway lines in Canada, who has had long and important connection with railways in the Dominion, and especially in the supervision of their construction, maintenance and traffic, and who is the appellants' leading witness, gives the following testimony:

The string of rails that are butted against each other at a temperature of 60 degrees, will, when the temperature of the sun rises in the day time, rises to 100, push itself forward somewhere, and in cases of that kind we used to have what is known as a sun kink. A sun kink is across on a straight track along tangents where the expansion space has been used up, and the rails expand and must go somewhere, and they jump out in a sort of an S shape. Some very serious wrecks have occurred on account of sun kinks.

His Lordship: That is buckling?—A. The buckle is a side buckle—they do not buckle vertically. The character, the shape of the rail, makes it so much stronger vertically than laterally that the buckling is laterally.

During the years before the appellants' patent various contrivances were devised and used for the prevention of creeping, and these usually took the form of some sort of stay or brace between the rails and the sleepers or ties, which were embedded underneath, and to which the rails were fastened. A favourite method of applying this ob-

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struction or mode of resistance, and which was tried in different forms and under various patents, was by means of a cross bolt or yoke underlying the rail, bent at either end so as to engage on each side with the base of the rail, and intended to be kept in position by a wedge inserted on one side between the hook and the rail, a part of the contrivance extending downward perpendicularly to form an abutment or obstacle designed to press upon the contiguous sleeper, and thus to stay or overcome the creeping. Indeed the appellants in their factum frankly confess that:

It had been more or less well known before the Vaughans' invention that, assuming an anti-creeping device to be in its proper initial relation to the rail just before the creeping was attempted, the actual creeping when attempted could be best resisted and prevented by a yoke, engaging the rail base transversely, and substantially inextensible crosswise of the rail, so arranged in combination with a downward abutment at one of its sides that when creeping was attempted this abutment would be forced against a sleeper and would prevent the forward movement of one end of the yoke while the other end was permitted to move forward so that the yoke would tend to assume a slightly diagonal position across the base of the rail with a resulting substantially unyielding grip upon the rail, increasing as the effort of the yoke to assume a diagonal position increased, and operating by a cramping or shackle action in a generally horizontal direction.

Some of these designs were found to operate with a measure of success, but the trouble appears to have been that the creeping action was not constant, and at times when the anti-creeping function of the rail anchor was not taking place, there being then no pressure of the shoe abutment upon the tie, the loads or blows and pressure to which the apparatus was subjected operated to loosen the grip or tension of the wedge, and in that manner to impair or destroy its usefulness. One after another of these designs was tried and rejected. Then the Vaughans, the patentees of the design which is said to have been infringed, contrived a special combination of means, as explained by their specification, for holding the rail in place. The apparatus consists of a yoke or crossbar, in principle and use not unlike those which were known and had been tried before; it abandons the wedge and uses a locking device the primary form of which I shall attempt to describe, although it is difficult, if not impossible, to give a lucid explanation in the absence of the drawings, which cannot here conveniently be reproduced, and the specimens used at the hearing.

The invention as introduced to the specification

consists in the novel construction and combination of parts which will be hereinafter fully described and claimed;

there follows a careful description by reference to the drawing of the applicants' device, explaining particularly its construction, parts and methods of engagement and operation. The claims upon which the appellants rely, as stated in paragraphs 1 and 4 of the specification attached to the patent, are as follows:

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(1) In an anti-creeping device for railroad rails, the combination, with the rail, of a part engaging one side of the rail foot flange, a cross bar extending beneath said flange, and provided with means on one end thereof for engaging one side of said flange, means on the other end of said bar for engaging said part, the part-engaging means on the bar being held in engaging position by the spring action of said bar in tending to assume a position from which it was sprung, and tie-engaging means acting upon said bar, substantially as described.

(4) In an anti-creeping device for railroad rails, the combination, with the rail, of a shoe engaging one side of the rail foot flange, a cross bar extending beneath said flange and provided with means on one end thereof for engaging one side of the flange, a head on the other end of said bar holding said shoe in engagement with said flange, means on said bar for engaging said shoe, the shoe-engaging means on the bar being held in engaging position by the spring action of said bar in tending to assume a position from which it was sprung, and tie-engaging means acting upon said bar, substantially as described.

The device consists of two pieces of metal; one, the yoke or cross bar, which is made of steel, having a hook at one end to engage with one side of the foot flange of the rail, and which, passing under the rail, terminates at the other end in a square bolt head by which the bar may be torted or twisted by a wrench or other suitable tool in the hands of a workman, thus applying the torsion necessary for the engagement of the parts. The other member consists of the shoe, which is a casting of malleable iron, having two jaws projecting on its inner side to engage with the side of the rail opposite to that which is hooked by the yoke. The upper jaw is continuous for the entire length of the shoe, about three inches, but the continuity of the lower jaw is interrupted by an open space to form a socket into which the yoke passes, and, on the inner side of the socket, at its opening, there is a notch or slot to admit, when in proper position, a projection upon the side of the yoke with which it engages, and which is known in the evidence as a lug or spud. The opening in the side of the jaw admitting to

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the socket is not of sufficient width to allow the yoke to enter in its natural position, but, when the shoe is affixed to the rail flange, the yoke, hooked to the opposite flange and brought into contact with the shoe at the opening of the socket, is twisted by use of the wrench upon the bolt head, and then, by reason of a diminution in the thickness of the bar, which is somewhat flattened on the side to which it is twisted or sprung, the bar finds room to enter and is pressed into its socket. It is then allowed to spring back, and, upon the recoil, the lug on the shoulder of the yoke or bar articulates with and engages in the slot on the inner side of the socket, thus locking the parts, and causing both yoke and shoe to remain in place. By this means the anchor is secured to the rail. In this connection the patentees state in their specification that they *preferably* so locate the spud on the bar, that, after the bar has been sprung into the socket, there will remain in it sufficient resilience or spring action to press the spud into engagement with the shoulder of the slot, and thus firmly to hold or lock the parts together and to the rail flange. Continuance of the torsional spring action after the shoulder or lug of the yoke is in place in its socket is therefore not claimed as an essential feature of the plaintiff's device. The function of the torsion is to enable the yoke to enter the socket under conditions in which it can be released only by reverse application of the force requisite to admit it.

The shoe terminates in a face, known as the abutment of the shoe, which, of a width of about two inches, projects perpendicularly downward from the rail flange with which the shoe is engaged, and is intended, when in position and in action, to press against the sleeper which underlies the rail immediately in front of this projection, and, in order better to serve its object, the surface of the abutment is preferably made slightly convex. Then, to strengthen and render more secure the hold of the anchor upon the rail, the yoke, which in the process above described lies transversely of the rail at right angles to it, is forced by hammer blows at the hook into a slanting position in the direction of the tie; and here it may be said that, in order further to increase the grip, and so to prevent the turning of the bar, the hook, or portion of the bar turned over which embraces the flange of the rail on the side opposite to the

shoe, is preferably made still further to extend laterally in the same direction. Mr. Gutelius says, referring to the cross bar, that:

In practice it should be driven forward toward the tie so as to get a triangle toggle action.

* * * *

Q. Is it necessary to drive that one side of that crossbar up towards the tie after you put the apparatus in working position?

A. It becomes in working position when the shoe touches the tie, it pushes the shoe back, and you get the same result as when you drive that side forward.

Q. In order to get this into working position you must have the crossbar more or less diagonal to the long line of the rail?

A. That is the way it should be when it is working. It is that diagonal position that gives the bite on the rail to resist the greatest tendency to creep.

* * * *

Q. Is that transverse toggle action due to the diagonal position of the crossbar that gives the apparatus its bite upon the rail?

A. It gives it the bite. It gives it the bite on the edges of the rail base both at the shoe and on the other side. There is a bite caused by the torsion in the crossbar which affects the top of the rail on the far side and inversely the lower portion of the rail on the shoe side. * * *

Q. You told me a moment ago the detorsion action of the spring rested against that stud on the shoe?

A. Yes.

Q. That is correct, is it not?

A. What there is left of it when the apparatus is static, that is true.

Q. What is true?

A. What torsion is left in the bar when the apparatus is static is overcome, held in position by the lug. When the apparatus is working as against track creeping there is another problem in connection with the forces.

Q. Then that torsional action against that stud or stud is parallel with the long axis of the rail, is it not?

A. It is at right angles to the yoke or crossbar, and that yoke or crossbar should not be at right angles to the centre of the rail in working position; it should be on a diagonal.

Q. But it is approximately parallel to the rail?

A. Well, approximately, yes.

Q. Now, you saw a moment ago that when one of the men relieved that stud and spring torque member back that the whole apparatus fell off from the rail—you saw that?

A. That is what it would do.

Q. And that is what it does do?

A. No, I do not agree with that. It did not do it except when it is unloosened.

Q. If the torque spring action against the spring is removed the apparatus falls off?

A. Yes.

Q. So that the torque spring action is to keep the anchor on the rail?

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A. Hold the contrivance together.

Q. So that it may stay upon the rail?

A. Yes; perform its function.

Q. Then that function and office is to keep the parts upon the rail?

A. That is one of the functions.

Q. Then tell me, if you will, if it were not for that torque action would the apparatus stay upon the rail?

A. No.

Q. Then, taking Exhibit No. 10, that crossbar must be twisted or torqued by a man—is not that so, with a tool or wrench or some such tool in order to get it on?

A. Yes, it must be sprung into this position.

Q. And so it must be of such size and shape that the ordinary man can with an ordinary tool twist it, or with some tool twist it?

A. Yes.

Q. And that fixes the limit of its size. It cannot be bigger than a man can twist?

A. It depends on your tool entirely as to what you can spring.

Q. But that is the situation whatever else there may be said about it, it has got to be of a size and shape that it is practical twist. Perhaps you can twist anything but this must be practical—is that the situation?

A. Yes. It takes a tool about thirty inches long in the hands of a labourer—and of course if the lever were lengthened the crossbar could be strengthened.

This explanation from Mr. Gutelius follows upon testimony in which he says that the twisting motion of the cross bar, to put it on, is necessary in all forms of the appellant's device; that it is, in the words of the witness, "the meat of the Vaughan patent," and he testifies moreover that

the full force of the torsional effect of the spring is taken against the spud—is exerted against the spud;

but, as will have been observed in the passage quoted, he says that

what torsion is left in the bar when the apparatus is static is overcome, held in position by the lug.

There are other forms of the appellants' device which rest upon the same principle and the same combination of parts, although showing some variety in structure, but it is not I think necessary for the purposes of the case to endeavour to explain these.

The object to which the appellants' patentees applied themselves was not new. The novelty of the means which they devised for realizing their object is to be found in the application of the resilient force of the steel yoke by the torque produced in the manner described, and in the adaptation and combination of the selected appliances. The claim can be understood and defined only by reference

to the drawings which accompany it. The device is in reality a combination of well known and tried parts for an object the achievement of which had been the subject of many trials. It had been found that a shoe abutment anchored to the rail and pressing with the traffic against the tie was effective, while firmly held in place, to overcome or materially to reduce the creeping movement of the rail, but that the efficiency of the anchors which had been tried was of duration too brief for practical purposes, and, for the reason which I have mentioned, that these devices speedily lost capacity to resist the action of the load upon the rail, and were therefore unreliable. It had been discovered that owing to failure of the holding device the forces to which the anchor was subjected had the effect of causing it to relinquish its hold upon the rail, and so to become loose or disengaged. Up to this point there was no novelty in the appellants' device; this was the state of the art as they found it; but what their patentees secured by their monopoly, and what is involved in their claim, if it be not too broadly stated to be valid for any purpose, is the holding to the rail of the parts in engaging position by the spring action of the cross bar

in tending to assume a position from which it was sprung * * * substantially as described.

The substantial description is to be found only in the specification and drawings, and by reference to these it is evident that the essence or substance, the "pith and marrow" in the terminology of the cases, or the "meat," to adopt the word of the expert witness, Gutelius, of the appellants' invention, which is in reality no more than an improvement, consists in the lug or spud of the cross bar, the slot or shoulder of the shoe, into or behind which the lug or spud is designed to find place, and the torsion and recoil of the cross bar by which these parts are articulated and locked together. These means are said to provide an efficient lock; but, preferably, as said in the specification, it is desirable so to locate the spud, that, after the bar has been twisted and sprung into the socket, there will remain sufficient resilience or spring action in the body of the bar to exert continuous pressure upon the spud, and thus to strengthen its engagement with the shoulder or slot in the socket; meaning thereby, as the specification may be in-

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terpreted, and as was in effect stated at the argument, that the lock would be strengthened if the natural recoil from the torsion communicated to the cross bar by use of the wrench be not permitted entirely to exhaust itself when the cross bar is released in its socket; the purpose of this reserve of spring or recoil, which is recommended, being to aid in securing the engagement of the parts of the lock by the continued and permanent pressure of the spring.

It is true, as has been shewn, that the Vaughans in their claims for invention speak of the shoe-engaging means on the bar being held in engaging position by the spring action of the bar, in tending to assume a position from which it was sprung; but, when the claims and specifications are read and construed together, as they should be (*Arnold v. Bradbury* (1)), it would seem that for its essential purpose the torsion is employed as a means to the fitting together of the parts.

The spring or resilient quality of steel was of course known, and it had been manifested in previous inventions; the appellants acquired no monopoly of that; it has not been denied upon this appeal that its use and application for the purpose, and by the particular method, which has been described, became by the grant, the exclusive right of the patentees; nevertheless of course the claim for infringement fails unless it be established that the right so acquired has been infringed.

Turning now to the evidence of the alleged infringement; on 16th May, 1922, the respondent Charles D. Ericson obtained Canadian letters patent, no. 218,561, for rail anchors; previously, on 21st March, he had become party to a deed whereby he had granted to the respondent corporation an exclusive license for the manufacture and sale of the device which was the subject of his application; net profits to be equally divided. The other respondent, Thomas H. Watson, is the president of the respondent corporation. It is the manufacture and sale of the rail anchors by the last named respondents, in which the respondent Ericson shares the profits, which are said to infringe the appellants' device. Ericson in his specification describes his object, and I quote his language as explanatory; it

(1) L.R. 6 Ch. App. 712.

should be borne in mind however that the infringement, if any, consists in what has been done, not in statement or description. He says:

This invention relates to devices for preventing the longitudinal creeping of railway rails and more particularly to that type in which a longitudinal wedge-shaped jaw is driven between one edge of a rail base and one end of a yoke member spanning the rail base, and my object is to devise an anchor of this type which will be cheap to construct and which will hold securely on the rail. In anchors of this type there always exists a tendency for the wedge to loosen under the stresses to which the anchor is subjected and unless there is sufficient resiliency in the parts to take up any slight initial slack, the whole anchor comes loose as soon as such initial slack takes place. I aim therefore to obtain as much resiliency as possible where resiliency does not affect the immobility of the device longitudinally of the rail base when in service. It is also desirable to provide resilient frictional locking pressure tending to resist the slipping of the wedge which does not resolve itself into component forces of which one acts in a direction parallel to the length of the wedge. I aim therefore to so design the anchor that a resilient locking friction is produced by wedge action transversely of the rail.

In the fitting of this device to the rail the shoe is driven firmly onto the rail base, and then the yoke is driven over the shoe. In the latter operation the shoe is not moved. The upper face of the shoe is somewhat chambered off at the end which enters the yoke for a distance of one-quarter to one-third of its length to form a slight vertical wedge which assists the driving, and, by the wedge action which it develops, has the effect of springing the large arm of the yoke into holding position. But, when the yoke has passed over the chamfered end, the upper surface of the shoe, over which it continues to move in the driving process, is horizontal or parallel to the rail, so that, when the yoke comes to rest, the plane of contact between it and the upper jaw of the shoe is horizontal and parallel with the underlying plane of contact between the lower jaw and the rail base, thus avoiding in the use of the anchor any resulting force, the action of which would tend to displace or to expel the wedge. This is a very simple expedient, and none the less meritorious because of its simplicity. The respondents have a patent for it; the question is, not the validity of the respondents patent, but whether the rail anchors which the respondents manufactured and sold infringe the appellants' patent.

Elaborate experiments were conducted by one of the appellants' expert witnesses to demonstrate, by means of

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scientific apparatus, that in the driving process by which the respondents' yoke was fitted to the shoe and to the rail, torsion of the yoke was necessarily, and it was suggested designedly produced, and therefore it was said that the respondents had appropriated the principle, and indeed the essential element, of the appellants' patent; but I would reject that contention, because, even were I satisfied that the respondents' contrivance is placed in position not without some twisting of the yoke when it is driven over the wedge, I would not consider that the respondents had thereby infringed the appellants' patent, because they have not adopted the appellants' method of engaging the parts, and I hold that the appellants have no monopoly of the torsion, unless, it may be, in the application of it to the particular contrivance which they describe in detail. The words of the Lord Chancellor in *Tweedale v. Ashworth* (1), are very pertinent. His Lordship said:

There are some things wherein a principle properly so called is invented, and the infringer may take the principle and may alter the details, and yet it is very obvious that he has, in truth, taken the idea which has been the subject-matter of the invention, and has simply altered the details so as to avoid the possibility of its being suggested that he has taken the same thing. The court can in such cases very often look through the mere variation of details and see that the substance and pith of the invention has been pirated, and consequently can protect the inventor. But there are some cases in which, although the principle is common to a great variety of manufacturers, there may be a good subject-matter of a patent in the particular mechanical mode by which that principle is carried into operation.

The appellants' invention is of the latter description, and if, using the language of the Lord Chancellor on the following page of the report, one were to endeavour to adapt it, *mutatis mutandis*, to the facts of the present case, I think the passage might fairly be reproduced thus:

If it is suggested that each of them uses a steel yoke, and that each of them fastens the shoe to the rail by the use of that yoke and the elasticity of the material of which it is composed, it occurs to me immediately that where there are two such things as we are dealing with here, where there must be a steel yoke underlying the rail to hold in position upon the rail a shoe of substantially common form and purpose, and where there must be some means or other of fastening the shoe to the rail by means of the bar or yoke, there is necessarily a considerable likeness between all the forms; and indeed in the oldest forms there must be in some sense a likeness; but that which alone seems to me to constitute the patentable article in the case of the appellants is that which the

respondents have not taken at all; they have not, either in the form of the bar or by what is called the grip, taken the appellants' mode of doing it.

In the same case at p. 128, Lord Watson said:

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 appellants' 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. To the like effect is the judgment of the same great authority in *Miller v. Clyde Bridge Steel Co.* (1).

The novel element either in the appellants' patent or in the respondents' device is somewhat fine and narrow. Both depend upon the use of the steel yoke and the rail-engaging shoe. The yoke is applied in the one case by the torque, in the other by the wedge. In either case there is of course the recoil or resiliency of the steel bar, but that was in fact a feature of prior devices; it had been specifically mentioned in two of them at least, Clawson's specification of May, 1907, and Gutheridge's of October, 1907; it was obvious or capable of being realized upon investigation, whether declared or not. It makes possible the appellants' method of locking the parts, and it is apparent that the Ericson wedge could not be worked to form a binding connection if the yoke were rigid. The appellants' patentees have made use of an ingenious means of interlocking for the purpose of making their device effective. They have produced a useful lock. The respondent, Eriscon, has succeeded in the same purpose by a simple adaptation of the form and use of the wedge.

The case is I think covered by the authorities. Vice-Chancellor Wood in *Curtis v. Platt*, as reported to the footnote to *Adie v. Clark* (2), among other pertinent observations, says:

Where the thing is wholly novel and one which has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object, to see whether or not they are merely colourable contrivances for evading that which has been before done. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before has a right to extend very largely

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(1) 9 R.P.C. 478-9.

(2) 3 Ch. D. 135.

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the interpretation of those means which he has adopted for carrying it into effect.

* * * *

And although one is not to be too narrow in scrutinizing or interpreting a patent against a person who is a *bona fide* inventor, yet, on the other hand, as to all those who may be proceeding to effect similar objects by other discoveries, the court is bound to say that they are at liberty to do so provided they do not infringe the precise mechanism claimed for by the patentee.

Upon review of the Vice-Chancellor's judgment Lord Westbury expressed his entire agreement (1). See also the observations of Patteson J. in *Jones v. Pearce* (2), and Lord Davey's judgment in *Consolidated Car Heating Co. v. Came* (3).

It is true as held by Lord Justice Clerk Hope in *Househill Company v. Neilson* (4), and by Viscount Haldane in *British Thomson-Houston v. Corona Lamp Works* (5), that a claim may be well founded to the use of a principle of manufacture so distinctive and individual in form that it may be carried out under the general direction of a skilled manufacturer without further invention. Or if you suggest and discover not only the principle but a means of applying it to practical result by mechanical contrivance and apparatus, and show also that you are aware

that no particular sort of modification or form of the apparatus is essential in order to obtain a benefit from the principle, then you may take your patent for the mode of carrying it into effect and are not under the necessity of describing and confining yourself to one form of apparatus.

It is said that in such cases the essence of the invention is independent of the form or construction of the instruments by which it is to be applied. The appellants claim that their invention is of this quality, but I think they fail to establish either the invention of a principle or a claim for the application of the principle, such as it is, which is embodied in their patent, in any manner other than that which is particularly described by their drawings. The invention is one of mechanical detail. The specification and claims of the appellants' patentees taught or suggested nothing as to the agency or usefulness of the wedge in fastening the rail anchor. They departed deliberately from the wedge and contrived a locking action of a minute and particular description, and essentially they invoked the

(1) 11 L.T. N.S. 247.

(3) [1903] A.C. 576-578.

(2) 1 Webster's P.C. 124.

(4) 1 Webster's P.C. 685.

(5) 39 R.P.C. 70.

resilient action of the steel yoke only for the purpose of bringing into place and engagement or function the specially designed parts of the anchor and the shoe. The characteristic of the steel bar when sprung or twisted to resume its normal position was not the discovery of the appellants' patentees. They merely made use of a well known quality of the metal for bringing about the particular result in the specified manner, and there is in my judgment no suggestion of or foundation for any broader application of their idea. The question raised in the case is essentially a question of fact and as I view the evidence there is nothing to suggest that practical men, working with the object of producing a contrivance answering to the appellants' specification in its broadest interpretation, would be apt by any chance to produce the device which is claimed to infringe. I have come to the conclusion, after reviewing the authorities, that the observations of the learned authors of Terrell on Patents, 6th ed. at p. 121, may be safely adopted. They say:

But the consideration of the question of infringement is much simplified if one remembers that inventions may be divided roughly into two classes in respect to subject-matter. Firstly there is that kind of invention which consists in the discovery of a method of application of a new principle—here what has been invented is in effect the new principle, and, generally speaking, the court will regard jealously any other method embodying that principle, for the patentee was not bound to describe every method by which his invention could be carried into effect. Secondly there is that kind of invention which consists in some particular new method of applying a well-known principle, and in this case the use of other methods is not contemplated by the patentee, and such will not fall within the ambit of his claim.

It is the second category to which the kind of invention which is involved in the appellants' patent belongs.

We ought not to overrule the judgment of the learned trial judge unless satisfied that he was wrong, and after having considered the findings below, and the carefully prepared and able arguments on both sides, which we had the advantage of hearing, I am by no means convinced that the judgment is erroneous.

I would dismiss the appeal with costs.

Appeal dismissed with costs.

Solicitors for the appellants: *Blake, Lash, Anglin & Cassels.*

Solicitors for the respondents: *Gibson & Gibson.*

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THE
P. & M.
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v.
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Newcombe J.