1908
*Nov. 17, 18.
1909
*Feb. 12.

HERBERT LEWIS HILDRETH (PLAINTIFF) ..... } APPELLANT;

AND

THE McCORMICK MANUFACTURING COMPANY (DEFENDANTS) .. } RESPONDENTS.

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA.

*Patent of invention—Anticipation.*

Canadian patent No. 79392 for improvements in candy-pulling machines granted on Feb. 17th, 1903, declared void for want of invention having been anticipated by earlier inventions in the United States.

Judgment of the Exchequer Court (10 Ex. C.R. 378), reversed on this point.

CROSS-APPEAL from the judgment of the Exchequer Court of Canada (1) in favour of the plaintiff.

The plaintiff brought action for infringement of his patent for improvements in candy-pulling machines claiming damages and injunction. Several defences were set up, including the following: That plaintiff's invention was not new; that it was not useful; that the public were allowed to use the improvements before the patent issued; that it was not manufactured within two years after the grant of the patent so that any person could buy it; and that after the expiration of twelve months from the date of the patent it was imported into Canada. By the judgment of the

*PRESENT:—Sir Charles Fitzpatrick C.J. and Davies, Idington, Maclennan and Duff JJ.

(1) 10 Ex. C.R. 378.

Exchequer Court the patent was declared void on the ground of non-manufacture for sale within two years. all other grounds of defence except the last being decided in plaintiff's favour. Both parties appealed to the Supreme Court of Canada and when the case came on for hearing it was agreed that only the main appeal by the plaintiff's should be argued and the defendant's cross-appeal should stand over. On the main appeal the judgment of the Exchequer Court was affirmed (1).

At a later date the defendant's cross-appeal was heard.

*Gibbons K.C.* and *Haverson K.C.* for the cross-appellant.

*Anglin K.C.* for the cross-respondent.

The judgment of the court was delivered by

IDINGTON J.—A decision against the appellant of any one of several issues raised by this appeal and cross-appeal would, if final, be fatal to the appellant's case.

At the hearing of the appeal, in 1907, the parties agreed to confine the argument to the main appeal, and judgment was given as appears in the report then published (1).

The appellant, it is said, desires to appeal therefrom and hence the cross-appeal has been recently argued.

The chief issues raised thereby are that the appellant was not in fact the first and true inventor, and that the use by the respondent of the machine, which

(1) 39 Can. S.C.R. 499.

1909

HILDRETH v. MCCORMICK MANUFACTURING CO.

Idington J.

it confessedly did use, was not an infringement of the appellant's patent.

It is also claimed that there was no novelty in the alleged invention as it had at the date of the application in fact become by public use thereof public property; and also that an importation into Canada by the appellant of one of his machines had the effect, by virtue of section 38, sub-section (*b*) of the "Patent Act," of nullifying the interest of the appellant in the patent.

A brief history of the appellant's relation to the claims he makes may help to understand the strength or weakness thereof.

He had been at the time of the trial, in May, 1906, a manufacturer of candy for twenty-five years. He kept a diary from which I quote and extract substance of events hereinafter referred to. As early as 1890 he recorded in it: "If I can invent some way of cooking it quick and pulling it by machine, also cut and wrap it by machine, then I would be all right. I will try when I get along a little further."

In 1894 he engaged a firm of machinists to get up such machines.

In May, 1897, the diary tells he had paid that firm $12,000 for wrapping and other machines which turned out useless, and that he was permitted by them to engage one Charlie Thibodeau, who had been working with them, to come to him and he would set up a machine shop of his own.

On the 29th of May, 1897, he accordingly entered into a written contract with Thibodeau whereby he agreed to enter his service for the purpose of perfecting and manufacturing such machines, and to give him "his best services and also the full benefit of any 'and

all inventions or improvements which he had made or might hereafter make relating to machines or devices in Hildreth's business."

He also agreed if Hildreth did not desire to patent any of said inventions or improvements to keep them secret.

Having, he claims, succeeded as to a wrapping machine on the 26th of December, 1897, he records in his dairy as follows:

> I made a little trial of my idea of a pulling machine, it is on the principle of hand-pulling. I drove two spikes in a board about eight inches apart and took a piece of iron in my hand and worked the batch around the spikes in the form of a figure eight. I think that is the principle we shall have to go on; we may have two hooks or pins pull apart drawing the candy and another hook or pin drawing it sideways and the two hooks go back again and take the candy once more and pull it out again either on a table or up on the side of the building same as hand pulling.

In November, 1899, he tried a pulling machine with rolls, but it would not work.

On the 30th of December, 1899, he records making a little experiment with the pulling machine. He adds there had never been one made or used to his knowledge.

On the 12th of February, 1900, the diary records as follows:

> Received a circular to-day from the Grand Rapids Steam Engine, Grand Rapids, Mich., of a pulling machine that they had got up. I sent letter to them for more information, it had a different principle than mine. I do not see how they can ever pull candy with it, but if it will I shall buy one until I can get mine finished; their machine seems more like a bread mixer than a candy-pulling machine.

On the 19th of the same month he sent them a telegram for one of their machines.

It arrived on the 8th of May following, and on the 10th a man came to set it up, and tested it on the 12th,

1909

HILDRETH v. MCCORMICK MANUFACTURING CO.

Idington J.

when the appellant records it would not work successfully, and that "the principle is wrong."

Then he says he told Thibodeau to make up the model and told him how he wanted it.

On the 15th of the same month he tested a minature of his own and it worked very satisfactorily, and had added a "reversible motion to the hooks in conjunction with the figure 8." Two days later he tested the model and "it *worked fine.*"

On the 21st of May he notes he had written Grand Rapids in relation to their pulling machine, and adds "they have given it up for a failure."

On the 24th, 25th and 26th he records what he is doing in building his pulling machine and on the said 26th "we shipped Grand Rapids pulling machine back to-day a failure."

The 10th of June he records that his "works fine" and he will apply for a patent.

On the 21st September, 1900, he filed in Washington an application for a patent for this invention which is called hereinafter "the pendulum machine" and in his specification describing it says "the essential parts of the invention being a plurality of candy-hooks, a candy-puller and means of producing a relative in and out motion of these parts." This and more was subsequently amended, probably because too indefinite.

He described it as "a new and useful *improvement* in candy-pulling machines."

On the 23rd October, 1901, Dickinson, the inventor of the Grand Rapids machine, made his declaration, to found an application for patent, which was filed in the following month.

Then interferences at Washington induced the appellant to try and defeat Dickinson by acquiring the rights of invention of one Jenner, who had in fact, but how or when or where does not clearly appear, invented a machine much superior to either that of Dickinson or of the apppellant.

This was in 1902 and Jenner pursuant to his agreement with the appellant and in verification of his specifications as to his invention swore on the 31st October, 1902, for the purpose of making application for patent, that he believed "himself to be the *original* and *first and sole inventor* of the candy-pulling machine described and claimed in the said specifications." The application for a patent for this Jenner invention was filed at Washington the 15th of November, 1902.

Meantime, in July, 1901, Thibodeau, having been sued by the appellant on the 15th of the previous March or earlier to restrain him from using a machine he had invented for candy-pulling, produced it for inspection and comparison with the pendulum machine appellant claimed to have invented.

This Thibodeau machine the appellant saw then for the first time and he admits it was the invention of Thibodeau, yet attempts sometimes feebly and at other times more boldly to claim it to be in principle the same as his.

It is admitted, I think, to be in principle identical with the Jenner machine. Whether admitted or not to my mind it clearly is so.

The chief difference seems to consist in the transmission of the driving power by means of a chain in one and in the other by a duplicate set of cogged wheels.

This Thibodeau machine is that in use by the re-

1909

HILDRETH v. MCCORMICK MANUFACTURING CO.

Idington J.

spondent and it is that use which is claimed by the appellant to be an infringement of the patent next referred to.

On the 12th of August, 1902, the appellant filed at Ottawa his application for a patent in Canada of the pendulum machine above referred to and on the 17th of February, 1903, patent was granted.

It was for an "alleged new and useful *improvement in candy-pulling machines.*"

How or why it comes to be thus designated, if as the diary asserts there never had been a prior candy-pulling machine in existence, is not explained.

We had before us in argument a model of each of the machines referred to which I will hereafter refer to as respectively the Dickinson, the Thibodeau and the Pendulum machine.

I was unable then, and after much reading of evidence and consideration of the whole matter am unable yet, to see how the Thibodeau machine can be said to be in any respect the same in principle as the Pendulum machine unless we are to seek for the principle in the motions necessary for pulling candy by means of hands and hooks on a wall or frame which it is said have been known for ages.

To use the same or similar motions was necessary in any method that might be adopted.

Even the appellant does not claim he has a patent on that, but seems to imagine there is some magic in the figure 8 that he has adopted and claims as his own ideal of the product of motion that must be got.

I cannot concede that he by his patent acquired in law any monopoly of the use of motions that may produce such a figure or semblance thereof, or that even when he got a machine that will produce in its paths

of motion such figure he has escaped from the consequences of copying another man's machine or its principle of action or that he will have debarred all others in Canada during the life of his patent from so combining well-known mechanical contrivances as to produce the necessary motions in handling and pulling candy, even if these motions were in and out or round about or intersecting paths of such a nature as should enable one to imagine a succession of figures "8" in tracing the paths the candy or parts of the machine may have followed.

It seems to me that the Dickinson machine produced and could not help producing intersecting paths that on inspection give evidence of some resemblance to a figure 8 if there be a charm in that. Of course the figure 8 it produces is not so elegant as that resulting from a use of the Pendulum machine.

When we come to pass this shadow and get to the substance of things in a comparison of these (Dickinson and Pendulum) machines, they are so nearly alike in their motions, and the Pendulum machine is so clumsy a contrivance that I think it was by a careful study of the former and an adherence, indeed a discriminating adherence, to its "mode or motion" that the Pendulum machine was arrived at; and that the rotary conception, so widely different, so much more useful, so much more readily seized by one who had the inventive faculty, and depended on that alone, freed from the trammels of a prior model, was possibly missed by the appellant.

Dickinson followed probably the baker's trough and mixer for his model and the appellant followed, at as respectable a distance as he knew how the Dickinson. It was necessary for him to differentiate from the model. Even Thibodeau, who was, as appellant

1909

HILDRETH v. MCCORMICK MANUFACTURING CO.

Idington J.

evidently was not, an expert mechanic, could not make anything really useful of the appellant's conception and instructions, whatever they were, and dropped them and invented for himself a rotary machine.

If the internal evidence which the diary furnishes so amply, the external or objective evidence which comparison of the machines also supplies, and the history of the case, including appellant's own evidence, do not fully support my surmises relative to the appellant and his alleged invention, let us turn to his conduct for further cogent evidence of their correctness.

Why did he, if conscious of his own rectitude and capacity as an inventor, buy the Jenner invention?

If, as he swears, the principle of the Thibodeau, which is another Jenner, are the same as his Pendulum machine, why should he seek for support in the Jenner and buy it? He replies it was to antedate the Dickinson.

But again, how or why or on what grounds? It is not apparent on the evidence before us that any one would invest money in its purchase for that reason alone.

But he seemed afraid of Thibodeau's rotary machine when Thibodeau, the inventor of it, ventured to interfere with his claim at Washington.

It seems hard to believe that the appellant did not know when seeking to restrain Thibodeau why he sought to restrain him. If he knew that his machine was only something he pretends now identical in principle with his own, why should he feel disturbed?

But, however that may be, having found from inspection he got in July, 1901, what it was, why should he seek in 1902 to buy Jenner's, which was the same in

principle? Besides the priority of date already referred to he adds it was better to buy him off.

I find no ground for apprehension unless his was an imitation of Dickinson's. If the Dickinson principle had not been adopted why seek to antedate it?

I think it is not unfair to infer that he had not the confidence he now pretends in the rotary and the pendulum being the same in principle or his pendulum machine being entirely different from the Dickinson, and in fact a machine that worked "fine" whilst the other was a total failure and worthless.

Moreover, why did he knowing of the identity as he must after in July, 1901, seeing Thibodeau's which is identical with Jenner's induce Jenner on the 31st October, 1902, to swear he was the sole inventor of the machine? If his present contention be correct as to identity in principle of the Thibodeau or its equivalent the Jenner with his, he (Jenner) was only one of several inventors of the same thing.

The appellant seems to be in this dilemma. The development of his pendulum machine from Dickinson's seems much more easy, much more probable than to suppose that some one else merely developed the rotary machine in question from the pendulum machine.

It seems a fair test when we are asked to find the rotary machine in question an infringement of the pendulum machine to consider if it is at all probable that an ordinary skilled mechanic having once seen the alleged original invention could at once suggest and apply without the necessity for any inventive power whatsoever some other arrangement of mechanical contrivances to produce the same result.

If he could not, then he who constructs a new

1909

HILDRETH v. MCCORMICK MANUFACTURING CO.

Idington J.

machine requiring inventive faculty is entitled to a patent, or to use as here without patent.

Of course, if that new machine be but an improvement on the other he inventing it must, if he apply for a patent, be confined to an invention by way of improvement. His use without patent must be, of course, subject to the like limitations.

But if, as I find here, the invention be entirely new and not merely an improvement, he would be entitled to his patent as for a new machine, or if he did not desire a patent, to use it free from restraint.

Even if in this case it is inconceivable that this rotary machine is not in fact founded on the earlier pendulum machine, then to my mind much less can it be conceived that was not anticipated by the Dickinson one still earlier.

Then again, the whole story of the appellant, for long years anxious to design a candy-pulling machine, beaten after years of speculation as to it, telegraphing to have the Dickinson machine sent him, shewing it to his skilled workman and to his attorney, and attacking immediately on its arrival with such feverish haste the problem he had so long failed to solve and coming to such sudden unexpected success and in one breath condemning as total failure that which he desired to have discarded, and self-approvingly recording how "finely" his own had worked when in fact it never was worth much, if anything, not only arouses suspicion, but when coupled with a pretty obvious resemblance between the two and all the other evidence and considerations I have adverted to, leads me to but one conclusion, and that is that the appellant never invented what he claims and is therefore not entitled to the relief he asks.

Nor do I think that the Thibodeau machine in question was an imitation of the appellant's. Indeed if the appellant had really supposed it was the result of his instructions to his servant he would, I suspect, have used it in applying for his Canadian patent for it was so much superior to his pendulum machine.

We have to bear in mind that it is the appellant's conception we have to consider and not that of his hired man. His long years of meditation and failure and the measure of his capacity to understand mechanical principles as shewn by his evidence do not lead me to conceive of the sudden inspiration he got coming to him save what was derived from the use he made of the Dickinson machine.

As to the grounds of his public user giving possession to the public, I do not think, in the view I take, it is necessary to follow that matter very far.

The use extended over several years under such circumstances of publicity that I would, in consequence of the view I have taken of the appellant and his case, feel inclined to seek for corroborative evidence that measures were really taken to protect his invention from publication.

In his attempt to establish its utility by his statements as to its being used and yet hand labour being continued until the rotary machine was installed when both the pendulum machine and hand labour disappeared together, one is at a loss to know exactly what conclusion to arrive at regarding his veracity on this point of public use.

As to the importation I incline to think it was of the substantial parts of the machine and hence an importation of the invention. See interpretation of the word in the Act. I have not, however, arrived at a

1909

HILDRETH v. MCCORMICK MANUFACTURING CO.

Idington J.

final opinion on that as it seems unnecessary to follow the matter further.

I think the cross-appeal should be allowed with costs of appeal and of the trial.

*Cross-appeal allowed with costs.*

Solicitors for the appellant: *Blake, Lash & Cassels.*

Solicitors for the respondents: *Gibbons, Harper & Gibbons.*