

THE DOMINION FENCE COM- }
PANY (DEFENDANTS) } APPELLANTS;

1907
*Oct. 30;
Nov. 5, 6.
*Dec. 13.

AND

THE CLINTON WIRE CLOTH }
COMPANY, AND OTHERS (PLAIN- } RESPONDENTS.
TIFFS)..... }

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA.

*Patent of invention—Novelty—Combination of known elements—
Infringement—Mechanical equivalents.*

A device resulting in the first useful and successful application of certain known arts and processes in a new combination for manufacturing purposes is not unpatentable for want of novelty merely because some of the elements so combined have been previously used with other manufacturing devices.

Judgment appealed from (11 Ex. C.R. 103) affirmed.

APPEAL from the judgment of the Exchequer Court of Canada (1), maintaining the plaintiffs' action with costs.

The action was brought for infringement of letters patent of invention granted to one Perry for making electrically welded wire fabric, such as is commonly used for fencing, which the defendants were alleged to have infringed, and claimed an injunction and damages. The defendants had caused to be made for themselves and had used a machine for making wire fences, the wires being automatically welded at their

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

(1) 11 Ex. C.R. 103.

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intersections by electric currents. In a number of details, this machine was different from the machine described in the plaintiffs' patent, but it produced the same products in a similar manner with devices of a similar character.

By the judgment appealed from, it was held that, giving a broad construction to the plaintiffs' patent as being the first in which a successful method was devised and pointed out for the manufacture of wire fences and other like products in the manner described therein, the defendants had been guilty of infringement, and an order was granted for the injunction and the confiscation of the machine used in the infringement.

J. B. Clarke K.C. for the appellants. In addition to the cases cited in the report of the case in the court below, we refer to *Harrison v. The Anderston Foundry Co.* (1); Tyrell on Patents (4 ed.), 284-6; *Bunge v. Higginbottom* (2). As to what constitutes invention, see 22 Am. & Eng. Encyc. of Law (2 ed.), pages 279 to 281. Simple and obvious modification of a former device is not invention, 22 Am. & Eng. Encyc. of Law, page 303. As to what constitutes novelty, see same volume at page 306, and, as to mechanical equivalents, see same volume, pages 289, 291 and 292.

A patent must be construed with reference to the prior state of the art to which the invention belongs and limited to that which is new: Am. & Eng. Encyc. of Law, pages 300 and 410.

Walter Cassels K.C. and *A. W. Anglin* for the respondents. There is no difference in substance be-

(1) 1 App. Cas. 574.

(2) 18 Cut. Pat. Cas. 201.

tween the two claims, a machine responding to one necessarily responds to the other, and, inasmuch as the defendants' machine embodies claim 35 of their patent, it likewise embodies and infringes claim 40 of the plaintiffs' patent.

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It is clear that no anticipation of the plaintiffs' patent has been shewn; there are vital differences between it and the previously patented machines, all of which proved inoperative and were never put in practice for manufactures such as are now in question. No skilled mechanic could, in view of the previous patents, have manufactured such products without invention.

We refer to *Smith v. Goldie* (1); *Proctor v. Bennis* (2). As to what constitutes a combination, see *Harrison v. Anderston Foundry Co.* (3), at pages 574-577; *Proctor v. Bennis* (2). Novelty is defined by Lord Hatherly in *Cannington v. Nuttall* (4), at page 216. See also *Saxby v. Gloucester Waggon Co.* (5), and *Bischoff v. Wethered* (6).

A prior inoperative patent, one which does not disclose a practical machine, and which has never been brought into actual operation cannot anticipate or invalidate a subsequent patent: *Betts v. Menzies* (7); *Patterson v. Gaslight and Coke Co.* (8), at page 823; *The General Engineering Co. v. The Dominion Cotton Mills Co.* (9).

(1) 9 Can. S.C.R. 46; 7 Ont.
App. R. 628, at p. 631.

(5) 7 Q.B.D. 305.

(6) 9 Wall. 812.

(2) 36 Ch.D. 740.

(7) 10 H.L. Cas. 117.

(3) 1 App. Cas. 574.

(8) 2 Ch.D. 812.

(4) L.R. 5 H.L. 205.

(9) 6 Ex. C.R. 306.

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The judgment of the court was delivered by

IDINGTON J.—The appellants seek relief from a judgment of the Exchequer Court declaring they had infringed a number of claims in a patent and restraining further like infringement.

It seems that the patentee under whom respondents' claim had invented and patented in the United States a wire fence of longitudinal wires crossed at right angles by stay wires at regular distances apart and that these crossing wires had been welded by some electric process of welding at each of the crossing intersections.

This product never was, even if in itself patentable, patented in Canada and hence cannot be claimed as covered here by any patent.

Some time afterwards the same patentee constructed and had patented a machine for making the said wire fence.

It is urged that it must be inferred that this was disclosed by the product in question.

I cannot see how that necessarily follows. The original product may have been the result of the use of one or more crude appliances that implied nothing requiring inventive faculties to produce.

Nothing is disclosed to shew that anything at all like the machine now in question was used in making that product.

Then the patented machine, now in question and under which respondents claim, is attacked here, on the grounds that Perry the patentee was not the true inventor, that there was no novelty in it, that it was not useful, and that there was no invention or subject matter.

The mode of attack is this. It is shewn that many of the parts of the machine were, in some other ways, used as machines or parts of machines used in welding processes. It is not pretended that any of them ever were used to construct such a wire fence as that produced by this machine. It is not pretended that they ever were all combined to form any single machine for any purpose. Nor can I find that any such combination of the major or substantial parts were ever before combined for any similar process of any kind.

It is urged, however, that each part having been in use and well known to ordinary men skilled in electric welding as having been in use for some purpose or other therefore any such man having his attention turned that way by seeing the wire fence product would have been able to and without any further knowledge could have framed such a machine as that now in question.

It is not at all self-evident or even probable to my mind that such is the case.

It may have been quite susceptible of proof by some such ordinary man saying so, but none has said so.

Mr. Bain, the only witness for the defence, says a great deal, but does not touch this point or vouch his belief that looking at the matter as an ordinary man might he could construct such a machine. This seems fatal to the contention.

Moreover, it is pretty evident that even Mr. Perry, who does not seem to have been an ordinary man, did not find it quite so easy a task as the argument implies, or he would have done so long before.

The grounds of the objection taken seem on this

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evidence utterly to fail. The specifications and claims do not in words specifically claim the invention, as a combination, but as at present advised I think enough is expressed to shew that such is the nature of the invention.

It is not pleaded that the specification or claims therein were insufficient, and besides there are some things that enter into this combination that I am not quite clear were anticipated in any prior invention.

I think the attack on the respondents' patent has upon the evidence and within the pleadings before us failed.

As to the appellants' machine, it seems on the evidence to be as a whole substantially the same as that of the respondents. It seems rather an unsuccessful attempt to differentiate but only, unfortunately for the attempt, by means of mechanical equivalents.

I think the appeal fails and must be dismissed with costs.

Appeal dismissed with costs.

Solicitors for the appellants: *Clarke, Bowes & Swabey.*

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