1947
Oct. 21-24, 27-29.
1949
Dec. 23

BETWEEN:

HIS MAJESTY THE KING, on the Information of the Attorney General of Canada,..... PLAINTIFF;

AND

UHLEMANN OPTICAL COMPANY,....DEFENDANT.

Patents—Action by Crown for declaration that patent invalid—The Patent Act, 1935, S. of C. 1935, c. 32, s. 60(1)—Eye-glasses—Two-point Numont mounting—Anticipation of invention by prior publication—Prior publication to be read in the light of common knowledge—Presumption of validity in favor of patent—Ease of putting item into practice not evidence of lack of invention—Evidence of commercial success coupled with evidence of a problem and its solution strong evidence of invention.

The Crown brought action under section 60(1) of The Patent Act, 1935, for a declaration that the defendant's patent covering an invention relating to a mounting means for the temples of spectacles was invalid for lack of novelty and lack of subject matter.

Held: That lack of novelty and lack of subject matter as grounds for holding a patent invalid are closely related, but are not the same.

2. That in order that an invention should be held to have been anticipated by a prior publication, the information as to the alleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent. Whatever is essential to the invention or necessary or material for its practical working and real utility must be found substantially in the prior publication. It is not enough to prove that an apparatus described in it could have been used to produce a particular result. There must be clear directions so to use it. Nor is it sufficient to show that it contained suggestions which, taken with other suggestions, might be shown to foreshadow the invention or important steps in it. There must be more than the nucleus of an idea which, in the light of subsequent experience, could be looked on as being the beginning of a new development. The whole invention must be shown to have been

published with all the directions necessary to instruct the public how to put it into practice. It must be so presented to the public that no subsequent person could claim it as his own. The test is whether the man attacking the problem finds what he wants as a solution in the prior so-called anticipations.

3. That in considering whether an invention was anticipated by a prior patent, the prior patent must be read in the light of the common knowledge which a person skilled in the art would have had immediately prior to the alleged invention.

4. That there is a presumption of validity in favor of the patent by reason of its issue and the onus of proving that it is invalid for lack of invention is on the person attacking it.

5. That invention may be present notwithstanding the fact that there was no difficulty in putting the idea into effect once it had been conceived. *Hickton's Patent Syndicate* v. *Patents and Machine Improvements Company Ld.* (1909) 26 R.P.C. 339 at 347 followed.

6. That evidence of the practical utility and commercial success of an invention coupled with evidence of the existence of a problem and its solution is strong evidence of invention. *Non-Drip Measure Coy., Ld.* v. *Stranger's Ld., et al* (1943) 60 R.P.C. 135 at 142 followed.

7. That if there were any doubt as to the validity of the patent by reason of lack of invention the commercial success of the defendant's mountings and its substantial displacement of mountings previously in use would be sufficient to turn the scale in its favor.

ACTION under section 60(1) of The Patent Act, 1935, for a declaration that defendant's patent is invalid.

The action was tried before the Honourable Mr. Justice Thorson, President of the Court, at Ottawa.

E. G. Gowling K.C. and *G. F. Henderson* for plaintiff.

Christopher Robinson, K.C. for defendant.

The facts and questions of law raised are stated in the reasons for judgment.

THE PRESIDENT now (December 23, 1949) delivered the following judgment:

This action was taken at the instance of the Attorney General of Canada under section 60(1) of The Patent Act, 1935, Statutes of Canada, 1935, chap. 32, for a declaration that Canadian letters patent 381,380 and 392,499 and industrial design registration 58/12138, owned by the defendant, a corporation association under the laws of Delaware having its principal place of business in Chicago, Illinois, are invalid. The defendant withdrew its defence

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as it related to Canadian letters patent 392,499 and industrial design registration 58/12138 and judgment was given for the plaintiff in respect thereof, so that it is only as to Canadian letters patent 381,380 that a declaration of invalidity is now sought.

The patent in suit relates to an alleged new and useful improvement in eye glasses, and more specifically to a mounting means for the temples of spectacles. The application for the United States patent was made on April 22, 1937, and this is relied upon as the date of the invention. The application for the Canadian patent was filed on March 5, 1938, and it was issued on May 16, 1939. The defendant's mounting is commonly known as the 2-point Numont mounting.

The specification states, *inter alia*:

> My invention relates to eyeglasses, and more specifically it relates to a mounting means for the temple.

and sets out the objects of the invention as follows:

> One of the objects of my invention is to provide an improved temple mounting which prevents strain from being transmitted to the lenses.
>
> A further object of my invention is to provide a temple mounting that requires a minimum amount of labour in attaching the mounting.
>
> A further object of my invention is to provide an improved temple mounting which will be inconspicuous in appearance.
>
> A further object of my invention is to provide an improved temple mounting which will result in a saving of material.
>
> Further objects and advantages of the invention will be apparent from the description and claims.

The inventor then describes generally the figures in the drawings, in which he says that several embodiments of his invention are shown. Then there is a description of the various constructions shown in the figures, of which only the following need be set out:

> The construction shown comprises a pair of channel-like straps 1 each having a lens-edge engaging portion with ears extending therefrom for embracing the edges and adjacent surface portions of the lenses 2, a bridge 3 secured to these straps, a pair of temple-supporting wires 4 having an anchorage portion thereof also secured to the straps 1, in general extending along, adjacent, and in the rear of the edges of the lenses 2, and a pair of temples 5 pivotally connected with the ends of the wires 4, the axes of said hinge connections being substantially vertical, whereby the temples will fold compactly. It will be noted that the supporting wires 4 which support the temples are supported solely or mainly by the bridge 3 and that any strain put on the wires by the temples will not be transmitted to the lenses but will be transmitted to and carried solely by the bridge 3.
>
> In the construction shown in Figs. 1 to 3, incl., the supporting wire 4 is secured to the lens-edge engaging portion of the lens-supporting strap. For this purpose, the supporting wire is bent or offset, as shown at 6,

so as to extend from front to rear along the upper lens-edge engaging portion of the strap, as shown in Fig. 3, thence angularly or outwardly a short distance, thence upwardly and outwardly following the contour of the edge of the lens so as to be inconspicuous and so as not to interfere with vision.

In Fig. 6 is shown another method of securing the supporting wire to the strap. In this form, the end of the wire 4 extends along and is secured to the rear edge of the strap 1, in the plane of the lens-edge engaging portion thereof as by welding, soldering, or the like.

In Figs. 7 and 8 is shown a mounting in which the temple-supporting wires 4 are formed integral with the bridge 3. In this form the straps 1 which support the lenses 2 are secured in any suitable manner as by soldering or the like to the wire adjacent the junction of the bridge and temple-supporting wire. The temple-supporting wires extend from the portions secured to the lens-engaging portions rearwardly and angularly to follow the contour of the lens adjacent to and along the rear surface thereof. The wire may be oval or slightly flattened and may be bent at the bridge portion so that the flattened surface of the wire will lie substantially parallel with the nose of the wearer.

Further modifications will be apparent to those skilled in the art and it is desired, therefore, that the invention be limited only by the prior art and the scope of the appended claims.

It will be seen that in all of the forms disclosed, the temple supporting wire follows the contour of the edge of the lens so as not to interfere with the vision and so as to be inconspicuous. It will also be noted that in all of the forms the temple-supporting wire is supported by the nose-engaging means.

The specification ends with 6 claims, which read as follows:

1. A spectacle construction comprising a pair of lenses, a pair of channel-like straps embracing the edges of said lenses, respectively, at the nasal edge of the lenses, each of said straps including a lens-edge engaging portion, a bridge member for connecting said straps, and a pair of temple-supporting wire members each having an anchorage portion extending therefrom and being secured directly to the lens-edge engaging portions of the strap and extending rearwardly and angularly therefrom and following the contour of the lens adjacent to and along the rear surface thereof for connection with the temple of the spectacle.

2. A spectacle construction comprising a pair of lenses, a pair of channel-like straps embracing the edges of said lenses, respectively, at the nasal edge of the lenses, each of said straps including a lens-edge engaging portion, a bridge member for connecting said straps, and a pair of temple-supporting wire members each having an anchorage portion extending therefrom and being secured directly to the lens-edge engaging portions of the strap intermediate the ends thereof and extending rearwardly and angularly therefrom and following the contour of the lens adjacent to and along the rear surface thereof for connection with the temple of the spectacle.

3. A spectacle construction comprising a pair of lenses, a pair of channel-like straps embracing the edges of said lenses, respectively, at the nasal edge of the lenses, each of said straps including a lens-edge engaging portion, a wire bridge member connecting said straps, and a pair of temple-supporting wire members each being formed integrally with said

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wire bridge member and being secured to the lens-edge engaging portions of the strap and extending rearwardly and angularly therefrom to follow the contour of the lens adjacent to and along the rear surface thereof for connection with the temple of the spectacle.

4. A spectacle construction comprising a pair of lenses, a pair of channel-like straps embracing the edges of said lenses, respectively, at the nasal edge of the lenses, each of said straps having a lens-edge engaging portion, a bridge member for connecting said straps, and a pair of temple-supporting wire members each having an anchorage portion extending therefrom parallel to the lens-edge engaging portion of said channel-like straps and being secured directly to said straps, there being offsets extending from said portions in the direction of the lenses, said temple-supporting wire members extending from said offset portions and following the contour of the lens adjacent to and along the rear surface thereof for connection with the temple of the spectacle.

5. A spectacle construction comprising a pair of lenses, a pair of channel-like straps embracing the edges of said lenses, respectively, at the nasal edge of the lenses, each of said straps including a lens-edge engaging portion, a bridge member for connecting said straps, and a pair of temple-supporting wire members each being secured to the lens-edge engaging portions of the strap and extending rearwardly and angularly therefrom and following the contour of the lens adjacent to and along the rear surface thereof for a substantial distance, the free end portions of said temple supporting wire having a rearwardly extending portion terminating in a hinge for pivotally receiving the temple of the spectacle.

6. A spectacle construction comprising a pair of lenses, a pair of channel-like straps embracing the edges of said lenses, respectively, at the nasal edges of the lenses, each of said straps including a lens-edge engaging portion, a bridge member for connecting said straps, and a pair of temple-supporting wire members each having an anchorage portion extending therefrom and being secured to said straps in the plane of the lens-edge engaging portions thereof, said temple suporting wire member extending therefrom to follow the contour of the lens adjacent to and along the rear surface thereof for connection with the temples of the spectacles.

Two attacks are made on the patent, namely, lack of novelty, sometimes called anticipation, and lack of invention, usually referred to in the English cases as lack of subject matter.

Before either of these is considered it is, I think, desirable to describe the state of the prior art. This may be outlined briefly. Optical lenses as assembled with their mountings are mainly of two kinds, namely, eye glasses and spectacles. Eye glasses are rimless and held in position on the nose by a spring. Spectacles are rimless or framed, the frames being of metal or plastic. They ride on the nose by a bridge and differ from eye glasses in being held in position by temples extending over the ears. In addition

to eye glasses and spectaclettes there are also spectaclettes, a combination of both, being fastened on the nose by a spring and held in position by temples over the ears.

The principal objects sought to be achieved by the use of the various types of mountings were to hold the lenses in the proper position before the eyes, enable as wide a range of vision as possible, and make them comfortable to wear and inconspicuous in appearance. It was also desired to have a minimum of breakage or loosening of the lenses.

Eye glasses gave a wider range of vision and were less conspicuous than spectacles but there were serious disadvantages in their use. It was difficult to keep them in the proper position, the pressure on the nose made them uncomfortable and the lenses were subject to breakage. The result was that while they were in vogue prior to about 1916 very few of them are now sold. Plastic frame spectacles are comfortable to wear and less subject to breakage than any other kind. But they are not always easy to fit and it is difficult to keep them in the proper position, their tendency being to slide down on the nose. The rims are obstructive of vision and they are more conspicuous than other types of glasses. Metal frame spectacles have the great advantage of being easily adjustable to the proper position by means of the guard arms and easily kept in position by the temples. They are less restrictive of vision and less conspicuous than the plastic frame ones, almost as comfortable, being only slightly heavier, and almost as free from breakage. The rimless spectacles are as easy to adjust and keep in the proper position as the metal frame ones and are lighter and less conspicuous. They give a wider range of vision than either plastic or metal frame spectacles but less than eye glasses because of the straps at the outer edges of the lenses by which the temples are connected. Their greatest disadvantage is the heavy rate of breakage of the lenses and the loosening of them both at the nasal and at the temple ends.

Eye glasses, spectacles and spectaclettes were all well known long before the 2-point Numont mounting came on the market. The greatest development up to that time was the Ful-Vue type of spectacles with the temples attached above the centre of the line of vision or what is

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called the 180 line. These came into prominent use about or shortly after 1930. By that time eye glasses had almost become obsolete and spectaclettes were seldom seen. But there were many different makes of spectacles, rimless and framed, having the advantages and disadvantages described. They are represented generally by Exhibits B (metal frame spectacles), C (rimless spectacles) and D (plastic frame spectacles). These constituted the practical art in spectacles at or about 1930 and the situation remained substantially unchanged until the appearance of the Numont mounting in 1938.

Counsel for the plaintiff filed a number of patents as part of the evidence of the prior art. I enumerate them as follows, giving in each case the name of the inventor and the number and date of the patent; namely, Exhibit 6, J. E. Briggs, U.S. patent 443,160, dated December 23, 1890; Exhibit 7, J. Savoie, U.S. patent 915,487, dated March 16, 1909; Exhibit 8, F. A. Stevens, U.S. patent 953,304, dated March 29, 1909; Exhibit 9, J. Savoie, U.S. patent 988,666, dated April 4, 1911; Exhibit 10, F. W. Haviland, U.S. patent 1,380,957, dated June 7, 1921; Exhibit 11, O. B. Carson, U.S. patent 1,904,852, dated April 18, 1933; Exhibit 12, W. W. Ferris, U.S. patent 1,972,479, dated September 4, 1934; Exhibit 13, G. E. Nerney, U.S. patent 1,984,541, dated December 18, 1934; Exhibit 14, G. E. Nerney, U.S. patent 1,987,701, dated January 15, 1935; Exhibit 15, R. G. Stayman, U.S. patent 2,057,855, dated October 20, 1936; Exhibit 16, F. R. Bishop, U.S. patent 2,063,657, dated December 8, 1936; Exhibit 17, A. F. Williams, U.S. patent 2,069,347, dated February 2, 1937; Exhibit 18, A. F. Williams, U.S. patent 2,091,296, dated August 31, 1937; Exhibit 19, J. Savoie, Canadian patent 118,602, dated May 25, 1909, the Canadian equivalent of Exhibit 7; Exhibit 20, E. Reach, United Kingdom patent 15,461 of 1907; and Exhibit 21, B. Merth, United Kingdom patent 29,840 of 1912. In addition counsel filed two other patents, namely, Exhibit 4, E. E. Emons, Canadian patent 274,841, dated October 25, 1927; and Exhibit 5, C. E. McLeod, Canadian patent 331,430, dated April 4, 1933.

The evidence adduced on behalf of the plaintiff, including the patents referred to, shows that at an early date efforts were made to improve rimless spectacles. The

problem was to overcome their defects, namely, the high rate of breakage of the lenses and their tendency to loosening, and at the same time retain their advantageous features, namely, their lightness, wide range of vision and comparative inconspicuousness. The problem was primarily that of breakage and next that of loosening. It was also desired to reduce the inconspicuousness of rimless spectacles still further. There was certainly a clear recognition of the problem to be solved in the specifications of several of the patents such as, for example, the Stayman, Ferris and Nerney patents.

The evidence establishes that there was no practical contribution to the solution of the problem prior to the 2-point Numont mounting. The inventions covered by the patents, Exhibits 6 to 21, were in the main paper proposals or, where that was not so, had no commercial success. For example, Mr. Kemp for the plaintiff said that he had seen a pair of glasses embodying the structure shown in the Savoie patents, Exhibits 7 and 19, about twenty to thirty years ago. He was struck by the loose temples and remembered the mounting because "it was such an odd-looking thing". Otherwise his memory of it was vague, but he agreed that it was not a practical mounting—it would never stay on. Mr. Kemp also said that he had seen a mounting something like that disclosed in one of the structures in the Stevens patent, Exhibit 8, about twenty years ago, but his recollection of this was also vague. There was also the statement of Mr. Elliott for the plaintiff that he had used some German glasses between 1905 and 1908 which he thought were similar to those described in Exhibit 7 and Exhibit 8. His recollection of them was not clear but they were not at all like the 2-point Numont mounting and he agreed that they were not satisfactory. Of the patents issued after 1930 only two reached the market, namely, the Nerney patent, Exhibit 14, and the Bishop patent, Exhibit 16, but neither was a commercial success. The other Nerney patent, Exhibit 13, did not come into practical use until after it had been substantially modified as shown by Exhibit G described as a Shuron Shurset Rimway. This was in 1940. There was also only a slight use of Exhibit 18. The other patents, Exhibits 4 and 5, were concerned with other

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matters. Without discussing the patents in detail, I think that it may fairly be said that up to the time when the defendant's 2-point Numont mounting came on the market no satisfactory solution of the problem had been found.

When the defendant's mounting came into production in 1938 there was an immediate and wide demand for it and it almost swept other types of rimless spectacle mountings off the market. This was admitted by Mr. Elliott for the plaintiff who said that when it first came it was about 90 per cent of the optician's business. Mr. Goodwin for the defendant also stated that it was the greatest revolution in the optical frame business. The evidence indicates that since then there has been a great trend towards plastic frame spectacles and a great reduction in the use of metal frame spectacles. Several estimates of the extent of this trend and change in use were given by the witnesses but I think that the best evidence was that of Mr. Steg taken from the records of the American Optical Company from 1936 to 1946 and set out in Exhibit K. This shows that in 1936 out of the total frame and mounting shipments of the American Optical Company plastic frames made up 14 per cent, metal frames 45 per cent and rimless mountings 41 per cent. By 1946 plastic frames had increased to 40 per cent and rimless mountings including the 2-point Numont mounting to 47 per cent, while metal frames had decreased to 13 per cent. Mr. Uhlemann's evidence shows an even greater tendency towards plastic or shell frames. He took the records of the defendant's sales of various types of frames and mountings in July 1941 as compared with those in July 1947. In July 1941 rimless mountings made up 57 per cent of the sales, shell frames 25 per cent and metal frames 18 per cent; in July 1947 the rimless mountings had gone down to 33 per cent and the metal frames to 6 per cent, but the shell frames had gone up to 61 per cent. He thought that the shell frames had reached their peak. Mr. Trebilcock for the defendant said that in 1936 his sales were 20 per cent plastic frames, 30 per cent metal frames and 50 per cent rimless mountings and that in 1947 they were 35 per cent plastic frames, 5 per cent metal frames and 60 per cent rimless. In his opinion, the Numont construction had increased the sale of rimless glasses considerably. Although

there is some evidence to the contrary it is established by the weight of evidence that the defendant's 2-point Numont mounting has maintained its leadership in the field of rimless spectacle mountings even after the introduction of various Rimway mountings. In these the temple supporting wire is connected with the upper outer edge of the lens by a lug extending from the wire with a hole drilled through it and the lens and a screw holding the lug and the lens together. There is also a strap connection with the lens at the nasal end. Thus there are two points of connection for each lens making a 4-point mounting, instead of only one connection with each lens as in the case of the 2-point Numont mounting. The only evidence against Numont's leadership in the field was that of Mr. Kemp and Mr. Elliott for the plaintiff. Mr. Kemp said that the 2-point Numont mounting made up only about 2 per cent of R. N. Taylor's sales of rimless mountings but admitted that his estimate was pretty much of a guess. Mr. Elliott, a strong supporter of the superiority of the 4-point Rimway mounting, said that the 2-point mounting, although originally 90 per cent of the opticians' business, was now not 2 per cent of it, the four-point being 60 per cent and the rest shell. On cross-examination he said that he didn't sell 2-point mountings and didn't even keep any in stock. The evidence for the defendant is all the other way. Mr. Trebilcock said that he did not believe in the 4-point mounting and that his sales of it would be less than half of 1 per cent of his total sales; 95 per cent of his rimless mounting sales were Numonts. Three Ottawa optometrists and opticians gave evidence to the like effect. Mr. Ryde said that he sold or prescribed ten Numonts to one Rimway; Mr. Goodwin said that the 4-point compared with the Numont would be less than half of 1 per cent; and Mr. Bastien that his sales were 98 per cent Numont and 2 per cent Rimway. But the most comprehensive evidence was that which Mr. Steg set out in Exhibit L. This shows all the American Optical Company's Numont shipments expressed as a percentage of all its rimless mountings shipments. In 1938 Numont was 7 per cent of the total, in 1939 50 per cent, in 1942 and 1944 a high of 84 per cent and in 1946 76 per cent. There is also the evidence of Mr. Uhlemann as to the

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defendant's sales. It has sold 4-point Rimways ever since 1940. In July 1941 its sales of Numont mountings was 75 per cent of its total rimless sales and its sales of Rimways about 5 per cent. In July 1947 its sales of these mountings were respectively 88 per cent and 9 per cent of its total. There can, I think, be no doubt that the Numont mounting is the leader in the rimless mounting field. Moreover, its total production since its introduction has been tremendous. The mounting is made by licensees under the patent who pay a royalty to the defendant of 2 cents per mounting. Mr. Uhlemann gave particulars of the number of mountings on which such royalties had been paid in each year up to the end of 1946. The first commercial production was in 1938 when 239,081 mountings were made. This rose in 1939 to 1,212,562 and reached a peak of 3,301,510 in 1944. In 1946 the figure was 2,865,871 and by the end of that year the total number of mountings had come to 20,599,894. There is thus no doubt that the defendant's 2-point Numont mounting was a great commercial success.

The evidence also establishes that the 2-point Numont mounting went a considerable distance towards solving the problem to which the inventor had addressed himself. There was really no substantial dispute of this fact. Counsel for the plaintiff sought to establish that certain 4-point mountings, such as Exhibits E, F and G, which I refer to generally as Rimway mountings, that came on the market after the defendant's 2-point mounting did, were superior to it. In my view, this evidence was, strictly speaking, irrelevant to the issue before the Court. We are not here concerned with comparison between the 2-point Numont mounting and mountings covered by patents subsequent to the patent in suit but with the question whether the Numont mounting was an advance over the previous art for which a patent could validly issue.

The evidence is conclusive that the defendant's mounting made a substantial contribution to the solution of the problem of breakage. Mr. Trebilcock said that as compared with rimless spectacles of the existing type (Exhibit C) it cut the breakage more than 50 per cent and Mr. Uhlemann's evidence was to the same effect. There was no contradiction of this evidence by either of the plaintiff's

witnesses and I accept it as true. Mr. Elliott did express the opinion that there was more breakage of lenses with the 2-point Numont mounting than with the 4-point Rimway one. But even on this point the weight of evidence and opinion was against him. Mr. Trebilcock thought that the Numont construction would not break as easily as the 4-point. And Mr. Uhlemann, Mr. Ryde and Mr. Goodwin all gave it as their experience that there was less breakage with the Numont mounting than with the Rimway one.

It is also clear that there was much less loosening of the lenses with the 2-point Numont mounting than with the former rimless spectacles. There was no contradiction of this evidence. And it would appear from the evidence of Mr. Trebilcock, Mr. Ryde, Mr. Goodwin and Mr. Bastien that there was also less loosening of the lenses with the 2-point Numont mounting than with the 4-point Rimway one. On the other hand, there was evidence of a greater tendency towards lens sag in the case of the Numont mounting. Mr. Kemp found this a great disadvantage and said that it was necessary to correct it by drilling a hole in the lens at the upper outer corner and fastening it by means of a clip over the temple arm and embracing the lens secured with a screw through the clip and the lens. He could not tell how many clips he put on in a year. The witnesses for the defendant found little difficulty with lens sag and said that clips were seldom used. Mr. Trebilcock had used only half a dozen, Mr. Uhlemann only one in five hundred cases and Mr. Bastien some, while Mr. Goodwin had not seen them in use at all. Mr. Uhlemann gave the best evidence on the subject of lens sag. It was caused by the shoe or bottom or lens edge engaging portion of the strap becoming bent away from the edge of the lens and the ears of the strap becoming bent away from the sides. He agreed that there had been a great deal of work in the industry to overcome this such as by the use of special kinds of straps with springs in them. He did not consider that the use of clips would help, but rather that it would be harmful in that it would obstruct vision, weaken the lens and tend to revert back to the type of 4-point mountings with their liability to breakage from which the Numont mounting had sub-

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stantially escaped. In the meantime, the correction of the sag was a simple matter of adjustment which all opticians made freely. As I see it, the advance made by the defendant's mounting in solving the various problems of loosening, including lens sag, was substantial but not as great as that made in solving the problem of breakage.

Nor is there any doubt that the defendant's mounting by taking off the strap connection of the temple at the upper outer edge of the lens rendered the spectacles less conspicuous than either the old 4-point rimless ones or those with the 4-point Rimway mounting.

I now come to the question of what change there was in the 2-point Numont mounting from the prior art that made these results possible and whether such change was a patentable invention. But before this is dealt with it is desirable to refer to some of the parts of the mounting. They are basically nine in number, namely, two guard arms with pads, two straps, a bridge, two temple supporting wires or temple arms and two temples or end pieces. These are soldered or otherwise joined together to make one mounting before they are delivered to the optical trade. We are not in this case concerned with the guard arms with the pads that rest on the nose or the temples, being the end pieces which extend over the ears, but only with the straps, the bridge and the temple supporting wires or temple arms. A brief description of each may be helpful. The specification speaks first of the straps as "a pair of channel-like straps each having a lens-edge engaging portion with ears extending therefrom for embracing the edges and adjacent portions of the lenses". Each channel-like strap consists of two ears or wings for holding the sides of the lens joined by a bar or strip forming the bottom of the channel for engaging the edge of the lens and conforming to its curved shape. A cross section of this strap looks like a U, the uprights or legs embracing the sides of the lens between them and the bottom engaging its edge. The bar or strip forming the bottom of the channel is called the lens edge engaging portion of the strap. The back of this is soldered to the end of the bridge. The portions of the strap holding the sides of the lens were in various forms, such as the diamond-shaped ears in Exhibit 30, which Mr. Elliott described as lugs, or the longer

wings in Exhibit H which Mr. Uhlemann described. There were several ways in which the lens could be held in the strap. One was by drilling a hole in the lens and holding it by a screw through the diamond-shaped ears and the lens as in Exhibit 30. There was also the method described by Mr. Uhlemann and embodied in Exhibit H, namely, that slots were cut diagonally in the edge of the lens and lugs in the bottom of the strap were angled to fit into these slots making a dovetailed construction held tight with a thermoplastic cement. In this method no hole was drilled through the lens. This was called the Everloct strap. There was also a combination of the screw and cement strap. Moreover, there were variations in the lens edge engaging portion of the strap. In some cases it was equipped with springs, either diaflex or triflex, whereas in others the portion was rigid. Originally there were several widths of straps, but now there are only two in general commercial use. Moreover, straps were used not only for the connection of the lens at its nasal edge but also for its connection with the temple at the outer edge as in the case of the rimless spectacles, Exhibit C. The other parts may be referred to briefly. The bridge is a saddle bridge that rests on the nose, with its ends secured to the back of the straps. The temple supporting wires or temple arms are also anchored to the straps at their nasal end, as hereinafter amplified, and then follow along and behind the edge of the lens until they are joined to the temples or end pieces with a hinge that enables the mounting to be folded flat to fit into a case.

There was no novelty in any of the parts, all of which were well known in the art prior to 1930. No invention is claimed in respect of the straps or any part thereof or in any springs or method of engaging either the sides or edge of the lens or the bridge or the temple arms. So that whatever invention there may be in the defendant's mounting lies, not in any part or parts, but in the manner of attachment of some of them.

Counsel for the defendant referred to two of the objects set out in the specification, namely, to provide an improved temple mounting which prevents strain from being transmitted to the lenses and one which will be inconspicuous in appearance, these being the principal objectives that

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were being sought in the industry, and submitted that the Uhlemann invention consisted in the elimination of the connection of the temples at the outer edge of the lens and the connection of the temple supporting wires or temple arms to the lens edge engaging portion of the straps at the nasal edge. The desirability of having a single point connection with the lens, as, for example, in the Stayman patent, was not new. Nor was it a new idea to have the temple arms connected somewhere near the nasal side of the lens, as in the Savoie patents, Exhibits 7 and 19, or the Stevens and Savoie patents, Exhibits 8 and 9. The invention did not, therefore, consist in having a 2-point mounting instead of a 4-point one, or in having the temple arms connected somewhere near the nasal end of the lens. The inventive idea lay in having a mounting in which there is a single point connection with the lens and the temple arms are connected at a specific place near the nasal edge of the lens, namely, to the lens edge engaging portion of the strap. It was the essence of the invention to have the temple arms so connected. No one had thought of having a single point connection with the lens with the temple arms connected at this point until Uhlemann brought out his 2-point Numont mounting. It succeeded in preventing strain from being transmitted to the lenses with the result that there was a reduction of at least 50 per cent in breakage and a substantial reduction in loosening, while at the same time the spectacles were made less conspicuous and none of the advantageous features of the rimless spectacles were lost. The 2-point Numont mounting thus brought success where other attempts to reach the desired objectives had failed. The embodiment of the inventive idea is clearly shown in the drawings of the specification. In every case, except in figures 10 and 12, they show the connection of the temple arm as being to the lens edge engaging portion of the strap. And it is to the securing of the temple arm at the lens edge engaging portion of the strap that all the claims are directed. The structures shown in figures 10 and 12 are excluded from the claims. The thread which runs through all the claims is the connection of the temple arm to the lens edge engaging portion of the strap at the nasal edge of the lens. In my opinion, counsel for the defendant has correctly set

out the essence of the alleged invention. I do not think that any person skilled in the art who read the specification would have had any doubt about it or how to carry it into effect.

I now come to the attacks on the patent. Lack of novelty and lack of subject matter as grounds for holding a patent invalid are closely related, but are not the same. Lindley L.J. pointed out the difference in *Gadd and Mason* v. *The Mayor of Manchester* (1):

> In considering subject-matter, novelty is assumed; the question is whether, assuming the invention to be new, it is one for which a patent can be granted. In considering novelty, the invention is assumed to be one for which a patent can be granted if new, and the question is whether on that assumption it is new. Has it been disclosed before? If there is an earlier specification for the very same thing, the second invention is not new; but if the two things are different, the nature and extent of the difference have to be considered. The question then becomes one of degree. But unless it can be said that the differences are practically immaterial; that there is no ingenuity in the second invention, no experiment necessary to show whether it can be usefully carried out or not, the second cannot be said to have been anticipated by the first.

The attack on the patent for lack of novelty was on the ground that the alleged invention had been anticipated by prior patents. The requirements that must be met before an invention should be held to have been anticipated by a prior publication have been discussed in many cases and may be stated briefly. The information as to the alleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent. Whatever is essential to the invention or necessary or material for its practical working and real utility must be found substantially in the prior publication. It is not enough to prove that an apparatus described in it could have been used to produce a particular result. There must be clear directions so to use it. Nor is it sufficient to show that it contained suggestions which, taken with other suggestions, might be shown to foreshadow the invention or important steps in it. There must be more than the nucleus of an idea which, in the light of subsequent experience, could be looked on as being the beginning of a new development. The whole invention must be shown to have been published with all the directions necessary to instruct the public how to put it into practice. It must be so pre-

(1) (1892) 9 R.P.C. 516 at 525.

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sented to the public that no subsequent person could claim it as his own. This statement is merely a summary of the views expressed by Lord Westbury L.C. in *Hill* v. *Evans* (1); Parker J. in *Flour Oxidizing Company Ld.* v. *Carr & Co. Ld.* (2); Fletcher Moulton L.J. in *British Ore Concentration Syndicate Ld.* v. *Minerals Separation Ld.* (3); and Lord Dunedin in *Armstrong, Whitworth & Co. Ld.* v. *Hardcastle* (4); *British Thomson-Houston Co. Ld.* v. *Metropolitan-Vickers Electric Co. Ld.* (5); and *Pope Appliance Corporation* v. *Spanish River Pulp and Paper Mills Ld.* (6). In the last mentioned case Viscount Dunedin, who delivered the judgment of the Judicial Committee of the Privy Council, put the test in these words:

> Would a man who was grappling with the problem solved by the Patent attacked, and having no knowledge of that patent, if he had had the alleged anticipation in his hand have said, "That gives me what I wish"?

and later, at page 56:

> Does the man attacking the problem find what he wants as a solution in the prior so-called anticipations.

Vide also the judgment of the Judicial Committee in *Canadian General Electric Co. Ld.*, v. *Fada Radio Ld.* (7) where the resume of the decisions made by Maclean J. in this Court was said to be an accurate statement of the law on the subject.

It must be kept in mind, of course, that in considering whether an invention was anticipated by a prior patent, the prior patent must be read in the light of the common knowledge which a person skilled in the art would have had immediately prior to the alleged invention: *Vide King, Brown, and Co.* v. *The Anglo-American Brush Corporation* (8); *Savage* v. *Harris & Sons* (9); and *Van Berkel et al* v. *R. D. Simpson Ld.* (10). If the prior publication would give such a person the same information, for practical purposes, as the patent under attack then it is an anticipation of the invention covered by it.

In support of his contention that the Uhlemann invention had been anticipated by prior patents counsel for the

(1) (1862) 4 De G, F & J 288 at 301.
(2) (1908) 25 R.P.C. 428 at 457.
(3) (1909) 26 R.P.C. 124 at 147.
(4) (1925) 42 R.P.C. 543 at 555.
(5) (1928) 45 R.P.C. 1 at 23.
(6) (1929) 46 R.P.C. 23 at 52.
(7) (1930) 47 R.P.C. 69 at 90.
(8) (1892) 9 R.P.C. 313 at 321.
(9) (1896) 13 R.P.C. 364 at 368.
(10) (1906) 23 R.P.C. 237 at 258.

plaintiff relied primarily upon the Savoie patents, Exhibits 7 and 19. His submission was that Figure 2 of Exhibit 19 showed that the temple arm was connected to the shank of the bridge; that the bridge was integral with what he called the lens edge engaging means; that the only difference between Figure 2 of Exhibit 19 and claim 1 of the patent in suit was that in the former the connection of the temple arm was removed from the lens by the length of the shank of the bridge whereas in the latter it was closer to the lens; and that Mr. Kemp had said that there would be no technical difficulty in attaching the arm to the lens edge engaging means or to the strap. From this he argued that the said Savoie patents anticipated the invention covered by the patent in suit; that their disclosure of the connection of the temple arm at the bridge would give a workman skilled in the art the solution of the problem; and that putting the connection at the lens edge engaging portion of the strap would be obvious to him as merely a workshop improvement that did not involve the exercise of any inventive ingenuity. I am unable to accept this submission. Savoie was not concerned with the problem of breakage or loosening of lenses and his invention was not even remotely related to its solution. The specifications in Exhibits 7 and 19 show that the object of his invention was to devise a temple arm connection that would keep the lens at the proper distance from the eyes of the wearer. That being so it was clear that the temple arms had to be back from the lens. Any attachment nearer to it would, therefore, defeat its very purpose. In my judgment, no one reading the specifications could possibly be directed towards the idea of having the connection of the temple arm at the lens edge engaging portion of the strap or anywhere near the lens. On the contrary, he would be definitely led away from it. The information given by the Savoie patents, Exhibits 7 and 19, was materially and substantially different from that of the patent in suit and I find no support for the submission that the Uhlemann invention was anticipated by them.

It was also submitted that the Uhlemann invention was anticipated by the Stevens patent, Exhibit 8, and the Savoie patent, Exhibit 9. In both of these there was a temple arm secured near the nasal edge of the lens. In Figure 3 of

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Exhibit 8 there was really no strap and the end of the bridge, the lens and the head of the temple arm were all held together by one screw. In Figure 6 there was a strap and the head of the temple arm was held between one ear of the strap and the lens by a screw. In Figure 4 of Exhibit 9 the head of the temple arm was outside one of the ears of the strap and held with the strap and the lens by a screw. Counsel did not press his submission as to Exhibit 8 seriously, but did urge that Exhibit 9 was an anticipation of claims 4 and 6 of the patent in suit in that it showed the connecton of the temple arm at the strap as the said claims did; that any difference in construction was purely a workshop improvement; that there was no patentable distinction in the other claims, there being no invention involved in having the temple arm connected to the lens edge engaging portion of the strap, and that such a connection would be obvious from the Savoie invention. I do not agree. I accept Mr. Uhlemann's evidence that the construction shown in these two patents was quite impractical, but that is not necessarily the test of whether they were anticipations of the Uhlemann invention. The objection to the submission is more serious. In both of the patents the temple arm is so held at the nasal edge of the lens that any pressure on it would make it act like a lever and transmit strain to the screw and through it to the lens. This would inevitably result in loosening and breakage of the lenses, the very thing that Uhlemann was seeking to avoid. Certainly, if he had not made his own discovery and had had the Savoie and Stevens patents in his hand he would not have said, "That gives me what I wish." No one seeking to reduce the breakage and loosening of lenses could have found a solution of his problem in anything he saw in Exhibits 8 and 9. There was nothing anticipatory of the Uhlemann invention in either of them.

It was also urged that the Nerney patent, Exhibit 13, was an anticipation. But this was based on the contention that the claims of the patent in suit were broad enough to include a 4-point connection and that there was nothing to show that they were confined to a 2-point one. There is a simple answer to this. It is true that there is no claim which says expressly that the temple arm is connected to the lens edge engaging portion of the strap and is not con-

nected anywhere else. It is not necessary that an inventor should set out what is not included in his invention for what is not claimed is disclaimed. There is nothing in the specification to suggest that Uhlemann was thinking of a 4-point connection and no claim could reasonably be construed as extending to it. That, of course, disposes of the Nerney patent, Exhibit 13, as an anticipation of the Uhlemann invention. It showed a 4-point mountng and there was no strap. There was no information in it that would have led anyone to the Uhlemann invention. It was not an anticipation of it.

Nor, in my judgment, was there anything anticipatory of it in any of the other prior patents.

This leaves only the issue of subject matter. There is a presumption of validity in favor of the patent by reason of its issue and the onus of proving that it is invalid for lack of invention is on the person attacking it, in this case, the plaintiff. The onus is not an easy one to discharge. No one has really succeeded in defining, apart from the statutory definition, the difference between an advance that is obvious as a workshop improvement and one that involves inventive ingenuity. One of the difficulties is that there is no objective standard of invention. What one person might regard as inventive another would consider as obvious.

In the present case, counsel for the plaintiff submitted that Mr. Kemp had said that there would be no difficulty involved in attaching the end of the temple holding means in the Savoie patent to the strap instead of having it attached at the end of the shank of the bridge and contended that the connection of the temple arm to the lens edge engaging portion of the strap as claimed in the patent would be obvious as a workshop improvement to a person skilled in the art and did not involve any inventive step.

I have come to the conclusion, for several reasons, that this contention ought not to be accepted. This *ex post facto* analysis of the invention is not sound. I am supported in this view by the statement of Fletcher Moulton L.J. in *British Westinghouse Electric and Manufacturing Company Ld.* v. *Braulik* (1):

I confess that I view with suspicion arguments to the effect that a new combination, bringing with it new and important consequences in

(1) (1910) 27 R.P.C. 209 at 230.

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the shape of practical machines, is not an invention, because, when it has once been established, it is easy to show how it might be arrived at by starting from something known, and taking a series of apparently easy steps. This *ex post facto* analysis of invention is unfair to the inventors, and in my opinion it is not countenanced by English Patent Law.

and the approval of it given in the House of Lords by Lord Russell of Killowen in *Non-Drip Measure Coy. Ld.*, v. *Stranger's, Ld., et al* (1) with his additional remarks:

> Whether there has or has not been an inventive step in constructing a device for giving effect to an idea which when given effect to seems a simple idea which ought to or might have occurred to anyone, is often matter of dispute. More especially is this the case when many integers of the new device are already known. Nothing is easier than to say, after the event, that the thing was obvious and involved no invention.

And in the same case Lord Macmillan said, at page 143:

> It might be said *ex post facto* of many useful and meritorious inventions that they are obvious. So they are, after they have been invented.

The fact that it was easy to connect the temple arm at the point where Uhlemann did once the idea of doing so had been thought of is thus no evidence of lack of invention. There is support of this in *Hickton's Patent Syndicate* v. *Patents and Machine Improvements Company Ld.* (2). There the Court of Appeal reversed the judgment of Swinfen-Eady J., who had held the patent invalid, and Fletcher Moulton L.J., at page 347, made the following comments with regard to the views expressed by the trial judge:

> The learned Judge says: "An idea may be new and original and very meritorious, but unless there is some invention necessary for putting the idea into practice it is not patentable." With the greatest respect for the learned Judge, that, in my opinion, is quite contrary to the principles of patent law, and would deprive of their reward a very large number of meritorious inventions that have been made. I may say that this dictum is to the best of my knowledge supported by no case, and no case has been quoted to us which would justify it. But let me give an example. Probably the most celebrated Patent in the history of our law is that of *Bolton* and *Watt*, which had the unique distinction of being renewed for the whole fourteen years. The particular invention there was the condensation of the steam, not in the cylinder itself, but in a separate vessel. That conception occurred to *Watt* and it was for that that his Patent was granted, and out of that grew the steam engine. Now can it be suggested that it required any invention whatever to carry out that idea when once you had got it? It could be done in a thousand ways and by any competent engineer, but the invention was in the idea, and when he had once got that idea, the carrying out of it was perfectly easy. To say that the conception may be meritorious and may involve invention and may be new and original, and simply because when you have once got

(1) (1943) 60 R.P.C. 135 at 142. (2) (1909) 26 R.P.C. 339.

the idea it is easy to carry it out, that that deprives it of the title of being a new invention according to our patent law, is, I think, an extremely dangerous principle and justified neither by reason, nor authority. Invention may, therefore, be present notwithstanding the fact that there was no difficulty in putting the idea into effect once it had been conceived.

Counsel for the defendant urged that there was evidence of invention in the fact that the 2-point Numont mounting solved a problem and supplied a want when other efforts to do so had failed and that when it came on the market it was a great commercial success. It is clearly established that the practical utility and commercial success of an invention may be a material factor in determining whether the new result produced by it was obvious or involved inventive ingenuity. Commercial success by itself, without the solution of a problem, is not sufficient to establish subject matter: *vide Longbottom* v. *Shaw* (1); *Heginbotham Brothers, Ld., et al* v. *Burne* (2). But where there is evidence of a problem and a solution of it then commercial success is strong evidence of invention. That was the effect of the statement of Tomlin J. in *Samuel Parkes & Co. Ld.* v. *Cocker Brothers Ld.* (3):

> Nobody, however, has told me, and I do not suppose anybody ever will tell me, what is the precise characteristic or quality the presence of which distinguished invention from a workshop improvement..... The user of this particular clip has been large. Over 1¼ millions were sold up to the end of 1927. The Railway Companies have adopted it as standard and to that extent it has beaten its competitors out of the field. The truth is that, when once it had been found, as I find here, that the problem had waited solution for many years, and that the device is in fact novel and superior to what had gone before, and has been widely used, and used in preference to alternative devices, it is, I think, practically impossible to say that there is not present that scintilla of invention necessary to support the Patent.

This statement was quoted with approval in the House of Lords by Lord Russell of Killowen in *Non-Drip Measure Coy., Ld.* v. *Stranger's Ld., et al* (4) where he said:

> it is always pertinent to ask, as to the article which is alleged to have been a mere workshop improvement, and to have involved no inventive step, has it been a commercial success? Has it supplied a want?

Then, at page 143, after citing the statement of Tomlin J. as apposite, he went on:

> As to the commercial success of the Plaintiff's patent there can, in my opinion, be no doubt. In 1935, 430 measures were sold; in 1936, 7,996;

(1) (1891) 8 R.P.C. 333 at 336.
(2) (1939) 56 R.P.C. 399 at 413.
(3) (1929) 46 R.P.C. 241 at 248.
(4) (1943) 60 R.P.C. 135 at 142.

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in 1937, 16,700, and in 1938, 18,400. In the war years the sales naturally fell off, but the success of the machine was immediate and great. That there was a need for such a machine was clear from the defects in those already on the market. Nor should it be forgotten that as far back as the year 1908 *Newland* was trying to solve the problem of producing a machine which would deliver measured quantities of liquid without requiring one hand of the operator to be left free to operate the valve. He failed to produce a practical or marketable machine. It was not until some 27 years have elapsed that the successful machine is forthcoming which achieves the object at which *Newland* aimed. My Lords, if during that long period it only required a workman to be told to adapt *Newland* to upward pressure, for him to produce a machine as claimed in the Plaintiff's patent, it is hard to understand why the production was so long delayed. There can, I think, be only one explanation, and it is that before such a machine could be produced an inventive step had to be taken, and that those who took out the Plaintiff's patent were the first to take it.

Counsel for the plaintiff submitted that the present case fell outside the ambit of the principles laid down in these cases. His argument was that the commercial success of the 2-point Numont mounting was due to factors extraneous to the invention, such as extensive advertising and the inducement of high profits held out to the dispensers of the mountings; that there was no evidence of any problem or long-felt want; and that if there was any such problem or want there was no evidence that it had been solved or met by the alleged invention.

I am not able to agree. There is no evidence of any unusual or excessive advertising. The defendant's mounting was advertised by the American Optical Company and by individual licensees and, no doubt, a large amount of money was spent in promoting sales, but there is nothing to show that there was any unusually extensive promotional campaign. It is also true that the dispensers of spectacles were given a larger profit than they had made on the rimless spectacle mounting. It sold for $8.00 and the dispenser paid $2.90 for it, whereas the 2-point Numont mounting cost him $4.85 and he had to sell it for not less than $11.00. If he bought more than twenty-five mountings at a time the price was reduced to $3.15 each and if his business reached a volume of $10,000 he was entitled to big dealer discounts. Moreover, dispensers were freely and widely licensed. Undoubtedly, these were important factors in the commercial success of the mounting. But the evidence also shows that dealers made no larger profits by selling the 2-point Numont mountings than by selling the various 4-point Rimway ones

that came on the market later and in some cases the profit was less than in the case of the newer introductions. But while advertising, the inducement of large profits to dispensers and the wide licensing of them account for some of the commercial success they cannot account for all of it, nor the fact that the 2-point Numont mounting almost swept the former rimless spectacle, Exhibit C, mountings off the market and has maintained its unquestioned leadership in the rimless spectacle field even against the competition of the new 4-point Rimway mountings on which dealers made just as great a profit. It is, I think, reasonable to say that a substantial part of the commercial success of the mounting was due to the fact that it had succeeded in overcoming the disadvantages of the heavy rate of breakage and the tendency to loosening of lenses to which rimless spectacles were subject without sacrificing their advantages and had thus given satisfaction to its users who by the end of 1946 numbered over 20 million. Moreover, I am unable to agree with the argument that there was no evidence of a problem to be solved or a want to be supplied. As in the *Non-Drip Measure Company* case (*supra*) Lord Russell of Killowen held that the need for the patented machine was shown by the defects in machines already on the market so in this case the need for the 2-point Numont mounting is clear from the defects of breakage and loosening of lenses to which rimless spectacles were subject. And it is incorrect to say that there was no evidence of the existence of the problem. The specifications of the patents put in evidence on behalf of the plaintiff, such as the Stayman, Ferris and Nerney patents, show a clear recognition of it. And I have already found that the 2-point Numont mounting made a substantial contribution to the solution of the problem. The evidence is conclusive that it reduced the breakage that had occurred with rimless spectacles, Exhibit C, by over 50 per cent. Indeed, there is no evidence that denies that fact. And I also find on the weight of evidence that there was less breakage with the 2-point Numont mounting than with the various 4-point Rimway ones. The evidence is similar, as I have already pointed out, with regard to the loosening of lenses, subject to what has been said as to lens sag. The reduction in the rate of breakage

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and in the tendency to loosening was, in my judgment, clearly attributable to the Uhlemann invention of connecting the temple arm to the lens edge engaging portion of the strap. This, I think, achieved the object of preventing strain from being transmitted to the lenses. It might have been desirable to have had evidence of a scientific test of this, but I am satisfied from such tests as were made before me by the witnesses and from the evidence that there was less strain put on the lenses as the result of the invention than would otherwise have been the case. There can be no successful contradiction of this so far as the rimless spectacles, Exhibit C, are concerned. And the weight of evidence and opinion indicates that this was also true so far as the 4-point Rimway was concerned. As I see it this was really a re-inforced rimless. In the old rimless spectacles, Exhibit C, the strain from normal use and from bending the temples was almost all transmitted to the lenses, both at the temple and at the nasal ends, whereas in the 2-point Numont mounting it was taken from the lenses and transmitted to the back of the strap and thereby to the bridge, and in the case of the 4-point Rimway mountings some of the strain continued to be transmitted to the lenses. If the connection of the temple arm to the lens edge engaging portion of the strap, which thus produced the desired result of taking the strain off the lenses, was only a workshop improvement and would be obvious to any person skilled in the art it seems strange that no one should have thought of it before Uhlemann.

In my judgment, the facts of this case bring it within the ambit of the principles laid down by Tomlin J. in *Samuel Parkes & Co. Ld.* v. *Cocker Brothers Ld.* (*supra*) and Lord Russell of Killowen in the *Non-Drip Measure Company* case (*supra*) and I apply them accordingly. Under the circumstances, I am unable to find that there was no invention in what Uhlemann did. It would, I think, be more reasonable to say that the result accomplished by him did involve the taking of an inventive step and that he was the first to take it, and I so find.

I am also of the view that if there were any doubt as to the validity of the patent by reason of lack of invention the commercial success of the 2-point Numont mounting

and its substantial displacement of the rimless spectacle mountings previously in use would be sufficient to turn the scale in its favor. That was the view of the Supreme Court of the United States in *Smith* v. *Goodyear Dental Vulcanite Company et al* (1). There Mr. Justice Strong, delivering the opinion of the Court, said, at page 495:

> We do not say the single fact that a device has gone into general use, and has displaced other devices which had previously been employed for analogous uses, establishes in all cases that the later device involves a patentable invention. It may, however, always be considered; and, when the other facts in the case leave the question in doubt, it is sufficient to turn the scale.

In any event, the plaintiff has not discharged the onus of proving that the patent was invalid and the presumption of validity in its favor continues. The plaintiff's action for a declaration of invalidity is, therefore, dismissed with costs.

Judgment accordingly.