

1921
Sept. 6.

HIS MAJESTY THE KING PLAINTIFF;

AND

JOSEPH TESSIER DEFENDANT.

Patent—Novelty—Invention—Old and known device—adapted to new and analogous use.

T. conceived the idea of sticking on a file cover a “pocket adapted to receive and conceal one end of the fastener.” The same idea had long been in use in connection with garments.

Held: That the mere carrying forward or applying of an original thought, or of an old and well known principle or device, from one use to another, doing substantially the same thing, in the same manner by substantially the same means, is not such an invention as will sustain a patent. That a patent granted for such a new use does not possess any element of invention and does not involve a creative work of inventive faculty such as is contemplated by the patent law and which the Patent Act intended to encourage and reward.

2. That estoppel cannot be invoked against the Crown.

ACTION on behalf of the Crown, to impeach and annul the patent of invention for “File Covers and Holders” granted to the defendant.

June 23rd, 1921.

Case now tried before the Honourable Mr. Justice Audette at Ottawa.

R. V. Sinclair K.C., for plaintiff.

Harold Fisher and R. S. Smart for defendant.

The facts are stated in the reasons for judgment.

AUDETTE J. now (this 6th September, 1921) delivered judgment accordingly.

This is an action on behalf of the Crown, to impeach and annul the patent of invention No. 167,102, for "File Covers and Holders," granted to the defendant, on the 11th January, 1916.

The specification attached to the letters patent describes the "file covers and holders," as follows:

"My invention relates to a file cover with envelope extension flap, being provided with a binder—or clasp-holder and with an adjustable locking attachment, and the objects of my invention are, first, to provide a binding process for a file of papers without the binder or clasp, so used, interfering with neighbouring or adjacent files; second, to provide a holder or envelope for a file of papers without using unnecessary space, and, third, to provide a cover for a file of papers that will not fray and wrinkle up under conditions existing in the average file drawer.

Then, after explaining the drawing, the specification concludes by saying, to wit:—

"I am aware that, prior to my invention, one or more of the devices used in my folder, have been used for securing papers or books; I do not, therefore, claim such devices separately; but

"What I do claim as my invention, and desire to secure by letters patent, is:

"1. A file cover and holder comprising a covering jacket and a strip secured thereto forming a pocket adapted to receive and conceal one end of the fastener used in filing.

"2. A file cover and holder comprising a foldable covering jacket and a strip secured thereto forming a pocket adapted to receive and conceal one end of a fastener used in filing.

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“3. A file cover and holder comprising a foldable covering jacket, a strip secured thereto forming a pocket adapted to receive and conceal one end of a fastener used in filing and means for fastening the folded edges of the covering jacket together.

“4. A file cover and holder comprising a foldable covering jacket, a strip secured at one end thereof forming a pocket adapted to receive and conceal one end of a fastener used in filing and means for fastening the folded edges of the covering jacket together.”

By examining exhibit A, which is filed as a sample of the defendant's patented article, it will readily appear that there is nothing new, and that no patent could be claimed for a folding covering jacket, and that what is really claimed by the defendant, as more clearly disclosed by his oral testimony at trial, is the strip forming a pocket which conceals the head of the fastener used in the file, and which is covered by claims Numbers 1 and 2. Then by claims 3 and 4, the same is claimed with this difference that the word “thereto” is used in the second line of claim No. 3, after the word “secured,” and that in the 4th claim the words “at one end thereof” is substituted for the word “thereto.” But claims 3 and 4 further claim a “means for fastening the folded edges of the covering jacket together,” as explained in the drawing by letters E-E which is old and offers no new feature.

The defendant, who is a civil servant employed in the Record room of the Department of Railways and Canals, being in charge of the records of the Department, it was part of his duties, for a number of years to look after the several departmental files. These files, made up of several documents attached together by means of a paper fastener, were placed inside what was called at trial, a backing cover. The defendant

contends that they encountered trouble with such files in that the head of the fastener, exposed on the outside of the cover, used to catch on the other files and cut the paper, and that the head of the fastener would also scratch the tops of their desks and cut their fingers in pulling them out of the drawers. Under such circumstances, he says that when "alone at night" he started to think out a method to overcome these troubles, and that he devised this pocket into which the fastener could be introduced thereby preventing the external exposure of the head of the fastener.

From the claims above described, and what has already been said, it will readily be seen that the patent is in itself very narrow.

In England, the Royal Commission on Awards to Inventors does not give a person who has improved a device for the best use of which he was responsible in the course of his daily duties, such consideration as to a person who invented in his spare time a device which had nothing to do with his duties (1).

Now, under the Canadian Patent Act, s. 7, a patent may be granted to any person who has invented any new and useful art, machine, manufacture or composition of matter; or any new and useful improvement therein, which was not *known or used by any other person before his invention thereof*, and which has *not been in public use or sale with the consent or allowance of the inventor thereof*, for more than one year previously to the application for the patent.

Therefore, the subject-matter of the letters patent must be a manufacture or device that is new, useful and involving ingenuity of invention. There must be a new art. The primary test is skilful invention.

(1) Moritz's Post War Patent Practice, p. 61.

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Under our patent law a patent is granted as a reward for invention, whereby restraint upon commercial freedom, in respect of the use of the patented invention necessarily results; and a court cannot be too careful in insisting that it is only when the requirements of the law have been satisfied by the patentee that the public will be prevented from using common and well-known articles or devices for a common purpose.

There is no invention in merely applying well-known things, in a manner or to a purpose which is analogous to the manner or to the purpose in or to which it has been previously applied (1).

The ingenuity of invention consists in discovering the thing. A screw being discovered, a patent cannot be granted every time it is applied to several and distinctive things.

In the present case we must enquire whether this alleged combination implies invention and whether the result therefrom has not been anticipated.

All of the devices mentioned in the four claims of the patent are old, and therefore the question is whether this combination involves ingenuity of invention and actually produced something that was new and involved invention.

It is quite clear we had in the trade, long before the patent was ever thought of, "file covers and holders comprising a covering jacket," with documents attached together by a fastener. The same may be said with respect to the tying of the file together as explained by letters E-E in the drawing, and described in the specification in the following language: "The extension flaps of jacket A are then folded up over the file and locked by some suitable means such as shown at E and E 1."

(1) Nicholas, on Patent Law, 23, and cases therein cited.

The paramount element or feature of the folder is the placing of the head of the fastener inside the backing or cover, within the pocket, thereby overcoming the trouble above mentioned.

Now this very feature of the patent has been in use in garments of different kinds long prior to the patent in question in this case. This device, as disclosed by the evidence, has been in use for over 20 years with respect to collar buttons under the shirt band, in trouser flaps, and in summer waist coats, thereby concealing the head of the fastener or button. Therefore there appears to be no ingenuity of invention in the most meritorious part of the patent. There was nothing new, when the patentee applied for his patent, in any of the devices mentioned in his claims. The same process or operation of concealing the head of fastener, in the manner above referred to, had long been in use in the manufacture of garments; and what the patentee has done was only to adopt without invention the old contrivance of a similar nature in the manufacture of file covers and holders.

The adaptation of an old function or contrivance to a new purpose is not invention—there is no subject matter where no ingenuity of invention has been exercised (1).

The case of *Abell v. McPherson* (2) abundantly confirms my views concerning the present patent. The head note in that case reads as follows: "The plaintiff had obtained a patent for an improved gearing for driving the cylinder of threshing machines; and the gearing was a considerable improvement; but, it appearing that the same gearing had been previously

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(1) Terrell, p. 38.

(2) [1870] 17 Gr. 23 & [1871] 18
Gr. 437.

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used for other machines, though no one had before applied it to threshing machines—it was *held* (affirming the decree of the court below) that the novelty was not sufficient under the statute to sustain the patent.”

And using the very words of Mowat, V.C., in the conclusion of that judgment, it must be said that the use of the pocket in a foldable covering jacket concealing one end of the head of the fastener, similar to those in shirt bands, in trouser flaps and summer waist coats, concealing head of fastener, “is thus an old and well known contrivance, applied to an analagous purpose (on a file cover or holder instead of these garments) and the settled rule is that such an application cannot be patented.”

Again, in the case of *Harwood v. G.N.R. Co.* (1), it was held that: “A slight difference in the mode of application is not sufficient, nor will it be sufficient to take a well known mechanical contrivance and apply it to a subject to which it has not been hitherto applied.”

The transfer of a known thing from one use to another, or to an analogous use, is not a good ground for a patent. See also *Bush v. Fox* (2), and *Brook v. Astor* (3).

The mere saving of labour and expense, and the production of a new and useful result cannot alone support a patent; there must be some “invention” as was held in *Waterous v. Bishop* (4).

The placing of known contrivances to a use that is new, but analagous to the uses to which they had been previously put, without overcoming any fresh difficulty, is no invention (5). “There is no patent-

(1) [1864] 11 H.L. Cas. 654; 11 E.

R. 1488.

(2) [1854] 9 Ex. 651.

(3) [1857] 8 El. & Bl. 478 & 120 E.

R. 178.

(4) [1869] 20 U.C.C.P. 29.

(5) [1914] Re Merten's Patent, 31,

R.P.C. 373 & *Layland v. Boldy*

& Sons [1913] 30 R.P.C. 547.

able invention where the peculiar structure necessarily resulted from the fact that the patentee wanted to combine certain old and familiar elements, and a person skilled in the art would naturally group the 'elements of the combination' in the way the patentee adopted (1).

And in *Blake v. San Francisco* (2), Wood, J., delivering the opinion of the court cited the following words of Gray J. in *Pennsylvania Ry. Co. v. Locomotive Truck Co.* (110 U.S. 490) with approval, to wit:—

"It is settled by many decisions of this court * * * that the application of an old process or machine, to a similar or analogous subject, with no change in the manner of application, and no result substantially distinct in its nature, will not sustain a patent, even if the new form of result has not been before contemplated."

The defendant's patent is made up of a group of well known old devices and contrivances, the result of which had long been anticipated or analogous functions in garments and discloses no invention, no ingenuity of invention. No new result is obtained from the patent, save perhaps the display of a function in file covers and holders which was in existence in garments long before, and was thus anticipated (3).

The mere carrying forward or the application of the original thought—the "pocket adapted to receive and conceal one end of the fastener"—from garments to files, doing substantially the same thing in the same manner by substantially the same means even with better results, is not such invention as will sustain a

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(1) *Eagle Lock Co. v. Corbin* (3) *Acetylene Illuminating Co., Ltd. v. United Alkali Co., Ltd.*, [1904] 22 R.P.C. 145; *Grip Printing & Publishing Co. v. Butterfield* (1883) 11 Ont. A.R. 145.
Cabinet Lock Co. [1894] 64 Fed. R. 789.
 (2) [1885] 113 U.S.R. 679 at p. 682.

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patent. The patent does not possess any element of invention, it does not involve in any sense, a creative work of inventive faculty, such as contemplated by the patent law and which the Patent Act intended to encourage and reward (1).

In the view I have taken of the case a passing word only will be sufficient in respect of the prior state of the art and publication, as well as to the question of estoppel resulting from the payment on one occasion of a small royalty when the Printing Bureau manufactured a few jackets similar to Exhibit "A."

Had I to consider the state of the prior art resulting from the American patents filed by the plaintiff, and especially with respect to Exhibit No. 3, I would be forced to find against the defendant.

The question of estoppel raised by the statement in defence has not been mooted at bar on behalf of the defendant. It will be sufficient to say that it is a well settled principle of law that estoppel cannot be invoked against the Crown (2).

- (1) *Hinks v. Safety Lighting Co.* [1876] 4 Ch. D. 607; *Smith v. Nichols* [1874] 21 Wall (88 U. S.) 112 at p. 118; *Hunter v. Garrick* [1885] 11 S.C.R. 300, *Yates v. Great Western Railway Co.* [1877] 2 Ont. A.R. 226; *Pickering v. McCullough* [1881] 104 U.S.R. 310; *Hailes v. Van Wormer* [1873] 20 Wall (87 U. S.) 353; *French et al. v. O'Hanlon Co., Ltd.* [1915] 32 R. P. C. 553; *Treo Company, Inc., v. Dominion Corset Co.* [1918] 18 Ex. C.R. 115 (affirmed by S.C. Canada, May 6th, 1919); *Northern Shirt Co. v. Clark* [1917] 17 Ex. C.R. 273; (affirmed by S.C., Canada, Nov. 18th, 1918).
- (2) *Ontario Mining Co. v. Seybold*; [1903] A.C. 73, at p. 84; [1899] 31 Ont. R. 386; *Bank of Montreal v. The King* [1906] 38 S.C.R. 258; *Queen v. Bank of Nova Scotia* [1885] 11 S.C.R. 1; *Peterson v. The King* [1889] 2 Ex. C.R. 67; *Humphrey v. The Queen* [1891] 2 Ex. C.R. 386, 390; *Robert v. The King* [1904] 9 Ex. C.R. 21; *Cunn v. The King* [1906] 10 Ex. C.R. 343, 346; *Robertsons' Civil Proceedings*, 576; *Chitty's Prerogatives*, 381.

The defendant's patent, which is wanting in meritorious invention, appears to me to be invalid for want of subject-matter, exercise of inventive faculties or ingenuity of invention; therefore, there will be judgment maintaining the plaintiff's action, annulling the defendant's patent, which is declared and pronounced void and of no effect.

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Judgment accordingly.

Solicitor for plaintiff: *R. V. Sinclair.*

Solicitors for defendant: *Murphy, Fisher, Sherwood
and Clark.*
