1922
February 21.

BETWEEN:

THE DETROIT FUSE AND MANUFACTURING COMPANY..... PLAINTIFF;

VS.

METROPOLITAN ENGINEERING COMPANY OF CANADA, LTD.. DEFENDANT.

Patent for invention—The Patent Act, sec. 24—Surrender of Patent Re-issue—Effect of surrender on judgment based on original patent—Contempt of Court—Practice.

A judgment had been obtained in this court by consent declaring Canadian Letters-patent No. 160043, valid as between the above mentioned parties, and that the defendant had infringed certain claims thereof. The usual injunction against further infringement was also granted. Subsequently plaintiff obtained a re-issue of the patent, alleged to contain everything that the original did and something more. More than 6 years after judgment, plaintiff moved to commit the President and Mana ger of defendant company for contempt of court in disobeying the terms of the judgment.

Held: 1. That as the judgment had not been served upon the officers against whom the contempt proceedings were taken, the application must be dismissed.

2. Applications for Court process involving the liberty of the subject are taken *strictissimi juris,* and all conditions or requirements antecedent to the right to obtain such process must be strictly fulfilled and satisfied.

3. A judgment for infringement of a patent for invention that has been subsequently surrendered and a re-issue obtained, is inoperative and cannot be enforced by process of contempt after the surrender of the original patent.

MOTION on behalf of plaintiff for an order to commit the president and the manager of the defendant for contempt of Court in disobeying a judgment pronounced in this case on the 9th October, 1915.

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Motion now heard before the Honourable Mr. Justice Audette at Ottawa.

George F. Henderson, K.C., for plaintiff;

R. C. H. Cassels, K.C., for defendant.

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

AUDETTE, J. now, this 21st February, 1922, delivered judgment.

This is a motion made on behalf of the plaintiff for an order that the President and Manager of the defendant Company be committed to jail, by reason of their contempt of the judgment pronounced herein on the 9th day of October, 1915.

Applications of this nature which involve the freedom and the liberty of the subjects of the Crown, are matters *strictissimi juris*, requiring the utmost strictness in procedure and which the Court will be jealous to observe and maintain.

A preliminary step in all such proceedings is the proof by affidavit of the service of the judgment relied upon and which is alleged to have been held in contempt. See *Oswald, Contempt of Court*, 210 et seq.; and cases therein cited.

There is no evidence of such service. Upon that ground and that ground alone the application must be dismissed.

My decision in the matter needs go no further. However, I was asked by Counsel for the respective parties to pass upon the other questions raised in this

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argument. To exhaust all these questions would carry me too far afield, but with reluctance, I will, however, accede to the desire of both parties, and express an opinion upon the question of the re-issue of the Patent,—a question of interest and moment to the parties,—with the view of avoiding further costs and multiplying litigation. (*Dudgeon* v. *Thomson* (1).

The judgment *a quo* is one obtained by consent whereby it was, *inter alia*, held that the Canadian Letters Patents of Invention No. 160,043 were good, valid and subsisting as between the parties herein, and that the defendant infringed claims 7, 8, 10, 11, 12, 14 and 15 thereof and finally granting the usual injunction.

However, since the pronouncing of this judgment, which does not appear to have been served upon the defendant, the plaintiff has sought and obtained a re-issue of the above mentioned patent.

Section 24 of The Patent Act, dealing with re-issue, reads as follows, viz:—

"24. Whenever any patent is deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake without any fraudulent or deceptive intention, the Commissioner may, upon the surrender of such patent and the payment of the further fee hereinafter provided, cause a new patent, in accordance with an amended description and specification made by such patentee, to be issued to him for the same invention, for any part or for the whole of the then unexpired residue of the term for which the original patent was, or might have been, granted.

(1) [1877] L.R. 3 A.C. 34.

"2. In the event of the death of the original patentee or of his having assigned the patent, a like right shall vest in his assignee or his legal representatives.

"3. Such new patent, and the amended description and specification, shall have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if the same had been originally filed in such corrected form before the issue of the original patent.

"4. The Commissioner may entertain separate applications, and cause patents to be issued for distinct and separate parts of the invention patented, upon payment of the fee for a re-issue of such re-issued patents."

From the perusal of that section it will be seen that Patent No. 160,043, mentioned in the said judgment has been *surrendered* and that a *new* patent has been issued with a description and specification materially amended and changed. The language is different, the distribution of the claims is different and there is something added thereto. Counsel for the plaintiff in answer to questions by the Court stated, in analysing the new patent, that it contained everything that was in the original patent and a little more; that the re-issue embodied the claims or clauses of the original patent, but numbered and distributed in a different way, not word for word the same, but covering everything.

Giving effect to what appears to be the plain language of the statute, the new, the re-issued patent would seem to have taken the place of the original one which from the issue of a new patent disappears and is replaced by the re-issue. The original patent being extinguished from the date of the re-issue, the judgment that was obtained by consent upon the original

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could only be said to be an accessory to such patent. If the original patent is the principal,—the objective of the judgment— the judgment, being only an accessory thereto, must disappear and be extinguished when the patent goes and must thereby become inoperative, therefore a committment for want of observance of the same could not at this stage issue.

The general similarity of the patent law between the Canadian and the American Statutes,—as stated by Patterson, J. in *Hunter* v. *Carrick* (1), will be a justification to seek support upon that ground from the American authorities. In re *Allen* v. *Culp* (2) it was held that "when a patent is thus surrendered (for a re-issue) there can be no doubt that it continues to be a valid patent until *it is re-issued, when it becomes inoperative.*" See also Walker on Patent, 3rd Ed. 214 et seq.

The same principle obtains in England. "It is a complete answer", says Frost, Patent Law, 2nd Ed. p. 597, "to a motion for committal for breach of a perpetual injunction restraining infringement of a patent to show that..... since the injunction was granted, the specification has been amended and so the injunction has become inoperative." See also *Dudgeon* v. *Thomson* (3).

The motion is dismissed with costs.

Judgment accordingly.

(1) [1884] 10 O.A.R. 449, at p. 468; (2) [1897] 166 U.S. 501, at p. 505; (3) [1877] L.R. 3 A.C. 34.