

LOWE-MARTIN COMPANY LTD., ET AL.. PLAINTIFFS;

vs.

OFFICE SPECIALTY MANUFACTUR- } DEFENDANT.
ING COMPANY LTD..... }

1930
April 25.
May 17.

Patents—Prior Art—Ingenuity of invention—Subject-matter

Claim 4 of the plaintiff's patent states that it is for "a file wrapper or folder including front and back leaves, the back leaf having a projecting tab formed integrally with the back and reinforced by an integral extension of the back doubled over at the top edge of the tab and pasted to the back," called "a straight edge tab," and claim 5 is for the same idea only for a "partial tab," part of the turned over edge being cut away.

Held, that the plaintiff's patent did not involve ingenuity of invention and was invalid for want of subject-matter.

2. *Held* further that, even if the same was patentable, inasmuch as the idea of turning over the edge of paper and gluing it down to reinforce such edge and to give it a smooth finish was clearly disclosed in

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the prior art, and was actually in use in the trade in the manufacture of folders similar to the plaintiff's, the plaintiff's alleged invention was anticipated and was not patentable.

ACTION by plaintiffs to have it declared that the defendant is infringing Canadian Letters Patent No. 218,775.

The action was tried before the Honourable Mr. Justice Audette, at Toronto.

*O. M. Biggar, K.C.*, for plaintiffs.

*F. M. Featherstonhaugh, K.C.*, and *H. G. Fox*, for defendant.

The facts are stated in the Reasons for Judgment.

AUDETTE J., now (May 17, 1930) delivered judgment.

This is an action for the alleged infringement, by the defendant, of claims 4 and 5 of the Canadian Patent No. 218,775, granted, on the 23rd May, 1922, to the plaintiff Edward A. Dunn. The plaintiff Lowe-Martin Company is an exclusive licensee of the said patentee Dunn under the said letters patent.

The defendant, by its statement in defence, avers that the plaintiffs' patent is null and void for want of subject-matter. Moreover, at the opening of the trial, counsel for the defendant admitted that the defendant manufactured files or folders covered by the said claims, thus only leaving for determination by the Court the question of the validity of the patent.

The grant contained in the patent is for a file or folder to hold papers in filing case or drawer and

the object of the alleged invention is to strengthen or stiffen such a folder at the point where the identification name or symbol of the file is applied, without increasing the weight or thickness of the file as a whole in the least, thereby enabling a folder to be made as a whole of relatively light and thin stock, while being at the same time greatly strengthened at the portion where the name or symbol occurs and where the folder is most frequently grasped and handled.

Another object is to make the edge of the folder or file which is subjected to handling rounded and smooth, merging gradually with the faces of the stock on a continuous curve, instead of presenting raw edges and sharp corners.

\* \* \* \* \*

The folder as a whole is represented by *a*, and the back or rear leaf thereof by *b*. This back is longer or higher than the first leaf either throughout its entire width, or for a limited extent. The projecting part of the back is adapted to bear the name of the person or of the matters

to which the contents of the file relate. This part of the folder is subjected to a much greater amount of handling than any other part, particularly in the course of searching through a cabinet for any particular file tucked between others, and it is the purpose of this invention to reinforce such part locally. In the form shown in Figure 1 this reinforcement is made by providing the back of the folder with a flap *c* which is doubled against the back and pasted down. The vertical extent of the flap is relatively slight as compared to the entire height of the file, and preferably is such that when the file is empty and closed the front leaf will not overlap it, whereby it does not increase the thickness of the file in the slightest. Thus the file is given more than double strength in the part where strength is most needed, without requiring the use of heavy stock.

Claims 4 and 5 read as follows, viz:—

4. A file wrapper or folder including front and back leaves, the back leaf having a projecting tab formed integrally with the back and reinforced by an integral extension of the back doubled over at the top edge of the tab and pasted to the back.

5. A wrapper or folder having a back, an integral extension of such back being folded against the back and permanently secured thereto by an adhesive, a part of the upper folded edge of the back being cut away and leaving a projecting tab, the outer edge portion of which is transversely rounded, and the tab being thereby formed integral with the back and of double thickness.

From the wording of the specifications and the two claims in question it appears that the patent covers two kinds of folders which may be referred to as *a straight edge tab* as shown by exhibit 2; and also *a partial tab* as shown by exhibit 3. Witness Dolan testified he would not say exhibit 2 has a tab. He would describe it as a file with the back projecting higher than the front. A tab is chiefly used for indexing and it projects beyond the main body for indexing purposes.

This alleged invention is the same as the one covered by the American Patent, filed as exhibit 4, bearing date the 16th December, 1913, and for which the application was filed on the 14th September, 1910.

At all events, the plaintiffs' patent in question is a very narrow and limited patent in a crowded art and must receive a narrow construction in view of the prior art.

The outstanding question left to the determination by the court is as to whether the devices in question are *per se* subject-matter as involving ingenuity of invention and further as to whether or not these devices have been anticipated by the prior art. The devices are undoubtedly of great simplicity involving a structure well defined in the prior art and to be valid must involve ingenuity of inven-

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tion. *Haskell Golf Ball Co. Ltd. v. Hutchison* (1); *Edison Bell Phonograph Corporation Ltd. v. Smith* (2).

These devices appear to be such as might, at that date, well have occurred to a skilled mechanic in that art and without any exercise of that inventive faculty which is necessary as the ground for a patent. It is always necessary to consider the rights of the general public to avoid monopolies on such simple devices as would occur to anyone familiar with the art. *Bonnard v. The London General Omnibus Co.* (3).

Now, the evidence, respecting the history of the art, discloses that before 1896 the usual method of filing papers was to lay them *flat* in the box and that the *vertical* system came into universal use after 1893. The first vertical files, for filing papers on edge, used no folders.

Witness McKee, a witness heard on behalf of the plaintiff, relates (p. 9) that the introduction of the plain folder was about 1900 and it was not until some time between 1905 and 1907 that the use of the partial tab began; the partial tab folder projects above the contents of the drawer and is subject to the wear of handling in referring to the contents of the drawer. These tabs or projections being subject to wear, various attempts were made to improve them. One of the first methods was the pasting of a *cloth* or *paper* on this partial tab projection to reinforce and strengthen it. A separate piece of cloth or paper was pasted on both sides—a *separate piece folded over* and that was done between 1901 and 1902 and until 1915 (p. 9).

Then came the Dunn American Patent exhibit A.

Witness McKee claims that the reinforcement is the invention and not the cutting away of the tab.

Witness Dolan, who has been with the defendant company, testified that in 1900 they used the ordinary vertical folder, that is a double sheet of manila paper folded to protect the contents, without any projecting part. Then with the development of the folder came the back flap projecting higher for the purpose of identifying the contents, and the partial tabbing, much in the manner of cutting the

(1) (1908) 25 R.P.C. 194 at 204 (2) (1894) 11 R.P.C. 389, at 398.
et seq.

(3) (1919) 36 R.P.C. 279 C.A.; 38 R.P.C. 1.

edges for the purposes of an index. Then in 1905 or 1906 or before, says witness Dolan, came the reinforced tabs, with the foreign substance such as linen or additional paper.

Q. What was the peculiarity of the reinforced thing?

A. Merely *folded over* with a foreign substance, an additional piece of paper or linen.

It *increased the thickness* of the tab, reinforced it, but not the thickness of the folder below the tab, and it produced *rounded edges*. That seems to be the crux of the claims by the patent.

Then witness Dolan produced exhibit B which he said they used prior to 1909-10, and it was used as long as he can remember in paper business for flat files. It is a file back with a reinforced top, which is thus reinforced by folding the top over and gluing it down, producing a smooth edge, as claimed in the plaintiff's patent. And the witness adds that the folding over of paper to get a rounded or reinforced edge is a common practice in the manufacture of paper products.

Witness Helmer says he has been in the paper business for 25 years and that he has been familiar with the folding of paper for the purpose of reinforcement, in different forms, ever since he started work. Exhibit B was made ever since he was in business, it is commonly used.

The following patents, among others, were filed as part of the prior art.

Exhibit A (1894), the Edgar Patent, shows a folder having a front and back flaps or leaves, the front one being shorter than the back, the extending portion of the back having a *reinforced projecting strip of wood*, stiff *paste-board* or other suitable material.

The Levey Patent, 3rd May, 1910, exhibit F, shows a cheque book wherein the edge of the paper is reinforced by folding it over and pushing it underneath.

Exhibit G, the Chynoweth Patent, 17th January, 1882, shows a folder in which the upper portion of a sheet is folded downwards, thereby constituting a reinforcement.

Exhibit H, the McKnight patent, 26th March, 1878, has a tab secured to both sides of the sheet, having a folded over portion offering a rounded surface, thus avoiding a cut or edged portion.

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Exhibit J, the Harris Patent, 19th January, 1909, has a folder provided with a tab on the upper side of the back flap and a folded over portion designated 15.

Exhibit K, the Kravik Patent, 23rd September, 1902, shows a folder comprising front and back leaves, the back leaf having its upper portion folded over as indicating at 9 and the other end of the leaf provided with an indicating tab. The folded over portion 9 is secured to the back by a fastener going through the paper.

Exhibit L, the Ayres Patent, 12th July, 1904, shows an index with a folded over portion at the side, the folded over portion being glued.

In Exhibit M, the Jones Patent, 11th April, 1876, the tabs are folded over and attached on both sides to a leaf providing a rounded edge, stiffening or reinforcing the projecting portion.

Exhibit N, a British Patent to Kenrick & Jefferson Ltd., 18th April, 1904, shows an index card doubled over throughout its length, with a cut away portion at the top forming a tab, which is doubled over integrally with the sheet and provided with a rounded transverse edge, in the same manner as in the plaintiffs' patent.

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 matters; 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.

The subject-matter of the letters patent must therefore be a manufacture or a device that is new, useful and involving ingenuity of invention. There must be something new in the art and the primary test is invention. All of which are wanting in the plaintiffs' patent.

From the above mentioned summary review of the prior art I am forced to the conclusion that, if the claims of the plaintiffs' patent could *per se* be patentable, a most doubtful matter, they are absolutely anticipated both by common use and by the prior art.

It is quite clear we had in the trade, long before the patent was thought of, folders of some kind or another that had that doubled soft rounding edge, constituting a reinforcement. There is no element entering in the patent which cannot be found in the prior art. The prior art describes the same function in practically the same manner, without involving, in any sense, a creative work of inventive faculty, which the patent laws are intended to encourage and reward. The plaintiffs came too late in this narrow field, they came when common knowledge of the art was extensively spread and well known. There is no new function or invention in the patent that could amount to invention under the circumstances of the case.

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The facts before the court show that the patentee has produced features and functions perfectly familiar to the prior art, without giving it any new functions and without accompanying it with new results, bring the patent within the principle so often stated that:

The mere carrying forward of the original thought, a change only in form, proportion or degree, doing the same thing in the same way, by substantially the same means, with better results, is not such an invention as will sustain a patent.

The Railroad Supply Co. v. The Elyria Iron and Steel Co. (1).

A patent for the mere new use of a known contrivance, without any additional ingenuity in overcoming fresh difficulties is bad and cannot be supported. If the new use involves no ingenuity, but is in manner and purposes analogous to the old use, although not quite the same, there is no invention.

And in *Blake v. San Francisco* (2), Wood J., delivering the opinion of the court, cited the following words of Gray J., in *Pennsylvania Railroad Co. v. Locomotive Engine Safety Truck Co.* (3) 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 and 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 contemplated.

See also *Nieblo Manufacturing Co. Inc. v. Reid* (4), confirmed on appeal to the Supreme Court of Canada; *The King v. Tessier* (5); *Copeland-Chatterson v. Paquette*

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| (1) (1917) Patent Office Gaz. | (3) (1884) 110 U.S. 490. |
| (U.S.) Vol. 239, p. 656. | (4) (1928) Ex. C.R. 13. |
| (2) (1885) 113 U.S.R. 679 at 682. | (5) (1921) 21 Ex. C.R. 150. |

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(1), confirmed on appeal (2); *Canadian General Electric Ltd. v. Fada Radio Ltd.* (3); *Detroit Rubber Products Inc. v. Republic Rubber Company* (4), confirmed on appeal to Supreme Court of Canada (5); *Treo Company Inc. v. Dominion Corset Company* (6); *Ball v. Crompton Corset Co.* (7); *Eagle Lock Co. v. Corbin Cabinet Lock Co.* (8); *The Northern Shirt Co. v. Clark* (9).

Audette J. The action is dismissed with costs for want of validity of the plaintiffs' patent.

Judgment accordingly.