CANADIAN RAYBESTOS CO., LTD.......PLAINTIFF;

1926
June 22.

AND

BRAKE SERVICE CORPORATION LTD. ET AL .... } DEFENDANTS.

Patents—Infringement—Date of invention—Conception—Publication

Held, that the date of a patentee's first conception of a thing patented is not necessarily to be taken as the date of his invention, and where an inventor had conceived the outlines of an invention, but required the time to bring it to perfection, he was held not entitled to a patent over one who in the meanwhile had invented the same thing, and given it to the public.

ACTION for infringement of patent of invention relating to a machine for applying brake lining.

Ottawa, April 6th and 7th, 1926.

Action now tried before the Honourable the President.

R. S. Smart for plaintiff.

W. L. Scott, K.C., for defendants.

The facts are stated in the reasons for judgment.

MACLEAN J., now this 22nd day of June, 1926, delivered judgment (1).

This is an action for infringement of a patent, the invention of one McBride of the State of California, U.S.A., who assigned the same to the plaintiff, and which relates to a machine for applying linings to brake bands.

In the cause of *Wright and Corson* v. *Brake Service Limited* (2), in which the plaintiff in the present action was prior to the date of trial added as a plaintiff, and which action was for infringement of the invention of Wright and Corson, being a mechanism for drilling and applying brake band linings, I found there was infringement of the patent and upheld the validity of the patent. In the report of this case there will be found a description of the mechanism constructed under the patent of Wright and

(1) An appeal has been taken to the Supreme Court of Canada.

(2) [1925] Ex. C.R. 127.

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Corson and of the infringing machine which is also the infringing machine in the present case. The description of these two machines adequately outlines McBride as well.

Later, the judgment in *Wright and Corson* v. *Brake Service Ltd.*, was opened up, and the production of further evidence was allowed upon the point of alleged anticipation by one Cady of the State of New York. Subsequently, I found that there had been anticipation by Cady, and thereupon the plaintiff's action was dismissed. Since then the plaintiff in the present action, acquired the patent of McBride, which relates as I have already said to a brake band lining machine, and the present action is for infringement of the McBride patent by the defendants. The evidence taken in the case of *Wright and Corson* v. *Brake Service Ltd.*, is by agreement also evidence in this case.

There can be no doubt I think but that McBride, the infringing machine of the defendants, and Cady are mechanical equivalents the one of the other. I think it unnecessary to further elaborate this point as I think it is beyond controversy.

In the action in reference to the Wright and Corson patent, I found that Cady had invented his brake lining machine late in 1918. In the reasons for judgment, I said:—

> I am entirely satisfied that Cady produced the machine referred to in the defendant's amended particulars, in the manner and at the time related by him. His evidence has been confirmed in too many particulars by other evidence oral and documentary, to cause me to doubt his veracity. In regard to the other witnesses who gave evidence at this trial on behalf of the defendant, my conclusion is that they were reliable and their evidence is to be believed. On the whole I have no doubt whatever that Cady produced the brake band lining machine in question late in 1918, and that he has since used the same with some slight modifications, in his garage at Canastota.

McBride, it is here contended, was invented prior to Cady. The evidence of McBride upon this point taken under commission is about as follows. McBride claims to have conceived his invention in April, 1916. He states he then made sketches upon a blackboard in his machine shop, and upon paper, of different forms of machines comprising the main elements later disclosed in his patent. He disclosed the outline of what he had in his mind to several men working in his shop whom he states he took

into his confidence for advice before commencing the construction of the machine. Early in 1917 he began making patterns of the machine which he worked upon at odd times until the latter part of 1918 when the patterns were completed for the drilling and countersinking portions of the machine. His original conception of the machine he states was to include a riveting device to be a part of the same machine. He states in this connection that in the meanwhile he was doing considerable experimental work with different kinds of hammers, a hammer being a necessary element in the riveting means. From the completed patterns he had castings made in the latter part of 1918. Some work was then done on the castings, and then they were laid aside till March, 1919, when the work was taken up again. In July, 1919, a machine was partially completed and put into use in drilling and countersinking brake band linings. McBride continued to experiment with hammers for the riveting device and eventually concluded to adopt an air hammer of a conventional type, and it was not till October, 1919, when he concluded his machine was perfected and completed. To use McBride's exact words:—

> This hammer functioning perfectly, I decided that the machine was O.K. and ready to shoot and then I next took steps to take out patent papers in the United States.

His application for a patent in the United States was in November, 1919.

The evidence of McBride and others taken under Commission in California was evidently brought out upon the theory that a machine having been completed and put into use in 1919, and a patent applied therefor, that the date of invention was the date of McBride's first conception of the machine, provided he showed in the interim diligence in perfecting his invention. This doubtless is explained by the fact that such a rule or principle is recognized by the courts of the United States. There is not, however, in my opinion, any acceptance of such a principle in our law. In April, 1916, McBride lost two of his workmen because he criticized the quality of some work they had done in lining brake bands. This incident impelled him to think of some mechanical device to perform this class of work. Instantly, according to his evidence, he conceived the outlines of his invention which required

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three years and more to bring to perfection. Whatever he conceived of and was doing all the while, he is not in my opinion entitled to a patent over one who in the meanwhile has invented the same thing and given it to the public.

The evidence of McBride which I have summarised does not support invention prior to Cady whose machine was completed and put into use late in 1918. McBride's own evidence is I think an admission of an incomplete invention until July, 1919, when he commenced using a machine without the riveting means, and which really was not the complete machine he conceived or had in mind. In fact he states that it was only in October, 1919 that he decided his machine was completed, and thereupon he applied for a patent. I do not think it is open to serious contention that there was invention if at all earlier than July, 1919. Prior to that date, had McBride been asked if he had invented a brake band lining machine, he would I think have answered in the negative, because he had not yet practically realized what he had in mind. Everything was I think experimental up to the date when he commenced to use a machine for drilling and countersinking brake band linings. There was no publication of any sort of the invention so far as I can see at any time till about this date. Any disclosure was largely to his own workmen, and as McBride states, was confidential, and because he had confidence in such employees. This was not therefore a publication or disclosure. The evidence of disclosure to persons other than his own workmen is unsatisfactory and cannot be given any weight whatever. He states with commendable frankness in his evidence that he could not disclose the invention until he had at least nearly perfected it mechanically. I have no difficulty whatever in concluding that the McBride alleged invention was not a complete invention at any time in 1918 but was merely an incomplete suggestion. I think this was the opinion even of the inventor himself. For this reason McBride must be held to have been anticipated by Cady. It would be a strange principle of law that would concede to McBride priority in invention over Cady in view of the facts which have been related. When I leave the sugges-

tion that there may have been invention by McBride in July, 1919, when he put into use a partially completed machine, I have not given consideration to the point as to whether there could be invention as of that date when the end reached is not wholly what the inventor conceived or sought to accomplish, but a lesser thing.

Another brake band lining machine was introduced into the evidence and was I think referred to at the trial as the Vancouver machine. I refer to this machine not for the purpose of showing it was an anticipation of McBride, because that is not now necessary, but for other purposes. This was an alleged invention of one Gerry now of Seattle. Gerry claimed invention as far back as August, 1918, in Providence, Rhode Island, and he states that he there made a machine which was actually used for lining brake bands from about the first of September, 1918, to May 26, 1919, the date on which he left his employment at Providence, in which employment he was shop foreman in a truck service department. After locating in Seattle he had other machines made of the same type, several of which were sold and used in Vancouver two years prior to the application for patent by McBride. Mr. Scott urged that this was fatal to the patent of McBride under section 7 of the Patent Act. Mr. Smart replied to this contention that this part of section 7 only applies where it is the inventor's own invention which has been in public use or sale for two years, and I agree that Mr. Smart's view of the statute is the correct one. If in fact McBride was a prior inventor to Gerry, I apprehend that the sales made of Gerry in Canada would not prejudice McBride if he took out a patent in Canada within the period by statute provided.

The defendants also contend that McBride is void for want of invention. This contention is very substantial. In the action involving the Wright and Corson patent, I held the patent to be valid upon the evidence then before me. Since then the McBride and Gerry inventions have appeared in addition to Cady, all originating from independent inventors. Evidence was given at the trial by Maurice Caron, a patent solicitor of Ottawa, who testified that he relined brake bands on three or four occasions,

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using an ordinary lathe, first as early as 1914, and he illustrated the lining of a brake band in court upon such a lathe, with rapidity and I think accuracy. The end accomplished was the same as would be done by the machines of the plaintiff and defendants. Once knowing that this class of work could be done upon a lathe, I think any skilled or experienced mechanic could easily produce either the plaintiff's or defendants' machines or their mechanical equivalent. The evidence of Caron, the additional evidence as to previous methods of lining brake bands, and the fact of several inventions coming along all about the same time, all involving substantially the same arrangement of mechanical means evolved by shop mechanics, not particularly skilled so far as know, has convinced me that McBride lacks invention. I am satisfied that the development of all the brake band machines disclosed in this case were readily suggested by the lathe or other well known tools or mechanisms to experienced mechanics. Gerry states that in making his Providence machine he used an ordinary blacksmith's drill into which he inserted new tools, etc., and apparently it required little time and involved no difficulties of any kind. He states that he regarded the machine rather as an experiment, but it seems to have worked quite well and involved the basic idea to be found in McBride and the others. He did not for some time regard himself as an inventor. McBride states that when he conceived of that which he now claims to be an invention he had no thought of patenting the idea. This was probably true of Cady. The necessity for a convenient tool or machine of this kind for ensuring rapidity and accuracy of work evidently enabled mechanics not particularly skilled to conceive and construct machines all of one type, and all involving practically the same combination of old devices. It has frequently been held that if skilled workmen could produce any particular mechanical device without difficulty, when their attention has been called to the need of it, there can be no invention. That principle I think may safely be applied here. The additional evidence now before me since the trial involving Wright and Corson compels me now to the conclusion that the

plaintiff's patent is void as it involves no invention, and upon this ground also this action must fail.

There will accordingly be judgment for the defendants with their costs of action.

Judgment accordingly.

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