

BETWEEN:

LIBBEY-OWENS-FORD GLASS }
COMPANY

PLAINTIFF;

Ottawa
1968
Nov 18, 22,
26-27

AND

FORD MOTOR COMPANY OF }
CANADA, LIMITED

DEFENDANT.

1969
Jan. 7

(No. 2)

Patents—Infringement—Patent for apparatus and method—Defence that invention acquired before patent issued—Whether intangible subject-matter excluded from defence—Patent Act, R.S.C. 1952, c 203, secs. 2(d), 58.

In 1962 plaintiff obtained a patent with respect to an apparatus and method for pressing glass and plastic assemblies and brought action for infringement against defendant, which in 1961 had acquired and commenced operating machines for pressing glass windshields. Amongst other defences defendant relied on s. 58 of the *Patent Act*.

Held, the immunity conferred by s. 58 on a person who acquires an invention before a patent therefor is issued to someone else is not confined to tangible subject-matter only, *viz* in this case the apparatus, but extends to intangible subject-matter also, *viz* in this case the method.

Schweyer Electric & Mfg. Co. v. N.Y. Central Railroad Co. [1934] Ex. C.R. 31; *McClurg v. Kingsland* (1843) 42 U.S. 202; *Andrews v. Hovey* (1887) 123 U.S. 267, (1888) 124 U.S. 694; *Barton v. Nevada Consolidated Copper Co.* (1934) 71 F (2d) 381; *Victor Sporting Goods Co. v. Harold A. Wilson Co.* (1904) 7 O.L.R. 570, considered.

1969

TRIAL OF ISSUE.

LIBBEY-
OWENS-FORD
GLASS CO.*Gordon F. Henderson, Q.C. and C. R. Carson* for
plaintiff.v.
FORD MOTOR
CO. OF
CANADA LTD.*Donald F. Sim, Q.C. and Roger T. Hughes* for
defendant.

THURLOW J.:—In this action, following the decision of the court on the special case by which it was sought to raise certain points of law, an order was made setting down for trial the question whether assuming the validity of Canadian patent number 653,277 the defendant is liable for infringement of that patent and this issue has since come on for trial accordingly.

The patent in question was issued on December 4, 1962 on an application filed on May 4, 1955. The specification, which consists of some forty typewritten pages and a set of fourteen drawings, is concerned with what is therein claimed to be “an improved method and apparatus for pressing assemblies of curved glass sheets and plastic interlayers preparatory to the final compositing operation”. More particularly as disclosed by the specification and evidence the purpose of the first of two consecutive pressing operations to be carried out by the method and apparatus is to expel entrapped air from such assemblies—chiefly laminated automobile windshields—while that of the second, which follows heating of the assembly, is to secure close contact of the surfaces to one another and to seal the edges so that oil under pressure, which is used in a subsequent processing step, will not penetrate between the layers.

The specification describes the characteristics and functioning of an apparatus designed to carry out these purposes. In general the characteristic elements of the apparatus described (so far as the present controversy is concerned with them) consist of a conveyor belt which moves the glass “sandwich” along a course which is so set as to bring the leading edge of the sandwich directly to the nip of a pair of power driven rollers in a plane which coincides with the common tangential plane of the rollers as they are at that moment positioned. The rollers are mounted on a frame which is capable of moving or rocking in an arc and thus of moving or rocking the rollers in an

arc as well, and there is a device which, on being engaged by the glass on its way between the rollers, automatically sets this frame in motion in its arc thereby causing the sandwich to be lifted from the conveyor and moved forward in that arc (while it is being passed between the rollers, and is at the same time being supported by other devices known as outrigger rolls and rocked with reference to the rollers as well to keep the plane of the portion in the nip at any particular time coincident with the common tangential plane of the rollers), to a point at the other end of the arc of the frame where on leaving the rollers the sandwich is again deposited on a conveyor precisely oriented for its reception and removal to its next processing step.

The specification concludes with twenty-three claims, fourteen of which are apparatus claims and nine of which are method claims. For the present purpose these are all assumed to be valid.

Since the end of March 1961 the defendant has had in its possession and since June of that year it has operated as part of its equipment for manufacturing curved glass windshields for cars, two pressing machines—one used to remove air from windshield assemblies and the other to secure close contact between the laminae and to seal the edges. Both of these machines—which were substantially alike—had rollers capable of being rocked with their supporting frame and devices for automatically rocking, lifting and supporting windshields passing between the rollers and for depositing them on exit from the rollers essentially similar in most respects to those of the apparatus described in the specification.

Since their acquisition both of the defendant's machines have been used in conjunction with conveyor devices so designed, positioned and adjusted as to receive the windshields from the pressing rolls and carry them away to their subsequent processing stage. In the case of the defendant's tacker unit there was also a feed conveyor in operation from the time of the acquisition of the machine to September 1964 when it was removed and replaced by a device known as a load stand. The defendant's de-air unit, throughout the period mentioned, and the tacker unit since September 1964 have been used in conjunction with load stands.

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 Co. OF
 CANADA, LTD
 Thurlow J.

1969

LIBBEY-
OWENS-FORD
GLASS Co.
v.
FORD MOTOR
Co. OF
CANADA LTD.
ThurLOW J.

The feed conveyor was designed and positioned and with necessary adjustments to its height and grade made from time to time to suit the requirements for the curvature of the particular style of windshield to be processed was used to carry the windshields from the tacker oven conveyor, on which they had been passed through the tacker oven for heating to the appropriate temperature, directly to the rollers of the tacker pressing machine. At that point the progress of the windshield would have been stopped had not a man been present to push or otherwise assist the leading edge of the windshield far enough into the nip of the rollers to engage the central lower rollers, which were power driven and the rollers above them so as to cause them to draw the windshield into and through their nip. How far into the nip between the rollers it would be necessary to push or assist the windshield would, I fancy, depend to some extent on the shape of the windshield since engaging the outer rollers would provide no assistance in drawing the windshield further into the nip until a sufficient portion of the leading edge engaged the power driven lower rollers in the middle.

The load stands were also devices used, in the case of both of defendant's machines, in the course of introducing the windshields into the nip of the rollers. Each of them consisted of a mere upright stand on top of which was mounted a rubber roll. This roll was free to turn but was not power driven. On it an operator could rest a windshield and move it forward towards the nip of the machine's rollers so that its leading edge could become engaged between them in the right plane therefor—i.e., the common tangential plane of the rollers—while its remaining portion was supported by the load stand and continued to be supported thereby until it was lifted therefrom in the course of the rocking action of the rollers and their supporting frame. The positions of these load stands on the floor in front of the tacking machines as well as their heights were adjusted as required from time to time to meet the requirements for easy handling and to secure the proper angle of entry for different types of windshields. The height to which the load stand would be adjusted might also depend to some extent on the height or stature of the operator. While the top of its roller could be higher at times than the nip of the machine's rollers it was more

often lower. It was, however, never directly below them but at a distance of some two feet or thereabouts therefrom. In general it was adjusted to about knee height.

At the hearing the controversy developed around three questions.

1. Whether and in what respects infringement by the defendant of all or any of the patent claims relied on by the plaintiff should be taken as admitted.
2. Whether, and how far, if not admitted, infringement has been established.
3. Whether, and how far section 58 of the *Patent Act* affords a defence.

The first of these questions arises from correspondence between solicitors during the course of the litigation and depends on the effect of certain admissions therein contained. This, as I see it must be determined having regard to the state of the pleadings and to what transpired in the course of the trial. In my opinion the result is not affected either on the one hand by the plaintiff having refrained, as counsel suggested it had, as a result of the letters, from taking preparatory measures with a view to proving infringement at the trial, nor on the other hand by the defendant having permitted, shortly before the trial, whether pursuant to an order of the court or otherwise, a further inspection of its premises by the defendant or a further examination for discovery. In short neither the interpretation nor the effect of the alleged admissions is in my view affected by the reasons which led to their being made or by what transpired afterwards between counsel.

The action was brought in respect of alleged infringement by the defendant of nine patents said to belong to the plaintiff. The allegations of infringement of all nine patents is made in paragraph 4 of the statement of claim which states that:

- 4 The Defendant has infringed the rights of the Plaintiff under the said Letters Patent as set out in the Particulars of Breaches served herewith and threatens to continue the said infringement

So far as material the particulars of breaches allege that:

- 1 The defendant has made, constructed, used and vended to others items containing glass in infringement . . .

of the nine letters patent referred to in the statement of claim including letters patent number 653,277.

1969
LIBBEY-
OWENS-FORD
GLASS Co.
v.
FORD MOTOR
Co. OF
CANADA, LTD
Thurlow J

1969
 LIBBEY-
 OWENS-FORD
 GLASS CO.
 v.
 FORD MOTOR
 Co. OF
 CANADA LTD.
 ———
 Thurlow J.
 ———

- 2 The Plaintiff relies on . . . (various claims in the other 8 patents) and claims 1 to 9 inclusive and 11 to 20 inclusive of Canadian Letters Patent 653,277
3. The precise number and dates of all of the Defendant's infringements are at present unknown to the Plaintiff, but the Plaintiff will claim to recover full compensation in respect of such infringements.

In its defence the defendant denied these allegations and went on to allege invalidity of the patent, licence by the plaintiff to the defendant under the patent and a defence under section 58 of the *Patent Act*.

The statement of claim was dated January 28, 1965, and the correspondence in question, so far as it is in evidence, commenced on May 8, 1967. It consists of six letters, the first three of which were offered by the plaintiff and the other three by the defendant. The first two of these are letters purporting to be written by the defendant's solicitor in the course of negotiations for an inspection of the defendant's premises under conditions that would be acceptable to both parties. While both hold out the possibility of some admissions being made in certain events neither, as I read it, makes any admission and it is unnecessary to set them out. The third letter, also written by the solicitor for the defendant to the solicitor for the plaintiff was dated November 13, 1967, and read as follows:

Subject: L-O-F vs. Ford Canada
 Actions Nos. 1 and 2
 "Inspection"

This will confirm the arrangements we have made with respect to the inspection of the Ford plant.

(1) The inspection is now scheduled to take place at 12 30 p.m. on Tuesday, November 28th, 1967.

(2) The parties making the inspection will be yourself, Mr. Henderson, Mr. Nobbe and one technical representative of L-O-F.

(3) You and each of the persons making the inspection have agreed that information obtained during the inspection will be used only for the purposes of the two pending actions and will not be used for any commercial or other purpose

(4) The inspection is to be of the vinyl stretching operations carried on by Ford and of the prepressing and tacking operations.

(5) The inspection shall be without prejudice to your right to apply to the Court for further or other inspections.

(6) L-O-F agrees to consent to and cooperate with Ford in obtaining an order directing a preliminary trial between the parties relating to the plea of license under patents Nos. 486,072, 486,073, 488,745, 488,746, 513,738, 549,068, 726,061 and 727,546 and the plea based upon Section 58 in respect of patent No. 653,277.

(7) Ford agrees that proceedings in the remaining portions of the actions may proceed in the normal course and undertakes not to seek any stay or delay thereof on the grounds of the separate and preliminary trial above referred to.

(8) Ford admits that it has infringed Canadian Patents Nos. 470,044, 488,745, 613,040 and 653,277 subject to and reserving all arguments as to validity, license and Section 58 in respect thereof.

Would you kindly indicate your acceptance of this and provide us with evidence that the parties making the inspection apart from yourself and Mr. Henderson are aware of and consider themselves bound by the provisions of (3) above.

1969
LIBBEY-
OWENS-FORD
GLASS Co.
v.
FORD MOTOR
Co. OF
CANADA, LTD.
Thurlow J.

It is common ground that the inspection referred to took place in about the month of December 1967 and no breach of any of the undertakings required of the plaintiff has been suggested.

The remaining three letters were written following the decision already referred to on the special case submitted to the court by the parties on the effect of section 58. The first of these was written by the defendant's solicitor on August 8, 1968. It read as follows:

Subject: L-O-F vs. Ford Canada
Action No. 1—Makovic
Canadian Patent 653,277
Preliminary Trial

(1) Following the examination for discovery of Mr. Thompson, I compiled a list of the information which we undertook to develop and supply you. Enclosed herewith is a schedule setting out this material. It may be some time before the transcript is available and so that no time will be lost in getting this material to you, I would appreciate it if you would check this list against your own notes and let me know whether I have overlooked anything.

(2) I would appreciate it if you would advise me, for the purposes of the trial, which of the documents adduced as exhibits to Mr. Thompson's examination for discovery, you are prepared to admit.

(3) To assist you in preparing for trial, the defendant admits that it has infringed claims 1 and 20 of the patent in the use of the tacking equipment described by Mr Thompson in the examination for discovery from the date of the patent to the date of issue of the Statement of Claim herein, subject to and reserving all arguments as to validity and Section 58 in respect thereof. The defendant does not admit infringement of any of the other claims of the patent at any time. If you decide to limit the claims in suit in view of the examination for discovery of Mr. Thompson, I would be glad to hear from you at your earliest possible convenience.

The remaining two letters were written thereafter by solicitors of the plaintiff to solicitors of the defendant. In the first of these, written on August 13, 1968, no comment was made with respect to the admission set out in the

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 Co OF
 CANADA LTD.
 Thurlow J.

defendant's letter but in the second, dated October 15, 1968, the defendant's solicitor stated his views that by the earlier letters infringement of all the claims in suit had been admitted.

At the trial, however, the plaintiff did not rely entirely on the first three letters as constituting an admission of infringement of all the claims relied on but led, as well, evidence of what had been observed at two inspections of the defendant's plant as to the characteristics of the apparatus and system for de-airing and tacking windshield assemblies then in operation as well as a considerable body of evidence given by a representative of the defendant on two examinations for discovery relating to the installation of the system, subsequent alterations thereto and its operation in the defendant's plant. Further evidence on the same subject was also adduced by the defendant who offered a number of documents pertaining to the acquisition, installation and operation of the system and oral evidence of the same person who had been examined for discovery. This witness was cross-examined at length on the same subjects by counsel for the plaintiff.

I see no difficulty in reaching the conclusion that the defendant's letter of November 13, 1967, constitutes an admission, for the purposes of this action, that the defendant has infringed the four patents listed in paragraph 8 and in my opinion this admission is of the same force and effect as if it had been made formally pursuant to a notice to admit facts. But it can have no effect beyond precisely what it says when read in answer to what had been alleged in the statement of claim and particulars of breaches. It admits infringement of the patent but like the statement of claim and particulars of breaches it appears to me to say nothing of any particular respect in which the patent has been infringed or when or by what particular makings, constructions, uses or sales of items containing glass by the defendant the patent was infringed. It thus leaves completely unidentified what it is that is being admitted to constitute infringement of the patent. As I read it the admission is equally consistent with a single act of infringement or with multiple acts of infringement and either in ways which the plaintiff had in mind in making its complaint, but did not state, or in ways not contemplated or known by the plaintiff. Of all this, however, the

plaintiff, as I view it, has no reason to complain since it flows from the plaintiff's own omission to state in its pleadings precisely what the defendant did which constituted infringement of its rights. Nor does the admission specify which of the claims relied on is admitted to have been infringed. It simply admits infringement of the patent and this appears to me to be equally consistent with the plaintiff having infringed one or more but not necessarily all of the claims cited in the particulars of breaches.

In the circumstances the admission appears to me to be as vague as the statement of claim and particulars of breaches for the purpose of ascertaining what it was that the plaintiff complained of or that the defendant did which constituted infringement of the patent in suit or when the defendant did it and to my mind it could never have served as a foundation for awarding the relief which the plaintiff claims, for, without agreement on the point or a trial for the purpose of determining it, there would have been nothing before the court upon which it could have been adjudged what it was that constituted the defendant's tort or by which the tort could have been defined for the purpose of a reference to assess damages or to determine profits or for the purpose of enjoining the defendant from continuing it. It appears to me therefore that the questions of what claims were infringed, when they were infringed and what conduct of the defendant infringed them can be determined only by reference to such evidence thereon as has been offered and as I see it the admission is of no assistance or effect whatever in reaching conclusions thereon.¹

That evidence, however, includes the defendant's letter of August 8, 1968, which was not offered by the plaintiff but was put in evidence by the defendant. The admission therein contained comes to much closer grips with the matter. While the letter appears to me to be open to more

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 Co. OF
 CANADA, LTD.
 Thurlow J.

¹ *Vide Ash v. Hutchinson & Co. (Publishers)* [1936] 1 Ch. 489 where Greene, L.J., said at page 503:

A Plaintiff who relies for the proof of a substantial part of his case upon admissions in the defence must, in my judgment, show that the matters in question are clearly pleaded and as clearly admitted; he is not entitled to ask the Court to read meanings into his pleading which upon a fair construction do not clearly appear in order to fix the defendants with an admission.

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 CO. OF
 CANADA LTD.
 Thurlow J.

than one interpretation in the light of the facts established in evidence to my mind this letter is *prima facie* sufficient to lead to a conclusion in favour of the plaintiff that the use of the defendant's tacker unit throughout the period referred to therein infringed both claim 1 and claim 20 of the patent and there the matter must rest save insofar as the other evidence may show this conclusion to be erroneous. *Vide Sinclair v. Blue Top Brewers Co. Ltd.*² In examining the evidence therefore I propose to approach the matter as being one in which infringement of both claim 1 and claim 20 of the patent throughout the period referred to in the letter by the use of the defendant's tacker apparatus has been established save insofar as the other evidence established the contrary but with respect to the rest of the matter as one in which, the onus being on the plaintiff, infringement is to be found only to the extent that it has been proved.

This brings me to the second of the areas of controversy that is to say how far infringement has been established. As will appear, despite his letter of August 8, 1968, counsel for the defendant took the position that none of the claims relied on had been infringed. I turn therefore to the claims on which the plaintiff relies and the several points raised in respect of each of them.

Claim 1 reads as follows, the portions which I have put in italics being those on which submissions were made:

1. In apparatus for pressing together the sheets of a curved glass-plastic sandwich, *means for conveying the sandwich in a defined path* transversely to an axis of curvature thereof, a pair of *pressing rolls disposed transversely of said path* and providing a confined passage therebetween to receive said sandwich means for mounting said rolls as a unit for rocking movement of said unit from a first position for receiving the forward end of said sandwich in said confined passage along a tangential plane common to both of said rolls to a second position for releasing the rearward end of said sandwich from said passage, and *means for rotating said rolls in opposite directions for moving said sandwich therebetween* during the rocking thereof from said first to said second position.

The first two submissions made by counsel for the defendant on this claim were that the load stands used in the defendant's operation were not "means for conveying the sandwich in a defined path" within the meaning of the claim since (1) a load stand was not a means for convey-

² [1947] 4 D.L.R. 561 per Kellock J. at pp. 561-2.

ing; and (2) there was no defined path in which the windshield was moved along the top of the load stand to the nip of the rollers. Counsel for the respondent, however, urged that a load stand was a "means for conveying" the windshield since it was equipped with a roller on which the windshield could be and was supported and moved and its position and height were adjusted to make it suitable for such use for the particular type of windshield to be pressed. He also submitted that the expression "defined path" in the claim referred to the course of the windshield from the time its leading edge was in the common tangential plane of the rollers—a distance that might be as little as one-quarter of an inch from their nip—to the moment, very shortly thereafter, when, by reason of the action of the rocking frame, the windshield was lifted up and rocked forward while between the rollers, and that the load stand was a means for conveying the windshield in this defined path within the meaning of the claim.

While I am inclined to the view that the "defined path" referred to in claim 1 means the course of the windshield during the period as submitted by Mr. Henderson (since the course of the windshield prior to that is of no importance to the pressing procedure and is of critical importance to it from the moment mentioned) I am unable to agree that the defendant's load stands are means for conveying the windshield in that defined path. I do not think, for example, that a man who manually inserts a windshield into the nip in the correct plane can be considered to be a means within the meaning of the claim and as I see it in the defendant's operation it is the operator who conveys the windshield in the defined path. The load stand is no doubt a means which he uses to assist him in doing so but it does not do the conveying and without the act of the man in putting the leading edge of the windshield in the defined plane, his keeping it there and his moving it in that plane the windshield would never reach or become engaged in the nip of the rollers since without the control exercised by the operator it would not only never reach the commencement of the defined path but would leave it and fall down if the operator failed to support it at any time prior to its becoming firmly engaged in the nip. This interpretation of the expression is I think confirmed by reading the claim in conjunction with the rest of the specification. In it

1969
 LIBBEY-OWENS-FORD GLASS Co.
 v.
 FORD MOTOR Co. OF CANADA, LTD
 Thurlow J.

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 Co. OF
 CANADA LTD.
 Thurlow J.

one finds no reference to a defined path. On the other hand one does find numerous references to the conveyor but none appears to me to contemplate a device which by itself will neither move nor provide complete support for the windshield in its course from the moment its leading edge is in the common tangential plane of the rollers until it is firmly engaged in the nip. In my view therefore the defendant's pressing machines when used in conjunction with load stands are not apparatus that fall within the terms of claim 1.

Counsel for the defendant also submitted that the use of the defendant's tacker unit in conjunction with a feed conveyor was not within the claim. As I understand it the feed conveyor had two parallel downwardly inclined conveyor belts on which the windshield was carried until its leading edge came in contact with the large power driven lower rollers of the pressing assembly. At that moment or shortly thereafter a set of castors arranged between the two conveyor belts was automatically raised to lift the windshield from the belts and support it during its movement between the rollers until it was lifted therefrom by the rocking action. The evidence was that with this apparatus the windshield would not enter the nip of the rollers automatically and that it was necessary to have an operator present to guide the windshield while on the conveyor belts and to rock its leading edge upward into the nip when it reached the rollers. In counsel's submission the path of the windshield was a defined path while it rested on the conveyor belts but that such defined path stopped or ceased to be a defined path (at the critical moment) when it became necessary for the operator to rock its leading edge into the nip by pressing down on the rear end.

I have already indicated my view that the only material defined path is that of the windshield from the time its leading edge is in the common tangential plane of the rollers which in the defendant's load conveyor arrangement would, as I understand it, commence when the leading edge of the windshield comes in contact with the power driven lower rollers of the pressing device. From that moment onward the windshield is supported in that path first by the conveyor belts and then by the castors and with the assistance of the operator, in addition to the force exerted by the belts and that of gravity, it is moved in that

path—(not of the leading edge but of the windshield itself) until, its leading edge and leading portion having become engaged between the rollers, it is raised from the castors by the rocking action. While the force exerted by the belts coupled with the gravitational tendency of the windshield to move along the path and the contact of the leading edge of the windshield with the power driven rollers was apparently insufficient to cause the windshield to continue along its path without the assistance of an operator I am not persuaded that this was not an inefficient example of the plaintiff's combination or that it was not within the claim. The use of this apparatus was admitted, by the defendant's letter of August 8, 1968, to infringe claim 1 and the evidence does not satisfy me that it did not do so.

The third point raised on claim 1 was that the pressing rolls in the defendant's apparatus were not disposed transversely of the defined path because while the rolls were disposed at an angle of 90° to the path, if indeed there was such a path, they did not cross it since it ended at the rolls. In the view I have taken that the defined path continues to the point at which the devices for moving the supporting frame have been engaged and the windshield is lifted from the conveyor the rolls are not disposed merely at the end of the path but are disposed across it. The point is therefore not sustainable.

The remaining point taken arises from a difference in the rolling mechanism of the defendant's machines from that described in the specification. In that described in the specification both upper and lower rollers are power driven. In the defendant's machines only the four central lower rollers are power driven and these exert rotating force on the rollers directly above them, with which they are in contact when no windshield is between them, and on the windshield when there is one between them so as to cause the upper rollers to turn in the opposite direction. The rotation of the outer rollers, both upper and lower, in the defendant's machine is produced by the movement of the windshield between them.

The point raised was that in the defendant's machines the rolls are not rotated "in opposite directions" for moving said sandwich therebetween within the meaning of claim 1, that the words of the claim are peculiar to the

1969
LIBBEY,
OWENS-FORD
GLASS Co.
v.
FORD MOTOR
Co. OF
CANADA, LTD:
Thurlow J.

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 Co. OF
 CANADA LTD.
 Thurlow J.

construction described in the specification and are confined to pressing rollers in which both upper and lower rollers are power driven. In my view, there is neither ambiguity nor lack of clarity in the expression "means for rotating said rollers in opposite directions for moving said sandwich therebetween" nor justification for limiting the expression so used to means of the kind described in the specification. As defendant's machines are equipped with means for turning the lower four central rollers which are larger than the others and which are in contact with the rollers immediately above them, there is a means for rotating those particular rollers in opposite directions when there is nothing between them and there is also a means for rotating them in opposite directions for moving the sandwich therebetween as well as between the outer upper and lower rollers.

The defendant's submission on this point accordingly fails.

In addition to submitting that the defendant's machines were within the text of this and the other apparatus claims counsel for the plaintiff contended that the machines were infringements of the substance or what has been referred to as the "pith and marrow" of the invention. He submitted that the invention was one of a process whereby a curved laminated glass windshield enters a pressing roll in a predetermined relationship, is rocked, while being pressed and while maintaining a particular position in the nip of the rollers, to a second position and is there unloaded in a defined relationship and that in terms of the apparatus all three pieces—i.e., the loading device, the rocking and pressing assembly and the receiving device—interrelate to enable the functions to be performed. He went on to submit that the substance of the invention relates to the proper entry of the windshield between the rolls the pressing of the windshield while being rocked and the proper discharge and that the use by the defendants of its load stands served the first of these functions and the pressing assembly and discharge conveyor served the others.

Of these submissions it is to be observed first that if the scope of the invention described by claim 1 is as broad as stated the insertion of a windshield between the rollers of the defendant's machine in the proper relationship by a

man using no device whatever therefor would meet the substance. I do not therefore think the substance can be as broad as suggested. Secondly, the argument really adds nothing to that already considered in relation to the wording of the claim itself since it too depends on a determination that a load stand is a means for achieving proper entry of the windshield into the nip of the rollers, which in my view, as already expressed, it is not. As I see it, it is no more such a means than are the gloves worn by the operator who without them would probably find it more difficult to position the windshield properly because of its being too hot for him to handle without them. Moreover, while evidence of what was known by persons skilled in the art prior to the date of the specification, from which one might form some view of the extent of the invention disclosed thereby, is very scanty, consisting as it does of a few not very informative recitals in the specification itself and a copy of an earlier specification, known as the Boicey patent (Exhibit Z), it seems clear from such evidence that the pressing of curved glass sandwiches by passing them between rollers was already well known as was also the necessity, which I should also have thought to be obvious to anyone whether skilled in the art or not, to have the edge of the sandwich oriented to enter the nip of the rollers in the common tangential plane of the rollers and for that reason to bring the sandwich to the nip of the rollers in the correct orientation, whether that was to be achieved by hand or by mechanical means. Having read and re-read all of the passages in the specification to which my attention was drawn as well as the other portions thereof which appeared to me to bear on the question I have not been able to discern therein or in any of the material before me any basis for concluding that any of the four elements or means referred to in the claim, whether by themselves or in any cooperatively acting group short of all the elements or means referred to in the claim and whether in an apparatus of the kind referred to in the claim or elsewhere could constitute an invention. There is nothing new about the product or result of using the apparatus and even to one inexperienced in the field there is nothing about any of the several elements claimed that strikes one as being capable of being regarded as novel, either in itself or in its employment in or in conjunction with a rolling or pressing

1969

LIBBEY-
OWENS-FORD
GLASS CO.v.
FORD MOTOR
CO. OF
CANADA, LTD.

Thurlow J.

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 Co. OF
 CANADA LTD.
 Thurlow J.

apparatus. In my view, therefore, the essence of the invention patented by claim 1 must lie, if anywhere, in the combination and arrangement in apparatus for pressing curved glass sandwiches of the several elements consisting of devices to produce proper entry between rollers, to rock the windshield while being rolled and to discharge it properly. This substance, as I see it, is not present in an apparatus in which one of the devices essential to the combination is not present.

I find therefore that claim 1 is not infringed by the defendant's use of its pressing machines in conjunction with load stands but that it was infringed by the use of the tacker unit prior to September 1964 in conjunction with a feed conveyor.

With respect to claim 2 counsel for the defendant raised no additional points but took the position that whether or not it was infringed would turn on whether or not claim 1 was infringed. Claim 2 reads:

- 2 In apparatus of the character defined in claim 1, means for resiliently pressing said rolls together along said confined passage.

For the reasons given with respect to claim 1, I am of the opinion that the claim has not been infringed by the use of the defendant's machines in conjunction with load stands but has been infringed by the use of the defendant's tacker unit in conjunction with a feed conveyor.

Claim 3 reads:

3. In apparatus for pressing together the sheets of a curved glass-plastic sandwich, *conveyor means for moving said sandwich in a defined path* transversely to an axis of curvature thereof, a pair of rolls disposed *transversely of said path* to provide a confined passage therebetween which is located *above said conveyor means* and generally parallel to said axis of curvature of the sandwich, *means for rotating said rolls in opposite directions to provide driving movement through said confined passage, and means for rocking said rolls, as a unit, to receive the forward end of said sandwich from the conveyor means* at one side of said rolls then tilt said sandwich and finally release the rearward end of said sandwich onto the conveyor means at the other side of said rolls after said sandwich has been moved through said confined passage.

Arguments were raised on the several portions of the claim which have been italicized. It was not suggested, however, that the expression "conveyor means" for moving said sandwich in a defined path in this claim meant anything different from the corresponding expression in claim 1 and

the arguments with respect to this and the expression “transversely of said path” and “means for rotating said rolls in opposite directions to provide driving movement through” were the same as those made with respect to the corresponding expressions in claim 1. My opinion thereon is, accordingly, the same as well.

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 Co. OF
 CANADA, LTD.

Thurlow J.

The point made with respect to the wording “above said conveyor means” was that even if the defendant’s load stands and feed conveyor could be considered conveyor means within the meaning of the claim in neither case were the rolls disposed above them. In the device described in the specification the rolls are shown above the conveyor belt but at that point it has been diverted downwards since that portion of it is no longer engaged in supporting the windshield. Mr. Henderson pointed out that the wording does not say “directly” above and that in the apparatus described in the specification there is no function to be performed by having the rollers directly above the conveyor. In his submission all that was required was that the rollers be higher than the conveyor and this requirement was fulfilled when the defendant’s load stands and load conveyor were being used at a lower level than the initial position of the rollers.

In my view what was contemplated in the specification was a device which would receive the windshield into the rollers with its curved ends pointing upwards—rather than downwards—and then rock the windshield by raising it off the conveyor means and this I think accounts for the use of the language “above said conveyor means” in the claim. Interpreted in this sense the language only requires the conveyor to be lower than the nip of the rollers at the point where it delivers the windshield into the nip of the rollers. I would not therefore sustain the defendant’s position on this point.

Next it was argued that the expression “means for rocking said rolls, as a unit, to receive the forward end of said sandwich from the conveyor means” meant that the conveyor means must itself lead the sandwich into the nip of the rolls and that this was not present in the defendant’s apparatus. There is, as I see it, no requirement in the wording of the claim that the mechanism be so arranged that the rolls will, without human assistance, engage the

1969
 LIBBEY-
 OWENS-FORD
 GLASS CO.
 v.
 FORD MOTOR
 CO. OF
 CANADA LTD.
 Thurlow J.

sandwich while it rests on the conveyor and apart from the submissions already considered with respect to the defendant's load stands and feed conveyor being means for conveying of the kind referred to in the claim there is in my view no substance in the point taken. The load stands in my opinion were not such means, the feed conveyor was.

Finally it was submitted that the words "finally release the rearward end of said sandwich onto the conveyor means at the other side of said rolls" meant the conveyor means referred to earlier in the claim (since the conveyor means described in the specification continued to the second position and received the sandwich from the rolls) and that since the same conveyor means did not receive the windshield from the rollers in the defendant's apparatus the claim did not cover it. I think the meaning of the words are sufficiently clear without reference to the description in the specification and as I read it the claim is not confined to devices embodying a single conveyor system for both delivering the sandwich to and receiving it from the rolls. The defendant's point is therefore not sustainable.

It follows from the foregoing that claim 3 is not infringed by the use of the defendant's apparatus in conjunction with load stands but was infringed by the use of the defendant's tacker unit in conjunction with a feed conveyor.

No additional submissions were made with respect to claims 4, 5, 6, 7, 8 or 9, which are all dependent on the apparatus falling within claim 3, and accordingly the same conclusion applies in respect to each of these claims.

The next claim relied on by the plaintiff is claim 11 which reads as follows:

11. A method of pressing together the sheets of a curved glass-plastic sandwich, comprising the steps of moving said sandwich along *one predetermined path*, receiving said sandwich from said path in a confined passage between rotary pressing elements, *lifting said sandwich from said path*, passing said sandwich between said pressing elements, and releasing said sandwich onto another predetermined path.

The sole point taken by the defendant on this claim turned on the meaning of the expressions which I have italicized and the argument was that in the defendant's apparatus there was no predetermined path along which the sand-

wich was moved or from which the sandwich was lifted, that the words of the claim contemplated a path provided by a mechanism, which is not present in the defendant's apparatus and that even if the path referred to means only the last quarter inch of travel prior to the engagement of the leading edge of the windshield between the nip of the rollers, in the defendant's operation there is no predetermined path at all prior to the actual engagement of the windshield in the rollers. The plaintiff's submission, as I have noted it, was that the path referred to is that defined by the relationship of the angularly disposed rollers and the position of the top of the defendant's load stand and proceeds to the point where the activating means takes over so that there is a rocking and a lifting of the windshield". If I understand this correctly it implies that the predetermined path really only begins when the leading edge of the windshield is being engaged by the rollers. This interpretation appears to me to be in conflict with the subsequent expression "releasing said sandwich onto another predetermined path", which appears to me to contemplate the path to be followed by the windshield after it has been released and I think that something of the same nature is what was contemplated by the use of the expression "along one predetermined path" earlier in the claim. That, however, as I see it, is the situation in the defendant's operation for at least some short distance prior to engagement of the windshield in the nip of the rollers even when a load stand is being used and as the wording of the claim imposes no limitation with respect to the length of the path or as to the means by which the movement along it is to be achieved I do not think the defendant's point is maintainable. I find therefore that this claim is infringed by the use of the defendant's apparatus whether in conjunction with a load stand or a feed conveyor.

Claims 12 and 13 are dependent on claim 11 and the same conclusion follows as to infringement of each of them.

A different problem was raised on the wording in claim 14 which reads:

14. A method of pressing together the sheets of a curved glass-plastic sandwich *during continuous movement thereof along a substantially straight path* transverse to an axis of curvature of said sandwich, comprising the steps of receiving the forward end of said sandwich in a confined passage between rotary elements

1969

LIBBEY-
OWENS-FORD
GLASS CO.v.
FORD MOTOR
CO. OF
CANADA, LTD.Thurlow J.
—

1969

LIBBEY-
OWENS-FORD
GLASS CO.

v.

FORD MOTOR
CO. OF
CANADA, LTD.

Thurlow J.

when said sandwich is located in a first position along said path, *rocking said sandwich on said rotary elements about an axis parallel to the axis of curvature of said sandwich from said first to a second position along said path while pressingly passing said sandwich between said rotary elements*, and releasing the rearward end of said sandwich from said confined passage when said sandwich is located in said second position.

Here the question arising on the first italicized passage is really whether the reader is to view the path from above, in which case in both the defendant's machines and that described in the specification the path of the windshield would appear straight or substantially so, or from the side, front or rear in which case, in both the defendant's apparatus and that described in the specification, the path would become higher and then lower as the rocking progressed but in the defendant's machines would also be affected vertically by reason of the axis on which the rocking frame rocks being angled 10° from horizontal. In my view the path referred to in the claim means a path viewed from above and I see no reason for regarding the path as being otherwise than straight for the purposes of the claim merely by reason of there being undulation or lack of evenness in the course of the path. In short as I see it a path can be straight even though it may be hilly and uneven. The defendant's point is therefore in my view without substance.

The second point taken, as I understand it, was that as the axis on which the frame which supports the rollers in the defendant's machines is set at an angle of about 10° from horizontal the step of "rocking said sandwich on said rotary elements about an axis parallel to the axis of curvature of said sandwich from said first to a second position along said path while pressingly passing said sandwich between said rotary elements" was not present in the defendant's machines. This submission is based on an interpretation of the wording as meaning that the rocking axis referred to is to be parallel to the horizontal transverse plane of the path referred to earlier in the claim. I do not so read it however. In my opinion the rotary elements referred to are the rollers and it is their axis which is to be parallel to that of the curvature of the sandwich from the first to the second position along the path while the pressing is being done. This as I understand it is the situation

in the defendant's machines. In my view, therefore, the elements of this claim are all present in the use of the defendant's machines whether used with a feed conveyor or with load stands and such use constitutes infringement of the claim.

Neither claim 15 nor claim 16, both of which are dependent on claim 14, adds any element not present in the defendant's apparatus and in my opinion these claims are similarly infringed as well.

Claim 17 reads as follows and here again I have italicized the wording on which argument arose:

17. A method of pressing curved glass-plastic sandwiches which includes the steps of *moving the sandwich forwardly with its leading area carried in a general plane of angularity coincident with a tangential plane common to opposed rotating pressure elements*, passing the sandwich between the pressure elements while rocking the same about a common axis and then removing the sandwich from between the pressure elements when the tangential plane common thereto coincides with the plane of the following area of the sandwich along which said following area moves from between the pressure elements.

The point raised was that the action of an operator of the defendant's machines cannot be said to be a "carrying" of the leading area in the required plane within the meaning of the claim and that in any event the claim requires more than the precise instant of coincidence which occurs at the time the leading edge goes into the nip. I incline to the view that some period of "carrying" however short prior to actual engagement by the rollers is contemplated by the claim but I see nothing in its language to restrict the means of moving the sandwich or carrying its leading edge in the required plane to mechanical devices therefor. As worded the claim appears to me to contemplate the defined method of pressing, however accomplished. In my opinion therefore this claim is infringed as well by the use of the defendant's machines whether in conjunction with load stands or a feed conveyor.

A similar point was made on the wording of claim 18 which, however, by its terms is limited to a method of pressing for the purpose of exhausting entrapped air from the sandwich. The submission fails for the same reason and in my opinion this claim is infringed by the defendant's use of its de-airing apparatus.

1969

LIBBEY-
OWENS-FORD
GLASS CO.v.
FORD MOTOR
CO. OF
CANADA LTD.

Thurlow J.

1969

LIBBEY-
OWENS-FORD
GLASS Co.
v.
FORD MOTOR
Co. OF
CANADA LTD.
Thurlow J.

Claim 19 reads as follows:

19. In apparatus for pressing together the sheets of a curved glass-plastic sandwich, *conveyor means for moving a curved leading end of said sandwich in a path substantially transversely of an axis of curvature thereof*, a pair of pressing rolls disposed *transversely of said path* to provide a confined passage therebetween along a plane tangentially common to both of said rolls, and *means mounting said rolls to dispose said confined passage angularly with respect to the path of said curved leading end of the sandwich for receiving the same in said confined passage along said plane tangentially common to both of said rolls.*

Submissions were made with respect to the first two portions of this claim which I have italicized, similar to those made on the similar expressions in claim 1 and my opinion on them is the same. A third point made was that the expression "*means mounting said rolls to dispose said confined passage angularly with respect to the path of said curved leading end of the sandwich for receiving the same in said confined passage along said plane tangentially common to both of said rolls*" calls for such an orientation of the path with respect to the rolls that the leading edge is received automatically into the nip and that this is not present where an operator is required to put the leading edge into the nip. In my opinion on the wording of this claim when the required conveyor means is present it does not matter that the entry of the leading edge into the nip is not accomplished automatically and without human assistance. My finding is accordingly the same on this claim as on claim 1, that is to say that it is infringed by the use of the defendant's tacker unit in conjunction with a feed conveyor but is not infringed by the use of either the tacker unit or the de-air unit in conjunction with a load stand.

The remaining claim relied on was claim 20 which reads:

20. In a method of pressing together the sheets of a curved glass-plastic sandwich, the steps of *moving a curved leading end of said sandwich in a defined path* substantially transverse to an axis of curvature thereof, and moving a pair of pressing rolls into position to receive said curved leading end of the sandwich in a confined passage between said rolls along a plane tangentially common to both of said rolls.

Here again the argument developed over what was embraced within the wording "moving a curved leading end of said sandwich in a defined path" and it was submitted that this wording could not apply in the defendant's

operation since there was no defined path in which the leading edge was moved even in the last quarter of an inch of its travel to the nip of the rollers. In my opinion, the defined path referred to in the claim is the path of the sandwich itself from the time its leading edge is in the common tangential plane of the rollers until the sandwich is lifted from such path by the rocking action of the device on which the rollers are mounted and the claim as worded is not restricted to situations in which the support and movement of the sandwich in such path is provided by mechanical means. It follows as I see it that this claim is infringed by the defendant's operation of its machines whether in conjunction with a feed conveyor or with load stands.

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 Co. OF
 CANADA, LTD.
 Thurlow J.

In summary I find that, except during the period in September 1963 when the rocking mechanisms of both machines were not operated but maintained in a fixed position while the machines were in operation,

- (1) the use of the defendant's tacker unit in conjunction with a load conveyor from the date of the patent to September 1964 infringed all the claims relied on except claim 18;
- (2) the use of the defendant's tacker apparatus since September 1964 in conjunction with a load stand infringed claims 11, 12, 13, 14, 15, 16, 17 and 20 but not any of the other claims relied on.
- (3) the use of the defendant's de-air apparatus since the grant of the patent in conjunction with a load stand infringed claims 11, 12, 13, 14, 15, 16, 17, 18 and 20 of the patent but not any of the other claims in suit. With respect to the operation of the tacker apparatus from September 1964 to the commencement of the action the second of the above findings is in conflict with the *prima facie* meaning of the admission of the defendant's letter of August 8, 1968, that claim 1 was also infringed thereby but on reading the letter in the light of the finding I do not think it is necessarily inconsistent therewith. However, even if it is, the finding, as I view the matter, must prevail.

I turn now to the third area of controversy, the defence based on section 58. Here the defence is that the defendant

1969
 LIBBEY-
 FORD MOTOR
 GLASS CO.
 v.
 FORD MOTOR
 CO. OF
 CANADA LTD.
 ———
 Thurlow J.
 ———

acquired both its tacker and its de-air apparatus and had them in operation to press curved glass windshields before the patent issued and that in consequence it is entitled to have and use them without being accountable to the plaintiff therefor whether so doing infringes the patent or not. Apart from contending that the use of these machines to press curved glass windshields prior to the issue of the patent was not established the plaintiff's main contention was that section 58 provides immunity only in respect of tangible subject matter of a patent but affords none in respect of the use of a patented process and so could not justify the defendant's use of the machines to press curved glass windshields by the patented methods. If so it is apparent that there is little scope for the operation of section 58 whenever a patent in respect of a newly invented machine includes claims directed to the methods by which it is to be used to achieve its purposes.

The section reads:

58. Every person who, before the issuing of a patent has purchased, constructed or acquired any invention for which a patent is afterwards obtained under this Act, has the right of using and vending to others the specific article, machine, manufacture or composition of matter patented and so purchased, constructed or acquired before the issue of the patent therefor, without being liable to the patentee or his legal representatives for so doing; but the patent shall not, as regards other persons, be held invalid by reason of such purchase, construction or acquisition or use of the invention by the person first mentioned, or by those to whom he has sold it, unless it was purchased, constructed, acquired or used for a longer period than two years before the application for a patent therefor, in consequence whereof the invention became public and available to public use.

The only other section of the Act which appears to me to have any important bearing on the question is section 2(d) which is as follows:

2. In this Act, and in any rule, regulation or order made under it,
 . . .
 (d) "invention" means any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter;

This definition has been unchanged in the English language editions of the Patent Acts of this country since

1923³ when the word “process” was inserted in two places in each case between the words “art” and “machine”. Prior to that the definition had been unchanged since the coming into force of chapter 61 of the Revised Statutes of Canada 1886.

Section 58, the forerunner of which was enacted in 1869⁴, has had no change material to the present problem since enacted as section 48 of chapter 26 of the Statutes of Canada 1872. Since then, however, substantial changes have been made from time to time in other provisions of the patent law particularly in those relating to entitlement to patent protection.

There is no Canadian case in which the precise point raised by the plaintiff has been determined but the problem has been considered in the United States, where a similar statutory provision was in effect from 1838-1870 and there are various comments to be found in text books on the subject. The argument covered these and raised points as well on the historical development of the Canadian section and on its particular wording.

In the view I take the proper approach to the interpretation of section 58 is to first read its wording, coupled with that of section 2(d), in an effort to ascertain its meaning therefrom without reference to preconceived notions generated by knowledge of how the comparable but different sections of earlier Acts read and without reference to expressions of opinion by text writers or by the courts of other countries thereon. *Vide S. & S. Industries Inc. v. Rowell* [1966] S.C.R. 419 per Martland J. at page 425; *Bank of England v. Vagliano Brothers* [1891] A.C. 107 per Lord Herschell at page 144; and *Wilkinson Sword (Canada) Ltd. v. Juda* [1968] 2 Ex. C.R. 137 per Jackett, P. at page 161.

So reading section 58 the first observation to be made, as I see it, is that the first part of the section applies to “every person who has purchased, constructed or acquired any invention for which a patent is afterwards obtained”.

³ Statutes of Canada 1923, c. 23.

⁴ A provision dealing with the same subject had been in the patent law of the Province of Canada from 1849. *Vide* Statutes of Canada 1849, c. 24, s. 12; Statutes of Canada 1851, c. 79, s. 1; Consolidated Statutes of Canada 1859, c. 34, s. 22.

1969
LIBBEY-
OWENS-FORD
GLASS CO.
v.
FORD MOTOR
CO. OF
CANADA, LTD.
Thurlow J.

1969
 LIBBEY-
 OWENS-FORD
 GLASS CO.
 v.
 FORD MOTOR
 CO. OF
 CANADA LTD.
 Thurlow J.

In this context the word "invention" appears to me to be broad enough to embrace any patentable subject matter, whether tangible or intangible, that would fall within what the word "invention" is defined by section 2(d) to mean, that is to say, "any new and useful art, process, machine, manufacture or composition of matter, or any new and useful improvement in any art, process, machine, manufacture or composition of matter". The verbs "purchase" and "construct" would not go well with the objects "art" or "process" nor would the verb "construct" go well with the object "manufacture" but it appears to me that the verb "acquire" is broad and versatile enough to comprehend any process of acquisition whether it be by purchase, gift, invention or discovery and, in its sense of gaining for oneself by one's own efforts, to be capable of applying as well to the acquisition of an art or process by invention or discovery or by learning, however obtained, or by the practice of it, as to any of the tangible items comprehended by the expressions "machine, manufacture or composition of matter".

To my mind as well the acquisition which this portion of the section appears to be directed to is that of the subject matter of the invention itself rather than that of the right which accrues to the first inventor to obtain patent protection therefor or that of such rights as the inventor of a patentable but unpatented invention can confer on another. In short it appears to me to embrace everyone who has somehow come by the subject matter of an invention before a patent therefor was obtained. There are no doubt cases wherein a person is disqualified by his own dishonest conduct from asserting a right under the section but these, as I see it, depend on principles of equity rather than on principles of statutory interpretation.

Next, the word "invention" appears later in the section in a context in which it is associated with the words "purchase, construction or acquisition", which are related by the word "such" to the earlier words "purchased, constructed or acquired", and is associated as well with the word "use". Here again the word "invention" appears to me to have the same connotation as it has in the opening words of the section. This latter portion of section 58 is directed to protecting the inventor against effects which such purchase, construction, acquisition or use might

otherwise have on his right to a patent and to my mind the significant feature of it is that the protection so provided is not confined to patentable subject matter of any particular nature or kind but applies to any kind of patentable subject matter whether tangible or intangible.

Turning now to the right conferred by section 58 on the person who qualifies for it it will be observed that it is a right to use and vend to others "the specific article, machine, manufacture or composition of matter patented and so purchased, constructed or acquired before the issue of the patent therefor". Here the word "so" relates the purchase, construction or acquisition referred to to that mentioned earlier in the section as qualifying the person to whom the section applies but at this point instead of the word "invention" the expression "article, machine, manufacture or composition of matter" appears coupled with the additional qualifying words "specific" and "patented". In this context the words "machine, manufacture or composition of matter" have, I think, the same meaning as they have in section 2(d) where they appear to me to be at least comprehensive enough to embrace (whether they embrace more or not) every kind or type of physical or tangible subject matter patentable as an invention. If, therefore, the word "article" is to be taken, as I think it must, as indicating something in addition to or apart from what is embraced by these expressions it seems to me that it must have been intended either to refer to and comprehend intangible subject matter embraced within the meaning of "art" and "process" in the definition of invention or to refer to what is connoted by the reference therein to an "improvement". In the definition, however, the improvements referred to are those in any art, process, machine, manufacture or composition of matter and thus if the word "article" refers to such improvements it refers to improvements in arts and processes as well as in machines, etc., and thus to intangible as well as to tangible patentable subject matter.

In its ordinary usage the word "article" has a number of different meanings depending on the context in which the word is used. Some of these meanings vary quite widely but in most cases they refer to intangibles. It is noticeable as well that it is the meanings of the word in reference to

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 Co. OF
 CANADA, LTD.
 Thurlow J.

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 Co. OF
 CANADA LTD.
 ———
 Thurlow J.
 ———

intangibles that are given first in the Shorter Oxford Dictionary, and that this applies as well to the Little Oxford Dictionary which gives but the commonest meanings of a selection of the more common English words. The meaning given for "article" in the Little Oxford Dictionary is:

Article, *n.* clause of agreement, treaty, etc.; short literary composition; any particular thing. *v.t* bind by articles of apprenticeship; set forth in articles

In my opinion, as used in the context of section 58, that is to say, a context referring to the subject matter of patentable inventions the meaning of "article" can be very broad and can be read as referring to the *res* or subject matter *patented and so purchased, constructed, or acquired* etc., regardless of whether such *res* or subject matter is tangible or intangible. In its context in section 58 the word appears to me to be the equivalent of such words as "item" or "particular" and if it is to have meaning beyond what falls within the meaning of the words "machine, manufacture or composition of matter" in the definition of invention in section 2(d), as I think it must, it seems to me that the word must refer to or at least include reference to what is embraced within the meaning of the words "art" and "process" in the definition in section 2(d). As I see it there are considerable areas of overlapping of the meanings of the several words used, both in the definition of invention in section 2(d) and in section 58, but if, as I think, the words "machine, manufacture or composition of matter" have the same meaning in both and if, as I also think, the word "invention" as used in section 58 comprehends the whole scope of patentable subject matter as defined in section 2(d) it seems to me that the selection and use of so broad and versatile a word as "article" indicates that whatever overlapping its meaning may have with that of the other expressions used its meaning should be interpreted broadly enough to refer to anything patentable that is embraced within the meaning of the words "art" and "process" but happens to fall outside the meaning of the three other expressions used in the definition of invention.

On this analysis of section 58 I am accordingly inclined to the opinion that the words "article, machine, manufacture or composition of matter patented" are broad enough by themselves to embrace anything whether tangible or intangible which is patentable as an invention and that the

scope of what the person referred to in section 58 may use and sell is limited only by the adjective "specific" and the subsequent expression "so purchased, constructed or acquired before the issue of the patent therefor." The effect of these words, as I see it, in respect to an "article" whether tangible or intangible, is to limit the use that may be made of the patented subject matter to use of the specific item of patented subject matter acquired before the patent issued.

1969
LIBBEY-
OWENS-FORD
GLASS Co.
v.
FORD MOTOR
Co. OF
CANADA, LTD.
Thurlow J.

While the section is worded somewhat clumsily, its meaning in this view would come to this:

"Every person, who, before the issuing of a patent has purchased, constructed or acquired *any invention* (i.e., *any* new or useful art, process, machine, manufacture or composition of matter) for which a patent is afterwards obtained, under this Act, has the right of using and vending to others the specific *thing* patented and so purchased, constructed or acquired before the issue of the patent therefor . . ."

This interpretation is, I think, supported by the consideration that the word "invention" would not fit well with the adjective "specific" in place of the several expressions used in section 58 since the effect could be to authorize use of the patented invention in more ways than had been practised before the issue of the patent. The interpretation is also supported by the consideration that there seems no reason in principle why, when the section is applicable to every person who has acquired any "invention" prior to the issue of a patent therefor, the words "article, machine", etc., should not be regarded as intended to refer to anything falling within the scope of patentable subject matter. Otherwise, it seems odd that the draftsman should not have used the words "article, machine" etc., in the place where the word "invention" first appears in the section,⁵ as well as in the second place where the word "invention" appears.

Next there is the consideration that the reason for having such a provision in the law seems to apply with as much force in the case of a process or method invention as in that of any other kind of invention. The grant of an exclusive right to an invention for a limited period rewards a person, who has made the invention and has disclosed it

⁵ This was the way section 7 of the United States Act of 1839 on which *McCullurg v. Kingsland* (1843) 42 U.S. 202, turned, was worded.

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 Co. OF
 CANADA LTD.
 Thurlow J.

to the public in the prescribed manner, for the benefit which thereby accrues to other members of the public. However, a member of the public who makes or acquires the invention, or some part of it, by himself before it becomes available to the public has, to that extent, no benefit to derive from the publication, yet, without a provision such as section 58, he would be restrained from practising what he had learned and done by himself before the publication by the person to be rewarded for the information.⁶ MacLean P. expressed the purpose of the section thus in *Schweyer Electric & Mfg. Co. v. N.Y. Central Railroad Co.*⁷:

The section is confusing and its meaning should be clarified. This statutory provision appeared in Chap. 34 of the Statutes of Canada for 1859, and also in Chap. 24 of the Statutes of Canada for 1848-9; which statutes related to patents, and the meaning and purpose of the provision was, I think, more clearly expressed in those statutes than in sec. 50 of the Patent Act. It seems to me that section means and was intended to mean, that if a person has acquired in some way or other, something which was the subject of an application for a patent by another who is presumably the first inventor, but for which a patent had not yet issued, he, the former, shall have a continuing right to use and vend the same notwithstanding the issue of the patent to the other person. That is the only interpretation I can put upon the section.

This consideration as well therefore inclines me to the view that the expressions used in section 58 apply to the whole scope of patentable subject matter both tangible and intangible.

This view, moreover, coincides with that taken by the Supreme Court of the United States on the purpose of a corresponding provision of the United States patent law of 1839 in *McClurg v. Kingsland*⁸ which, despite criticism

⁶ Mr. J. G. Fogo in his article on section 58 in 38 C.P.R. 147 cites at page 149 as an interesting hypothesis to explain why rights are accorded a prior user the following presentation given by George Benjamin in the Journal of the Patent Office Society:

The right to use *any* article, process or composition of matter is a natural right in all persons independent of patent protection. The State, by legislation, gives to the patentee an added right in exchange for teaching the nation—an exclusive right—the right to exclude others from manufacture, sale and use of the invention. The words “exclusive” and “exclude” stem from the Latin “excludere”—to lock out. But you can lock out only those who are not already inside when the fence is erected. Thus those already practising the invention at the critical date are not excluded.

⁷ [1934] Ex. C.R. 31 at 65.

⁸ (1843) 42 U.S. 202.

that had been expressed in the meantime was reaffirmed by the same court in *Andrews v. Hovey*⁹. In the *McClurg* case the court said at page 208:

The remaining exception is to the charge of the court below, on the effect of the 7th section of the act of 1839, which is in these words: "That every person or corporation who has, or shall have purchased or constructed any newly-invented machine, manufacture, or composition of matter, prior to the application by the inventor or discoverer of a patent, shall be held to possess the right to use and vend to others to be used, the specific machine, manufacture, or composition of matter, so made or purchased, without liability therefore to the inventor, or any other person interested in such invention; and no patent shall be held invalid by reason of such purchase, sale, or use prior to the application for a patent as aforesaid, except on proof of abandonment of such invention to the public, or that such purchase, sale, or prior use has been for more than two years prior to such application for a patent." Pamphlet Laws, 1839, 74, 75.

The object of this provision is evidently twofold; first, to protect the person who has used the thing patented, by having purchased, constructed, or made the machine, etc., to which the invention is applied, from any liability to the patentee or his assignee. Second, to protect the rights, granted to the patentee, against any infringement by any other persons. This relieved him from the effects of former laws and their constructions by this court, unless in case of an abandonment of the invention, or a continued prior use for more than two years before the application for a patent, while it puts the person who has had such prior use on the same footing as if he had a special license from the inventor to use his invention; which, if given before the application for a patent, would justify the continued use after it issued without liability.

The *McClurg* case was decided in 1843. In *Andrews v. Hovey*, decided in 1888, the court reviewed it and other cases which had been decided in the meantime and said of the *McClurg* case at page 703:

The first case in which the 7th section of the Act of 1839 appears to have come under consideration in this court was that of *McClurg v. Kingsland*, 42 U.S. 1 How. 202, decided in 1843. But that was a case which involved only the first clause of the section. The patent was for an improvement in the mode of casting chilled rollers. It was, therefore, a patent for an improvement in a process. The patentee invented it while he was a workman in the employ of the defendants. They put it into use in their business. He left their employment, and then applied for and obtained his patent. His assignees sued the defendants in an action at law for continuing to use the improvement. There was a verdict for the defendants, upon the ground that, by reason of their unmolested, notorious use of the invention before the application for the patent, they had a right to continue to use it, under the provisions of the first clause of the 7th section. The judgment for the defendants was affirmed by this court upon that ground. It held that the defendants were on the same footing as if they had

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 Co. OF
 CANADA, LTD
 Thurlow J

⁹ (1887) 123 U.S. 267; (1888) 124 U.S. 694.

1969
 LIBBEY-
 OWENS-FORD
 GLASS Co.
 v.
 FORD MOTOR
 Co. OF
 CANADA LTD.
 Thurlow J.

had from the inventor a special license to use his invention, given before he applied for his patent, and that the first clause of the 7th section extended to the invention or thing patented in that case, although it consisted of a new mode of operating an old machine, as contradistinguished from a patent for a machine. The court distinctly held that the words "newly invented machine, manufacture, or composition of matter," and the words "such invention," in the first clause of the 7th section, meant the invention patented; and that the words "the specific machine, manufacture, or composition of matter" meant the thing invented, the right to which was secured by the patent.

Moreover, in *Barton v. Nevada Consolidated Copper Co.*¹⁰ decided in 1934 a United States Circuit Court of Appeals further held that the expression *machine or other patented article* in a corresponding provision of the 1870 United States statute "should be construed to have the same comprehensive meaning as the Supreme Court attributed to the words 'machine, manufacture, or composition of matter' in the earlier act in *McClurg v. Kingsland*, that is 'invention' or 'thing patented'" and that a patent on a process was as much within the reason of the statute as a patent on a machine.

These considerations lead me to hold that the immunity given by section 58 is not confined to tangible patented subject matter but applies to intangible subject matter as well including patented processes. To my mind, moreover, the contrary conclusion would lead to capricious results which I do not think should be taken to have been contemplated. It would, for example, protect a person's use of an infringing apparatus only insofar as the use of that apparatus was not by a patented method which might well be the only way to use it satisfactorily and the way it was designed to be used. It would also provide no protection against the use of apparatus by a person in the way in which it was designed to be used and had been used even though the apparatus itself bore no resemblance to anything patented as an apparatus and was not within any apparatus claim and even though the patentee had no patented apparatus.

In the course of considering the matter I have also examined the historical development of section 58 but I have not derived assistance from it. In this connection counsel for the plaintiff stressed the fact that in the 1869

¹⁰ (1934) 71 F (2d) 381.

statute¹¹ the word *art* appeared in section 48 in place of the word *article* and was changed to *article* in 1872¹² and he urged that this supported his position that arts and processes were not intended to be within the enumeration in that section. There is, however, no presumption that a change in the law is intended by such a change in the language of a statute, which may be intended merely to clarify the law as already expressed, but in any event, no inference to be drawn from such a change of wording can, as I see it, prevail over the necessity to interpret the words used in the section as amended and to give effect to the legislative intent appearing therefrom.

It may also be worthy of note that in the French language edition of the statutes the word *procédé* (which it seems to me would have meant a process) appeared in what is now section 58 in the place of the English word *manufacture* from the time of the enactment of Statutes of Canada 1872, c. 26 to and including R.S.C. 1927, c. 150, s. 50¹³ (that is to say even after the word "process" had appeared in the definition of invention) but that the word was changed to *l'objet manufacturé* (though the English wording did not change) in section 56 of Statutes of Canada 1935, c. 32, which now appears as section 58 of R.S.C. 1952, c. 203. As the 1935 statute was a statutory revision of the patent law rather than a mere consolidation it would seem to follow that the word "manufacture" in the English text can no longer be interpreted as referring to a process. The translation of the English word *article*, however, to *l'article* has not been changed since it appeared in the French language edition of Statutes of Canada 1872, c. 26, s. 48.

A further submission put forward by counsel for the plaintiff was that section 58 applies only when the acquisition of the invention prior to the issue of the patent has been with the consent of the patentee but this to my mind

1969
LIBBEY-
OWENS-FORD
GLASS Co.
v.
FORD MOTOR
Co. OF
CANADA, LTD.
Thurlow J.

¹¹ Statutes of Canada, 1869, c. 11.

¹² Statutes of Canada, 1872, c. 26, s. 48.

¹³ *Vide* S. of C. 1872, c. 26, s. 48.

R.S.C. 1880, c. 61, s. 46.

R.S.C. 1906, c. 69, s. 54.

S. of C. 1923, c. 23, s. 50.

R.S.C. 1927, c. 150, s. 50.

S. of C. 1935, c. 32, s. 56.

R.S.C. 1952, c. 203, s. 58.

1969
 LIBBEY-
 OWENS-FORD
 GLASS CO.
 v.
 FORD MOTOR
 CO. OF
 CANADA LTD.

is not sustainable. There appears to me to be nothing in the wording of section 58 to support it and the judgment of the Ontario Court of Appeal in *Victor Sporting Goods Co. v. Harold A. Wilson Company*¹⁴ which applied the reasoning of the Supreme Court of the United States in *Andrews v. Hovey*, is against it.

Thurlow J.

Turning now to the facts in the present case on the evidence I see no reason to doubt that the defendant's tacker and de-air machines had been purchased and installed by the end of March 1961 and, notwithstanding Mr. Henderson's submissions to the contrary, I find that these machines were in fact used to press curved glass windshields from June 1, 1961, onward and were being used for that purpose on a considerable scale at the time of the grant of the patent. As there has been no change in the defendant's de-air apparatus or in the method of its operation since that time it appears to me to follow from what I have held with respect to section 58 that that section would afford a defence to the plaintiff's claim both in respect of the apparatus itself, even if contrary to what I have found it does infringe the apparatus claims of the patent, and in respect of the method used as well. The same conclusions also appear to me to follow with respect to the defendant's tacker apparatus and its operation in conjunction with a feed conveyor from the time of the issue of the patent until the removal of the feed conveyor in September 1964 and its replacement by a load stand. If, contrary to what I have held, the operation of the combination consisting of the tacker presser and load stand infringes the apparatus claims I do not think section 58 would afford a defence to the plaintiff's claim insofar as it was based on infringement of the apparatus claims since it is not established that this particular combination, including a load stand, making up the tacker apparatus was acquired prior to the issue of the patent but in view of my conclusion on the question of infringement of these claims there is no necessity for the defendant to resort to section 58 for its defence to that particular aspect of the plaintiff's claim. The infringement of the method claims, however, does not depend on the precise combination of apparatus used and even though

¹⁴ (1904) 7 O.L.R. 570.

the tacker combination differed after the introduction of the load stand from what it had been before that the elements of the methods used, whose presence brought its operation within the method claims of the patent, as I see it, were the same both before and after the removal of the feed conveyor and the substitution of the load stand. To this aspect of the plaintiff's claim in respect of the operation of the tacker apparatus after the introduction of the load stand, therefore, section 58, in my opinion, affords a defence.

In the result, therefore, assuming the validity of Canadian Patent number 653,277, as prescribed by the order by which the issue was set down for trial, I find that the defendant is not liable for infringement thereof.

The defendant is entitled to the costs of the issue.

1969
 LIBBEY-
 OWENS-FORD
 GLASS CO.
 v.
 FORD MOTOR
 CO. OF
 CANADA, LTD.
 Thurlow J.