BETWEEN

1904
April 5.

THE INDIANA MANUFACTURING COMPANY..... } PLAINTIFFS;

AND

HARRY WARD SMITH, MARTIN FRANKLIN SMITH, BRUCE SMITH, MARTIN SMITH AND JAMES HAMILTON AND ARCHIBALD SMITH..... } DEFENDANTS.

Patent for invention—Infringement—Assignor and assignee—Estoppel—Fair construction.

Where the original owner of a patent had assigned the same, and was subsequently proceeded against by the assignee for the infringement of the patent so assigned, the former was held to be estopped from denying the validity of the patent but, inasmuch as he was in no worse position than any independent member of the public who admitted the validity of the patent, he was allowed to show that on a fair construction of the patent he had not infringed.

THIS was an action for the infringment of a patent for invention.

The facts of the case are stated in the reasons for judgment.

January 26th 1904.

The case was tried at Hamilton, Ont.

February 22nd, 1904.

The case was now argued at Ottawa.

W. D. Hogg, K.C., for the plaintiffs;

C. A. Masten for the defendant H. W. Smith.

J. P. Stanton for the defendants Martin F. Smith, Bruce Smith and Martin Smith.

W. H. Hogg, K.C., for the plaintiffs, contended that the defendants were estopped from setting up the

1904

THE INDIANA MANUFACTURING CO. v. SMITH.

Argument of Counsel.

invalidity of the patent because the plaintiffs deduced their title from the defendants. A vendor cannot attack the title of his vendee under a grant. (*Oldham* v. *Langmead* (1); *Chambers* v. *Critchley* (2); *Whiting* v. *Tuttle* (3); *Frost on Patents* (4).

On the merits of the case the facts show very clearly that the "chaff-board", claimed in paragraph No. 5 of the claim of the plaintiffs' patent, has been infringed. Not only the "chaff-board" but the "fan" and the "hopper" have also been infringed. Parts of our claim, such as the hopper and fan and the "fan-housing," have been directly infringed by the defendants. The invention shown in plaintiffs' claim as to a "chaff-board" is absolutely a new thing. It produces, almost automatically, a desired result in a pneumatic stacker. The defendants cannot evade their infringement by showing that they use a piece of canvass instead of a board to effect the same purpose. The mere change of one material for another is not sufficient to enable them to escape the charge of infringement. A mechanical equivalent is an infringement under such circumstances as exist in this case. If you have a mere colourable device it is not a "mechanical equivalent" but is simply an infringement.

The plaintiffs' invention consists of two distinct combinations: 1st, the interior arrangement which makes a complete pneumatic stacker; and, 2ndly the combination described in our claim No. 7, including the "fan-housing," the "discharge-pipe," the "collapsible elbow" and the "sleeving." The pith and marrow of the invention under claim No. 7 is in the fact that we have a movable stack; so far as the defendants use a device by which the discharge-pipe of the stacker is made easily movable they are infringing

(1) 1 Web. P. C. 291.
(2) 33 Beav. 37.
(3) 17 Grant 454.
(4) 2nd ed., pp. 354, 355.

1904

THE INDIANA MANUFACTURING CO. v. SMITH.

Argument of Counsel.

our invention covered by claim No. 7. If the collapsible elbow and sleeve constitute an invention, they have been infringed here by the defendants.

C. A. Masten, for the defendant H. A. Smith, contended that while the defendant for whom he appeared might be technicallv estopped from denying the validity of the patent, such estoppel would be limited to the identical thing covered by the assignment under which the plaintiffs made title to the patent. The position of the defendants here is very little different from that which any independent member of the public who admitted the validity of the patent would occupy, and it is open to them to show that on a fair construction of the patent they have not infringed.

The plaintiffs' patent is not a primary one, and therefore the doctrine of equivalents does not apply with the same strictures as if it were. (*Walker on Patents* (1).)

As to claim No. 5 in plaintiffs' patent, defendants' device of a piece of canvas instead of a board was used at the time of the assignment. It would not operate successfully in the plaintiffs' device; more than this it serves the purpose better. The canvas stops the draft from the separator, while the board does not discharge the desired function in substantially the same way. (*Cropper* v. *Smith* (2); *Franklin Hocking & Co. Limited* v. *Franklin Hocking* (3); *Western Telephone Const. Co.* v. *Stromberg* (4); *Martin & Hill Cash-Carrier* v. *Martin* (5); *Babcock* v. *Clarkson* (6); *Smith* v. *Ridgely* (7); *Brown* v *Jackson* (8); *Consolidated Car Heating Co* v. *Came* (9).)

(1) 3rd ed. secs. 354, 359, 362.
(2) 26 Ch. D. 700; 10 App. Cas. 249.
(3) 6 Cutl. R. P. C. 69.
(4) 66 Fed. Rep. 550.
(5) 67 Fed. Rep. 787.
(6) 63 Fed. Rep. 607.
(7) 103 Fed. Rep. 877.
(8) 3 Wheat. 449.
(9) 19 T. L. R. 692.

1904

THE INDIANA MANUFACTURING CO. v. SMITH.

Reasons for Judgment.

J. P. Stanton followed for the defendants *Martin F. Smith*, *Bruce Smith* and *Martin Smith*, citing *Rowcliffe* v. *Morris* (1); *Graham* v. *Earl* (2); *Sykes* v. *Howarth* (3); *Walker on Patents* (4).

W. D. Hogg, *K.C.*, replied citing *Edmunds on Patents* (5).

THE JUDGE OF THE EXCHEQUER COURT now (April 5th, 1904) delivered judgment.

The action is brought for the infringement, by the defendants, of letters-patent numbered 73416 for alleged new and useful improvements in pneumatic straw stackers, issued on the 15th of October, 1901, to the defendants Harry Ward Smith and Martin Franklin Smith. The latter assigned his interest in the patent to the former, who afterwards, and before this action was brought, assigned to the plaintiffs. Before the hearing, the plaintiffs discontinued the action as against James Hamilton and Archibald Smith, and nothing has been shown to connect Bruce Smith and Martin Smith with any infringement of the plaintiffs' patent; and the action as against them will be dismissed with costs.

The pneumatic straw stackers alleged to be an infringement of the patent in question here was constructed by Harry Ward Smith, Martin Franklin Smith being employed as a workman in their construction, but having no other interest therein. He has no objection, so far as he is concerned, to the injunction asked for being granted; but asks that he may have his costs, or at least that costs should not be given against him.

Mr. Masten, for the defendant Harry Ward Smit ,

(1) 3 Cutl. R. P. C. 17.
(2) 92 Fed. Rep. 155.
(3) 12 Ch. D. 826.
(4) 3rd ed. p. 302, n. 5.
(5) 2nd ed. p. 340.

1904

THE INDIANA MANUFACTURING CO. v. SMITH.

Reasons for Judgment.

admitted on the hearing that the latter was estopped from denying the validity of the patent, but alleged that he was entitled to adduce evidence to show the state of the art in order that the claims made in the specification should receive a proper construction; and evidence of that character and for that purpose was admitted.

It is conceded that the defendants cannot as against the plaintiffs set up in this action or show that the alleged invention was not new or useful, or that there was no invention, or that they were not the first or true inventors. Neither can they attack the specification for insufficiency or otherwise; but it is contended that, conceding the validity of the patent, they are otherwise in a position that does not differ materially from that which any independent member of the public who admitted the validity of the patent would occupy; and that it is open to them to show that on a fair construction of the patent they have not infringed. I think the cases on which Mr. Masten relied support that view, and I accept it as a fair though somewhat general statement of the law on that subject.

Then with respect to infringement, it seems to me, and I find, that the pneumatic straw stackers made by the defendant Harry Ward Smith are infringements of the patent in question in respect of the element or feature described in the 5th claim as a chaff board. I do not doubt that the chaffing apron, as he called it, and which he now uses to perform the office or function that the chaff board as described in the patent performed, does its work better than the chaff board did; and it is clear, of course, that it differs from it in some particulars. But the object aimed at and attained in each case is the same. The principle is also the same, and there is not, it seems to me, sufficient difference in the means used to attain that object to enable one to

1904

THE INDIANA MANUFACTURING CO. v. SMITH.

Reasons for Judgment.

say that there is no infringement. The chaffing apron may be, and no doubt is, an improvement on the chaff board; but it is, I think, an improvement that the defendant Harry Ward Smith is not entitled to use without the plaintiffs' consent.

With respect to the other matters discussed, the discharge pipe, the sectional telescopic elbow with means for adjusting the same and the circular track or turntable, the patent relied upon is, it appears to me, good only for the particular mode of construction described therein, and the defendant having used a different form of construction in the straw stackers complained of, has not infringed the patent.

A question having arisen on the argument as to the plaintiffs' status and their right under the laws of the Province of Ontario to maintain this action, that objection was abandoned; the plaintiffs at the same time abandoning any claim for damages in respect of the pneumatic straw stackers that had been made or sold by the defendant Harry Ward Smith before this action was brought.

There will be judgment for the plaintiffs against the defendants Harry Ward Smith and Martin Franklin Smith, and an order for an injunction against both of them, and the plaintiffs are, I think, also entitled to costs as against them.

Judgment accordingly.

Solicitors for the plaintiffs: *Hogg & Magee.*

Solicitor for the defendants: *F. B. Featherstonhaugh.*