
NIEBLO MANUFACTURING CO., INC. . . . PLAINTIFF;
 AND
 DAVID J. REID ET AL. DEFENDANTS.

1927
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 Sept. 14.  
 Oct. 22.  
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*Patents—Invention—Prior art—Commercial success—Improvement*

The patent in suit, dated the 16th December, 1924, was for golfing tees. One of these tees comprised a shank having a pointed end, and a disked or concaved ball-supporting member connected with and carried by the shank, and the other consisted of a cone shaped shank with a disk shaped member at the top to support the ball. The structure and function of the golfing tee was well defined and known in the prior art.

*Held*, that, where the patented device embodies most of the features, functions and contrivances of the prior art, the mere difference in some small structural details, does not constitute invention.

2. The fact that a device was somewhat of an improvement on the prior art and had resulted in commercial success, only afforded a presumption of its usefulness, and was not conclusive that such improvement constituted invention.

ACTION by plaintiff to have it declared that Canadian Patent No. 245,444 was valid and infringed by the defendants.

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

*R. S. Cassels, K.C.*, for plaintiff.

*R. S. Smart, K.C.*, for defendants.

The facts are stated in the reasons for judgment.

AUDETTE J., now (22nd October, 1927), delivered judgment.

The plaintiff company bring their action against the defendants, for an alleged infringement of the Canadian Patent No. 245,444, bearing date the 16th December, 1924, granted to them, as assignee of the patentee, William Lowell.

The defendants by their statement in defence deny infringement and aver that the plaintiff's patent is null and void for want of subject-matter.

The grant contained in the patent is for certain new and useful improvements in Golfing Tees.

The second paragraph of the specifications states:

This invention related, generally, to *improvements* in that class of devices, known as tees for use upon the green of a golf course, and for the placing thereon of a golf ball, the device being very simple in its construction and being easily forced into its proper position upon the green, so as to be of immediate use, and to enable the player to dispense with the building up with wet sand of the usual tee.

Proceeding further on with the specifications we come to the claims which are in the following language, viz:—

What I do claim as my invention, and desire to secure by letters patent, is:—

1. A golfing tee comprising a shank having a pointed end so as to be readily pressed into the ground, and a dished or concaved ball-supporting member connected with and carried by said shank, and adapted to be arranged slightly above the ground, said shank being centrally disposed with relation to said ball-supporting member.

2. A golfing tee comprising a shank having a pointed end so as to be readily pressed into the ground, and a disk-shaped member connected with and carried by said shank, said member being dished or concaved in its upper surface, and surrounded by a marginal ball-retaining and supporting rim, said shank being centrally disposed with relation to said ball-supporting member.

3. A golfing tee comprising a cone-shaped shank having a pointed end so as to be readily pressed into the ground, and a dished or concaved ball-supporting member connected with and carried by said shank, and adapted to be arranged slightly above the ground, said shank being centrally disposed with relation to said ball-supporting member.

4. A golfing tee comprising a cone-shaped shank having a pointed end so as to be readily pressed into the ground, and disk-shaped member connected with and carried by said shank, said member being dished or concaved in its upper surface, and surrounded by a marginal ball-retaining and supporting rim, said shank being centrally disposed with relation to said ball-supporting member.

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From the wording of the specifications and of these claims it appears clearly that the patent covers two kinds of tees which may be simply referred to as exhibits No. 2 and No. 3 respectively, although only exhibit No. 2 is covered by the pleadings and is described in the drawings attached to the patent.

And while the alleged infringing tees manufactured and sold by the defendants are filed as exhibit No. 4 and exhibit No. 5, the statement of claim only attacks exhibit No. 4 as infringing plaintiff's exhibit No. 2—for the obvious reason that the defendants only began to experiment with No. 5 (or No. 1 on Discovery, also filed as exhibit No. 9) in the fall of 1926 and market it in the spring of 1927,—and the present action was instituted on the 16th December, 1926.

This matter was mentioned at trial, but no formal application was made to amend the pleadings accordingly—as might have been done under the practice. Therefore the consideration of the case, so far as the court is concerned, must be confined to the pleadings. Possibly in the result it does not make much difference; and the fate of one device may very properly follow the fate of the other.

Proceeding to the consideration of the merits of the case as submitted, two outstanding questions present themselves for determination by the court. One is as to whether or not the device in question, exhibit No. 2, covered by the patent and the pleadings is *per se* subject-matter as involving any ingenuity of invention, and the second is whether or not this device has been anticipated by the prior art. The case is really one of great simplicity involving a structure well defined in the prior art. Its present size, dimension and shape, as distinguished from those of the prior art, do not make it a device involving ingenuity or invention. *Haskell Golf Ball Co. Ltd. v. Hutchison* (1).

(1) (1908) 25 R.P.C. 194, at p. 204 *et seq.*

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Does not the present device or tee appear to be one which especially at that date, might well have occurred to an ordinary intelligent person without any exercise of that inventive faculty which is necessary as the ground for a patent. It is always necessary to consider the rights of the general public to avoid monopolies on such simple devices as would occur to any one. *Bonnard v. The London Omnibus Co.* (1).

On the question of prior publication, as establishing the state of the prior art, the defendants set up, *inter alia*, the plea arising out of the enactments of sec. 7 of the Patent Act, stating that when the patentee applied in Canada for his patent on the 24th November, 1923, more than two years prior to that date the device in question had been used, as disclosed by the evidence, on a public golf course, in the United States in June, 1921. Furthermore, in the United States, as appearing from exhibits C. and D., the patentee, although casting the net large enough to claim all that is claimed by the Canadian Patent, succeeded in getting a patent only for the rim. A rim is claimed also by the Canadian Patent, but whether the rim by itself is good subject-matter or not is immaterial as the defendants' device has no rim and nothing arises in that respect in the present case. However in the view I take of the case it is unnecessary to pass upon these two questions.

The patent is in itself very narrow and calls therefore for a narrow construction.

Dealing with these questions of anticipation and invention it is well to mention that there are to-day on the market between fifty and sixty kinds of artificial golf tees, and exhibit 6 is produced as an exhibition of some 15 of them, including that of the plaintiff's.

Witness Cumming saw tees like exhibit No. 14 about 10 years ago. Witness Hopeson has been selling golf tees for a good many years. Previous to 1924 his employers sold a number of varieties made in England and Scotland, of rubber and paper, principally rubber; some with weight attached, and some with a red flannel cord attached. There was also the rubber type, pyramid shape, which was set on top of the ground.

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

Witness Ross Preston, one of the defendants, who was examined on Discovery and whose whole examination was read at trial by the plaintiff, being asked as to whether he had made a study of the old types of tees, testified as follows:—

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A. Well, I might say before we manufactured tees at all, my partner, Mr. Reid, was presented with a game which I believe was sold under the name of "lawn-ball," and in that game they use as part of the implements of the game what they call a peg which is absolutely identical with what you might call the wooden tee on the market to-day, only it was of a much larger design.

Q. What game is that?—A. I believe it is a game which was introduced back in 1880 or 1890 and patented under the name of lawn-ball. We were presented with the game by a sports dealer in the city of Montreal and he mentioned at the time—he said there is what I consider the golf tee of to-day—it is the outgrowth of this peg for old lawn ball game I used when I was a boy.

B2, the Turner patent, dating as far back as 1882, provides also for a stake or peg, with a point going into the ground, larger at the upper end which provides a cup for receiving and supporting a ball—the whole as used in the game of "lawn pool." The game consisted in hitting the stake or peg with another ball and knocking this ball off.

True the golf tee is smaller, but it embodies all of these elements and it could hardly be contended that a patent could be maintained for a smaller size device, with a few variations—and to be used in an analogous manner for a game of ball.

Is not the plaintiff's device simply an old device used for a new but analogous purpose? If so, it is not patentable. The device of a peg pressed into the ground to hold a ball existed before the plaintiff's patent.

B3, Grant, American Patent, dated 12th December, 1899, is for a golf tee, made of a wooden shank, tapered to a point at the lower end, running into the ground, with a rubber tubing top in the shape of a cup into which the ball sits. Some of the language used in this patent resembles very much the language in the plaintiff's patent. The top parts are different in shape. The plaintiff's device may be considered an improvement, but there is no invention in a mere adaptation of an idea in a well-known manner for a well-known purpose, and here for an analogous purpose, without ingenuity, though the adaptation effects an im-

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provement which may supplant an article already on the market. *Carter v. Leyson* (1).

The plaintiff's device may be somewhat an improvement on the prior art and has resulted perhaps in commercial success; but this only affords the presumption of usefulness coupled with the marked increase in the number of people playing golf in our days and correspondingly increasing the demand for such devices. However, it does not follow by any means conclusively that the improvement lay in a discovery based upon an invention. *Charlesworth, Peebles and Co. v. British Thomson-Houston Co. Ltd.* (2); *Durable Electric Appliances Co. v. Renfrew Electric Products Co.* (3).

Exhibit B9, the Ellis Patent of 1893, discloses all the elements involved in the plaintiff's patent; that is you have a spike or shank and a top of conical shape upon which the ball is placed. Exhibit B10, the Kirkwood patent of 1896, discloses again all these elements designed or displayed somewhat differently; but the elements are all there: that is a spike or shank, pointed at the lower end, and with a somewhat larger top, cup shaped, to receive the ball.

Exhibit B11 embodies again the elements set forth in the plaintiff's patent which have just been mentioned; that is a concave superstructure or head with a pin or shank set under the same and which is "pushed into the ground."

Having thus in a summary way reviewed the prior art, we are forced to the conclusion that the plaintiff's patent embodies most of the features, functions and contrivances of the prior art, differing, however, somewhat in small structural details which come, I may say, within some of the language of the old patents and may be termed full equivalents and substantially the same. There is not in the plaintiff's patent or device any new element entering into it which cannot be found in the prior art. The general construction of all those tees are all of the same general character. They all perform the same function in practically the same manner. The plaintiff's device may

(1) (1902) 19 R.P.C. 473.

(2) (1925) 41 T.L.R. 259 at 262.

(3) (1926) 59 Ont. L.R. 527 at 534.

give a somewhat different form to the features disclosed in the prior art, but without giving to any of them any new function and without accomplishing any new result.

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The adaptation of old functions or contrivances to a new purpose, especially in the same class of article, would not constitute invention. Indeed, it cannot be successfully contended that the improvement claimed by the plaintiff's patent lies so much out of the track of the prior art and former use as to involve ingenuity of invention.

The plaintiff's patent, considering the state of the prior art, discloses no new function or invention which could amount to invention. The features and functions of the devices both of the prior art and of the plaintiff's patent are the same. Indeed, there is no sufficient invention in merely applying a well-known thing, in a manner or to a purpose which is analogous to the manner or to the purpose in or to which it has been previously applied. Nicolas on Patent p. 23, and cases there cited.

There is not in the present case any novelty in the mode of using the device as distinguished from the novelty of purpose. The present patent relies on the functions performed by well-known devices abundantly disclosed in the prior art.

The slight alteration which may be found, especially in the size, of plaintiff's device as compared with the prior art does not involve ingenuity of invention and is not sufficient under the statute to sustain a patent. What the patentee did was to apply a well-known contrivance, different in size, to the same or to an analogous purpose without invention. Why should then, at this stage of the art, the public be deprived of, by monopoly founded on unmeritorious ground, of a device or contrivance well-known in the prior art? The device does not possess any element of invention. It does not involve, in any sense, a creative work of inventive faculty, which the patent laws are intended to encourage and reward. The plaintiff came late in this narrow field of golf tees; he came when common knowledge of the art was extensively spread and well known.

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The application of a well-known

contrivance to an analogous purpose, without novelty in the mode of application, is not invention and is not good ground for a patent.

*Northern Shirt Company v. Clark* (1).

The facts before the court show that while the patentee has produced a device of somewhat different size, but with features perfectly familiar to the prior art, without giving it any new function and without accompanying it with new result, bring the patent within the principle so often stated that:

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

*The Railroad Supply Co. v. The Elyria Iron and Steel Co.* (2).

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

*Gadd and Mason v. The Mayor, etc., of Manchester* (3).

See also Frost on Patent, 4th ed., vol. 1, p. 86.

In view of the state of the prior art and for the reasons above set forth I have come to the conclusion that the plaintiff's patent has been anticipated in the prior art and that it is further null and void for want of the primary test of ingenuity of invention.

Were the patent valid I would have certainly found infringement; but I have come to the conclusion, looking to the prior art and to the subject-matter, that the plaintiff's patent does not possess any element of invention and I can in no sense find in it any element of an inventive quality which the patent laws are intended to encourage and reward by restraint upon commercial freedom. *Treo Company Inc. v. Dominion Corset Co.* (4); *Ball v. Crompton Corset Co.* (5).

The action is dismissed with costs.

(1) (1917) 17 Ex. C.R. 273; 57 S.C.R. 607.

(2) (1917) Patents Office Gaz. (U.S.) Vol. 239, page 656.

(3) (1892) 9 R.P.C. 516 at 524.

(4) (1918) 18 Ex. C.R. 127.

(5) (1886) 13 S.C.R. 469, at p. 475.