LIGHTNING FASTENER COMPANY, LIMITED ..... } PLAINTIFF;

1932
Feb. 9.
April 18.

AND

COLONIAL FASTENER COMPANY LIMITED AND G. E. PRENTICE MANUFACTURING COMPANY ... } DEFENDANTS.

Patents—Infringement—Invention—Improvement on means known

The invention in question is for an improvement in locking devices, for use on separable slider fasteners. Held; That, as the essence of the invention was the production of an old result, even though there is invention, the patentee is only protected in respect of the particular means he sets forth in his specification, and in such circumstances it may not be infringement to achieve the same result by using other means, by a different device.

ACTION by plaintiff against the defendant asking that patent no. 288,925, owned by the plaintiff, be declared good, valid and infringed by the defendants.

The action was tried before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

O. M. Biggar, K.C., and *R. S. Smart, K.C.*, for plaintiff.

D. L. McCarthy and *S. A. Hayden* for defendants.

The facts of this case are stated in the Reasons for Judgment.

THE PRESIDENT, now (April 18, 1932), delivered the following judgment.

This is an action for infringement of patent, no. 288,925 owned by the plaintiff, the patentee being Noel J. Poux. The patent was applied for in January, 1928, and issued in April, 1929. The invention relates to a separable fastener slider and has for its object to provide a locking device therefor, at any point on its travel along the stringer.

The second and third paragraphs of the specification read as follows:—

Previous suggestions for locking a slider have included cumbersome pins projecting through both wings and unduly thickening the slider, a slidable plate presenting too many parts and too complicated a construction to be made cheaply, or some locking device projecting beyond the end of a slider where the locking members are in engagement, making the device of inconvenient length.

1932

LIGHTNING FASTENER CO., LTD. v. COLONIAL FASTENER CO., LTD. AND G. E. PRENTICE MFG. CO.

Maclean J.

According to this invention, a slider pull is provided adjacent its pivot with one or more fingers or lugs shaped to extend through a recess in the slider wing for direct engagement between locking members on one stringer or the lug may indirectly co-operate with said members through the aid of some other part of the slider. Preferably these lugs are spaced longitudinally and laterally to be engaged between locking members on each stringer.

It will be seen that essentially the Poux locking device comprises one or more lugs or fingers on a pivoted "pull" or "tab" on the slider and that the lug goes through a hole in the front wing of the slider, between the units, thus locking the same. I use the word "hole" instead of "recess" because I think the former term more accurately expresses what the patentee had in mind. In the alleged infringing device, which I shall call Prentice, the pull or tab has two small lugs on its upper edge, bent at right angles to the face of the pull, one of which is longer than the other, the longer one being intended to go between the units, the other being intended simply as a support. The pull is not pivoted on the front wing of the slider but travels on a longitudinal slide the full length of the slider, and falls below the slider where the longer lug enters between the units, thus preventing any sliding of the fasteners. There is no hole extending through any portion of the wing of the slider. There are two slight recesses, not holes, at the bottom of the slider, on either side of the longitudinal slide, against which the lugs or fingers rest when in a locking position; it is really at the end of the front wing of the slider that the lug enters between the units. It would be as correct to say that the outer and lower edges of the slider are elongated as to say that there is a recess in the slider. The device would lock, it seems to me, without the recess, just as in Exhibit B, where Prentice used the same device but with the spiral type of fasteners, although possibly the longitudinal slide or travel would require to be slightly lengthened; it is simply a matter of construction and nothing else. At any rate the recess in Prentice has not the same function as the hole in the slider of Poux, because there the lug went through the hole, the hole was made for the lug, and that is what Poux says he invented.

As one of the paragraphs of the specification, which I have quoted states, there had been previous suggestions for locking a slider, many of them, including, the specifica-

tion states, a cumbersome pin projecting through the wings of the slider, and also a locking device projecting beyond the end of the slider which the patentee states was objectionable because it was of inconvenient length. The essence of the invention then being the production of an old result, the patentee is protected, if there be invention, only in respect of the particular means he sets forth in his specification, and in such circumstances it may not be infringement to achieve the same result by the use of other means, by a different device, perhaps by a slightly different device. It cannot be said that the lug in the defendant's device projects through the slider, for it distinctly drops between the units below the slider element, but not through a hole in the slider. Moreover, Poux in effect stated in his evidence that in his invention the pull was pivoted on the slider element, whereas in Prentice the pull is not pivoted, but moves longitudinally the full length of the slider. Poux, taking the alleged invention to be what the patentee himself says it is, it seems to me, would not be successful in operation if the pull were not pivoted on the slider. Prentice discloses a conception of functioning different from Poux and represents an entirely different idea. There was nothing new in the idea that a lug or finger, if placed between the units, would cause a locking of the fasteners, the invention if any, would be in the particular means or method of bringing a lug or something of that sort between the units. Assuming that there is invention in Poux, still the patentee must be held to the specific device which he says he has invented. Poux did not claim to have invented in 1923 or 1925 all the types of locking devices appearing in the drawings. It does not seem to me that Prentice infringes the locking means or method orally described by Poux as his invention, or that used by the plaintiff and put in evidence as representing the invention, Exhibit 7. It was argued by Mr. Biggar that Prentice infringes the device shown in fig. 11 of the patent. Fig. 11 is referred to in the specification as being a "modified slider" of the type shown in fig. 5, and fig. 5 shows a slider which is a modification of that shown in fig. 4, and so on. Fig. 11, which discloses a locking device quite similar to Prentice, does not fall within what Poux himself described as his invention made in 1923 or 1925; it seems to be a new idea in-

1932

LIGHTNING FASTENER CO., LTD. v. COLONIAL FASTENER CO., LTD. AND G. E. PRENTICE MFG. CO.

Maclean J.

corporated into the specification and drawings when the application was made in 1928. But even if the same is now properly there as a part of an alleged invention of Poux, application for this patent was only made in 1928 and there is no evidence of any earlier application, yet the defendants, or one of them, had commenced manufacturing and selling Prentice in 1925. So that the particular method or mode of locking down in fig. 11 would be anticipated by the use of Prentice in 1925. It cannot be claimed that the device shown in fig. 11 was invented by Poux in 1923 or in 1925. The evidence of Poux and of Sundback, shows that all the invention which Poux claims to have made in 1923, or in 1925, was in the idea of a lug or pin pivoted on the pull that would penetrate a hole in the slider and thus enter between the units, as shown in exhibit 7. There is nothing in the evidence indicating that Poux ever had the slightest idea of a locking device such as shown in fig. 11, and I do not believe his mind was ever directed to such an idea, so that the date of any alleged invention of a locking device described in the specification and corresponding to fig. 11, or anything outside of obvious equivalents to that which he has described as his invention, must be taken to be of the date of the application for patent, January, 1928; if I am correct in this, then the device shown in fig. 11 was anticipated by Prentice.

Looking at some of the drawings accompanying the specification, and after hearing the evidence of Poux, one cannot but suspect that the specification was designed to include much that was not in the mind of Poux at the date when he is said to have made his invention. Poux states that he conceived his invention in 1923, and that he revived it or completed it in 1925. The application for patent was not made until January, 1928, and it was not till 1929 that the plaintiff or its allied company, commenced the manufacture of the device said to be infringed. In the meanwhile, in 1925, Prentice came on the market, and also the locking device used by the United States Rubber Company which is almost identical with the plaintiff's Exhibit no. 7; and the producers of such locking devices could not possibly have heard of or seen Poux, because it had not been made public. It is probable that Poux conceived the idea described by him, in a rough fashion, at the time

stated, but whether this constituted invention, it is not necessary to decide, inasmuch as I find there is no infringement.

Mr. McCarthy for the defendants argued that there was no assignment of the patent in suit to the plaintiff. The plaintiff pleaded an assignment made in December, 1926, from Poux to Canadian Lightning Fastener Company, the plaintiff's predecessor. This assignment purports to grant an assignment of a certain invention relating to new and useful improvements in Separable Fastener Sliders, and it is there set forth that Poux had applied for a patent of the alleged invention in the United States, and he therein assigns all his right title and interest in the alleged invention for the Continent of America, excepting the United States, to the assignee. The nature of the invention is not described except as I have stated. Mr. Biggar contended that having put in evidence an assignment certified by the Patent Office to be an assignment of the patent in suit, and there registered, that he had discharged the burden of proving the assignment, and that if such an assignment was attacked by the defendants the onus was upon them to show that it did not cover the patent in question. The defendants did not in their pleadings attack the assignment beyond a general denial of several paragraphs of the plaintiff's statement of claim, inclusive of the one pleading the assignment. I am inclined to think that Mr. Biggar's contention is the correct one. If the defendants intended to seriously raise such an issue, it should have been pleaded and the issue distinctly raised. An agreement to assign may be made prior to the grant of a patent, or even prior to application for the patent concerned. Sec. 29 of the Patent Act, I think, contemplates an assignment even before the patent is granted. I think therefore I am bound to assume that the assignment pleaded, and put in evidence, places the title to the patent in suit in the plaintiff; the assignment is not questioned by either the assignor or the assignee and I should doubt very much if the defendants are in a position to challenge the force or validity of the assignment.

Therefore, in my opinion, the plaintiff's patent has not been infringed and the action is dismissed with costs to the defendants.

Judgment accordingly.