

BETWEEN :

JAMB SETS LIMITED PLAINTIFF;

AND

WILLIAM H. CARLTON DEFENDANT.

1962
Oct. 1, 2,
3, 5, 9
1963
Nov. 15

Patents—The Patent Act, R S C. 1952, c. 203, as amended, ss. 36(2), 48, and 62(2)—Validity—Infringement—Anticipation—Obviousness—Declaration of non-infringement—Admission in pleading and effect of subsequent amendment thereof—Precision of directions in patent—Workshop improvement—Doctrine of “Pith and Marrow”—Onus of proving invalidity—Statutory presumption of validity.

The plaintiff brought this action for a declaration that the prefabricated frames for doors, windows and the like manufactured by it did not infringe the defendant's Letters Patent No. 604,140, the defence being that such manufacture constituted infringement of the said patent and by way of counterclaim the defendant asked for a declaration that the said patent was valid and infringed. The plaintiff in its defence to the counterclaim denied infringement and stated that it did not dispute the validity of the claims in the defendant's patent. Later, before trial, the plaintiff, by leave, amended its statement of defence to the counterclaim to include an allegation that the said patent was invalid for obviousness and lack of invention.

Held: That the amendment of the defence to the counterclaim put the validity of the defendant's patent in issue and evidence was properly admissible with respect thereto, notwithstanding that the original defence to the counterclaim contained an admission of the validity of the said patent.

2. That since the products manufactured by the plaintiff did not incorporate essential elements of the defendant's patent as claimed in claims No. 4, 5, 6, 7, 8 and 9, these claims were not infringed.
3. That since the door frames as described in the defendant's patent were made in accordance with the directions contained therein, it follows that the directions were sufficiently precise and were not ambiguous and obscure.
4. That the evidence of the commercial success of the invention rebutted the allegation that it was not workable or useful.
5. That the new method of joining the top jamb to the side jambs of the frames to prevent cupping of the top jamb, as suggested by an employee of the exclusive licensee of the defendant and adopted by the licensee was well known in the industry and was no more than a workshop improvement, since the method of joining described in the patent worked effectively.
6. That the onus of showing invalidity rests on the party attacking the patent, and more particularly so by reason of the statutory presumption of validity.
7. That if a prior publication would give a person skilled in the art in the light of the common knowledge prior to the invention the same information for practical purposes as the patent under attack, then it is in anticipation of the invention covered by it.

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8. That documents put forward as anticipations must be read singly and independently and must not be made into a mosaic by taking bits out of various documents and putting them together.
9. That in order to constitute anticipation, every element specified in the claims of the patent attacked must be present in the prior art device.
10. That the mere simplicity of a device is not proof that it was obvious and that inventive ingenuity was not required to produce it.
11. That the defendant took a number of well known elements, fastened them together by well known means and produced a result that was new and inventive and which fulfilled a commercial need which had not been previously supplied.
12. That the testimony of the inventor himself as to what his invention was would be inadmissible to contradict the clear and unambiguous wording of the patent claims.
13. That the defendant having deliberately chosen to make the toeing-in of the casing numbers an essential feature of claims 1, 2 and 3, it was open to the plaintiff to fashion its door frames in any manner it chose provided the way it chose did not include this feature.
14. That the plaintiff is entitled to a declaration that its doors do not infringe the defendant's patent and the defendant is entitled to a declaration that, as between the parties, the said patent is valid.

ACTION for a declaration that plaintiff does not infringe defendant's letters patent.

The action was tried before the Honourable Mr. Justice Cattanach at Toronto.

R. H. Saffrey for plaintiff.

D. F. Sim, Q.C. for defendant.

The facts and questions of law raised are stated in the reasons for judgment.

CATTANACH J. now (November 15, 1963) delivered the following judgment:

This is an action under section 62, subsection (2) of the *Patent Act*, R.S.C. 1952, c. 203 as amended, for a declaration that prefabricated frames for doors manufactured by the plaintiff do not constitute an infringement of the exclusive property or privilege granted to the defendant under Letters Patent, No. 604,140 dated August 30, 1960.

The plaintiff is a corporation in the business of manufacturing prefabricated frames for doors, windows and the like and having its principal place of business at 131A Oakdale Road, Downsview, in Ontario.

By way of defence to the action, the defendant alleges the said Letters Patent have been infringed by the plaintiff and by counter-claim requests a declaration that Letters Patent, No. 604,140 are valid and have been infringed.

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The plaintiff by a statement of defence to the counter-claim denies infringement and repeats the allegations in its Statement of Claim and states that it does not dispute the validity of the claims of the defendant's patent.

By leave the plaintiff filed an amended Statement of Defence to the counter-claim alleging that Letters Patent, No. 604,140 are invalid by reason of the claims being obvious and disclosing no invention having regard to the prior art.

The defendant in reply to the amended defence to the counter-claim denies that the said Letters Patent are invalid and states that the previous admission by the plaintiff that such Letters Patent were valid, constitutes a binding admission and accordingly the plaintiff is not entitled to dispute the validity of the said Letters Patent. I am unable to agree with this contention. While it is the fact that the plaintiff in its Statement of Defence to the defendant's counter-claim, did admit the validity of the defendant's patent, nevertheless, the plaintiff obtained leave to amend its pleadings and in its amended pleadings specifically raised the issue of validity. In my opinion the question of validity of the Letters Patent is in issue and evidence was properly admissible with respect thereto.

The patent was granted on August 30, 1960 for an invention entitled "Prefabricated Frame for Doors, Windows and the Like" to William H. Carlton, the defendant herein, as inventor pursuant to an application therefor dated July 25, 1959 and comprises nine claims.

The basic objects of the invention according to the specifications are to provide prefabricated frames for doors in parts which may be readily and quickly assembled on the construction site thereby overcoming inherent disadvantages of the conventional and known methods of the fabrication of frames and doors.

Evidence was given by the defendant, the inventor, on his own behalf outlining the inherent difficulties in the conventional and known methods of fabricating frames for doors, windows and the like on the construction site and he described how the patented device which he evolved overcame these difficulties.

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The defendant had been engaged in the building industry continuously from 1934 to 1962 in a number of capacities such as designer and sales representative, for a wide variety of building products and specifically those building products relating to doors and fittings.

By means of a model simulating the rough wall opening for a door he demonstrated the method used by carpenters to frame such an opening and the difficulties encountered, which method for the purposes of convenience I shall refer to as the "conventional" method. The first step is to affix the jamb member, normally a piece of lumber 1 inch in thickness, 5 inches in width and 6 feet, 8 inches in length, to the internal side of the door opening. An identical jamb is also required to be affixed to the opposite side of the opening. Because of the rough nature of the carpentry work in the opening, it is not true and plumb, which necessitates the use of shingle shims to ensure that the jamb will be inserted in a perfectly erect position which in turn requires nailing and several adjustments to ensure a truly perpendicular result. When both perpendicular jambs have been adjusted and fitted to the two sides of the door opening, the top section is inserted at the correct height and joined to the side members in one of a number of acceptable ways. After the three jamb members are fixed in place the opening is then dressed by the application of decorative trim lumber, which are called casings. This application also requires measuring and cutting to ensure a correct fit. Next the door is hung. Recesses are required to be cut into the jamb and door edge so the hinge will be flush therewith. The weight of the door determines the number of hinges which will be required, normally two, but sometimes three. There is also required to be cut in the opposite jamb a recess to receive a latch and bolt emanating from the door itself and over which a striker plate is installed. The door-knob hardware must also be installed in the door. It frequently happens that the door itself must be trimmed to fit. Then a door stop is affixed to the jamb members to act as a bumper.

The lumber, which comprises the three jambs, six casing members and door stop is obtained from a lumber mill and may be delivered to the construction site in a variety of degrees of dressing.

The disadvantages of the conventional method of framing a door opening are obvious. Highly skilled carpenters

are required to do the work. The installation is time consuming. There may be differences in the trim supplied by the lumber yard and distortion may occur at a subsequent time by reason of the shingle shims being dislodged or broken.

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The defendant sought to overcome these disadvantages by precutting and fitting the frames and incorporating locks, hinges, striker plates and like hardware at a factory under ideal working conditions.

The defendant did not deny or suggest that prefabricated frames were not available to the construction industry, but he did contend that those available were unsuitable for their intended purpose, due to complete and final assembly of the units at the factory, thereby resulting in cumbersome and unwieldy structures which were fragile and susceptible to damage in shipping. If the prefabricated units were slightly oversized or undersized, which was frequently the case, extensive modifications were then required on the construction site because of the rough carpentry of the door opening.

The defendant then described and demonstrated the construction and installation of a prefabricated door frame known as the split jamb. A split jamb is, in reality, a completely assembled door frame which is divided in half or "split" through the centre of the side jamb members and the top jamb member.

The split jamb is constructed of the same material which composes the frame installed by the conventional method previously described and is normally shipped from the factory to the construction site as a pre-hung door unit. At the site the two halves of the split jamb are separated (having been fastened together for shipping) and one half is installed on the door opening and it is made plumb or level at the sides by the use of shingle shims, the top jamb is put in place and squared and the one half of the split jamb is fastened in place by nailing both through the jamb and casing. When the first half is firmly in place, the other half of the frame is fitted from the opposite side of the opening to the half first installed and is fastened in place by nailing. The split or division through the centre of the frame is then covered by the lumber described as the door stop so that the divided unit has become a whole.

The defendant described the split jamb method of framing a door opening as an advance on the conventional

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method previously described by him, but subject to certain disadvantages the principal of which he considered to be that the structure was not basically strong enough, a weakness being caused by the split, there is time consumed in installing, it is shipped as a completely assembled structure and its bulk increases shipping costs and renders it more susceptible to damage in transit and the tendency to become distorted is greater than in the conventional method of framing because there are twice as many parts to become warped.

To contend with these disadvantages the defendant designed frames to be partially assembled at the factory to allow for quick and ready assembly at the construction site. The knocked down feature of the frames provided for shipment as a compact package. Features were added to the sections of the frame to allow for flexibility considered by him to be necessary for installation and to allow for variations in the wall dimensions of the rough door opening. The interlocking and self-supporting features of the component parts of the frame were designed by him to allow for ease in the accurate squaring and adjusting of the assembly prior to permanent fastening in place. Figures 2 and 3 of the drawings attached to Letters Patent, No. 604,140, show the interlocking nature of the top and side assemblies.

The frame designed by the defendant consists of three basic parts, two vertical side members and a horizontal top member. These three component parts are in turn composed of three parts, the jamb portion (being that portion which frames the internal door opening) to which two casing members (being the trim on the wall surface) are affixed along a precut rabbet joint by an adhesive or nails, screws or staples or a combination of both. Longitudinal slots are cut into the jamb members to provide flexibility to the integrated unit for ease in installation.

To effect a tight fit with the wall, the casing members are "toed in" at an angle of between 1 to 5 degrees.

To further facilitate installation the inside leading edges of the side and top casings bearing on the wall are rounded.

These two features of the casing members, that is, the toeing-in and the rounded edges, are considered by the defendant to afford a hugging and self-guiding action respectively, thereby permitting quick installation of the frames

on the wall and provide self-support while the frames are being squared and adjusted, a difficulty in the conventional and known methods of installation above described and which was sought to be overcome.

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In addition to the conventional method of framing doors and the split jamb there has been in existence a prefabricated wooden frame used by the manufacturers of factory built cottages, garages and like structures, which is made from a solid piece of lumber of the appropriate size required from which a slot the required size is cut out by machine so as to form a "U". The frame is comprised of two side members and one top member which are fitted over the edges of the door opening.

There have also been on the market prefabricated metal door frames falling into two general categories, the first of which is those used in commercial and apartment buildings and second is those used in domestic buildings. In commercial buildings and apartments, where fireproofing is of paramount importance, these metal frames are usually completely prefabricated and the wall is built into the frame after the frame has been put in place. However, a further type of metal door frame was developed which could be installed after the partitions were built. This particular type of metal door framing has been used primarily in private homes and smaller apartment buildings for which reason they have been characterized as being installed in domestic buildings. Contrary to the metal door frames installed in commercial buildings which become part of the wall, the domestic type of metal door frame is not welded together, but is comprised of three separate parts, the two side members and a top member. Each such member is formed from a single piece of cold rolled prime grade steel about .031 inches in thickness which has been shaped in such a way as to perform the desired purpose, that is to form a metal channel. The metal frame is made slightly smaller than the width of the wall. The metal frame is spread to fit over the wall so that it is held in place by tension. This frame is kept true and in place by the use of toggle bolts, compression lugs or similar devices. The jambs are punched and recessed to receive the normal door hardware. When the frame has been installed over the door opening and adjusted to be true and perpendicular by means of the toggle bolts, lugs or similar device depending on the manufacturer, the

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metal door frame is then fixed in place by nailing to the wall through strap anchors normally placed at the bottom of both side members.

The principal disadvantage of the metal door frame is that the metal is capable of receiving only one type of decorative finishing which is paint. Again metal is a more difficult material to handle than is wood. Because of the limitation of the decorative finish which may be applied to metal door jambs they have not been widely accepted by the public or builders for use in domestic buildings. The method of fixing to the wall opening is also limited by the number of strap anchors which are attached, whereas a wooden door frame may be nailed at any place.

The embodiments of the invention in which an exclusive property is claimed by the defendant are set out in nine claims reading as follows:

1. A prefabricated frame comprising vertical side members and a horizontal top member for use in buildings, each member comprising an elongated jamb member, rabbets formed in the longitudinal edges of said jamb member, a pair of casing members, an edge of each of said casing members being adapted to mate with a rabbet in a longitudinal edge of said jamb member, said casing members being inwardly inclined from a plane perpendicular to the plane of the wide axis of the jamb member, and means for securing said casing and jamb members together along the opposing, rabbeted, marginal edges thereof, said members designed for flexing to embrace the edges of an opening in a wall structure.

2. A prefabricated frame as described in claim 1 in which the casing members are inwardly inclined from a plane perpendicular to the plane of the wide axis of the elongated jamb member not less than about 1° and not more than about 5°.

3. A prefabricated frame as described in claim 1, in which the casing members are inwardly inclined about 1° from a plane perpendicular to the plane of the wide axis of the elongated jamb member.

4. A prefabricated frame as described in claim 1, claim 2 or claim 3 in which a plurality of longitudinal slots are formed in the said elongated jamb member and a longitudinal slot is formed in each of the casing members.

5. A prefabricated frame comprising vertical side members and a horizontal top member for use in buildings, each member comprising an elongated jamb member, rabbets formed in the longitudinal edges of said jamb member, a pair of casing members, an edge of each of said casing members being adapted to mate with a rabbet in a longitudinal edge of said jamb member, an edge of each of said casing members being rounded, said casing members being inwardly inclined from a plane perpendicular to the plane of the wide axis of the jamb member, and means for securing said casing members and jamb member together along the opposing, rabbeted, marginal edges thereof, said members designed for flexing to embrace the edges of an opening in a wall structure.

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6. A prefabricated frame as described in claim 5 in which the casing members are inwardly inclined from a plane perpendicular to the plane of the wide axis of the elongated jamb member not less than about 1° and not more than about 5°.

7. A prefabricated frame as described in claim 5 in which the casing members are inwardly inclined about 1° from a plane perpendicular to the plane of the wide axis of the elongated jamb member.

8. A prefabricated frame as described in claim 5, claim 6, or claim 7 in which a plurality of longitudinal slots are formed in the elongated jamb member and a longitudinal slot is formed in each of the casing members.

9. A prefabricated frame comprising vertical side members and horizontal top and bottom members, for use in buildings, each member comprising an elongated jamb member, rabbets formed in the longitudinal edges of said jamb member, a pair of casing members, an edge of each of said casing members being adapted to mate with a rabbet in a longitudinal edge of said jamb member, an edge of each of said casing members being rounded, said casing members being inwardly inclined from a plane perpendicular to the plane of the wide axis of the jamb member, and means for securing said casing members and jamb member together along the opposing, rabbeted, marginal edges thereof, said members designed for flexing to embrace the edges of an opening in a wall structure.

Claim 4 differs from claims 1, 2 and 3 in that it contains an additional element being a plurality of longitudinal slots cut into the jamb members. Since claim 4 differs from claims 1, 2 and 3 by the addition of this element, it follows that this is an essential element.

The evidence was conclusive that the plaintiff did not incorporate longitudinal slots in the jamb members manufactured by it from which it follows that claim 4 was not infringed.

Claims 5, 6 and 7 incorporate the additional element of the leading edges of each of the casing members being rounded. I find as a fact, on the evidence, that the edges of the casings included in the door frames manufactured by the plaintiff were not so rounded from which it follows that claims 5, 6 and 7 were not infringed.

Claim 8 embodies both the features of longitudinal slots in the jamb members and the rounding of the edges of the casing members and accordingly claim 8 has not been infringed by the plaintiff for the combination of the reasons that claims 4, 5, 6, and 7 were not infringed.

Claim 9 includes, in addition, a reference to bottom members for the purpose of covering four sided frames such as those for windows, milk boxes and like openings. The plaintiff did not manufacture frames of this kind and accordingly claim 9 was not infringed by it.

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Therefore only claims 1, 2 and 3 remain in issue.

The plaintiff's defence to the counter-claim consists of attacks on the validity of the claims and a denial of the charge of infringement.

The attacks on the validity of the claims were outlined in the amended Statement of Defence to the counter-claim and in the particulars thereto as follows,

- (1) that the subject matter of the claims was obvious and discloses no invention having regard to the common knowledge of the art, existing patents and publications;
- (2) that the invention was not new having been known and used by others prior to the date of the invention;
- (3) that the claims fail to state in distinct and explicit terms the things or combinations which the defendant regards as new and in which he claims exclusive property or privilege;
- (4) that the invention is neither operable or useful in that the joint between the head joints and the side joints is unworkable as is the "toed in" feature of the casings;
- (5) that the Letters Patent claim more than was invented;
- (6) that the claims are a mere aggregation or juxtaposition of well known components of similar articles used in the art prior to the date of the invention;
- (7) that the defendant, William H. Carlton was not the inventor, but that William Jarvis, an officer and shareholder the plaintiff was;
- (8) and that the claims in the Letters Patent are ambiguous and avoidably obscure in their use of the term "wide axis" of the jamb member.

At the trial, however, counsel for the plaintiff placed particular emphasis on the first two enumerated attacks on the validity of the claims, namely, the obviousness thereof and anticipation.

The attack on the validity of the claims that the invention defined in them is wider than the invention described in the specification and that the claims are, therefore, invalid and the attack that the claims are ambiguous and obscure were not strenuously argued by counsel for the plaintiff. In my opinion these two attacks cannot be substantiated. On construing the Letters Patent of invention herein and bearing in mind that the addressee is a person ordinary skilled in the art, I conclude that there were clear and unmistakable directions from which such a skilled workman could fashion the device. I am confirmed in this conclusion by the fact that the door frames as described in the Letters Patent were so made from which it follows that the directions contained in the Letters Patent were sufficiently precise.

It is also alleged that the claims are a mere aggregation or juxtaposition of well known components of similar articles used in the art prior to the date of the invention and that the claims fail to state the things or combinations which the defendant regards as new. There was abundant evidence that all the component parts of the door frames devised by the defendant were stock lumber obtainable at any lumber mill but the invention defined in the claims is a combination. Consequently, the fact that the elements in it are old and well known does not invalidate the claims for it is the combination, and not its elements that is claimed. The stock materials were fastened together by means which were well known, but as stated above, it is not the old elements nor the accepted and well known methods of fastening those stock materials together that is claimed, but rather the resultant combination. Further, it is my view that the specification and claims were drafted in compliance with the requirements of section 36(2) of the *Patent Act*.

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It was also disputed that the invention was workable or useful. This contention has been convincingly rebutted by the evidence of the commercial success of the invention of which there is no doubt. In the space of two years some 60,000 units were produced by a licensee of the defendant in an industry which was acknowledged by all witnesses to be an ultra conservative one.

However, the commercial success of the defendant's device was not immediate. At the outset a company known as Ellesmere Door Products Limited was incorporated for the specific purpose of marketing the door frames designed by the defendant. The door frames were manufactured for Ellesmere Door Products Limited by Ontario Lumber Company Limited. There were problems encountered relating to manufacturing but not to any basic defect of the door unit as claimed in the patent. Ellesmere Door Products Limited failed and went into liquidation. The defendant then granted an exclusive licence to manufacture and market the door frame designed by him to a company known as Prividor Limited on a royalty basis.

Mr. Jarvis was employed by Prividor Limited to supervise plant procedure and manufacturing techniques. Mr. Jarvis was of the opinion that the joint described by the defendant in the patent obtained was not sufficient to hold the side jambs and the top jamb in exact register. It was

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suggested by him that the top jamb, instead of resting on top of the side jambs, should be inserted into a slot cut into the side jambs. This method of joining was standard and well known in the industry and had the advantage of restraining a tendency of the jamb of the top member from cupping. This suggestion was adopted and incorporated in the units manufactured by Prividor Limited.

It is this variation of the defendant's invention as claimed in the patent which inspired the attacks on the validity of the patent on the grounds that the joint between the head jamb and the side jambs as described in the defendant's claim was unworkable and that the defendant was not the inventor but that William Jarvis was in fact the inventor.

In my view neither of such objections to the validity of the patent can prevail. The join described by the defendant in his claims did work effectively and accomplished the purpose it was designed to achieve, although the alternative method of joining suggested by Mr. Jarvis and implemented by Prividor Limited was an improvement. What was done was to substitute one well known and accepted method of joining for another. Therefore, such substitution amounted to nothing more than a workshop improvement.

At this point I should mention that Mr. Jarvis and Mr. Taub, who had been employed as a salesman by Prividor Limited, left the employ of Prividor Limited and were instrumental in incorporating Jamb Sets Limited, the plaintiff herein, of which company they became officers and shareholders.

There, therefore, remains to be considered those attacks on the validity of the Letters Patent of invention more emphatically argued and relied on by counsel for the plaintiff, namely, anticipation or lack of novelty and obviousness or lack of invention.

Before considering the immediately foregoing attacks by the plaintiff on the validity of the patent in suit, the onus in this regard should be borne in mind. The onus of showing invalidity of a Canadian patent rests on the party attacking it, in the present instance the plaintiff, and more particularly so by reason of the statutory presumption of validity of a Canadian patent under section 48 of the *Patent Act*, 1952, R.S.C., c. 203 reading as follows:

Every patent granted under this Act shall be issued under the signature of the Commissioner and the seal of the Patent Office; the patent shall

bear on its face the date on which it is granted and issued and it shall thereafter be *prima facie* valid and avail the grantee and his legal representatives for the term mentioned therein, which term shall be as provided in and by section 49.

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The first reference to such statutory presumption was in *The King v. Uhlemann Optical Company*¹, where the President of this Court said at page 161:

There is a presumption of validity in favour of the patent by reason of its issue and the onus of proving that it is invalid for lack of invention is on the person attacking it. . . . The onus is not an easy one to discharge.

Later in *Unipak Cartons Ltd. v. Crown Zellerbach Canada Limited*², the President stated at page 39,

. . . I add only the comment that the statutory presumption is not confined to the attribute of inventiveness but extends to all other attributes that an invention must have if it is to be patentable under the Act, such as novelty and utility. The three attributes of patentability, namely, novelty, utility and inventiveness are all presumed to be present in an invention for which a patent has been granted under the Act until the contrary is clearly shown.

Still later in commenting on the above quoted statement from *Unipak Cartons Ltd. v. Crown Zellerbach Canada Limited*, (*supra*) the President had this further to say in *McPhar Engineering Company of Canada Ltd. v. Sharpe Instruments Limited*³, at page 28,

On further consideration I am of the opinion that this statement is not as wide as the terms of the Act warrant. It must follow from the provision of the Act that a patent granted under it "shall thereafter be *prima facie* valid" and avail its grantee and his legal representatives for the term of the patent, that the onus of showing that it is invalid lies on the person attacking it, no matter what the ground of attack may be, and that until it has been shown to be invalid the statutory presumption of its validity remains.

This does not mean that the patent is immune from attack or that the patentee is free from the obligations that are incumbent on him by way of consideration for the grant of the patent monopoly to him, but it seems clear that, since Parliament has deliberately endowed a patent granted under the Act with a presumption of validity, the onus of showing that such a patent is invalid is not an easy one to discharge. That being so, the English decisions indicating that a patentee must prove the existence of the essential attributes of the patentability of the invention covered by his patent before he can succeed in an action for damages for infringement of his rights under his patent are no longer applicable in Canada. He need not prove the existence of these attributes, for he starts with a statutory presumption of their existence in his favour and the onus of showing their non-existence lies on the alleged infringer of the patent. The enactment of

¹ [1950] Ex. C.R. 142.

² (1960) 33 C.P.C. 1.

³ 21 Fox P.C. 1.

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the statutory presumption of validity effected an important change in Canadian patent law and marked a substantial advance in the protection of a patentee's rights.

The defence that claims in suit should be held to have been anticipated by reason of prior publications and patents and the common knowledge of the art before the date of the defendant's patent was advanced on behalf of the plaintiff.

The requirements that must be met to justify the defence of anticipation were summarized by the President in *The King v. Uhlemann Optical Company (supra)* at page 157 in the following language:

. . . The information as to the alleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent. Whatever is essential to the invention or necessary or material for its practical working and real utility must be found substantially in the prior publication. It is not enough to prove that an apparatus described in it could have been used to produce a particular result. There must be clear directions so to use it. Nor is it sufficient to show that it contained suggestions which, taken with other suggestions, might be shown to foreshadow the invention or important steps in it. There must be more than the nucleus of an idea which, in the light of subsequent experience, could be looked on as being the beginning of a new development. The whole invention must be shown to have been published with all the directions necessary to instruct the public how to put it into practice. It must be so presented to the public that no subsequent person could claim it as his own. . . .

In *Pope Appliance Corporation v. Spanish River Pulp and Paper Mills Ltd.*¹, Viscount Dunedin put the test in these words:

Would a man who was grappling with the problem solved by the Patent attacked, and having no knowledge of that patent, if he had had the alleged anticipation in his hand have said, "That gives me what I wish"?

and later at page 56:

Does the man attacking the problem find what he wants as a solution in the prior so-called anticipations.

It follows, therefore, if a prior publication would give a person skilled in the art in the light of the common knowledge prior to an alleged invention, the same information for practical purposes as the patent under attack, then it is in anticipation of the invention covered by it. It should also be kept in mind that in considering a defence of anticipation it has been said in *Von Heyden v. Neustadt*², that you can-

¹ (1929) 46 R.P.C. 23 at 52.

² (1880) 14 C.D. 230.

not make a mosaic in the sense that you take bits out of various documents and put them together. Documents put forward as anticipations must be read singly and independently although in the case of the defence of obviousness all documents may be looked at.

In support of his contention that the defendant's invention had been anticipated, counsel for the plaintiff relied primarily on U.S. Patent No. 2,753,602 (C.S. Ringle) Exhibit G and U.S. Patent No. 2,706,837 (E. T. Jackson) Exhibit H.

In my view the two foregoing patents cited as being anticipatory do not meet the stringent tests outlined above which a prior patent must comply with before it can be considered as an anticipation.

The principal object of the Ringle Patent is to provide a door frame with adequate wedges for quickly and easily backing up solidly between the side jamb members and the buck of the rough door opening in the wall. The back-up wedges are pre-positioned and releasable in readiness for driving. The use of shingle shims described in the conventional method of building door frames and the use of which is also required in the split jamb method, also previously described, was what the defendant sought to avoid in designing the door frame described in the patent in suit. The defendant's theory was that the jamb members should be free standing without the necessity of fastening through the jamb to the buck, but that the only fastening required is by nailing to the wall through the casings and that the jamb members were adjustable to be plumb and perpendicular without the use of shims or wedges.

The Jackson patent was for an adjustable door casing substantially preassembled at a factory for rapid erection in the rough wall openings. The device so described parallels the split jamb method of construction with an attachment for fastening one portion of the jamb to the door buck and a further device in the other portion of the frame to receive a part of the attachment fastened to the door buck to permit of variation to suit the different widths of the wall. The Jackson patent differs from the defendant's patent in that the Jackson patent is similar to the split jamb method of installation, there is a fastening to the door buck not present in the defendant's patent and the adjustable feature in the Jackson patent is achieved by the attachment by which one

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portion of the jamb is fastened to the door buck operating in an attachment on the other portion of the jamb which is designed specifically to receive the other portion of the attachment fastened to the door buck.

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Counsel for the plaintiff also placed reliance for his contention of anticipation on two other documents, one being a brochure describing the Kewanee "Kwick-fit" steel door frame, Exhibit F, published in 1954 and another publication entitled, "Keepright Universal Kwick-fit Steel Door Frames" published by Keepright Products Limited of Brantford, Canada before July 25, 1957, i.e. more than two years before the application by the defendant for Letters Patent of invention.

In this instance I am also of the opinion that the metal frames so described cannot be construed as being in anticipation of the defendant's patent for in order that there may be anticipation every element specified in the claims must be present in the prior art device. There is ample structure recited in the defendant's claims to differentiate the metal construction. The metal frames described in the above publications are one piece of metal wrought to present different planes, whereas the wooden channel frame devised by the defendant, must of necessity, because of the different characteristics of wood and metal, be comprised of several separate pieces of wood. Still further, the metal frames described in the publications are adjusted to the plumb and perpendicular by the use of compression lugs operating as a screw through the jamb of the metal against the door buck which is not the case in the defendant's patent, his jamb being designed to be free standing without the necessity of contact with or fixing to the door buck.

One further instance of prior use was put forward by the plaintiff being a moulding introduced in evidence as Exhibit B. This moulding was formed from a solid piece of wood by cutting a groove in it into which the wall opening would fit. The usefulness of this device is severely limited by reason of its size and it is manifestly not the equivalent of a jamb member with two side casings.

As I have previously intimated, these attacks on the validity of the defendant's claims have not been established by reason of their having been in anticipation or for lack of novelty. A claim is novel unless there is a prior document from which an addressee could make the device and in my

opinion none of the instances of prior publication or use cited by the plaintiff do this.

It was next contended on behalf of the plaintiff that the device described in the defendant's claims in suit was obvious and required no application of inventive ingenuity on the part of the defendant.

The question for decision, therefore, is whether the prior art before outlined made it obvious to adopt the method claimed in claims 1 to 3. I do not think it did. It has been frequently pointed out that what may seem obvious when you see the result, may not have been at all obvious at the beginning and it has always been held to be a good reason for rejecting a plea of obviousness that others failed to reach the solution discovered and set forth in a patent and adopted some other and different method.

It is well settled in patent law that a mere scintilla of inventiveness is sufficient to sustain a patent and as expressly stated by Thorson P. in commenting on the statutory presumption of validity created by s. 48 of the *Patent Act* in *O'Cedar of Canada Ltd. v. Mallory Hardware Products Ltd.*¹,

This statutory presumption of validity is of considerable importance to the Court. Instead of having to determine that the invention covered by the patent in suit does not involve the exercise of inventive ingenuity, which is presumed until the contrary is shown, its task is the simpler one of deciding whether the person attacking the patent has succeeded in showing that the invention covered by it was merely an obvious workshop improvement.

In the present instance it is my view that the plaintiff has failed to rebut the statutory presumption of validity which includes the presumption that the attributes of patentability, namely, novelty or lack of anticipation, utility, and inventiveness or lack of obviousness, are present.

The mere simplicity of the device is not proof that it was obvious and that inventive ingenuity was not required to produce it.

In my opinion the defendant took a number of well known elements, fastened them together by well known means and produced a result that was new and inventive and which fulfilled a commercial need which was not previously supplied.

¹ [1956] Ex. C.R. 299 at 316-17.

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I, therefore, find that all attacks on the validity of the claims in suit fail.

It follows, of course, that I find as between the parties the claims in suit are valid and that the defendant is entitled to a declaration to that effect as requested by him.

There remains for determination the issue whether the plaintiff infringed the defendant's rights under claims 1 to 3 of the patent in suit. Infringement is a question of fact. If the alleged infringement falls within the express terms of the claims that concludes the matter and the plaintiff is clearly guilty of infringement, but if not, the question for determination is whether the plaintiff has taken the substance of the invention and if that is so the plaintiff is likewise guilty of infringement.

The plaintiff's submission is that a principal feature of the patent is not found in the plaintiff's construction, namely, that the toeing-in of the casing, which is alleged by the plaintiff to be an essential element of the invention as defined in claims 1 to 3, is not present in the plaintiff's device within the meaning of those claims.

In *Smith Incubator Company v. Seiling*¹, Duff, C.J. had this to say:

It is now settled law that, for the purpose of ascertaining the meaning of the claims, the language in which they are expressed must be read in light of the specification as a whole, but it is by the effect of the language employed in the claims themselves, interpreted with such aid as may properly be derived from the other parts of the specification, that the scope of the monopoly is to be determined.

The toeing-in feature of the casing member is included in each of the claims in issue.

In claim 1 it is defined in these terms:

. . said casing members being inwardly inclined from a plane perpendicular to the plane of the wide axis of the jamb member, . . .

Claims 2 and 3 reads as follows:

2. A prefabricated frame as described in claim 1 in which the casing members are inwardly inclined from a plane perpendicular to the plane of the wide axis of the elongated jamb member not less than about 1° and not more than about 5°.

3. A prefabricated frame as described in claim 1, in which the casing members are inwardly inclined about 1° from a plane perpendicular to the plane of the wide axis of the elongated jamb member.

¹ [1937] S.C.R. 251 at 255.

To determine the intention of the defendant in so inserting this limitation reference is made to that portion of the specification reading as follows:

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A further important object of this invention is the interlocking and self-supporting features of the component parts of the frame which permits and allows for final accurate squaring and adjusting of the assembly during installation and prior to permanent fastening.

and to the additional language of the specification:

To effect a tight fit with the wall 16-16a, a right-angle rabbet joint 9 is cut so that the included angle 17 is not less than about 91° and not more than about 95° and included angle 18 is correspondingly not more than about 89° and not less than about 85°, the preferred embodiment being about 91° and about 89° respectively as shown. This feature, referred to as "toeing-in", imparts a springiness to the jamb and casing units.

To facilitate installation, the inside leading edges of the side and top casings bearing on the wall 16-16a are rounded. This feature, together with the "toeing-in" of the casing are the primary factors permitting considerable variation in wall thickness as well as local wall irregularities. Furthermore, the hugging action afforded by the flexible "toed-in" casing, together with the self-guiding action of the rounded leading edges 16, interact to permit rapid and ready installation of the frames on the wall and allow self-support while the frames are being squared and adjusted to meet irregularities. Normally, the head member is stationed in place and the side members flexed and sprung into place, embracing the edges of the opposing wall.

From the foregoing language of the specification, it is, I think, fair to say that the patentee states the toeing-in feature of the casing members, in combination with the rounded leading edges thereof, is a primary factor permitting considerable variation in wall thickness as well as local wall irregularities.

A further object, as gleaned from the specification, present in the mind of the defendant, is the self-supporting feature of his frames permitting of final accurate squaring and adjustment during installation and prior to permanent fastening to the wall.

The defendant states that the hugging action that is achieved by the toed-in casing members permits of self-support of the sections of the frame members while they are being adjusted.

It is readily apparent that the defendant sought to achieve a structure that could be adjusted prior to permanent fastening. He then describes the toeing-in feature of the casing members and makes the statement that the desired self-support is accomplished by the toeing-in of the casing

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members. This toeing-in feature is related to one of the defendant's expressed objectives and in claims 1 to 3 the toeing-in feature is claimed.

In his testimony the defendant sought to minimize the necessity of this toeing-in feature. His evidence was as follows:

Q. The angle formed by the jamb member and the trim member?

A. Yes, the enclosed angle formed by the joining of the jamb to the casing. That is a little less than a right angle.

Q. What is the importance of that feature?

A. The importance is to give us more room at the bottom and still give us a tightly fitting joint between the wall itself and the casing after the frame is installed. We were trying to minimize the gap between the wall and the casing.

Q. In what way does that provide an advantage, in what phase of the operation does that provide an advantage?

A. It had to be done eventually and we felt that by doing it in the plant we were helping the job along a little bit. It does make it a little easier for the installer when the toeing-in is done at the plant, but it could be done without it.

I particularly refer to the decision of the House of Lords in *Electric and Musical Industries, Ltd. v. Lissen, Ltd., et al.*¹, which may be fairly described as the leading case on the principles to be applied in construing the claims of a patent. There Lord Russell of Killowen, after first stating that the question of construction is of primary importance, described the function of the claims in a patent specification as follows:

The function of the claims is to define clearly and with precision the monopoly claimed, so that others may know the exact boundaries of the area within which they will be trespassers. Their primary object is to limit and not to extend the monopoly. What is not claimed is disclaimed. The claims must undoubtedly be read as part of the entire document, and not as a separate document; but the forbidden field must be found in the language of the claims and not elsewhere. It is not permissible, in my opinion, by reference to some language used in the earlier part of the specification to change a claim which by its own language is a claim for one subject-matter into a claim for another and a different subject-matter which is what you do when you alter the boundaries of the forbidden territory. A patentee who describes an invention in the body of a specification obtains no monopoly unless it is claimed in the claims. As Lord Cairns said, there is no such thing as infringement of the equity of a patent (*Dudgeon v. Thomson*, L.R. 3 App. Cas. 34).

At page 41 Lord Russell makes this important statement:

. . . But I know of no canon or principle which will justify one in departing from the unambiguous and grammatical meaning of a claim and

¹ (1939) 56 R.P.C. 23.

narrowing or extending its scope by reading into it words which are not in it; or which will justify one in using stray phrases in the body of a Specification for the purpose of narrowing or widening the boundaries of the monopoly fixed by the plain words of a claim.

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He then makes this further comment on the function of a claim: Cattanach J.

A claim is a portion of the specification which fulfils a separate and distinct function. It and it alone defines the monopoly; and the patentee is under a statutory obligation to state in the claims clearly and distinctly what is the invention which he desires to protect. As Lord Chelmsford said in this House many years ago: "The office of a claim is to define and limit with precision what it is which is claimed to have been invented and therefore patented" (*Harrison v. Anderston Foundry Co.*, L.R. 1 App. Cas. 574). If the patentee has done this in a claim the language of which is plain and unambiguous, it is not open to your Lordships to restrict or expand or qualify its scope by reference to the body of the specification. Lord Loreburn emphasised this when he said: "The idea of allowing a patentee to use perfectly general language in the claim and subsequently to restrict or expand or qualify what is therein expressed by borrowing this or that gloss from other parts of the specification is wholly inadmissible". (*Ingersoll Sergeant Drill Co. v. Consolidated Pneumatic Tool Co.*, 25 Reports of Patent Cases, page 61, at page 83). Sir Mark Romer expressed the same view in the following felicitous language:— "One may and one ought to refer to the body of the specification for the purpose of ascertaining the meaning of words and phrases used in the claims, or for the purpose of resolving difficulties of construction occasioned by the claims when read by themselves. But where the construction of a claim when read by itself is plain, it is not, in my opinion, legitimate to diminish the ambit of the monopoly claimed merely because in the body of the specification the patentee has described his invention in more restricted terms than in the claim itself." (*British Hartford-Fairmont Syndicate, Ltd. v. Jackson Bros.* (*Knottingley*), Ld, 49 Reports of Patent Cases, page 495, at page 556).

From the foregoing statements of Lord Russell it follows that even the testimony of the inventor himself as to what his invention was would be inadmissible to contradict the clear and unambiguous wording the claims.

As a matter of construction it seems clear to me that the defendant deliberately chose to make it an essential feature of claims 1 to 3 that the casing members should be toed-in even though he subsequently testified that it was not absolutely necessary that they should be. Why he so drafted these claims is not for me to speculate, but my function is to state that he did so.

The plaintiffs in their construction did not incorporate this toed-in feature of the casing members and accordingly I find, as a fact, that there has been no textual infringement of claims 1 to 3. The plaintiffs exercised particular care by use of jigs to ensure that the angle formed between the jamb

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member and the casing member of the door frame manufactured by it was a right angle.

The defendant invokes the doctrine of "pith and marrow" in order to maintain his contention that his patent has been infringed by the plaintiff for he says that the substance of his invention has been taken under cover of an unessential change in that the casing members were not toed-in.

I cannot, however, agree that this is a proper case for the application of that doctrine. Each case must be considered on its own facts. In the present case, whatever the reason, the defendant deliberately drafted claims 1 to 3 so as to include the use of the toed-in feature and this, in my view, left it open to the plaintiff to fashion its door frames in any manner it chose provided the way it chose did not include the toed-in feature which had been deliberately included in the defendant's claims.

In my opinion claims 1 to 3 have not been infringed by the plaintiff.

Therefore, the plaintiff is entitled to a declaration that the prefabricated doors manufactured by it do not constitute infringement of the exclusive property or privilege granted to the defendant in Canadian Patent No. 604,140 as was originally sought by the plaintiff.

On the other hand the defendant is entitled to a declaration that, as between the parties hereto, the said Letters Patent are valid, but it follows that the defendant's request in his counter-claim for a declaration of infringement and for consequent relief must be dismissed.

Since the success on the counter-claim is divided, I award the defendant one half of his costs on the counter-claim.

In view of the fact that the plaintiff was successful in its request for a declaration of non-infringement, but was unsuccessful in contesting the validity of the said Letters Patent which question was not originally in issue but was brought in issue by way of the plaintiff's amended defence to the counter-claim, I award the plaintiff one half of the costs ordinarily taxable in respect of the action, the respective awards to be set off against each other.

Judgment accordingly.