

CARTER &amp; COMPANY (LTD.).....PLAINTIFFS ;

1893

AND

June 26.

SAMUEL DAVID HAMILTON AND }  
JOHN PHILLIPS.....} DEFENDANTS.*Patent—"The Paragon Black-leaf Cheque Book"—Validity—Want of novelty—Infringement.*

The plaintiffs obtained letters-patent on the 15th February, 1882, (registered in the Patent Office at Ottawa as No. 14182) for "The Paragon Black-leaf Cheque Book" which was described in the letters-patent to consist "in a black-leaf cheque book composed of double leaves, one-half of which is bound together while the other half folds in as fly leaves, both being perforated across so that they can readily be torn out ; the combination of the black-leaf bound into the book next to the cover, and provided with the tape bound across its end, the said black-leaf having the transferring composition on one of its sides only." The objects of the invention, as stated in the specification, were to provide a check-book in which the black-leaf used for transferring writing from one page to another need not be handled and would not have a tendency to curl up after a number of leaves had been torn out. The first of such objects was to be obtained by the use of the tape which enabled "the black-leaf to be folded back or raised without soiling the fingers," and the second by binding the black-leaf in with the other leaves but next to the cover in which position there "would be less likelihood of the black-leaf becoming crumpled up than if it were placed in the centre and the leaves removed from the stub on either side."

The defendants had a patent for and manufactured a countercheck-book in which a margin was left on the carbon leaf by which it could be turned over without soiling the fingers. With the exception of the tape for turning the leaf it was established that the plaintiffs' patent had been anticipated, and it was also proved that prior to the issue of the plaintiffs' patent, a patent had been granted in the United States for the process of manufacturing carbon for use in manifold writing with clean margins so that the paper could be handled without soiling the fingers.

*Held*, that if the plaintiffs' patent was construed to include the use of clean margins on carbon paper, as applied to countercheck-books,

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it failed for want of novelty; but that if the patent was limited, as it was thought it should be, to the means described therein for turning over such carbon leaves without soiling the fingers, that is, to the use of the tape, the defendants did not infringe the patent by using a clean margin for the like purpose.

**ACTION** for infringement of a patent for invention.

The facts of the case are stated in the judgment.

The case was heard at Toronto on the 5th April, 1893.

*Cassels*, Q.C. for the plaintiffs: The two points which present themselves for the consideration of the court in this case are, first, whether there has been an infringement by the defendants and, secondly, whether the patent has been successfully impeached.

It would be entirely wrong on the evidence before the court to conclude that the patent should be impeached after all the length of time that has elapsed since the granting of the patent (Cites *Walker on Patents*) (1). This patent was granted in the year 1882. We find from that year right down to the institution of the present action no attack has been made on the patent; nothing has been done towards having it repealed. The defendants cannot come in here now and attack it with success. Then, in regard to the patentability of the article in question, the law is exhaustively discussed in the case of *Harrison v. Anderston Foundry Co.* (2). There every element of the combination was as old as the hills. A great many of the elements had been already put in several combinations, but there was no combination of all these elements together forming one patent. Such a combination was there held to be a valid patent. The law is well settled that the combination may be valid although all the elements are old. (Cites *Cannington v.*

(1) Sec. 76.

(2) 1 App. Cas. 574.

*Nuttall* (1); *Cantrell v. Wallick* (2.) The courts uphold patents although the invention is a simple one. (Cites *Gadd v. Mayor of Manchester* (3); *Frearson v. Loe* (4); *Terrell on Patents* (5); *Spencer v. Jack* (6); *Hinks & Son v. Safety Lighting Co.* (7); *Hayward v. Hamilton* (8); *Grip Publishing Co. v. Butterfield* (9); *Gould v. Rees* (10); *Eames v. Godfrey* (11); *Vance v. Campbell* (12); *National Cash Register v. American Cash Register* (13); *Seymour v. Osborne* (14); *Philadelphia & Trenton Ry. Co. v. Stimson* (15); *Plimpton v. Malcolmson* (16); *Hills v. Evans* (17); *Hill v. Thompson* (18); *Machine Co. v. Murphy* (19).)

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*Edgar* followed on the same side and discussed the evidence.

*Johnston*, for the defendants;

It is not an invention to improve a known structure by substituting an equivalent for either of its parts. (Cites *Walker on Patents* (20).) The fact that one device performs the same function as another, though necessary, is not sufficient to make it an equivalent thereof. (Cites *Eames v. Godfrey* (21); *Conover v. Roach* (22); *Merriam v. Drake* (23).) The function must be performed in the same way, so that if one thing performs the same function as another, but does it in a different way, it is not an equivalent. (Cites *Burr v. Duryee* (24)) Patents

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| (1) L. R. 5, H. L. 205.                   | (13) U. S. Patent Gazette Jan. 17, 1893. |
| (2) 117 U. S. 689.                        | (14) 11 Wall. 515.                       |
| (3) 9 T. L. R. 42.                        | (15) 14 Pet. 458.                        |
| (4) 9 Ch. D. 48.                          | (16) 3 Ch. D. 567.                       |
| (5) P. 50.                                | (17) 31 L. J. Ch. 643.                   |
| (6) 11 L. T. N. S. 242.                   | (18) 1 Web. P. C. 242.                   |
| (7) 4 Ch. D. 615.                         | (19) 97 U. S. 135.                       |
| (8) Griff. P. C. 115.                     | (20) 2 Ed. sec. 36 and cases cited.      |
| (9) 11 O. A. R. 145; 11 Can. S. C.R. 291. | (21) 1 Wall. 78.                         |
| (10) 15 Wall. 187.                        | (22) 4 Fisher 12.                        |
| (11) 1 Wall. 78.                          | (23) 5 Fisher 259.                       |
| (12) 1 Black 427.                         | (24) 1 Wall. 573.                        |

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should be construed in the light of the description and specifications. (Cites *Clark v. Adie* (1); *Harrison v. Anderston Foundry Co.* (2); *New American File Co. v. Nicholson File Co.* (3).) Claims are narrowed by limitations in descriptions. (Cites *Crawford v. Heysinger* (4).) Interpretation is not to be strained in favour of the patentee. (Cites *Simpson v. Holliday* (5); *Badische v. Levinstein* (6).) The mere fact that there is a similarity of appearance between an article made by the patent process and the alleged infringement is not sufficient. There must be reasonably satisfactory evidence that a similar article could not be produced in any other manner, that in fact it carried the footprint of the invention with it. (Cites, generally, *Palmer v. Wagstaff* (7); *Davenport v. Richard* (8); *Curtis v. Platt* (9); *Rushton v. Crawley* (10); *Morley Machine Co. v. Lancaster* (11); *McCormick v. Talcott* (12); *Railway Co. v. Sayles* (13); *Walker on Patents* (14); *Terrell on Patents* (15); *Nordenfeldt v. Gardiner* (16); *Brown v. Davis* (17); *Murray v. Clayton* (18); *O'Riely v. Morse* (19); *Ewart M'fg. Co. v. Bridgeport Iron Co.* (20); *Pope M'fg. Co. v. Gormully, et al.* (21); *Saxby v. Clunes* (22); *Seed v. Higgins* (23); *Gill v. Wells* (24); *Snow v. Lake Shore and M. S. Ry. Co.* (25); *Walker on Patents* (26); *Roger v. Schultz Belting Co.* (27); *Robinson on Patents* (28); *Many v. Sizer* (29).)

- (1) 2 App. Cas. 315.
- (2) 1 App. Cas. 581.
- (3) 31 Fed. Rep. 289.
- (4) 123 U. S. 606.
- (5) 13 W.R. 578.
- (6) 12 App. Cas. 723.
- (7) 9 Ex. 494.
- (8) 3 L.T. N.S. 504.
- (9) 3 Ch. D. 135.
- (10) L.R. 10 Eq. 522.
- (11) 129 U.S. 273.
- (12) 20 How. 405.
- (13) 97 U.S. 556.
- (14) Sec. 360.
- (15) P. 177.

- (16) Cited at p. 5 of *Terrell on Patents*, 2nd ed.
- (17) 116 U.S. 249.
- (18) L.R. 7 Ch. 570.
- (19) 15 How. 62.
- (20) 31 Fed. Rep. 150.
- (21) 34 Fed. Rep. 885.
- (22) 43 L.J. Ex. 228.
- (23) 8 H.L. C. 550.
- (24) 22 Wall. 14.
- (25) 121 U.S. 629.
- (26) Sec. 349.
- (27) 28 Fed. Rep. 850.
- (28) Vol. 1, p. 388.
- (29) 1 Fisher 27.

BURBIDGE, J. now (June 26th, 1893) delivered judgment.

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The plaintiffs complain that the defendants are infringing certain letters-patent issued to one John Robert Carter on the 15th day of February, 1882, and registered in the Patent Office at Ottawa as number 14182, under which and certain assignments thereof they claim the exclusive right of making, constructing and using and vending to others, to be used in Canada, certain new and useful improvements in copying books. The plaintiffs' book, the title of which is "The Paragon Black-leaf Check Book," is described in the letters-patent to consist in a black-leaf check-book composed of double leaves one half of which is bound together while the other half folds in as fly-leaves, both being perforated across so that they can readily be torn out, the combination of the black-leaf bound into the book next to the cover, and provided with the tape bound across its end, the said black-leaf having the transferring composition on one of its sides only. The objects of the invention, as stated in the specification, were to provide a check-book in which the black-leaf used for transferring writing from one page to another need not be handled and would not have a tendency to curl up after a number of leaves had been torn out. The first of such objects was to be obtained by the use of the tape which enabled "the black-leaf to be folded back or raised without soiling the fingers," and the second by binding the black-leaf in with the other leaves but next to the cover in which position there "would be less likelihood of the black-leaf becoming crumpled up than if it were placed in the centre and the leaves removed from the stub on either side." Referring to his knowledge of the state of the art at the time of his application for letters-patent, the inventor in the specification stated that he was

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aware that black-leaves were employed in other forms of books used in transferring writing from one page to another but they were either loose in the book and were therefore easily lost and were dirty to handle, or were placed in the centre of the book and the leaves numbered on either side of it,—which latter arrangement was faulty from the fact that the space left on each side of the black-leaf when the leaves were torn out caused the black-leaf to curl up and become unsatisfactory in its operation.

The validity of this patent came in question in the case of *Grip Printing and Publishing Company of Toronto v. Butterfield* (1), and it was upheld by the learned Chancellor of Ontario, and by the Supreme Court of Canada on appeal from the Court of Appeal of Ontario, which had reversed the Chancellor's decision. The countercheck-book of the manufacture of which the plaintiffs in that case complained, was made without any tape attached to the black-leaf and, with the exception of a few that were not sold, that is also true of "The Paragon black-leaf check books" manufactured by Carter and by the assignees of the letters-patent granted to him. It will be necessary to refer to this matter of the tape more at length; but for the present it will be sufficient to observe that in the result nothing turned upon it in the case to which I have referred. It was there held on the evidence before the court that the plaintiffs were under the letters-patent in question entitled to the exclusive right to manufacture countercheck-books with the black or carbon leaf bound into the book next to the upper cover, and that the manufacture of a similar book with the black or carbon leaf bound in between the lower leaf and the lower cover, but which, in use was placed next to the upper or open cover as it was called, was an infringement of the plaintiffs' patent.

(1) 11 Ont. App. R. 145; 11 Can. S. C. R. 291.

But in this case it is set up as a defence and it is, I think, satisfactorily established that countercheck-books with the black or carbon leaf bound into the book next to the upper cover had been made and used prior to the date of the plaintiffs' patent.

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Harmon Butterfield, the defendant in the case referred to, in his evidence in this case said,—that about July, 1882, he saw two copies of such a book at the Copyright Office at Ottawa, and that he believed the book produced in court from the office of the Minister of Agriculture was one of them. In the countercheck-book produced, for which Charles Andrew Muma and Angus George Mackay appear to have obtained copyright in 1871, the black-leaf was loose. But it bore evidence of having been stitched in with the other leaves, though apparently one of the stitches had missed or only touched the black-leaf at the very edge. Butterfield says that in the book which he saw at the Copyright Office the black-leaf was bound in the book, the binding thread passing through the leaf the same as it did through any of the other leaves. Crawford Ross, a dry goods merchant of Ottawa, testified that in 1871 or 1872, when he was a clerk with McGee & Russell, then doing business at Ottawa, the Muma & Mackay countercheck-books were in use at McGee & Russell's place of business, and that the black-leaf in such books was bound in as part of the book, and next to the upper cover. Hiram S. Morison testified to the use in 1874 or 1876 of a similar book in W. A. Murray & Co.'s, of Toronto, and Charles Lanning to the use at O'Donnell & Company's, of Toronto, in the year 1878, of countercheck-books with the black-leaf stitched in at the top of the book. For the plaintiffs, James Gordon, who succeeded Muma in the business of manufacturing the Muma & Mackay countercheck-book, was called and testified that Gordon & Mackay never manufactured

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a book with the black-leaf bound in with the other leaves. It is to be observed, however, that Knox, who was the manager of Gordon & Mackay's business, was not called although he was in court. Neither was Muma or Mackay, and no reason was given for not calling them; I cannot but regard the negative evidence as incomplete and unsatisfactory, and insufficient to meet the case made by the affirmative evidence to which I have referred. There is not, I think, ground for a reasonable doubt, and on the evidence before the court I have none, that prior to Carter's invention, and the granting of the letters-patent in question, countercheck-books, similar to those manufactured by the plaintiffs and with the black or carbon leaf bound into the book next to the upper cover, had been manufactured and used in Canada.

Now, putting aside any question as to the effect upon the patent as a whole of the want of novelty in one of the improvements claimed, it is obvious that the patent is to be sustained, if sustained at all, as an improvement in the manufacture of countercheck-books, the leading feature of which is the tape attached to the black or carbon leaf for the purpose of enabling the person using the book to turn the leaf over or back without soiling the fingers. The plaintiffs say that the patent is a good patent for a new combination of old elements. I shall not stop to discuss that question which at present does not appear to be material. I am not, however, at all convinced that the countercheck-book protected by the patent is a combination in the proper sense of the term. But assuming that it is, we come back to where we were before, that the only novelty the combination possesses is the tape attached to the carbon leaf. In using the books which the plaintiffs have manufactured, and which are not provided with any tape, the fly-leaf may be used for turn-



ing over the carbon leaf, though it would appear that such a use of the fly-leaf is not in practice general. It was suggested that the fly-leaf would perform this function only when the book was bound at the top, but it is clear, I think, that the fly-leaf may be used in the same way, and for a like purpose, though not so conveniently, where the book is bound at the side, as was the case with the Muma & Mackay book produced. In the defendants' countercheck-books a margin or black space is left on the carbon leaf, or on the cover to which the carbon is applied by means of which the carbon leaf or cover may in like manner be turned over without soiling the fingers. This margin the plaintiffs say is the equivalent of the tape mentioned in their patent, and they complain that as the books used by the defendants are in other respects substantially the same as the book for which they hold the prior patent, the use of such book constitutes an infringement of the patent.

No question is raised by the pleadings that the invention for which Carter's patent was granted was not the proper subject of a patent, and the case is to be disposed of on the assumption that some invention or ingenuity was necessary to the conception that if one attached a tape or a tag to the carbon leaf in a countercheck-book he could turn the leaf over without touching it. Neither is any question raised as to the utility of the tape, though the evidence on that point is, to say the least, conflicting. The utility of the improvements covered by the patent, and the use of the tape is one of them, is conceded, and the defence is limited to the want of novelty in the invention. Now apart from the means employed to attain that end there was, I fancy, in 1882 nothing new in handling or turning over the carbon leaves in countercheck-books without soiling the fingers. Whether the fingers were

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soiled or not depended probably upon the care and means taken by the person using the book to avoid such soiling. It was said by one of the witnesses that in the Toronto shops the clerks who use "The Paragon check-book" manufactured by the plaintiffs turn over the black-leaf by taking it between the thumb and fingers. That may not be the best way, and it may have its disadvantages; but as there is no carbon on the upper side of the leaf, the leaf may, I suppose, in that way, if one is careful, be turned over or back without leaving any dirt on the fingers.

Then there are the fly-leaves which Mr. Ridout, who is a patent solicitor and who was put upon the stand by the plaintiffs, says perform the same function as the tape, and constitute an equivalent therefor. If he is right that the fly-leaves are an equivalent for the tape, then it would follow, I suppose, that the tape would equally be the equivalent of the fly-leaves and that the use of the tape as well as the manner of binding in the black-leaf with the other leaves of the book had been anticipated by the Muma & Mackay countercheck-book and that there was no novelty in either of the improvements for which the patent was granted.

Further it appears from the evidence of Mr. Caron, one of the examiners of patents in the office of the Minister of Agriculture at Ottawa, that as early as 1872 a patent had been granted in the United States for the process of manufacturing carbon for use in manifold writing, with clean margins so that the paper could be handled without soiling the fingers.

Apart altogether from any question of anticipation, it must, it seems to me, at all times have been open to any one who had occasion to use carbon paper, to have the paper prepared with a clean margin by which it could be handled without touching the carbon. There may be different ways in which to secure the clean

margin and in the adoption of the means to attain that result there would be room for the exercise of the inventive faculty, but it would not, it seems to me, be possible for one to monopolize the use of such margins on carbon paper even within the limited field of countercheck-books. In the same way it might require some skill or invention to devise a practicable method of attaching a tape to such carbon paper or leaves, and such method might possibly be the subject of a patent, although it appeared obvious to every one that the end arrived at could be attained by the use of a tape. But that question is not at present in issue.

The result, I think, is that if the plaintiffs' patent is construed to include the use of clean margins on carbon paper used in countercheck-books, it fails for want of novelty; but that in case the patent is limited, as I think it should be, to the means described therein for turning over such carbon leaves without soiling the fingers, that is to the use of the tape, the defendants do not infringe the patent by using a clean margin for a like purpose. In either case the plaintiffs' action fails.

*Judgment for defendants, with costs.*

Solicitors for the plaintiffs: *Edgar & Malone.*

Solicitors for the defendants: *Heighington & Johnston.*

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