
BETWEEN:

OTTAWA 1965 May 31-June 4 June 11

CURL-MASTER MFG. CO. LTD. .....PLAINTIFF;

AND

ATLAS BRUSH LIMITED .....DEFENDANT.

Patents—Infringement—Reissue patent—Patent Act, s. 50—Improved curling broom—Essential element of invention not disclosed in original patent—Deficiency not remediable by reissue patent.

One F. M. developed a new type of curling broom with two distinctive features: (1) a short outer skirt of straws surrounding and providing support for the inner and longer sweeping straws, and (2) a binding around the sweeping straws a substantial distance lower than the regular factory binding to which it was attached by loose cords to prevent it from sliding off the broom and which provided flexibility and support. When introduced in 1955 the broom became very popular and in March 1958 a patent was issued to the inventor. The specification described the second of the above features as "a transversal binding hidden by the outside fibers . . . attached by small strings to the top bindings in order that it cannot move".

F. M. applied for a U.S. patent in the same general terms. His application was rejected in 1957 on the ground of anticipation but in May 1961 a U.S. patent was granted following a revised application. F. M. then applied under s. 50 of the *Patent Act* for a "reissue" patent on the ground that the lower binding had been insufficiently described in the original patent because of inadvertence, accident or mistake

[1] [1957] 2 Lloyd's Rep. 506.

resulting from the illness and impaired efficiency of his patent attorney. In January 1963 a reissue patent was issued for a broom "essentially characterized by the provision of a low binding stitched loosely enough to slide on the fibers and spaced a substantial distance downwards towards the outer ends of the fibers from the conventional cord bindings of the broom, said low cord binding preventing the fibers from spreading apart and maintaining the bunch of fibers in flat condition while at the same time allowing the individual fibers to curve freely when the broom is pressed on the ice, due to the fact that the low binding can slide along the fibers".

In an action for infringement by plaintiff company (as assignee of the patent) the Court found that the nub or genius of the invention was described in the above quoted passage but that it was not disclosed in the original patent, which contained no suggestion of the essential elements of looseness and slidability of the lower binding or of its position on the broom substantially lower than the regular binding, and also that the broom described in the original patent was not a new and useful broom and not therefore an invention.

Held, dismissing the action, a reissue patent under s. 50 of the *Patent Act* can replace a defective or inoperative patent with a valid patent by substituting a sufficient description or specification for an insufficient description or specification or by adding or omitting claims but it cannot be for any invention other than an invention disclosed by the original patent. The invention embodied in the brooms F. M. put on the market in 1955 and disclosed in the reissue patent was not disclosed in the original patent and consequently the reissue patent was invalid.

Northern Electric Co. Ltd. v Photo Sound Corpn. [1936] Ex. C.R. 75; [1936] S.C.R. 649 followed.

ACTION for infringement of a patent.

Joan Clark and *Paul Amos* for plaintiff.

Walter C. Newman, Q.C. and *E. Foster* for defendant.

JACKETT P.:—This is an action for infringement of a patent for an invention relating to an improved curling broom granted under the *Patent Act* on March 25, 1958 (No. 554,826) and of a "reissue" patent granted under section 50 of the *Patent Act* upon the surrender of that patent. The reissue patent was issued on January 29, 1963 (No. 656,934). The plaintiff alleges that the defendant "has infringed" both patents by manufacturing, using, advertising, offering for sale and selling in Canada, curling brooms in infringement of Claims 1, 2, 3 and 4 of Patent No. 656,934 and in infringement of Claims 2, 3 and 4 of Patent No. 554,826. (The claims in respect of Claims 2 and 3 of the latter patent were dropped during argument.) The defendant, by way of defence to the action, denies that it has infringed any rights of the plaintiff under either patent and claims

1965

CURL-MASTER MFG. CO. LTD. v. ATLAS BRUSH LTD.

Jackett P.

that both patents are, and have always been, invalid. The defendant further counterclaims for a judgment that the patents are invalid.

Prior to 1955, the brooms employed in Canada by participants in the game of curling, particularly in Western Canada were normally like ordinary kitchen brooms except that the straws were substantially longer. Such a broom consisted of a cylindrical wooden stick or handle to one end of which was attached a bundle of straws of some suitable kind, the bundle of straws being pressed into a roughly flat broad shape and held in that shape by a number of tight bindings (three or four) near the handle. The opposite sides of these bindings were so stitched together through the straws that they held the bundle of straws in the flat broad shape. These bindings were attached by a machine process and are hereafter referred to as the factory bindings. Such brooms were employed in the game of curling to sweep the ice on which the game is played, more or less vigorously according to the style of the player using the particular broom. Among others, such brooms had the following characteristics:

(*a*) as the straws were all of approximately the same length, the outside straws tended, under the influence of vigorous sweeping, to break off at the lowest factory binding,

(*b*) as there was a relatively long distance between the lowest factory binding and the part of the broom that came in contact with the ice, the straws tended to spread out on coming in contact with the ice thus diminishing the force which would otherwise be applied to the ice at the particular place that the player intended to sweep.

About the end of 1953, Fernand Marchessault, who is the president of the plaintiff company, became interested in breaking into the business of making and selling curling brooms in Canada. In the course of attempting to do so, he developed a new type of curling broom which differs from the type of curling broom that I have just described in that

(*a*) it has a "short outer skirt" of straws surrounding the straws that come in contact with the ice (which I will call the "sweeping straws")—the outer straws, not being as long as the sweeping straws, are not

subject to pressure from the ice and are not as likely to break against the factory binding; they also supply support for the sweeping straws and they supply protection to the loose lower binding hereinafter referred to; and

(*b*) it has a binding around the sweeping straws about half-way between the lower factory binding and the sweeping end of the broom; such binding is applied by hand and not by machine and is loose enough so that the straws can move in relation to it but it is tight enough and it has its opposite sides so stitched together that the sweeping straws are held together and cannot spread appreciably in any direction. (This loose lower binding is attached by cords to the lowest factory binding so that it will not slide off the sweeping end of the broom.)

This new style broom is narrower and thicker than the old style broom.

In the fall of 1955, Marchessault introduced brooms of the kind that I have just discussed to curlers in various parts of Canada and that kind of broom, almost immediately, became very popular. Curlers in substantial numbers preferred them to the old style broom because the short outer skirt solved to a considerable extent the very troublesome problem of broken straws and, apparently, because the loose lower binding kept the sweeping straws together in such a way that much greater force was applied to the part of the ice that it was desired to sweep, thus giving the curler the feeling that his sweeping was more efficient. This feeling was undoubtedly aided by the backing given to the sweeping straws by the short outer skirt. In addition, the concentration of straws enabled certain curlers to develop a rhythmic noise or beat while sweeping that contributed to their satisfaction with their sweeping efforts.

Commercial success therefore followed the introduction of this broom both for Marchessault (or the plaintiff company, all the shares of which belong to him and his family) and for his various competitors who imitated his new style broom.

On March 1, 1956, Marchessault filed an application for a Canadian patent and, on March 25, 1958, Patent No. 554,826 was issued to him pursuant to that application. The specification reads as follows:

1965

CURL-MASTER MFG. CO. LTD. v. ATLAS BRUSH LTD.

Jackett P.

La présente invention se rapporte à un nouveau balai destiné particulièrement pour le jeu de curling.

Le but principal de l'invention est d'obtenir un balai de grande élasticité et de grande souplesse.

Un autre but de l'invention est d'obtenir un balai dont les fibres le composant sont de grande longueur sans risque de se disloquer ni de se briser.

Encore un but de l'invention est d'obtenir un balai qui est souple et bien monté.

Encore un but de l'invention est d'obtenir un balai homogène dont la qualité des fibres ne varie pas.

Encore un but de l'invention est d'obtenir un balai qui est très fort c'est-à-dire en rapport avec le volume de fibres qui le compose de sorte qu'il peut durer longtemps, les bouts ne se fendant pas et ne produisant pas de fentes.

Enfin, encore un but de l'invention est d'obtenir un balai du but et caractère décrits qui est de construction rationnelle et constitue une innovation très prisée dans le monde du curling.

Dans les buts précités, l'invention consiste en un faisceau plat de longues fibres végétales fixées sur un bout d'un manche. Le faisceau est à deux étages c'est-à-dire que les fibres extérieures ne se rendent pas à l'extrémité. Comme tous les balais, à courte distance de la fixation au manche, le faisceau de fibres comporte plusieurs ligatures transversales qui sont cachées par une gaine de toile. Les fibres se rendant à l'extrémité du balai comportent en outre une ligature transversale cachée par les fibres extérieures. Cette dernière ligature est reliée par des cordelettes aux ligatures supérieures afin qu'elle ne puisse se déplacer.

J'obtiens les buts précités au moyen de l'invention illustrée dans les dessins ci-joints et dans lesquels:

La figure 1 est une vue en élévation d'un balai construit selon l'invention;

La figure 2 est une vue semblable à celle de la figure précédente, sauf qu'elle est partiellement en coupe;

La figure 3 est une vue de côté; et

La figure 4 est une autre vue de côté et illustrant l'emploi de l'invention.

Dans la description qui suit et les dessins qui l'accompagnent les chiffres semblables renvoient à des parties identiques dans les diverses figures.

Comme tous les balais, le balai constituant la présente invention comporte un manche 1 à un bout duquel est fixé un faisceau de fibres végétales 2. Ces fibres sont de préférence des fibres simples et résistant à l'eau. Elles peuvent toutefois être de tampico tiré de feuilles d'un agrave du Mexique, de coco provenant de fibres entourant la noix de coco, de paille de sorgho, ou de piassava provenant de palmiers de l'Amérique du Sud. L'invention ne réside cependant pas dans le choix de fibres mais plutôt dans la construction du balai. Celui-ci est relié au manche 1 par une forte ligature de broche 3 et le joint caché par une bague métallique tronconique 4 elle-même fixée par une autre ligature de fil métallique 5.

A courte distance de la fixation au manche, le faisceau 2 comporte plusieurs ligatures transversales et parallèles 6 à l'aide de cordelettes. Dans les dessins, ces ligatures sont au nombre de quatre. Une cinquième ligature 7 est formée un peu plus bas dans un but qui sera expliqué plus loin. Ces

ligatures sont cachées par une gaine de toile 8 dont la surface peut recevoir un texte publicitaire ou un écusson d'un club de curling.

Le faisceau 2 est obtenu de fibres végétales très longues qui forment deux groupes d'inégales longueurs. Les fibres intérieures 9 sont les plus longues et les autres 10 formant le tour des premières sont les plus courtes. Au point de vue apparence le bout du faisceau est à deux étages. Les fibres les plus longues 9 comportent une ligature transversale 11 sous les fibres 10 de sorte qu'elle est invisible à l'œil. Pour que cette ligature ne puisse se déplacer elle est reliée à la ligature 7 ou à tout autre partie fixe du balai par des cordelettes 12 ou tout autre lien.

Dans l'emploi de l'invention, particulièrement pour le jeu de curling où le palet lancé par le joueur doit glisser sur la glace, le balayage facilitant le parcours doit s'effectuer rapidement et couvrir beaucoup de surface. Le balai constituant la présente invention permet un emploi rapide sans risque de briser les fibres. Ces dernières qui sont longues conservent leur homogénéité tel que la figure 4 des dessins l'illustre. Les fibres 9 se courbent sous la poussée et ne se mélangent pas avec les fibres 10. Les fibres 10 constituent un arc-boutant pour les fibres et ces dernières conservent cette homogénéité grâce à la ligature 11. En même temps les fibres 10 protègent la ligature 11 intérieure contre l'usure et servent de garde aux fibres longues pour les empêcher de briser. Le balai peut donc être ployé dans les deux sens sans qu'il ne puisse se briser.

Quoiqu'une seule forme spécifique de l'invention ait été illustrée et décrite, il est bien entendu que divers changements à la construction de l'invention peuvent être effectués pourvu que l'on ne se départe pas de son esprit tel que réclamé dans les revendications qui suivent.

Les réalisations de l'invention au sujet desquelles un droit exclusif de propriété ou de privilège est revendiqué, sont définies comme suit:

1. Un balai formé d'un faisceau de fibres fixées à un bout d'un manche, lesdites fibres étant à deux étages c'est-à-dire que les fibres sont en deux groupes d'inégales longueurs, ledit groupe de fibres plus longues que celles de l'autre groupe formant le centre du faisceau tandis que ledit autre groupe l'entoure.

2. Un balai tel que réclamé dans la revendication 1, dans lequel lesdites fibres des deux dits groupes comportent des ligatures transversales, les ligatures dudit centre de faisceau étant sous ledit autre groupe qui l'entoure.

3. Un balai tel que réclamé dans la revendication 1, dans lequel lesdites fibres des deux dits groupes comportent des ligatures transversales, les ligatures dudit centre de faisceau étant sous ledit autre groupe qui l'entoure et suspendues auxdites ligatures dudit autre groupe.

4. Un balai tel que réclamé dans la revendication 1, dans lequel lesdites fibres des deux dits groupes comportent des ligatures transversales, les ligatures dudit centre de faisceau étant sous ledit autre groupe qui l'entoure et suspendues par cordelettes auxdites ligatures dudit autre groupe.

An English translation of this specification was subsequently filed in the Patent Office by the plaintiff. That translation reads as follows:

This invention deals with a new broom particularly designed for playing curling.

The main purpose of the invention is to obtain a broom with great elasticity and great suppleness.

1965

CURL-MASTER MFG. CO. LTD. v. ATLAS BRUSH LTD.

Jackett P.

Another aim of the invention is to obtain a broom made up of long fibers without risking that they dislocate or break.

Another aim of this invention is to obtain a supple and well mounted broom.

Still another purpose of the invention is to obtain a homogeneous broom in which the quality of the fibers does not vary.

Another aim of the invention is to obtain a very strong broom that is, in relation with the volume of fibers with which it is made so that it may last a long time without the ends splitting or producing splits.

Finally one more aim of the invention is to obtain a broom for the purpose and type described of a rational construction, and constituting a much appreciated innovation among curling fans.

For the above-mentioned aims, the invention consists of a flat bunch of long vegetable fibers tied to one end of the handle. The bunch is in two layers, that is, the exterior fibers do not reach the extremity. Like all brooms, at a short distance from where it is secured to the handle, the fiber bunch includes several transversal bindings hidden under a linen sheath. The fibers reaching the extremity of the broom also include a transversal binding hidden by the outside fibers. This last binding is attached by small strings to the top bindings in order that it cannot move.

I attained the above-mentioned aims by means of the invention illustrated in the attached drawings and in which:—

Figure 1 is an elevation view of the broom built according to the invention;

Figure 2 is a view similar to the one on the previous figure except that it is partially cut;

Figure 3 is a side view; and

Figure 4 is another side view illustrating the use of the invention.

In the description which follows and the accompanying drawings, similar figures refer to identical parts in the different figures.

Like all brooms, the broom being the object of this invention includes a handle 1 at one end of which is attached a bunch of vegetable fibers 2. These fibers are preferably simple, waterproof fibers. They may however be made of tampico from the leaves of Mexican aloes, coir derived from fibers surrounding coconuts, sorghum straw, or piassaba from South American palm trees. The invention does not consist however in the choice of fibers but rather in the construction of the broom. This broom is attached to handle 1 by a strong wire binding 3 and the joint hidden by a metal ring in the shape of a truncated cone 4, itself attached by another metallic wire binding 5.

At a short distance from where it is attached to the handle, bunch 2 includes several transversal and parallel bindings 6 with small strings. In the drawings, there are four such bindings. A fifth binding 7 is made a little lower for a purpose explained below. These bindings are hidden by a linen sheath 8 on which can be applied some slogans or curling club emblems.

Bunch 2 is obtained from very long vegetable fibers which form two groups of different length. Inside fibers 9 are the longest and the others 10 surrounding the first ones are the shortest. From a point of view of appearance, the end of the bunch is in two layers. The longest fibers 9 include transversal binding 11 under fibers 10 in order that it is invisible. In order that this binding does not move, it is attached to binding 7 or to any stationary part of the broom by small strings 12 or any other tie.

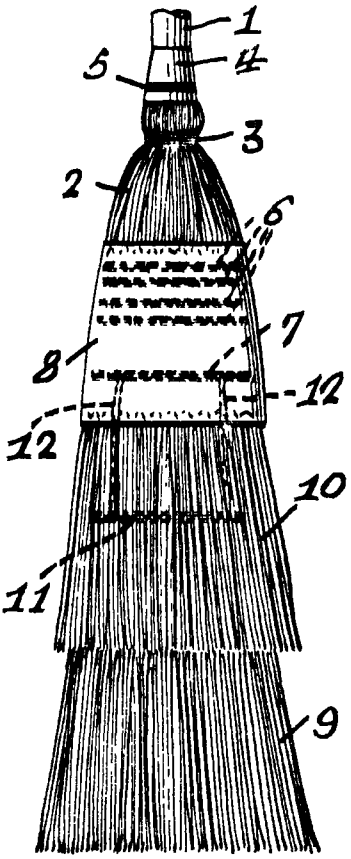

Fig. 1

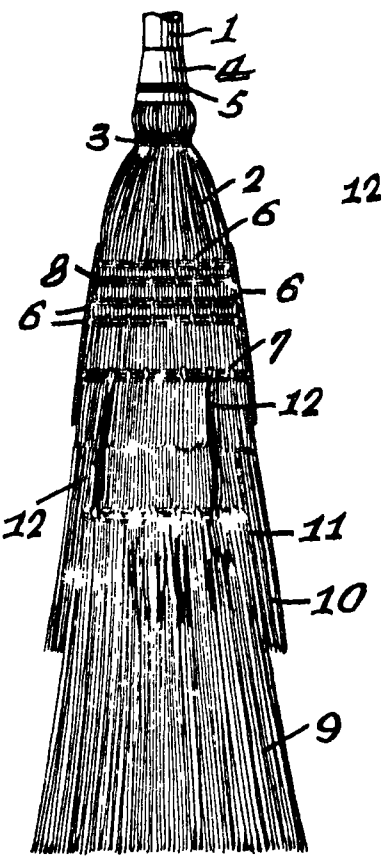

Fig. 2

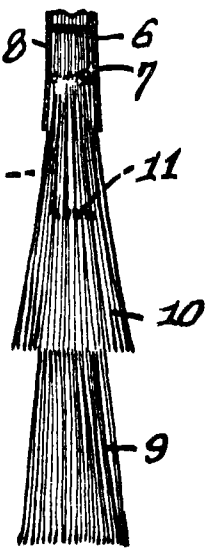

Fig. 3

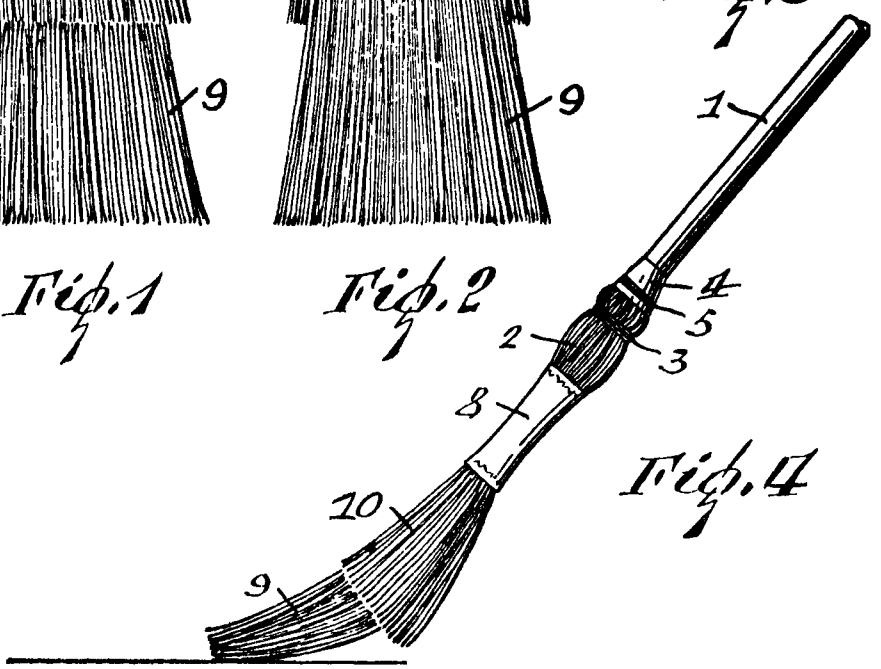

Fig. 4

554826

1965

CURL-MASTER MFG. CO. LTD. v. ATLAS BRUSH LTD.

Jackett P.

In using the invention, particularly for the game of curling where the stone pushed by the player must slide on the ice, the sweeping facilitating the run must be made rapidly and cover a large area. The broom being the object of the present invention permits rapid use without risking to break the fibers. Those fibers which are long keep their homogeneity as illustrated on figure 4 in the drawings. Fibers 9 bend under pressure and do not mix with fibers 10. Fibers 10 constitute a buttress for the fibers which keep this homogeneity thanks to binding 11. At the same time, fibers 10 protect inside binding 11 against wear and act as a guard to prevent long fibers from breaking. The broom may therefore be bent in both directions without breaking.

Even though only one specific form of the invention has been illustrated and described, it is well understood that various changes in the construction of the invention may be made as long as its idea is not departed from as claimed in the following claims.

The embodiments of the invention in which an exclusive property or privilege is claimed are defined as follows:

1. A broom made up of one bunch of fibers attached to one end of a handle, said fibers being in two layers, that is, that the fibers are in two groups of different length, the said group of fibers longer than the ones from the other group forming the center of the bunch while said other group surrounds it.

2. A broom as claimed in claim 1, in which said fibres of said two groups include transversal bindings, the bindings of said center of bunch being underneath said other group surrounding it.

3. A broom as claimed in claim 1, in which said fibers of two said groups include transversal bindings, the bindings of said center of bunch being underneath said other group surrounding it and suspended to said bindings of said other group.

4. A broom such as claimed in claim 1, in which said fibres of said two groups include transversal bindings, the bindings of said center of bunch being underneath said other group which surrounds it and suspended by small strings to said bindings of said other group.

On January 28, 1959, Marchessault assigned this patent to the plaintiff.

In connection with the application for Patent No. 554,826, Marchessault was represented by a patent attorney whose name was Albert Fournier. Fournier, in February, 1957, also made an application on behalf of Marchessault for an invention concerning curling brooms under the United States patent legislation.

The claims put forward in the original United States application were not in the same terms as the claims subsequently allowed in the Canadian patent, but they followed the same general lines. They were all rejected by the United States Patent Office on the ground that they were anticipated by prior patents. In May, 1959, Fournier was replaced by Pierre Lesperance as Marchessault's attorney in connection with his United States application. After

some negotiation, a United States patent issued, on May 16, 1961, containing a number of claims, of which the first, second and fifth read as follows:

1. A broom for use in the game of curling comprising a head and a staff to which the head is attached, said head being formed of long fibers, closely spaced bindings extending around said fibers, an additional flexible binding loosely surrounding and loosely stitched through said fibers and slidable relative to said fibers and spaced from said first named bindings a distance about half way between the sweeping end of the broom and said closely spaced bindings, and flexible ties having one end connected to said additional binding and having their other end fixed with respect to said first named bindings in order to prevent slipping of said additional binding off said fibers.

2. A broom for use in the game of curling comprising a head and a staff to which the head is attached, said head being formed of a central bunch, and an outer bunch of fibers, substantially closely spaced bindings extending around the two bunches of fibers, and an additional binding surrounding only the central bunch of fibers and covered by the fibers of the outer bunch, said additional binding being spaced from said first named bindings a distance about half way between said first named bindings and the sweeping ends of said fibers.

. . . .

5. A broom for use in the game of curling comprising a head and a staff to which the head is attached, said head being formed of a central bunch of relatively long fibers and an outer bunch of shorter fibers forming a skirt surrounding the upper part of the central bunch, closely spaced cord bindings extending around the two bunches of fibers, and an additional cord binding surrounding only said central bunch of fibers and covered by the free end portions of the fibers of the outer bunch, said additional cord binding being spaced from said first named cord bindings a distance about half way between said first named cord bindings and the sweeping ends of said fibers.

On March 21, 1962, the plaintiff filed a "Petition for Reissue" in the Canadian Patent Office pursuant to section 50 of the *Patent Act*, which reads as follows:

50. (1) Whenever any patent is deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more or less than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, the Commissioner may, upon the surrender of such patent within four years from its date and the payment of the further fee hereinafter provided, cause a new patent, in accordance with an amended description and specification made by such patentee, to be issued to him for the same invention for the then unexpired term for which the original patent was granted.

(2) Such surrender takes effect only upon the issue of the new patent, and such new patent and the amended description and specification have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if such amended description and specification had been originally filed in their corrected form before the issue of the original patent, but in so far as the claims of the original and reissued patents are identical such surrender does not affect any action pending at the time of reissue nor abate any cause of action then existing,

1965

CURL-MASTER MFG. CO. LTD. v. ATLAS BRUSH LTD.

Jackett P.

and the reissued patent to the extent that its claims are identical with the original patent constitutes a continuation thereof and has effect continuously from the date of the original patent.

(3) The Commissioner may entertain separate applications and cause patents to be issued for distinct and separate parts of the invention patented, upon payment of the fee for a reissue for each of such reissued patents.

The Petition for Reissue reads as follows:

The Petition of Curl-Master Mfg. Co. Ltd., whose full post office address is 1575 Craig Street, East, Montreal, Province of Quebec, Canada, SHEWETH:

(1) That Your Petitioner is the patentee of Patent No. 554,826 granted on the twenty-fifth day of March, 1958, for an invention entitled:

"BROOM"

(2) That the said Patent is deemed defective by reason of insufficient description or specification and by reason of the patentee having claimed more in certain respects and less in other respects than that he had the right to claim as new.

(3) That the respects in which the patent is deemed defective are as follows: In the description of the Patent there is insufficient description as to the purpose of the low binding 11 and of the ties 12.

The low binding 11 actually prevents spreading apart of the long fibers during sweeping. In the description of the original Patent this is only mentioned in an inferential way on page 6, line 11, wherein it is stated "et ces dernières conservent cette homogénéité grâce à la ligature 11." (translation, page 3, line 27, "which keep this homogeneity thanks to binding 11").

Furthermore, the description of the original Patent only mentions in an inferential way that the low binding surrounds and is loosely stitched through the fibers as follows: Page 4, lines 6, 7 and 8: "Cette dernière ligature est reliée par des cordelettes aux ligatures supérieures afin qu'elle ne puisse se déplacer." (translation, page 1, lines 28, 29 and 30: "This last binding is attached by small strings to the top bindings in order that it cannot move.") Page 5, line 25, "pour que cette ligature ne puisse se déplacer elle est reliée à la ligature 7 ou à tout autre partie fixe du balai par des cordellettes 12 ou tout autre lien." (translation, page 3, lines 15, 16, 17: "In order that this binding does not move, it is attached to binding 7 or to any stationary part of the broom by small strings 12 or any other tie.")

In accordance with the invention it is important that said low binding 11 be stitched loosely enough in order to slide on the fibers so as to allow flexibility in the bending of the fibers during sweeping.

Claim 1 of the Patent, which claims the broad idea of having a broom head of stepped formation with a central group of long fibers and an outer group of shorter fibers forming a skirt surrounding the central group, is probably somewhat too broad in view of U.S. Patent: Struve–1,115,255–October 27, 1914.

Claim 2 of the Patent which mentions the bindings surrounding the center bunch of fibers and surrounded by the outer bunch of fibers depends on claim 1 and is deemed too restricted because the Patentee's broom could very well be made without the skirt or outer bunch of shorter fibers. Such a broom is certainly operative as a curling broom and the low binding 11 would continue to exert its essential function although it will last a shorter

time because of the absence of the protection afforded by the skirt of outer fibers.

Claims 3 and 4 of the Patent are also defective for the reasons given in connection with claim 2.

(4) That the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention in the following manner:

That the patent application which resulted in the above noted Patent was prepared by Albert Fournier in the month of February 1956 at which time Mr. Fournier was suffering from a heart condition which somewhat impaired his work efficiency; Mr. Fournier died in fact in August 1958. Therefore, he did not fully comprehend the purpose of and working of the low binding 11 and of the importance of ties 12 of the inventor's broom. On the other hand, the inventor himself was not fully conversant with the requirements of a patent application to wit the fact that he delegated to Mr. Fournier the task of preparing a patent application and obtaining a patent for his invention. Moreover, the Canadian Examiner only cited against the original patent application. U.S. Patent 2,043,758–Lay–June 9, 1936. Therefore the Patent issued without knowledge either by the Patentee, his Patent Agent, or the Canadian Office, of a prior Patent teaching that it was known to have a broom with a stepped construction which might render claim 1 of the Patent invalid.

(5) That knowledge of the new facts stated in the amended disclosure and in the light of which the new claims have been framed was obtained by Your Petitioner on or about the last days of December 1958, in the following manner: At that time an official action had been received from the U.S. Examiner citing the Struve U.S. Patent mentioned above against the Patentee's corresponding U S. patent application Serial No. 640,676 dated February 18, 1957. Copy of this Patent was ordered from the Patent Office and it was then discovered that it showed the stepped construction of Applicant's U S. claim 1 which at that time somewhat corresponded to claim 1 of the Canadian Patent. In December 1958, the Canadian Patent was already issued. In view of the situation of the U.S. patent application at that time, it was decided to await the issue of the U.S. Patent before initiating re-issue procedure in the Canadian Patent. The eventual U.S. Patent claiming the Patentee's invention finally issued on May 16, 1961, under U.S. Patent 2,983,939.

(7) That Your Petitioner hereby appoints PIERRE LESPERANCE, whose full post office address is 934 St. Catherine Street, East, Montreal, Province of Quebec, Canada, as his agent, with full power of revocation and substitution, to sign the petition and drawings, to amend the specification and drawings, to prosecute the application, and to receive the patent granted on the said application; and ratifies any act done by the said appointee in respect of the said application.

(8) Your Petitioner therefore surrenders the said original patent and prays that a new patent may be issued to him in accordance with the amended specification herewith, for the unexpired term for which the original patent was granted.

Signed at Montreal, P.Q., this 21st day of March 1962.

CURL-MASTER MFG. CO. LTD.

F. Marchessault (signed)

president

1965

CURL-MASTER MFG. CO. LTD. v. ATLAS BRUSH LTD.

Jackett P.

On January 29, 1963, Patent No. 656,934 was issued as a "reissue" patent pursuant to section 50 of the *Patent Act*. The specification reads in part as follows:

The present invention relates to a new broom specifically adapted for the game of curling.

In the game of curling, brooms are used for sweeping the ice ahead of the stone sliding on the ice. This has the effect of removing dirt or ice particles and temporarily melting the sandy like frost which covers the ice surface thus making it more slippery so that the stone will travel farther.

Prior to the present invention, brooms identical in construction to household brooms were used for curling, except that they had longer fibers than household brooms. Conventional household brooms comprise a wooden handle or staff to the lower end of which a head is attached, said head consisting of fibers usually secured to the staff and held together as a bunch by means of a wire binding and also by several cord bindings spaced from each other, surrounding the fibers and stitched through the fibers in a tight manner. Because these cord bindings are located in the upper part of the broom head and that the fibers of the broom head are long, the fibers had a tendency to spread excessively when the broom was used for sweeping the ice, and to break, especially at the lowermost cord binding, rendering the old time broom ackward (sic) to use.

It is the general object of the present invention to provide a curling broom which obviates the above disadvantages and which more particularly prevents spreading apart of the fibers of the conventional curling brooms when the broom head is pressed on the ice.

Other objects of the present invention reside in the provision of a curling broom which is of light weight construction and is easy to manipulate and efficient for ice sweeping in the game of curling, and which has a long life because the fibers do not break easily.

The broom in accordance with the present invention is essentially characterised by the provision of low binding stitched loosely enough to slide on the fibres and spaced a substantial distance downward towards the outer ends of the fibers from the conventional cord bindings of the broom, said low cord binding preventing the fibers from spreading apart and maintaining the bunch of fibers in flat condition while at the same time allowing the individual fibers to curve freely when the broom is pressed on the ice, due to the fact that the low binding can slide along the fibers. Thus, the flexibility of the fibers is not impaired.

In accordance with the invention, the low binding is prevented from sliding off the outer end of the fibers by being attached by flexible ties.

In accordance with another characteristic of the invention, the main bunch of fibers is surrounded by an outer bunch of shorter fibers defining a skirt and overlying the low cord binding so as to protect the same against wear as it is known that when the broom is manipulated, the low cord binding due to its very low level position strikes the ice during sweeping motions.

(At this point there is a description of how to make an embodiment of the invention.)...

While a preferred embodiment in accordance with the present invention has been illustrated and described, it is understood that various modifications may be resorted to without departing from the spirit and scope of the appended claims.

The Embodiments of the invention in which an exclusive property or privilege is claimed are defined as follows:

1. A broom for use in the game of curling comprising a head and a staff to which the head is attached, said head being formed of fibers and including fiber binding means in the zone of said head attached to said staff, a low flexible binding surrounding and stitched loosely enough through said fibers to be slidable relative to said fibers, and spaced a substantial distance from said fiber binding means and flexible ties connecting said low binding to said head in order to prevent slipping of said low binding off said fibers.

2. A broom for use in the game of curling comprising a head and a staff to which the head is attached, said head being formed of a central bunch and an outer bunch of fibers and including bindings extending around the two bunches of fibers, a low binding surrounding and loosely stitched through the central bunch of fibers only, slidable with respect to said central bunch of fibers and covered by the fibers of the outer bunch, said low binding being spaced a substantial distance from said first named bindings, and flexible ties connecting said low binding to said head in order to prevent slipping of said low binding off said fibers.

3. A broom as claimed in claim 2, wherein said outer bunch is constituted by fibers shorter than the fibers of the central bunch, whereby said outer bunch forms a skirt surrounding the upper part of the central bunch, said low binding being disposed underneath and covered by the free end portion of the fibers of the outer bunch.

4. A broom for use in the game of curling comprising a head and a staff to which the head is attached, said head being formed of a central bunch of long fibers and an outer bunch of shorter fibers forming a skirt surrounding the upper part of the central bunch, said head including bindings extending around the two bunches of fibers, and a low flexible binding surrounding and loosely stitched through said central bunch of fibers only and slidable relative to the fibers of said central bunch and covered by the free end portions of the fibers of the outer bunch, said low binding being spaced about half way between said first named bindings and the sweeping ends of said long fibers, and flexible ties attached to the low binding at one end and having their other end connected to said head in order to prevent slipping of said low binding off the fibers of said central bunch.

It is common ground that the defendant did manufacture some brooms, both in the period between the issue of Patent No. 554,826 and the issue of Patent No. 656,934 and in the period since the issue of Patent No. 656,934, which, in my view, fall clearly within Claim 3 of Patent No. 656,934. The plaintiff contends that Claim 3 of Patent No. 656,934 is substantially identical to Claim 4 of Patent No. 554,826. The plaintiff's case was closed on an understanding between the parties and the Court that, if the plaintiff had made out a case for one act of infringement of either patent, there would be

1965

CURL-MASTER MFG. CO. LTD. v. ATLAS BRUSH LTD.

Jackett P.

(a) a reference as to what acts of infringement had been committed, and

(b) a reference as to the damages flowing from such acts of infringement, or a reference for an accounting of profits depending upon what relief the Court determines that the plaintiff is entitled to.

It is therefore unnecessary for me to make any further finding of fact concerning such matters.

I find as a fact that the broom that Marchessault put on the market in the fall of 1955 was the embodiment of an invention of which Marchessault was the inventor. Leaving aside the element of the short outer skirt as a protection against the breaking of the sweeping straws at the bottom factory binding and as a support for the sweeping straws, in my opinion, the loose lower cord around the sweeping straws a substantial distance down the broom from the factory bindings (which I have already described), by virtue of its effect of keeping the sweeping straws in a compact bundle without interfering with their flexibility, created a curling broom that was substantially different from the brooms previously used by curlers and definitely more satisfactory to them. It was not anticipated in my view by any of the earlier patents or by Ken Watson's personal practice of putting a loose string an inch or so below the factory binding (Ken Watson himself admitted that Marchessault deserved the credit for getting the loose string "down there" although he thought that his loose string involved the same principle). The new element was relatively simple, it is true. It resulted, however, in a radically different broom that was so much more useful (judged by the assessment of those who used curling brooms) that it immediately came into great demand. There is no doubt in my mind that it was an "invention" within the meaning of the *Patent Act* in the sense that it was "new" and "useful". It was an inventive step forward. I also find that the combination of the element of the loose lower binding and the element of the short outer skirt as a means of protecting the loose lower binding from wear also constituted an invention for the same reasons.

Unfortunately, I have come to the conclusion that neither of those two inventions are either disclosed or claimed by Patent No. 554,826 and that section 50 of the *Patent Act* does not authorize the grant of a reissue patent for an

invention that has not been disclosed or claimed by the original patent.

Section 50 authorizes the Commissioner to cause a new patent to be issued "for the same invention . . . for which the original patent was granted". See *Northern Electric Co. Ltd. v. Photo Sound Corpn.*[1] where Maclean J. (as he then was) at page 89 summarized the effect of the reissue provision as follows:

> . . .the purpose of a re-issue is to amend an imperfect patent, defects of statement or drawings, and not subject-matter, so that it may disclose and protect the patentable subject-matter which it was the purpose of that patent to secure to its inventor. Therefore the re-issue patent must be confined to the invention which the patentee attempted to describe and claim in his original specification, but which owing to "inadvertence, error or mistake," he failed to do perfectly; he is not to be granted a new patent but an amended patent. An intolerable situation would be created if anything else were permissible. It logically follows of course, that no patent is "defective or inoperative" within the meaning of the Act, by reason of its failure to describe and claim subject-matter outside the limits of that invention, as conceived or perceived by the inventor, at the time of his invention.

See also the same case on appeal to the Supreme Court of Canada[2] where Duff C.J., delivering the judgment of the Court said at page 651:

> First of all, the invention described in the amended description or specification and protected by the new patent must be the same invention as that to which the original patent related.

and at page 652:

> The statute does not contemplate a case in which an inventor has failed to claim protection in respect of something he has invented but failed to describe or specify adequately because he did not know or believe that what he had done constituted invention in the sense of the patent law and, consequently, had no intention of describing or specifying or claiming it in his original patent. The tenor of the section decisively negatives any intention to make provision for relief in such a case[3].

Patent No. 656,934 was issued for a broom "essentially characterized by the provision of low binding stitched loosely enough to slide on the fibers and spaced a substantial distance downwards towards the outer ends of the fibers from the conventional cord bindings of the broom, said low cord binding preventing the fibers from spreading apart and maintaining the bunch of fibers in flat condition while at the

[1] [1936] Ex. C.R. 75. [2] [1936] S.C.R. 649.

[3] I have in mind that Duff C.J., in the following paragraph, comments, "In this connection," on an aspect of the section that he was discussing that was the subject of an amendment before the legislation was reproduced in the present section 50. I do not understand the passage quoted to be dependent on that comment.

1965

CURL-MASTER MFG. CO. LTD. v. ATLAS BRUSH LTD.

Jackett P.

same time allowing the individual fibers to curve freely when the broom is pressed on the ice, due to the fact that the low binding can slide along the fibers." That, in my opinion, is the nub or the genius of the invention. It is not, in my opinion, to be found disclosed, either expressly or by reasonable inference (I should have thought there is some doubt as to whether a specification can disclose an invention by inference), in Patent No. 554,826, which contains a general description of the patent for which it is issued in the following paragraph:

> Dans les buts précités, l'invention consiste en un faisceau plat de longues fibres végétales fixées sur un bout d'un manche. Le faisceau est à deux étages c'est-à-dire que les fibres extérieures ne se rendent pas à l'extrémité. Comme tous les balais, à courte distance de la fixation au manche, le faisceau de fibres comporte plusieurs ligatures transversales qui sont cachées par une gaine de toile. Les fibres se rendant a l'extrémité du balai comportent en outre une ligature transversale cachée par les fibres extérieures. Cette dernière ligature est reliée par des cordelettes aux ligatures supérieures afin qu'elle ne puisse se déplacer.

The essential elements of the loose lower cord are neither expressed nor suggested either in this paragraph or elsewhere in the original patent. I cannot accept the suggestion that the elements of looseness and slideability is in any way indicated by the words "reliée par des cordelettes aux ligatures supérieures afin qu'elle ne puisse se déplacer" or by the expression "suspendues par cordelettes" in Claim 4. Nowhere is there any indication of the equally important element of the position of the loose lower cord substantially down the straws from the factory bindings toward the sweeping end of the broom.

In my view, a reissue patent under section 50 of the *Patent Act* can replace a defective or inoperative patent with a valid patent by substituting a sufficient description or specification for an insufficient description or specification or by adding or omitting claims but it cannot be for any invention other than an invention disclosed by the original patent. The invention that is embodied in the brooms that Marchessault put on the market in 1955, prior to applying for either patent, and that is disclosed in Patent No. 656,934, the reissue patent, is not disclosed in Patent No. 554,826, and Patent No. 656,934 is therefore invalid.

Patent No. 554,826 is invalid because the class of broom described in it is not a new and useful broom and is not therefore an invention. Claim 4, the only claim that the

plaintiff endeavoured to support, is, among other things, for an unspecified number of bindings around the sweeping straws, whether tightly or loosely bound and in any position between the factory bindings and the end of the outer skirt.[1] It would extend to what Ken Watson did and to many embodiments which would obviously not be good curling brooms as well as to the broom made by Marchessault in 1955. Patent No. 554,876 claims too much and is invalid.

I do not therefore need to come to any conclusion with reference to the several other submissions made for the defence.

The action is dismissed and the prayer in the counterclaim for a declaration that both patents are invalid is granted. Costs follow the event.

Action dismissed; counterclaim allowed.

[1] I cannot accept the submission that a wide claim may be restricted by reference to an illustration used in describing a particular embodiment. See *Northern Electric Co. Ltd. v. Photo Sound Corpn., supra.* See also *United Merchants and Manufacturers, Inc. v. A. J. Freiman Limited, et al.* [1965] 2 Ex. C.R. 690. Cases such as *George Hattersley & Sons Ltd. v. George Hodgson Ltd.,* [1906] 23 R.P.C. 192, upon which counsel for the plaintiff relied, are distinguishable. In that case, the claims were expressly framed by reference to the illustration and description and there was no statement such as there is in Patent No. 554,826, viz., «Quoiqu'une seule forme spécifique de l'invention ait été illustrée et décrite, il est bien entendu que divers changements à la construction de l'invention peuvent être effectués pourvu que l'on ne se départe pas de son esprit tel que réclamé dans les revendications qui suivent.»