

1931
Jan. 27, 28.
Feb. 7.

THE G. E. PRENTICE MANUFACTUR- } PLAINTIFF;
ING COMPANY

VS.

C. R. KENNY ET AL. DEFENDANTS.

Patents—Invention—Utility—Novelty—Impeachment—Costs

The patent for invention in this suit is for a "new and useful improve-
ment in separable fasteners."

Held that the fact that a patented device, consisting of an improvement
on similar devices to be found in the prior art, has been generally
adopted by the public, is strong evidence of its novelty and useful-
ness and of its being an advance in the art.

2. That the increased security in a fastener, when applied successfully to
remedy an old defect, with the discovery of the cause for such defect,
would seem to amount to invention, and the novelty of an invention
is not impeached by the fact that the same results may be achieved
in a different way.

(1) 1915, 1 K.B. 852. (2) (1880) 14 Ch. Div. 311.
(3) (1918) 34 T.L.R. 589-341.

3. That a Court should not be too astute to find reasons for impeaching a document under the Great Seal, and that where any doubt exists it should be resolved in favour of the patentee.
4. Plaintiffs having at trial, abandoned their action against one of three of the defendants, the Court ordered that one-third of the costs to be taxed against the defendants be deducted upon taxation.

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ACTION by the plaintiff to have it declared that the defendants have infringed its patent for Invention Number 286,528, and dated the 15th January, 1929. The defendants denied the infringement and asked that it be declared that the patent sued on was invalid, null and void.

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

D. L. McCarthy, K.C., and *S. A. Hayden* for plaintiff.

O. M. Biggar, K.C., for defendants.

AUDETTE J., now (February 7, 1931), delivered judgment.

This is an action for an alleged infringement by the defendants of the plaintiff's Canadian Patent No. 286,528, bearing date the 15th January, 1929, and which is now held by the said plaintiff company under assignment from the inventors.

The grant covered by the patent is for "new and useful improvements in separable fasteners."

A patent case always primarily involves a question of fact followed by a question of law, and in no case more than the present can it be said more truly that every such case must stand on its own merit.

The field of the prior art relating to this subject matter is large and covers a number of very narrow patents. The plaintiff's patent is, indeed, also very narrow and should receive a narrow construction.

However, the evidence establishes that the defendants have infringed the plaintiff's patent by the shipment into Canada of the trivial quantity of one dozen of such fasteners.

The defendants assert that this dozen of fasteners are not the fasteners which they manufacture under their patent and that such shipment is the result of a defective plug and die used when manufacturing them and that they were sold without their knowledge at the time, a fact which, according to them, they only became aware of at trial,

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when they then undertook not to manufacture any more fasteners of such description in the future.

The plaintiff, on the other hand, abandons its action against the defendant Kenny and further abandons any demand for taking any account and for any damages—its claim narrowing down to the compass of a demand for injunction and costs.

The defendants, however, maintain their claim for impeachment on the ground of anticipation.

As a test of the difference between success and failure the evidence discloses that the plaintiff's device—notwithstanding the large field of the prior art—has proved a great success commercially and that such device has become in use, in preference to all others, when applied to golf bags, as giving better results where others have failed. The general adoption of the improvement, with increased productivity, is a strong evidence of its novelty and usefulness and would seem to have advanced the art. The increased security in a fastener, when applied successfully to remedy an old defect with the discovery of its cause, would seem to amount to an invention and the novelty of an invention is not impeached by the fact that the same results may be achieved in a different way.

The principle in all these devices is the same, but it is carried out with some small mechanical devices differing from one another, and the prior art is especially conspicuous with the apparent narrow dissimilarity, if any, among them.

It would seem that in a case of this kind one should not be too astute in finding reason for impeachment of a document under the Great Seal and that the doubt, if any, should be resolved in favour of the patentee. *Consolidated Car Heating Company v. Came* (1).

Coming to the question of costs, considering that the plaintiff has abandoned his case against defendant Kenny who must have been put to some expense in defending and which somebody must satisfy, it would seem unjust that this expense of a successful opposition should be borne by the party succeeding. *Hill's Patent* (2); in re *Johnson's Patent* (3).

(1) (1903) A.C. 509.

(2) (1863) 1 Moore's P.C.N.S. 258, at p. 271.

(3) (1871) L.R. 4 P.C. 75.

Therefore there will be judgment declaring that the defendants Beddoe and The Jiffee Sales Company have infringed in the manner above mentioned and that the plaintiff is entitled as against them to the injunction prayed for, and with costs in favour of the plaintiff, but one third of the said cost to be deducted therefrom.

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Judgment accordingly.

Audette J.