

1926  
June 18.

GERRARD WIRE TYING MACHINES  
COMPANY, LTD. OF CANADA..... } PLAINTIFF;

VS.

CARY MANUFACTURING CO.....DEFENDANT.

*Patents—Conflict or interference—Date of invention—First inventor—  
Publication*

*Held:* That a mere conception of anything claimed to be an invention, but which is concealed and not disclosed or published, is not such an invention as will invalidate a patent granted to a subsequent inventor and who has published his invention.

Mere conception is not invention within the meaning of the Patent Act, and a first inventor, in the popular sense, who has not communicated or published his invention is not entitled to priority over a later inventor who has made the same public, and for which a patent has been granted or applied for.

- 2. What constitutes publication is a question of fact, depending upon the circumstances of each case. There must be publication or use in public of a satisfactory kind, in order to bar the claim of a subsequent inventor who has disclosed the same and who first applied for a patent.
- 3. That "first inventor" within the meaning of the Patent Act means not the first discoverer of the thing or the first to conceive the same, but the first to publish the same. Such inventor, however, must be the true inventor and must not have borrowed the idea from anybody else.

ACTION by the plaintiff for a declaration that his assignors were the first inventors of the device described in their application for a patent. The Commissioner of Patents having declared plaintiffs' and defendants' applications to be in conflict.

Ottawa, January 18 to 22, and March 8 and 9, 1926.

(1) An appeal has been taken to the Supreme Court of Canada.

Action now tried before the Honourable the President.

*Russel S. Smart* for plaintiff.

*A. W. Anglin, K.C.* and *R. C. H. Cassels, K.C.* for defendant.

The facts are stated in the reasons for judgment.

MACLEAN J., now this 18th day of June, A.D. 1926, delivered judgment.

The applications for patents, of the plaintiff and the defendant respectively, are in conflict, and these proceedings are taken under sec. 22 of the Patent Act. The issue for determination is, which of the two parties, Gerrard and Wright, assignors of the plaintiff on the one hand, and Cary, assignor of the defendant on the other hand, was the first inventor, and which is in law entitled to a patent. The question as to whether or not there is invention in either case, is not in issue and was not tried. That there is invention or subject matter disclosed in each application is to be assumed for the purposes of this case.

The plaintiff's Canadian application is dated October 4, 1922, and relates to a wire package binder provided with a deformed or flattened end, and which forms a holding shoulder designed to prevent the wire from endwise slipping, when tensioned, for application to packages or boxes, etc., and which is adapted for use in a wire tying machine. This sufficiently describes, I think what the plaintiff claims as its invention. Claim 9, however, is relied upon by the plaintiff as of particular importance, and as being something different from anything claimed by the defendant in its application, in that the shoulder on the wire is described as "sloping." In the view I take of the case I do not think this claim is of special importance, and possibly not in any view of the case. That claim is as follows:—

9. A tie wire adapted for use in wire tying machines and provided with a deformed end having a sloping holding shoulder substantially as described.

On April 5, 1920, the plaintiff's inventors, Gerrard and Wright, filed an application in the United States Patent Office for a patent of a wire twisting machine, and in that application there is disclosure of a wire package binder, to be used in such machine. The specifications of this

1926  
 GERRARD  
 WIRE TYING  
 MACHINES  
 CO., LTD.,  
 OF CANADA  
 v.  
 CARY MFG.  
 Co.

1926  
 GERRARD  
 WIRE TYING  
 MACHINES  
 Co., LTD.,  
 OF CANADA  
 v.  
 CARY MFG.  
 Co.  
 Maclean J.

application frequently refer to a wire with a flattened portion or shoulder, and which flattened portion is to be inserted in the slit of a post in a machine provided for the reception of the wire. Substantially the wire is the same as described in the Canadian application just mentioned, except that there is no reference to a *sloping* shoulder. The application contained the following claims as to the wire:

19. As a new article of manufacture, the herein described wire adapted to encircle a box, and provided with a flattened portion near one end, and a round portion at each end of the flattened portion, substantially as described.

20. The herein described article of manufacture consisting of a wire adapted to encircle a box and provided with a flattened portion and a holding shoulder at one end of the flattened portion, substantially as described.

21. In a wire tying machine, the combination of a holding post provided with a slit, and a wire adapted to encircle a box having a flattened portion to fit said slit, and holding shoulders to contact with the edges of the said slit substantially as described.

The United States Patent Office having required a division of this application, Gerrard and Wright made application for a patent for the wire binder only, on October 21, 1922. What was claimed in this application for the wire is again substantially the same as that claimed in the Canadian application of Gerrard and Wright, except that claim 9 of the latter, does not appear in the claims of this United States application.

Gerrard and Wright claim to have made their invention of the wire package binder sometime between the first of the month of October and the latter part of December, 1919.

Cary's original Canadian application, filed April 27, 1922, was for a wire package binder and a machine or means for applying the same. The specifications make disclosure of a shouldered wire, performing the function of an abutment co-operable with an element or part of a tensioning mechanism for retaining the wire against slipping during the application of the tensioning, and the subsequent operation of locking or twisting the end portions of the wire. The Patent Office concluding that the claims defined a plurality of invention, ordered a division of the application, and thereupon the present application was restricted to the machine, and a fresh application was made

for a patent of the wire only on November 2, 1922, and it is that application that is here in question.

The specifications of this application contain the following description of the wire:—

The wire is used in conjunction with a suitable implement tool, or machine, whereby it is tensioned and locked, and to enable the wire to be used with facility, it is desirable to straighten said wire and cut it to a length suited to the package, and to so fashion the wire that it is held against slipping with respect to the tool, implement, or machine in the operations of tensioning and locking the same.

The wire of my invention is deformed to produce a shoulder performing the function of an abutment co-operable with an element or part of the tensioning mechanism for retaining said wire against slipping during the application of tension thereto and the subsequent operation of locking the end portion of the wire as by twisting the same.

The claims are eight in number and are quite similar. The first claim might be referred to as expressive of the other claims.

1. A Package binder comprising a piece of wire provided with an adjacent end and a portion with a shoulder forming an abutment, adapted to prevent a wire from slipping when tension is applied to said wire.

A reference to the drawings will reveal clearly the character of the shouldered wire. The drawing, fig. 1 indicates a V-shaped wire which shall be later referred to. There is nothing, I might say, disclosed in the drawings which would indicate a sloping shouldered wire, such as is referred to in claim 9 of the Gerrard and Wright's Canadian application, and to which I have already referred.

On March 31, 1922, Cary applied to the United States Patent Office for a patent of a shouldered wire, and the drawings of the wires are exactly the same as appear in the Canadian application of November 2, 1922. It is claimed on behalf of the defendant that Cary's invention was made sometime within the months of January, February or March, 1919.

At this stage, the important dates affecting the position of the parties are as follows: The plaintiff claims that Gerrard and Wright made their invention of the shouldered wire sometime between the first of October and the latter part of December, 1919. On April 5, 1920, Gerrard and Wright made application in the United States for a patent in which the shouldered wire was disclosed, and which was the subject of a separate application in that country, on October 21, 1922. The date of the Canadian application

1926  
 GERRARD  
 WIRE TYING  
 MACHINES  
 Co., LTD.,  
 OF CANADA  
 v.  
 CARY MFG.  
 Co.  
 Maclean J.

1926  
 GERRARD  
 WIRE TYING  
 MACHINES  
 Co., LTD.,  
 OF CANADA  
 v  
 CARY MFG.  
 Co.  
 Maclean J.

of Gerrard and Wright for a patent on the wire is October 4, 1922. On the other hand, the defendant claims that Cary made his invention within the first three months of 1919. The date of Cary's application for the grant of a patent on the wire in the United States was March 31, 1922. In Canada, Cary's application for a patent on a machine and a wire was on May 1, 1922, and on the wire alone on a divisional application on November 2, 1922.

There seems to be no question but that Gerrard and Wright conceived the idea of a shouldered wire sometime during the last three months of 1919, and within that period made it in an experimental way. They disclosed the same to Bauer, who was in the plaintiff's employ as salesman, in December, 1919. It was clearly disclosed on April 5, 1920, in their application for a United States patent on a wire twisting machine, and of course in the divisional application in that country upon a wire only in October, 1920. The application of April 5, 1920, is an important date. While the specifications accompanying an application for a patent may not constitute publication, it at least fixes the date of the plaintiff's completed invention as not later than that date. In 1920 the plaintiff produced the wire in the United States in a limited way, but early in 1921, it was being produced on a substantial scale, and being sold to the public along with suitable tools or machines for applying the wire. The plaintiff has since established a large trade in the wire in many countries of the world. In April of 1921 the plaintiff claims to have shipped wire into Canada. There is nothing in the evidence in my opinion to sustain the suggestion that Gerrard and Wright obtained in any way the invention from Cary, or in fraud of his rights.

Now as to the facts regarding the defendant's claim to invention and the time of the same. It is claimed that Cary conceived of or invented his wire sometime during the first three months of 1919. Cary says that during that period he conceived of the idea of a shouldered wire, and in exhibit X 11 there is to be found several samples of notched or shouldered wire which Cary claims were made by him early in 1919. These are samples of wire only a few inches in length disclosing a variety of shouldered

wire. Cary, so far as I can see, made no disclosure or publication to any persons except McFaul, Ragona and Frech, three men in his employ, all of whom were I think mechanics. He does speak of disclosure to "other persons," but there is no evidence as to who the others were, or when such disclosures were made. He did not apply for a patent on the wire in the United States until March, 1922. There is no evidence that he ever applied a preformed or shouldered wire to any package, even in an experimental way in 1919, and he never manufactured this class of wire until early in 1922. He apparently did not possess a machine for applying such a wire to packages in 1919, 1920 or in 1921. He states that in the early part of 1919 he made a notched wire similar to fig. 1 of his drawings. That was not, however, a wire that was completed with a shoulder ready for sale or use and to be applied by a machine, but was merely a straight plain wire that was placed in a machine for application to a package, and while being so applied a V-shaped notch was made in the wire by the holding grippers which were a part of the machine. This had long been known by other users of other wire tying machines. That was not I think a preformed shouldered wire such as contemplated in the application I am here dealing with, but is another matter altogether.

Cary had in the course of a long business career as a producer of various package tying devices, patented many of such articles, and it is strange that if he invented at the time claimed, he should have allowed about three years to pass before he applied for a patent of the wire in question in the United States. Exhibit X 23 is an application for a patent, filed in the United States in February, 1919, by Cary, for a machine for binding shipping packages, and he makes no reference therein to a preformed wire package binder, but only a wire which would be crimped or shouldered by the grippers, after it was put in the machine or tool which would apply the wire to a package. The shouldered wire in question, by itself, was not difficult of description in an application if it then represented a completed invention. The fact is I think, that until Cary had developed a machine specially adapted for the shouldered wire, he did not consider he had completed that which he

1926  
 GERRARD  
 WIRE TYING  
 MACHINES  
 CO., LTD.,  
 OF CANADA  
 v.  
 CARY MFG.  
 Co.  
 Maclean J.

1926  
 GERRARD  
 WIRE TYING  
 MACHINES  
 Co., LTD.,  
 OF CANADA  
 v.  
 CARY MFG.  
 Co.  
 Maclean J.

now calls an invention. In the extract already quoted from his specifications he describes the wire as an article to be used in conjunction with a suitable tool or machine, and that the wire was to be fashioned as described so that it would be held against slipping with respect to the tool or machine. Not having for a long time subsequent any such tool or machine, he no doubt concluded that he had not made anything representing a completed invention and he cast it aside as something about which he had speculated without attaining any practical results. It was I think regarded as nothing more than a suggestion.

Certain correspondence passed between the defendant and the Frank L. Wells Company, of Wisconsin, U.S.A., which reveals matter that does not appear quite consistent with the idea of a completed invention by Cary in 1919, and discloses knowledge by the defendant of a prior user of a shouldered wire in the United States by one of the companies associated with the plaintiff company.

On March 9, 1922, the defendant wrote to the Wells Company asking if they manufactured a machine for straightening wire and cutting it off in certain lengths, to which the latter replied on the 11th day of the same month that the Gerrard Wire Tying Machine Co., of Chicago had in use for that purpose a number of machines in their various plants throughout the country, made by the Wells Company, and which they recommended to the defendant for its purposes.

On March 13 the defendant company wrote to the same firm as follows:—

What we would like to know is whether any of your machines are so arranged that they would put the shoulder on the wire same as Gerrard's is now doing. We do not want you to think for a moment that we are attempting to infringe on any rights of Gerrard. Our Mr. Cary has been in the present line of business for over 30 years and has taken out over 100 patents relating to our line of manufacture both in this country and abroad and would be very loath to tread on any one else's rights.

Then, on March 15, the Wells Company wrote to the defendant company as follows:—

Now we do not know whether the flat spot which is on the wire sample you sent us is patented or not, but we think it is. We had nothing to do with putting these attachments on the machine for flattening this wire. The Gerrard people put the attachments on after they received the machines, and we would suggest that if you were to do this

same thing and find it is not patented, that you also put this device on yourselves, as we would not want to get in wrong with these people by selling machines to someone else with this attachment on them. You will appreciate our position in this matter.

Following this the Cary Manufacturing Company wrote as follows on March 17:—

We note what you say in regard to the attachment for putting the shoulder on the wire and we appreciate very much your position, and certainly would not ask you to do anything that we would not think fair if we were in Gerrard's position.

Another strange circumstance is that in September, 1921, Cary visited the plaintiff's place of business in New York, and while there he states that he then saw one of the plaintiff's wire tying machines, Model B, and that he then learned that the plaintiff was using a shouldered wire as shown in figure 2 of Cary's patent, and also that on this occasion Gerrard personally operated this machine with this form of wire several times in his presence. Cary says he was surprised to find the plaintiff using a shouldered wire of this character on this occasion. He consulted his attorney and apparently the only thing decided upon was an investigation into the prior art in other countries, but nothing was done apparently by Cary in assertion of his alleged rights in the invention. There was apparently some talk between them about some of their respective tying machines infringing one another. Early in 1922 Cary visited the plaintiff's Chicago factory at the latter's request. While there he saw wire bundles which he assumed to be notched wire, and he was shown a large machine which was notching the wire. In this paragraph and in the other parts, for the sake of convenience and clarity, I refer to the American corporations, apparently controlled by Gerrard, as part of the plaintiff company's organization, which strictly speaking is not accurate, as the plaintiff company herein is solely a Canadian corporation, but all are controlled by the same persons so far as I know.

I do not refer to Cary's visit to the plaintiff's plant nor to the correspondence with the Wells Company for the purpose of supporting the conclusion that the evidence of Cary, as to the date when the several wires in exhibit X 11 were made is in error. The plaintiff suggests that the wires in this exhibit were made at a much later date

1926

GERRARD  
WIRE TYING  
MACHINES  
CO., LTD.,  
OF CANADA

v.  
CARY MFG.  
Co.

Maclean J.



1926  
 GERRARD  
 WIRE TYING  
 MACHINES  
 Co., LTD.,  
 OF CANADA  
 v.  
 CARY MFG.  
 Co.  
 Maclean J.

than claimed. I do not think it is necessary to make any specific finding upon this point in the view I take of the case. By agreement the evidence of Cary, now deceased, taken in interference proceedings in the United States, was read into the record at the trial and if this decision comes under review by others, they will be in just as good a position as I am to draw conclusions from that testimony. Expert evidence was given on behalf of both parties as to the probable age of these wires. The plaintiff's witness in this regard was in direct conflict with those produced by the defendant. I propose disregarding the whole of it. I do not think any safe conclusion can be drawn from this particular piece of evidence one way or the other.

While the means of applying the wire to packages, such as wire tying machines, is not here in issue, still it must be taken into consideration, and may be looked to for evidentiary purposes. A specially shouldered wire, without a machine or tool designed to accommodate such a shouldered wire would I think lack utility, and Cary had not developed or procured a machine or means to use his wire for a long time after Gerrard and Wright had filed their application in the United States in April, 1920. As utility is a requisite of invention, Cary can hardly be said to have invented anything until a mode of application had been united with the idea of an end so as to produce useful results. That is to say there must be an idea of means as distinguished from an idea of object or end. The conception of a bare wire with a shoulder, with no conception of means or mode of application is not I think an invention any more than the hands for a clock would be invention without the invention of the clock itself, and I do not think it would. If I am correct in this view, then Cary was never an inventor of the wire at the time claimed, and probably it was only after he saw that the plaintiff was winning a place in the market with its wire that he came to look upon it in any other light himself. In 1919, it is safe to assume that Cary could not have described his alleged invention, because he had not sufficiently thought out a means of application, and a thing which cannot be described cannot possibly be invention. Both

parties were in search of a special wire, and a special wire tying machine adopted for this wire which would sell together, the one being the complement of the other, the customer for the machine perforce becoming a customer for the wire and vice versa, each thus hoping to establish a closed trade in their combined wire and machine. I therefore am of the opinion that Cary did not invent in 1919 as claimed. At the most he had merely a suggestion or incomplete conception.

Upon another ground Cary cannot I think, even assuming he did all he claims to have done early in 1919, be held to be the first inventor. Mr. Anglin very ably and ingenuously put forward the contention that a person who conceives an invention, and who is in a position if and when he chooses to produce a physical embodiment of his mental conception, is in law an inventor in this country. Mr. Anglin of course conceded that such a person might have great difficulty in establishing his invention by satisfactory evidence, but in this case he thought that difficulty had been overcome by Cary on the facts already related. This calls for some discussion as the contention is often advanced here. I cannot accept Mr. Anglin's proposition, as expressing the law, even with the evidence of the alleged inventor as to the conception being accepted as proven, nor can I agree that a "physical embodiment" of the conception, which was never disclosed would void the patent of a subsequent inventor who had first and effectively disclosed his invention. It must be conceded I think, without qualification, that a mere conception of anything claimed to be an invention, that is concealed and never disclosed or published, is not an invention that would invalidate a patent granted to a subsequent inventor. To say that mere conception is invention or that a first inventor in the popular sense who has not communicated or published his invention is entitled to priority over a later invention accompanied by publication, and for which a patent was granted, or applied for, would I think throw this branch of our jurisprudence into such utter confusion as to render the law of little practical value owing to uncertainty. If this is the policy and meaning of the Patent Act, an inventor might safely withhold from the public

1926  
 GERRARD  
 WIRE TYING  
 MACHINES  
 Co., LTD.,  
 OF CANADA  
 v.  
 CARY MFG.  
 Co.  
 Maclean J.

1926

GERRARD  
WIRE TYING  
MACHINES  
Co., LTD.,  
OF CANADA  
v.  
CARY MFG.  
Co.  
Maclean J.

his invention for years, while another independent but subsequent inventor of the same thing, who had secured or applied for a patent, and who had proceeded to manufacture and sell his invention without any knowledge of the undisclosed invention, would always be in danger if the prior inventor could secure a patent by merely proving an unpublished invention. The situation should not I think be changed by the production of drawings, plans, etc., evidencing the date of the prior invention, or even a physical embodiment of the invention by the alleged inventor. All this might be done and still be within the knowledge of the inventor alone, it having been kept a secret, and which so far as the public is concerned is no more effective publication than a mere conception uncommunicated to the public. There must be a publication or a use in public of a satisfactory kind in order to bar the claim of a subsequent inventor who discloses the same and first applies for a patent. The latter act is not perhaps necessary. What is publication is a question of fact, and each case must depend upon its own circumstances. In this case Cary did not give the public his invention by any recognized form of publication. The knowledge, whatever its nature or extent, which came to the employees of Cary was not publication because they were each under an obligation of secrecy arising from their confidential relations towards him, and Cary says he kept the wires he claims to have made in 1919 in a drawer in his desk where they were kept until interference proceedings were started in the United States in 1922. Accepting the statement of Cary as to the date of his alleged invention, about three years elapsed before he made any disclosure of his invention.

It seems to me that the first inventor must and should mean in patent law, not the first discoverer or the first to conceive, but the first publisher, and publication is always a question of fact. That person must, however, be a true inventor, that is he must not have borrowed it from anyone else. This principle was laid down in Great Britain by the courts there as early as 1776, and is there still accepted as expressing the law. In the case where a person who was first granted a patent was not in popular

language the first inventor because somebody had invented it before him, but had not taken out a patent for it, it has been decided that the former was entitled to a grant provided the invention of the first inventor had been kept secret, or without being actually kept a secret had not been made known in such a way as to become part of the common knowledge or of the public stock of information. Therefore, the person who was in law held to be the first and true inventor was not so in popular language because one or more people had invented before him, but had not sufficiently disclosed it. *Plympton v. Malcolmson*, Jessel M.R. (1); *Dollonds Patent* (2); *Cornish v. Keene* (3); *Smith v. Davidson* (4); *Robertson v. Purdy* (5) *ex parte* Henry (6). While these general principles may be subject to qualification, depending upon the facts involved in any particular case, it seems to me they should be applied in this case.

The decisions to which I have just referred, I apprehend, proceed upon the principle that until disclosure, or an application for a patent is made, a person cannot be heard to say he is an inventor as against one who first discloses his invention and applies for a patent; and also upon the principle that the consideration which the patentee gives for the monopoly granted by the patent, is that he first gave the invention to the public. The latter ground is well stated in *Smith v. Davidson* already cited by the Lord President of the Court:—

When a patent is validly granted, that is, is held in law to be a valid patent, then I think that the party who obtains the patent is held to be the owner of that invention disclosed in the Letters Patent. It is held in law to be his invention, a monopoly of it is given to him as being his invention because he is the party who has given to the public that invention. He has given to the public under the condition that he shall obtain a monopoly and so it comes to be his invention in that sense. The discovery is not the thing the public have an interest in. What they have an interest in is that they shall have the benefit of that invention. A party may live and die taking the knowledge of his invention with him, but disclosure of invention and the means by which he obtains a monopoly of it from the public, and the party who comes

1926  
 GERRARD  
 WIRE TYING  
 MACHINES  
 Co., LTD.,  
 OF CANADA  
 v.  
 CARY MFG.  
 Co.  
 Maclean J.

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| (1) [1876] 3 Ch. Div. 531, at pp. 555, 556. | (4) [1857] 19 Court of Sessions 691 at p. 698 (2nd Series). |
| (2) [1766] 1 W.P.C. 43.                     | (5) [1906] 24 R.P.C. 273 at p. 290.                         |
| (3) [1835] 1 W.P.C. 501.                    | (6) [1872] 8 Chan. App. 167.                                |

1926  
 GERRARD  
 WIRE TYING  
 MACHINES  
 Co., LTD.,  
 OF CANADA  
 v.  
 CARY MFG.  
 Co.  
 Maclean J.

forth and complies with that condition being himself the true inventor, gets the right to the monopoly of that invention. It becomes his invention in law.

In *ex parte Henry* already cited, Lord Selborne in discussing this point, said:—

I apprehend that it would be no answer to a *bona fide* applicant for a patent, who has himself, by his own ingenuity made a useful invention, and has applied for a patent before any one else claiming to have made the same invention—it would I say, be no answer to him, assuming the absence of fraud or communication, to allege that experiments had been going on, or even drawings made, by another inventor. One person, being a *bona fide* inventor comes first to ask for a patent for his invention and such allegations are no answer to him. If a patent be granted to him, it would date from the day of his application. If he were the true inventor, the circumstance of something having taken place somewhere else, which was not disclosed to the world, and as to which no prior application was made, would be no answer to him, even if it were shewn that the two inventors were travelling very much upon the same lines, and that their minds were going very much to the same point at the same time.

I observe nothing in our Patent Act which warrants the inference that there can be but one inventor of the same thing, and that a patent can issue only to a first inventor. The invention of a subsequent but true inventor is still “new” if the other has not been published; in fact it is the only invention to which the term “new” can be strictly applied. A thing, undisclosed and unknown except to the mind of an inventor, can hardly be described as “new and useful art.” It is in fact not “new” because not being known it cannot be compared with any pre-existing art, and it is “useless” because it is unknown, and it therefore should not be a bar to one who has disclosed or published in some way, or to one who comes forward and says he has something new and describes it in writing and asks for a patent. The Act says any person who has invented a new and useful article may apply for and obtain a patent upon compliance with the terms of the Act. The applicant must be an inventor, you need not say the inventor, because someone else may have invented it and concealed it. I know of no authority however, directly upon the point under discussion, in our law reports. In *Smith v. Goldie* (1) so often referred to here in cases of this kind, there was no question as between a first and a

(1) [1883] 9 S.C.R. p. 46.

subsequent inventor; there was only one inventor, Smith, and others were attempting to make piratical use of his invention. In the *Queen v. Laforce* (1), another frequently cited case, the facts are quite distinguishable from the facts disclosed in this case, and a comparative study of these cases would be hardly profitable or useful.

Upon the trial reference was made to many American decisions. There, many statutory provisions prevail which are not to be found in our Patent Act. It seems to me, however, that the law as interpreted by the courts of the United States is in effect the same as here as applied to the facts of this case. In a recent case, *Millburn Co. v. Davis-Bourninville Co.* (2), Mr. Justice Holmes in rendering the judgment of the Supreme Court of the United States, and in discussing the statutory defence that the "patentee was not the original and first inventor or discoverer of any material and substantial part of the thing patented" observed:—

Taking these words in their natural sense as they would be read by the common man, obviously one is not the first inventor, if, as was the case here, somebody else has made a complete and adequate description of the thing claimed before the earliest moment to which the alleged inventor can carry his invention back. But the words cannot be taken quite so simply. In view of the gain to the public, that the patent laws mean to secure, we assume for purposes of decision that it would have been no bar to Whitford's patent (the subsequent applicant) if Clifford had written out his prior description and kept it in his portfolio uncommunicated to anyone.

It is really the last few lines of this citation to which I wish to refer as to the effect in law of an uncommunicated invention as against a subsequent inventor and patentee, and which would appear to conform to the principles laid down in the decisions of the courts of Great Britain which I have cited. The real point of decision however in the case was that a description in a patent application was publication even if there was no claim for the thing described.

Again I would refer to the American case of *Mason v. Hepburn* (3). Hepburn's date of invention was confined to his date of application, April 3, 1894. Mason conceived of the invention and made a complete drawing of it on

1926  
 GERRARD  
 WIRE TYING  
 MACHINES  
 Co., LTD.,  
 OF CANADA  
 v.  
 CARY MFG.  
 Co.  
 —  
 Maclean J.  
 —

(1) [1894] 4 Ex. C.R. p. 14.

(2) [1926] 46 S.C. Rep. 324 (U.S.)

(3) [1898] Decisions of Com. of Pat. 510.

1926  
 GERRARD  
 WIRE TYING  
 MACHINES  
 Co., LTD.,  
 OF CANADA  
 v.  
 CARY MFG.  
 Co.  
 Maclean J.

June 28, 1887. He reduced the invention to practice soon after. The device was then stored away in the model room of his company and it was not produced until the institution of interference proceedings. No devices of the kind were manufactured for any purpose, and no exhibit of the device was made to the public, and no one saw it except Mason and one or two other employees of his company. It was held by the Court of Appeals of the District of Columbia that Mason had abandoned his invention and priority was awarded to Hepburn. An American text writer says that this opinion has since been favourably cited in one hundred and twenty-two cases in the United States. In the reasons for judgment, the court made the following observation:—

Considering, then this paramount interest of the public in its bearing upon the question as presented here, we think it imperatively demands that a subsequent inventor in a new and useful manufacture or improvement, who had diligently pursued his labours to the procurement of a patent in good faith and without any knowledge of the preceding discovery of another shall, as against that other, who has deliberately concealed the knowledge of his invention from the public, be regarded as the real inventor and as such entitled to his reward.

The learned judge of that court, rendering the decision, further observed that in some of the decisions in the United States, the first inventor is regarded as having abandoned the field to other inventors, while in other cases he is held to have lost his right by sleeping too long upon it. After stating that abandonment after the completion of an inventive act, more strictly speaking, applies to the case where the right of the public to the use is involved, and not to the case where the contention is between rival claimants merely of the monopoly, he proceeds to say:—

The true ground of the doctrine, we apprehend lies in the spirit and policy of the patent laws and in the nature of the equity that arises in favour of him who gives the public the benefit of the knowledge of his invention who expends his time, labour, and money in discovering, perfecting, and patenting in perfect good faith that which he and all others have been led to believe has never been discovered by reason of the indifference, supineness, or wilful act of one who may, in fact, have discovered it long before.

An interesting discussion of the doctrine of abandonment is to be found in Robinson on Patents, Vol. 1, pages 509, 510 and 511, Vol. 2, p. 159 et seq, and particularly

in the notes to be found on these pages. The author there discusses the question of abandonment, which rule he states rests upon the principle of equitable estoppel, and he states that abandonment in fact may be inferred from unreasonable delay in patenting the invention or from any other circumstances which render the inventor chargeable with bad faith towards the public or voluntary negligence in the assertion of his rights. Whether or not I correctly apprehend the state of the law in the United States upon the point under discussion, it seems to me that the principles laid down in the authorities I have just referred to are sound and quite applicable here.

In the United States by some means or other not necessary to discuss here, Cary was the first to secure his patent, although his application was about two years subsequent to that of Gerrard and Wright. In fact I understand the plaintiff's application has not yet been dealt with owing to interference proceedings being taken and still outstanding, and perhaps something should be said upon this fact. I do not propose resting my decision upon the ground that an application for a patent is in law a publication, and that the plaintiff is entitled to priority in the grant of a patent by reason of such prior application. It is not necessary that I should do so in this case, and the point was not discussed during the trial. In this country an application until dealt with is not open to public inspection, but it at least should have as a matter of proof as to priority of invention, as much effect as a caveat filed under the statute. In the judgment of the Supreme Court of the United States, *Millburn Co. v. David-Bourninville Co.* already cited, Mr. Justice Holmes would appear to have there held that the application of the first applicant for a patent was a publication as against a subsequent applicant though the former had not claimed the thing described. I need not, however, now trouble myself upon this point, as in the case before me there was publication by use and sale in public on the part of the plaintiff long before Cary applied for a patent, and I need not enlarge upon this.

Invention without publication, in my opinion, is of no effect as against another inventor who discloses the invention and who applied for a patent. Whether this rule

1926  
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 MACHINES  
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 OF CANADA  
 v.  
 CARY MFG.  
 Co.  
 Maclean J.



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rests upon the principle of estoppel or laches, or for want of consideration for the monopoly inherent in a patent, or whether it is a rule of evidence which presumes against invention in law when undisclosed, it seems to me to matter little. It is a safe rule to follow. It imposes no hardship or injustice upon any person, it appears well within the letter and spirit of the statute and seems to have the support of weighty authority. It is a bar to the fabrication of evidence and other objectionable practices, and will render assurance to many whose position ought to be secure.

There is another point to which I must briefly refer. Mr. Anglin contended that there was not joint invention by Gerrard and Wright of the invention claimed by the plaintiff because an important part of the invention claimed was made by one of them only, and that the claim to joint invention in fact failing the application for a patent cannot in law be considered. The evidence satisfies me that both Gerrard and Wright had constantly been conferring together on the development of the shouldered wire and the appropriate machine with which to use it. I think the proper view in this connection is well stated in Walker on Patents, 5th Ed. at Sec. 46, which is as follows:—

Nor is a patent to joint inventors invalidated by the fact that one of them only first perceived the crude form of the elements and the possibility of their adaption to complete the result desired. In fact the conception of the entire device may be attributed to one, but if the other makes suggestions of practical value, which assist in working out the main idea and making it operative, or contributes an independent part of the entire invention which helps to create the whole, he is a joint inventor even though his contribution be of minor importance.

I am of the opinion that Gerrard and Wright contributed jointly to the development of the wire for which a patent is now claimed, and that the several contributions, whatever the degree, cannot be assigned to any particular claim in the patent, but to the whole of them. I think therefore this contention fails.

My finding is, that as between the parties before me, the plaintiff's assignors were the first to invent. The plaintiff will have its costs of action.

*Judgment accordingly.*