

Between:

ROBERT PRESTON MOODIE,.....PLAINTIFF;

1916

April 19.

AND

THE CANADIAN WESTINGHOUSE }  
COMPANY, LIMITED, } DEFENDANT.

*Patent for invention—Infringement—Strict Construction—Discretion of Court to discriminate between claims as to validity.*

In an action for the infringement of a patent for electric toasters, it appeared that the plaintiff's patent contained five separate claims. At the opening of the trial the first claim was abandoned, and the case confined to infringement of the balance of the claims.

*Held*, that the patent was one requiring strict construction, and that as an element specifically claimed by the patentee as essential to his invention was omitted from defendant's machine, there was no infringement.

*Quaere*: Whether where three out of five claims are held void the Court should discriminate and sustain the patent under the remaining claims?

THIS was an action for the infringement of a patent of an electric toaster.

The facts of the case are stated in the reasons for judgment.

The case was now heard at Ottawa before the Honourable Mr. JUSTICE CASSELS, April 10th, 11th, 12th and 13th, 1916.

*R. S. Smart* (with whom was *H. Fisher*) for plaintiff, contended that the Court should look at the patent to see whether plaintiff covered the invention, and whether the invention, as he patented it, covers the defendant's patent.

The defendant has a bar which is equivalent to plaintiff's. That is the real crux of the case as far as claim 2 is concerned. The defendant has taken the

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U-shaped frame and projected the top of the frame upwardly a distance above the bar. If these wires were kept in position in some way, there would be no reason why he should not raise the top, the horizontal portion of the U-shaped frame upwardly, and if he does that he infringes the structure of the defendant (1).

When the plaintiff claims the base and plate and makes no disclosure in the drawings, it must be understood that what he has made is the kind of base and plate he means. We rely on *Ide v. Trorlicht, Duncher & Renard Carpet Co.*(2) and *Adam v. Folger*(3), in which a very narrow claim was construed.

[BY THE COURT: Suppose your patent is narrowed down to a very strict construction patent, what then could you establish that the defendant infringes?]

If you narrow it down, there is only four words in claim 2 that you have to leave out in order to have that claim covered in the defendant's structure, but those words only relate to the position of the bar and not to its function.

[BY THE COURT: You do not claim any new function for any of your elements. You claim a better method of obtaining a result which was well known.]

The drawings are explanatory of the specification but you cannot enlarge them.(4).

The fourth claim covers the heating element, which is wound on plates of suitable material.

[BY THE COURT: There is nothing at all in that claim so far as I can see except that method of winding the

(1) *Incandescent Gas Light Company v. De Mare Incandescent Gas Light System, Limited*, 13 R.P.C. 330; *Consolidated Car Heating Company v. Came* (1903) A.C. 509; *Proctor v. Bennis*, 36 Ch. D., 740; *Clark v. Adie*, L.R. 2 App. Cas. 315; *Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U. S., 405; *Miller v. Eagle Manufacturing Co.*, 151 U.S. 186; and *National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 Fed. Rep. 693.  
 (2) 115 Fed. Rep., 137;  
 (3) 120 Fed. Rep. p. 260.  
 (4) *Johnson v. Oxford Knitting Co.*, 15 Ex. C.R., 340, *Walmsley v. Eastern Hat and Cap Company*, 43 N. S. R. 432.

wire on the mica plate. It is a curious thing, supposing the fifth claim were bad, what is the effect on the rest of your patent?]

There is section 33 of *The Patent Act* which permits you to distinguish between the good and the bad. The plaintiff is entitled to have a fair and beneficial construction applied to the specification.

Now the fourth claim covers the completed winding. The heating elements are wound on plates of suitable material. The winding being in the form of a double helix and the claim describes the manner in which it is wound, although that may be regarded, not so much as a description of the manner it is wound, as a description of the element itself.

The question of the effect of an invalid claim comes under section 29 of *The Patent Act*, see *Copeland-Chatterton Co. v. Hatton* (1). It is a question of costs only.

In any case the ambiguity introduced into the specification must be specific for the purpose of misleading the public.

There is one recent English case, a very narrow construction patent, in which a reasonable range of equivalent was allowed. *Estler v. Adjustable Shelving and Metal Construction Co., Ltd.* (2).

On the question of clerical errors and misleading statements of the patentee, see the case of *Short v. Federation Brand Salmon Canning Co.* (3).

*A. W. Anglin*, for the defendants, contended that the plaintiff had not satisfied his obligation in respect of manufacture. It does not seem to have ever been determined that non-manufacture of one claim of the patent will entail avoidance of all the claims of the patent because the Court has not, in that case,

(1) 10 Ex. C.R., p. 224.

(2) 32 R.P.C., 501.

(3) 7 B.C.R. 197.

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a power to discriminate. But he submitted that under the Act no such power to discriminate is given in a case of the avoidance of a claim, by reason of non-compliance with the provisions of the Act as to manufacture.

I do not think it will be necessary to decide it here. I propose taking up claim one which has been dropped from the case so far as any endeavor to hold us under that claim is concerned. I do not want it out of the case for other purposes. I propose arguing very shortly, however, that there has been non-manufacture here in the case of every claim of the patent.

Referring to claim one, I want to direct attention first, to the fact, that it is not in words, but in substance identical with claims four and five, except that in four and five there is the addition of what I may refer to as the method element or process element, which has been hitched on to the claim. Claim one, under which nothing is sought against us, is identical in substance with four and five, if you leave out of consideration the question of winding.

Now the absence of those toast supporting wires from claim one, and the absence of any specific description of them or terms dealing with them in the wording of the claim, leaves it open to the patentee under that claim, to do something which, when he comes to his actual construction, he cannot do.

When he comes to claim 2, he introduces for the first time his toast supporting wires, then it is no longer possible for him to say that the tops of the heating elements are suitably secured to the horizontal portion of the frame and he does not do it, and the reason will be quite obvious on looking at his construction.

Now, that being so, I say he has never manufactured that claim. The only construction he has ever made was produced under the construction of Exhibit 2, in which the heating elements are not secure to the horizontal portion of the frame and insulated therefrom.

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Claims two and three are subsidiary, or more limited claims, or more peculiarly construction claims than claim one, and the limitations are of course, what my learned friend relies on to give validity to two and three as against one which he has concluded to be invalid and which, of course, is invalid.

Now, when he comes to the claim we are dealing with, claim 2, he says, towards the close, that the wires for supporting the toast, the lower ends are sprung into holes in the base; and, I say, that having regard to his specification, the base must mean the metallic surrounding portion and cannot be at all events, whatever else it may be, the insulating plate. His only actual construction is the construction of Exhibit 2. In Exhibit 2 the wires are, in fact, inserted not in the base but in the insulating plate.

In claim 3 it is even more emphatic a case than in claim 2, that his wires, in order to be constructed according to the claim, must be sprung into the base as he defines, viz., the metallic portion and not into the insulated plate.

He has wound his wires around the insulating plate and he has secured the insulating plate to his cross-bar and he has secured the cross-bar by means of a screw to the horizontal portion of the U-shaped frame so that in these claims he is further away than ever from manufacture.

The plaintiff never used the process of winding he claimed.

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Then the whole patent is void because of what is disclosed by the specifications in claims 4 and 5, and the Patent Office record or file wrapper. And I submit, further, that the case is not one that the Court either can or should exercise its discretion and discriminate to save the other claim.

Mr. *Smart* replied.

CASSELS, J., now (19th April, 1916) delivered judgment.

This was an action brought by Robert Preston Moodie against the Canadian Westinghouse Company, Limited, claiming that the defendants have infringed certain letters patent granted to the plaintiff, bearing date the 11th of March, 1913.

The case came on for trial before me on Monday, the 10th April, instant, and the three following days.

During the progress of the trial I had an opportunity of becoming familiar with the different questions that were raised, and I think it better while the matter is fresh in my mind to give judgment and avoid any extra expense to the parties of having a transcription of the evidence.

The patent in question, of the 11th March, 1913, contains five separate claims. The plaintiff sued in respect of all of these claims. At the opening of the trial, plaintiff's counsel stated that they did not intend to proceed upon the first claim, and the plaintiff's case was confined to the 2nd, 3rd, 4th and 5th claims, all of which claims, he alleges, had been infringed by the defendant.

I am of the opinion that the 1st, 4th and 5th claims are invalid claims for reasons which I will give later.

If the 2nd and 3rd claims can be upheld, they can only be upheld as very strict construction claims,

and, I am of opinion that so construed the defendants do not infringe either of these claims.

I propose to deal with the construction of the patent in the way pointed out in the case of *Edison-Bell Phonograph Corporation v. Smith*, quoted in a judgment of my own in *Johnson v. The Oxford Knitting Co.* (1).

According to the evidence produced before me showing the state of the art, numerous electric toasters had been on the market prior to the alleged invention of the plaintiff Moodie. Taking up the specification of the patent, the patentee claims to have invented certain new and useful improvements in electric toasters, and he declares that the following is a full, clear and *exact* description of the same. He alleges that his invention consists of "a suitable base, a plate "of insulating material, an inverted U-shaped frame, "having rectangular upper corners, the said frame "being secured at its lower ends to the base, heating "elements secured at the top to the horizontal bar "of the frame, and at the bottom by means of the "wires of the heating elements, extending through "holes in the aforesaid plate, a bar having cross "slots in its upper surface designed to be secured "to the cross bar of the frame, and inverted V-shaped "wires of the like, having upper ends extending "through the aforesaid slots in the bar, and being "provided with outwardly extending projections "near their lower ends designed to serve as rests for "the toast, the lower ends of the said wires or the "like being sprung into suitable holes in the plate "of insulating material secured to the aforesaid base."

He then refers in detail to the drawings and he describes in detail the bar which is suitably secured

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(1) 15 Ex. C.R. 342.

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to the horizontal portion of the frame. This bar has cross slots on the upper surface. He proceeds to point out that No. 6 of the drawing are wires of inverted U-shape. The apex 6a being designed to be held in the cross slots. He shows outwardly extending projections formed near the lower ends of the wires designed to form rests for the toast. The lower ends of the wires being designed to be sprung into holes in the insulating plate.

He then proceeds to describe the wires of the heating elements stating that they extended down through holes in the plate. The plates 2 of the heating elements have apertures 2x extending through the same near the top, and also toothed side edges 2y. And he goes on and describes the manner in which the wires are wound, as follows:—"The upwardly wound wires of the heating elements fit into spaces between alternate teeth at the side edges, and at the top extend through the apertures 2x in the plates 2, and are then wound down the plate in the opposite direction to the direction in which they are wound up, and fit into the spaces between the teeth 2y left by the upwardly wound wire."

This method of winding the wire was apparently adopted by the patentee at the instance of one of the examiners in the patent office, in order to avoid a previous patent referred to in the letter. According to the evidence, it is a method which is useless compared to the proper method of winding the wire and a method which the patentee himself in his evidence points out was never used by him. In his specifications, however, he has expressly laid stress upon that method of winding. The defendants, in the toaster manufactured by them, never adopted that method of winding.



According to the evidence the method of winding described in the specifications is old, having been disclosed in the art,—and in fact the prior art discloses both the process of winding claimed by the plaintiff, and also the method of winding adopted by the defendant. The evidence before me also shows that the double helical winding is not as useful as the single helical one.

Now, turning from the specifications to the claim. In his first claim the patentee claims an electric toaster comprising (1) a base; (2) heating elements and a frame of inverted U-shaped extending longitudinally to the base—the lower ends of the frame being suitably secured to the base—the tops of the heating elements being suitably secured to the horizontal portion of the frame and insulated therefrom.

There is no claim in regard to the method of affixing and holding in position the wires used for the support of the bread to be toasted.

Having regard to the productions as to the prior art, this claim is absolutely void. It is forestalled by several of the productions of toasters in existence prior to the alleged invention of the patentee. He lays no stress in this claim to any particular kind of heating elements. There is no provision for the toasting wires, an essential feature of a toaster,—no claim for any particular method of holding these wires in position.

I am of opinion that this claim is bad. If it be a valid claim without the other elements which are requisite to a valid combination, every element is shown in the prior art in combination.

No. 4 claim is practically the same claim as No. 1, except that it describes the specific method of winding the wire as described in his specification,

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namely the wire at the top of the heating element extending through an aperture in the insulating plate in the opposite direction to the direction in which it is wound up. That method of winding has never been adopted by the defendant. It is shown in the prior art. It is also shown that it is a useless method of winding compared to the one used in practice both by the patentee and the defendant. Placing what is practically a useless element into what is claimed by the first claim of the patent does not, in my opinion, make it a valid claim. If it did the defendant has never used the heating element wound in the manner described by the patentee.

The 5th claim is the same, except he introduces into the plates around which the wire is wound two side edges. These edges form a guide as well as preventing the wires slipping.

Both of these claims in my opinion are met by the prior art, and if in point of fact they could be upheld, the defendant does not use them. In my opinion both of these claims are invalid for lack of patentable invention or utility, and in any event neither of them does the defendant infringe. The patentee has deliberately described the particular method of winding so as to avoid if possible the prior art, and at the instance of the patent examiner. The specification was amended in order to cover the suggestion of the examiner, and the patentee is now confronted with a patent prior to his invention, disclosing the exact method of winding, so that he has inserted an element into claim "1" which is old and practically useless as compared with the method of winding both adopted by the patentee in the manufacture of his toaster and the defendant.

Turning to the 2nd and 3rd claims, in my opinion, having regard to the prior art referred to by Mr. Beam in his evidence, and exhibited to me by means of previous patents, previous models of toasters in use and on the market and the catalogues showing toasters, all of which were known and described prior to the alleged invention, the only manner in which the patent could be upheld is by construing these two claims, numbers 2 and 3, as strict construction claims, and, in my opinion, they are neither of them infringed by the defendant.

The second claim is for "an electric toaster comprising a base, heating elements, a frame of inverted U-shape having rectangular upper corners and extending longitudinally of the base, a bar secured to the horizontal portion of the inverted U-shaped frame, said bar having depending tongues, and cross slots in its upper surface, the upper portion of the heating elements being designed to be secured to the said tongues, the ends of the wires thereof extending through holes in the base, wires bent into inverted V-shape, and having outwardly extending projections for supporting the toast, the lower ends of the wire being sprung into holes in the base."

This word "sprung" is an error in the language. The ends of the wires for supporting the toast are all according to the plaintiff's evidence formed by a bender.

The ends of the wire are pushed into the holes in the base. In point of fact they are not pressed into the base, but into the insulating material. The wires are placed in these holes to prevent any lateral movement, but these holes form no support to the wires themselves. The wires are held in place by the bar which is described as being secured to the

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horizontal portion of the inverted U-shape frame. This bar has as indicated cross slots. Into the slots the wire fits so that when fastened in place to the horizontal portion of the U-shape frame, it forms a close connection. To my mind, this method of construction is an essential feature of the plaintiff's claim. The defendant's toaster does not contain this bar. The wire supporting the toast in the defendant's is held from a lateral motion by a notch and obtains its rigidity by the particular method of fastening shown in the toaster by means of passing the ends of the wires through the insulated part of the base. I think it is quite obvious, if construing the plaintiff's patent in the way in which it has to be construed, as a strictly construction patent, there is no infringement.

I have had occasion to deal with these questions in *Barnett-McQueen Co., Ltd. v. Canadian Stewart Co., Ltd.* (1). In the Privy Council case of *The Consolidated Car Heating Co. v. Came* (2), it was held the defendant did not infringe, where an element specifically claimed by the patentee as an essential element was omitted from defendant's machine. This element of the bar with the slots was admitted by the plaintiff's counsel to be an essential element.

The first claim of the patent being void, the whole patent falls to the ground unless the provisions of the Patent Act, Cap. 69, R.S. of Canada, 1906, sections 2 and 33, which permits the court to discriminate are invoked.

Arguments were addressed to me by the counsel for both parties,—on behalf of the plaintiff that the provisions of these sections should be invoked,—on the part of the defendants that under the circum-

(1) 153 Ex. C.R. 186.

(2) (1903) A.C. 509.

stances disclosed the Court should not discriminate. As I have come to the conclusion that the defendants do not infringe the second and third claims of the patent, I do not consider it necessary to determine this question. There is no decision in our courts, as far as I know, placing a construction upon these sections, and deciding in what class of cases the court should exercise its discretion, and I prefer to reserve my views until a case arises in which it is necessary to give a decision.

In the case of *Johnson v. The Oxford Knitting Co.*, to which I have previously referred, I followed the precedent set by the Privy Council and did not pass upon the validity or non-validity of the patent as a whole, coming to the conclusion as I did that there was no infringement.

The action is dismissed with costs to be paid by the plaintiff to the defendants.

*Judgment accordingly.*

Solicitors for the plaintiff: *Fetherstonhaugh & Smart.*

Solicitors for the defendant: *Blake, Lash, Anglin & Cassels.*

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