

BETWEEN:

INTERNATIONAL VEHICULAR }
 PARKING LIMITED..... }

PLAINTIFF;

AND

MI-CO METER (CANADA) LTD., }
 THE MUNICIPAL CORPORA- }
 TION OF THE CITY OF GUELPH }

DEFENDANTS.

1947
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 Sept. 9, 10,
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 Nov. 19
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Patent—Infringement—Patent for improvements in parking meters—Lack of invention—Subject matter—Prior art—Utility—Improved method of attaining old object is not invention.

The action is one for infringement by defendants of plaintiff's patent. The invention claimed by plaintiff relates to improvements in or relating to parking meters. The main object of the invention was to overcome the tendency in some meters for the violation signal to indicate a violation before the paid-for predetermined time had in fact elapsed. The defendants denied infringement and questioned the validity of plaintiff's patent.

The Court found that the alleged invention disclosed in plaintiff's patent is merely an improved mode of attaining an old object, it being a mere mechanical device which solved no engineering problem and required no exercise of the inventive faculty to achieve its object which was accomplished by merely a skilled application of tools and well understood processes in the art. Plaintiff's patent was therefore invalid as lacking subject matter and there could be no infringement.

Held: That a mere workshop improvement does not constitute invention.

2. That since plaintiff's alleged invention is merely a different method of achieving a result already known in the art defendants could infringe plaintiff's patent only by making use of the particular method described or by means substantially the same.

ACTION by plaintiff to have it declared that Canadian Patent No. 395,164 owned by it is valid and has been infringed by defendants.

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

S. S. McInnes, K.C. and *G. E. Maybee* for plaintiff.

E. G. Gowling, K.C. and *Andre Forget* for defendants.

The facts and questions of law raised are stated in the reasons for judgment.

1948

INTERNATIONAL
VEHICULAR
PARKING
LIMITED
v.
MI-CO
METER
(CANADA)
LIMITED
ET AL.

Cameron J.

CAMERON J. now (November 19, 1948) delivered the following judgment:

This is an action for infringement. The plaintiff is a company incorporated under the laws of the State of Delaware. The first-named defendant is a company incorporated under the laws of the Dominion of Canada with its head office in Montreal. The other defendant is a municipal corporation in Ontario.

The plaintiff is the owner of Canadian Patent No. 395,164 and alleges that its patent has been infringed: (a) by Mi-Co Meter (Canada) Limited, by making, using and vending to others to be used, and licensing or leasing to others to be used, apparatus embodying the invention claimed in the said patent; and (b) by the other defendant by using apparatus made by and purchased from its co-defendant and embodying the invention claimed in said patent.

Both defendants admit the issue of the patent to the plaintiff but deny infringement, allege that the patent is invalid for reasons that will later be referred to, and ask that the patent be declared invalid. Notice of Infringement, dated September 30, 1946, is admitted by the first defendant.

Application for the plaintiff's patent is dated June 2, 1937, and was made by William Noll Woodruff, Charles Alfred Toce and William Foy Herschede. It was filed on June 17, 1937, together with an assignment to Vehicular Parking Limited. The patent issued to the plaintiff on March 11, 1941, an assignment to it from Vehicular Parking Limited, having been filed prior to the grant. In the application priority was claimed as of November 24, 1936, the date of filing the application in the United States Patent Office; but in these proceedings the plaintiff gave notice that it proposed to rely on November 1, 1935, as the date of invention, and the defendants do not challenge the claim of the plaintiff to rely on that date. For the sake of brevity the plaintiff's patent will hereafter be called the "Woodruff" patent.

Exhibit (1) is the plaintiff's patent. Exhibit (3) is a sample of the parking meter admittedly manufactured and sold by the first defendant in Canada, and leased and used by the second defendant and other municipalities.

It will be convenient to consider first the attack made by the defendants on the validity of the plaintiff's patent. If that patent be found invalid the action for infringement must fail.

Woodruff and his associates were not the first inventors of parking meters. In the specification the Woodruff invention is called "improvements in or relating to parking meters." The following are the opening clauses of the specification which show that parking meters were known and in use prior to Woodruff and also indicate the objects of the improvements later set out.

This application relates in general to time measuring apparatus, and more particularly to that type of apparatus designed for measuring the time which a vehicle remains parked in a given location.

Great difficulty has been encountered from time to time in regulating the parking on the city streets, and in other locations, and various means have been devised for regulating this practice in such a manner that the public would derive the greatest benefit from the parking space available, and would not unduly hamper traffic. *One means of controlling the parking of vehicles has been to provide a meter or time keeper which will indicate to a passer-by upon a mere casual inspection the length of time which has elapsed since a vehicle was parked in the space controlled by said device.*

It is an object of this invention to provide a device of this general character which will eliminate the difficulties encountered by and inherent in previous means for this purpose.

It is a more specific object of this invention to provide a device which will indicate at a glance whether or not a given period which has been paid for has expired, and which will show on inspection within certain limits the length of time which has expired beyond the period within which parking is allowed.

It is a further object to provide a device of the character set forth in which when the device is to be reset before the initial period has expired, a signal will be operated to indicate that the time period has expired, and this signal will not be rendered inoperative until the resetting operation is complete.

It is a further object of this invention to provide a device of the character set forth with a signal adapted to indicate that the allowable parking period has expired, and to eliminate the necessity in such a device for a latch or catch mechanism to hold such signal in inoperative position until the time has expired.

One other object of this invention is to provide a device of the character described which will give a readily perceptible visual indication of whether or not the time has expired, and will give this indication at night as well as in daylight.

Another object is to provide a device which will give an accurate indication of the passage of time after the allowed parking period has expired, as well as prior thereto.

1948
 INTERNATIONAL
 VEHICULAR
 PARKING
 LIMITED
 v.
 MI-CO
 METER
 (CANADA)
 LIMITED
 ET AL.
 Cameron J.

1948
 INTERNATIONAL
 VEHICULAR
 PARKING
 LIMITED
 v.
 MI-CO
 METER
 (CANADA)
 LIMITED
 ET AL.

Another object is to provide a separate scale upon which overtime parking is indicated, and to provide for the automatic replacement of the regular time scale by such separate scale upon the expiration of the allowed parking period.

Other objects and advantages of this invention will become apparent from the following description taken in connection with the accompanying drawings, it being understood that the embodiment set forth in said description and drawings is by way of illustration and example only, and not by way of limitation. This invention is to be limited only by the prior art and by the terms of the appended claims.

Cameron J.

The recital by the plaintiff in its specifications that parking meters were actually in use is, of course, binding on the plaintiff (Terrell on Patents, 8th ed., p. 138). In further proof that Woodruff and his associates were not the first inventors of parking meters, the defendants produced the August 1935 issue of "The American City." (Exhibit E). On page 61 thereof there are photographs establishing that parking meters having a dial and timing mechanism were known prior to the date of the plaintiff's invention.

The plaintiff relies only on Claims 5, 6, 7 and 8, as follows:

5. In a timing apparatus, means for indicating the passage of time, a mechanism for setting said indicating means at a predetermined starting point, signalling means for signalling the expiration of a predetermined period of time following said setting operations, means constantly urging said signalling means away from signalling position, and means controlled by said indicating means for overpowering said last-mentioned means to move said signalling means to signalling position when said predetermined time has expired.

6. In a timing apparatus, means for indicating the passage of time, a mechanism for setting said indicating means at a predetermined starting point, signalling means for signalling the expiration of a predetermined period of time following said setting operation, means for normally urging said signalling means away from signalling position, and means controlled by said first means for overpowering said last-mentioned means toward signalling position when said predetermined time has expired.

7. In a timing apparatus, means for indicating the passage of time, a mechanism for setting said indicating means at a predetermined starting point, signalling means movable to signal the expiration of a predetermined period of time following said setting operation, and means controlled by said first means for moving said signalling means toward signalling position when said predetermined time has expired.

8. In a timing apparatus, means for counting the passage of time, means for causing said counting means to start the counting of a predetermined period of time, signalling means movable to signal the expiration of said predetermined period of time, and means controlled by said first means for moving said signalling means toward signalling position when said predetermined time has expired.

The elements in these claims may be enumerated as follows: (1) a timing apparatus; (2) means for indicating the passage of time; (3) a mechanism for setting said indicating means at a predetermined starting point; (4) signalling means for signalling the expiration of a predetermined period of time following said setting operation; (5) means constantly (or normally) urging the said signalling means away from a signalling position and means controlled by said first means for overpowering said last-mentioned means to move said signalling means towards signalling position when said predetermined time has expired; (6) a signalling means movable to signalling the expiration of a predetermined period of time following said setting operation; (7) means for counting the passage of time.

J. H. Joynt—a Patent Attorney practising in Washington, U.S.A., and a witness for the plaintiff—alleges that the defendant's meter incorporates each of the said seven elements.

The defendants, however, allege that in Woodruff's patent there was no invention having regard to the common knowledge in the art and because of the prior knowledge of the applicants named in the patents referred to, and that the specification and claims in the latter completely anticipated all the claims in the plaintiff's patent, and, alternatively, that if there is any subject-matter in the plaintiff's patent, they have not infringed it.

The defendants refer first to Exhibit B, a patent issued to Carl C. Magee by the United States Patent Office on May 5, 1936, as No. 2,039,544, and which was filed December 21, 1932, for a "parking meter". An examination of this patent discloses that it includes the elements of a timing apparatus, a means for indicating the passage of time, a lever for setting the meter at a predetermined starting point, signalling means for signalling the expiration of a predetermined period of time following said setting operation, signalling means movable to signal the expiration of a predetermined period of time following said setting operation, and means for counting the passage of time.

The one remaining element in which the plaintiff's claims differ somewhat from those in the Magee patent is in regard to the violation signal. In the Magee patent above referred

1948
 INTERNATIONAL
 VEHICULAR
 PARKING
 LIMITED
 v.
 MI-CO
 METER
 (CANADA)
 LIMITED
 ET AL.
 Cameron J.

1948

INTERNATIONAL
VEHICULAR
PARKING
LIMITED
v.
MILCO
METER
(CANADA)
LIMITED
ET AL.

Cameron J.

to there is a flag or violation signal to indicate when the predetermined time has expired. Magee contemplated that his violation signal would always be urged into signalling position. His method is described as follows:

In order that an officer may tell at a glance if a car is parked overtime, a flag or arm 56 is located exteriorly of the housing adjacent the top of the end 7 thereof. The arm 56 is rigidly keyed to the protruding end of a shaft 57 which is mounted for rotation in the housing ends 7 and 8. The shaft 57 is urged by a spring 58 to normally hold said arm 56 in an upright position so that it may be seen above the housing from all directions.

The following described mechanism is provided for the purpose of holding the arm 56 in a horizontal position below the top of the housing until the predetermined parking time limit has been reached and for then automatically releasing the arm to the action of said spring 58. At a point in alignment with the previously described small sheave 43 the shaft 57 is equipped with a similar sheave 59 which is keyed or otherwise firmly attached thereto. A cable 60 is connected firmly between the two sheaves 43 and 59 so that when the shaft 36 is partially rotated by use of the lever arm 30, the shaft 57 is likewise partially rotated. This partial rotation brings the free end of a rod 61 which is rigidly attached at its other end to said shaft 57, into engagement with a latch or retaining mechanism carried by the upper surface of the side 17 of said frame 15. This latch mechanism is best illustrated in Fig. 5, and consists substantially of bell-crank 62 pivotally mounted upon a pin 63 and urged to rotate through substantially one-fourth of a complete circle by a spring, not shown, but which is similar in action to said spring 58 on said shaft 57. A pivotally mounted latch 64 is provided for engaging one arm of the bell-crank 62 when the rod 61 forces it past the latch. When the latch engages the bell-crank, the rod 61 is held against movement by the other arm of the bell-crank. A pin 65 carried by the adjacent face of the sheave 38 is adapted to contact the free end of the latch 64, and release the bell-crank 62 when the sheave reaches the end of its partial rotation. When the bell-crank is released, the rod 61 is consequently released, and the spring 58 is then free to partially rotate said shaft 57, and thus return the flag 56 to its upright position. *Other desired mechanism may be provided for giving the visual signal.*

When this Magee meter was in operation the violation signal was in a horizontal position, but at the expiry of the predetermined time it was automatically brought to a vertical position above the housing by the action of a spring. The violation signal was constantly being urged into signalling position by a spring, the action of which was restrained by a latch or catch until it was released to action upon the expiry of the predetermined period of time in the manner above mentioned.

It was stated by Mr. Joynt that this type of violation signal was defective in that when the meter was jarred there was a tendency for the latch to release the spring to action with the result that the violation signal would spring into

view and indicate that the predetermined time had expired, although such was not the case. As stated in Woodruff's specification, therefore, one of the objects of his invention was to eliminate the necessity for a latch or catch mechanism to hold such signal in inoperative position until the time had expired.

In the Woodruff meter the scale is vertical and at the left side of the meter. Until the coin is placed in the slot and the starting level fully rotated and released, the violation signal completely covers the scale and is itself in view through the window in the meter. When the starting operation has been completed and the starting handle fully released, the violation signal is carried by a spring away from the scale and into an obscured position at the top of the housing. It is constantly and normally held there by a spring until the expiry of the predetermined period of time, when, by the operation of the indicating means, it is released to the action of another spring and drops into view over the scale. Mr. Joynt described these two operations as follows:

Now, the handle is released to act under the force of its spring 20. Notice that as it comes back it is fairly easy to move. Now, the ratchet arrangement is no longer in contact because the coin has fallen out and it permits this brass plate, that includes studs 33, 32 and 72 to fall back out of alignment with these various pieces that they contacted before. On the continued return, stud 32 now comes in contact to release the latch which has been holding this signal 52 down. It releases latch 56 to permit the signal to fly up under the pull of its spring 54. Now, the meter is placed into operation. Signal 52 is withdrawn from view. The indicator 42 is exposed and it starts its timing operation . . . the red violation signal is obscured and it is constantly being held in this obscured position. If you shake it, it will go right back up again. There is a spring force, the force of spring 54 keeps that in an obscured position.

That control or lease is had when the indicating means 42 as driven by the clock mechanism and this shaft 38 which is integral with the clock mechanism and the indicating means, reaches the point 60, for example, on the timing dial 9 in fig. 1, and in Exhibit 4 it is the ten-minute count. When the indicating means reaches that particular point, it is the back end, 41, as seen in fig. 7, for example, it is the back end, 41, which contacts the cam surface 66 and releases the catch 62 as shown in figs. 8 and 9, for example, which had been holding arm 60 against the action of the spring 61. When your time indicating means trips that latch then the arm 60 acting under the force of spring 61 is rotated in a counter clockwise direction as seen in the drawings and pulls the signal into view. This pulling serving to stretch or extend the spring 54 which is connected to the signal means and which normally holds the signalling means up.

1948

INTERNATIONAL
VEHICULAR
PARKING
LIMITED
v.
MI-Co
METER
(CANADA)
LIMITED
ET AL.

Cameron J.

1948
 {
 INTERNA-
 TIONAL
 VEHICULAR
 PARKING
 LIMITED
 v.
 MI-Co
 METER
 (CANADA)
 LIMITED
 ET AL.
 —
 Cameron J.
 —

In so far, therefore, as claims 5, 6, 7 and 8 are concerned, Woodruff's improvement over the first Magee patent consisted in changing the means by which the violation signal was controlled. Instead of using a spring which normally and constantly urged the violation signal into the signalling position (the action of which was restrained by a latch or catch until the predetermined time had elapsed) as set forth in Magee, he made use of a spring which operated in the reverse direction and which constantly or normally urged the violation signal *out* of signalling position until the expiration of the predetermined period of time, thus eliminating the necessity of a latch or catch to keep the violation signal out of signalling position.

For the defendant it is contended that this is nothing more than a workshop or mechanical improvement. The plaintiff, while frankly admitting that there would be no serious engineering problem involved in making the change, contends it was the conception of the idea of the improvement that was important, and that that, and the method provided for carrying it into effect, constituted invention. The question for consideration, therefore, is whether that which Woodruff did in so reversing Magee constitutes a patentable invention. Is there sufficient subject matter to support the plaintiff's patent? Or, on the other hand, having regard to what was known or used prior to the date of the patent, was the invention obvious and one that did not involve any inventive step?

It is clear, I think, that the improvement so made was a simple one. The evidence is that to actually make the change required no skill beyond that of a mechanic. Mere simplicity, however, will not prevent there being invention. As stated in *Terrell on Patents*, 8th Edition, p. 67:—

A mere scintilla of invention is sufficient, especially where the appreciation of a desideratum is one of the important features of the invention, and there may be invention in what is merely simplification. But matters of ordinary skilled designing or mere workshop improvements cannot be considered as requiring the exercise of invention.

Reference may usefully be made to *Longbottom v. Shaw*, (1) where, in giving judgment in the House of Lords, Lord Herschell stated at p. 336:—

If it were shown that the defects which this apparatus is designed to remedy, or does remedy, were defects which had been felt, and the knowledge of which had come to the public so that there was a demand for a

1948
 {
 INTERNATIONAL
 VEHICULAR
 PARKING
 LIMITED
 v.
 MI-CO
 METER
 (CANADA)
 LIMITED
 ET AL.

 Cameron J.

new apparatus which did not possess those defects, and if it were shown that that demand had lasted for a considerable time, so that men's minds were likely to have been engaged upon a mode of remedying those defects, and they were not remedied until the apparatus was devised for which the patent is taken out, no doubt that would have afforded considerable evidence that the adaptation or arrangement of the patentee was not obvious, inasmuch as you would then have a demand for some considerable time not met although known, and the fact that it was not met for a considerable time though known would indicate that the mode by which it was ultimately met could not have been so obvious as otherwise might have been supposed. Therefore, in that way, the demand for an improved article might become a very material circumstance. But it appears to me that the elements which would make it very material are altogether wanting in the present case. We have here no evidence that the defects, though they existed, seriously pressed upon those who used this apparatus, and that they had indicated a desire for a machine which was free from those defects. There is no evidence that men's minds had been applied to the removal of these defects, which in some cases has been thought a very material circumstance . . . But nothing of that sort appears here. We have no history of the manner in which this invention came about.

And, at p. 337:—

But when we are coming to enquire into the question whether there really is an invention in any case, or whether it is merely such an adaptation as would be obvious to anyone whose mind addressed itself to the subject, then the absence of any such evidence as I have indicated of either experiment or investigation or thought on the part of the patentee, or evidence that the mind of anybody else had been addressed to the subject, or that there had been attempts to remedy the defects by other methods—I say the absence of such evidence appears to me to justify one in resting upon the opinion which one has formed that there is in this case no invention at all. I quite agree that it is always easy to say a thing is obvious when it has been pointed out. I fully feel the force of that argument and the danger of hastily arriving at such a conclusion; and, as I have said, if I saw that although the minds of mechanics had been directed to meeting a certain want, and various methods of doing so had been devised, those mechanics had not arrived at the simple and the efficient one at which the patentee had arrived, I should be disposed to put aside my own view of the obviousness of the so-called invention and to come to the conclusion, notwithstanding my own impression on the subject, that those facts indicated that it was not so obvious as I myself should have thought. But in this case nothing of that sort is really to be found in the evidence, and therefore it appears to me that no more is shown than an adaptation of the well-known idea of utilizing a row of hooks attached to or forming part of a band of metal by applying them as they are required, the adaptation in the particular case being in a well-known manner, for a well-known purpose, and not involving, as it appears to me, any invention which can support a patent.

Reference may be made also to *Leonard's Perfect Skill Control Co. Ltd. v. John Henry Holloway et al* (1), and to *Deutsche Nahmaschinen Fabrik vorm Wertheim v. Pfaff* (2).

(1) (1929) 46 R.P.C. 353. (2) (1890) 7 R.P.C. 251.

1948
 }
 INTERNA-
 TIONAL
 VEHICULAR
 PARKING
 LIMITED
 v.
 MI-Co
 METER
 (CANADA)
 LIMITED
 ET AL.

 CAMERON J.

In the case of *Non-Drip Measure Co. Ltd. v. Strangers Ltd. and others* (1), Lord Russell of Killowen, at p. 143, referred with approval to the case of *Samuel Parkes & Co. Ltd. v. Cocker Brothers Ltd.* (2), in which Tomlin J. at p. 248 said:—

Nobody, however, has told me, and I do not suppose anybody ever will tell me, what is the precise characteristic or quality, the presence of which distinguishes invention from a workshop improvement . . . the truth is that, when once it has been found, as I find here, that the problem had waited solution for many years, and that the device is in fact novel and superior to what had gone before, and has been widely used, and used in preference to alternative devices, it is, I think, practically impossible to say that there is not present that scintilla of invention necessary to support the Patent.

Now what are the circumstances here? The art of parking meters was quite new, having commenced, as Mr. Joynt stated, in 1935, just a few months prior to the date of the Woodruff invention. There is no evidence that knowledge of the defect in the Magee type of meter—if, in fact it be a defect—had lasted for any considerable length of time or that men's minds had been engaged upon a mode of remedying that defect. There is no evidence that the defect, although it may have existed, seriously pressed upon those who used the apparatus or that they indicated a desire for a meter which was free of those defects. Further, there is no evidence that the Magee meter was commercially unsuccessful, or that the Woodruff meter, with the improvement, was a commercial success over the Magee meter. No new result was obtained by the Woodruff meter over Magee so far as the violation signal was concerned, although the "invention" was possibly a better way of securing the same result. Magee and others had previously conceived the idea of using a violation signal.

In my opinion, as soon as it became known to those skilled in the art of parking meters that jarring of the Magee meter could at times cause the signal to indicate a violation before the expiry of the predetermined time, it was quite obvious that such a defect was caused by the spring urging the signal *into* view. The remedy also was obvious, namely, to use a spring which would normally and constantly urge the violation signal out of view. Springs, and the use of springs, to raise or lower objects, to urge

(1) (1943) 60 R.P.C. 135.

(2) (1929) 46 R.P.C. 241.

them in any direction, were well-known. In my view, therefore, having regard to what was known and used prior to the date of this patent, no exercise of the inventive faculty was required to reverse Magee, and to conceive the idea of using a spring which would constantly and normally hold the violation signal *out* of view. And, as I have pointed out, the witness for the plaintiff states very frankly that there was no engineering problem involved in providing the mechanical means for carrying the idea into effect. The answer to the problem would at once jump to the mind of a mechanic. It was not merely obvious that the improvement could be done, but it was also obvious to do it.

In my opinion, there was here no invention but merely a skilled application of tools and well understood processes. I do not think it required any study or thought to arrive at the plaintiff's method of controlling the violation signal. Any ordinary skilled workman setting his mind to accomplish that object could have come to the same result. What was done by Woodruff did not, I think, involve that degree of ingenuity which must have been the result of thought and experiment. I find that there was here no invention, or at least insufficient invention to support the plaintiff's patent. It lacks subject-matter and therefore I must find that the plaintiff's patent is invalid.

The defendants also refer to a second Magee patent No. 2118318, filed in the United States Patent Office on May 13, 1935, and which issued on May 24, 1938. It was filed prior to the date of the Woodruff invention but issued after the Woodruff application was filed. The corresponding Magee patent was applied for in Canada on January 16, 1936, and issued as No. 390,658 on August 13, 1940. As previously stated the Woodruff patent was applied for in Canada on June 17, 1937, and issued on March 11, 1941.

I do not need to say much about this second Magee patent. It was filed in the United States Patent Office prior to the date of the Woodruff invention and contained all the elements in the first Magee patent which I have outlined above. The main difference, I think, is in the flag or violation signal. It has no separate violation signal, but the scale itself is the signal. It disappears from view

1948
 INTERNATIONAL
 VEHICULAR
 PARKING
 LIMITED
 v.
 MI-Co
 METER
 (CANADA)
 LIMITED
 ET AL.

 Cameron J.

1948

INTERNATIONAL
VEHICULAR
PARKING
LIMITED
v.
M1-Co
METER
(CANADA)
LIMITED
ET AL.

Cameron J.

when the predetermined time is up, thus indicating that the paid-for time has elapsed. It discloses all the essential elements claimed by the plaintiff which are here in issue and is, therefore, again a complete anticipation of the patent in suit.

Counsel for the defendant also attacked the validity of the plaintiff's patent on the ground of a certain disclaimer filed in the United States Patent Office. The application by Woodruff and his associates for the United States patent corresponding to the Canadian patent in suit was filed on November 24, 1936, and issued to patent on June 13, 1939, as No. 2162191, Exhibit A being a certified copy thereof, which contains also a copy of the disclaimer filed by Woodruff, Toce and Herschede and also by their assignee, Vehicular Parking Limited, to Claim 1 of the patent as issued to them. The disclaimer is dated September 27, 1940, and was filed October 4, 1940. It is admitted that Claim 3 of the Canadian patent corresponds to the original Claim 1 of the United States patent which is as follows:—

In a timing apparatus, means for indicating the passage of time comprising a dial and a hand moveable over said dial, means for setting said hand at a predetermined starting point with respect to said dial, and a signalling means connected to said first means and operable upon the expiration of a predetermined period of time following said setting operation, said signalling means including a shield adapted to move to a position between said hand and said dial.

Mr. Joynt stated that he was responsible for the preparation and filing of the disclaimer and that it resulted from certain interference proceedings which culminated in a concession of priority by both sides; he also admitted that the reason for filing such disclaimer was that the applicants for the patent were not the inventors of the subject-matter referred to in Claim 1. No similar disclaimer was filed in Canada.

I agree, however, with counsel for the plaintiff that such disclaimer is of no importance so far as the present litigation is concerned. The disclaimer, as mentioned above, was made by the inventors and Vehicular Parking Limited. The plaintiff was not a party to the disclaimer. And before the date of the disclaimer, namely on August 29, 1939, Vehicular Parking Limited, then the owners of the application for the Canadian patent which had been assigned to

them by Woodruff and his associates, had further assigned all its rights in that application to the plaintiff company. A disclaimer is effective only as to the persons filing it. Notwithstanding the statement by Mr. Joynt that the reason for filing the disclaimer was that Woodruff was not the inventor of the claims in Claim 1 of the United States patent, I do not believe that he is a competent witness on that point in these proceedings. In any event, the present plaintiff, not being a party to the disclaimer, is not here bound by it inasmuch as a grantor cannot derogate from his grant.

1948
 INTERNATIONAL
 VEHICULAR
 PARKING
 LIMITED
 v.
 MI-CO
 METER
 (CANADA)
 LIMITED
 ET AL.
 Cameron J.

Having found that the plaintiff's patent is invalid, it follows that there can be no infringement by the defendants. I think it advisable, however, to consider briefly the question of infringement in order that all the issues may be determined.

I do not think it is necessary to examine in great detail each element of the plaintiff's claims. The essence of the "invention" is, I think, in the method of controlling the violation signal by providing that it is normally and constantly urged out of signalling position rather than into signalling position. In the specification the invention is referred to as "improvements in or relating to parking meters". The evidence indicates that the main difficulty encountered in previous meters was a tendency for the violation signal to spring into view and indicate a violation before the paid-for predetermined time had in fact elapsed, and it was the main object to Woodruff's invention to overcome this difficulty. Taking into consideration the evidence as to the prior art, it must be found that if there were any subject-matter in the plaintiff's patent it could be only the means for controlling the violation signal.

This is not the kind of invention which consists in the discovery of a method of application of a new principle. If it were, the Court would regard jealously any other method embodying that principle because the inventor was not bound to describe every method by which his invention could be carried into effect. Here no new result was obtained, but merely a different and possibly better method of achieving the same result as had been previously obtained. It is merely an improved mode of attaining an

1948
 INTERNATIONAL
 VEHICULAR
 PARKING
 LIMITED
 v.
 MI-Co
 METER
 (CANADA)
 LIMITED
 ET AL.
 Cameron J.

old object and the monopoly is for that particular improvement, and the defendants would only be held to have infringed if they had made use of that particular method. (Terrell—p. 153).

Reference may be made to *Young v. Morris and Bastert* (1). In the Court of Appeal Rigby, L.J. gave a dissenting judgment in which it was held that, assuming, but without deciding, that the application of the old appliance to hoists was good subject-matter, that there was no infringement, as the plaintiff's invention was not a pioneer invention but only a new combination producing an old result, and the plaintiffs must therefore be confined to their particular method.

At p. 213 Rigby, L.J. said:

In my judgment, it cannot be denied that the plaintiffs' machine, when properly understood, is essentially different from the Defendants'. If the Plaintiffs had been the first who, by the application of the inventive faculty, had produced machinery calculated to operate by way of raising, and also by graduated and safe lowering, they might have had a better case. They were not the first, and can only claim for what is substantially set out and described in their Specification.

The judgment of Rigby, L.J. was upheld in the House of Lords, 12 R.P.C. 455.

Reference may also be made to *Nettlefolds Ltd. v. Reynolds* (2). In that case the Court of Appeal held, affirming the judgment at the trial, that the plaintiff's claim was confined to circular dies and even if it had not been so confined, the defendants' die differed more from the plaintiff's die than that did from earlier dies, and that there was therefore no infringement.

In that case Kay L.J. stated at p. 299:

The case in my opinion comes within the decision in *Curtis v. Platt*, 3 Ch. D. page 135. I quote from the judgment in that case the following passage which applies closely to the facts which I have been considering, "Where the thing is wholly novel, and one that has never been achieved before, the machine itself which is invented necessarily contains a great amount of novelty in all its parts, and one looks very narrowly and very jealously upon any other machines for effecting the same object to see whether or not they are merely colourable contrivances for evading that which has been before done. When the object itself is one which is not new, but the means only are new, one is not inclined to say that a person who invents a particular means of doing something that has been known to all the world long before, has a right to extend very largely the interpretation of these means which he has adopted for carrying it into effect.

(1) (1895) 12 R.P.C. 200.

(2) (1892) 9 R.P.C. 270.

Because, otherwise that would be to say that the whole world is to be precluded from achieving some desirable and well known object which everybody has had in view for years. In such a case, it may be said that the means taken are simply mechanical equivalents for the means previously adopted for arriving at the same object. One looks more jealously at the claims of inventors, seeking to limit the rights of the public at large, for effecting that which has been commonly known to all the world long ago. Of course, no patent can be taken out for effecting this as a new object, but only effecting it by a new means."

1948
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 INTERNATIONAL
 VEHICULAR
 PARKING
 LIMITED
 v.
 M-I-Co
 METER
 (CANADA)
 LIMITED
 ET AL.

—
 Cameron J.
 —

I have previously described the means used by Woodruff for controlling the violation signal. The signal is carried away from a scale into an obscured position by means of a spring. There it is constantly and normally held by the action of the spring until the expiry of the predetermined time when by the operation of the indicating means it is released to the action of another and stronger spring and drops into view over the scale. The signal is held in view until the setting operation is completed and the starting handle fully released and returned to its original position. It is held out of view until the paid-for predetermined time has elapsed when it drops into view.

The defendants' means of operating the violation signal are quite different. The signal starts to disappear when the re-setting operation is commenced and completely disappears when it is set back a few minutes, and therefore it does not remain visible during the entire setting operation as does the plaintiff's. Springs are not used in controlling the signal. The means for constantly urging the signal out of view are the weight of the violation signal itself and the weight of two parallel levers or arms pivoted to an extension of the frame plate and attached at the extreme left ends to the violation signal by means of pivots. The means used for over-powering the weight of these members and to bring the signal into view is the indicating means or pointer. A downward extension or hook forming part of the indicating means, shortly before the expiry of the predetermined time, engages a pin or projection attached to the extremity of the parallel bars supporting the violation signal, and as the indicating means approaches zero on the dial it forces the violation signal gradually into view, and it is fully in view when the indicating means has reached the zero point on the dial. While, therefore, it must be

1948
 INTERNATIONAL
 VEHICULAR
 PARKING
 LIMITED
 v.
 MI-Co
 METER
 (CANADA)
 LIMITED
 ET AL.
 ———
 Cameron J.

found that the defendant's meter has means for constantly and normally urging the violation signal out of view and means controlled by said indicating means for overpowering the said last-mentioned means to move said signalling means to said signalling position (as set forth in the plaintiff's claim), the mechanism used by the defendants is essentially different from the mechanism which is particularly illustrated and described in Woodruff's specification. That this is so was frankly admitted by Joynt. In Woodruff's specification there is no suggestion whatever about the use of counter balances and weights to control the violation signal. If the plaintiff's patent were valid, its monopoly would in this case be limited to the particular mode described. The defendants would infringe the plaintiff's monopoly only by making use of the particular mode described or by means substantially the same. I find that they have not done so, and the claim for infringement therefore fails and is dismissed.

In the result, therefore, the plaintiff's action for infringement will be dismissed and there will be a declaration that the plaintiff's patent No. 395,164, dated March 11, 1941, is invalid.

The defendants normally would be entitled to their full costs. However, at the trial the defendants asked leave to amend their particulars of objections by adding thereto a reference to United States patent No. 2,118,318 and the corresponding Canadian Patent No. 390,658, as well as the publication entitled "The American City," of August 1935, all of which had been omitted therefrom in error. Counsel for the plaintiff consented, it being agreed, however, that if counsel for the plaintiff were thereby taken by surprise and that if I felt that the addition of these matters were important to the case, the defendants would be penalized in costs to such extent as I felt proper. Under all the circumstances, therefore, I award the defendants one-half of their taxed costs.

Judgment accordingly.
