

PAUL BERGEON PLAINTIFF;

AND

DE KERMOR ELECTRIC HEATING }
CO., LTD. } DEFENDANT.

1927
Jan. 5.
May 5.

*Patents—Impeachment—Reissue—Commissioner of Patents—Jurisdiction
—Improvement*

1. *Held*, That in granting a reissue the Commissioner's jurisdiction was limited to the grounds set out in sec. 24 of the Patent Act; and where the Commissioner had granted a reissue for more than what was claimed in the original patent, and where there was no inadvertence,

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- accident or mistake in respect of the issuance of the original patent, his decision to grant a reissue may be reviewed by the Court. (*Auer Incandescent Light v. O'Brien* (1897) 5 Ex. C.R. 243) distinguished.]
2. That anything disclosed in the specifications of a patent of invention and for which no claim is made becomes *publici juris*.
 3. That a patentee in a patent for an improvement on a known device, must not throw his net so wide as to omit to honestly disclose what belongs to the prior art as distinct from his new claim.
 4. That the adaptation of old contrivances or devices of a similar nature to a new or similar purpose, especially to the same class of articles, performing an old well known function, did not amount to or constitute invention.
 5. That the mere applying of well known things in a manner or to a purpose which is analogous to the manner in or to which it had been previously applied, did not amount to invention.
 6. That a patent covering generally any and every means or method for producing a given result cannot be upheld. There cannot be two patents; one to cover the method and the other the apparatus.

ACTION to impeach four patents of the defendant.

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

R. S. Smart, K.C., for plaintiff.

R. V. Sinclair, K.C., for defendant.

The facts are stated in the reasons for judgment.

AUDETTE J., now this 5th day of May, 1927, delivered judgment.

This is an action to annul, cancel and set aside four Canadian patents of invention, namely:

Exhibit 17: Letters Patent No. 228,931 issued, on the 20th February, 1923, to Louis G. DeKermor, purporting to be a reissue of Patent No. 141,290, dated 18th June, 1912, to Leslie E. A. Kelso (Exhibit 21), who assigned to the said De Kermor, through assignee Matthews, the patent being "for certain new and useful improvements in Electric Heaters."

Exhibit 18: Canadian Patent No. 217,100 granted to Louis G. De Kermor, on the 21st March, 1922, for a certain new and useful improvement in "Method of Regulation of heat generated by electricity."

Exhibit 19: Canadian Patent No. 217,101 granted to Louis G. De Kermor, on the 21st March, 1922, for a "self regulating electric steam generator."

Exhibit 20: Canadian Patent No. 217,102 granted to Louis G. De Kermor, on the 21st March, 1922, for "self regulating water heaters."

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All of these patents have been assigned to the defendant company. None of them are pioneer patents; on the contrary they are all narrow patents which should receive strict construction.

The four patents, as is seen by their name or title, are all in respect of electric heaters and are very much interwoven one with another.

I shall, however, deal first with exhibit No. 17 which is the reissue of Kelso's patent (exhibit No. 21) of the 18th June, 1912. It may be stated in a general way, that this device is designed to produce steam by passing an electric current through water by means of electrodes, the water absorbing the current, and when the current passes through the water it vaporizes it into the dome, and the automatic regulation is produced by reason of the increase of the pressure of the steam above, which presses the water down the electrodes, the water rising at the sides, thus varying the amount of current by covering and uncovering the electrodes. In other words, the electric current is proportioned to the degree of immersion of the electrodes.

This reissue was not applied for by the inventor; but by the assignee of a previous assignee under the provisions of sec. 24 of The Patent Act. It was applied for entirely at the suggestion of De Kermor's solicitor, Mr. Caron, who testified as follows in this respect.

Q. Now about the application for a reissue, which resulted in exhibit No. 17, did you suggest that reissue to De Kermor?—A. Yes.

Q. Did you suggest to De Kermor that he should buy the old Kelso patent?—A. I did.

Q. In preparing your application for reissue, adding the additional claims, you were instructed solely by De Kermor?—A. No. Solely by my own suggestion, by my own examination of Kelso and the reading of the specification.

This establishes that it is not De Kermor who believed that Kelso had invented what he claims by the reissue, but it was all the idea of his solicitor, a person of more fertile brain than himself.

Be that as it may, coming to the next stop, we find that in his petition for reissue (Exhibit 40) De Kermor states that he is

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advised that the Kelso patent is deemed defective, or inoperative by means of insufficient description, or specification and the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention.

And he concludes by stating that he is

desirous of obtaining a new patent in accordance with an amended description and specification of the said invention.

Then follows his affidavit that all the allegations of that petition are true: that is that he is advised that it is so.

The affidavit required by sec. 10 of the Patent Act only provides for such an affidavit in case of death when the deponent should state "he verily believes" that his assignor was the inventor. If the claim is for the same invention no oath would, it seems, be required; but when the claim is new would it not seem that a new affidavit would be required—as is required on the application of all patents establishing who is the inventor?

All of this is said to present in sequence the chain of facts leading to the granting of the reissue, which was granted under the provisions of sec. 24 of the Patent Act which reads as follows:

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

2. In the event of the death of the original patentee or his having assigned the patent, a like right shall vest in his assignee or his legal representatives.

3. Such new patent, and the amended description and specification, shall have the same effect in law, on the trial of any action thereafter commenced for any cause subsequently accruing, as if the same had been originally filed in such corrected form before the issue of the original patent.

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

Now, under these circumstances, a reissue was granted. Yet, when comparing the description and specification of Kelso's patent with the description and specification in the reissue, we find that they are word for word the same,—

with the exception of the last paragraph of the Kelso patent which says that "the numerous uses of the heater need not be mentioned," whereas the reissue names some such uses,—without, however, amending or making any change in the description, the specification and the diagram—and yet five new claims are added thereto.

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It is contended that the reissue was wrongly granted—because there is no amended specification or description, and moreover that the five new claims are to be entirely found in the prior art and are not for the "same invention."

Several expert witnesses were heard on both sides and, without making any disparaging observation concerning the defendant's witnesses, I may say that the qualifications to speak with authority upon questions of this kind are clearly in favour of the plaintiff's witnesses. And witnesses Ball and McRae have conclusively established that the five new claims of the reissue belong to the prior art, and Ball has produced as exhibit No. 24 a comparative analysis of the Kelso patent and the reissue claims thereby completing and illustrating his testimony by showing what parts of the reissue belong to the prior art.

It is quite manifest and self-evident that the Kelso Patent was not "defective or inoperative by reason of insufficient description or specification or by reason of the patentee claiming more than he had a right to claim." Kelso in 1912, after fully describing by his specifications his whole device, gave to the public all that was in the specifications which he had not claimed, and he could not 10 years after take it back by his new claims 1 to 5. (Keiper Pioneer Inventions and Pioneer Patents. 73, 74; *Miller v. Brass Co.* (1)). Much more so when what he thus claims by claims 1 to 5 belongs to the prior art. This reissue issued without justification, is nothing but an afterthought and a mere pretence developed by the defendant's solicitor and intended, by an expansion of claims, to sweep into one net all the appliances of the prior art necessary to monopolize a profitable business, and is obnoxious to grave inadvertence in that it had escaped the patentee or his assignee for 10 years. What was omitted in 1912 in the Kelso patent has been dedicated to the public and forms now part of

(1) (1881) 104 U.S. 350

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the prior art. A most unreasonable delay has since elapsed for a reissue. As said in *Miller v. Brass, ubi supra*,

Every independent inventor, every mechanic, every citizen is affected by such delay, and by the issue of a new patent with broader and more comprehensive claim.

Ten years after the issue of the original patent, an attempt is made to cast as broadly as possible everything in the art. The statute must be read in its grammatical and ordinary meaning and there is no justification to misconstrue it in an attempt to save the patent. I fail to see how a reissue could ever have been granted, because no valuable or meritorious statutory reason has been shown for it, and Kelso had nothing to do with the reissue. There is no statutory foundation for it. While the witnesses on behalf of the plaintiff satisfactorily established that fact, I may also cite in a general way,—without reviewing every item of the claims—the admission (at p. 670 of the evidence) by witness Caron, Sr., that it was old to provide a device comprising a casing, electrodes, steam dome, and means permitting the automatic regulation of the contracting water on the electrodes in accordance with steam pressure. Devices of the kind in which steam was produced through the passage of the current between two electrodes in the casing were known prior to Kelso's patent. It was well known in that type of device to cause the steam pressure mechanically and automatically to regulate the active area of the electrodes by the pressure of the steam on the water. In other words there were devices in which when the steam pressure rose the water level automatically went down, and these devices would necessarily have a dome to accumulate the steam. Expansion tanks were a common means of supplying water pressure to any device which required water under pressure, at the time of Kelso. Witness MacRae, at pp. 210 and following, explains the history of the prior art to the time when Kelso made application for his patent.

There is nothing special in the Kelso patent for the removal of air, excepting the opening through which the water is introduced and described as such.

The steam circulating system was a matter of common knowledge, and the removal of the air by vent, or otherwise was not new at the date of the Kelso patent. The

honest disclosure of the prior art must be distinctly shewn from the new claims.

As said by Nicolas, p. 75,—

When the invention is for an improvement (as in this case) the patentee must be careful to claim only the improvement and to state clearly and distinctly of what the improvement consists. He cannot take a well-known existing machine, and, having made some small improvements, place that before the public and say: 'I have made a better machine. There is the sewing machine of so and so; I have improved upon that; that is mine; it is a much better machine than his.' He must distinctly state what is, and lay claim only to his improvement.

See also *Minter v. Mower* (1); *Foxwell v. Bostock* (2); *The King v. Else* (3); *Moore Filter Co. v. Great Boulder Proprietary Gold Mines Ltd.* (4).

The five new claims of the reissue are so comprehensive in terms that they would cover all that has been done before, and therefore do not show any invention. Revel and Gale and other prior patents cover what is claimed by claims 1 to 5, which in addition define in so many words the principle upon which the device works. *Kynoch & Co. Ltd. v. Webb* (5). The reissue cannot stand the ordeal of the prior art in claims 1 to 5.

If the patentee throws his net too wide, the patent will be bad, as said by Lindley L.J. in *Dick v. Ellam's Dupli-cator Co.* (6); per Pollock C.B. in *Crossley v. Potter* (7).

If the defendant has the right to the exclusive use of what is described in his claims 1 to 5 of the reissue, besides having a patent for a principle, he could stop the use of all the previous patents for electric heaters.

A man cannot introduce some variations or improvements, whether patentable or not, into a known apparatus or machine and then claim as his invention the whole apparatus. Roberts On Patents 425.

One cannot claim something new together with the prior art, without discriminating between what is old and what is new, even when the mechanical device is new but the principle is the same. And having regard to the produc-

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| (1) (1837) 6 Ad. & E. 735 at p. 744, 745. | (4) (1921) 38 R.P.C. 239. |
| (2) (1864) 4 de G.J. & S. 298 at p. 313. | (5) (1899) 17 R.P.C. 100. |
| (3) (1785) 1 Webster Pat. Cases 76. | (6) (1900) 17 R.P.C. 196 at p. 202. |
| (7) (1853) Macr. P.C. 240 at pp. 245, 246. | |

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tions of the prior art, the five new claims are forestalled by Revel and others, and De Kermor lays no stress whatsoever in dividing what is old and what is new. *Moodie v. Canadian Westinghouse Co.* (1); Terrell 129.

Moreover, some of the claims of the reissue, such as claims 2 and 5, are nothing but a statement and a claim of the principle upon which all these four patents work. They clearly define the principle. Besides embodying the principle this reissue patent also embodies an assemblage of devices contained in the prior art, performing the same function as they did in the prior art, thereby becoming a mere aggregation. The adaptation of old contrivances or devices of a similar nature to a new or similar purpose, especially to the same class of article, performing an old well-known function, will not amount to or constitute invention. As was said in *Eagle Lock Co. v. Corbin Cabinet Lock Co.* (2):

There is no patentable invention when the peculiar structure necessarily resulted from the fact that the patentee wanted to combine certain old elements, and a person skilled in the art would naturally group the elements in the way this patentee adopted.

Abell v. McPherson (3); *Jordan v. Moore* (4); *Wood v. Raphael* (5); *Pope Appliance Corp. v. Spanish River Pulp & Paper Mills Ltd.* (6); *Northern Shirt Co. v. Clark* (7) abundantly confirm this view.

In the present case the *improvement* claimed consists in a combination which, considering the state of the prior art, discloses no new function or discovery which could, to my mind, amount to invention. There is no sufficient invention in merely applying well known things, in a manner or to a purpose which is analogous to the manner or to the purpose in or to which it has been previously applied. *Nicolas On Patent Law*, 23. *Pope Appliance Corp'n. v. Spanish River Pulp and Paper Mills Ltd.* (*ubi supra*).

In view of the prior art, I am of opinion that not only is there no contrivance or device that is new in the defendant's patent, but that there are no new features in the com-

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| (1) (1916) 16 Ex. C.R. 133. | (4) (1866) L.R. 1 C.P. 624. |
| (2) (1894) 64 Fed. Rep. 789. | (5) (1896) 13 R.P.C. 730. |
| (3) (1870) 17 Gr. 23; 18 Gr. 437. | (6) (1927) Ex. C.R. 28. |
| (7) (1917) 17 Ex. C.R. 273; 57 S.C.R. 607. | |

bination claimed, the same features having been previously shewn in other electric heaters.

The claims must be read and construed in no manner different from the plain import of the terms used. *White v. Dunbar* (1); *Excelsior Needle Co. v. Morse-Keefer Cycle Supply Co.* (2); *McCarty v. Leigh Valley Ry. Co.* (3); *Penfield v. Potts & Co.* (4); *Mast, Foos & Co. v. Dempster Mill Mfg. Co.* (5); *Anderson Foundry & Machine Works v. Potts et al* (6).

Now it is contended on behalf of the defence that the decision of the Commissioner of Patents in granting a re-issue is final and conclusive, resting on the decision of Burbidge J. in *Auer Incandescent Light v. O'Brien* (7). However the present case can obviously be distinguished, because in the Auer Light Case the decision is limited to a case of infringement, and the statute gives specific defences in that respect. *Mahn v. Harwood* (8). Burbidge J., says in the Auer Light Case, dealing with the finality of the Commissioner's decision:

It seems to me that it must at least (be so) in an action for infringement of the reissued patent.

The other decisions in this respect do not go any further and confine the view expressed to an action of infringement. See also *Withrow v. Malcolm* (9).

It is contended, among other things, that defendant uses the same water while the other patents do not, but that has not been claimed by De Kermor and has therefore become *publici juris*.

Commercial success has been claimed. That alone would not make a patent valid. Installations of boilers are also claimed, but the evidence has not established what these installations were, and the attempt to prove it has entirely failed. De Kermor himself testified he could not say if the boilers he referred to as being his were built under his patents. However, pecuniary success has no relation to the question of utility or invention in the Patent Law. *Nicolas On Patents* 18.

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| (1) (1886) 119 U.S. 47. | (6) (1901) 108 Fed. 379. |
| (2) (1900) 101 Fed. 448. | (7) (1897) 5 Ex. C.R. 243 at 286. |
| (3) (1895) 160 U.S. 110. | (8) (1884) 112 U.S. 354 at p. 358. |
| (4) (1903) 126 Fed. 475 at 483. | (9) (1884) 6 O.R. 12. |
| (5) (1897) 82 Fed. 327. | |

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Sec. 24 of the Act provides that a reissue can be granted when the patent is deemed defective and inoperative.

by reason of insufficient description or specification . . . or by reason of the patentee claiming more than he had a right to claim as new . . .

These terms are quite precise and definite.

The reissue was not granted because the patentee claimed more than he should,—quite the contrary, since he thought of adding five new claims thereto. It was not granted because the patent could be

deemed defective and inoperative by reason of insufficient description or specification

because it is in evidence and it appears on the face of the reissue that the original specifications and description in the patent were just the same and therefore just as operative and effective as the reissue. There could not either have been any inadvertence, accident or mistake in taking out the original Kelso patent as established by the evidence, since the only difference between the two consists in the additional claims for new invention. The reissue is not for the same invention as Kelso, since it has five more claims claiming all the prior art to date. Moreover the Act does not provide that a reissue may be granted to allow to add any new claims because it limits the reissue to the “same invention.” Therefore placing the most forced construction upon sec. 24 there can be found no intention to interfere with the jurisdiction of the court in dealing with the impeachment of a patent which is legally bad and should never have been granted, as distinguished from infringement cases as herein before mentioned. A reissue under the present circumstances of this case does not come within the ambit of the statute. There is no provision in the Act which could either authorize or justify the granting of a reissue under the circumstances of this case. It was null and void *ab initio*.

If it is contended that the reissue was granted upon the statement that the patent was deemed defective and inoperative, etc., the answer is that it is obvious there was no material upon which the discretion of the Commissioner of Patents could be exercised—since he reissued the patent with the identical specification. Walker On Patents, 3rd ed., 289. There was no actual error when issuing the original Kelso. Therefore the Commissioner did not exer-

cise his discretion, since the application for reissue did not come within the cases provided by the statute. The case, as I have said, does not come within the statute. The Commissioner had an inadequate appreciation of the circumstances of the case, and his finding is so erroneous, so contrary to law and to the provisions of the statute, that it must be considered as if there was no finding at all. *Robins v. National Trust* (1). The Commissioner of Patents was given jurisdiction to grant a reissue only in the cases provided for by the statute,—the present case does not come within the ambit of the statute,—therefore the Commissioner had no jurisdiction to grant a reissue under the circumstances of the present case. It was the result of the patent solicitor's design and an acquiescence on the part of the Commissioner of Patents. Indeed it would be outrageous to think that in such a case when the Commissioner is acting beyond the provisions of the statute, that the court would be deprived of its jurisdiction to pass upon the rights of a party aggrieved thereby and upon the validity of a patent, and allow an unlawful patent to prevail against other meritorious patents which are good and valid. This was not the intention of the legislator or of Parliament when this section 24 became the law of Canada. *Ubi jus ibi remedium.*

When a patent fully and clearly, without ambiguity, describes and claims a specific invention, complete in itself, so that it cannot be said to be inoperative or invalid by reason of a defective or insufficient specification, a reissue cannot be had for the purpose of expanding and generalizing the claims so as to make it embrace an invention other than the one specified in the original. *Rogers on Patents*, vol. 2, 1083.

A reissue cannot be attended with such injurious results as would follow from the enlargement of the claim. The reissue must be for the same invention. *Idem* 1087, 1097, 1111.

The broadening of claims is to be condemned. A simple invention of a distinct device, as in *Kelso*, cannot by a reissue, be expanded into a number of all embracing claims by a wide generalization of language embodying the prior

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art, such as Revel and others. Macomber 2nd ed., 791. A reissue can only be granted for the same invention and the defendant had no legal right to insert in their reissue five new claims for five new inventions, especially as they all belonged to the prior art. *Parker & Whipple Co. v. Yale Clock Co.* (1). The case of *Manufacturing Company v. Corbin* (2) lays down that reissued letters patent are void, if they embrace a broader claim than that for which the original letters patent were issued.

The broadening of claims voids the patent. *Ives v. Sargent* (3); *Newton v. Furst & Bradley Co.* (4); *McMurray v. Mallory* (5); *Miller v. Brass Co.* (*ubi supra*); *White v. Dunbar* (*ubi supra*).

As said in the case of *Wing v. Anthony* (6),

It is quite clear that the original patent covers a mechanism to accomplish a specific result and that the reissued Patent covers the process by which the result is attained, without regard to the mechanism used to accomplish it. The reissue is, therefore, much broader than the original patent, and covers every mechanism which can be contrived to carry on the process.

The reissue being for a different invention from that described in the original patent, the reissue was declared void.

The Commissioner of Patents has no jurisdiction to grant a reissue for an invention substantially different from that embodied in the original patent. *Parker & Whipple Co. v. Yale Clock Co.* (*ubi supra*); Macomber, 2nd ed. 795; the reissue must be for the same invention. Macomber, 2nd ed. 798 and 799.

In the present case it is quite clear that the reissue is not for the same invention. The specification and claim 6 are identical with the original patent and the Commissioner of Patents in granting such reissue for a different invention—a different patent altogether,—has exceeded his statutory authority. It thus becomes a question of law wherein the Commissioner has exceeded his statutory authority, and in such cases the court cannot be bound by his decision. The statute does not provide for a reissue, in the case before the court. The Commissioner has mani-

(1) (1887) 123 U.S. 87.
 (2) (1880) 103 U.S. 786.
 (3) (1887) 119 U.S. 652.

(4) (1886) 119 U.S. 373
 (5) (1884) 111 U.S. 97.
 (6) (1882) 106 U.S. at p. 245.

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festly disregarded the rules of law by which his authority to grant a reissue in such cases is governed, and the reissue must be considered void to the extent of such illegality. It has become a question of law, not a question of fact. A reissue for the purpose of enlarging and expanding the claims of a patent is not comprised within the literal terms of sec. 24 of The Patent Act which created the power to reissue patents.

If on examination of the record it is found it discloses no evidence before the Commissioner of accident, inadvertence or mistake, such as to warrant him in reissuing the patent, or that there was record evidence of a conclusive character, showing that there could have been no accident, inadvertence or mistake, the Supreme Court has not hesitated to hold a reissue void.

Peoria Target Co. v. Cleveland Target Co. (1). See also Macomber, *The Fixed Law of Patent*, 2nd ed., at page 811, for a number of decisions to the same effect.

Therefore, the application for a reissue in this case, though made by a second assignee, is not made by the patentee nor for his benefit but for that of the assignee, who goes so far as to state in his affidavit that Kelso was the inventor of what is to be found in the new claims. The specifications are free from any complexity or ambiguity and the claim in the original is clear and explicit and the reissue was made against law as appears on its face and there is nothing on the record or in the evidence adduced which can remove this illegality. The reissue was not given for any of the reasons mentioned in sec. 24. It was given for a new invention, which, even if coming within the ambit of the original patent, was not claimed, and thereby became dedicated to the public. It was applied for after 10 years had lapsed, but, in the view I have taken of the case, it is unnecessary to pass upon the question of laches arising from such delay.

The case of *Mahn v. Harwood* (2) which is very much in point both in law and in fact, deals with and settles most of the propositions considered above.

Therefore the reissue patent No. 228,931 (exhibit No. 17) granted on the 20th February, 1923, to Louis G. De Kermor, assignee of the patent No. 141,290, of the 18th June, 1912, is hereby declared null and void and of no

(1) (1893) 58 Fed. 227.

(2) (1884) 112 U.S. 354.

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force and effect with respect to claims 1 to 5 inclusively.

However, availing myself of the provisions of sec. 33 (see also sec. 29) of the Patent Act I shall discriminate and declare the reissue good and valid in respect of claim 6 thereof, thereby maintaining the reissue for what was in the original Kelso, Exhibit No. 21.

EXHIBIT No. 18

I shall now deal with the Canadian Patent No. 217,100 granted to Louis G. De Kermor, on the 21st March, 1922, for an alleged certain new and useful Improvement in "Method of Regulation of Heat generated by electricity." Witness Ball has produced, as exhibit No. 25, a comparative analysis of this patent and the prior art as understood by him.

It is very important to state *in limine* that what is claimed by this patent is the method therein described and not the design, contrivance or device shown in the diagram, which, as stated in the specification is only there by way of an illustration of the method. The shape of the device or structure is not claimed. The patent shows a mode of operating a principle which as such is not patentable. In fact all of the four patents under consideration work under the same principle. All there is in this patent is even disclosed in Kelso which belongs to the prior art. The problem alleged to be solved by De Kermor had been solved in the prior art under the same principle, without claiming a choice for a new means. Frost, 3rd ed., 24. These patents lie within the prior art and no application of thought or study amounting to ingenuity of invention has been disclosed. The patents are merely analogous to the prior art and no new difficulty has been overcome by the defendant's patents.

Analysed by witness Caron, who was also the patent solicitor who prepared the patent (as previously referred to) he declares that this is a patent on a series of acts and that the only new thing in exhibit No. 18, over the prior art, is the removal of the air (p. 102 of evidence). And at p. 726 he further says that exhibit 18 is the method.

In exhibit 18 the machine is shewn to illustrate the method of working the apparatus by means of steam generated over the column of water the same as in Kelso, and with the addition of the air removal.

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Every steam radiator has an air vent, every house heat radiating system has a vent or valve. There is certainly nothing new in the air valve. In all the old devices the air must be removed to allow operation. Bergeon's French patent, exhibit 41, of July, 1921, and applied for on 25th November, 1920, has such an air vent in the very place where De Kermor has placed his and his patent is good the world over. There was absolutely no ingenuity of invention in putting a vent in such a heater. The rest of the claims practically describe the operations of the prior art, including Kelso, which anticipated it for a number of years, because Kelso, with respect to this patent, belongs to the prior art. The Revel or Thompson or Gale patents could not be operated without carrying out the process defined in exhibit 18. The state of the art in inventions of this kind is far too advanced to allow a patent for such comprehensive claims as it could not now be possible to take a patent for the method so well known in the prior art. If any patent can be obtained it must be restricted to a machine or device. He has failed to disclaim what belongs to the prior art. This patent claims such a monopoly which would, if good, prevent any one making any of the old devices, even covering Kelso. The claims are broad enough to cover the principle and all the known methods of carrying it out. The patentee has practically included in his patent everything found in the prior art or what is common knowledge to a skilled mechanic in that class of work. It is again the case of casting the net too wide.

The method, or process of operation claimed by this patent had long been in use in electric heaters and what the assignee of the patent has done here is merely and solely to add or adapt without invention old and similar contrivances of the prior art to such heaters. Even the adaptation of an old function or contrivance to a new purpose is not invention and there is no subject-matter when no ingenuity of invention has been exercised. Terrell 38.

It would even seem that in 1921, when this patent was applied for, there was no room for a patent of this kind for a method, because the method was well known in the prior art. The state of the art, at that time, was such

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that it could not be invention to claim such a method.
The King v. Else (1); *Templeton v. MacFarlane* (2).

It was held in *Denning Wire and Fence Co. v. American Steel and Wire Co.* (3):

That the mere function or operation of a machine, or other device, as distinguished from the machine or device itself, are not the subject of a patent is well settled.

And a patent covering generally any and every means or method for producing a given result cannot be upheld.

In the present case there is the old Kelso patent on the apparatus; then we have besides to-day exhibit 18—this method patent into which the Kelso can be read—therefore there cannot be two patents, the one to cover the method and the other the apparatus—as decided *In Re Rowe* (4). In this case the patent was refused on the ground that it was a mere statement, in different words, of the invention by the applicant's prior patents. See also on this question: *Busch v. Jones* (5); *Ex parte Creveling* (6); *In re Tallmadge* (7); *Paramount Hosiery Form Drying Co. v. Moorhead Knitting Co.* (8). The patent, it will readily be seen, covers nothing more or less than the method of using vapour to displace the liquid so as to get automatic regulation which appears in all these patents.

If a process and an apparatus are described in specifications and the process is old and the apparatus new, and the process is claimed, the patent is bad because what has been claimed is what is old. Frost 3rd ed., 251 The claim must be limited to what is new. See also *Hosiers Limited v. Penmans Limited* (9). Robinson On Patents 256.

I have come to the conclusion and hereby declare that the De Kermor Canadian Patent (Exhibit 18) No. 217,100 is null and void.

EXHIBIT No. 19

Dealing now with the Canadian Patent No. 217,101 granted to Louis G. De Kermor, on the 21st March, 1922, for an alleged certain new and useful Self Regulating Electric

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| (1) (1785) 1 W.P.C. 76. | (6) (1904) 111 Pat. Off. Gaz. |
| (2) (1848) 1 H.L.C. 595. | U.S. 2439. |
| (3) (1909) 169 Fed. 793 at p. 795. | (7) (1911) 174 Pat. Off. Gaz. |
| (4) (1913) 192 Pat. Off. Gaz. | U.S. 1219. |
| (U.S.) 519. | (8) (1918) 251 Fed. Rep. 897. |
| (5) (1902) 184 U.S. 598. | (9) (1925) Ex. C.R. 93 at p. 104. |

Steam Generator, we meet the old familiar statement common to all these patents attempting to cover the whole field of the prior art as if it were a pioneer patent opening new avenues.

Mr. Caron, the expert witness for the defence, states that what is new in the patent is the steam circulating system.

Witness Ball, on behalf of the plaintiff, has produced as exhibit 26, a comparative analysis of this patent and the prior art as understood by him.

This patent is completely met with in every particular in the prior art and even in the original Kelso of 1912. Indeed, we find in this patent as in Kelso, a water container which forms a steam dome or space above the water similarly to other disclosures; we have the electrodes, and the water receptacle at the upper end to provide an hydraulic head against which the steam pressure acts as it forces the water downwardly to the container, thereby changing the area of the electrodes, as in the previous inventions.

Now the connecting of the steam produced by the device to a steam circulating system is by no means new and involving ingenuity of invention. Any skilful mechanic knew of that and could easily make the necessary connections.

It is quite significant that in comparing exhibits 44 and 19 we find almost identical mechanical construction described in similar language, having regard to the fact that these parties were in contact with each other and that their application for a patent was filed about one month after.

There is here again the characteristic broad casting of the net in the widest possible form by De Kermor. The pioneer and subsequent patents of the prior art are all taken in and the patent could not operate without infringement.

This patent is so obviously met by the prior art that it becomes unnecessary to say any more. The patentee has failed here again to disclose any vestige of scientific vistas of unanticipated reach.

This patent No. 217,101 is also declared null and void.

EXHIBIT No 20

I shall now deal with the Canadian Patent No. 217,102, granted to Louis G. De Kermor, on the 21st March, 1922, for an alleged certain new and useful Self Regulating Water Heater.

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Witness Ball, on behalf of the plaintiff, has also produced as Exhibit No. 27, a comparative analysis of this patent and the prior art.

Witness Caron, on behalf of the defence, says that the novelty of this patent, apart from the by-pass and the deflecting jacket, is the addition of a water heating tank.

However, a test of the validity of these claims is whether the first combination claimed is really new as arising from further invention clearly and separately described from the prior art which contains what has already been discovered and published. *Moore Filter Co. v. Great Boulders Proprietary Gold Mines Ltd.* (1).

This patent shows a construction very similar to that in exhibit 18 and it is a patent, drawn by the same solicitor at the same time as he conceived his idea of subdividing and multiplying the patents by such a wide casting of language that would take the prior art including the principle. The claims are not narrowed to the specific things which differentiate the device from the prior art. The claims do not define—as distinguished from the prior art—what is new, but they are cast in such broad language as to embody comprehensively both the principle and all the prior art. It is the repetition of what we have seen in respect of the previous patents and it is perhaps unnecessary to say any more than that all previous observations so far as they are relevant, must apply to this patent.

However, the characteristic feature of the patent as shewn in claims 5 and 7, besides what has just been mentioned, is the attachment of well known specific mechanical devices, such as the jacket, the by-pass and the water-tank, all well known in the prior art. The patentee has not in this patent, as well as in all others, interjected anything which is not to be found in the prior art or which is not common knowledge to skilled mechanics.

Now De Kermor went across to France in 1920 and 1921, took drawings with him in 1920, got in touch with people there interested in these electric heaters; saw Bergeon, and on his return in Canada filed, on the 23rd November, 1921, his application, about one month before Bergeon applied. Then on the 16th January, 1925, De Kermor wrote (ex-

hibit 36) to the plaintiff, in view of a settlement of the present case, offering to give plaintiff a percentage of the defendant's capital stock in exchange for the patents Bergeon may have or may obtain in the United States and in Canada. The letter ends by asking to cable, if offer acceptable, in order that a tangible offer may be made, etc. Bergeon had in the meantime filed an application in Canada on the 5th October, 1921.

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It is argued on behalf of the plaintiff, that it is not much to infer that something that DeKermor saw when in France must have put it into his head to file an application of this kind when returning to Canada—harboring the intention to forestall Bergeon's application—DeKermor had, in his application, devices absolutely similar to Bergeon's, such, for instance, as the pipe for the removal of the air, which is identical, in the same form and placed in the same position.

Furthermore, DeKermor in an attempt to anticipate all of Bergeon's patents has endeavoured to make some claims on the alleged fact that his invention dated back to 1911 or 1912, and that he had made installation of such a boiler in his house at Edmonton around that date, without however giving a description of the same. Some evidence has been adduced in this respect but I must hold that the defence has failed to establish that fact to the satisfaction of the court. Indeed, prior use, and especially under the present circumstances, has to be established by predominant evidence. It must also indeed be examined very critically when such evidence has been lying back for ten years. The evidence has failed to earmark the boiler, which might have been under the patents of either Revel, Gale or a dozen other patents, the evidence is too faint to establish any substantial fact. However, De Kermor was not the first inventor as provided by sec. 7 of the Act. *Moore Filter Co. v. Great Boulder Proprietary Gold Mines Ltd. (ubi supra)*.

The conclusion arrived at in respect of this evidence makes it unnecessary to pass upon the question as to whether such disclosure, to third persons, for more than one year previously to his application for a patent therefor, vitiated the patent. In the view I have taken of the case

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it is also unnecessary to give further consideration to the question raised by the defence under sec. 7 of the Act of 1921, amending the Patent Act.

Therefore, the De Kermor Canadian patent No. 217,102 is hereby declared null and void and of no force and effect in so far and with respect to claims Nos. 1, 2, 3, 4 and 6,— and availing myself of the provisions of sec. 33 (see also sec. 29) of the Patent Act, I shall hereby discriminate and declare the patent good and valid in respect of claims 5 and 7 thereof.

It is difficult to understand how these four patents under consideration were ever granted, as they are so much wanting in inventive conception and are so comprehensive in terms that they cover both the principle and the prior art, all of them working under the same principle. They are in the result, with slight exception, but mere aggregation, wanting in the essential requirements of a patent for invention. If there was something, in structure or otherwise, the claims of the patents have not been directed to it. *Durable Electric Appliances v. Renfrew Electric Products Ltd.* (1).

RECAPITULATION

There will be judgment as follows:—

- (a) The reissue patent No. 228,931 (exhibit No. 17) is hereby declared null and void and of no force and effect in so far and with respect to claims 1 to 5 inclusively; claim 6 thereof is, however, declared good and valid.
- (b) The De Kermor Canadian Patent No. 217,100 (Exhibit 18) is hereby declared null and void.
- (c) The De Kermor Canadian Patent No. 217,101 (Exhibit 19) is hereby declared null and void.
- (d) The De Kermor Canadian Patent No. 217,102 (Exhibit 20) is hereby declared null and void and of no force and effect in so far and with respect to claims Nos. 1, 2, 3, 4 and 6; and claims 5 and 7 thereof are hereby declared good and valid.
- (e) Substantial success being with the plaintiff, he will have his costs against the defendant.

Judgment accordingly.