1928
Oct. 15.
et seq.
Nov. 13.

ELWOOD GRISSINGER ....PLAINTIFF;

AND

VICTOR TALKING MACHINE COMPANY OF CANADA, LTD.......... } DEFENDANT.

Patents—Infringement—Principle—Different Means of Operating

Held, that a principle cannot be the subject of a patent, and a claim to every mode or means of carrying a principle into effect amounts to a claim for the principle itself.

Held further, that a patent may be granted for a principle coupled with a mode of carrying the principle into effect, but such principle may be carried into effect under several patents operating in different ways and by different means.

ACTION by the plaintiff against the defendant for alleged infringement by it of a patent granted to the plaintiff.

The action was tried before the Honourable Mr. Justice Audette, at Ottawa, on October 15 to 31, and November 2 to 13, 1928.

G. Wilkie, K.C., and *T. D. Delamere* for the plaintiff.

O. M. Biggar, K.C., and *R. S. Smart, K.C.*, for the defendant.

AUDETTE J., now (November 13, 1928), delivered judgment.

I have listened with great interest and attention to this long and protracted trial and to the searching evidence placed before me on this question of sound both fundamental and harmonic controlling all these patents, and which, in their very nature, are so complex that some witnesses heard on behalf of the plaintiff have declared a multitude of questions raised by the patent, in respect of the same, as beyond their comprehension.

It was not even without most elaborate mental exertions that the plaintiff, the patentee himself, in the course of his testimony, after considerable time, ventured to point out and mark with letters the several expansions, the different parts of the internal mechanism of the defendant's devices charged with infringement. Yet, we find him coming on the following day declaring he made mistakes in respect of the same, and correcting himself, marking such places differently. All of this goes to show that the charges of infringement, even at the hand of the plaintiff, are not very clearly conceived. However, counsel has since made that clear.

The laws of nature with respect to sound have been much discussed in the course of the trial and both the plaintiff's and the defendant's devices are built according to such laws or principles. However, it must be borne in mind that a principle cannot be the subject of a patent, and a claim to every mode or means of carrying this principle into

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effect would amount to a claim to a principle, for it was said in *Neilson* v. *Harford* (1), that there is no difference between a principle to be carried into effect in any way you will and claiming the principle itself. A patent may be granted for a principle coupled with a mode of carrying out this principle into effect and it may be carried into effect under several patents operating in different ways and by different means and that is what we have in this case. The question of infringement is an issue of fact and this question disentangled and freed from the manifold questions discussed in the course of the trial is the simple issue before the Court in these proceedings. The evidence discloses the prior art at the date of the charged infringements and having regard to it the monopoly claimed by the plaintiff's devices must be limited to the same.

Were I to take the case under consideration for further advisement, I would perhaps be in a position to review the evidence at length; but I could not come to any other conclusion than the one I have now formed, after hearing the case during these several days.

The plaintiff's patent is not dealing with a new field in that art. His patent is necessarily a narrow patent and must receive a narrow construction. The prior art discloses innumerable patents in connection with this subject-matter, and there are over 100 such patents mentioned in the defendant's particulars. The difference among some of these patents is very, very small. Yet patents were granted. A number of patented devices were exhibited and tested before me during the trial and comparing such devices with each other, I find there is less mechanical difference between them than there is between the plaintiff's and the defendant's devices, and yet they were all patented. The principle underlying all these inventions is the same. And without entering upon the question of the validity of the patent, it must be found that all the patentee is entitled to claim is a special means by which the known principles are carried into effect, and his patent, in view of the prior art, can merely lie in the use of old features all well known before.

The defendant's devices produce the known results, but omit, add and distribute a number of mechanical features

(1) (1841) 1 W.P.C. 295, at p. 355.

belonging to the prior art, and not at all infringing any mechanical devices in the plaintiff's patent. In the result the defendant shows devices having a different means of achieving the ends contemplated and involved in the general principle controlling all these patents. *Consolidated Car Heating Co.* v. *Came* (1). The mechanical details and means of obtaining the common result under the general principle are different in the defendant's devices from that of the plaintiff's devices. The curve at the slot in the plaintiff's patent is angular and in the defendant's devices it maintains a steady and gradual curve.

The defendant's structures are obviously different from those of the plaintiff. The mechanical construction of all these devices is mechanically different from that of the plaintiff, besides in most cases obtaining a longer horn, fitted in a reasonable sized cabinet, with good results. The controlling of the curved wave sounds is different in the respective devices; the division of the channels is obviously different from a single channel, and then the abrupt angular curvature found in the Grissinger device is avoided in the respondent's devices, with perhaps better effects according to the evidence. However, I am not called upon in this case to pass upon the respective efficiency of these devices of different construction. The infringement is the only question before the Court.

Moreover, the mere ocular observation of the plaintiff's and the defendant's structures and devices will readily convey the firm notion that they are materially different and that notion will become more confirmed as one pursues the examination in detail and especially comparing the easy curves of the defendant's machine with the abrupt course in the plaintiff's device. This manner of proportioning, of modulating the air planes in the defendant's devices is very different from the abrupt manner shewn in the plaintiff's construction. All of this is significant of much especially when going back many years in that art.

When two separate devices work under the same principle, both arriving at the same result, but by different means and new ways of achieving the end contemplated,

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

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there is no infringement. *The P. & M. Company et al* v. *The Canada Machinery Corporation Ltd. et al* (1).

I am clearly satisfied that the defendant's devices do not infringe the plaintiff's devices. Having so found on the question of infringement, it becomes unnecessary, under the practice of this Court, *Dominion Bedstead* v. *Guertler* (2), to pass upon the question of the validity of the plaintiff's patent.

The action is dismissed with costs.

Judgment accordingly.