

VAN HEUSEN PRODUCTS INC. ET AL. . . . PLAINTIFFS;

1927

AND

Oct. 20-27.

TOOKE BROS. LIMITED. DEFENDANT.

1928

Patents—Invention—Vague and indefinite claim—Ingenuity of invention

Oct. 9-13.

Plaintiff in his specification states that "the invention provides a collar of multiple-ply interwoven fabric which is sufficiently stiff to maintain its shape without the employment of starch, and is nevertheless suffi-

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ciently pliable to assume the necessary curvature to fit the neck of the wearer without undue rigidity. Accordingly the collar may be washed and if desired, ironed without the supplemental use of starch, which therefore, becomes unnecessary in the laundry operation," and claim No. 1—the only claim alleged to be infringed—reads as follows: "A shirt collar, made up of fabric having a reinforce interwoven therein and inherently capable in an unstarched condition of receiving and maintaining a curvilinear set." No claim is made for the fabric or material, nor for the weave or the shape or form of the collar.

Held, that, as reinforce interwoven, as a means of stiffening a fabric was part of the prior art, it did not require ingenuity of invention to make a collar as claimed, it being only a matter of the degree of stiffness to be used.

2. That there is no invention in a mere adaptation of an idea in a well known manner for a well known or clear purpose in a well known art, without ingenuity, though the adaptation may effect an improvement which may supplant an article already on the market.
3. *Held*, further, that the description formulated in claim No. 1 above was too wide and vague in view of the prior art, and fails in that respect to comply with the statute, and is void.

ACTION to have it declared that Canadian patents Nos. 217,308 and 243,516 were valid and in force and were infringed by the defendant.

The action was tried before the Honourable Mr. Justice Audette, at Ottawa, on October 20 to 27, 1927, and was argued on October 9 to 13, 1928.

Arthur Anglin, K.C., for the plaintiffs.

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

The facts are stated in the reasons for judgment.

AUDETTE J., now (February 27, 1929), delivered judgment.

This is an action whereby it is sought by the plaintiffs, among other things, to have a declaration that the two Canadian Letters Patents Nos. 217,308 and 243,516 are valid and in full force and effect, and for a further declaration that the defendant has infringed the same, and praying for the issue of an injunction restraining the said alleged infringement.

The defendant, by his statement in defence, denies any infringement, and by way of counter-claim seeks to impeach the said letters patents and to have the same adjudged as invalid, null and void.

The two patents are in respect of alleged improvements in shirt collars.

The letters patent first mentioned in the statement of claim is No. 217,308, bearing date the 28th March, 1922, in favour of John Manning Van Heusen, which said letters have been assigned and transferred to the plaintiff Van Heusen Products Inc.

The second letters patent, No. 243,516, upon which most of the issues turn, bear date the 7th October, 1924, and were granted to the said plaintiff, Van Heusen Products, Inc. as assignee of the said John Manning Van Heusen, who in turn was assignee of one John Blakesly Bolton, the alleged inventor. Most of the present controversy turns upon these last mentioned letters patents which will hereafter be called the Bolton patent.

The plaintiffs, the Cluett Peabody & Co. of Canada, and Canadian Converters Company, Limited, together, hold an exclusive license from the plaintiff, Van Heusen Products, Inc.

By the plaintiffs' supplementary particulars of breaches it is charged that the defendant has infringed claims Nos. 1, 2, 9 and 12 of the Letters Patent No. 217,308, and claim No. 1 of letters patent No. 243,516, the Bolton patent.

The novelty sought by the Bolton patent is the introduction upon the market of a semi-soft collar, as distinguished from what is known as a stiff and a soft or negligé collar. Or to make of a soft collar a stiff collar without using starch.

The specifications claim that the invention provides a collar of multiple-ply interwoven fabric which is sufficiently stiff to maintain its shape without the employment of starch, and is nevertheless sufficiently pliable to assume the necessary curvature to fit the neck of the wearer without undue rigidity. Accordingly the collar may be washed and, if desired, ironed without the supplemental use of starch, which, therefore, becomes unnecessary in the laundry operation.

Having thus summarily described by the specifications, the alleged invention, the patentee formulates his claim No. 1, the only claim charged to have been infringed, in the following language, viz:

1. A shirt collar, made up of fabric having a reinforce interwoven therein and inherently capable in an unstarched condition of receiving and maintaining a curvilinear set.

Before entering upon the consideration of the actual meaning of the language used in this claim it is thought

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desirable to relate the circumstances under which the idea of the alleged invention was conceived and how the patent issued.

Van Heusen, relating these circumstances, says, that as he was (p. 117) wearing stiff and starched collars he thought them uncomfortable and conceived the idea he would like to get a collar made that would simulate a starched collar and be comfortable, and with that object in view he saw Bolton, a weaver and told him of his idea. As Van Heusen knew nothing about weaving, he employed Bolton to invent a fabric which would be sufficiently rigid to stand up and simulate a starched collar. Bolton said he could make such a fabric in his odd times, after hours and on holidays and the like, and he negotiated that with him (p. 118) on September, 1913.

Van Heusen then went to Europe in November, 1913, for one month, and left instructions to Bolton that if he got anything, that he was to get in touch with his (Van Heusen's) patent attorney.

On his return Bolton submitted some samples of fabrics. One of them (exhibit No. 27) had longitudinal wires weaved in the fabric and another (exhibit No. 26) along the line of his researches, and Van Heusen thought this latter sample had "a proper bottom sufficient to maintain its position without starch." Then Bolton made two applications for patent, through Van Heusen's patent solicitors and sought in 1917 to exploit his collars which were on the market in the United States not before 1921.

On the 7th April, 1914, (exhibit No. 29) the Crompton and Knowles Loom Works wrote to Bolton advising him that one Mr. Bardsley had produced some very good looking samples of his special fabrics and were mailing the same. The letter ended by inquiring as to what action they were to take and whether Bolton wanted them to further experiment along the lines suggested.

All of this discloses that Van Heusen is the one who first dimly conceived the idea of the collar above described; that Bolton was instructed by him to experiment in getting a material that would answer; that Mr. Bardsley had produced good looking samples and that Crompton and Knowles were also experimenting.

Who, under the circumstances, is the inventor? This is a question that was much mooted during the trial and suggestions were made that Van Heusen is the person who should have taken the patent for the collar in question and not Bolton or those working for him, as he was, or they were, only weavers who were working to get a fabric of such strength as might be used to make a semi-soft collar as described and harboured in Van Heusen's mind.

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However that may be, the inventor is not the person who may say to himself that there may be some way of producing a fabric that would answer to a given idea. We remain with the question unsolved: Is it Van Heusen who conceived dimly the idea set out in claim No. 1 and sought and found the cloth to make it; or is it Bolton who, at Van Heusen's request, worked on the cloth, or is it the Crompton and Knowles Company, or is it Mr. Bardsley who really found a satisfactory fabric? That is a question which cannot be solved under the limited evidence in this respect spread upon the record, and if it is a fabric which Van Heusen directed Bolton and his patent attorneys to get patented, that was not done because the patent is not for the fabric. However, in the view I take of the case, the question becomes immaterial. Yet it must be taken that the plaintiff's claim is presented and formulated in a rather disquieting manner and in this new labyrinth of warps and wefts, one may again for a moment feel lost at the end of Ariadne's deceiving threads.

It is well here to bear in mind that the charge of infringement is only with respect to claim No. 1. Furthermore that the plaintiffs make no claim to the form or shape of the collar which is more or less common to all collars according to that kind in respect of shape. No claim either is made to the weave, fabric or material; but the only claim made is to the collar which Bolton claims to obtain through or by his fabric as set forth in claim No. 1.

The patent is in itself quite narrow—the dream of expert attributes—and therefore it must be narrowly construed.

The defendant first attacked the patent for disconformity with the statute with respect to the oath of the inventor and with respect to sec. 7; but it is found, under the circumstances of the case, unnecessary to specifically deal with

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this question. Nicolas, on Patents, p. 72; *Floyd Smith Aerial Equip. Co. v. Irving Air Chute Co.* (1).

Turning again to claim No. 1, it is desirable to set out in a summary way the meaning attached by the evidence to the language used in it.

The word "*multiple-ply*," known only in recent years, has no technical significance in the weaving art, but witness Brown (p. 390) looks upon it as a very excellent generic word or expression to include a double cloth or clothes of any number of layers. And witness Haines (p. 201) thinks that claim No. 1 covers in its description any fabric wherein there is interwoven with the collar fabric a reinforce which will impart to that fabric the characteristics of assuming and maintaining a curvilinear set; and it may be a single-ply fabric in some cases if the reinforcement or the reinforce is interwoven with it, or it may be a multiple-ply fabric.

The word "*reinforce*" in the patent used in the case of multiple-ply or double-ply (p. 252) consists of the several plies of the material each reinforcing the other and bound together in a single unit, and in cases of fabrics other than multiple-ply being an interwoven material of some sort. It is the multiple-ply that constitutes the reinforcement (p. 158). It is just the woven fabric that exists without any wire, because there are several plies. Reinforce is constituted in the several plies, pp. 204, 205. Another witness (p. 391) testified that there is no such terminology in the literature of the weaving art and that a fabric is reinforced if it has connected with it any instrumentality for rendering it stiffer or firmer. If there is to be an interwoven reinforce, the reinforcing threads, whatever they may be, must be incorporated in the fabric as the result of the weaving operation. The binding, the reinforcing threads in a double, triple, quadruple fabric, etc., are made with two, three or four systems of warps and wefts or any extra number of the same, pp. 392, 161 *et seq.* It applies to single or double fabrics. *Northern Shirt Co. v. Clark* (2).

The expression "*curvilinear set*" would seem to mean nothing else than that the collar would fit around the neck and that is applicable to all collars. The expression "*set*"

(1) (1928) U.S. Av. R. 275.

(2) (1917) 17 Ex. C.R. 273 at 283.

has been defined by one witness (p. 396) as "anything which is moved to a position and remains in that position taken a 'set'". Bolton never got a curve in the fabric, p. 140. Patentees Bowen and Morgan are the persons who ultimately made the curve in the fabric (p. 135).

With these words and expressions of the patent fully explained and clarified there is no occasion to toil in search of the meaning of claim No. 1.

Therefore, coming to the crucial question of the scope and conception of the claim, and considering all has been said, and more especially that the patent is not for the shape or form of the collar, that it is not for the fabric, in the result we are faced with a claim placing an inhibition upon using in the manufacture of collars a fabric woven in the most ordinary manner and known to the trade for years back; and for the reason that it might be a fabric or material allowing a collar to be made out of it, that would be neither stiff nor soft, but that might be called semi-soft. Yet there is nothing new in the art of weaving brought out by the Bolton patent, and if Bolton were to make a claim for the weaving, his claim, under the evidence taken both in Canada and in England, would be clearly anticipated (see also p. 382 evidence).

While the plaintiffs clearly state they made no claim for the shape or the fabric—yet they claim they get the collar by means of the Bolton patent. Is it not somewhat difficult to reconcile these facts under the circumstances of the case?

Can any one place such a restraint upon commercial freedom by thus casting so wide a net as to unduly affect the weaving and textile market? The state of the art in our days is far too advanced and developed to allow a patentee making such a comprehensive claim which would put an embargo upon a weave or fabric produced quite lawfully in the usual manner which has been in use for many years back. Can a patentee at this stage come and say: You may manufacture that cloth as in the past, but you may not make any collars therewith. Another illustration of the characteristic casting of the net!

Bolton has failed to disclaim what belongs to the prior art. The claim is broad enough to cover the principle and all the known methods of carrying it out. Every element

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described and upon which Bolton rests his invention in claim No. 1 is to be found in the prior art.

There is no subject-matter in the present case. What the plaintiffs are doing is nothing more than using a stiff material to produce a stiff collar. Is not Bolton's patent, as set forth, similar to the case where a merchant would go to a steel manufacturer and ask him to replace, in his warehouse, a wooden post by one of steel which would be strong enough to carry the very heavy stock he wished to store in his warehouse? Would this steel manufacturer—manufacturing this special pole especially strong in the usual manner known to his art, be entitled to a patent because he obtained a steel post which would be of such strength that would carry this or that weight? And would he be entitled to a new patent every time he manufactured a steel pole to meet other specific weights? There is certainly a fallacy in the granting of a patent under the present circumstances. The rights derived from such a patent would indeed stagger and bewilder the weaving and textile trader.

Is every one in the weaving trade entitled to get a patent for every kind of garment produced from a fabric woven, in a manner well known to the art, of many warps and wefts that would have a special stiffness and which would possess such given inherent strength suitable to a garment of the softness or stiffness desired?

The subject-matter of a patent must be something new, useful and involving ingenuity of invention. The novelty must be the outcome of skilful ingenuity and the primary test in invention and the question as to whether there has been invention is one of fact in each case. *British Vacuum* case (1), and *British Thompson-Houston Co. Ltd. v. Corona Lamp Works Ltd.* (2).

Bolton's dim exterior vision, seen through the cloudy vistas of the avenues of his imagination, induces him to claim the collar described in his claim to the exclusion of the rest of the world.

It is not sufficient that a patentee's utterance springs from his imagination, he must need carry with it the immediate warrant showing that what he has done was done in a manner new to the specific art.

(1) (1911) 29 R.P.C. 309.

(2) (1922) 39 R.P.C. 49.

Invention must not be of questionable import. To constitute invention it is not enough to disclose something but dimly visualized. There is wanting in the patent a clear result of ingenuity of invention.

There is no invention in a mere adaptation of an idea in a well known manner for a well known or clear purpose in a well known art, without ingenuity, though the adaptation may effect an improvement which may supplant an article already on the market. *Carter v. Leyson* (1).

The field of this patent is obviously in the well known weaving art. Yet no claim is made for the fabric which might produce the collar in question. No claim is made for the shape or form of the collar, but it is made for a collar that would, within a certain degree of stiffness, stand between a stiff and a soft collar.

Under the provisions of sec. 14 of The Patent Act (13-14 Geo. V, ch. 23) the patentee must correctly and fully describe the invention and its operation or use as contemplated, and must (shall) set forth clearly the various steps in a process or the method of constructing or making. The office of a claim is to define and limit with precision what it is that is claimed.

The description formulated in claim No. 1 is too wide and vague in view of the prior art and fails in that respect to comply with the statute. The patentee must not throw the net too wide, but must claim clearly what he has invented, but not more than he has invented, that is something which is the mere subject of his speculation of his endeavour to grasp more than he is entitled to. The public must know what they can infringe. *Incandescent Lamp Patent* (2); *Tyler v. Boston* (3). See also *British Thompson-Houston Co. v. Corona Lamp Works Ltd.* (*ubi supra*).

Now there is nothing new in the weave or in the manner the weave is to be made for this collar, it is only a question of degree of stiffness and weight in the material that will exactly correspond with the wide and vague description of claim No. 1. That is no meritorious step on the prior art. There is no specific degree of stiffness, no specific weight of the cloth or fabric to be used, disclosed or defined in the patent. Has the language of the patent been intentionally

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(1) (1902) 19 R.P.C. 473.

(2) (1895) 159 U.S. 465 at 475.

(3) (1868) 7 Wall 327, 330 (74 U.S.).

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so used to allow this degree of stiffness and weight to be extended or restricted as occasion might arise in the interest of the patentee? *British Ore Concentration Syndicate Ltd. v. Mineral Separation Ltd.* (1). And I may add here that this is the reason why the case of *Power v. Griffin* (2), cited and relied upon at trial, has no appositeness. One clearly defines what he invented and the other does not show it satisfactorily.

There is no new element entered into the production of the collar in question. The adaptation of old fabric, woven in the usual manner well known in the art applied to the same class of articles cannot constitute invention. Terrell on Patents, 5th ed., 38. The application of an old device to a similar or analogous subject, with no change in the manner of application and no result substantially distinct in its nature, will not sustain a patent, even if the new form of result has not been before contemplated. *Blake v. San Francisco* (3); *The Northern Shirt Co. v. Clark* (*ubi supra*) confirmed on appeal to the Supreme Court of Canada (4).

The collar described in the plaintiffs' claim does not lie out of the track of former use as to evolve invention, considering the state of the art disclosed by the patent, and especially the evidence taken in England under commission.

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 the purpose in or to which it has previously been applied. Nicolas, on Patent Law, 23 and cases therein cited.

The Bolton patent does not possess any element of invention and I can in no sense find any creative work of inventive faculty which the patent laws are intended to encourage and reward. *Ball v. Crompton Corset Co.* (5). There is no invention in devising a stiffer fabric, under a weave known in prior art, to make a stiffer collar.

(1) (1909) 27 R.P.C. 33.

(2) (1902) 7 Ex. C.R. 411, at p. 413; 33 S.C.R. 39.

(3) (1885) 113 U.S.R. 679, at p. 682.

(4) (1918) 57 S.C.R. 607.

(5) (1886) 13 S.C.R. 469, at p. 475.

The device claimed consists in nothing else than using a stiffer fabric to make a stiffer collar, and not only a person skilled in art—but any worker or rational being—would know that. *Eagle Lock Co. v. Corbin Cabinet Lock Co.* (1).

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A patent for the mere new use of a known contrivance, without any additional ingenuity in overcoming fresh difficulties, is bad, and cannot be supported. If the new use involves no ingenuity, but is in manner and purposes analogous to the old use, although not quite the same, there is no invention,

as said by Lord Lindley, in the case of *Gadd and Mason v. The Mayor, etc., of Manchester* (2).

I may further add that in the case of *Yates v. Great Western Ry. Co.* (3) it was held although the patented article was a most useful contrivance, that it could not be the subject of a patent as it was wanting in the element of invention. Commercial success is not sufficient. *Nicolas, On Patents*, 18.

See *Treo Company, Inc. v. Dominion Corset Co.* (4) confirmed by the Supreme Court of Canada; *Detroit Rubber Products Inc. v. Republic Rubber Co.* (5), confirmed on appeal; *Nieblo Mfg. Co. Inc. v. Reid* (6) confirmed on appeal; *Corbin Cabinet Lock Co. v. Eagle Lock Co.* (7); *Harvey Hubbell, Inc. v. General Electric* (8).

In *Smith v. Nichols* (9), it was held that:

Where a textile fabric, having a substantial construction and possessing essential properties, has been long known and in use, a patent is void when all that distinguishes a new fabric is higher finish, greater beauty of surface, the result perhaps of greater tightness of weaving, and due to the observation or skill of workman, or the perfection of the machinery employed.

The patent in the present case rests upon no other or better foundation.

The making of a device in whole or in part of materials better adapted for the purpose for which it is used than materials of which those of the prior art were made, unless the mode of operation is thereby changed, does not consti-

(1) (1894) 64 Fed. Rep. 789.

(5) (1928) Ex. C.R. 29.

(2) (1892) 9 R.P.C. 516 at 524.

(6) (1928) Ex. C.R. 13.

(3) (1877) 2 A.R. (Ont.) 226.

(7) (1889) 37 Fed. Rep. 339.

(4) (1918) 18 Ex. C.R. 115.

(8) (1920) 267 Fed. Rep. 564.

(9) (1874) 88 U.S. (21 Wall.) 112.

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tute patentable invention. *Cover v. American Thermo-Ware Co.* (1).

See also *Stahlwerk Becker Aktiengesellschaft* (2).

Now, the fact that a patent has been supported in a former action in the United States does not estop a new defendant questioning its validity. *Nicolas, On Patent 201.*

The two patents in question in this case have been passed upon in the United States in re *Van Heusen Products Inc. et al v. Earl Wilson* (3), whereby claim No. 1 of the Bolton patent has been declared valid and the Van Heusen patent anticipated.

Canadian courts, like the English courts, are accustomed to treat the decisions of the American courts with great respect, although they are in no manner bound by them. See per Halsbury L.C., in re *Missouri Steamship Co.* (4); per Brett L.J., in *Queen v. Castro* (5); and per Kekewich J., in re *De Nicols* (6).

Moreover, the plaintiffs' principal expert witness, heard at trial, differs in opinion with some parts of the Judgment of the Court of first instance in the United States. (Evidence, pp. 245, 235 and 237.)

I am unable to accept the finding of the judgment in the United States. Indeed, the evidence adduced before me may be entirely different from that offered before the United States Court.

Then, there is more in that case. The judgment of first instance, finding as above mentioned, was taken to the Court of Appeal and before the latter court rendered judgment, the case was settled without having the advantage of the pronouncement of the Appellate Court.

It is sufficient to say on the question of infringement that having passed on the question of validity and coming to the conclusion that the Bolton patent is null and void, it becomes unnecessary to pass upon the question of infringement.

Coming to the Van Heusen patent No. 217,308, which plaintiffs' witness Haines (pp. 190 *et seq*) places in the relation of juxtaposition of genus and the species, the Bolton

(1) (1911) 188 Fed. Rep. 670.

(4) (1889) L.R. 42 Ch. D. 330.

(2) (1918) 36 R.P.C. 13, at p. 18,
19.

(5) (1879-80) L.R. 5 Q.B.D. 490,
at p. 516.

(3) (1924) 300 Fed. Rep. 922. 936.

(6) (1898) 1 Ch. D. 403 at 410.

patent being the genus, it is considered that if the Bolton patent fails the Van Heusen follows, for reasons that have already been mentioned and debated at trial, and which it is unnecessary to repeat here. The most that could be said of the Van Heusen patent is that it could only stand on sec. 9 of the Patent Act.

Therefore the two patents relied upon by the plaintiffs are found and adjudged invalid for want of subject-matter, or ingenuity of invention, and the action is dismissed, and with costs in favour of the defendant.

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Judgment accordingly.