

BETWEEN:

SOMERVILLE PAPER BOXES LIM- ITED, LEON BENOIT, and COYLE } SAFETY CARTON CO.	} PLAINTIFFS;
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1938
 March 22-25,
 28 & 29.
 —
 1939
 Dec. 22.
 —

AND

ARTHUR CORMIER, carrying on business under the name of A. CORMIER & CO., and the said A. CORMIER & CO.	} DEFENDANTS.
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Patent—Infringement—Invention claimed for new improvements in egg boxes and cartons and machines for assembling the same—Subject-matter—Lack of novelty—Anticipation—Prior art—New use of known device.

The action is one for infringement of three Letters Patent numbered 200,100, 282,212, and 282,214. The invention claimed in the first two patents relates to improvements in boxes and cartons for eggs and like commodities. The invention claimed in Patent No. 282,214 relates to alleged improvements in machines for assembling cartons.

The Court found that the alleged inventions relating to the boxes and cartons were not new but were old in the art and that a prior patent included the essential features found in plaintiffs' machine in that it applied to wooden crates or racks while the plaintiffs' patent related to cardboard boxes or cartons, the difference of material not being important.

Held: That in order that a new use of a known device may constitute the subject-matter of an invention, it is necessary that the new use be quite distinct from the old one and involve practical difficulties which the patentee has by inventive ingenuity succeeded in overcoming.

2. That where a new use of a known device does not require any ingenuity but is in manner and purpose analogous to the old use, although not exactly the same, there is no invention.

ACTION by plaintiffs herein to have it declared that three patents owned by them are valid and have been infringed by defendants.

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

O. M. Biggar K.C. and *R. S. Smart K.C.* for plaintiffs.

H. Gerin-Lajoie K.C. and *A. Demers* for defendants.

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

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ANGERS J., now (December 22, 1939) delivered the following judgment:

This is an action for the infringement of letters patent for invention bearing Nos. 200,100, 282,212 and 282,214, the first whereof issued to Joseph Leopold Coyle and Frederick Dundas Todd on May 11, 1920, and the other two to Leon Benoit on August 7, 1928.

By an agreement made on April 14, 1922, Joseph Leopold Coyle, Frederick Dundas Todd, Roderick Anderson Dundas Todd, Ian Dundas Todd, Henry Vours and Leon Benoit sold, transferred and conveyed to Coyle Safety Carton Co. all their rights, title and interest in and to, among others, the letters patent No. 200,100 aforesaid. This assignment was recorded in the Patent and Copyright Office, at Ottawa, on May 20, 1922, under No. 108,351.

How Roderick Anderson Dundas Todd, Ian Dundas Todd, Henry Vours and Leon Benoit acquired an interest in the said patent is not disclosed by the evidence, but the matter is unimportant as the title is not challenged.

By an agreement dated April 15, 1925, Coyle Safety Carton Co. granted unto Leon Benoit the exclusive licence to make and sell the egg cartons and boxes containing the invention covered by the letters patent No. 200,100 during the unexpired term thereof.

By an agreement dated January 28, 1927, Leon Benoit granted unto Somerville Paper Boxes Limited the exclusive licence to make, use and sell the egg cartons and boxes containing the invention covered by the letters patent No. 200,100 during the unexpired term thereof.

By a deed made on June 6, 1934, between Leon Benoit and Somerville Paper Boxes Limited it was agreed that the agreement of January 28, 1927, hereinabove referred to was continued in full force and effect through the remainder of the term for which the said letters patent No. 200,100 had been granted.

The invention covered by letters patent No. 200,100 relates to improvements in egg boxes.

The objects of the invention are stated as follows:

. . . the object of my invention is to provide a simple, inexpensive, and safe receptacle for the carrying and handling of eggs in which the eggs are suspended and supported clear of each other so that the breakage is reduced to the minimum and the construction of which is such that the removal of the eggs is accomplished with great facility. A further object

is to devise an egg box capable of being assembled from its knock-down form into receptacle form very quickly and with great convenience and which is very cheap to manufacture.

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The specification describes the invention thus:

The egg box is formed preferably of cardboard or the like and may be made in sizes suitable to the requirements of trade and while this description applies to the use of the device for the carrying of eggs it may be here stated that it can be used with equal facility and convenience for transporting other kinds of merchandise, such as glass bottles and other commodities of a fragile nature.

After referring to the drawings, the specification continues as follows:

It will be seen, therefore, that I have devised a carrier for eggs and other merchandise which is simple and inexpensive in construction and operation and of great convenience and utility to those engaged in the transportation of fragile articles.

One distinguishing characteristic of my device is that the partitions 10 are not permanently connected with the sides of the main body, so that they may be folded into the position shown in Figure 9 without bending. They lay substantially flat against the sides of the upstanding folded centre of the main body, which folded or doubled centre portion is indicated generally at 15. The ends of the partitions are entirely free from permanent connection with the sides of the body and being held at their centre portions by the slotted construction of themselves and the main body they are freely removable and thus the compartments are adjustable as to size for holding different sizes of articles. In other words by removing alternate partitions the carrier may receive apples, pears, oranges, or other articles larger than eggs.

After relating how the partitions free from permanent connection with the body of the box at their ends can be located automatically in a crosswise position from their folded position by unfolding the sides of the body, the specification adds:

In effect therefore the partitions are pivotally mounted at a point intermediate of their length to the body blank or member. They fold substantially parallel with the adjacent faces of the blank when folded.

In removing any one of the partitions it is simply moved down through the slot 9 in the main body, the notch 13 permitting this to be done.

It will be observed from Figure 1 that the box when folded is in the form of a strip no wider than the height of the partitions, plus the thickness of the material of which the body is composed, this body as it were being folded or wrapped around the doubled centre 15 with its folded and overlapping partitions. There are no protuberances extending laterally of the folded strip like form of the container.

The partitions as shown in Figures 5, 7 and 8 form a base for the body member to rest on and as they project both below and at each side of the body they serve as protectors for the body member and its contents being in the nature of projecting fins or webs, receiving any side blows or pressures to which the box may be subjected.

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Claims 1, 3, 4, 7, 8 and 9 of patent No. 200,100 are relied upon by plaintiffs; they read as follows:

1. An egg box comprising a foldable blank forming the body of the box, and partitions individually removably mounted on the body blank foldable longitudinally within the box and unfolding automatically when the body is extended, substantially as described.

3. An egg box having a body with an upstanding centre portion and side extensions, partitions pivotally mounted thereon to fold against the sides thereof and between the same and the extensions, said partitions having free ends, said extensions and the free ends of the partitions having means for detachably holding them together substantially as described.

4. An egg box having a body with an upstanding slotted portion, partitions extending through said slots, and thereby adapted to swing into folded position against the sides of said upstanding portion or to extend at right angles thereto, said body portion having extensions to fold up around the edges of the partitions with means for holding the said extensions inclosing said partitions; said partitions when folded lying between the extensions and the upstanding portions, substantially as described.

7. An egg box comprising a slotted blank and walls inserted in said slots each provided with end notches, said walls being adapted to lie flat one on the other longitudinally of the blank when the same is folded and to be erected transversely of the blank by the opening out of the same, the said blank when opened out forming sides adapted to be seated in the said wall notches so as to form with the said walls egg-carrying compartments.

8. An egg box comprising a slotted blank and walls inserted in said slots each provided with end notches and an upper edge slot, said walls being adapted to lie flat one on the other longitudinally of the blank when the same is folded and to be erected transversely of the blank by the opening out of the same, the said blank when opened out forming sides adapted to be first seated in the said end notches so as to form with the walls egg-carrying compartments and then folded so that its ends may be engaged in the upper edge slots whereby covers for the said compartments are formed.

9. An egg box comprising a slotted blank and walls inserted in the said slots each provided with end notches and a pair of inclined upper edge slots, said walls being adapted to lie flat one on the other longitudinally of the blank when the same is folded and to be erected transversely of the blank by the opening out of the same, the said blank when opened out forming sides adapted to be first seated in the said end notches so as to form with the walls egg-carrying compartments and then folded so that its ends may be engaged in the inclined upper edge slots whereby covers provided with a cushioning edge for the eggs are formed.

The invention forming the subject of letters patent No. 282,212 relates to improvements in a knock-down carton for eggs and like commodities.

The objects of the invention are stated as follows:

This invention which relates to certain improvements in a knock-down carton for eggs and like commodities is particularly concerned with

features which facilitate the assembly of the carton components, enhance the strength and utility thereof, and assure a more serviceable construction.

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After referring to the drawings, the specification describes the invention thus:

The carton herein shown and described is of that type which utilizes a blank A which is formed into bottom, side walls, and covers, and in conjunction therewith a plurality of cross walls B which provide ends and intermediate partitions. The blank is folded upon itself at 20 in its middle region and is also bendable at other points as indicated at 21, 22, 23 and 24. The general form of the blank so folded is that of the letter W. The folds 22 occupies lowermost positions, the folds 23 are adjacent the upper edge of the carton, and the folds 24 are adapted to occupy substantially a centre position when the blank is closed over to provide covers for the carton. The bends 21 are disposed between the centre and bottom folds 20 and 22, as shown. The sections of the blank between the fold 20 and bends 21 provide a vertically extending double wall c. Between the bends 21 and 22 are oblique sections d, between the folds 22 and 23 are other sections e, and between the folds 23 and 24 are cover sections f. Joined to each cover section at the fold 24 is a flap g. In addition the blank is adapted to be further bent, when the carton is closed up, along the line 31 which define between itself and the fold 23 one additional section h which is substantially vertically disposed. In the manufacture of a blank having the characteristics noted, the material, preferably a commercial fibrous product, may be scored or otherwise weakened along the lines where the several folds are to be made, so as to facilitate the operation of bending the blank to the form described.

The blank is further provided upon opposite sides of its centre fold with two sets of aligned slots 35 which extend between the bends 31 and 21. In line with these slots are openings 36 arranged in a row along the centre line of the blank. When the blank is folded upon itself along its centre line, as shown in Fig. 1, these several openings take on the form of semi-circular notches.

After describing the cross walls and explaining the manner in which they are assembled in the blank, the specification adds:

The carton herein shown and described by way of exemplification is of the double row form; that is, its folds are so disposed in relation to the type of cross walls used as to present two rows of cells. Manifestly the length of these rows will be determined by the dimensions of the blank, and the number of compartments or cells will depend upon the number of cross walls which are used. In the construction shown, where the blank is bent to substantially W-formation, two such rows are provided, but this may be increased by duplicating the folds wherever necessary to add rows to whatever number is desired. In such instances, the essential features of the invention will remain unchanged both as regards the formation of the blank and of the cross walls which co-operate therewith.

The specification then deals with the possibility of varying the construction in various particulars (the fastening

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devices, the form of interlock between the blank and the cross walls, the notches along the centre fold of the blank, etc.); and the patentee concludes thus:

The features of my invention, as set out in the preceding description, tend to a more certain and secure assembly of the carton components. Without the provision of locking means by which to prevent accidental displacement of the cross walls from the blank, the use of the present carton will be attended with certain disadvantages. This tendency of the blank to separate from the cross walls is particularly noticeable before the covers are closed down. During the operation of filling the carton, the upper portions of the blank will be extended outwardly somewhat, as illustrated in Fig. 1, in which position it is important that the blank should remain engaged with the side edges of the cross walls. By the notch constructions which I have shown and described, any separation of the blank from the cross walls at these points is effectively prevented.

The claims of patent No. 282,212 on which the plaintiffs rely are claims 1, 2, 4, 6, 12 and 14.

It will suffice to quote claims 1, 4, 6 and 14, which are typical.

1. An egg carton in which is comprised a blank having plural sets of aligned slots, the blank being folded upon itself along a line between the two sets of slots, and a plurality of cross walls each having a slot proceeding inwardly from one edge adapted for insertion through the slots of the blank, each cross wall being provided with means partially obstructing the entrance to its own slot adapted to overlie an edge of the blank whereby to retain the cross walls in interlocked relation therewith, substantially as described.

4. A carton in which is comprised a blank folded upon itself to provide double walls and provided further with two sets of slots on opposite sides of the fold, and a cross wall adapted for insertion within the slots of the blank, each cross wall being provided with a slot extending inwardly from an edge which is disposed adjacent the folded edge of the blank, the entrance to the slot in the cross wall being flared in one direction and having an obstruction extending partly thereacross from the opposite side whereby the double walls of the blank when received within the slot of the cross wall may lie beneath said obstruction, substantially as described.

6. A carton in which is comprised a blank folded upon itself to present double walls, there being a cut through the two walls of the blank adjacent the fold and in line with each pair of slots, and a plurality of cross walls adapted for insertion within the slots of the blank, each cross wall having a slot extending inwardly from one edge thereof and provided with means partially obstructing the entrance to said slot, each cross wall, when moved to a final position in the blank, being adapted to present its obstructions through the cut in the double walls of the blank whereby to interlock the cross walls therewith, substantially as described.

14. A carton in which is comprised a plurality of slotted cross walls, and a slotted folded blank adapted to interlock with said cross walls, the slots of the one being obstructed by yielding means adapted to interlock with the other whereby to prevent disassembly of the cross walls from the blank, substantially as described.

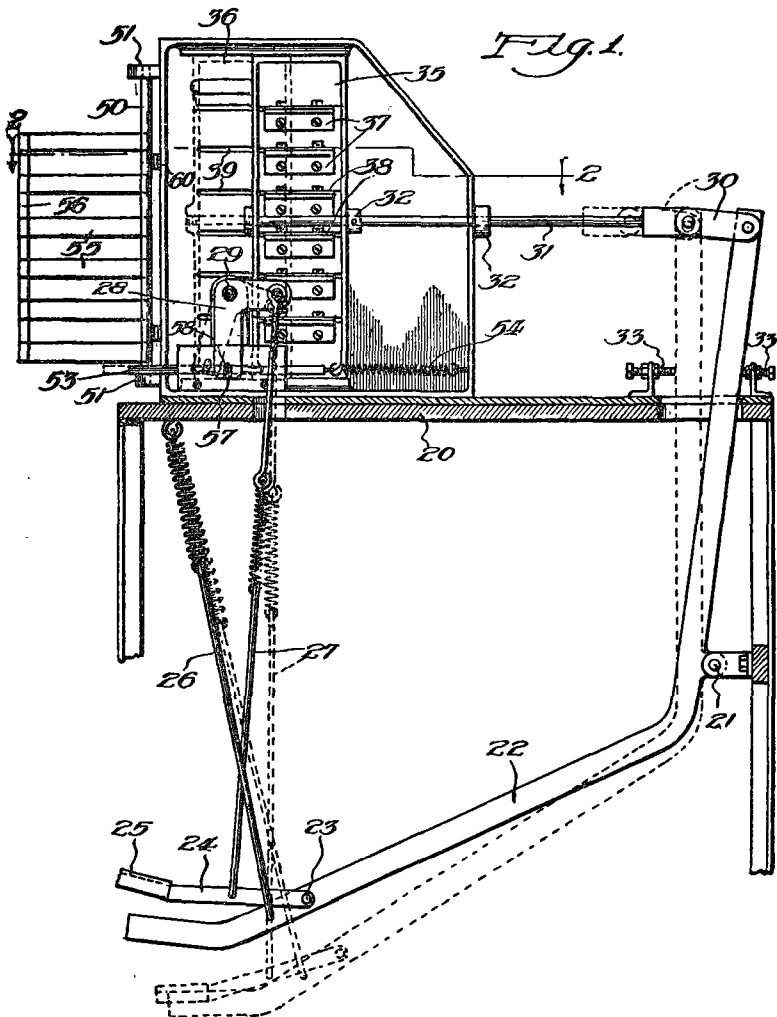
The invention covered by letters patent No. 282,214 refers to alleged improvements in machines for assembling cartons.

The object of the invention is stated as follows:

This invention relates to a machine for assembling loose partitions in a carton such, for example, as is suitable for the reception of eggs. The carton herein set forth consists of a blank which is doubled over along its longitudinal centre and which is provided in each of its two sections with registering transverse slots through which are inserted loose partition members. As these partitions are several in number for each carton, it follows that the operation of setting these partitions in place involves considerable time and effort. It is with a view to expediting this assembly of the partitions in such a carton that the present machine has been designed.

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Figures 1 and 4 of the drawings, reproduced below, will help in understanding the description of the alleged invention as set forth in the specification.



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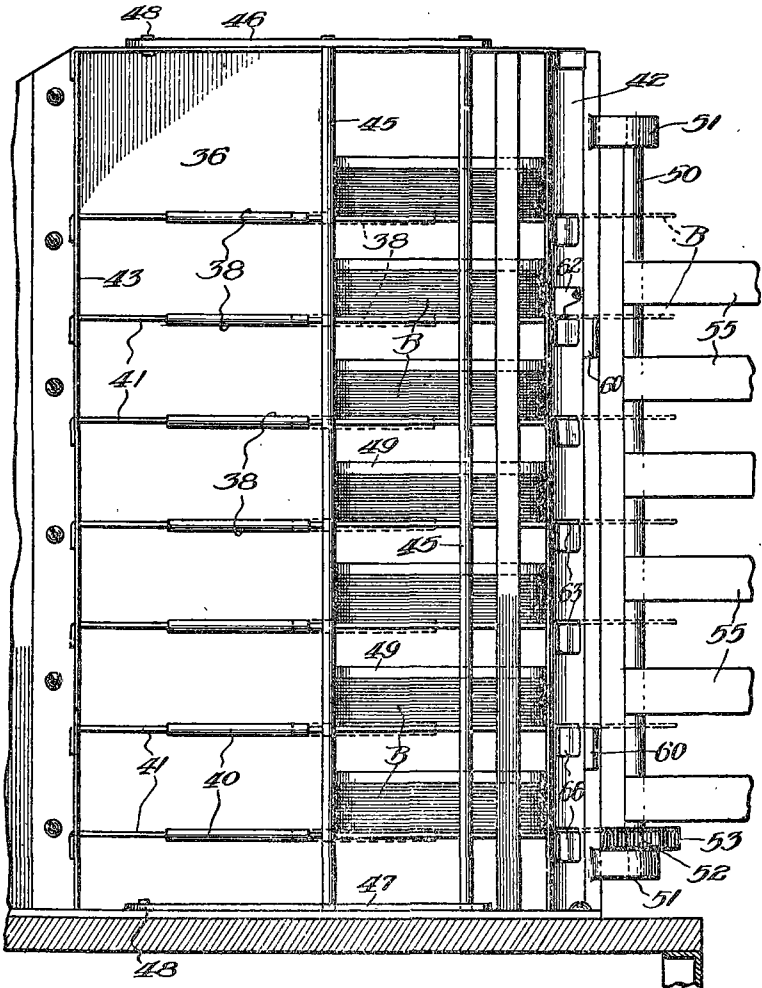
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Fig. 4.



The patentee describes his invention as follows:

The machine which assembles the partition cards within the slots of the carton blank will now be explained. As shown in Fig. 1, it may be mounted upon a bench or table 20 with which is associated a pivotal support 21 for a lever 22 constituting an operating treadle. Pivoted as at 23 to the treadle is a second lever 24 having a laterally extending pedal 25 adapted, when depressed, to engage with the proximate end of the treadle lever 22 whereby to move the same. A spring connection 26 extending between the treadle 22 and the table 20 normally holds the former in an upward position, and by means of a similar spring connection 27, which extends upwardly from the pedal lever 24, this latter element also is normally maintained in an upper position.

The upper end of the spring connection 27 is joined to a bell crank 28 pivoted as at 29 to a fixed part of the machine. A link connection 30 also extends between the upper end of the treadle lever 22 and a pusher



bar 31 slidably mounted within bearings 32 to reciprocate certain parts within the machine. As by means of adjustable stops 33 the movement range of the pusher bar can be definitely controlled. The effect of pressure applied to the pedal 25 is first to transmit movement to the bell crank lever 28, following which the treadle 22 is actuated to reciprocate the pusher bar 31.

A vertically extending head 35 connected to one end of the pusher bar is slidably mounted within the machine frame which includes a vertical wall 36. I provide also upon the pusher head a series of bracket supports 37 spaced equidistantly one above the other. These supports each afford a mounting for a blade 38 which extends laterally of the pusher head and through slots 39 in the frame wall 36. Each blade at its outer end may be bent upon itself as at 40 so as to embrace loosely one edge of a guide plate 41 carried between the respective front and rear walls 42 and 43 which are supported adjacent the ends of the frame wall 36. The front wall is, by preference, not quite perpendicular to the line of movement of the pusher rod 31 and ejecting blades 38 carried thereby.

The specification then deals with the compartments defined by the guide plates (41) upon which may be stacked a quantity of partitions (indicated by letter B on figure 4) and describes a swinging frame affording a partial closure for these compartments; and it continues thus:

Adjacent one side of the front of the machine is a vertically extending shaft 50 the ends of which are rotatively carried within upper and lower bearings 51. Mounted on the shaft near its lower end is a pinion 52 in meshing relation with a rack bar 53. This rack bar is extended rearwardly along one side of the machine, as indicated in Fig. 1, for connection with a spring 54 which tends to draw the bar rearwardly. Extending laterally from the shaft 50 are a plurality of bars 55 one for each card stack on the guide plates 41. The swinging ends of these bars may be connected to a common vertical bar 56. These several bars form, in effect, a gate which is normally held open, as shown in Figs. 1 and 2, by the spring 54. This gate is adapted to be closed, however, in response to movement of the bell crank 28 transmitted through a connection consisting of a slot 57 and pin 58 therein extended laterally from the rack bar.

The specification then explains how the carton blank folded upon itself is maintained in a vertical operative position and how the partition members are projected through each of the slots in the carton blank.

The patentee concludes thus:

The advantages of the present machine are that it facilitates assembly of the partition members into the carton blank. Were this operation to be performed by hand, it would be necessary to handle each of these partitions separately. With the present machine, however, all the partition members are correctly positioned in one operation. This is accomplished expeditiously and always with a uniformity which is sparing of damage to the carton.

All the claims are relied upon; claims 2, 4, 5 and 10, which are typical, may be quoted:

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2. A carton assembling machine in which is combined means for centering a slotted carton adjacent one edge of a partition member adapted to be inserted therethrough, means for advancing the partition into the carton slot, means for holding the carton stationary during such movement, and a single operating means for the two means last mentioned, substantially as described.

4. In a carton assembling machine, the combination of a plurality of ejectors adapted to advance a plurality of partitions, means for holding a carton blank in position for insertion through slots therein of said partitions, the blank being disposed angularly with respect to the line of advance thereof, said holding means permitting the carton blank thereafter to be shifted laterally and be straightened up perpendicularly to the line of partition advancement, and means for operating said partition ejectors simultaneously, substantially as described.

5. In a carton assembling machine, the combination with a frame, of a head slidably mounted therein, means for reciprocating the head, a plurality of ejectors connected for movement with the head and extended laterally therefrom through the frame, guide plates, one for each ejector, providing supports for a plurality of stacked partitions the lowermost of which is displaceable with each forward movement of the ejectors, and means for holding a slotted carton blank in position to receive there-through a plurality of partitions with a single operation of the ejector head, substantially as described.

10. In a carton assembling machine, the combination of a vertical frame wall having horizontal slots therein, a head slidably mounted on one side of said wall, ejector blades carried by the head and extended laterally through said slots to the opposite side of said wall, supports on said latter side of the wall whereon are arranged a plurality of card stacks one in operative relation to each ejector blade whereby the lowermost card in each stack may be displaced thereby, a movable closure for holding all of said stacks in position, and means for retaining a slotted carton blank in position to receive simultaneous insertion of a card from each stack, substantially as described.

The amended statement of claim alleges that the defendants have infringed the rights of the plaintiffs under the said letters patent, as set out in the particulars of breaches, and threatens to continue the said infringement.

The amended particulars of breaches state that the defendants have, since the issue of the letters patent, at their place of business in Montreal, sold, in the ordinary course of their business, egg cartons which constitute an infringement of the said letters patent; that the precise number and dates of the defendants' infringements are presently unknown to the plaintiffs, but that the latter will claim full compensation in respect of all such infringements.

In their statement of defence the defendants deny or say that they are ignorant of the allegations contained in the statement of claim, plead that the letters patent in suit have always been invalid, null and void for the reasons set forth in the particulars of objections and deny having

infringed them; the defendants also deny the particulars of breaches filed by the plaintiffs.

In their particulars of objections the defendants rely on lack of subject-matter, absence of utility and want of novelty.

The defendants aver that the alleged inventions were not new, but were made and used by others before they were made by the applicants for the said patents, as appears from the common knowledge of the art on said dates and from the prior knowledge shown by the patents hereinafter set out and the applications therefor.

The defendants claim that the alleged inventions covered by letters patent Nos. 200,100 and 282,212 were known to the persons to whom the following patents were granted and that they were anticipated and disclosed in the said patents and the applications therefor, to wit:

UNITED STATES PATENTS

|                  |                   |                |
|------------------|-------------------|----------------|
| Stevens .....    | March 10th, 1878. | No. 201,568.   |
| Page .....       | Nov. 9th, 1880.   | No. 234,141.   |
| Ferguson .....   | March 31st, 1896. | No. 557,371.   |
| Barkley .....    | Dec. 20th, 1898.  | No. 616,392.   |
| Batchelder ..... | Oct. 2nd, 1900.   | No. 658,906.   |
| Vernon .....     | Feb. 6th, 1906.   | No. 811,676.   |
| Keys .....       | April 21st, 1908. | No. 885,159.   |
| Wilson .....     | Dec. 1st, 1908.   | No. 905,615.   |
| Carter .....     | Aug. 30th, 1910.  | No. 969,087.   |
| Eddy .....       | Oct. 25th, 1910.  | No. 973,927.   |
| Wilson .....     | Jan. 6th, 1914.   | No. 1,083,512. |
| Tieman .....     | Nov. 24th, 1914.  | No. 1,118,702. |
| Weis .....       | May 25th, 1915.   | No. 1,140,643. |

The defendants claim that the alleged invention covered by letters patent No. 282,214 was known to the persons to whom the following patents were granted and that it was anticipated and disclosed in the said patents and the applications therefor, to wit:

UNITED STATES PATENTS

|                      |                 |                |
|----------------------|-----------------|----------------|
| Damren .....         | March 18, 1890. | No. 423,415.   |
| Bates .....          | Nov. 3, 1896.   | No. 570,621.   |
| Williams .....       | Dec. 29, 1896.  | No. 573,947.   |
| Herr .....           | July 13, 1897.  | No. 586,519.   |
| Weis & Starman ..... | March 3, 1908.  | No. 880,845.   |
| Schleicher .....     | March 17, 1914. | No. 1,090,655. |

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The defendants further state: that the claims in the letters patent in suit claim more than the applicants invented; that the specifications and claims do not set forth clearly the improvements and are not limited to the improvements on which the applicants base their invention; that the alleged inventions were not useful; that the specifications contain more than was necessary for obtaining the end for which they were made and that the additions were wilfully made for the purpose of misleading; that the specifications contain less than was necessary for obtaining the end for which they were made and that the omission was wilfully made for the purpose of misleading.

I shall first deal with patents Nos. 200,100 and 282,212, both of which relate to egg cartons. When I am through with them, I shall turn my attention to patent No. 282,214, which, as we have seen, concerns an entirely different subject, viz., a machine for assembling cartons.

The old type of egg carton, which has been on the market for a great number of years, is like a shoe box with a kind of honeycomb cell which is put into the box. The cells are square and consequently do not exactly fit the eggs.

The egg cartons of the defendants as well as of the plaintiffs are quite different from the old carton of the shoe-box type. They have a greater strength both in a vertical and in a lateral direction; the compartment cells are not square as in the old carton but are more or less a sort of tapered receptacle which offers more protection to the egg.

The body member of the carton is formed from a blank folded upon itself along its longitudinal centre line so as to provide a centre partition wall and folded on each side of this centre partition wall so as to provide the bottom of the two sections of the carton, the longitudinal side walls and the cover extending inwardly from each side wall. In the centre wall and the side walls there are slots through which the partitions or cross walls are inserted.

The type of collapsible or knock-down carton for eggs, comprising a foldable body member and cross walls or partitions is not new; it is disclosed in the following patents: U.S. patent No. 557,371 issued to William H. Ferguson on March 31, 1896 (exhibit P3); U.S. patent

No. 811,676 issued to Frederick R. Vernon on February 6, 1906 (exhibit P5); U.S. patent No. 885,159 issued to Benjamin Keys on April 21, 1908 (exhibit P7); U.S. patent No. 905,615 issued to Michael H. and Leonard B. Wilson on December 1, 1908 (exhibit P8); U.S. patent No. 969,087 issued to James H. Carter on August 30, 1910 (exhibit P9); U.S. patent No. 973,927 issued to Charles A. Eddy on October 25, 1910 (exhibit P11); U.S. patent No. 1,083,512 issued to Leonard B. Wilson on January 6, 1914 (exhibit P12); U.S. patent No. 1,118,702 issued to George Tieman on November 24, 1914 (exhibit P13).

It was contended on behalf of plaintiffs that new features comprised in patent No. 200,100 consisted in the facility of assembling the carton components and in the fact that the eggs are suspended and are thus less exposed to shock and breakage. These features, in my judgment, are found in the U.S. patents Nos. 905,615, 1,083,512 and 1,118,702 above mentioned.

With regard to patent No. 282,212, the proof discloses that the only substantial difference between it and patent No. 200,100 lies in a little projection at the top of the slot in the cross wall adapted for insertion within the slots of the blank so as to prevent the disassembly of the cross walls and the blank. I do not believe that the addition of this projection required the exercise of inventive ingenuity; it is merely the result of mechanical ability or, in other words, a workshop improvement.

I may say incidentally that, had I reached the conclusion that patents Nos. 200,100 and 282,212 were valid, I would not have felt disposed to declare that they had been infringed by the defendants. The defendants' carton, which like the plaintiffs' carton, contains the characteristics found in the anticipatory patents aforesaid, includes in addition features which are not found in the plaintiffs' carton and are not covered by patents Nos. 200,100 and 282,212. Seeing the conclusion to which I have arrived I do not think that dwelling upon these additional features at length would serve any useful purpose. It will suffice to note (*inter alia*) that the defendants' carton, when it is shipped to the purchaser, is complete and ready for use. In this connection I may perhaps quote an extract from the deposition of Leopold Limoges, manager of L. Limoges et Compagnie, wholesale provision dealers, a witness heard

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on behalf of defendants, who declared he had no interest whatever in the issue of the present case; at page 16 of his deposition we find the following remarks:

R. Ce qui m'a fait adopter la boîte Cormier, c'est que nous recevions la boîte Cormier faite, rendue en magasin toute complétée, faite, tout monté.

D. Voulez-vous expliquer ce point-là? Je vous réfère à la même boîte sous forme pliée; je comprends que c'est sous forme pliée que vous la receviez?

R. Oui.

D. Expliquez donc à la Cour ce que vous venez de dire?

R. Pour faire la boîte Cormier, on n'a pas à la faire, elle est toute faite.

La Cour:

D. Vous les receviez toutes faites?

R. Oui. C'est-à-dire pliées.

D. Pliées comme elles sont là?

R. Oui. Et je n'ai pas d'opération à faire. Je prends la boîte Cormier, je l'ouvre. Elle est faite en arrivant je suis prêt à déposer mes œufs dedans, dès la minute que je la reçois. Je n'ai pas besoin d'avoir d'aide additionnel pour préparer la boîte.

Reference may also be had, in this connection, to the deposition of Raymond A. Robic, professional technician graduate of the Montreal Technical School, member of the Association of Civil Engineers of France, president of the Patent Institute of Canada and director of technics of the firm of Marion et Marion, patent solicitors of Montreal, called as witness by defendants; at pages 105 (last line) and 106, Robic says:

R. Voici les parois—sauf une couple que je ne peux pas tenir—qui sont toutes couchées. Maintenant, dès qu'on lâche la boîte, il faut qu'elle s'écarte et c'est un écartement qui rend inévitable la position transversale que viennent prendre les cloisons par rapport au sens longitudinal de la boîte.

D. Cette tendance à s'ouvrir ou plutôt cette ouverture partielle offre-t-elle un avantage au point de vue de l'utilisation de ces boîtes?

R. Sans doute.

D. Cela nécessite moins de manipulation?

R. Cela nécessite énormément moins de manipulation. Il s'agit pour l'opérateur ou plutôt pour celui qui doit mettre les œufs dans la boîte de la prendre dans le magasin dans lequel elle se trouve empilée pardessus les autres et en la prenant il est immédiatement prêt à mettre les œufs qu'elle doit contenir dans chacune de ses cellules, dans chacun de ses compartiments.

The defendants' carton is completely erected; the cross walls or partitions are inserted through the slots of the side walls as well as of the longitudinal centre wall; it merely needs being unfolded to be ready to receive the

eggs. In the plaintiffs' carton the cross walls are only inserted through the longitudinal centre wall and, when the carton is unfolded, the cross walls have to be inserted through the side walls. The use of the defendants' carton saves to the egg dealer time, labour and cost; as Robic stated: "cela nécessite énormément moins de manipulation"; or as Limoges, speaking of the Cormier box, said: "Elle est faite, en arrivant je suis prêt à déposer mes œufs dedans, dès la minute que je la reçois. Je n'ai pas besoin d'aide additionnel pour préparer la boîte." A summary examination of the plaintiffs' and defendants' cartons folded will be sufficient to demonstrate the advantage of the Cormier carton over the plaintiffs' carton in this respect.

I shall now turn my attention to patent No. 282,214 concerning the machine for assembling egg cartons and deal with the question of anticipation. In their amended particulars of objections the defendants claim that the alleged invention covered by the said patent was disclosed and anticipated in seven patents and the applications therefor. At the trial the defendants only relied on three of these anticipatory patents, namely, Damren No. 423,415, Herr No. 586,519 and Schleicher No. 1,090,655.

The Damren patent relates to a machine for making paper boxes; the object of the invention is to provide a machine for automatically pasting the ends of the box and applying them to the body. The specification states that the principal features of the machine are "an open-ended receptacle for containing the box end pieces, a form for containing the box-body having a rearward recess or opening, a slide or carrier having an extensible end reciprocating by the open end of said receptacle and adapted to convey the box end from its receptacle to said form, an anvil-block above said form, cam mechanism for causing said anvil-block and form to press against each other to secure the end to the body, a paste-reservoir, and a row or series of fingers having a reciprocating motion from the paste to the surface of the end piece."

After a careful examination of this patent I may say that I have reached the conclusion that the Damren patent cannot be considered an anticipation of the plaintiffs' patent No. 282,214; it does not disclose all the essential features of the plaintiffs' invention.

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The second patent relied upon by defendants as anticipatory is that of Herr, No. 586,519, styled "Means for making cell cases." The invention relates to means for making cell cases in which eggs are packed for transportation. As in the case of the Damren patent I do not think that the Herr patent discloses all the essential features of patent No. 282,214 and can be looked upon as an anticipation.

There remains the Schleicher patent, No. 1,090,655, for a crate or rack making machine. The specification states that the invention pertains to crate or rack making machines and more specifically to machines for assembling strips of wood to produce racks such as used to hold bottles. It is hardly necessary to note that the Schleicher machine is double and that it is sufficient to consider one side of it for the purpose of comparison with the plaintiffs' machine.

The patentee describes his invention thus:

The machine stated in general terms may be said to comprise two heads or members, having a relative movement toward and from each other, said heads carrying means adapted to position and hold the main notched bars or members of the crate, combined with means for holding the cross strips or rods, preferably magazine holders, and means for forcing said strips into the notches of the bars, suitably timed mechanism being employed to operate the various parts and to effect the discharge of the assembled racks.

As in the case of the Benoit patent there is in the Schleicher machine a head slidably mounted carrying means adapted to position and hold the main notched bars or members of the crate, means for holding a stack of cross strips, means for ejecting the cross strips and forcing them into the notches of the bars or members and a mechanism to operate the various parts of the machine. After a careful comparison of the two machines I am satisfied that the Schleicher machine includes the essential features found in the plaintiffs' machine.

It is true that the Schleicher patent applies to wooden crates or racks while the plaintiffs' patent relates to cardboard boxes or cartons. I do not think that the difference of material has any importance. The substitution of material constitutes merely a new use of a known contrivance without any inventive ingenuity and, to my mind, it does not form proper subject-matter for a patent.



In order that a new use of a known device may constitute the subject-matter of an invention, it is necessary that the new use be quite distinct from the old one and involve practical difficulties which the patentee has by inventive ingenuity succeeded in overcoming; if the new use does not require any ingenuity but is in manner and purpose analogous to the old use, although not exactly the same, there is no invention; *Harwood v. Great Northern Railway Company* (1); *Penn v. Bibby* (2); *Blakey & Co. v. Latham and Co.* (3); *Morgan and Co. v. Windover and Co.* (4); *Gadd and Mason v. The Mayor, &c., of Manchester* (5); *Riekmann v. Thierry* (6); *Acetylene Illuminating Co. Ltd. v. United Alkali Co. Ltd.* (7); *Bonnard v. London General Omnibus Company* (8).

The remarks of Lord Lindley in *Gadd and Mason v. The Mayor, &c., of Manchester (ubi supra)* are interesting and may conveniently be quoted (p. 524):

These cases, and many others which might be cited, establish the following propositions applicable to the present case, viz.: 1. A patent for the mere 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 purpose analogous to the old use, although not quite the same, there is no invention; no manner of new manufacture within the meaning of the Statute of James. 2. On the other hand, a patent for a new use of a known contrivance is good and can be supported if the new use involves practical difficulties which the patentee has been the first to see and overcome by some ingenuity of his own. An improved thing produced by a new and ingenious application of a known contrivance to an old thing, is a manner of new manufacture within the meaning of the Statute.

In the case of *Riekmann v. Thierry (ubi supra)* Lord Halsbury expressed the following opinion (p. 115):

My Lords, it appears to me that there is no invention in applying to eyelets either celluloid or any other similar material. Whether there is or is not invention such as will support a patent is a question of fact and degree, and the state of facts and degree in one case can never be any guide in another. It is certainly quite true that mere simplicity will not prevent there being invention. It is often justly urged in favour of a patent that its very simplicity is the merit of the invention. Sir George Jessel, in *Hinks and Son v. The Safety Lighting Company*, L.R. 4 Ch. D. 607, pointed out in his judgment that the substitution of a flat wick for a round one might well be, and was in that case, a sufficient invention to support a patent, where, as he held in that case, the round wick patented by a former inventor was not available for any useful purpose,

(1) (1865) 35 L.J.Q.B. 27.

(2) (1866) L.R. 2 Ch. App. 127.

(3) (1889) 6 R.P.C. 184.

(4) (1890) 7 R.P.C. 131.

(5) (1892) 9 R.P.C. 516.

(6) (1897) 14 R.P.C. 105.

(7) (1905) 22 R.P.C. 145.

(8) (1921) 38 R.P.C. 1.

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whereas the flat wick had supplied a great want, and had worked to a great extent with a useful result. On the other hand, the Court of Queen's Bench in *Brook v. Ashton*, 8 Ell. & B. 478, decided that there was no novelty in applying revolving beaters or burnishers by certain machinery which had been applied to cotton and linen, though never before to woollen threads, though the Court assumed that the effect produced on woollen thread was different from that produced on cotton or linen, and was new and beneficial.

I refer to these two cases only as illustrative of the proposition that no smallness or simplicity will prevent a patent being good, while mere novelty of manufacture, or usefulness in the application of known materials to analogous uses, will not necessarily establish invention within the meaning of the patent laws.

Perhaps I may cite a passage from the observations of Lord Chelmsford in the case of *Penn v. Bibby* (p. 135) :

The third and last question raised here, was upon the finding that the invention was the proper subject-matter of a patent.

To this it was objected that the finding is erroneous, because the alleged invention was merely a new application of an old and well-known thing. It is very difficult to extract any principle from the various decisions on this subject which can be applied with certainty to every case; nor, indeed, is it easy to reconcile them with each other. The criterion given by Lord Campbell in *Brook v. Astor* (8 E. & B. 485) has been frequently cited (as it was in the present argument), that a patent may be valid for the application of an old invention to a new purpose, but to make it valid there must be some novelty in the application. I cannot help thinking that there must be some inaccuracy in the report of his Lordship's words, because, according to the proposition, as he stated it, if the invention is applied to a new purpose, there cannot but be some novelty in the application. Lord Chief Justice Cockburn approaches much nearer to the enunciation of a principle, or at least of a rule for judging these cases, in *Harwood v. Great Northern Railway Company* (2 B. & S. 208), where he says, "although the authorities establish the proposition that the same means, apparatus, or mechanical contrivance, cannot be applied to the same purpose, or to purposes so nearly cognate and similar as that the application of it in the one case naturally leads to application of it when required in some other, still the question in every case is one of degree, whether the amount of affinity or similarity which exists between the two purposes is such that they are substantially the same, and that determines whether the invention is sufficiently meritorious to be deserving of a patent."

In every case of this description one main consideration seems to be, whether the new application lies so much out of the track of the former use as not naturally to suggest itself to a person turning his mind to the subject, but to require some application of thought and study.

Reference may also be had with profit to the remarks of Lord Dunedin in the case of *Pope Appliance Corporation v. Spanish River Pulp and Paper Mills* (1), relative to the question of anticipation; at page 275, he said:

The objections, as already stated, are based on want of novelty and subject-matter, that is, want of invention, and also of anticipation. It

will be convenient to examine anticipation first, as much of the argument on want of invention is bound up with what was disclosed by the patents which are said to anticipate. The test of anticipation has been dealt with in many cases. They were enumerated in the very recent case of *British Thomson Houston Co. v. Metropolitan Vickers Electrical Co.* (45 R.P.C. 1). A passage in the judgment (*ibid.* 23) runs thus: "In *Otto v. Linford* (1882) 46 L.T. 35, 46) Holker L.J. expresses himself thus: 'We have it declared in *Hill v. Evans* (1862, D.F. & J. 288) as the law, and it seems very reasonable, that the specification which is relied upon as the anticipation of an invention must give you the same knowledge as the specification of the invention itself.' And in *Flour Oxidising Co. v. Carr & Co.* (1908, 25 R.P.C. 428, 457, Parker J. (afterwards Lord Parker) says: 'Where the question is solely a question of prior publication, it is not, in my opinion, enough to prove that an apparatus described in an earlier specification could have been used to produce this or that result. It must also be shown that the specification contains clear and unmistakable directions so as to use.' And the remarks of Lord Dunedin in *Armstrong, Whitworth & Co. v. Hardcastle* (1925, 42 R.P.C. 543, 555) are quite in line with these dicta." In the same case the test is stated (45 R.P.C. 1, 22), and turning the particular instance to the general may be expressed thus: Would a man who was grappling with the problem solved by the patent attacked, and having no knowledge of that patent, if he had had the alleged anticipation in his hand, have said, 'That gives me what I wish.'?

At page 281 Lord Dunedin, dealing with the questions of anticipation and analogous user, expressed himself as follows:

Having these views, it is clear that, in their Lordships' opinion, the learned trial judge misdirected himself. He arrived at the opinion that the invention was old by making a mosaic of other and prior descriptions. He also, in their Lordships' opinion, took quite an erroneous view as to an analogous user. Analogous user is what its name denotes, something which has to do with user. He has applied the doctrine not to things used but to things described. But as to things only described, there must either be anticipation or not. And anticipation must be judged by the canons already mentioned. Does the man attacking the problem find what he wants as a solution in the prior so-called anticipations? The distinction between anticipation by prior description and by prior user is well understood. The doctrine of analogous user only applies to cases as to things in actual use. The leading case is the fishplate case: *Harwood v. Great Northern Ry. Co.* (1865, 11 H.L.C. 654). That dealt with the question whether there could be a good patent for a fishplate on a railway where the same fishplate had been used on a bridge. Blackburn J., one of the consulted judges, who although he differed on the ground that the thought there was a real difference between the two fishes, yet concurred with all the others as to the law, states the problem thus (*Ibid.* 667): 'In every case arises a question of fact, whether the contrivance before in use was so similar to that which the patentee claims that there is no invention in the differences.' The contrivance, be it observed, must be a contrivance in use, not one merely described. Then there was the case of *Morgan & Co. v. Windover & Co.* (1890, 7 R.P.C. 131), the *C-spring* case. Throughout the judgment analogous user is only

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applied to a known thing. In the words of Lord Halsbury (*Ibid.* 134): 'The application of well known things to a new analogous use is not properly the subject of a patent.'

See also *Canadian General Electric Co. Ltd. v. Fada Radio Ltd.* (1); *British Celanese Ltd. v. Courtaulds Ltd.* (2); Terrell on Patents, 8th ed., p. 71; Fox, Canadian Patent Law and Practice, pp. 78 *et seq.* and pp. 113 to 116; Nicholas on Patent Law, p. 23.

Questions of invention and anticipation are questions of fact. No general rule can be laid down to determine whether any particular instance involves invention or not or whether any prior publication constitutes an anticipation or not. Each case must be determined on its own merits. After carefully perusing the evidence and the argument of counsel, I believe that the specification of the Schleicher patent was liable to disclose to Benoit the material elements and features found in patent No. 282,214.

I may state in passing that if I had decided that patent No. 282,214 was valid, I would have felt inclined to declare that the defendants' machine constitutes an infringement of the said patent. Although to a certain extent differently constructed, being more effectual and producing a complete carton instead of merely inserting partitions through the slots of a blank, it contains the same characteristics as those set forth in the said patent and reproduced in the plaintiffs' machine.

For the reasons hereinabove mentioned, I have reached the conclusion that the letters patent for invention Nos. 200,100, 282,212 and 282,214 are invalid, null and void as between the parties hereto and that the plaintiffs' action must accordingly be dismissed.

The defendants will be entitled to their costs against plaintiffs.

*Judgment accordingly.*