
BETWEEN:

BARBARA B. DEFREES AND BETTS MACHINE COMPANY, PLAINTIFFS;

AND

DOMINION AUTO ACCESSORIES LIMITED, ... DEFENDANT.

1962
Oct. 15, 16, 17, 18, 22
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Oct. 23

Patents—Patent Act, R.S.C. 1952, c. 203, ss. 2(d), 24, 28(1)(b), 36(1), 46 and 80—Patent Act, S. of C. 1935, c. 32, s. 47—Invention to be defined in claim—Anticipation—What to be included in prior art when considering anticipation—What necessary to constitute invention—Combination of things—Statutory presumption of validity—Onus of showing lack of inventive ingenuity on person attacking patent—Requirement to have patented articles marked with year of date of patent.

The plaintiffs sued for infringement of a patent for a removeable sealing device for vehicle marking lights, the patent being owned by the plaintiff, Barbara DeFrees and licensed exclusively to the plaintiff Betts Machine Company. The validity of the patent was attacked for anticipation, lack of invention or subject matter and for failure of the patentee to have the patented articles marked in accordance with s. 24 of the *Patent Act*. The defendant alleged that since the patentee related his invention in the specification not to vehicle marking lamps but rather to a static seal and it was only in the claim of the patent that the invention was related to the auomobile lamp field, all patents covering closures or means of sealing enclosures and static seals for housing any unit chambered containers or hollow bodies were brought into the prior art to be reviewed by the skilled workman.

Held: That since it is clear from the title of the patent in suit that the art to be referred to is the vehicle marking light art and the claim relates to the art of vehicle lamps, this is the main art to be looked at by the Court or a skilled workman in order to determine whether or not the patent was anticipated or was obvious. However, the skilled workman or the Court may look at anything that may be of assistance in this regard, the reference in a patent dealing in one art (vehicle lamps) to another art (enclosures), as in this case, being one element to be considered in determining whether from such a directed use in the patent (use in vapour-proof containers) the patentee in effect invented something that was new or that was obvious.

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2. That whether the statutory presumption of validity of a patent is a heavy or easy one to displace is a question of fact in each case. However, the alleged infringer has the burden of not only attacking the validity of the patent in issue but of also placing the Court in the position of one skilled in the prior art.

3. That in order to establish anticipation, the defendant must show that whatever is essential to the invention or necessary or material for its practical working and real utility appears in the prior publication. He must establish that the whole invention has been published with all the directions necessary to instruct the public how to put it into practice. When documents are produced as anticipations they must be read singly and must in no way be combined together to form a mosaic of extracts. In none of the prior art patents or publications produced in this case can an answer be found to the problem solved by the patent in issue, and the attack on the patent on the basis of anticipation or lack of novelty accordingly fails.

4. That although the patent itself does not restrict the inventor to a construction where the O-ring is permanently seated in the housing or where the lens is inserted by a cocking action, the former is indicated by a reasonable reading of the patent and an examination of the drawings and the latter is clearly inferred from the disclosure, so both advantages should be considered in determining the validity of the patent.

5. That the definition of invention in s. 2(*d*) of the *Patent Act* requires not only novelty and utility but also the attribute of inventiveness.

6. That in order to determine whether or not there is inventiveness the prior art should be reviewed and its cumulative effect considered.

7. That the patent in suit is a new combination, for it is a combination of a particular sealing method not entirely similar to that found in the prior art transferred to the sealing together of two well known parts, a slightly cupped lens and a cupped housing, but in a different manner and with an entirely different purpose or object than it accomplished when sealing a jar or an enclosure. Most patents are combinations of elements which are well known and old, the patent being for the combining of them for a new purpose and inventive ingenuity being used in combining and adjusting existing devices and thereby achieving new and valuable results. In the present case, there is this ingenious combining but in addition there is a completely different disposition of the component parts and these parts themselves are different.

8. That the fact that all the prior art patents cited are very old and that many years elapsed before someone thought of applying the well known things contained therein to the vehicle lamp field, as well as the widespread acceptance of the invention in the fuel tank industry despite a higher price and that the plaintiffs' lamp displaced previous types in that industry to a significant extent are secondary considerations indicating the existence of inventive ingenuity in the patent in suit and that it was far from obvious.

9. That the provision of Sec. 24 of the *Patent Act* requiring the patented articles to be marked with the year of the date of the patent is merely directory, the marking being required only when possible, and the failure to so mark the patented articles might involve at the most a liability to penalty as provided by Sec. 80 of the Act.

10. That the conditions referred to in Sec. 46 of the *Patent Act* do not include the marking provision which is dealt with in Secs. 24 and 80 of the Act.

11. That the defendants' marking light infringes the plaintiffs' patent.

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ACTION for infringement of a patent.

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

W. L. Hayhurst and *David Rogers* for plaintiffs.

Donald F. Sim, Q.C. for defendants.

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

NOËL J. now (October 23, 1963) delivered the following judgment:

This is an action for infringement of patent No. 522093 issued February 28, 1956, to Joseph H. DeFrees, the inventor, now owned by plaintiff Barbara B. DeFrees, and licensed exclusively to Betts Machine Company, the other plaintiff, a United States corporation having its head office and chief places of business at Warren, Pennsylvania. The defendant is a Canadian corporation and has its head office and chief place of business at Toronto, Ontario.

A large number of defences were raised in the statement of defence and in the particulars of objections, but at the trial counsel narrowed his case to three specific matters: (1) lack of invention or subject matter; (2) that the claim is not new but was anticipated by prior inventions; (3) failure by the patentee to have marked the patented articles in accordance with s. 24 of the *Patent Act*.

He conceded that the defendant's lamp V. P. 236T, Ex. 6, infringes the patent in suit if this patent is valid and that the device therein was useful, his entire defence being limited to the question of validity.

The invention defined by the claim in suit relates to a "Removable sealing device for vehicle marking light". The invention date on which the plaintiffs rely goes back to 1951. This is not in dispute.

Vehicle marking lights are used on tanker trucks that travel on the highway and indicate at night the bounds of the truck, its edges and corners, so as to indicate to other

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drivers the limits of the vehicle for the purpose of avoiding accidents; some of these lights are also used to show the height of the vehicle. The lights on the side of the trucks are termed coloured lights, whereas those at the front and the rear are called clearance lights.

The patent in suit, No. 522093 of the Canadian Patent Office, relates to an alleged new and useful improvement in vehicle marker lights and more specifically to a simple means of sealing the lamp and of removing it when needed.

The application for the Canadian patent was filed on November 9, 1951, and the patent was issued on February 28, 1956.

The specification states *inter alia* that:

> The present invention relates to a novel and improved vapor-proof and leak-proof enclosure, and to a static seal especially adapted for use as a low pressure sealing element in combination with a chambered container or hollow body and a closure therefore.
>
> An object of the invention is to provide a seal which permits ready attachment and removal of the closure, using only a simple tool such as a screwdriver or stout knife blade. The sealing element is quite inexpensive and immediately replaceable if it becomes unserviceable after extended use. A number of adaptations where such seal can be advantageously used will immediately occur to those skilled in the art.
>
> It can be used, for example, in a blow out cap for low pressure safety-valve type operation in conjunction with containers where it is desirable that the pressure in the space be maintained below a predetermined figure. In the meantime, the chamber is effectively sealed against dust, dirt, or moisture contamination, as will appear herein below.
>
> A further object of the invention is to provide a vapor-proof enclosure adapted to receive a static seal as herein defined.

As an illustration of the structure and an advantageous use of his static seal, the inventor then refers to one of the many possible useful embodiments of his invention, that of a vehicle marker or clearance light attached to a vehicle.

Then there is a description by way of reference to drawings of this vehicle marker or clearance light as follows:

> In the drawings there is shown a portion of a panel 11 forming the side, front, or rear wall of a vehicle, the wall being usually of sheet metal. The wall is provided with an opening 12 of suitable shape and size to receive a cupped lamp housing 13.
>
> If desirable, and as is usual, the inner wall of the lamp housing may have a polished reflecting surface 13a.
>
> The housing wall is provided with a socket 14 which can be fixed in the wall, and is here shown as having a screw-thread engagement therein. The socket carries a lamp 15 which is fixed at the focal point of the housing. A lens 16 is retained in the housing as will presently be more fully described.

As is well known, plated surfaces of the reflector type when exposed to air and moisture, progressively deteriorate or become covered by a coating of dirt and dust, so that the housing must occasionally be removed for replating, repolishing, or even replacement. In addition, moisture and dirt have a detrimental effect on electrical connections, so that current flow may be interrupted or short circuited . . .

I have provided a simple and effective sealing means which is vapor-proof and leak-proof and which permits practically instantaneous removal of the lens whenever desirable, such as for bulb replacement. The lens 16 has an axially inwardly extending annular shoulder 17. The circumferential edge of the lens extends radially outwardly beyond the shoulder, at 16a, to provide a flange which overlaps the edge flange 13b of the housing. When in assembled relationship, the shoulder portion 17 nests within the annular, peripheral edge part of the housing in telescoped relationship, but with adequate working clearance. The outer periphery of the shoulder tapers radially inwardly, converging away from the inner wall 13a of the housing. When in such assembled relationship the inner wall of the housing is provided with a peripheral groove 18 which is in planar registry with a complementary groove 19 on the outer wall of shoulder 17. The grooves are preferably of arcuate character in cross section.

Seatable in both grooves is a static seal member 20 of the type known to those skilled in the mechanical arts as an "O" ring. It is preferably circular in cross-section, when unstressed, but may be elliptical, or otherwise of rounded peripheral contour, and is of relatively resilient rubber-like material so that it can be deformed sufficiently to permit the co-operating parts to be subjected to a mildly forced fit to the assembled position shown in Fig. 4 wherein the ring 20 nests simultaneously in both grooves 18 and 19.

. . . In such position the lens is tightly retained, and the seal is so effective that there is no evidence of leakage of moisture, or other corrosive or stain-inducing medium, to the interior of the lamp housing. A screwdriver or a heavy knife blade can be inserted beneath it whereupon the lens can be removed without undue effort . . .

A replacement ring can be readily procured, if eventually desirable, and there are no clamping rings, screws, etc. to deteriorate and cause assembly and disassembly troubles.

. . . The art has previously disclosed the use of an "O" ring in what I may term "dynamic" sealing adaptations wherein such a ring is seated in a groove in one element of a relatively movable pair, the other element having a smooth wall surface.

. . . in the present application the seal is strictly a "static" one wherein there is no relative movement of the parts during service . . .

The specification ends with one claim which reads as follows:

A vapor-proof vehicle lamp comprising in combination, a housing of cup-like shape having at its open periphery an annular flange extending transversely to the axis of the housing, a discoidal slightly-cupped lens having a generally tubular flange of a diameter smaller than the housing periphery so as to be telescopingly movable thereinto and having an annular shoulder extending transversely outwardly whereby to be abuttable against said annular flange when said tubular flange is telescopingly inserted within said housing as aforesaid, the inner surface of said housing within said annular flange and the outer surface of said tubular flange

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being provided with peripheral grooves of arcuate cross section which are in mated alignment when said annular shoulder abuts said annular flange as aforesaid, the portion of said tubular flange inwardly beyond said arcuate groove being inwardly convergent conically whereby to provide a clearance between said conical portion and the inner wall of said housing, and a ring of resilient material of rounded cross section seatable partially in each said groove, the spacing between the complementary walls of said arcuate grooves, and the thickness of said ring being such that the ring is subjected to leak-proof compression when the lens is telescopingly assembled into the housing when said annular shoulder is moved into abutment with said annular flange.

In short, the claim covers a vapour-proof vehicle lamp consisting of a cup-shaped housing, a slightly cupped lens and a means of securing the two together; the lens goes into the housing telescopically and the housing is shaped to accept that telescope. The sealing of both parts is effected by means of O-rings and two mating grooves, one on the housing and the other on the lens so that when they come together in the proper relationship they snap into position. When the grooves are in alignment and the O-ring is seated between them to effect a seal the flange on the outside of the lens abuts against the flange on the housing which is the snap seal effect.

Evidence for the plaintiffs was given by Joseph H. DeFrees, president and chief engineer of the Alleghany Valve Company and the Alleghany Coupling Company in Warren, Pennsylvania, and the inventor of the patent in suit; by Richard Betts who graduated in 1953 from Grover City College with a degree in commerce, president of the Betts Machine Company, one of the plaintiffs herein which is engaged in the manufacture and sales of valves to the tank truck industry as well as vehicle lamps; by Mahlon Burgett of Touowanda, New York, safety director for Williams P. Crosset Inc., a common carrier of petroleum products and Harold Johnson, of Warren, Pennsylvania, sales and engineering manager and secretary-treasurer for the Pennsylvania Furnace and Iron Company which manufactures liquid and dry bulk trailer equipment as well as heating equipment.

The defence produced no witnesses but submitted a book of prior art containing copies of patents in the United States and photostats of British patents and a number of photostats of catalogues.

Evidence of the state of the vehicle marking light art prior to 1948 was given by the inventor of the patent in issue in the present case, Mr. J. H. DeFrees.

One of the problems in the early development of vehicle marking lights was to overcome the tendency of the lamps to untighten. Another problem and possibly the most serious one, was corrosion from the inside and outside due to this condition of untightness and also corrosion that interfered with the flow of electricity; the fact that these lights had to be screwed in created also a problem in that when replacing a burnt out lamp on the highway, the screws were difficult to insert and to screw in as the bolt holes had to line up and many were dropped and lost in the process and in many cases became rusted; the sealing qualities of these lights were very questionable and the latter consisted of so many parts that they were hard to put together and had a tendency to get away from one in the assembling process.

There was, prior to 1948, a second type of lamp where the lens is attached on by a metal snap ring illustrated by Ex. 10. However, the greatest drawback here was that the ring did not create enough pressure on the lens to adequately seal it. Sometimes the ring was hard to dislodge and at other times it was hard to assemble. This lamp in addition was made of very thin material which rusted easily, and the attaching of the lens depended a lot on the skill of the man and the care with which it was put back together; this lamp also admitted corrosion and dirt. Rusting would occur on both sides of the metal stamping, moisture would corrode the electrical contacts and the oxides would insulate it; in some instances, corrosion would lock the lamp in the socket which was objectionable, the removeability of the lamp would then become most unsatisfactory because of the number of parts involved, the complexity of the assembly, and the skill and time needed to reassemble it. These lights had repeated lamp failures which involved cost and time in replacing them and, of course, the operation on the road with lamps out was dangerous. According to Mr. DeFrees they did not do the job as a trouble-free, long life piece of equipment.

Lamp Ex. 11 was not satisfactory either as it did not do the sealing job the trade required. The lens could be removed more easily than Ex. 10, but it also gave trouble to assemble and disassemble because of its numerous parts.

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J. H. DeFrees then attempted to make an improved vehicle lamp and he thought he had one in Ex. 12. This is a lamp with clear lens and a brass body. It has a threaded body and lens with a gasket made of synthetic rubber and is rugged. However, in low temperature work, below zero, it was found that the lens shrunk so much more rapidly than the body that it became loose. This whole concept was therefore put aside because it would fall out and would not stay tight.

As a new approach to the vehicle lamp field, J. H. DeFrees then made drawing 45022 dated September 6, 1948, produced as Ex. 14 and drawing 45027A, Ex. 15, both of which are related to Ex. 13, a marker lamp with red lens. He states that he personally conceived the design and made drawing 45022 on September 6, 1948, and drawing 45027A (Ex. 15) on October 24, 1948.

Exhibit 13 is essentially a housing and a body with quite a high upstanding lug into which was inserted a gasket and a lens and this in turn was mechanically spun together thus making a permanent joint.

The method of spinning the flange and have it clamp the gasket and lens as shown on the above drawings proved to form a very efficient joint according to J. H. DeFrees. Indeed, it was tight and there was no moving of the lens. However, this design had such serious objections that it had to be abandoned. Indeed, if the lens were broken, the entire body had to be thrown away and the permanent anchorage of the lamp was objectionable. There was also a further objection in that the bulb had to be replaced from the rear side. In view of this, DeFrees states that it was decided that a vehicle lamp of this design could not be mechanized.

DeFrees kept working on a further design and on May 15, 1951, he personally made drawing No. 45079, dated May 15, 1951, (Ex. 16) which was his first approach to the use of a resilient ring for not only sealing the lens but also for anchoring it in place. On July 23, 1951, he made drawing No. 4506-7 (Ex. 18) which was used for the production of Ex. 8, an illustration of the patent in suit. The former drawing had the general principles but was not as specific as Ex. 18.

The lamp described in Ex. 16 went into production in the latter part of 1951 but not as shown in Ex. 16. Indeed,

some minor changes in the shape of the housing came in a later refinement but essentially this is the invention.

DeFrees states that the lamp described in Ex. 16, which is Ex. 8, the lamp put forward as an exemplification of the patent in issue in the present case, varies greatly from Exs. 10 and 11. These lamps are all clearance lamps but the method in which the lens is attached and sealed varies greatly. In Ex. 10 the lens is held in place with three screws, an annular clamping ring and a separate gasket. In Ex. 11 there is a separate gasket with a metal snap spring which holds the lens in place. This lamp has no O-ring nor two grooves opposite each other.

Exhibit 8, which represents the patent in suit here, has, according to Mr. DeFrees, a positive seal; it is bubble tight and no moisture can get in or out of it. It is more easily removed than the other lamps in that there is only one part which is removeable and which is replaced whereas in Ex. 10 there are five parts which become disengaged from the vehicle and in Ex. 11 there are three.

The advantage of simplicity is that fewer parts can be lost and a man can remove and replace it more quickly and accurately.

The first sale of lamps, Ex. 8, which is a representation of the patent in issue here, was made, according to J. H. DeFrees, in the latter part of 1951 and originally packaged and shipped in a container produced as Ex. 17.

Asked as to whether in zero and sub-zero temperatures the lens would contract more than the housing and the effect of the resilient ring would be less effective than at higher temperatures, he admitted that the pressure exerted on the sealing rings would be less in cold weather than hot weather adding however that it would be of sufficient magnitude to do the job.

Mr. Richard Betts, of the Betts Machine Company, one of the plaintiffs, was then heard. One of his main responsibilities with the company became the vehicle lamp part of the business. The company began manufacturing and selling vehicle lamps in December of 1951. The lamp manufactured was made, according to this witness, in accordance with the patent in suit and was designed and developed by Mr. DeFrees. The manufacturing of these lamps was continued until 1956 when a separate company, Warren Manufacturing, was formed which manufactured

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lamps for the plaintiff company. Due to a prior agreement with a manufacturer, vehicle lamps of the plaintiff company's design are being assembled in Canada by Faucher & Fils. The first sale of the DeFrees design lamp in the United States took place on December 7, 1951, and was sold under the trade mark "Snap Seal" in a carton marked Ex. 17.

The total sales in the United States in the year 1952 through and including the year 1962 (for the first half of 1962) appear on Ex. 19 which is a tabulation of the sales. It appears that 13,196 lamps of a value of $31,246.64 were sold in 1952 compared to 182,476 of a value of $513,791 in 1961 and 106,903 lamps of a value of $393,096 for the first half of 1962.

The plaintiff company's lamp is more expensive than that of its competitors.

As far as the total market for safety lamps in vehicles is concerned, the portion of the trade the plaintiff company has is relatively small. But with respect to the highway tank industry, the company's lamps are on the majority of the tank trucks.

The company's first sale in Canada was made to Dominion Auto Accessories, the defendant herein, in response to its order of June 17, 1952, when it ordered 700 of the company's lamps, 600 for Model B-60 and a hundred for Model B-50.

The company in addition sold lamps in Canada directly to manufacturers and users of vehicle lamps and also through their outlets in Canada such as distributors or jobbers. Exhibit 21 shows total Canadian sales of snap seal lamps by Betts Machine from the year 1952 to 1961 as follows:

CANADIAN SALES OF SNAP SEAL LAMPS BY BETTS MACHINE COMPANY

Year	*No. of Lamps*	*Value of Lamps & Parts*
1952	2,350	$4,731 36
1953	4,764	9,116 56
1954	975	1,936.75
1955	438	914 38
1956	1,055	2,151.05
1957	2,072	4,144 36
1958	4,939	9,879 09
1959	3,425	6,851.52
1960	2,773	5,547 24
1961	2,984	5,418.00

Mr. R. Betts stated at p. 115 of the transcript that sales in Canada could be compared to those in the United States.

Mr. Rogers:

Q. How did the Canadian sales compare with those in the United States?

A. Having respect to the smaller market in Canada versus that in the United States in the years 1952 and 1953, the sales are comparable. However, in the year 1954-1955, our sales dropped off substantially and haven't risen substantially since.

The witness attributes this drop to the entry of Dominion Auto Accessories, the defendant, into the Canadian market, as he states at p. 115 of the transcript "with a lamp copying our design".

The plaintiff company first became aware of the defendant's lamps, Ex. 6, in 1956 and a letter was written by Mr. R. Bett's father to Mr. Durand, a United States attorney, inquiring as to what action should be taken in the matter and a letter dated October 16, 1956, was sent by Mr. Durand to the defendant company telling them of the plaintiff company's claim and asking them to stop manufacturing.

All lamps sold in Canada according to Betts have been marked to indicate they are patented but with no year indicated as required by s. 24 of the *Patent Act*. In other words, they have not been marked "patented 1956". The plaintiff company also sold in Canada a number of lamps marked with the U.S. patent number and not the Canadian patent number.

A series of dies were made for lenses with the Canadian number on and some of the lamps were sold in Canada with the Canadian patent number but Mr. Betts admits that his company has taken no steps to insure that only lenses so marked with the Canadian number have been sold to the Canadian market. Indeed, if an order was received it was filled with whatever lamps were available.

He also states that in his opinion the portion of the tank truck field the company lamps enjoy would be the majority of the United States market.

According to Mr. Betts the plaintiff company has sold to manufacturers in Canada and to freight operators primarily and also through the company's distributor outlets.

He also attributes to the entry of Dominion Auto Accessories Ltd. the reduction in sales for 1954 and 1955 although

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it is only in 1957 that he received a sample lamp V.P. 236T, which was made by the defendant company.

Mr. Mahlon Burgett of Touowanda, New York, a safety director for William P. Crossett Inc., a common carrier of petroleumn products with an experience of 25 years in the tank truck industry stated that during the years from 1938 to 1951 several types of lamps were used on tank trucks operated by the companies for whom he worked; some were similar to Exs. 10 and 11 and there were a couple of other styles which were not produced as exhibits; there was also a larger lamp than any exhibited in the present case, probably seven inches across the base of the lens, and the latter was attached to the body by a channel-type lock ring which folded over the lens and a protrusion from the body and went around out to hold the lens to the body.

Similar types of lamps were used by the competitors of the companies for whom he worked prior to 1951. A lamp similar to Ex. C was also used and the lens was held to the body in a manner similar to Ex. C, i.e., by means of two screws. However, the lens did not have a lip on the outside, it fitted more or less flush with the body and the screws went through the lens itself.

Mr. Burgett stated that prior to 1951, Ex. 10 as a vehicle lamp did the job it was supposed to do but that however after 1951 there was a better lamp on the market, as he put it at p. 143 of the transcript:

> . . . And we considered these lamps as shown here in Exhibits 10 and 11 and C, and the other ones I have mentioned, as not good enough to do the job we wanted them to do.

According to this witness, Ex. 10 was not good enough in that it was not a tight seal light and not having a tight seal it had a corrosion problem that made it difficult to change bulbs and maintain. The rust problem was both on the outside of the lamp as well as on the inside. The screws would rust so badly that they could not be taken out in the normal manner with a screwdriver or a wrench but had to be drilled out and on the highway it was almost impossible to have a driver change one. The corrosion on the inside was a problem because it corroded the bulk socket and the bulb could not be removed in this condition without ruining the bulb socket and the whole lamp then had to be replaced. The corrosion on the inside was caused by water and mois-

ture getting inside and mixing with the air due to the fact that there was not a tight seal on the lens.

According to Mr. Burgett, in a vehicle lamp lens ease of removal is important especially on a highway so that the driver can replace a burnt out light as soon as it needs it and the vehicle will not run without its lamps lit. They must also be easily removeable in the shop so as not to run into an expensive maintenance programme.

As to the usefulness of Ex. 11, this witness is of the opinion that it is an improvement over Ex. 10 due to the fact that the lens is easier to remove as there is a clamp over the lens instead of screws. However, the seal on this lamp would not be tight enough to make it waterproof or vapour-proof and they ran into the same problems with this lamp as far as rust and corrosion were concerned.

Back as far as 1952, Oil Marketers for whom this witness worked changed the lamps on their equipment from lamps such as Exs. 10, 11 and C and the other ones he mentioned to lamps such as Ex. 8 for clearance identification and marker lamps. When the witness left Oil Marketers, in 1956, apart from the headlights, the cab lights and the cab interior lights, they would all be Betts type lamps and the same applied to the Crossett Company for whom, as we have seen, he worked also. On the equipment purchased by the above company, lamps such as Ex. 8 were written into the specifications.

Oil Marketers in the year 1952 came to use the lamp of the type of Ex. 8, the patent in suit, after several phone calls between the above company and the Betts Machine Company. According to this witness also, lamp Ex. 8 is quite a bit more expensive than the other lamps, however, due to the increased length of service and the less maintenance required, the initial additional cost is soon recovered and will in the long run cost less money.

Its lighting qualities are a little better than the other lamps, it has a tight seal, it has less maintenance, it is easier to change the bulb and it is vapour-proof and this witness adds at p. 149 of the transcript:

> . . . In fact, we haven't found a lamp on the market yet that will give us all the qualities we like to see in a lamp as this one has done.

The importance of lamps such as this, of being vapour-proof, is that it eliminates corrosion and also in the tank

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truck industry where inflammable liquids are being handled, some very volatile, it becomes an important safety feature.

In cross-examination this witness, although stating that some of their competitors used Ex. 8 lamps, admitted that others used also types of lamps similar to Exs. 10 and 11 and C.

Mr. Harold Johnson was then heard on behalf of the plaintiffs. He is sales and engineering manager for Pennsylvania Furnace and Iron Company as well as its secretary-treasurer. This company manufactures liquid and dry bulk trailer equipment such as truck tanks, trailer tanks, cement tanks, chemical tanks, milk tanks, as well as heating equipment and is a medium sized tank trailer manufacturer. Mr. Johnson has a degree in mechanical engineering from the Pennsylvania State University.

The tank trailers or trucks manufactured by the above company are equipped with vehicle lamps. Prior to 1951 this witness had a lot to do with the vehicle lamps used on the tank trucks manufactured by his company; he was in charge of the drawing room and was, since 1951, responsible for the choice of lights on the company's vehicles.

Prior to 1951, according to this witness, the type of vehicle lamps used were similar to Exs. 10 and 11. With respect to the type of lamp illustrated by Ex. 10, he stated that numerous complaints were received due to the fact that it was not waterproof or vapour-proof and because of the number of pieces involved and the difficulty in replacing lenses and/or bulbs.

He also asserted that the importance of the lights being moisture proof is that there would be less corrosion, less danger of lighting shorting out, of screws and parts rusting tight so they could not be removed.

As for its vapour-proof aspect, this witness is of the opinion that the tank truck segment of the trucking industry has always ranked high in safety and because this industry is handling dangerous commodities, they will do everything they can to ensure safety.

With respect to Ex. 11 this witness states that he personally never liked it. This is the lamp with a clamp ring. It is quite a job to assemble and put in place and he does not think it has a tight seal nor that it is easy to replace a bulb.

The type of lamps used on the tank trucks manufactured by his company at the present time is, unless specified otherwise, of the type of Ex. 8 which exemplifies the patent in suit.

It was early in 1952 that his company started using the Ex. 8 type of lamp because it had been specified by a customer.

Their competitors at the present time are also using the Ex. 8 type of lamps.

According to this witness also the Ex. 8 type of lamp has a better seal than the other lamps, it is easier to remove the lens and replace the bulb, fewer parts are involved and there is less corrosion.

The term "explosion proof" is not used too much in the tank truck industry as it is generally understood to mean a light which, if vapours were admitted, could withstand an explosion and, of course, that is not what the plaintiffs' lamp is. This explains why the words "explosion proof" were deleted from Ex. 9.

This witness admitted that in order to make a lamp such as Ex. 8 vapour-proof, some means would have to be taken for insuring that vapour does not enter the housing from the back so that the effectiveness of the lamp depends not only on the effectiveness of the seal between the housing and the lens, but also the effectiveness of the fittings at the back of the lamp where the wires enter. However, he added that steps are taken in a lamp such as Ex. 8 to insure that no vapours enter from the back in that the socket is threaded into the light body and the wires are run in a conduit which in turn is threaded into the socket. This, however, is not mentioned in Ex. 8, the patent in suit, nor is the rubber grommet through which the pigtail enters. He admitted in cross-examination that the signal stat lamp also has the same type of conduit as Ex. 8 as well as a similar rubber gasket.

Counsel for the defendant filed a number of patents as part of the prior art on the basis that all of these references are available as citations against the patent in suit because they were published more than two years before the date of filing of the application in suit under the provisions of s. 28(1)(b) of the *Patent Act* which reads as follows:

28. (1) Subject to the subsequent provisions of this section, any inventor or legal representative of an inventor of an invention that was

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(a) . . .

(b) *not described in any patent or in any publication printed in Canada or in any other country more than two years before presentation of the petition hereunder mentioned,*

* * *

may, on presentation to the Commissioner of a petition setting forth the facts (in this Act termed the filing of the application) and on compliance with all other requirements of this Act, obtain a patent granting to him an exclusive property in such invention.

With the exception of those, counsel for the defendant stated he did not rely on, I shall now enumerate these prior art citations as follows, giving in each case the name of the inventor and the number and date of the patent with the title of the invention, namely Ex. D. Horace Resley, U.S. Patent No. 379,127, dated March 6, 1888, a pavement-light; Ex. E, Williams E. Brown, U.S. Patent No. 723,645, March 24, 1903, a jar-closure; Ex. F, William H. Jones, U.S. Patent No. 785,106, March 21, 1905, a jar or bottle closure; Ex. H, B. F. Savery, U.S. Patent No. 861,552, June 3, 1930, a jar and closure therefor: Ex. J., B. S. Floraday, U.S. Patent No. 2,106,144, August 8, 1935, a dome light assembly; Ex. L., T. R. Smith, U.S. Patent No. 2,404,409, October 3, 1942, a container; Ex. N, U.S. Patent No. 28,113, May 22, 1860, an improvement in preserve cans; Ex. O, W. H. Jones, U.S. Patent No. 769,866, December 5, 1903, a jar or bottle closure; Ex. P., Dorothea C. Hull, U.S. Patent No. 770,751, September 27, 1904, a closure for bottles, jars or other receptacles; Ex. T, Robert Edwin Ashworth, British Patent No. 11,953, January 23, 1908, improvements in and relating to stoppers for bottles, jars and the like; Ex. U, Charles Lewis Bush, British Patent No. 21,443, May 2, 1896, improvements in or relating to stoppers, lids or caps for bottles, jars, cans or boxes.

The jars or stoppers for jars and the like patents were brought into the case by the defendant on the basis that the patentee in the specification related his invention not only to the vehicle marking lamps but rather to a static seal and thereby brought into the prior art to be reviewed by the skilled workman all the patents covering closures or means of sealing enclosures and static seals for housing any unit chambered containers or hollow bodies.

Indeed, it is only in the one claim of the patent that it relates the invention to the automobile lamp field.

Counsel for the defendant indeed argues that the patentee himself here has set the stage for his invention by claiming in the specification that it relates to a static seal that has the advantage of being quickly removed and replaced and being vapour-proof, which would involve the Court in examining the jar and enclosure art in addition to the vehicle marking lamp art. The matter of deciding whether those jar or enclosure documents are relevant here must be decided now. Indeed, if they are not relevant there is no necessity for this Court to examine them at all.

The defendant contends that the patentee by relating his invention not to vehicle marking lamps but rather to a static seal has brought into the area to be reviewed, or charged the person reading this patent, with the responsibility of being aware of all the patents covering closures or means of sealing enclosures and static seals for housing any unit, chambered containers or hollow bodies and that by so doing he has also in effect defined the person to whom the patent is addressed as the skilled workman in the field of closures.

On this point, defendant relies on the first paragraph of the patent which reads as follows:

> The present invention relates to a novel and improved vapor-proof and leak-proof enclosure, and to a static seal especially adapted for use as a low pressure sealing element in combination with a chambered container or hollow body and a closure therefor.
>
> An object of the invention is to provide a seal which permits ready attachment and removal of the closure, using only a simple tool such as a screwdriver or stout knife blade. The sealing element is quite inexpensive, and immediately replaceable if it becomes unserviceable after extended use. A number of adaptations where such seal can be advantageously used will immediately occur to *those skilled in the art.*

The defendant claims that the art referred to above would be the enclosure art rather than the vehicle light art.

I cannot accept defendant's proposition here for several reasons. It is very clear from the title of the patent in suit here that the art is the vehicle marking light art. Indeed, the title reads as follows: "Removable sealing device for vehicle marking light".

The above quoted first passage from the patent is nothing more than a full statement of what the inventor, Mr. DeFrees, contemplated might be done with the thing he allegedly invented in compliance with s. 36, s-s. (1) of the *Patent Act*. This section indeed deals with the necessity

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of disclosing "the invention and its operation or use as contemplated . . . so as to enable any person skilled in the art or science to which it appertains, or with which it is most closely connected to make, construct, compound or use it . . . ".

From this it appears that the adaptations of the seal which the patentee declares can be advantageously used will immediately occur to those skilled in the art, which here is the vehicle art field which is to paraphrase the above section "the art or science to which the invention appertains or with which it is most closely connected" and not the jar or enclosure field with which it is not closely related.

There is however a more conclusive way to determine the art to which an invention relates and that is by looking at the claim or claims of the patent. It is indeed in the claim or claims that the monopoly is defined and not in the specification as stated by the Supreme Court in *Noranda Mines Ltd. v. Minerals Separation North American, Corporation*[1] "the forbidden field must be found in the language of the claims and not elsewhere."

And as put in the same case[2] in this Court by Thorson P.:

> Two things must be described in the disclosures of a specification, one being the invention, and the other the operation or use of the invention as contemplated by the inventor and with respect to each, the description must be correct and full. The purpose underlying this requirement is that when the period of monopoly has expired the public will be able, having only the specification, to make the same successful use of the invention as the inventor could at the time of his application.

and at p. 317:

> When it is said that a specification should be so written that after the period of monopoly has expired the public will be able with only the specification, to put the invention to the same successful use as the inventor himself could do, it must be remembered that the public means *persons skilled in the art to which the invention relates for a patent specification is addressed to such persons.*

As the claim here deals exclusively with a vapour-proof lamp for vehicles, ordinarily the art to which it relates should be that of vehicle lamps.

It is therefore in that field mainly that the ordinary skilled man may look here in order to find out whether the

[1] [1950] S.C.R. 34 at 56. [2] [1947] Ex. C.R. 306 at 316.

patent in suit has been anticipated or not, or the prior art in that field may be used to indicate the state of the art at the time that the patentee made his alleged invention and as a means of ascertaining whether what the patentee did was so slight a contribution to existing knowledge as to lack the essential element of invention and to be merely obvious.

However, here, the vehicle lamp art, although the main one is not the only art that the skilled workman or this Court can look at in order to determine whether the patent in suit was anticipated or whether it was obvious or not. Indeed, it would seem to me that he may look at anything that may assist him in this regard, the reference in a patent dealing in one art (the vehicle lamp art) to another art (the enclosure art) such as we have here, being one element to be taken into consideration in determining whether from such a directed use in the patent (the use in vapour-proof containers) the patentee in effect invented something that was new or that was obvious. With this in mind, I therefore intend to examine all the prior art patents cited by the defendant.

However, before examining the prior art, in view of the attack made by the defendant on the validity of the patent in suit, it would be in order here to deal with defendant's onus in this regard. Indeed, the showing of the invalidity of a Canadian patent rests on the person attacking it and in the present instance on the defendant in view of the statutory presumption of validity of a Canadian patent under s. 47 of the *Patent Act,* S. of C. 1935, c. 32, which states that:

> 47. Every patent granted under this Act shall be issued under the signature of the Commissioner and the seal of the Patent Office. The patent shall bear on its face the date on which it is granted and issued and it shall thereafter be *prima facie* valid and avail the grantee and his legal representatives for the term mentioned therein . . .

In *Unipak* v. *Crown Zellerback*[1] Thorson P. stated at p. 39:

> . . . the statutory presumption is not confined to the attribute of inventiveness but extends to the other attributes that an invention must have if it is to be patentable under the Act, such as novelty and utility. The three attributes of patentability, namely novelty, utility and inventiveness are all presumed to be present in an invention for which a patent has been granted under the Act until the contrary is clearly shown.

[1] 33 C.P.R. 1.

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However in the case of *McPhar Co. v. Sharpe Instruments*[1] he added at p. 28:

> On further consideration I am of the opinion that this statement is not as wide as the terms of the Act warrant. It must follow from the provision of the Act that a patent granted under it "shall thereafter be *prima facie* valid" and avail its grantee and his legal representatives for the term of the patent, that the onus of showing that it is invalid lies on the person attacking it, no matter what the ground of attack may be, and that until it has been shown to be invalid the statutory presumption of its validity remains.
>
> This does not mean that the patent is immune from attack or that the patentee is free from the obligations that are incumbent on him by way of consideration for the grant of the patent monopoly to him but it seems clear that, since Parliament has deliberately endowed a patent granted under the Act with a presumption of validity, the onus of showing that such a patent is invalid is not an easy one to discharge. That being so, the English decisions indicating that a patentee must prove the existence of the essential attributes of the patentability of the invention covered by his patent before he can succeed in an action for damages for infringement of his rights under his patent are no longer applicable in Canada. He need not prove the existence of these attributes for he starts with a statutory presumption of their existence in his favour and the onus of showing their non-existence lies on the alleged infringer of the patent. The enactment of the statutory presumption of validity effected an important change in Canadian patent law and marked a substantial advance in the protection of a patentee's rights.

Counsel for the defendant recognized at the hearing that the onus of establishing that the patent in suit is invalid rested on him. He argued however that the President of this Court had gone further than the words *prima facie* would warrant one to go in stating that "the onus of showing that such a patent is invalid is not an easy one to discharge" and that the ordinary plain meaning of *prima facie* is that if no evidence is adduced tending to show invalidity and no argument is advanced then of course the patent is valid and the patentee or any one claiming under him has no duty to prove that there was novelty, utility and inventive ingenuity. However, if sufficient evidence is adduced, then the *prima facie* presumption may be rebutted and the Court is left to determine the matter not on the basis of a heavy or difficult onus to discharge but merely on the weight of the evidence.

In *Land Registering Act* v. *Shaw*[2] Mr. Justice Martin stated that:

> . . . a *prima facie* title can only mean a good title till there is evidence to displace it.

[1] 21 Fox Pat. Cas. 1.

[2] [1915] 24 D.L.R. 429.

I do believe that whether the presumption of validity is a heavy or easy one to displace remains a question of fact in each case although I must say that in patent matters it would seem that as the alleged infringer has the burden of not only attacking the validity of the patent in issue, but of also placing the judge in the position of a man skilled in the prior art it is not too surprising that the President of this Court has stated on numerous occasions that the onus is not an easy one to discharge.

Although the defence of anticipation was advanced by the defendant in this case, counsel did not seem to rely too strongly on this argument and in view of the requirements of anticipation, this is not too surprising.

These requirements were set out clearly by Thorson P. in *The King* v. *Uhlemann Optical Company*[1]:

> . . . The information as to the elleged invention given by the prior publication must, for the purposes of practical utility, be equal to that given by the subsequent patent. Whatever is essential to the invention or necessary or material for its practical working and real utility must be found substantially in the prior publication. It is not enough to prove that an apparatus described in it could have been used to produce a particular result. There must be clear directions so to use it. Nor is it sufficient to show that it contained suggestions which, taken with other suggestions, might be shown to foreshadow the invention or important steps in it. There must be more than the nucleus of an idea, which in the light of subsequent experience, could be looked on as being the beginning of a new development. The whole invention must be shown to have been published with all the directions necessary to instruct the public how to put it into practice. It must be so presented to the public that no subsequent person could claim it as his own.

And in *Pope Appliance Corporation* v. *Spanish River Pulp and Paper Mills Ltd.*[2] Lord Dunedin described the method to find out whether there was anticipation or not as follows:

> . . . 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 hands, have said, "That gives me what I wish?"

and at p. 56:

> Does the man attacking the problem find what he wants as a solution in the prior so-called anticipations.

Furthermore, as set down by Lord Dunedin in *Pope Appliance Corporation* v. *Spanish River Pulp and Paper*

[1] [1950] Ex. C.R. 142 at 157. [2] [1929] A.C. 269; 46 R.P.C. 23 at 52.

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Mills Ltd. (*supra*) when documents are brought forward as anticipations, they must be read singly and must in no way be combined together to form a mosaic of extracts.

These requirements, as we can see, are difficult to meet and have not been met in the present case. Indeed, in none of the prior art patents or publications produced by the defendant, and I include here not only those relevant to the lamp field but also those relevant to the field of enclosures or jars, can we find an answer to the problem solved by the patent in issue.

The first patent produced by the defendant as prior art is Ex. D, U.S. Patent No. 379,127, dated March 6, 1888, a pavement light for the purpose of illuminating compartments below the surface of the ground. It deals with a light, mating grooves in both the glass block and the housing, the former fitting telescopingly into the latter and the housing is sealed when the groves are in alignment and the O-ring made of a resilient material secures the two mated channels together.

The abutting flange here, however, is on the outside of the lens instead of on the inside as in the patent in suit. Furthermore, it is not a construction where one could, working from above, pry out the transparent portion. Indeed, there is nothing that one can use from that position to do so. It would here be necessary to go underneath and push from there. Now this transparent part is not easily lifted as stated in column 2, lines 73 to 74 "and can be removed more easily, when necessary, by a twisting or turning motion" which of course is entirely different from the manner in which the lenses are removed in the patent in suit. Furthermore, there is no clearance between the transparent portion and the housing portion and no taper on the transparent portion. In the patent in suit it is difficult to push in the lens into the housing without cocking the lens to some extent relative to the housing. Indeed, one does not push the whole lens in a straight axial direction; to telescope it in, one part goes in first and the remaining part after, so that the clearance referred to in the claim is significant in order to obtain a tight seal.

Furthermore, in Ex. D the ring E is seated in a recess, which is not arcuated but V-shaped with a certain amount of room given to allow it to be pushed into and this might affect the sealing quality of the light.

Finally, in this exhibit there is no housing or a slightly cupped lens in the sense of the patent, although, as we have seen, both of these are admittedly old.

Exhibit E, U.S. Patent No. 723,645, dated March 24, 1903, is a jar closure and refers to the fitting of a seal by the alignment of two groves, one on the inside of the housing and the other on the outside of the part telescopingly fitting inside the housing. The O-ring here is said to be a rubber or other flexible gasket. This patent has a flange on the outside of the part closing the jar which abuts a corresponding transverse flange on the jar itself. There is not here, however, the inwardly tapered front portion of the part going in that we have in the patent in suit nor is it possible to cant the stopper when it goes into the bottle or container. Indeed, here the stopper must be pushed straight down into the bottle.

Furthermore, a little recess is provided in the stopper groove No. 5 and when the stopper is pressed down, the whole ring deforms into that recess which, of course, is entirely different from the ring in the patent in suit, and would as far as the latter is concerned, create a number of problems. Indeed, the material of the O-ring that would have to be used for that purpose would have to be soft and might not be adequate for a vapour-proof lamp and because of it being constantly deformed, might not resist too long.

The manner in which the stopper in Ex. E is entered into the container is entirely different from that in the patent in suit, the patentee, at p. 1, column 2, lines 63 and 64, therein stating that "the stopper is inserted by a twisting or screw like motion."

In the patent in suit the deforming of the O-ring is done differently. Indeed, because of the clearance between the tubular flange on the lens and the adjacent wall of the housing and the cocking action, the ring is deformed a bit at a time gradually along that part of its periphery where the pressure is being applied.

Exhibit F, U.S. Patent No. 785,106, dated March 21, 1905, is also a jar or bottle closure and here the jar or container fits inside the cup and an O-ring seals the two parts together by the alignment of mating grooves.

According to counsel for the defendant, if the drawings are here reversed and the cap becomes the housing and the

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closure becomes the sealing element, this patent would have everything described in the patent in suit. It would have an abutting flange on the closure and the housing and a knife or other thin instrument inserted between the abutting flanges would break the seal and remove the cap from its aligned position in the same manner as in the patent. It has also a resilient sealing O-ring that fills the grooves when they are sealed. The part that goes in telescopingly is even tapered.

Exhibit F, according to the patent at line 89 of p. 1, column 2, deals with the closing up of these jars in a vacuum by removing the air from the chamber in which the jar is located. A plunger is then applied to the cap and pushes it down. This of course is pretty far afield from vehicle lamps and no vehicle lamp could be filled in this manner in the field.

Now in so far as the structure is concerned, the manner in which the ring in Ex. F operates is entirely different from that in the patent in suit. Indeed, this ring starts in the arcuate groove on the container but as the cap is pushed down with the plunger, the O-ring has to come downwardly to a position where it is compressed into a rectangular groove and in so doing, the ring rides over an edge between the grooves and it is therefore subject to some manipulation and wear. The ring in the patent in suit for a vehicle lamp might not stand much of this manipulation.

In Ex. H, U.S. Patent 1,861,552, dated June 7, 1932, the parts must also be reversed as in Ex. F. The top of the jar is to be considered as the housing and the jar body as the part to be inserted into the housing with a resilient O-ring sealing the space between the two parts when in the sealed position. This exhibit has abutting flanges which can easily be removed by inserting a thin bladed instrument between them. The part that is inserted into the cap is tapered inwardly, the inside diameter of that part being significantly less than the outside diameter of the part into which it is inserted.

However, there appears to be no clearance here corresponding to the part situated in the location between the conical portion of the lens of the patent in suit and the conical portion of the head of the housing. Indeed, in Ex. H. there is uniform space between the cap of the bottle and its cross-hatching. However, that space, according to

column 2, line 2 of the said patent, is filled with a sealing material, paraffin, and then the corner is shoved down over the neck, so that the ring itself does not act as a seal here and the patentee himself refers to the ring simply as a packing ring at column 2, line 64, p. 1. The ring here would therefore be more of a gasket than a holding or sealing means of the kind with which the patent in suit is concerned.

Here again if one tried to pry off the jar body from the top, it would have to be done by means of a straight pull and therefore a tight seal could not be obtained. As there is not sufficient clearance between the inside of the cap and the jar body, it is not possible to pry them open by tilting or by means of a cocking action. With this patent it is not possible to press gradually all along the periphery of the O-ring and if an attempt was made to tilt, the glass would probably break.

I may add that Ex. H clearly shows that we are dealing here with a permanent closure as indicated at p. 1, column 2, line 99 "when the paraffin hardens a permanent closure is provided."

Finally, the O-ring in this exhibit is seated on the outside of the jar when the cap is off. This would be a problem if an attempt was made to transfer this to the vehicle marking lamp. Indeed, by putting the O-ring on the outside of the housing or the container, the whole of the lens or the light would protrude to a considerable extent from the side of the truck whereas when the ring is in the inside of the container, such as in the patent in suit, the lens protrudes much less, which is a considerable advantage. Now when withdrawing the body from the cap in Ex. H., the O-ring cannot remain in the housing but comes out with the lens and thereby creates a problem of manipulation.

Exhibit J, U.S. Patent No. 2,106,144, dated January 18, 1938, is a light with a press fit between the housing and the lens, the housing is cup-shaped and the lens is slightly cupped. The two are merely pressed together and held in that position by frictional engagement. They do have abutting flanges in the closed position.

This patent, however, has no O-ring and mating grooves and no taper on the part fitting in. As it is a dome light in an automobile, it need not be sealed as inside automobiles one does not worry about vapour, nor about differ-

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ential rules of expansion between the housing and the lens.

Counsel for the defendant stated that Ex. K. is not really relevant as it is another art. It does, however, show a rubber O-ring and an abutting flange. However, he stated that he does not rely heavily on this exhibit.

Exhibit L, U.S. Patent 2,404,409, dated July 23, 1946, also a container, shows a tapered part being inserted into a housing and a groove on the tapered part, a resilient sealing O-ring and abutting flanges when the jar is in the sealed position. However, this patent has not a corresponding groove on the housing. It has but one groove and effects its seal by merely bearing against the flat surface of the housing. The holding of the cap to the receptacle is accomplished by friction between the ring of the wall and the interior wall of the receptacle or the jar. It is not necessary to deform the rubber of the O-ring in order to remove the cap from the receptacle. The O-ring simply slides in with the cap but does not change its shape in so sliding which, of course, is entirely different from the situation one has if an O-ring is seated in grooves in both of the parts that come together because the O-ring must be deformed before the lens can be released.

If the construction in Ex. L was applied to a marker light and came in contact accidentally with something such as a branch for instance, the cap might very well be pulled right out of the container and there would be no vapour-proof seal because the ring did not seat itself firmly between two parts in the manner the O-ring is embedded in the patent in suit. Furthermore, the ring here also is carried on the outside of the cap with the difficulties we have seen in the former exhibit.

Exhibit N, U.S. Patent 28,413, dated May 22, 1860, has, as a fruit jar, to be turned inside out or upside down, the cap being considered as the housing and the jar as the lens. If that is done, it appears that there is a resilient O-ring that fills the space between the two mating grooves and effects a seal. The part inserted into the housing is tapered. There are, however, no abutting flanges between the two parts when in a sealed relationship. Here also the O-ring is on the outside of the container and travels as the parts are assembled from one location to another from the groove near the top of the bottle down to a lower groove also on the bottle.

In Ex. O, U.S. Patent 769,866, dated September 13, 1904, another jar or bottle closure, we have two mating grooves. Here again it is necessary to reverse the parts and consider the cap as the housing and the jar as the closure part. A resilient ring seals the space between the mating grooves and there are flanges abutting against each other in the closed position. Mention is made here in the specification of a tight joint which would prevent not only "the ingress of air when the contents of the vessel are packed in a vacuum, but also to prevent the escape of contained gases which may be in or produced by fermentation or otherwise."

However, here again there is a substantial difference with the patent in suit. Indeed, the O-ring again must move with the cap as the parts are put together from a groove A to a groove C and over a relatively sharp edge and these grooves being angular formed instead of arcuated they would considerably affect the life of the ring.

Exhibit P, U.S. Patent No. 770,751, dated September 27, 1904, is also a closure for bottles, jars or other receptacles. It seals by means of mating grooves and a resilient ring but here the grooves themselves change their shape to place the stopper in the bottle which, of course, is entirely different from the patent in suit.

Exhibit T, British Patent No. 11,953, dated January 23, 1908, relates to a stopper for bottles, jars and the like. This patent shows a housing with a flange, a tapered closure being inserted into that housing which would allow the application of a gradual pressure to the O-ring which seals the space between the two parts. In the specification of this patent, the tapered construction of the closure is mentioned and it is pointed out that this tapering not only facilitates entry of the closure but also enables the application of gradual pressure on the O-ring when the grooves are in alignment and the O-ring fills the space between them and effects the seal and the flange on the stopper abuts against the top of the housing.

Although this patent appears to be constructed in the same manner as called for in the patent in suit, the clearance feature between the stopper and the container such as that between the tubular flange on the lens and the wall of the housing is not provided. Here also this is not something that one can pry open easily as it must travel axially.

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Indeed, such is the teaching of this patent at p. 2, lines 3 to 33:

> . . . The vertical surfaces form a guide for the cover and enable it easily to be inserted in a level manner, compressing the ring equally as it enters and thus preventing distortion.

And, of course, as we have seen, one with such an arrangement cannot obtain as tight a seal as one where it is necessary to employ a cocking or tilting action.

Furthermore, on figure 3 of the drawings it appears that on the stopper shown there, the groove is not arcuated, but has a little recess below the O-ring in which the ring must contract and move into when the stopper is pushed downward which, of course, is again different from the patent in suit.

Exhibit U, British Patent No. 21,443, dated May 2, 1896, deals with improvements in or relating to stoppers, lids or caps for bottles, jars, cans or boxes. We have here the closure telescopingly fitting into the housing, a groove on the inside of the housing and one on the outside of the closure. When the O-ring seals the spaces between the two grooves, it seals. There is also an abutment between the stopper and the housing. The construction here is different from the patent in suit in that when the stopper is inserted into the bottle, the rubber ring passes from the groove at the end of the stopper into the groove at the head of the stopper and also enters the internal groove at the neck of the bottle. Furthermore, the O-ring is on the outside once the stopper is pulled out. A construction such as this would not be of much use in solving the problem the patent in suit solved.

Exhibit V, British Patent No. 647,374, dated July 9, 1949, published December 13, 1950, i.e., being less than two years before the date of the application of the patent in suit, although relating to improvements to vehicle and other lamps, is not available as a record under s. 28 of the *Patent Act* and therefore cannot be considered.

Exhibits G, I, M as well as Exs. Y, Z, Z1 and Z2 were all presented by the defendant to show that a cup-shaped lens and housing were old. However, as Mr. DeFrees in his evidence admitted that they were old or in common usage, counsel for the defendant did not deal with them in detail.

Counsel for the plaintiff in considering the prior art produced by the defendant stressed a number of differences

between them and the patent in suit and laid particular stress on the cocking action found in the patent in suit and not in the prior art due to the fact that the inward part of the lens was tapered; he also mentioned the fact that the O-ring in the patented article in suit is seated in the housing and not on the outside and, therefore, does not come out with the enclosure nor does it roll from one position to another, as in the prior art documents. This can be seen in Ex. T on which the defendant relies mostly.

Counsel for the defendant, however, submits that although the above are advantages of Ex. 8, the patent itself does not restrict the inventor to a construction where the O-ring is seated permanently in the housing, nor is mention made therein of the lens being cocked to one side and then snapped in at an angle so as to effect the gradual compression of the O-ring. The only mention of a clearance can be found in column 2, line 33, where it is stated: "When in simple relationship the shoulder portion rests within the annular peripheral edge part of the housing in telescoped relationship, but with adequate working clearance." This, of course, does not go as far as to describe a cocking action as the sufficient clearance mentioned here is that which will allow the engaging of only one portion of the circumference of the O-ring and gradually compress it and then push it into position on the other rather than moving the parts vertically into registration with each other. Indeed, the patent does not say tapering inwardly with sufficient clearance to permit this cocking action.

On the basis that it is to the invention as claimed that one must look for inventive ingenuity, counsel for the defendant submits that the two advantages of the patented article in suit, i.e., the cocking action and the O-ring being seated permanently in the housing cannot be considered.

I am afraid that I cannot agree with this submission. Indeed, although the patent does not expressly mention this cocking action, it does permit its inference from the manner in which it describes the prying off of the lens at column 3, line 4: "a screwdriver or a heavy knife blade can be inserted beneath it, whereupon the lens can be removed without undue effort". Now if this is done, one can see that the decompression is gradual along the periphery of the O-ring and we therefore have this cocking action in reverse.

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In *The King* v. *American Optical Company*[1] Thorson P. dealing with the suggestion made in that case that a vertical operation was not claimed in the patent said:

> Nor is it any objection to the sufficiency of the disclosures that the advantages of the invention as enumerated by Professor Price were not set out in the specification. As Fletcher Moulton L.J. said in *Clay v. Alcock & Co. Ltd.* (1906) 23 R.P.C. 745 at 750 it is a "well known principle in Patent law that a man need not state the effect or the advantage of his invention if he describes his invention so as to produce it". That is not so where the inventor has to rely on the presence or absence of such effect or advantage as a part of the necessary delimitation but we are not concerned with that here. If an inventor has adequately defined his invention he is entitled to its benefit even if he does not fully appreciate or realize the advantages that flow from it or cannot give the scientific reasons for them.

It appears clearly to me here that although the patentee in suit has not specifically described this cocking action, the operational advantage can be clearly inferred from the disclosure and should be considered in determining the validity of the patent.

Now with respect to the permanency of the O-ring in the groove of the housing, although the defendant maintains that the patent has not taught this, it appears to me that the patent does mention the removing of the lens without due effort by inserting a heavy knife blade beneath it and if a knife is applied to Ex. 8 or even Ex. 6, the defendant's lamp, the lens alone is removed and the O-ring remains in the groove of the housing. In view of this I believe that a reasonable reading of the patent and an examination of the drawings, and particularly figure 3, would indicate here that the ring is seated in the housing.

This exhaustive review of all the prior art enables me to say without any hesitation that in none of the patents cited would the patentee in suit have found the solution that he solved by his patent and, consequently, the attack on the patent in suit on the basis of anticipation or lack of novelty must fail.

Now before going into the matter of inventiveness or inventive ingenuity, I would like to deal with a submission made by plaintiff that the definition of invention in s. 2(d) of the *Patent Act* does not require this inventiveness or inventive ingenuity as it mentions only the attributes of novelty and utility. A decision of Thorson P. in

[1] [1950] Ex. C.R. 344 at 366.

the *Farbwerke Hoechst* v. *The Commissioner of Patents*[1] case was then referred to in which the President stated:

> Before I set it out I should, as a matter of duty, comment on a matter that has been a cause of concern since the decision of the Supreme Court of Canada in the *Ciba Ltd.* case [1959] S.C.R. 378. I refer to the definition of "invention", which I have already cited, and the statement of Martland J. in the said case, at p. 383, where he said:
>
> > "To constitute an invention within the definition in our Act the process must be new and useful."
>
> The statement is in strict accord with the definition from which it follows, of necessity, that, if the words "new" and "useful" in the definition are given their plain and ordinary meaning, the definition clearly lends itself, as does the statement, to the construction that novelty and utility are the only attributes of patentability that need to be present in order to constitute an invention . . .
>
> * * *
>
> It appears that in the *Ciba Ltd.* case Martland J. so construed the definition. This inference may, I think, be fairly drawn from the fact that after making the statement to which I have referred he addressed himself to only two questions, the first being whether the process before him was useful and the second whether it was new, and that when he had found these two attributes of patentability, namely, novelty and utility, present in the process he dismissed the appeal.
>
> * * *
>
> The fact that the definition lends itself to the construction to which I have referred with the consequence that necessarily follows from it to which I have also referred demonstrates that it is defective for it runs counter to the whole current of patent law jurisprudence. Prior to the decision in the *Ciba Ltd.* case it was never considered that an art, process, machine, manufacture or composition of matter, or an improvement therein, was an invention merely because it was new and useful. The attributes of novelty and utility were, and are, of course, essential to its being an invention but their presence was never considered sufficient to constitute it an invention. It was always assumed that a further attribute of patentability was essential.

It appears to me after reading the judgment of Martland J. in the *Ciba Limited* case[2] that although he does mention only the attributes of utility and usefulness, he may well have taken for granted in that case that the requirement of inventiveness had been fulfilled. Indeed, in no part of this decision does he say that this last attribute is not required. I might also add that the word "invention" itself or the verb "to invent" aside from the definition of the statute carries within it this attribute of inventiveness and, therefore, it may not have been necessary to specifically provide for it in the definition. Indeed, invention, and I am not here talking of the object invented but of the action of

[1] [1963] 39 C P R 105 at 122. [2] [1959] S C R. 378.

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invention, which is the quality of mental production required to bring the thing invented into being, if one goes to the Larousse Dictionary under the French verb "inventer" we find that it means "imaginer le premier quelque chose de nouveau—créer par la force de son imagination" and in the Shorter Oxford English Dictionary, Vol. 1, p. 1039, the verb "invent" means to find out or produce by mental activity—to devise, to contrive.

I might also add that in view of the uncertainty of the *Ciba* decision with respect to the requirement or not of inventiveness and the long line of decisions handed down by the Supreme Court and this Court, confirming inventiveness as a requirement of an invention, I must hold that such an attribute is still required today. Indeed, it would seem to me that an important change in the law as this must be done unequivocally and without drawing inferences. I will therefore take it that the attribute of inventiveness is required and consider whether such an attribute exists in the patent in suit.

The attack on the patent on the ground that it is invalid because of lack of invention or of inventive ingenuity is based on the assertion that if there was an advance over the prior art it was an obvious workshop improvement and did not involve the exercise of any inventive ingenuity.

Although on the matter of anticipation or novelty it was necessary to go into the prior art in great detail to find out the differences and distinctions between the prior art documents individually and the patent in suit, on the matter of inventive ingenuity or inventiveness or lack of obviousness, the test with respect to how the prior art should be examined is somewhat different. Indeed, in determining whether there is inventiveness or not, the prior art should be reviewed and its cumulative effect considered. This is what I have attempted to do in examining whether there was any inventive ingenuity involved in conceiving or constructing the patent in suit.

On this matter of inventiveness, the defendant submits, as we have seen, that the patentee here has delved into the prior art in a field which comes within the scope of his invention as defined by himself (the jar and enclosure field) to take in all its parts and transfer them to the well known elements such as a cup-shaped housing and a cup-shaped lens, adding that the patent in suit is not a new

combination but the use of a well known sealing method, described in a number of prior art patents transferred to the sealing together of two well known parts and with the same object that it accomplished when it was sealing a jar, in the same manner and with all the advantages and disadvantages that existed in that field. Indeed, that the sealing of two parts together in a vapour-proof relationship by means of two mating grooves and an O-ring between them and flanges abutting when they are sealed together with the tapered portion to gradually compress the O-ring and to facilitate entry, had been known in the field of sealing jars or containers and, in fact, is the same thing as shown in the lamp field and particularly in the pavement light (Ex. D). The defendant finally contends that having placed the Court in the position of the skilled workman with all the prior art before it, there was no problem to be solved and that any competent workman could have produced what is covered by the patent in suit without the exercise of invention but merely by skill, discrimination and ability as it was only necessary to apply the sealing construction that is shown to be old by the prior patents to old parts of the automobile, i.e., a cup-shaped housing and a slightly cupped lens.

Now Thorson P. speaking of the statutory presumption of the validity created by s. 47 of the *Patent Act* in the case of *O'Cedar of Canada Ltd.* v. *Mallory Hardware Products Ltd.*[1] stated:

> This statutory presumption of validity is of considerable importance to the Court. Instead of having to determine that the invention covered by the patent in suit does not involve the exercise of inventive ingenuity, which is presumed until the contrary is shown, its task is the simpler one of deciding whether the person attacking the patent has succeeded in showing that the invention covered by it was merely an obvious workshop improvement.
>
> Consequently, there is help to be found in decisions indicating what should not be considered as a negation of inventive ingenuity. As examples of what I have in mind, I refer to decisions to the effect that the simplicity of a device is not proof that it was obvious and that inventive ingenuity was not required to produce it.

It may be useful here to refer to a statement made by Lord Russell of Killowen in *Non-drip Measure Co. Ltd.* v. *Stranger's Ltd. et al*[2]:

> Whether there has or has not been an inventive step in constructing a device for giving effect to an idea which when given effect to seems a

[1] [1956] Ex. C.R. 299 at 316-17. [2] [1943] 60 R.P.C. 135 at 142.

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simple idea which ought to or might have occurred to anyone, is often a matter of dispute. More especially is this the case when many integers of the new device are already known. Nothing is easier than to say, after the event, that the thing was obvious and involved no invention.

And Lord MacMillan added at p. 143 of the same case:

> . . . It might be said *ex post facto* of many useful and meritorious inventions that they are obvious. So they are after they have been invented.

And as Lord Moulton said in *British Westinghouse Electric and Manufacturing Company Ltd.* v. *Braulik*[1]:

> . . . I confess that I view with suspicion arguments to the effect that a new combination bringing with it new and important consequences in the shape of practical machines is not an invention, because, when it has once been established, it is easy to show how it might be arrived at by starting from something known and taking a series of apparently easy steps. This *ex post facto* analysis of invention is unfair to the inventors, and in my opinion, it is not countenanced by English Patent Law.

In *Hayword* v. *Hamilton*[2] Lord Justice Bramwell, at p. 117, speaking of a simple directing pavement light said:

> . . . it is not the less an invention because it required but small inventive powers to enable him to do it.

And a little lower:

> . . . nor is it open to any objection in regard to the constituent parts of it being old No doubt the prism, as the plaintiff used it, is old, it is as old as the world that a prism used as the plaintiff uses it will direct light in the way his prism does, and the other part of his invention is not new; that is to say, the particular mode in which he makes his pavement light, but the combination is a novelty. The thing was never practised before, and undoubtedly a combination of two old things may be made the subject of a patent

Now a high standard of invention has not been set by our courts and it is well settled in patent law that a scintilla of invention is sufficient to sustain a patent.

In *O'Cedar of Canada Ltd.* v. *Mallory Hardware Products Ltd.*, referred to above, Thorson P. at p. 318 stated:

> Apart from the presumption of validity to which I have referred, there is confirmation of what I have said in the frequently repeated statement that a mere scintilla of inventiveness is sufficient to support a patent.

In the present case it is clear that the plaintiffs' clearance light showed a marked advance over the prior art that was not an obvious workshop improvement. Indeed, Mr.

[1] (1910) 27 R.P.C. 209 at 230

[2] [1884-1886] Griffin's Patent Cases 115 (C.A.)

DeFrees's account of the various phases he went through before hitting upon his patent indicates clearly that this was far from obvious.

Even with the jar or enclosure or other prior art documents before him and even if he was thinking about lamps, I do not think that one can say that it would have been a simple matter for the skilled workman in 1951 to have transferred them into the construction of the patent in suit.

It is clear from the evidence and from the jar or enclosure documents themselves that none of the latter meet the terms of the claim and significant alterations of the parts were required to fit into the construction described by the claim.

Indeed, the idea of removing the cup-shaped lens by lifting one side first so as to have a tighter seal, rather than having to pull it straight out, or the arranging of the seal so that only the lens comes off, or of the parts so that a durable rubber O-ring in two grooves could be used, and yet permit the assembly and removal of the lens or arranging the parts so that a difference in the rates of expansion of the housing and lens does not spoil the seal, or the providing of a clearance so that the seal can be deformed gradually and without damage, yet allowing it to snap into position when assembled and allowing it to pull out of the grooves in the lens on the removal of the latter, all establish that it took a considerable amount of inventive ingenuity to conceive and effect the construction of the patent in suit.

Indeed, all these improvements are so important and show such a difference between what has gone before and what the patent shows that it necessarily must have involved a substantial exercise of the inventive process.

Now although the defendant, as we have seen, asserts that the patent in suit is not a new combination, such is not the case. Indeed, it is a combination of a particular sealing method not entirely similar to those found in the prior art, whether that be the vehicle light or the enclosure art, transferred to the sealing together of two well known parts, a slightly cupped lens and cupped housing, but in a different manner and with an entirely different purpose or object that it accomplished when sealing a jar or an

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enclosure. This, in my opinion, definitely makes it a new combination.

Now the combination of old and commonly known items is regularly held to be patentable and, in fact, virtually most patents are combinations of elements which are well known and old, the patent being for the combining of them for a new purpose and inventive ingenuity being used in combining and adjusting existing devices and thereby achieving new and valuable results. However, in the present case, we have this ingenious combining, but we have also something more, i.e., a completely different disposition of the component parts and these parts themselves are different.

There is indeed invention in the idea of using an O-ring to hold the two parts together and to provide at the same time an effective seal between them, but even the mere seating of the O-ring as in the patent in suit so that it holds the two parts together by means of a groove in the housing as well as in the lens, apart from the sealing result, is a structure different from anything before it and is not obvious. There is also invention in conceiving a simple construction providing a tight seal, which is vapour-proof, consisting of few parts capable of being taken apart and reassembled in the dark and under adverse weather conditions without being lost.

Now a number of secondary considerations have also convinced me of the existence of inventive ingenuity in the patent in suit or that it was far from obvious, such as the fact that all the prior art patents cited by the defendant are very old and that many years elapsed before someone thought of applying the well known things contained therein to the vehicle lamp field as well as the widespread acceptance of the invention in the fuel tank industry, which is the industry for which it was made, despite a higher price and the fact that it displaced previous types in that industry to a significant extent.

Under these circumstances, I would say that it is impossible not to find here the amount of inventiveness necessary to sustain the patent in suit and I might very well

repeat here what Mr. Justice Tomlin said in *Samuel Parkes & Coy. Ltd.* v. *Cocker Bros., Ltd.*[1] at p. 248:

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

There is, therefore, here, in my opinion, impressive evidence of inventiveness and of a want in the fuel tanker trade that remained unfulfilled until the DeFrees patent came along and, consequently, the defendant's attack on the patent in this respect must fail.

The defendant's final attack on the validity of the patent is based on the fact that the plaintiffs' patented articles sold in Canada were not marked in accordance with s. 24 of the *Patent Act* which reads as follows:

> 24 (1) Every patentee under this Act shall, if possible, stamp or engrave on each patented article sold or offered for sale by him notice of the year of the date of the patent applying to such article, thus—Patented, 1935, or as the case may be.

The purpose of this requirement appears to be to enable one to add 17 to the year and thus obtain the year of expiry of the patent without going to any expense or trouble to find out when the patent expires.

The evidence discloses that in some cases the patented articles contained the word "patented" and the American patent number and in others, the word "patented" and the Canadian patent number, which, of course, is not in accordance with the above section which, as we have seen, requires the word "patented" and the year.

Now what are the consequences of the failure of the plaintiffs to mark their patented articles as required? Would the only consequence of a breach of s. 24 be a penalty under s. 80 of the *Patent Act*, as submitted by the plaintiffs, or would it go to the substance of the patent itself and invalidate the latter as asserted by the defendant. Section 80 of the Act reads as follows:

> 80. Any patentee under this Act or any one claiming under him who, in contravention of any requirement of section 24, sells or offers for sale

[1] 46 R.P.C. 241 at 248.

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any articles patented under this Act, is liable to a fine not exceeding one hundred dollars, and in default of the payment of such fine, to imprisonment for a term not exceeding two months.

In the case of *Overend* v. *Burrow Stewart and Milne Co.*[1] "it was held that the only consequence of a failure properly to mark the articles, as required by s. 55 of the Act is a penalty imposed by s. 64."

Counsel for the defendant, however, urges that the above decision no longer stands in view of the difference in the wording of s. 45 of the 1935 *Patent Act,* now Sec. 46 of C. 203, RSC (1952) and its predecessor, s. 21 of the 1908 Act, under which latter section the decision was rendered.

Section 46 of the *Patent Act* now reads as follows:

> 46. Every patent granted under this Act shall contain the title or name of the invention, with a reference to the specification, and shall, *subject to the conditions in this Act prescribed,* grant to the patentee and his legal representatives for the term therein mentioned, from the granting of the same, the exclusive right, privilege and liberty of making, constructing, using and vending to others to be used the said invention, subject to adjudication in respect thereof before any court of competent jurisdiction.

I have emphasized the above words "subject to the conditions in this Act prescribed" because the defendant argues that because of these words the grant of the patent is now one "subject to the conditions in this Act prescribed" including the marking requirements whereas those words not being present in the former s. 21, the grant of the patent in 1906 was an absolute grant.

He therefore suggests that now, because of this change in the law, one of the conditions in the present Act prescribed is the imperative direction that the patentee shall mark all articles on the basis that when the words in a statute or law constitute a change, some change in the statute or law was intended to be made or must be assumed to be made and that the marking s. 24 now stands by itself completely removed and divorced from s. 80, the penalty section, and becomes a "condition in this Act prescribed". This failure to mark, he then urges, must therefore be held under the present Act to be non-compliance with the conditions and, therefore, by the very provisions of s. 46, this would render the patent invalid.

He then suggests that as s. 80 of the Act, the penalty section, does not state that the only penalty for not mark-

[1] 19 O.L.R. 642.

ing shall be a fine or in default imprisonment, and having regard to the difference made by the existing law, the *Overend* v. *Burrow Stewart and Milne Co.* decision, referred to above, which says that the only consequence of failure to mark is the penalty, no longer applies and that in addition to being subject to imprisonment and fine, the patent is now invalid because it no longer conforms with all the conditions in this Act.

I am afraid that I cannot agree with the defendant's interpretation of the sections involved for the following reasons.

The words "subject to the conditions in this Act prescribed" of the present s. 46 are in a section which is not grouped with s. 24 and in no way relates to it.

Furthermore, as urged by counsel for the plaintiffs, the history of this legislation confirms the view that the conditions mentioned in s. 46 do not comprise the marking provision which is dealt with in ss. 24 and 80 of the Act.

In c. 69 of the 1908 Revised Statutes of Canada, s. 21, which was the predecessor of s. 46 of the present statute, did not have this provision "subject to the conditions in this Act prescribed" but ss. 38 to 45 of the 1908 statutes which were grouped under the heading "Conditions and Extensions" had *inter alia* the following:

> Every patent shall . . . be subject to the following conditions.

Now these conditions referred to what is termed the abuse provisions, such as for instance, a patentee rendering his patent bad if he failed to manufacture in Canada after the patent had been in effect for two years.

By c. 23 of the Statutes of Canada, 1923, a new Patent Act was created and s. 23 of this Act was the successor of the former s. 21. It was at this time that there was inserted into that section the words "subject to the conditions hereinafter mentioned" which, in fact, included the section on marking which appeared in this Act in s. 51. There was also in this Act a group of sections, 40 to 41, which dealt with conditions, and s. 40 provided *inter alia* that:

> Every patent . . . shall be subject to the following conditions.

In 1935, another Patent Act was enacted and it gave us the wording of today s. 21 being the marking section, s. 45 the granting section and s. 78 the penalty section.

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Now in the present abuse provisions, ss. 66 to 73, apart from the heading which contains the word "conditions" it is no longer stated that the patent will be subject to the following conditions.

We therefore have a situation where, although originally in 1908 no mention was made of the "subject to conditions" in the grant section (s. 21) it is now contained in the present Act in s. 46, the progeny of s. 21 and although the "subject to conditions" was originally in the conditions section of the 1908 Act, it no longer is in the conditions section of the present Act although this section still carries the heading conditions.

Does such a change involve, as suggested by the defendant an amendment to the Act which would now include the marking requirements as a condition to the validity of the Patent. I do not believe that it is possible to conclude that Parliament by merely transferring the "subject to conditions" from one section to another and by changing "subject to the conditions hereinafter mentioned" to "subject to the conditions in this Act prescribed" effected a change in the Act rendering non-compliance with the marking requirements a condition of invalidity in addition to the penalty already provided under s. 80 of the Act. Indeed, had it intended to do so, it could and would have surely, for such an important change, expressed itself more clearly, which, of course, it did not do.

Furthermore, in a matter such as this where the consequence of non-compliance with a statutory requirement is not clearly set out, the intention of Parliament in this regard may be found by inference. An examination of the conditions section, and other pertinent sections of the *Patent Act,* indicates in my opinion that non-compliance with the marking section of the Act would in no way defeat the whole aim and purpose of Parliament. Its purpose is merely, as we have seen, informatory and such a requirement is not always called for but only when possible. This, in my opinion, clearly establishes that the marking prescriptions are not essential to the Act and their omission cannot, therefore, be held fatal to the validity of the patent. Indeed, I believe that such prescriptions are merely directory and their omission might involve, in this case at least, at the most a liability to a penalty as provided by s. 80 of the Act.

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In view of this I must also find that defendant's attack on the patent in suit on the basis of the deficiency in markings must also fail.

There will therefore be judgment for the plaintiffs for the relief sought by them except as to damages. If the parties are unable to agree on the amount of the damages or the amount of profits, if the plaintiffs elect the latter, there will be a reference to the Registrar or a Deputy Registrar and judgment for such amount of damages or profits as found in the reference. If there are any difficulties in settling the minutes of judgment the matter may be spoken to. The plaintiffs are entitled to their costs to be taxed in the usual manner.

Judgment accordingly.