



1964 BETWEEN:

Feb. 17-21,
24-28
Mar. 2-6,
9-11

UNITED MERCHANTS AND MANU-
FACTURERS, INC. }

PLAINTIFF;

1965

AND

June 9

A. J. FREIMAN LIMITED and GER-
ALD N. SPRINGER (trading under
the name of GERRY SPRINGER
COMPANY), STIX INTERNA-
TIONAL INCORPORATED and C. E.
SPRINGER & COMPANY LIMITED }

DEFENDANTS.

Patents—Infringement—Removable plastic strip applied by pressure sensitive adhesive—Description in claims exceeding description in disclosure—Onus of proving first invention date—Patent Act, c. 203 ss. 28(1)(a), 36(1)(a), 36(2).

Plaintiff company sued for infringement of a patent relating to surface coverings. The disclosure indicated that the patentee contemplated bonding, by a pressure sensitive adhesive, of a plastic film with or without cloth or decoration to a paper base which could be readily stripped off, thus permitting the plastic film to be secured by the pressure sensitive adhesive to a given surface. Plaintiff relied on claims set out as follows:

- 1. Method of making decorated surface covering material in sheet form which includes the steps of applying. . . a permanent adhesive. . . .
- 2. A plastic film-strip paper in sheet form adhesively bonded to each other; and
- 3. Laminate for covering surfaces combining in combination a film of vinyl chloride in sheet form bearing an ornamental design on one side thereof, the reverse being secured temporarily to . . . a paper backing.

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The plaintiff's witnesses and counsel emphasized that an essential characteristic of the invented product was its pressure sensitive adhesive quality which enabled it to be applied to a surface by simple pressure and to be readily removed therefrom. The evidence disclosed that in the commercial development of the invention no adhesive other than a pressure sensitive adhesive was ever used.

Held: That the action be dismissed.

- 1. A proper reading of the claims disclosed no limitation that the product be removable and re-applable nor even that a pressure sensitive adhesive be used, and the claims were therefore invalid as going beyond the description of the disclosure. (*Minerals Separation North American Corp. v. Noranda Mines Ltd.* [1947] Ex. C.R. at p. 352, referred to. *Radio Corporation of America v. Raytheon Manufacturing Co.* 27 C.P.R. 1 at 12, *Mullard Radio Valve Company v. The Philco Radio and Television Corporation of Great Britain* [1936] 53 R.P.C. 323 at p. 345, *B.V.D. Company Ltd. v. Canadian Celanese Ltd.* [1937] S.C.R. 221 at pp. 228, 233, applied.)
- 2. It was not permissible for the Court to limit the claims by reference to the disclosure, where the pressure sensitive adhesive feature was stressed. (*Ingersoll Sergeant Drill Company v. Consolidated Pneumatic Tool Company Ltd.* (1908) 25 R.P.C. 61 at p. 83, applied.)
- 3. Moreover the patentee had not complied with s. 36(2) of the *Patent Act* which required that he claim distinctly and in explicit terms the things or combination he regards as new and in which he claims an exclusive property and privilege.
- 4. Because the defendant in an infringement action has by ss. 28(1)(a) and 63(1)(a) of the *Patent Act* the onus of proving knowledge or use before the invention date it does not follow that he must also prove the first invention date. The application date of a patent or the foreign application date pursuant to s. 29(1) of the *Patent Act* is assumed to be the date of the invention and the onus is on the inventor or his assignee to allege and prove an earlier date. (*Omark Industries (1960) Ltd. v. Gouger Saw Chain Co.* 27 Fox P.C. at pp. 39 and 40, followed.).

ACTION for infringement of a patent.

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

David Watson and John D. Richard for plaintiff.

Ross G. Gray Q.C. and J. G. Fogo for defendants.

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

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Noël J. now (June 9, 1965) delivered the following judgment:

This is an action for infringement of patent No. 563,020 issued on September 9, 1958, to David Silman, the inventor, and assigned to the plaintiff, United Merchants and Manufacturers, Inc., which is a body politic and corporate having its head office and principal place of business at the City of New York, in the State of New York, U.S.A. The defendant, A. J. Freiman Limited, is a body politic and corporate having its head office and principal place of business in the City of Ottawa, in the Province of Ontario. The defendant Gerald N. Springer operates a sole proprietorship under the name of Gerry Springer Company, having its place of business at the City of Toronto, in the Province of Ontario. The defendant Stix International Incorporated is an American body politic and corporate having an office and place of business in the city of New York, in the State of New York, U.S.A. The defendant C. E. Springer Company Limited is a company incorporated under the laws of the Province of Ontario and having its head office and principal place of business at the City of Toronto, in the Province of Ontario.

The plaintiff has listed in the particulars of breaches a list of alleged infringements made by the said defendants which it is not necessary to go into at this stage.

The statement of defence produced by the defendants herein, as well as the particulars of objection filed on their behalf, contain a large number of defences which, however, can be summarized as follows: the defendants have not infringed the patent and particularly the claims relied on, as there is a difference between the defendant's products and the product claimed by the patent, and even if they have, the patent is not valid because it has been anticipated, the said claims being so extremely broad that they read of surface coverings in the prior art, because it lacks inventiveness and because the claims are so worded that they claim more than the inventor invented, if he invented anything. It is further alleged: that the said invention as claimed in the patent was not described in the disclosure and that the specification of the patent does not correctly or fully describe the invention or its operational use as contemplated by the inventor and does not set forth clearly the various

steps in the method of making or using the product in such full, clear, concise and exact terms as to enable any person skilled in the art to make or use it; that the said claims fail to state distinctly and in explicit terms the things and combinations that the appellant regarded as new and in which was claimed an exclusive property or privilege as required by section 36(2) of the Act; that the alleged invention, as claimed in each of the claims of the patent, was not a combination but a mere aggregation of elements; and, finally, that the specification of the said letters patent is ambiguous. Furthermore, C. E. Springer and Company Limited's statement of defence as well as that of Stix International Incorporated contain a counterclaim for a declaration that Canadian patent No. 563,020 is and always has been invalid and void.

The alleged invention, according to the plaintiff, relates to surface coverings and the inventive ingenuity, according to counsel for the plaintiff, comes from a combination of the various components which make up this product. These components, according to counsel for the plaintiff, are the cloth, the adhesive, the film, the resin and the paper. There is also the primer which, however, is an optional component. These components can be found in the introductory paragraphs in the patent and in some of the claims. The introductory paragraphs of the disclosure, up to the description of the figures, indicate what the patentee claims for his invention and is reproduced hereunder:

This invention relates to plastic films, pressure sensitive adhesives, and temporary carriers, and the combination thereof in making up articles adapted to cover surfaces.

It is known, of course, to produce a "band-aid" or bandage comprising a strip of plastic sheet, medicated or otherwise, having an adhesive undercoating to which a temporary backing, as for example, gauze, is adhered; the gauze being adapted to be stripped off from the adhesive and plastic covering just before the band-aid is adhesively applied to a surface to be covered.

It is also known to make disposable railroad tickets by supplying the under side of the ticket with an adhesive coating, and temporarily fixing the adhesive coated ticket to a backing such as paper or some other temporary carrier. When the period for which the ticket is issued becomes effective, the paper may be stripped off from the back of the ticket, leaving behind it a substantial residue of the adhesive composition which continues to adhere to the under-side of the ticket. Following removal of the temporary paper backing, the ticket is fixed as by the undercoating of adhesive to what may be termed for convenience a ticket holder or card, and during the period for which the ticket is effective, remains adhesively

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secured to this ticket holder, and at the end of such period is stripped off therefrom subsequently to be replaced by another ticket for the next ensuing period of use.

According to the present invention, however, a disposable backing is supplied and adhesively secured to the undersurface of a decorative article or object in the piece, for example, a web of cloth or plastic film bearing a design on its upper surface. A surface covering of this type may be used as wall-paper in children's rooms and other rooms, to cover shelves in the kitchen, and to attractively ornament the interior and exteriors of cabinets, tables and other home furnishings.

Another object of the present invention is the production of what may be termed a "package" article for the housewife comprising a composite sheet made up of bonded components, which she herself may use to cover any desired surface in the home or out of it with a decorative covering.

A further object is the production of a composite laminated article comprising decorated plastic film or cloth in the piece removably secured as by an adhesive to a temporary paper backing.

A still further object is a method and means for making laminated objects comprising plastic film or cloth in web-like form, temporarily bonded to a removable carrier wherein the surface of the carrier out of contact with the plastic film or cloth is printed with instructions to guide the housewife or other user in stripping the carrier from the film or cloth and adhesively securing what remains, namely, the cloth or film carrying an undercoating of adhesive to a plane or other surface.

A still further object is a product of the character described adapted to cover curved and other non-planar surfaces as well as straight line surfaces by reason of its inherent plasticity or flexibility.

Another object of the invention is a method of making a laminated package adapted to cover a surface which comprises the steps of printing instructions for use on one side of a temporary carrier, coating its other side with a resin of such character as to furnish a relatively smooth surface to the carrier, subsequently depositing a pressure sensitive adhesive on the resin coated carrier on the opposite side to that on which the printed instructions appear, and thereafter adhesively applying a plastic film coating or cloth, having a distinctive design or texturized surface, or not, as may be desired, to the side of the carrier opposed to that which bears the instructions.

A further object is a method and means for annealing plastic film surface coverings of the character referred to above so as to relieve the stresses and strains therein, both natural and those acquired as a result of prior processing, thereby establishing dimensional stability in the finished article.

With the above and other objects in view, as will be apparent, the present invention consists in the construction, combination, and arrangement of parts and/or steps, all as hereinafter more fully described, claimed and illustrated in the accompanying drawings wherein;

The disclosure further indicates that the patentee contemplated the bonding by a pressure sensitive adhesive, of a plastic film with or without cloth, and with or without design or decoration, to a temporary base, preferably of relatively heavy paper arranged in such a way that when the product is to be used for the purpose intended, the paper

may be readily stripped off, thus exposing the pressure sensitive adhesive which remains adherent to the plastic film whereby it may be adhesively secured to the surface to be covered. The paper can be more readily stripped off if a carrier of the phenolic resin type is interposed between the paper and the adhesive.

It is also stated therein that: "If desired, the paper which serves as the temporary carrier for the plastic film may also comprise printed instructions explaining how the article may be employed to cover the surface."

The preferred film is a polyvinyl chloride one in combination with non-migratory plasticizers of the polymeric type and the plasticizer is a component of that film which gives it softness. The ornamentation or design should comprise vinyl inks so that the printed matter and its composition will be compatible with the base to which they are to be applied. The preferred adhesive is of the polyisobutylene type which tends to enhance the flexibility of the product in its relation to the application thereof to curved surfaces and other uneven irregularities. It comprises a synthetic rubber type composition which does not oxidize or promote oxidation. To serve as an anchoring base between the polyisobutylene type adhesive and the plastic film, a primer coating of the rubber latex type may be utilized so that the adhesive will stick more readily to the film. This particular type was used in the early stage but it appears that in the last few years this primer coating was dispensed with and the film sensitive adhesive adheres right to the film. The slip strip paper which refers to the manner in which the temporary backing paper can easily be stripped off may be kraft paper and the instructions may be printed on the outer surface of the slip strip with a phenolic thermosetting resin, namely phenol formaldehyde which prevents offset.

The terms "piece goods" or "goods in the piece" or "object in the piece" are used to indicate by way of example, a bolt or web of cloth or plastic and the words "web-like form" according to the plaintiff means a large piece of material.

It appears from the above that the patentee's declared invention comprises two embodiments, one in which the ornamented surface is a film of plastic preferably a vinyl chloride, sometimes called polyvinyl chloride or vinyl plastic, and one in which the surface is a cloth, backed up by a

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pressure sensitive adhesive. This pressure sensitive adhesive is covered with a temporary layer of paper sometimes referred to as a temporary carrier.

Counsel for the plaintiff in opening clearly stressed the invention and its component parts by stating that the adhesive remained permanently tacky, that it can be applied to a surface and then removed without leaving any residue and that this can be done with no water, no paste and no tools. He emphasized it is washable, waterproof, alcoholic resistant, durable, and can be used to cover and protect. He finally added "it is the very simplicity of the product and the very fact these additional tools are not needed, which is one of the merits of the product".

It is alleged that the art to which the invention in suit relates is that of surface covering to ornament and to protect and that prior to this invention there was very little of relevance in this art. There was the possibility of painting the surface or of wallpapering all of which, however, suffered from many disadvantages such as requiring respectively paint and paste, without having the same appearance nor being as easy to handle as the product of the invention in suit.

With regard to the temporary layer of paper, or the carrier it was urged that it could be stripped off by the user and that it performed several functions namely: covering the adhesive surface and, therefore, making the articles easier to manage, protecting the adhesive surface, thereby preventing dirt from adhering to the adhesive and providing an exceedingly more convenient vehicle for carrying the instructions for use. According to counsel for the plaintiff, this latter characteristic was an important part of the invention because it allowed, for instance, the housewife or the ordinary man to use the material without going wrong. This is what the plaintiff terms a package article in which the user has everything he needs, not only the material, but also something which, in addition to being protective, contains instructions as to how the material should be used.

The invention date, according to the plaintiff's response of June 29, 1961, under Rule 22A, is the period January to April 1951 and the nature of the acts upon which it then declared it intended to rely for the purpose of establishing the same are disclosures of the invention by the inventor to

others. Some attempt was made by the plaintiff to establish this date by means of Mr. Morton Strauss at pp. 72 to 73 of the transcript wherein this witness stated that Mr. Silman, the alleged inventor of the patent in suit, had shown him a sample of Con-Tact on September 2nd or 3rd, 1952:

- Q. Did you acquire any knowledge of the product which afterwards became known under the trade name "Con-Tact"?
- A. As a matter of fact, the following day of my employment I was presented with a very small sample by Mr. David Silman. This sample was some six inches or eight inches square, and represented a piece of what today has become Con-Tacts.

This witness then referred to Ex. 1 (a current sample of Con-Tact) as being the Con-Tact he was referring to.

There is also further evidence by this witness on this point at pp. 90 and 123 of the transcript with reference to the first offering for sale of Con-Tact to a store called Spiegel's, in New York, in the months of April or May of 1954. Cf. pp. 89-90 of the transcript:

- Q. And when was Con-Tact, what became known as Con-Tact, first introduced to the market or, let me clarify my question; when was it offered to the market?
- A. It was first shown and offered to a retail organization in the early Spring of 1954, some year and three-quarters later. Somewhere around February or March I personally took the merchandise to a Chicago mail-order house called Spiegel's, which is a very large multi-million dollar organization, and offered the merchandise to them for sale in their catalogue, which goes directly to some several million consumers in the United States.

The filing of the United States application for the invention appears from Ex. 6 to have been made on August 9, 1954 and that, in my view, under section 29 of the Act, is the earliest date the plaintiff can rely on as the invention date here. I say this because the January to April 1951 date has not been established and I am not satisfied that the evidence of Mr. Strauss satisfactorily establishes the September 2nd or 3rd, 1952 date or even the early 1954 Spring date (which was not properly alleged). I am supported in this conclusion by the fact that the alleged inventor although, according to counsel for the plaintiff, available, was not produced to testify concerning the date of his invention.

I might also deal with a submission made by counsel for the plaintiff that the defendants having, under section 28(1)(a) and section 63(1)(a), the onus of proving that prior knowledge or use occurred before the invention date,

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they, therefore, had to prove also plaintiff's first invention date. This is not my understanding of the position under the Act with regard to the establishment of a date of invention earlier than the one that is established by the records of the Patent Office. I dealt with this subject at some length in *Omark Industries v. Gouger Saw Chain*¹, and reference thereto will indicate that, in my opinion, the application date of a patent or the foreign application date pursuant to section 29(1) of the Act is assumed to be the date of the invention unless, of course, it is established that the invention was made earlier than that date and the inventor, or his assignee, has the burden or onus of alleging and proving such earlier date. In the above referred to case, at p. 39, I pointed out that:

... the *prima facie* validity of a patent does not go beyond the application date and if he (the patentee or his assignee) desires to go beyond this date, he must prove it by cogent evidence.

Having, indeed, under Rule 22A of the *Exchequer Court Rules and Orders* the obligation to state the "particulars of the date which he proposes to assert and the nature of the acts upon which he intends to rely" (which acts I believe may comprise prior uses, disclosure to other persons, written descriptions, drawings, sales, etc.) "for the purpose of establishing his invention date" it would, in my view, follow that this obligation cannot be discharged unless the patentee, or his assignee, who alone is in a position to establish such a date does so in a convincing manner, otherwise the invention will be assumed to have been made on the date which appears on the face of his patent (or the convention date).

Counsel for the plaintiff, at the end of the trial, stated that the plaintiff relied on three claims only, i.e., claim 5, which deals with a method of making decorative surface covering material in sheet form; claim 8, which is a product claim and deals with a plastic film slip strip paper in sheet form adhesively bonded to each other, and claim 13, which is also a product claim and which deals with a laminate (i.e., a material composed of several layers joined together) for covering surfaces using a film of vinyl chloride bearing an ornamental design. These three claims are set out hereunder:

5. Method of making decorative surface covering material in sheet form which includes the steps of applying a decorative pattern to the top side of the material and a permanent adhesive to the under side thereof,

securing a temporary paper backing to the exposed adhesive, said backing being adapted subsequently to be stripped from the adhesive, and printing instructions on the exposed surface of said temporary paper backing for stripping the backing from the adhesive and applying the decorative surface covering to a surface to be covered.

8. As a new article of commerce, a plastic film-slip strip paper in sheet form adhesively bonded to each other, the exposed surface of the paper out of contact with the plastic film being printed with instructions for stripping the paper from the plastic film and subsequently adhering said plastic film to any desired surface.

13. Laminate for covering surfaces comprising in combination, a film of vinyl chloride in sheet form bearing an ornamental design on one side thereof, the reverse side of the film being secured temporarily to one side of a paper backing, the other side of the paper backing bearing printed instructions for separating the backing from the film and applying the separated film as a surface covering.

Before dealing with the claims, it might be useful to repeat here, what has been stated so frequently in patent cases, that the claim or claims in a patent alone define the monopoly where the patentee has a statutory duty to state in the claims what is the invention he desires to protect and it is in the claims only that one should find the forbidden field described.

In the *Minerals Separation v. Noranda case*¹ Thorson P. set down clearly the obligations of the patentee with regard to the matter of drafting claims as follows:

"Section 14(1)" (which is now section 36(2)) "also requires that the specification shall end with a claim or claims stating distinctly the things or combinations which the applicant regards as new and in which he claims an exclusive property and privilege. By his claims the inventor puts fences around the fields of his monopoly and warns the public against trespassing on his property. His fences must be clearly placed in order to give the necessary warning and he *must not fence in any property that is not his own*. The terms of a claim must be free from avoidable ambiguity or obscurity and must not be flexible; they must be clear and precise so that the public will be able to know not only where it must not trespass but also where it may safely go."

(*The italics are mine*).

Before approaching the question of validity and infringement, the first duty of the Court is to construe the claims, and this should be done like any other document with due regard, however, to the special functions of the claims. After properly instructing itself as to the technical matters involved and acquainting itself with the art of the patent in suit, and looking at the meaning of the words used in the

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¹ [1947] Ex. C.R. 306 at 352.

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claims, the Court must then see what invention, if any, they define.

Now, although in determining what the claims mean, the specification at large must be considered and the whole document read, this does not mean to use the language of Lord Loreburn in the *Ingersoll Sergeant Drill Company v. Consolidated Pneumatic Tool Company*¹ that one can tolerate "the idea of allowing a patentee to use perfectly general language in the claim and subsequently to restrict, or expand, or qualify what is therein expressed by borrowing this or that gloss from other parts of the specification . . .".

It is indeed a cardinal rule of interpretation that when plain ordinary words are used, they should be given their plain ordinary meaning. It is also well established in patent law that, if a particular term is proven to have a special meaning in the art, unless such term has been defined in a dictionary sense in the disclosure, it should be given the meaning ascribed to it in that art.

It is also a rule peculiar to patent law that the claim or claims must be construed without reference to any document relied upon as an anticipation in order to prevent the construing "of a claim with an eye to avoiding the effect of a prior document". Of Lord Green in *Molins et al v. Industrial Machinery Company*².

One must, therefore, divorce one's mind from the prior art and look at what the claims mean as they stand. Once that is done, the evidence as to the prior art may be considered. In the present case, it consists of prior documents and prior uses. It then follows that, when looking at the prior art, one should not look at and compare the prior art with the plaintiff's product as made and sold in the market place but with the claims in the patent relied upon. I might add that, to determine whether or not there is infringement, one must compare the defendants' product not with the disclosure nor with what the plaintiff is doing in the market place, but only with the claims of the patent. It is indeed a quite wrong approach to compare the defendants' product with the plaintiff's product, unless prior thereto the claim relied on has been properly sustained in the light of the prior art and the plaintiff's product has been shown to embody the claim.

¹ (1908) 25 R.P.C. 61 at 83.

² (1938) 55 R.P.C. 31 at 39.

I will now proceed to the construction of the three claims relied on by the plaintiff herein with emphasis only on those elements which could be contentious or which require a proper determination of their significance. I shall strive to do this in the light of the common knowledge which persons skilled in the relevant art are assumed to have had at the date of the patent, which knowledge is acquired with the aid of the expert evidence as to the state of the art at the date of the patent, the meaning of technical terms and the working of the invention.

The first point of contention with regard to claim 5, which point also applies to claim 13, is the meaning of the expression "surface covering" material. Mr. Parrington, on behalf of the plaintiff, was asked at p. 277 of the transcript:

Q. . . . Can you explain what that is that you have just cut off?

A. This exhibit represents a surface covering material; . . . On the surface which I display to the court we see a decorated, which means to say, a printed and textured surface, obviously in a wood grain design . . .

Now here I may say that the words decorative or decorated surface covering have no special meaning in the art and, consequently, these words cannot be confined to printed or textured surface, such as suggested by the witness nor as urged by counsel for the plaintiff, so as to exclude emblems for instance on the basis that the purpose of emblems is not to decorate and protect surfaces. These words must, in my view, be given their clear ordinary meaning which obviously is a very broad one and extends, in my opinion, to all materials that are adapted to cover a surface and are decorative, i.e., that please the beholder, that have "eye appeal", that are "nice to look at", because "decorative" connotes "eye appeal" and an emblem may well cover a surface and be decorative or have "eye appeal". It is even questionable that the decorativeness of the material is an essential element in the embodiment of the alleged invention. It indeed appears from the disclosure of the patent in suit that such decorativeness of the material is optional (cf. column 3 of the patent where the following words appear "with or without a design or decoration" and claim 8 contains no such decorative requirement). Furthermore, as in the disclosure of the patent and in the submission of counsel for the plaintiff, emphasis is laid on the use of adhesives, the relevant art herein appears clearly to be not

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merely the surface covering art to protect and decorate, but the adhesive coated material surface covering art in general.

The second point of difficulty is the words "in sheet form" which are found in the three claims. Mr. Parrington here again explained the term at p. 312 of the transcript as follows:

- A. That is an expression of the trade and would mean to say a piece of material of considerable length and more than average dimension, or a piece of material of substantial width and length, again as an expression of our trade.

The witness then stated that a plastic raincoat would not be in sheet form and, of course, that is clearly so.

He was later presented with Ex. L, which is a laminate a little less than seven inches wide by a little less than nine inches long, and he admitted this was in sheet form.

It appears to me from the evidence that although some of the witnesses have drawn a distinction between "sheet form" and "roll form" they are merely talking about the manner in which the same material has been sold. In my view, the question is what can be correctly described as sheeted material, rolled or not rolled. The mention made in the disclosure of webs and cloth in the piece and the suggestion by the plaintiff that this would indicate that the words "in sheet form" are confined to huge lengths of material, is not supported by the evidence nor does the plain ordinary meaning of the words "in sheet form" indicate that such is the case. These words, in my view, merely mean that the material is a sheet, i.e., that it is not three-dimensional but something that is flat and thin irrespective of size and can even encompass a band-aid, as appears from the very reference to a band-aid in the disclosure of the patent in suit at column 1, lines 15 and 16, where the word "sheet" is used to describe a component of the band-aid:

It is known, of course, to produce a "band-aid" or bandage comprising a strip of plastic sheet...

I therefore have no hesitancy in finding that small pieces of sheet material are also in sheet form. Indeed, I have no doubt what would happen if someone took a piece of Stix material, cut it in a small size and placed it on the market; the plaintiff would undoubtedly take the position, and rightly so if the claim is valid, that such material is in sheet form and sue for infringement.

There are also other expressions which must be defined. They are the words "permanent adhesive" in claim 5, "adhesively bonded" in claim 8 and "the reverse side of the film being *secured temporarily* to one side of a paper backing" in claim 13.

I should first like to deal with the term "secured temporarily" which is very ordinary and very broad language and which clearly cannot be held necessarily to require that the temporary securing be accomplished by an adhesive. It is general language which, in my view, would apply to any means of securing the laminate temporarily and it would include not only the pressure sensitive adhesives but also the heat and solvent activated ones (which are respectively adhesives activated by heat and by solvents). Indeed, it would encompass any mode, even a mechanical one, of securing the laminate together.

With regard to the term "permanent adhesive" the very fact that a considerable part of the evidence was devoted to finding out what it meant and that varying interpretations were given as to the number of possible meanings it may have, indicates clearly that in any event it is a very broad term.

Mr. Parrington, on behalf of the plaintiff, looking at Ex. 21, which is a sheet cut off the roll of a piece of Con-Tact stated at p. 278 of the transcript:

A. ... We find on the obverse side, or the side opposite the printing a layer of pressure sensitive adhesive described as that backing or permanent pressure sensitive, or permanent adhesive, and if I demonstrate just quickly, we see it sticks upon contact even in the absence of pressure and is removable.

And at p. 331 of volume 3, this same witness, at line 25, referring to the outer surface of the plastic film states:

A. ... we find a pressure sensitive or permanent adhesive.

At p. 333 of the transcript he states that pressure sensitive adhesives are designed to last indefinitely.

It therefore appears that what the plaintiff's witness is saying here is that pressure sensitive adhesives connoting permanent tackiness must, therefore, be a permanent adhesive.

It does not follow, however, from this, and relying only on the plaintiff's evidence in this respect, that the expression "permanent adhesive" refers only to pressure sensitive adhesives.

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There is indeed no reference in the disclosure to permanent adhesive whatsoever and, therefore, within the patent specification, there is nothing which would indicate that permanent adhesive by definition connotes necessarily a pressure sensitive adhesive. As a matter of fact, Mr. Parrington, the plaintiff's witness, admits this very point at p. 535, volume 4, of the transcript:

Q. Are you suggesting that the term "permanent" as applied to adhesive means that it must be a pressure sensitive adhesive?

A. No, the expression "permanent" means to infer that it acts as an adhesive permanently.

Now as a heat activated adhesive or a solvent adhesive, as admitted by this same witness, acts also as a permanent adhesive, the words "permanent adhesive" cannot, in my view, be read as applying only to a pressure sensitive adhesive.

I have also considered the words "permanent adhesive" in this context in the whole of claim 5, and particularly in relation to the words "securing a temporary paper backing to the exposed adhesive, said backing being adapted subsequently to be stripped from the adhesive" with a view to determining whether they indicated necessarily a pressure sensitive adhesive. Here also I must conclude that they do not, because the evidence, in my opinion, discloses that even the heat activated adhesive can be peeled off and the degree of pulling would involve just about the same amount of force as with the pressure sensitive adhesive.

Mr. Parrington, in connection with a heat activated adhesive, being a permanent adhesive and being removable, was cross-examined in this regard at p. 537 of the transcript:

Q. Have you ever heard of heat activatable adhesives?

A. Yes.

Q. What are they?

A. Adhesives responsive to heat and therefore called thermoplastic materials.

Q. . . . can heat activated adhesives be used to laminate one surface to another surface?

A. Yes.

Q. Can it be used to laminate a plastic film to a sheet of paper?

A. Yes.

Q. And assuming that such a laminate were made... could such an adhesive be regarded as permanent adhesive?

A. Yes, it could.

Q. Could it be regarded as a temporary adhesive?

A. Yes, it could be regarded as a temporary adhesive too.

The witness was then asked whether the backing paper could be regarded as being temporarily secured to the film to which he replied:

A. No, Mr. Gray, not without employing a number of other qualifications, which you haven't qualified.

Q. Such as what?

A. For instance, the adhesive—My Lord, it may be bonded to the paper with the application of heat. It is then a permanent adhesive until it is re-softened by the application of heat. Re-softening again gives it adhesive quality, but it does not imply that it is separable from the paper to which it was applied, unless the paper were of such a sort as to have only a mild degree of adhesion to the adhesive film.

This same witness was then asked if his answer would be different if the paper were coated with an anti-adhesive coating to which he replied:

A. My answer would be, then, no, we do not have a permanent adhesive because in the instance of using a thermoplastic adhesive against an anti-adhesive coating on paper, we would effect no bond.

This answer in my view indicates to me that the witness here was quibbling and had no desire to answer the real point involved in this line of questioning, which, however, he does answer in some measure when further examined on this point and when he finally admits that, of course, the permanency of the adhesive, if an anti-adhesive coating is used, is a matter of degree depending upon how much is used in a particular case. He indeed had to admit that the degree of anti-adhesiveness had a bearing on whether there was a permanent adhesive or not, as, if he had not, having stated in earlier testimony that even Con-Tact uses an anti-adhesive coating, he would then have had to admit that the plaintiff's product could not be considered as a permanent adhesive. He also admitted that pressure sensitive adhesives are also thermoplastic or thermosensitive. It therefore follows that a heat activatable adhesive, with a certain degree of anti-adhesive coating applied thereto is not only a permanent adhesive, but also could have a backing paper temporarily secured to the film.

There appears to be further confusion possible in using the term "permanent adhesive" in that within the pressure sensitive adhesives, there can be two types of laminated material, one that can be easily separated and the other

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which one cannot separate without destroying the film. This was brought out by the defendants' witness, Mr. Palmquist at p. 1034, at line 3, of the transcript:

Q. As a matter of terminology, do you distinguish between the sort of pressure sensitive adhesive in the material you just referred to and the pressure sensitive adhesive in the early material, the exposed surface of which cannot be removed?

A. Well, our terminology—we refer to the one as the permanent type adhesive and the other as a removable type of adhesive.

And at p. 1280, this same witness cross-examined by counsel for the plaintiff on the suggestion that there is something different between what is a permanent adhesive and something which creates a permanent bond, replied:

A. Well, this is the type of terminology that we can use in our organization to contrast combinations of materials that can be easily removed. There is an entirely different concept to what a permanent adhesive might be. It might be one that would last forever...

Later, the witness stated that his definition with respect to permanent was not in connection with the life of the adhesive. Finally, at p. 1287, line 13, Mr. Palmquist stated:

A. In the usage of the art permanent can be something with respect to its life, and it also can describe a property with respect to the degree with which it bonds to a surface. In our particular thinking and terminology we are talking about the degree of bonding, and not how long it lasts.

It, therefore, in my view, follows that whatever the term "permanent adhesive" means, and I believe we can say that it may have many and various meanings, it certainly cannot be said to be synonymous with pressure sensitive adhesive whether or not it is read in the context of claim 5 of the patent in suit.

The definition of pressure sensitive adhesive as taken from p. 80 of the American Adhesive Index, edited by Patrick McGuire, and read to Mr. Palmquist by counsel for the plaintiff, is as follows:

An adhesive film displaying permanent tackiness and universal adhesion; an adhesive surface which requires only temporary pressure to achieve adhesive bonding.

It does not, however, follow, in my opinion, that because this definition discloses that pressure sensitive adhesion means one that is permanently tacky (i.e., sticky, must have a grab to it, not completely dry and yet not so wet that it just strips out) that a permanent adhesive is one that is necessarily a pressure sensitive adhesive but it could also be

a heat or solvent activated adhesive or any other type of adhesive providing it gives rise to a permanent bond and because of this, the term "permanent adhesive" must, as used in claim 5, be taken to have that very broad meaning.

I am further convinced that such is the proper construction to be given to the words "permanent adhesive" if consideration is given to the words used on numerous occasions in the disclosure of the patent in suit, namely "pressure sensitive adhesive", to describe an adhesive that always remains tacky. That term was immediately available and at hand and, in my view, should have been used in the claim if the disclosed invention was to be properly described. In addition, in claim 6 (which up until the end of the evidence, was involved in these proceedings but which thereafter was withdrawn from suit by counsel for the plaintiff) this very terminology of "pressure sensitive adhesive" was used. The fact that in claim 6 the patentee used this specific terminology and that in other claims he refers to adhesives at large or to polyisobutylene adhesives, indicates necessarily that when the patentee uses these different phrases he is not using them as having the same meaning. That also confirms the view that the words "permanent adhesive" as used in claim 5 mean something much broader than pressure sensitive adhesive.

I now come to the term "adhesively bonded to each other". These words, in my view, are even broader than "permanent adhesive" and can in no way be restricted to a pressure sensitive adhesive even in the context of the wording used in the claim which indicates that the backing paper is to be stripped from the film in order to adhere to a surface. The language here also is clearly sufficiently broad to cover the heat activatable adhesives.

I now come to the term "slip strip" used in claim 8 in association with the word "film" at lines 16 and 17 of column 8 of the patent in suit as follows: "film-slip strip". Mr. Parrington was questioned at p. 303 of the transcript, by counsel for the plaintiff as to the meaning of these words and his answer was:

- A. ... this falls in the vernacular of the trade. That is, a paper that may be slipped or stripped off; it may be slipped back on. It is another expression for temporary backing, removable backing.

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This same witness was then cross-examined later on this subject and shown Ex. H which is a "decal" transfer. He was then asked at p. 492 of the transcript:

Q. Referring to the backer, the paper that is slid off the film of Exhibit H, is that a temporary paper backing?

A. This is obviously a fibrous structure like paper. I would identify this very probably as paper, but not positively. Since it has been separated from the decal I think it would fall in the category of "temporary".

Q. Would it fall in the category of being regarded as a slip strip?

A. In the vernacular of the pressure sensitive trade we might identify this as a slip strip.

Q. Or slip strip paper?

A. Yes, or slip strip paper.

He then, however, refused to agree that if the film were a plastic film, the laminate could be termed a plastic film slip strip paper by stating:

A. No. The defect in so identifying is that the article cannot be conveniently returned to the paper for later re-application, in my estimation.

Having thus brought into the significance of the word slip strip the requirement also that it should be returnable to the paper for later application, he was then queried on this matter as follows:

Q. Is that (its returnability) a necessary quality of the expression "slip strip paper"?

A. That is an implication of the expression "strip slip".

Q. But a few moments ago you said it would be appropriate to term this a slip strip paper.

A. That is true.

Having admitted as this witness did that the "decal" material was a slip strip paper, if the film thereon was a plastic film, it clearly follows, in my view, that it would be necessarily a plastic film slip strip paper. To import into the words used, in the absence of the words "pressure sensitive adhesive", which, as seen, is one which is always tacky, the further requirement as put by the witness that in his estimation (and it may be noted that he is not relying on any particular significance of these words in the art) the articles must also be able to be conveniently returned to the paper for later reapplication is not acceptable not only because of the prior testimony of the witness to the effect that "in the vernacular of the pressure sensitive trade we might identify this" (the "decal" transfer, Ex. H.) "as a slip

strip" but also because of the clear ordinary meaning of the words slip strip which can be found for instance in the Shorter Oxford English Dictionary where one of the meanings of slip is (3) a long and relatively thin (sic) and narrow (sic) piece or strip of some material and where the significance of strip is "to doff, take off, peel away, remove from".

Having regard to these meanings, it can be taken, in the absence of a proven technical meaning in the art different from the plain and ordinary meaning, that we are merely dealing here with a material that can be stripped off something and it connotes no requirement that it be possible to reapply it. It therefore encompasses all materials that can be stripped or peeled off.

This disposes of the terms used in the three claims in suit which gave rise to some difficulty. Before leaving the subject, it might be useful to review here the meaning of the language of the three claims in the light of the conclusions that I have just reached.

Claim 5 deals with a method of making a material (it is not restricted to a plastic film) whether it is a film or a cloth or any other material, adapted to cover a surface. The material must be decorative (appealing to the eye) and in sheet form (i.e. thin and flat irrespective of size) and involve the following steps: the application of a decorative pattern on the top side of the material, of a permanent adhesive to the under side (and this means any adhesive, whether pressure sensitive or heat activatable, as long as it creates a permanent bond), then the securing of a special type of temporary paper backing to the exposed adhesive and, finally, the printing of instructions on the exposed surface of the temporary paper backing.

Claim 8 is directed to a new article of commerce, more particularly a plastic film (which includes any plastic including cellulose acetate film) slip strip paper (i.e., a removeable backer made of paper). It also calls for a combination of any film and a removeable paper backer to be in sheet form (ie. thin and flat irrespective of size) and then the words "adhesively bonded to each other" which encompasses any type of adhesive so long as it has some sort of bonding action, with instructions printed on the paper dealing with the manner in which to use the product.

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Claim 13 calls for a laminate for covering surfaces comprising a film of vinyl chloride, which (according to the plaintiff's witness Parrington, at p. 298 of the transcript) is also known under the terms "vinyl film, vinyl film and sheeting, polyvinyl chloride, a film of vinyl chloride, vinyl chloride film". The laminate bears an ornamental design on one side of it, and the reverse side of the film is "*secured temporarily*" to one side of the paper backing which may be done by means of any type of appropriate adhesive or even without an adhesive at all and finally here also the other side of the paper backing bears printed instructions as to how the product is to be used.

The above, in my view, not only establishes that the language used in the three claims, and particularly with regard to the matter of adhesiveness of the laminate, is extremely broad but also that it goes beyond not only the invention as described in the disclosure and as emphasized by the plaintiff's witnesses, but also the invention as described by the plaintiff's counsel. Indeed, both of the plaintiff's witnesses, Mr. Strauss and Mr. Parrington, were at great pains to emphasize that a fundamental and essential characteristic of the invented product was its ability to be put on and taken off, that there were no messy solvents, or heat required in view of this always tacky pressure sensitive adhesive. There are indeed many references in the evidence to this pressure sensitive adhesive feature as being essential to the invention such as, for instance, its application to a surface by simply pressing upon it, the fact that there is no need for special tools, except scissors, no spilling or wiping up (none of which would be applicable if a heat or solvent activated adhesive was used). The evidence is also to the effect that, in the development of Con-Tact, no adhesive was ever used other than pressure sensitive adhesives. Finally, the evidence of commercial success has no significance whatsoever except in relation to the pressure sensitive adhesive.

It therefore appears that a proper reading of the three claims discloses no limitation that the product be removable and reapplicable nor even that a "pressure sensitive adhesive" be used (although claim 6, which is not in suit, calls for such an adhesive). In view of this, it necessarily follows that the disclosure of the specification does not

support the claims and, if this is so, the claims are invalid on this basis alone. It also follows that the patentee has not complied with the requirement of section 36(2) of the Act which requires the applicant to state in the claims distinctly and in explicit terms the things or combinations that he regards as new and which he claims an exclusive property or privilege.

In *Radio Corporation of America v. Raytheon Manufacturing Co.*¹ Thorson P. clearly dealt with a similar situation when he said:

. . . It is a cardinal principle of patent law that an inventor may not validly claim what he has not described. In the patent law jargon, it is said that the disclosures of the specification must support the claims. If they do not, the claims are invalid.

The fact that, in none of the claims in suit, the pressure sensitive adhesive or the removeability of the product and its reapplicability, two essential characteristics of the patentee's invention, are not mentioned at all makes these claims different from and much wider than the alleged invention and the patentee, therefore, is not entitled to these claims.

Further authority on this matter can be found in the *Mullard Radio Valve Company v. The Philco Radio and Television Corporation of Great Britain*² in the House of Lords where this very question of a patentee claiming too extensively was dealt with by Lord MacMillan at p. 345 as follows:

A patentee may make a most meritorious discovery and may give an entirely adequate description of his inventive idea and of the manner of putting it into practice, but when he comes to formulate the claim to his invention he may claim a monopoly wider in extent than is warranted by what he has invented.

And at p. 346 he continued:

. . . A patentee is granted his monopoly in order to protect the invention which in his specification he has communicated to the public. He is not entitled to claim a monopoly more extensive than is necessary to protect that which he has himself said is his invention.

At p. 347 he added, and this is rather pertinent to the present case:

It was argued for the Appellants that if an article is new, is useful and has subject-matter, then it is necessarily patentable and entitled to protection. But a claim may be for an article which is new, which is useful and which has subject-matter, yet it may be too wide a claim because it extends beyond the subject-matter of the invention.

¹ 27 C.P.R. 1 at 12.

² (1936) 53 R.P.C. 323.

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The language of the three claims here, as we have seen, is so broad that it clearly extends beyond the subject-matter of the invention and as this language is couched in clear ordinary words which cannot, in my view, be legitimately limited in their scope by a reference to the specification, they must be held to be invalid.

Dealing with a very similar situation in *B.V.D. Company Ltd. v. Canadian Celanese Ltd.*¹ Davis J. stated at p. 228:

A formidable objection to the validity of the patent is advanced by counsel for the appellant upon the ground that the claims are not limited to the use of woven cellulose yarns but extend to the use of a cellulose derivative in any form.

The objection then, to the validity of the claims is that they omit any reference to what counsel for the respondent at the trial described in the opening statement as "the new ... and all important feature of the invention" namely, the form in which the thermoplastic derivative of cellulose to be acted upon is to be present in the layers of fabric to be united.

At p. 230 he added:

Unless the claims in the Canadian patent can properly be narrowed by the introduction of a limitation to the use of the cellulose derivative in the form of yarns, filaments or fibres, they are, we think, clearly anticipated by the United States patent of Van Heusen and the British patents of Green and Henry Dreyfus.

And then at p. 233, after asking why the claims omit what counsel stated at the trial was "the new . . . and all important feature of the invention" and why this was left out of the claims, he concludes at p. 233 as follows:

... We cannot say. Throughout the somewhat long specification there is a continuous reference to the use of the thermoplastic derivative of cellulose in the form of yarns, filaments or fibres and it is plainly the very essence of the disclosure in the specification. Why, then, was it left out of the claims? It may have been a slip of the draftsman or it may have been a deliberate omission in an effort to secure a wider field of protection than the disclosure warranted.

The same question may be asked in the present case and we may well wonder why, when in claim 6, which is not in suit, the term "pressure sensitive adhesive" was used, it was not used in the claims in suit. I might also point out that in the American judgment (Ex. 7) filed by the plaintiff, which sustained the American patent of the plaintiff, the two corresponding claims used the words "pressure sensitive permanent adhesive".

There appears to me to be no possible justification for the patentee here to have used, as he did in the three claims in

¹ [1937] S.C.R. 221.

suit, such general language as “permanent adhesive”, “adhesively bonded” and “secured temporarily”. In view of the proper terminology used in claim 6 of the patent, the only reason for so doing appears to me to have been to secure a wider field of protection than the disclosure warranted.

It also appears that I cannot, in order to limit these claims, go to the disclosure where the pressure sensitive adhesive is stressed because there is nothing which can justify me in doing so. There is indeed, as far as I know, no dictionary meaning in the specification which could give a particular significance to the words used in the claims and which would necessarily limit them to a pressure sensitive type of adhesive. If this cannot be done, no assistance can be obtained by a reference to the disclosure. Moreover, to do so in such circumstances would be quite unwarranted. It would be doing what the Lord Chancellor, Lord Loreburn said should not be done in *Ingersoll Sergeant Drill Company v. Consolidated Pneumatic Tool Company Ltd.*¹ when he said at p. 83:

... Obviously, the rest of the Specification may be considered in order to assist in comprehending and construing a Claim, but the Claim must state, either by express words or by plain reference, what is the invention for which protection is demanded. The idea of allowing a patentee to use perfectly general language in the Claim, and subsequently to restrict, or expand, or qualify what is therein expressed by borrowing this or that gloss from other parts of the Specification, is wholly inadmissible. I should have thought it was also a wholly original pretension.

Now two of the claims, claim 5 and claim 8, are not only unreasonably broad but they are quite ambiguous. Indeed, the use of the terms “permanent adhesive” and “adhesively bonded” when the clear words “pressure sensitive adhesive” had been used extensively in the disclosure and even in one claim, and were available, when there were a number of adhesives mentioned in the specification of the patent, can only indicate to me that the patentee was deliberately using general language. If one looks at the claims of the patent, one is struck by the fact that the patentee took great pains to differentiate in the claims the various types of adhesive. In claims 1 to 4 he mentions a polyisobutylene adhesive, in claim 5 a permanent adhesive, in claim 6 a pressure sensitive adhesive, in claims 6, 7, 10 and 11 a polyisobutylene type of adhesive, in claims 7, 10 and 11 a thermoplastic adhesive

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¹ (1908) 25 R.P.C. 61.

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(for the other adhesive near the cloth), in claims 7, 9, 10, 11 two coatings of adhesives, in claim 8, adhesively bonded, in claim 12 "secured" or "adherents" (with no reference to an adhesive at all) and finally, in claim 13, "secured temporarily" (with no reference to an adherent at all).

Such a deliberate use of general language can only indicate that the purpose of using such language (as stated by Lord Justice Romer in *British Hartford Fairmont Syndicate Ltd. v. Jackson Bros. (Knottingley) Ltd.*¹) "may well have been intentional and created with the object", to use the words of Lord Loreburn in the *Natural Kinematograph case*².

...of holding in reserve a variety of construction for use if the patent should be called in question, and in the meantime to frighten off those who might be disposed to challenge the patent.

The three claims in suit, 5, 8 and 13 go far beyond the invention and upon that ground alone these three claims are, in my view, invalid.

In view of the conclusions I have reached with regard to the three claims relied on herein, it becomes unnecessary to deal with the other submissions made for the defence and particularly with the defence of invalidity based on the said claims being anticipated or not being inventive, other than to say that having regard to the date of invention of the patent in suit which, as already mentioned, corresponds with the American application date, i.e., August 9, 1954, and the extremely broad language of the three claims in suit, the evidence with regard to the available and applicable prior knowledge, prior patents and even prior use (in the relevant art as hereinabove defined) is such that the claims as drafted cannot, in my view, contain even the scintilla of inventiveness required to sustain them. I should also add that the presence of printed instructions and the reference thereto in the claims cannot, in my view, lend patentability to an otherwise unpatentable combination, nor can the contents of the instructions be used to import a limitation into the claims.

The action, accordingly, fails and will be dismissed with costs and the counterclaims restricted as stated by counsel

¹ (1932) 49 R.P.C. 495 at 556.

² (1915) 32 R.P.C. 256 at 257.

for the defendants to the claims in suit only, is therefore maintained with costs to the two defendants who have counterclaimed, i.e., Stix International and C. E. Springer Company, Limited. The said three claims in suit 5, 8 and 13 are, therefore, declared to be invalid. As the four defendants were represented by the same counsel there will only be one counsel fee at trial in the principal action and one counsel fee at trial in the counterclaims.

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