

<p>1944 { Sept. 22 — 1946 { Dec. 31 —</p>	<p>BETWEEN:</p>	<hr style="width: 20%; margin: 0 auto;"/> <p>WINTHROP CHEMICAL COM- PANY INCORPORATED..... } AND THE COMMISSIONER OF PATENTS, }</p>	<p>APPELLANT, RESPONDENT.</p>
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(No. 2)

Patents—The Patent Act, 1935, ss. 40 (1), 40 (4)—Claims for substances prepared or produced by chemical processes and intended for food or medicine—Meaning of word “claimed”—Claim for substance per se not valid—Separate claim for process not required.

Each of the claims in the appellant’s patent specification contained the definition of a substance prepared by a chemical process and intended for medicine together with a definition of the process by which it was prepared so that the claim was for the substance as prepared by the defined process, but the process itself was not claimed. The Commissioner of Patents rejected the claims on the ground that section 40 (1) of The Patent Act, 1935, required that claims for the substances covered by it must be accompanied by claims for the processes by which they were prepared. From such decision an appeal was taken.

Held: That section 40 (1) is complied with if in a claim for a substance to which it applies the process of its manufacture is described in the disclosure of the specification and so defined in the claim as to be made an essential element thereof so that the claim is restricted to the substance as produced by the process so defined, even if such process is not a patentable one. There is no need for a separate claim for the process.

1946
WINTHROP
CHEMICAL
COMPANY
INC.
v.
COMMISSIONER
OF PATENTS
(No. 2)

APPEAL from a decision of the Commissioner of Patents under section 40 (1) of the Patent Act, 1935.

The appeal was heard before the Honourable Mr. Justice Thorson, President of the Court, at Ottawa.

Christopher Robinson for appellant.

W. L. Scott K.C. for respondent.

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

THE PRESIDENT now (Dec. 31, 1946) delivered the following judgment:

This appeal depends on the construction of section 40 (1) of The Patent Act, 1935, Statutes of Canada, 1935, chap. 32, which provides:

40. (1) In the case of inventions relating to substances prepared or produced by chemical processes and intended for food or medicine, the specification shall not include claims for the substance itself except when prepared or produced by the methods or processes of manufacture particularly described and claimed or by their obvious chemical equivalents.

The appellant applied for a patent for an invention relating to basic double ethers of the quinoline series. Four claims were included in the specification. In each claim there was a definition of a substance prepared by a chemical process and intended for medicine together with a definition of the process by which it was prepared so that the claim was for the substance as prepared by the defined process, but the process itself was not claimed. The Commissioner rejected the claims on the ground that section 40 (1) required that claims for substances covered by it must be accompanied by claims for the processes by which they were prepared, and from such decision this appeal was taken under section 40 (4).

The respective contentions may be briefly stated. The Commissioner's view is that there cannot be a valid claim

1946
 WINTHROP
 CHEMICAL
 COMPANY
 INC.
 v.
 COMMISSIONER
 OF PATENTS
 (No. 2)
 THORSON P.

for a substance under section 40 (1) unless there is also a separate claim for the process of its manufacture; that a product claim cannot stand without a process claim; and that if the inventor cannot claim the process he has no right to a patent for the substance either *per se* or even as produced by a defined process. According to the Commissioner, the word "claimed" in the section means that the process of manufacture must be made the subject of a separate claim. The appellant's contention is that section 40 (1) does not go so far in its requirements; that its purpose was to prevent, in the case of the substances to which it applied, the issue of patents for such substances *per se* and that such purpose would be fully served by restricting the claim to the substance as produced by the process of manufacture particularly described in the disclosure of the specification and defined in the claim. In this view, the word "claimed" means that the process of manufacture must be defined in the claim so as to be made a constituent element of it.

It was contended for the Commissioner that the meaning of section 40 (1) was too clear to admit of argument; that its purpose was to prevent the patenting of new substances of the kind covered by it unless the process of their manufacture was also patentable; that there cannot be a valid claim for the substance even if new unless the process of its manufacture is also new. If the word "claimed" is capable of only one meaning and such meaning is that the process must be made the subject of a separate claim then, of course, there is no room for further argument and the Commissioner's construction of the section must be accepted. Indeed, that was my first inclination, but further consideration of the argument by counsel for the appellant and the history and purpose of the section has led me to the contrary conclusion.

There is no canon of construction more commonly applied than the rule in *Heydon's Case* (1). The rule there referred to was said to be applicable to a statute effecting a change in the common law, but I see no ground of principle for not extending its application to a statute effecting a change in the previous law whether common or statutory. It is, therefore, necessary to consider the state

(1) (1584) 2 Coke 18.

of the law prior to the statute to be construed, the mischief or defect for which the previous law did not provide and the nature of and reason for the remedy provided by the statute, so that, as Lord Coke put it, such construction of the statute shall be made "as shall suppress the mischief, and advance the remedy."

Section 40 (1) was an amendment of section 17 (1) of the Patent Act, R.S.C. 1927, chap. 150, first enacted in 1923, Statutes of Canada, 1923, chap. 23. This was taken from section 38A.—(1) of the Patents and Designs Acts, 1907 and 1919, of the United Kingdom, as first enacted by section 11 of the Patents and Designs Act, 1919, which read in part as follows:

38A.—(1) In the case of inventions relating to substances prepared or produced by chemical processes or intended for food or medicine, the specification shall not include claims for the substance itself, except when prepared or produced by the special methods or processes of manufacture described and claimed or by their obvious chemical equivalents:

The Canadian section 17 (1) was in identical terms except that in place of the word "or" before the word "intended" it had the word "and" so that it was more restricted in the scope of the substances to which it applied than the English section was.

There can, I think, be no doubt that the purpose of section 38 A.—(1) was to limit the scope and breadth of product claims in patents in the case of the substances covered by it so that such substances should not be patentable regardless of the process of their manufacture. Before its enactment, while there was no decision on the subject, there was grave doubt as to the validity of a claim for any product *per se* and the weight of opinion of text-book writers was against the validity of such claim: *Vide* 22 Halsbury's Laws of England, page 140, sec. 296: Terrell on Patents, 7th Edition, page 53. Yet, notwithstanding such doubt and opinion, claims were made and granted for substances independently of their process of manufacture. It appeared desirable to prevent such practice in certain cases and the section did so in the case of the substances to which it applied. No claims could validly be made for such substances *per se*.

Soon after its enactment the section was construed by the Solicitor-General, to whom appeals from decisions of

1946
 WINTHROP
 CHEMICAL
 COMPANY
 INC.
 v.
 COMMISS-
 SIONER
 OF PATENTS
 (No. 2)
 THORSON P.

1946

WINTHROP
CHEMICAL
COMPANY
INC.

v.

COMMISSIONER
OF PATENTS
(No. 2)

THORSON P.

the Patent Office lay, and the effect of the word "special" was settled. In *In re M's Application* (1) Sir Ernest Pollock, who was then Solicitor-General, said:

In my judgment the word "special" is introduced, in addition to the word "described", in order to connote that the particular method or process set out in the specification must contain the essentials of a valid patent . . . It must be a method, or process, which has such attributes that it is a proper subject of a claim for letters patent, one that has some intrinsic characteristics which are the invention of the inventor and for which a patent may properly and legitimately be claimed and granted.

He expressed a similar view in *In re Applications by W., K.-J., and W. Ld* (2) and also, after he had become Master of the Rolls, in *Sharp & Dohme Inc. v. Boots Pure Drug Company Ld.* (3). It was, therefore, settled that it was not possible to get a patent for a new substance under the section unless the process of its manufacture was also patentable.

But apparently it was felt that the section with this interpretation of the word "special" had gone too far, for when the Act was recast by the Patents and Designs Act, 1932, section 38 A.—(1) was amended in a number of respects; the word "special" was deleted, the word "particularly" inserted before the word "described" and the word "claimed" replaced by the word "ascertained". It was still the purpose of the section as amended to prevent in the case of the substances to which it applied the issue of patents for such substances *per se*, but it did not go so far as it had gone previously. It is now clear in England that a claim for a new substance is valid if restricted to the substance as produced by the process of manufacture defined in the claim as an integral part thereof, even if such process is not a patentable one, and that it is no longer necessary to the validity of the claim that the inventor of the new substance should also be able to claim the process of its manufacture.

The history of the Canadian legislation took a similar course. Just as section 17 (1) of The Patent Act, 1923, was taken from section 38 A.—(1) of The Trade Marks and Designs Acts, 1907 and 1919, so also when the Canadian Act was recast by The Patent Act, 1935, the same amendments were made to section 17 (1) as had been made to the

(1) (1922) 39 R.P.C. 261 at 262.

(3) (1928) 45 R.P.C. 153 at 175.

(2) (1922) 39 R.P.C. 263 at 268.

corresponding section 38 A.—(1) of the English Act in 1932, except that the word “claimed” remained unchanged.

If the effect of the 1935 amendment of the Canadian section is the same as that of the English one by the 1932 amendment, the appellant’s contention as to the construction of section 40 (1) is unanswerable. The Commissioner’s contention must, therefore, hang on the fact that no change was made in the word “claimed”. This brings me back to the question whether that word means “made the subject of a separate claim” and is capable only of such meaning. While the word may be capable of such a meaning, it is not, in my opinion, its only possible one or, indeed, its best one having regard to the context. The word can, I think, properly be used as meaning “defined in the claim” so as to be “made a constituent element of the claim”. It was in a somewhat similar sense that the word was used by Rinfret J., as he then was, in delivering the judgment of the Supreme Court of Canada in *Lightning Fastener Co. Ltd. v. Colonial Fastener Co. Ltd. et al* (1). There he was dealing with a claim for a slider comprising certain features and in referring to such features said that “all the features claimed herein were old”. It is quite common to speak of the integers of a claimed combination as having been claimed in combination. Similarly, if in a claim for a new substance under section 40 (1) the process of its manufacture is so defined in the claim that the claim is restricted to the substance as produced by such process, then the process, having been made an essential element of the claim, can properly be said to be claimed within the meaning of the section, and need not be made the subject of a separate claim. If such a meaning is taken of the word “claimed” then, of course, the appellant’s construction of the section must be accepted. There are, I think, a number of reasons why this should be done.

The Commissioner’s meaning completely disregards the amendment of 1935 by which the word “special” was deleted from the section. It was the presence of this word in the corresponding English section that led to the decisions that there could not be a valid patent for a substance under the section even if new unless the process of its manufacture was patentable. And it is clear that the deletion of the

1946
 WINTHROP
 CHEMICAL
 COMPANY
 INC.
 v.
 COMMISSIONER
 OF PATENTS
 (No. 2)
 THORSON P.

1946
 WINTHROP
 CHEMICAL
 COMPANY
 INC.
 v.
 COMMISSIONER
 OF PATENTS
 (No. 2)
 THORSON P.

word "special" by the amendment of 1932 was for the very purpose of getting away from the construction which its use had called for. I see no reason for taking a different view of the effect of the deletion of the word from the Canadian section. Moreover, there is no reference in the decisions to the use of the word "claimed" and nothing to indicate that its presence in the section had anything to do with them. And if such word is reasonably capable of the meaning urged on behalf of the appellant, then nothing turns on its retention in the Canadian Act or the substitution in the English one of the word "ascertained", particularly since that word is used in several sections of the English Act which is not the case in the Canadian one.

It was always the purpose of the section to prevent the inventor of a new substance under it from obtaining a patent for such substance *per se* so that he would not have a monopoly of it regardless of the process of its manufacture and thus be able to claim it even when produced by a process quite different from the one which he had used. Such purpose would be served just as fully by restricting the claim to the substance as produced by the process defined in the claim as by requiring that the process should be patentable before allowing a claim for the substance. Both methods would equally suppress the mischief for which the previous law did not provide. Then when Parliament deleted the word "special" from the section, it dropped the requirement that a patentable process was a condition precedent to the validity of a claim for a new substance. In my view, the appellant's construction is more consistent with the history and present purpose of the section than is that of the Commissioner.

Moreover its adoption will lead to a more reasonable and equitable result. It is anomalous to say to the inventor of a new substance under the section, as the Commissioner does, that he is not entitled to a patent for what he has invented because he has not also invented something else, and a construction leading to such a result depriving an inventor of the fruits of his inventive genius ought not to be adopted unless the language of the section clearly so demands. As I see it, there is nothing in the purpose, history or language of the section that makes such a

construction necessary. On the other hand, the appellant's construction gives the inventor the benefit of his invention, namely, the new substance as produced by the process defined in his claim.

For these reasons I think that the remedy contemplated by the section as it now stands would be fully advanced if the appellant's construction of it is adopted. In my opinion, section 40 (1) is complied with if in a claim for a substance to which it applies the process of its manufacture is described in the disclosure of the specification and so defined in the claim as to be made an essential element thereof so that the claim is restricted to the substance as produced by the process so defined, even if such process is not a patentable one. There is no need for a separate claim for the process.

In coming to this conclusion I have not overlooked the decision of this Court in *Winthrop Chemical Co. Inc. v. Commissioner of Patents* (1). In that case there was no definition of the process of manufacture in the claim, as there was in the present case, but merely after the definition of the substance a reference to the process in the following terms, "when produced by the processes of manufacture particularly described or by their obvious chemical equivalents", and it was held by Angers J. that this was not a compliance with the requirements of the section. The question now under consideration was not before the Court in that case at all and any observations in the reasons for judgment relating to it must be regarded as *obiter*.

In my opinion, for the reasons given, the Commissioner should not have rejected the claims on the ground taken by him and the appeal from his decision must be allowed so that if the claims are otherwise unobjectionable they may be granted. The allowance of the appeal will be without costs.

Judgment accordingly.

1946
 WINTHROP
 CHEMICAL
 COMPANY
 INC.
 v.
 COMMISS-
 SIONER
 OF PATENTS
 (No. 2)
 THORSON P.

(1) (1937) Ex. C.R. 137.