

In the Matter of the Appeal of
WILLIAM LEONARD from a decision of the Commissioner of Patents refusing an application for a patent of invention.

1913
Oct. 7

Patent of invention—Feeds for Grain, Ore and Mineral Separators—Appeal from decision of Commissioner under 3-4 Geo. V. c. 17—Grounds for refusal to grant patent.

More than two years before the application for the patent in question on the appeal, the applicant had obtained Canadian letters-patent No. 110,156 for feeds for grain, ore and mineral separators. The specification of the former patent after declaring that the old method of separating materials such as gold and ore, cereals and seeds, by delivering them into a vertical spout from a connecting inclined spout and forcing a current of air upward through the vertical spout, was ineffective, disclosed the nature of his invention as follows:—

“I have found that by delivering the materials in a horizontal plane or directly across the vertical spout and therefore at right angles to the ascending air current, they are spread out in a thinner sheet so that the air current acts thereon more effectively, or in other words forces upward and separates the lighter material from the heavier in a more perfect manner than is practicable when the materials are discharged in a downward direction.”

The substance of the invention claimed in the former patent was the delivering of the materials in a horizontal plane, or directly across the vertical spout, and therefore at right angles to the ascending current of air.

Held, (affirming the decision of the Commissioner) that by the specification to his former patent the applicant had disclosed the invention now claimed and the same must be taken to have been abandoned and dedicated to the public.

2. A former patent, while in force, operates as a bar to the application for a new patent, and the only remedy open to the applicant, if he is in a position to invoke it, is to apply for a reissue of the former patent.

Barnett-McQueen Co. v. Canadian Stewart Co. (13 Ex. C. R. 186) distinguished.

Observations on desirability of Commissioner being represented by counsel on appeals from his decisions refusing to grant patents.

APPEAL from a decision of the Commissioner of Patents refusing to grant a patent of invention.

The grounds of the appeal are stated in the reasons for judgment.

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Argument
of Counsel.

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The appeal now came on for hearing before the Honourable Mr. Justice Cassels at Ottawa.

R. S. Smart appeared for the appellant.

No one appeared for the Commissioner of Patents.

Mr. Smart submitted the following argument:—The patent is an apparatus for separating grain, comprising a blower to create an upward current, and an inclined chute down which the grain slides. The idea is to separate the seeds of the grain, in order to obtain the best grain for seeding purposes. For instance if the grain are all the same size, it will separate the heavier from the lighter; or if they were all of the same weight it will separate the larger from the smaller. The grain slides down this inclined chute, and is turned into a horizontal sheet by a current of air which is blowing—the density of the air being such that certain of the grains will fall down, and the others will be blown out. If they vary in size, the separation will be affected on account of the greater surface exposed to the blast.

The decision of the Deputy-Commissioner of Patents is in these words: “The patent is refused inasmuch as in the apparatus patented, which was granted more than two years before the date of the present application, the applicant disclosed the invention now claimed without any reservation. I am of the opinion that the invention now claimed must be considered to have been at the date of the present application abandoned and dedicated to the public, and that, consequently, the present application cannot be allowed.”

[THE COURT.—What is the meaning of the limitation of two years you mentioned—what is its bearing?

My position is that it has nothing to do with this case. There is no such limitation in *The Patent Act*.

[THE COURT.—Why not obtain a reissue, assuming it to be patentable?]

The reissue would not be for the same invention. One is an invention of an apparatus, and the other is an invention of a process. There must be some intention shown in the original patent to claim the invention, before you can claim it on a reissue. I think there might be two different positions. You might have two inventions but entirely disconnected, and in order to show the operation of one you would have to disclose both in the one patent. Our position is, if you did disclose both, and only claimed one, and made no statement with regard to the other, that you might come at a later date and obtain the other; but you could not patent the other on a reissue.

But we are not precluded from obtaining a new patent by anything that is disclosed in the specification to the former patent. Description of a process in an application for a machine patent does not constitute an abandonment or dedication to the public of such process so as to stop the inventor from obtaining a patent for the process. *Eastern Paper Bag Co. v. Standard Paper Bag Co.* (1); *Eastern Paper Bag Co. v. Nixon* (2); *Victor Talking Machine Co. v. American Gramophone Co.* (3).

Our law is different from the English law as well as the American law. In England publication of an application at once dedicates the invention to the public. In the United States publication for a period of over two years dedicates the invention to the public. Under section 7 of our Patent Act there is no ex-

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(1) 30 Fed. Rep. 63.

(2) 35 Fed. Rep. 752.

(3) 145 Fed. Rep. 350.

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clusion of inventions by reason of publication in a prior application; and section 7 (d) does not refer to that sort of publication. *Anderson Tire Co. v. American Dunlop Tire Co.* (1).

The difficulty as to obtaining a reissue is that it must be for the same invention as the original patent. *Auer Incandescent Light Mfg. Co. v. O'Brien* (2); *Parker & Whipple Co. v. Yale Clock Co.* (3); *Withrow v. Malcom* (4).

It has been decided in this Court that a former patentee has the same right as a stranger would have to obtain a patent for a particular means of doing something which is the subject of a general claim in the former patent. *Barnett-McQueen Co. v. Canadian Stewart Co.* (5); *Lombard v. Alexander* (6).

CASSELS, J., now (October 11th, 1913) delivered judgment.

This is an appeal from a decision of the Commissioner of Patents refusing to grant an application for a patent.

Chapter 69, Revised Statutes of Canada, 1906, section 19, reads as follows:

“ Every applicant who has failed to obtain a patent
 “ by reason of the objection of the Commissioner, as
 “ aforesaid, may, at any time within six months after
 “ notice thereof has been mailed, addressed to him or
 “ his agent, appeal from the decision of the Com-
 “ missioner to the Governor in Council.”

Chapter 17, 3 & 4, Geo. 5th, assented to the 16th May, 1913, amended the Exchequer Court Act, as follows:

“ 23A. Every applicant for a patent under the
 “ Patent Act who has failed to obtain a patent by

(1) 5 Ex. C. R. 82.
 (2) 5 Ex. C. R. 243.
 (3) 123 U. S. 87.

(4) 6 O. R. 22.
 (5) 13 Ex. C. R. 186.
 (6) 8 E. L. R. 261.

“ reason of the objection of the Commissioner of
 “ Patents as in the said Act provided may, at
 “ any time within six months after notice thereof has
 “ been mailed, by registered letter, addressed to him
 “ or his agent, appeal from the decision of the said
 “ Commissioner to the Exchequer Court.

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“ 2. The Exchequer Court shall have exclusive
 “ jurisdiction to hear and determine any such appeal.

“ 3. The Exchequer Court shall have exclusive
 “ jurisdiction to hear and determine any now pending
 “ appeals to the Governor in Council under section
 “ 19 of the Patent Act, and the Governor in Council
 “ shall transfer the said appeals and all documents
 “ and proceedings relating thereto to the Exchequer
 “ Court.”

Previous to the passing of the last mentioned Act, the applicant for the patent, William Leonard, had appealed to the Governor in Council pursuant to the provisions of the Patent Act hereinbefore quoted.

The decision of the Commissioner of Patents was given on December 12th, 1911, and the appeal was filed on January 29th, 1912, and was pending before the Governor in Council at the time the statute extending the provisions of the Exchequer Court Act hereinbefore quoted was passed.

Shortly after the enactment of this statute orders of Court were made providing for a summary appeal to the Exchequer Court, and the papers in connection with the application were duly forwarded to this Court. Thereupon the notice of the appeal and that the same would be argued on the day named in the notice, was duly served upon the Commissioner.

Nobody representing the Commissioner appeared before me on the appeal; and I understand it to have been stated that it was not the intention of the

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Department to be represented on any appeals under this statute.

It seems to me that it is throwing too much responsibility on the Court, and that the better practice would be that the Commissioner should be represented in order to aid and assist the Judge who hears the appeal.

Counsel for an appellant, as a rule, will not be very apt to put forward the opposite view of the case to that which he is retained to argue on behalf of his client.

Since the argument I have gone carefully through the papers, and am of the opinion for the reasons that I am about to give, that the Commissioner was right in refusing a patent to the applicant.

Upon the 11th day of February, 1908, the applicant William Leonard, obtained a patent for an alleged new and useful improvement in feeds for grain, ore and mineral separators.

I wish it to be clearly understood that while on this application I assume this patent to be valid, I am in no way precluded, if the case were presented in litigation before the Court, from determining that the patent is invalid or valid, as the case may be. It is only for the purpose of this appeal that I accept it as a valid patent.

The claims of this patent are combination claims—a vertical air blast spout and an inclined grain spout connected with one side of the same, of the feed plate arranged wholly within the said grain spout etc.,

The only invention described in the patent is the delivering of the materials in a horizontal plane or directly across the vertical spout, and therefore at right angles to the ascending current.

Figure 3 to his patent, the patentee states in his specification, is a perspective view of the curved chute which particularly embodies his inventions. The object of this curved chute is in order that the material might be delivered in a horizontal plane or directly across the vertical spout and therefore at right angles to the ascending air current.

In his specification the patentee describes the manner in which this result is obtained.

The specification states as follows:—

“ Heretofore, gold and ore, cereals, seeds and various other materials requiring to be separated, have been delivered into a vertical spout from a connecting inclined spout whereby the materials acquired a considerable momentum in a downward direction and the grains or particles composing such materials were held to a certain degree in close contact and in consequence the current of air forced upward through the vertical spout or chamber failed to act on the materials in the most effective manner. I have found that by delivering the materials in a horizontal plane or directly across the vertical spout and therefore at right angles to the ascending air current, they are spread out in a thinner sheet so that the air current acts thereon more effectively, or in other words forces upwards and separates the lighter materials from the heavier in a more perfect manner than is practicable when the materials are discharged in a downward direction.”

This specification shows on its face the complete invention which the patentee was claiming. It also shows the whole process. It admits the state of the art from which there would be nothing new in the patentee's invention, except the delivery of the material in a horizontal plane. With this specification

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the patentee obtained his patent, dated as I have mentioned, on the 11th February, 1908. More than two years from the issue of his patent, namely upon the 18th May, 1910, the application was filed for the patent in question.

By the patent which was refused by the Commissioner, the patentee is seeking to obtain a method or process patent which would cover any device or contrivance which had the effect of delivering the material in a horizontal plane, thereby very much widening the claims of the previous patent. The Commissioner refused the application, his reasons being as follows:

“ Inasmuch as in his apparatus patent, which was granted more than two years before the date of the present application, the applicant disclosed the invention now claimed without any reservation, I am of the opinion that the invention now claimed must be considered to have been at the date of the present application abandoned and dedicated to the public; and that, consequently, the present application cannot be allowed.”

I think this decision is correct. In the case of *The Barnett-McQueen Company, Limited, v. The Canadian Stewart Company, Limited* (1); I had occasion to point out the objects of the claim.

In patent cases the decisions are so numerous that it is useless to cite them. I would just refer to two, one a judgment of the late Lord Justice Jessel, M.R., in the case of *Hinks & Son v. Safety Lighting Co.*, (2); where the view of that celebrated Judge is set out, as follows:

“ I am anxious, as I believe every Judge is who knows anything of patent law, to support honest *bonâ*

(1) 13 Ex. C. R. 186 at p. 120.

(2) 4 Ch. Div. 612.

vide inventors who have actually invented something novel and useful, and to prevent their patents from being overturned on mere technical objections, or on mere cavillings with the language of their specification so as to deprive the inventor of the benefit of his invention. This is sometimes called a 'benevolent' mode of construction. Perhaps this is not the best term to use, but it may be described as construing a specification fairly, with a judicial anxiety to support a really useful invention if it can be supported on a reasonable construction of the patent. Beyond that the 'benevolent' mode of construction does not go. It never was intended to make use of ambiguous expressions with a view of protecting that which was not intended to be protected by the patentee, and which has not been claimed to be so protected by him whether or not it was an invention unknown to himself. It is for the patentee to tell the world that of which he claims a monopoly, to tell them, 'You may do everything but this; but this you must not do, this is my invention.'

"With the view of getting this into a narrow compass, it has long been the practice of patent agents to insert in specifications the distinct claim of what they say is comprised in the patent, meaning that nothing else is comprised, that everything else is thrown open to the public, or, to put it in other words, if a man has described in his specification a dozen new inventions of the most useful character, but has chosen to confine his claim to one, he has given to the public the other eleven, and he has no right to be protected as regards any one of the other eleven if he wishes to recall that gift which he has made by publishing the specification."

Then in the United States Supreme Court, the case

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of *Miller v. Brass Company* (1); is to the same effect. The head note is as follows;

“Where a specific device or combination is claimed, the non-claim of other devices or combinations apparent on the face of the specification is, in law, so far as the patentee is concerned, a dedication of them to the public and will be so enforced, unless he with all due diligence surrenders his patent for reissue, and proves that his omission to claim them arose wholly from inadvertance, accident or mistake.” (2).

I, therefore, am of the opinion, that so long as the patent of the 11th February, 1908, is in force, it is a bar to the applicant obtaining the patent sought for.

The applicant for the patent is not without redress. Section 24 of *The Patent Act*, relating to reissue of patents, provides a remedy, and if entitled to a reissue the applicant can bring himself within the provisions of this section. His proper remedy would be to apply for a reissue of the patent.

It is quite clear by a long series of decisions, that the words “by reason of insufficient description or specification” cover the claim in the patent as part of the specification.

It is also settled that the original patent may be perfectly good upon its face, but that nevertheless it may come within the terms of this provision and be held defective or inoperative by reason of insufficient description for specification, if it appears that the patentee had set out in the specification his invention but through mistake had not made a claim for it. Usually the invention granted by the original patent would not be broadened by the reissue, but in a clear case it would be, provided the applicant had brought himself within the provisions of the statute. The

(1) 104 U. S. 350.

(2) See also Frost on patents, 4 Ed. (1912) p. 336 for other authorities

patentee by taking his patent, has dedicated, as I have pointed out, what he has not claimed for the benefit of the public, and he must get rid of this dedication by means of a reissue patent.

Mr. Smart, in his argument, referred to my judgment in the case of *The Barnett-McQueen Co., Ltd. v. Canadian Stewart Co., Ltd.* (1), where I say, at page 209, that "I agree with Mr. Anglin's view that, having regard to the dates, the patentee has the same right as a stranger would have to apply for and obtain a patent for a particular means of support, provided always that there was invention and subject-matter." But I was dealing with that particular case as I have stated in my reasons for judgment, *having regard to the dates*. The application for the second patent was filed on the 6th April, 1908. The first patent was granted on the 14th April, 1908. So that in that particular case there had clearly been no dedication to the public. Moreover, the application in that case was to procure a purely construction claim. I do not think that the *Barnett-McQueen* case affects the case before me.

The American statute upon which the American decisions are based, is identical in language, or nearly so, with our own statute. There are a long series of cases in the Supreme Court of the United States dealing with this question.

I quote at length from the judgment of Blatchford, J., in the case of *Wilson v. Coon* (2); as follows:

"It is contended for the defendants that the reissue patent is void, because the original patent was valid and operative, and because it contains new matter and entirely changes the character of the invention set forth in the original patent, and

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(1) 13 Ex. C. R. 186.

(2) Vol. 19 Off. Gaz. U.S. at 482.

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“ because the reissue patent was intended to cover
“ a different collar from that originally invented.

“ This reissue was granted under section 4916 of the
“ Revised Statutes, which provides as follows:

‘ Whenever any patent is inoperative or invalid by reason of a defective or insufficient specification or by reason of the patentee claiming as his own invention or discovery more than he had a right to claim as new, if the error has arisen by inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, the Commissioner shall, on the surrender of such patent and the payment of the duty required by law, cause a new patent for the same invention, and in accordance with the corrected specification, to be issued The specification and claim in every such case shall be subject to revision and restriction in the same manner as original applications are. Every patent so reissued together with the corrected specification, shall have the same effect and operation in law, on the trial of all actions for causes thereafter arising, as if the same had been originally filed in such corrected form; but no new matter shall be introduced into the specification, nor in case of a machine patent shall the model or drawings be amended, except each by the other; but when there is neither model nor drawing, amendments may be made upon proof satisfactory to the Commissioner that such new matter or amendment was a part of the original invention, and was omitted from the specification by inadvertence, accident, or mistake, as aforesaid.’

“ This enactment is the same as section 53 of the Act of July 8, 1870, (16 U. S. Stats. at Large, 205). The word ‘ specification’, when used separately from the word ‘ claims ’ in section 4916, means the entire paper

referred to in section 4888—namely, the written description of the invention ‘ and of the manner and process of making, constructing, compounding, and using it,’ and the claims made. The word ‘specification,’ meaning description and claims, is used in that sense in sections 4884, 4895, 4902, 4903, 4917, 4920 and 4922. In some cases, as in sections 4888 and 4916, the words ‘ specification and claim ’ are used, and in section 4902 the word ‘ description ’ and the word ‘ specification ’ are used; but it is clear that the word ‘ specification,’ when used without the word ‘ claim ’ means description and claim. Therefore a reissue is allowed under section 4916, when the specification is defective or insufficient, in regard to either the description or the claim, or to both, to such an extent as to render the patent inoperative or invalid, if the error arose in the manner mentioned in the statute. In such case there may be a corrected specification—that is, one corrected in respect to description or claim, or both, and there may be a new patent in accordance therewith; but the new patent must be for the same invention. This does not mean that the claim in the reissue must be the same as the claim in the original. A patentee may, in the description and claim in his original patent, erroneously set forth as his idea of his invention something far short of his real invention, yet his real invention may be fully described and shown in the drawings and model. Such a case is a proper one for a reissue. A patent may be inoperative from a defective or insufficient description, because it fails to claim as much as was really invented, and yet the claim may be a valid claim, sustainable in law, and there may be a description valid and sufficient to support such claim. In one sense such patent is operative and is not inoperative,

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yet it is inoperative to extend or to claim the real invention, and the description may be defective or insufficient to support a claim to the real invention, although the drawings and model show the things in respect to which the defect or insufficiency of description exists, and show enough to warrant a new claim to the real invention."

I do not wish to be understood that I am in any way deciding that the applicant is entitled to a reissue, nor do I wish it to be considered that I am holding that he is not so entitled. That is a matter that rests entirely with the Commissioner at the present time.

The appeal is dismissed. As nobody appeared for the respondent, it is dismissed without costs.

Order accordingly.

Solicitors for the appellant: *Fetherstonhaugh & Smart.*
