

THE AUER INCANDESCENT LIGHT
 MANUFACTURING COMPANY } PLAINTIFFS;
 (LIMITED)

1897
 Jan. 11.

AND

WILLIAM P. O'BRIEN.....DEFENDANT.

*Patent of invention—Illuminant device—Infringement—Process—Reissue
 —Equivalents—Manufacture—Importation—Price.*

An inventor, in the specification to his first Canadian patent, after disclaiming all other illuminant appliances, for burners, claimed :
 “An illuminant appliance for gas and other burners consisting of a cap or hood made of fabric impregnated with the substances hereinbefore mentioned and treated as herein described.” In the specification the substances and the proportions in which they might be combined were stated. Eight years afterwards the owner of the original patent surrendered the same and obtained a reissue, the specification whereof differed from that of the original only in respect of the claim, which was as follows :—
 “The method herein described of making incandescent devices, which consists in impregnating a filament, thread or fabric of combustible material with a solution of metallic salts of refractory earths suitable when oxidized for an incandescent, and then exposing the impregnated filament, thread or fabric to heat until the combustible matter is consumed.”

Held, that although in the claim of the reissue there were no words of reference or limitation to the refractory earths mentioned in the specification, yet the words “salts of refractory earths” occurring in the claim must be limited or restricted to such refractory earths as were mentioned in the preceding part of the specification, or to their equivalents.

2. That the reissue was for the same invention as that which was the subject of the earlier patent.
3. The reissue being for the same invention as the original patent, delay in making the application for the reissue did not invalidate the same.
4. That the Act 55-56 Vict. c. 77, passed for the relief of Von Welsbach and Williams, the original patentees, was effective although at the time it was passed others than they were interested in the patent.

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5. To give the Commissioner jurisdiction to authorize the reissue of a patent it is not necessary that the patent be defective or inoperative for some one of the reasons specified in sec. 23 of *The Patent Act*. It is sufficient to support his jurisdiction that he deems the patent defective or inoperative for any such reasons, and his decision as to that is final and conclusive.
6. That it was open to the owners of the patent to import the impregnating fluid or solution mentioned in the specification of their patent, without violating the provisions of the law as to manufacture.
7. That although the plaintiffs had at the outset put an unreasonable price upon their invention, yet as it was not shown that during such time any one desiring to obtain it had been refused it at a lower and reasonable price, the plaintiffs had not violated the provisions of the law as to the sale of their invention in Canada.
8. That it is not open to anyone in Canada to import for use or sale illuminant appliances made in a foreign country in accordance with the process protected by the plaintiffs' patent.

ACTION to restrain the infringement of a patent of invention.

The facts of the case are stated in the reasons for judgment.

The case was heard before the Judge of the Exchequer Court, at Montreal, on the 19th, 20th and 21st days of November, 1896.

C. A. Duclos for the plaintiffs :

The first inquiry that I will take up is, what was the invention, from a scientific standpoint, of Dr. Carl Auer von Welsbach? Dr. Auer von Welsbach discovered a law of nature, hitherto not only unknown, but which, according to the scientists we have heard in the box, would at that date have been almost declared non-existent. But it was not sufficient for Dr. Auer von Welsbach to discover a law of nature, for that he could not patent. The important discovery that he made, and which bore practical fruit, and

which he could patent, was the application of this wonderful new law of nature to a practical result. That it was a practical result, and a useful result and a commercial and valuable result, has not been called in question by the defence in their evidence; but it has been superabundantly proved by the plaintiff in this case.

The next inquiry we have is this, did the patentee set forth his discovery or invention correctly? When we come to the question of the patent, the word "invention" probably is the more proper term. Did the patentee set forth correctly his invention? First, did he do so in the original Canadian patent? I think it is only necessary to read the patent to see that he clearly, fully and exactly set forth what he could patent. That is to say, a practical mode, method or process of carrying out his scientific discovery; and giving, at the same time, an example of carrying out this particular process.

I would call the court's attention especially to the following matters in construing this patent. The inventor first states: "My invention relates to the manufacture of an illuminant appliance;" indicating thereby a method of producing an illuminant. Then he sets forth the formula of a particular impregnating solution. The terms used show the office that these earths were to fill. "For applying the substances mentioned as an illuminant I use a fine fabric, preferably of cotton, previously cleansed by washing with hydrochloric acid," etc. There is no doubt that there he has fully set forth a method of carrying out his discovery; and I submit that it agrees with what the experts have said was the discovery.

A second inquiry might be at this point, whether this is also sufficiently set forth in the claim in the re-issued patent. Of that there can be no doubt. The

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descriptive part of the reissued patent is absolutely the same; therefore, we say that Dr. Von Welsbach's invention was fully set forth in both patents.

The next inquiry is, did the patentee cover the whole of his invention by his claim; and now I am referring to the original patent, No. 23523.

I submit, that in the construction of a patent, as in the construction of any other contract, the court will not presume a dedication or a gift or a gratuity, if intention or intendment has anything to do with it. I think that the court would be justified, where an inventor has made a valuable discovery and has clearly set it forth, in construing the language of his claim to fully protect that invention. The court will give it such a construction, more especially if, as has been shown in this case, the invention is a primary invention, not a secondary one, or merely an improvement on a previously known substance or machine, but one striking out in an entirely new path.

Bearing in mind this canon of construction, I come to the claim of the original patent. Before I deal at length with the claim, I would simply refer, in a few words, to the disclaimer; because some mention has been made as to the effect of that disclaimer. I submit the disclaimer is nothing more than an acknowledgment of what the law would silently do of itself. It gives him no more than he claims. He disclaims what he has not claimed. That is all there is in it. It is tantamount to saying: "I hereby disclaim anything that is not included in my claim." So we are thrown back to a construction of the claim.

What is the claim in the original specification? An illuminant appliance for gas and other burners, consisting of a hood made of fabric impregnated with the substances mentioned and treated as described. This claim may be construed in two ways. Taking

first, what I might perhaps say is the least favourable construction, that it was merely for an illuminant appliance. I submit that even if the claim were for an illuminant appliance, if that illuminant appliance is claimed as having been made in a particular method specified in the descriptive part of the patent, that method is thereby made as much a part of the claim as the illuminant or product itself. [Cites *Smith v. The Goodyear Vulcanite Company* (1); *Merrill v. Yeomans* (2).]

The same doctrine is also treated at length in the *Telephone Cases*, which take up the whole of volume 126 of the United States Reports.

The claim is for a product, being the result of a particular process described in the specification. But there is another construction that may be placed upon this patent, and it is this, that it is a double claim; it is both for the product and the process. The words "treated as hereinbefore described" undoubtedly claim the process thereinbefore described.

As to this point I rely upon the English case arising upon this patent. The English patent, so far as the descriptive part of the specification is concerned, is almost word for word identical with the Canadian patent. As to the claim, there is merely a slight difference of words, such a difference only as would occur if two minds were trying to state the same thing. In effect and in substance the claims are identical, and there can be no question that His Lordship Mr. Justice Wills and the Court of Appeal, in England, in construing this very patent, construed it as a process patent. The only difference is that in the English patent the claim starts out thus: "the manufacture of an illuminant appliance," and we say: "an illuminant appliance" treated in such a way. In other words, it is the manufacture of an illuminant appliance; the process of manufacturing this particular product.

(1) 93 U. S. R. 486.

(2) 94 U. S. R. 568.

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As to the validity of the reissued patent, I think the position is this, that the action of the Commissioner is conclusive, unless it were evident, from a mere comparison of the two documents, that there was such repugnancy that it must be construed or decided as a matter of law that the Commissioner exceeded his jurisdiction, and that it was not for the same invention. It cannot be maintained for one moment that we fall within that category. That is the limit, I think, of the proposition; that it must appear as a matter of law from the comparison or examination of the two documents, that there was an excess of jurisdiction. In that case it is clear that they would not be for the same invention. We lay much stress upon the claim of the original, because the two specifications themselves are identical; there is no difference in the invention described in either the original or the reissued patent. I submit to the court that the claim of the reissue is nothing more than the statement in express terms of what the law would construe the claim of the original to have been. In other words, that the claim of the original being for a process and the invention being of the character of the one described, namely, a primary invention, the patentee would be entitled to the fullest benefit of the doctrine of equivalents as known in the patent law.

To look at the results. I submit that the greatest reproach, if any reproach is applicable to the reissue, is this, that it is useless. That is the greatest reproach, that the claim of the reissue is co-extensive with the original and unnecessary. I do not know that we should suffer for having gone to needless expense; and on that point, of course, the doctrine is that the action of the Commissioner is conclusive. [Cites *Allan v. Brunt* (1); *Curtiss' Law of Patents* (2); *Simpson v.*

(1) 3 Story, 742.

(2) P. 623, section 471 A.

The West Chester Rail. Co. (1); *Woodworth v. Stone* (2); *Jordan v. Dobson* (3); *The Rubber Company v. Goodyear* (4).]

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The decision of the Commissioner would also appear to be conclusive as to the identity of the invention, unless there is such repugnancy between the old and new patents, that it must be held to be a matter of legal construction.

We submit that, having claimed an appliance made in a specific way, which way was referred to and set out in the descriptive part of the specification, that process became thereby as much a part of the claim as the product and would be considered as a process patent; therefore, that the claim of such original and re-issue are co-extensive and for the same thing.

Then applying the doctrine of equivalents, I will confine myself first to the original claim. I cannot put it in a briefer form than I find the statement of the doctrine laid down in a little manual called *Hall's Infringement Outline* (5), which seems to me to be a *résumé* of the whole doctrine on this point.

In a few words, the doctrine is that equivalents unknown at the time of the original invention, and subsequently invented and made the subject of an invention, might be an infringement of such original invention.

I do not think that in this case we require the full benefit of that doctrine, because from the evidence it is clear that these equivalents were known at the time, most probably known to Dr. Auer himself, and in the mind of a chemist, if not to the lay mind, suggested by the patent itself.

[He cites *Knights' Patent Manual* (6); *Tilman v. Proctor* (7); *The National Type Company v. The New*

(1) 4 How. 380.

(4) 9 Wall. 788.

(2) 3 Story, 749.

(5) P. 13.

(3) 2 Abbott's U.S.R. 398.

(6) Page 93.

(7) 102 U. S. R. 728.

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York Type Company (1); *The McCormick Harvesting Machine Company v. Altman* (2).]

The doctrine of equivalents, which in some of the cases I have cited was applied to machines, is more especially applicable, as in the case of *Tilman v. Proctor*, to process patents.

Dealing now with the facts of the case in hand, the evidence has made it conclusive that the solution, used by the defendant, of thorinum and cerium is the equivalent of the solution or compound mentioned in the Canadian patents, equivalent in its physical properties and equivalent in the office which it performs with respect to this particular process, equivalent in the fullest sense. Then we find an illustration in the same patent, namely, the substitution of the asbestos thread for the platinum wire. In one sense platinum and asbestos cannot be said to be equivalent, that is in the limited sense, or I might say, almost theoretical definition of an expert witness of the defendant who gave us the Latin definition of equivalent; but in the sense of the patent law, the substitution of asbestos thread for the platinum wire is an equivalent, because it performs the same office and is relied upon for the same physical qualities. [Cites *Morley Machine Company v. Lancaster* (3).]

As to the question of manufacture, I would refer to a case decided in the Court of Appeal of Douai, France, upon this very patent. The French Patent Act of 1844 on this question of manufacture is more strict than our own. [Cites *Malapert*; "Lois sur les Brevets d'invention" (4).]

The particular application of the French case (5) to the case in point is this:—"L'exploitation du brevet

(1) 56 U. S. Of. Gaz. p. 661.

(2) 73 U. S. Of. Gaz. p. 1999.

(3) 129 U. S. R. 273.

(4) At p. 54.

(5) *Le Droit*, Jour. des Trib. No. 148, June 25, 1896.

commence seulement au moment de l'imprégnation du tissu, laquelle se fait en France." They hold that the manufacture of the patented invention begins at the moment of impregnation, and that being done in France, the whole manufacture was there; and that case also deals with the question of importation. There it is specially held that this fluid is a raw material *quoad* the patent.

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J. E. Martin for the defendant: The plaintiffs in this case rely somewhat upon the interpretation that the English courts have put upon the English patent which has been put in. I think it but fair, perhaps, at the opening, to point out one or two distinctions which appear to me to be material between that patent, as it was taken out, and their first Canadian patent, of which the one in question is the reissue.

In the British patent No. 15286, which has been put in as an exhibit, there is no disclaimer, while in the Canadian patent, which was the basis of the present reissue, there was a special disclaimer in these terms:

"I hereby disclaim all illuminant appliances for burners, except that included in the following claiming clause."

There is that distinction which must be borne in mind, and there is an additional distinction in the wording of the claim. The claim in the British patent is for the manufacture, substantially as therein described, of an illuminant appliance for gas and other burners consisting of a cap or hood made of a fabric impregnated with the substance mentioned, and treated as set forth. What is claimed in the Canadian patent was not the manufacture "substantially as herein described." These words are left out; but after disclaiming everything the patentee says: "I claim an illuminant appliance." I point out these distinctions which appear to me to be material when

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reading or considering the remarks of the learned judges who decided the case in England, and if the original Canadian patent were identical in terms with the British patent, which has been a subject of litigation there, I do not think I would have very much to say, and probably could not impress the court very much with whatever I might say, respecting the question of the invalidity of the patent that has been passed upon by English courts. But I do say that there are these two very material distinctions: that in the British patent there was no disclaimer; and, in the British patent there was the claim of the manufacture in express terms: "I claim the manufacture substantially as hereinbefore described of the appliance." While in the Canadian patent, what appears to have been the thing that was covered by the patent, the thing which the patentee had in his mind, was the "illuminant appliance."

I submit, bearing in mind these two very material distinctions, that the English and Canadian patents are not analogous.

There are one or two preliminary points as to the *locus standi* of the plaintiffs which I submit for consideration. The first is the question of the effect of the statute which is cited by the plaintiffs themselves in their statement of claim and invoked by them as giving them a standing before the court, or, in other words, as giving their patent a legal existence. The statute in question was passed on the 9th of July, 1892, or after a lapse of five years from the taking out of the Canadian patent. The payment on the patent was only made for that partial period of five years, the statute was passed in 1892 and purports to grant relief for the neglect in fulfilling the provisions of the law on the part of Carl Auer von Welsbach and Frederick de la Fontaine Williams.

The point I wish to make is that from the documents put in of record, the assignments, that neither Carl Auer von Welsbach nor Frederick de la Fontaine Williams, at that date, had any title or interest or right whatsoever in respect of that patent. The statute only granted relief to those two individual persons, and those two individual persons were in no need of asking for relief, and had no right to ask for relief, and the relief cannot avail to anyone who did not ask for it, and who was not granted it, who were not the owners of the patent at the time. It is evident from these documents that long previous to that date, in fact before the patent issued—the original inventor had parted with his interest in the patent; and it is in evidence that long before that statute passed, Frederick de la Fontaine Williams had parted with all his interest in the patent. The preamble of the Act throws some light upon that. They asked for relief because they say they were out of the country; and I assume from that that they plead ignorance of the law. But that same reasoning would not apply to the present company plaintiff, nor to the Welsbach Incandescent Light Company, who obtained the reissue. They were in the country and they are presumed to know the law. The Parliament of Canada would not have granted them any relief. Therefore, I submit that the statute is invalid in so far as granting relief, because the persons to whom it purported to grant relief had no interest in asking for it.

[BY THE COURT: This reissue was not made in pursuance of that statute in any way, was it?]

Not made in pursuance of the statute, but if the statute had not been passed, my lord, certainly the Commissioner of Patents would never have issued it.

The next objection which I make to the patent in question is, that the title of the reissue specification is

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illegal and misleading. The patentee in the specification of the original patent says: "My invention relates to the manufacture of illuminant appliances in the form of a cap or hood;" and he claims illuminant appliances consisting of a cap or hood. The title of what is termed the amended specification, which was in the application for the reissue but which was identical and word for word with the first specification, except as to the claim, is in the same words. He says that he has invented a certain new and useful appliance for gas and other burners, and it relates to the manufacture of an illuminant appliance in the form of a cap or hood. That is the title of the invention. Now the preamble and claim of the original specification are I submit, therefore, identical with the preamble of the reissue specification, and relate to an illuminant appliance; whilst the claim of the reissue specification relates solely to the method or process of making these incandescent devices. [Cites *Agnew's Law and Practice of Patents of Invention* (1); *Johnston's Epitome of Patent Law and Practice* (2).] If in what they term their amended specification, they amended the preamble or title of the specification in so far that it would give a true idea of what they claimed, namely, the method in the reissue, then it would not be open to this fatal objection. I submit that it is open to that objection, and that under those authorities it is bad. [He cites *Cochrane v. Smithhurst* (3).]

The question was raised by my learned friend as to the scope of the power of the Commissioner of Patents in respect of granting a reissue, and as to whether the court can inquire into his acts, as regards that reissue, as to whether he has acted within the statute in granting it. In other words, is the decision of the Commissioner final in respect to granting the reissue?

(1) P. 143.

(2) P. 21.

(3) 1 Abb. Pr. C. 228.

As to this point I cite *Ridout on Patents* (1) where a number of American cases are collected; and I cite particularly a case of *Giant Powder Company v. The California Powder Company* (2). The ruling in that case, as well as the remarks of Chief Justice Field, seem to me to be directly in point with this case. The language in that case is applicable here, because we come back to the question of the application for the reissue. There is no mistake, no error, and no inadvertence, I submit, disclosed by the amended specification. The only thing which was done at all, if anything, was to alter the patent from an appliance to a process. They claimed in their original patent an appliance, and they say that the words "treated as hereinbefore mentioned" cover all this delicate process which was the gist and the substance of the invention. I submit that the words "treated as hereinbefore mentioned" do not cover the process, but that they cover the treatment of the cap or hood after it was manufactured. After it was manufactured into an illuminant appliance it had to be subjected to a certain treatment mentioned in the patent. The claim of the patent is clearly in respect of the article, to the illuminant appliance; and, after it is made into an illuminant appliance in the shape of a cap or hood, it is subjected to certain treatment mentioned in the body of the specification.

The reissue must be for the same invention. I do not think that that principle can be controverted. [Cites *Ridout on Patents* (3).]

It was decided in *Wicks v. Stephens* (4) that neither inadvertence, accident or mistake had caused the omission, and that the reissued patent could not be sustained.

I cite the case of *Powder Company v. Powder Works* (5). A patent for a process cannot, after a con-

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(1) P. 184.

(2) 4 Fed. Rep. 720.

(3) Pp. 183, 184 and 185, and

cases cited.

(4) 3 Bann. & A. 318.

(5) 98 U. S. 126.

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siderable lapse of time, be reissued as a patent for a product. If we take the converse of that rule, and apply it in the present case, it seems to me we are justified in saying that a patent for a product cannot, after a considerable lapse of time, be reissued for a process. The claim of the reissue being, as is manifest on reading it, solely for the method, I submit that that is an entirely different subject-matter from the claim of the original patent. That it is, in other words, for a different invention; and, that it is not authorized by section 23 of *The Patent Act*, which requires that the reissued patent shall be for the same invention.

I submit, further, that having disclaimed in the original patent all illuminant appliances except the particular appliance which he described in that patent, it was not open to him eight years afterwards to have patented a method which would embody all the elements disclaimed formerly.

By the surrender of the original patent he has abandoned all claim to the appliance, and he has no longer any protection in respect of that. His reissued patent comes back to the question of the method generally of making these illuminant appliances, irrespective of the form or the materials, composing the appliance. I speak of the incandescent materials.

It seems to me in reading the claim of the reissued patent, that in so far as it is a process, and that I think must be conceded, there is no doubt that the reissue expands the original patent, or expands whatever could be, by any possible construction, deemed to have been included in the original patent as a process. It expands the claim of the original patent in so far as the form of the appliance that is made is concerned. In the first patent the patentee says, "I make an illuminant appliance in the form of a cap or hood;" in the reissue he says, "I want to make an incandescent

device, consisting of a filament, thread or fabric, no matter what shape, no matter what form, any kind of a filament, thread or fabric; I am going to make and adapt this process to it." There is an expansion of the original claim here, and an expansion after a special disclaimer is put in. I do not think that the doctrine of equivalents, in so far as creating the incandescent fluid with which to impregnate this mantle, has really very much application in this case. I submit that on the question of the doctrine of equivalents, it would be only equivalents known at the time of the invention. [Cites *Heath v. Unwin* (1).]

That would apply if the original patent were still in force, and if they still had a patent on the appliance; but, I submit that by the reissue they have surrendered all claim to the appliance, and they have restricted themselves solely and wholly to the method. What we must look at is the pith and marrow, the material substance of this patent. The substance of this patent was finding that you could take certain fluids and impregnate the fabric in the manner indicated. Dr. Carl Auer von Welsbach himself does not appear to have thought at the time he took out the first set of patents that thorinum was a substance that would answer the purpose; but he says in his patents which are produced afterwards, that continuing his researches he found that another substance may be substituted for one of those mentioned in the specification to make the illuminant, and such other substance is the oxide of thorinum, in combination with those that he had already mentioned.

The plaintiffs are occupying here a weaker position than they would have occupied if their original patent had subsisted. They have, by their surrender, surrendered their patent on the appliance. They have

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(1) 5 H. L. C. 505.

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surrendered the original patent, and they have abandoned with that surrender, the claim to the appliance itself; and, they restrict themselves altogether now to the method. And, I submit, that is not for the same invention. I cite on this point *Merrill v. Yeomans* (1), that has already been cited by my learned friend, but, I submit, it is really a case that bears in our favour. This is an authority to show that a claim must be definite and plain so that the public may know what is and what is not included under the patented invention. It is the public who should clearly know this, not an eminent chemist or an eminent expert that the public have to employ to interpret what is the patented invention. It is the ordinary individual, the public, who is entitled to know what is really the patented invention, and if a layman, if a man not versed in chemistry, were to take up the specifications of the original patent, I hardly think he would inquire, and I hardly think that even Dr. Welsbach himself imagined, that thorinum was a good substitute for making that mantle. [Cites *Miller v. Brass Co.* (2).] To claim a certain improvement, and to omit to claim other improvements, is in law a statement that an improvement which is not claimed, either is not the patented invention or is dedicated to the public.

Then, the patentee has also expanded and broadened the claim in the reissue by claiming the filament, thread or fabric of different form, and so on, while in the original claim he has restricted himself to an appliance in the form of a cap or hood. [Cites *Mahn v. Harwood* (3); *Flower v. Detroit* (4); *Electric Gas-light Company v. Boston Electric Light Company* (5); *James v. Campbell* (6).] A patent for a machine

(1) 94 U. S. R. 568.

(2) 104 U.S.R. 350.

(3) 112 U.S.R. 354.

(4) 127 U.S.R. 563.

(5) 139 U.S.R. 481.

(6) 104 U.S.. 356R.

could not be reissued for the process of operating that class of machine, because if the claim for the process is anything more than the use of the particular machine patented, it is for a different invention.

I submit that a consideration of these two claims is very material in determining what is covered by the Canadian original patent and by the reissue, because, while the American patent relates to the appliance, the same as the original Canadian patent, this patent which was taken out in the United States in 1890, but for which application was made as early as 1886, relates to the method, and the claim of this American patent for the appliance was made in 1886. The American patent is taken broadly from this patent, and included in the reissue of the Canadian patent.

In 1886, after Dr. Welsbach had patented the appliance in England, had patented the appliance in the United States, under patents almost similar to the first Canadian patent, he proceeds in the United States to patent the method, and this is the claim of such method patent: "the method herein described of making incandescent devices which consist in impregnating a filament, thread or fabric of combustible material, with a solution of metallic salts of refractory earths, suitable when oxidized for an incandescent," and so on. That is the claim, I think, with all the words alike, even to the function that is contained in the claim of the reissue Canadian patent, upon which the plaintiffs rely in this case.

I submit that it was not competent for the plaintiffs to apply for a reissue embodying that new invention, which had been patented in the United States for upwards of four years. [He cites *Béné v. Jeantet* (1).]

Another objection I make to the claim of the reissue is that it is ambiguous. It is in evidence here by the

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(1) 129 U. S. 633.

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experts that the salts of all refractory earths will not make an incandescent, and that it is only by resorting to experiments you can tell.

You have the example in the reissue. If in his claim the patentee attempts to put a blanket upon any discovery that may come after him, his claim is too broad, I submit. If he says, as it is said here, that you can take the metallic salts of refractory earths as generally suitable when oxidized for incandescent purposes, without indicating which are suitable, that leaves the subject-matter of the patent, and what is claimed by the patent, open only to be determined by resorting to experiments.

I come now to another point, which I will just touch on briefly. The plaintiffs say that their patent is a process patent. That is the one they are acting under. The English courts decided in effect that the English patent was a process patent, but I call the court's attention to certain of the remarks of the judges and of the learned counsel. Mr. Moulton for the respondent says:—"The patentee's method is to get a solution of the nitrates; the oxides do not dissolve." And, then, he goes on to say that the patentee gives three essentials of his process as forming the soluble nitrate. He argues that if this is to be treated as a process patent that the plaintiffs must practise the process which is the subject of the invention, they must practise it in all its essential elements; and, the evidence there went to show that they did not practise the process in respect of an essential element of forming the solution, viz., nitrate. These remarks run through the judgment too. In the English case, as will appear from the evidence quoted by the learned judges, and from their remarks, there is a process from start to finish. They take this specification of the patent, and they go through the process

and make the article in which this process results ; but here the plaintiffs in the present case did not do any such thing, and it is only such eminent men as Dr. Morton and Professor Chandler, and such men who are able, by experimenting in their laboratories, to make this solution, and to practise the process from the beginning to the end.

I say that the plaintiffs here, not making the fluid, not being able to make the fluid, do not practise the process in its entirety. If they were building a machine, or if they were doing anything which could be done under the patent, they would be required to do all that was required to make the patented invention.

On the question of the refusal to sell at a reasonable price, the evidence, I submit, makes out a case against the plaintiffs on this head. The cost of the article produced is established, by the witness Granger, at about thirty-four cents. He says that up to January, 1893, I think, (the transfers will establish that) they asked \$100 for this patented article. I think his evidence goes further and says that they did not find any purchasers at that price. I submit that this is very material in determining that such was not a reasonable price. The patent is forfeited, if any person desiring to use it cannot obtain it or have it caused to be made for him at a reasonable price. Can it be contended that for an article which only costs thirty-four cents complete, one hundred dollars is a reasonable price? The best evidence that it was a most unreasonable and arbitrary price is the fact that the very same article costing not one cent more to manufacture, is to-day selling for \$3.50.

[BY THE COURT: Is the cost of manufacture material?]

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Of course, in the *Telephone Cases* (1), it was decided there must not be a refusal to sell. I think the question of leasing came up there, and it was decided that an offer to lease was not a compliance with the provisions of *The Patent Act*. In fact, I believe that the refusal to sell telephones was always coupled with a statement that we do not sell them, but we lease them, and that was held insufficient. I think I am correct in saying that; and, here, I do not think that the mere leasing would fulfil the terms of the statute. They are bound to sell at a reasonable price, and the demanding of an unreasonable price like \$100 for this article is tantamount to a refusal to sell.

There is only one other point I will touch on briefly and that comes up with reference to one branch of the plaintiffs' case. The infringements complained of are with respect to importation and sale, and with respect to manufacture. Now, adopting the construction which the learned counsel for the plaintiffs put upon their reissued patent, and reading that by the light of their abandonment of whatever claim they had to the appliance under the original patent, it seems to me that the most they can contend for is that their reissued patent only relates to the process. In fact, I understood that to have been the position taken by my learned friend Mr. Hellmuth at the opening, and the position assumed by my learned friend Mr. Duclos, in summing up, that their reissue was solely for the process.

The point which I make is that if they have by their surrender of the original patent abandoned the claim to the appliance, that there can be no infringement against a party who imports and sells the manufactured article which is made in some other country. In other words, that the importation and sale of an

(1) 126 U. S. R. 1.

article, the article itself not being protected by the patent, is not the practising of a process, when the process and that alone is covered by the patent. That would be material only for one branch of the defence; because the plaintiffs charge infringement both as regards the manufacture and as regards the importation and sale, and ask for an injunction against us in respect to both; and if their patent can only be construed as a process patent, and I submit there can be no question about that, and it is all that anybody can contend for on their behalf, the process patent does not protect the article itself, and that if it is manufactured in some country where their patent does not reach, say in Russia or in India, where they have no patent at all, and is brought in here and sold, that they have no legal machinery by which they can protect themselves.

J. F. Hellmuth, in reply:—As to the refusal to sell. I do not know that it requires a very ample answer, for this reason: *The Patent Act* does not say that a person shall not put an unreasonable price, even if it were that, upon an article, but it says that the inventor or the holder of the patent, under the amendment which is practically the same as the original Act, (section 37 of the Act of 1892) must be in readiness to supply it to any person desiring to use it upon payment of a reasonable price. Why, the very first thing that must be done under that section in order to bring anybody under the penalties of the Act is to show some person who desired to use it; and then, show the refusal to sell to that person at a reasonable price. There has been no pretense whatever that there was any person who ever desired to use this in the sense of purchasing it and it was refused him, and they have put one person into the witness box, and that person has proved what? First, that he made an application to purchase, if at all, not a mantle, but he asked the

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plaintiffs to perform an operation which was no part of their manufacture, to fit a light upon a machine or gallery which he took to them and asked them to deal with. Supposing a haberdasher were obliged to sell gloves, and I go in there and say, put them on my hands, of course, he can say I will do nothing of the kind. Suppose a grocer is obliged to sell apples, I ask him to send them to my house, he says, I will not do anything of the kind. If this witness wanted, even at that date, to make a case, he might have shown that he had applied for the simple purchase of a mantle; the mantle covered by this patent, if anything is covered by it, and had been refused. So that I submit there is nothing whatever before the court here to show that there has been such a refusal.

The next point which I wish to take up is as to the effect of the statute of 1892, and upon that I have but very few words to say.

I ask the court to look at the preamble, because that statute shows that Dr. Carl Auer von Welsbach had disposed of part of his interest in this patent at the very time that he made the application to the Welsbach Incandescent Light Co., the father, so far as the chain of title goes, of the plaintiffs before you now. What concealment was there in this? Parliament were advised that he had parted with part of his interest, but he has still an interest, as I am advised. It may be as a stockholder or in some other way that he has an interest in this company, and furthermore, he did pay the fee to the Commissioner of Patents, and when the court looks at the patent it will be seen that it acknowledges the receipt from Dr. Carl Auer von Welsbach of that fee. The patent was renewed; but, if he had not been named, if this company had not been named, surely the Act is conclusive on that point, and you cannot go behind it. That receipt only

appears upon the original, and the certified copies. It is only the original patent. There is no question about this, the object and purport of the Act was to admit, as your Lordship has said, this patent to be kept alive practically in whatever hands it might come into, and to allow it to be extended, and not to work a forfeiture; but if it were not, what right has this defendant to complain? He was not a party or privileged in any way. He is not injured by whoever took out the patent, whether Dr. Welsbach or the company, and he cannot, I submit, be heard here to question the right of the company, or of anybody else, who has a proper chain of title from Dr. Carl Auer von Welsbach, to take out the extended term of the original patent.

Then, in addition, the Commissioner was the proper authority. He says, under the very Act, by his own receipt, "I have received this fee." Can any doctrine be invoked which would ask a court of justice to proceed upon the question that the Commissioner had exceeded his duties in doing that? The Commissioner could not have taken the fee without the Act. He got the power to take the fee by the Act, and he took it, and granted the extension.

My learned friends have said that the Welsbach Company were not the owners at the time of the surrender. I find that at the date of the surrender, the entire title to the patent, not only in the province of Quebec which would be quite enough perhaps for this purpose, but throughout the Dominion of Canada, the last one coming in being the city of Halifax, had come into the Welsbach Company; and, therefore, it is not necessary for me to dwell upon that further than to say that if they had not been at that date, at which this document conclusively shows they were, the sole owners of the patent, and if they had not the sole interest, the only party that could complain would be

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the other party who had an interest; but, if the other party, and that is all my learned friend can say, is the Auer Light Co., the plaintiffs in this action, the defendant cannot be heard, when the plaintiffs come here and say, we claim our interest in the patent by subsequent assignments. And, there again, the action of the Commissioner, I submit, was conclusive.

Now, when I come down to what might be termed the marrow of the case, we find this extraordinary fact almost admitted, that under the first patent, if we had that alone, we would be in a position to restrain the defendant; and that under the second patent, if we had that alone, the reissued patent, we would be in a position, except as to one branch, to also restrain the defendant. We would be able, if we had been content with patent No. 1, to stop manufacturing; we would have been able, had we only taken out the reissued patent, No. 2, to stop him. Now, if that is the case, must not there be some very close connection between the two patents? It follows, as it seems to me, as a matter of natural deduction, that if we could have restrained this defendant from performing the work he proposes to do under either patent, there must necessarily be the very closest connection between the two; and, when you come down to the patent, the first thing, I submit, that you are met with is, can the court say by any construction of these two patents, the patents themselves and nothing else, that they are, therefore, a different invention? Is there any question that they are not for the same invention? It is the identical specification and process set out in a somewhat more or less minute detail. Can anyone say that Dr. Carl Auer von Welsbach had in one patent one invention, and in another patent another invention, unless he had in one patent the appliance, and in the other the process. It seems to me that the invention described

is exactly the same. The discovery certainly was the same. The court has said that it may be that the first patent is the broader patent, and that the second patent is the narrower patent. I have been of two or three opinions myself, as to that. The only safe ground that I felt I could tread upon was that the second patent was in no sense broader than the first, and might be somewhat narrower; but, that it certainly was not broader, and that is all we are concerned with, because if the first patent was a wide patent, and the second patent was a confined patent in any way, for part only of the same invention, we would have a perfect right to take it out at any time, even assuming that the action of the Commissioner of Patents was not conclusive.

I submit the two patents are identical in law. They are in law absolutely identical. I have, as I say, varied in opinion, but after spending as much time as I could devote to this, and looking at the authorities, I could not come to any other conclusion than the conclusion I now submit to the court, that, as a matter of law, those two patents are the same. The first patent claims, unquestionably, the appliance made and constructed by the process described in the patent; and as a matter of law, from the description in that and following what is cited by my learned friend Mr. Duclos, that would cover and must cover the process. The distinction being simply this, that if a person simply patents a product irrespective of the methods by which it is brought into existence, he does not cover, of course, the process; but if he identifies his product by making it the product only of a certain process, he has made that process as much a part of his patent as the product itself. That is the distinction as I draw it from the American cases that have been cited. Therefore, I submit that we had in our first patent a patent

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for a product of a process, and in that way, necessarily, as a matter of law, the process itself. Then, if that were so, in what respect, if any, did we alter that by the second patent?

I confess that by the simple wording of the second patent, the reissued patent, we appear to claim merely the process, and we appear to have waived—I am speaking now of the English patent as it simply would strike the lay mind, if I may say so, reading it the first time—we appear to have given up the product; but, as a matter of fact, and as a matter of law, we did not. We really continued to hold the product only of that process, I admit. Not a product made by an entirely different process, following other steps, but we did hold, as a matter of law, the product of that process.

I submit that the American authorities do show some difficulty in keeping a product under a process patent, protecting a product under a process patent; but the English decisions, and where they conflict on this point with the American decisions, I assume the court will follow the English decisions—the English decisions have gone to a very great length in protecting from importation abroad the product of a defined process where the patent only covers the process.

[Cites *Elmslie v. Boursier* (1); *Wright v. Hitchcock* (2); *Van Heyden v. Neustadt* (3).]

In one of these cases a proposition was fought out very strongly, and it arose from the manufacture of a product that was comparatively common, and the counsel put it to the court in this way: Supposing a man discovered a new process for making flour, and the result of that process was a flour of a particular kind, could you stop the importation of flour from

(1) L. R. 9 Eq. 215.

(2) L. R. 5 Ex. p. 37.

(3) L. R. 14 Ch. D. 230.

abroad, say if one went over to France and procured it made by that process? The court said it could. I confess it was very startling to me, but they said, otherwise what refuge has a patentee? As soon as you patented a process, a man might step over to France, or Belgium; or Holland, where there are no patent laws, and manufacture the article and send it in.

On that point I would call attention to the fact that the English judges have had a great deal more difficulty in bringing the law to mean what I have endeavoured to say that it does now mean, because the English Act only deals with the making and working of an invention, whereas our Act deals with the vending and use. The English judges said they might find some difficulty in the case of a man who imported for his sole and only use, without any intention of selling, an article made abroad according to a process, because they had nothing in their Act but the making and working of the invention, but they held the vending covered work. Now our Act mentions both use and vending. Its use is made an infringement.

I said, to return for a moment, that the two patents were alike; the second patent covers the process and, as a matter of law, affords protection to the product of that process. The first patent covers the process and the product only of that process. There was, therefore, in law, no distinction between the two; but there was in the reissue a better and clearer, and more definite and accurate, statement of the steps of that process than were put into the first patent; and, it is only in that respect, I submit, that the two patents are at all different or vary, and that they have no different legal effect. The purpose of the reissue was that it might be beyond peradventure shown to the world at large what exactly our invention was by its claiming clause, without causing them to go back and read over

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the specification. The common man would have learned it if he had gone back and read over our first specification, but the common man could not learn it so easily from our first claim, without doing that, and he could learn it more easily from our second claim by the way in which it was therein set out. And, we find that it has been followed here by a person who certainly cannot be called a chemist—this defendant, in the production of mantles. It is useless, I think, to attempt to say that our directions are not amply sufficient to enable anyone to practice the process therein set out; and the point that there are two inventions covered by this separate patent, I submit, falls to the ground entirely. I submit that no little weight must be attached to the fact that this is a master or pioneer patent. Mr. Justice Bowen, in *Procter v. Bennis* (1), has dealt with this question of pioneer patents in one case, and in this particular case the English counterpart of this case was dealt with by the Court of Appeal; they do not indulge in any sneer at the term “master patent” or “pioneer patent,” and although they do say it is somewhat of a slang term, they add the dignity of that court to the slang, and use it and give it its weight in determining the question of equivalents.

We had a right under the first patent to the process therein set out, which consisted of several steps, and we say that we had, as a pioneer or primary discovery, or invention, the right to take all the natural equivalents, or substitutes for the various steps, and in that direction to perform our process substantially as therein set out.

I think it was in *Clark v. Adie* (2) in which Lord Cairns laid down the rule, that although a process or a method of manufacture might consist of twelve or thirteen steps, even if anyone subsequently endeavour-

(1) 36 Ch. D. 764.

(2) 2 App. Cas. 315.

ed to obtain the result brought about by that method or process of manufacture, and left out—he went as far as to say four or five of the steps—left them out altogether, but took into effect and substance the invention that had been patented, that he would be held an infringer. That case was cited with approval in the judgment of the Court of Appeal in the English case involving this patent. There they left out the lanthanum. Here, we do not find that any of the steps have been omitted. Every step detailed in the original patent has been practically and substantially followed, and the only thing that the defendant has done is to alter, in the minutest way, the character of the solution. If a patentee said: One of my methods is, or one of the steps in my process is, to soak a handkerchief in water; and somebody came along afterwards and said: I do not follow your process, because I soak the handkerchief in milk or ammonia, and if milk or ammonia were the chemical equivalents for water, and not the physical equivalents in the mere question of saturation and moisture, nobody could for a moment say that that person was not infringing the patent in bringing about the result. That is really what is done here. I am not very much concerned whether Dr. Welsbach knew or did not know at the moment that this patent was taken out, although I think, my lord, I can show you that he must have had a very good idea, that thorinum would do the same work, perhaps, although not to the extent he subsequently discovered it would do, but, as I say, I am not very much concerned whether he did know or did not know it, at that time. The real question is, is thorinum nitrate and cerium an equivalent to-day, a physical equivalent in this patent for this lanthanum and zirconium? That, it seems to me, is the test. The Court of Appeal laid by no means the stress that even

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Mr. Justice Wills, who gave judgment for the plaintiff, laid upon the solution. Your lordship will notice that they treat it, as I submit it should be treated, as simply one step in a long and complicated process, and Lord Justice Smith, I think it is, says that the counsel for the defendant has treated this case as if it were the patent for the making of a compound. I entirely dissent from him. It is nothing of the kind.

[BY THE COURT: Mr. Justice Wills was, it appears, inclined to treat it somewhat in that way, because they apparently had considerable evidence as to how far you could vary the formula.]

Yes, but your lordship will notice in the Court of Appeal that they took the broader and wider view of it, and in fact one of the judges said: The defendant leaves out lanthanum and does not put in any equivalent. I am not going to treat it as a matter of equivalent.

Our position is that under the first patent we would have had a perfect right to stop anybody from using a solution of these rare earths in such a manner as to be the equivalent—the physical equivalent of our solution. The evidence is conclusive. The evidence is not seriously combated that thorinum and cerium form the physical equivalents for the lanthanum and zirconium mentioned in the patent.

My learned friend laid some stress on the fact that we rely on the English patent, and that the English patent differed from our first patent in that there was no disclaimer in the English patent. Now, the disclaimer in the patent has absolutely, I submit, no effect whatever. The law would oblige us to disclaim, if we did not do so, just exactly what we do disclaim. We have stated in words what the law would have attached to our patent in any event. What does he say? Having thus fully described the

nature of my invention, and in what manner the same has to be performed, he says: "I hereby disclaim all illuminant appliances for burners, except that included in the following claiming clause." He could make no claim to any burner except that included in the following claiming clause, because the claiming clause is a claim for all burners treated in that way made by that process, and he had a right to no other burners except those treated in that way, and made by that process. I submit that the disclaimer helps them in no way. It is immaterial whether it is there or not. The law would not have given them any more, and he did not perform any act of generosity to the public by what he did. What is not claimed unquestionably is dedicated to the public whether there is an express disclaimer or not.

Counsel for the defendant have raised some question about the title of the reissue, as to it being misleading. I think it is fair to your lordship to say that in that respect they have been citing English cases, under the English law, which is entirely different in that respect from the Canadian law. Of course our Patent Act resembles, in its complexion and in its bearing, much more closely the American than the English Act, follows it much nearer. Of course they have no such things as reissues at all in England.

[Cites *Curtis on the Law of Patents* (1).]

As to the scope of the power of the Commissioner in granting the reissue. Counsel for defendant has practically admitted that all the cases will warrant is that if upon a bare comparison of the documents the court can say, (and that is, I am satisfied, the ruling of the courts of last resort in the United States) if from a bare comparison of the two documents your lordship can say they do not cover the

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same invention, that a man has invented one better, and he wants to get it in, and it is not the same equivalent at all, then you can say the Commissioner has erred. But if it is not that, there is no authority, I submit, that goes to the extent of allowing a court to intervene or interfere, until it is perfectly apparent from the mere instruments themselves that there is not the same invention. Then I admit at once, the court is entitled to say, we have got two inventions, and we must determine then the question of whether they have broadened their claim or not; or whether they have gone into something entirely new. It cannot be urged for one moment, after the admission, that either patent would protect us against this infringement, that we have two inventions here. Can it be suggested, with the specifications that are in, that there is anything like two inventions? Therefore, I submit that the action of the Commissioner in this matter is final and conclusive, and that this court has no more jurisdiction, with all deference, to review that decision, than a court that had been constituted as your lordship's is in many cases, a court of final resort, than any other court would have a right to take up a matter that was not appealable from your lordship.

Then as to the case of the *Powder Company v. The Powder Works* (1), cited by counsel for defendant. He maintained that a patent for a process cannot be reissued as a patent for a product, after a considerable length of time. It should have been the opposite, I think. It should have been the case of a patent for a product cannot be issued, and reissued as a patent for a process after a considerable length of time.

Can anybody say that Welsbach's first patent here could have been made by one person at one time, and that the reissued patent could have been made by an

(1) 98 U. S. R. 137.

other person at another time, and both issued as good patents? Why, the case just shows that it was for a product of a different process, and it is an authority, not against us, but one that makes strongly in our favour.

Perhaps it is not necessary to say anything in regard to the question of the practising of the process here. But the French case that Mr. Duclos has cited shows that the process commences at the moment you start impregnating the filament or thread, and just as we can buy the cotton, or thread, or asbestos, so, I think, we have conclusively shown by the evidence that this thorinum nitrate is a commercial article. And I care not whether it be only for the purpose of incandescent light, or other purpose, it is a commercial article for sale in the United States and abroad, and we have a perfect right to buy it and use it. I would ask the court to consider, at all events, that the plaintiffs' case is meritorious in this respect, that they come here as the legitimate successors of the discoverer Dr. Carl Auer von Welsbach in respect of a discovery which was world-famed, and has had world-wide results. And we meet as their opponent in the case a man who has absolutely made no investigation whatever, who has been an employee of their own, who has endeavoured to get from them the advantage which they were entitled to under the patent that they had purchased at a great expense from Dr. Carl Auer von Welsbach; and that he is not entitled to any meritorious consideration other than what the very strictest interpretation of the law will warrant him.

At the conclusion of the argument, by permission, Mr. *Martin* cited the following cases upon the point that the importation and sale of an article is not the practising of a process. *Cochrane v. Damer* (1); *Roper v. Chicago Manufacturing Company* (2).

(1) 94 U. S. R. 789.

(2) 20 Fed. Rep. 853.

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Judgment.

THE JUDGE OF THE EXCHEQUER COURT now (January 11th, 1897) delivered judgment.

The plaintiff company brings this action to restrain the defendant from infringing letters patent number 46,946, granted on the 1st of September, 1894, to the Welsbach Incandescent Gas Light Company (Limited), and for an account of the profits made by the defendant by the manufacture, sale and use of lights or devices for lights manufactured in accordance with the process protected by such letters patent. This patent is a reissue of letters patent numbered 23,523, that on the 2nd of March, 1886, were granted to one Frederick de la Fontaine Williams as assignee of the inventor, Dr. Carl Auer Von Welsbach. The patent of March, 1886, was surrendered when that of September, 1894 was issued, and the first question to be determined is: Whether the latter is a valid and subsisting patent, the protection of which the plaintiff company, as assignee of the patentee, is entitled to invoke in this action?

But before considering that question it will be convenient, I think, to compare the two patents and to see what the invention was and wherein they differ. The letters patent of March 2nd, 1886, numbered 23,523, were issued for "an improvement on illuminant appliances for gas and other burners." In the first paragraph of the specification, the inventor, Dr. Carl Auer Von Welsbach, of Vienna, in the Empire of Austria, alleges that he has invented a "new and useful illuminant appliance for gas and other burners" of which he proceeds to give "a full, clear and exact description." "My invention," he continues, "relates to the manufacture of an illuminant appliance in the form of a cap or hood to be rendered incandescent by gas or other burners so as to enhance their illuminating power." For this purpose he uses a compound of the

oxides of certain rare earths that he mentions, which substances he states "in a finely divided condition when they are heated by a flame give out a full, large almost pure white light without becoming volatilized or producing scale or ash after being kept incandescent for many hours, but remain efficient without deterioration even when they are long exposed to the air." He then gives the proportions in which such substances may in compounding be varied, and which he has found suitable.

Then comes a description of the process of making the illuminant appliance, the cap or hood. The description is as follows:—

For applying the substances mentioned as an illuminant I use a fine fabric preferably of cotton previously cleansed by washing with hydrochloric acid. I saturate this fabric with an aqueous solution of nitrate or acetate of the oxides above mentioned, and gently press it until it does not readily yield fluid, so that in stretching or opening out the fabric, the fluid does not fill up its meshes. The fabric is then exposed to ammonia gas, and when it has been dried it is cut into strips and folded into plaits. In order to give the fabric thus prepared a suitable shape, a fine platinum wire is drawn through the meshes of the net and bent to the form of a ring so as to give the fabric the shape of a tube, the edges of which are then sewn together with an impregnated thread. The cap or hood thus formed can be supported on cross wires in the chimney of the lamp, or the platinum ring may be attached to a somewhat stronger platinum wire serving as a supporting stem by which the hood can be secured to a holder on the burner tube, the platinum ring of the hood being thus held about an inch or more above the burner.

On igniting the flame the fabric is quickly reduced to ashes, the residuum of earthy matters nevertheless retaining the form of a cap or hood.

After stating that "obviously fabrics of various forms or construction may be employed according to the character of burner to which they are applied" and giving directions as to the means that may be adopted to protect the fabric and prevent its rupture when exposed to a strong current of gas, the inventor dis-

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claiming all other illuminant appliances for burners' claims :

An illuminant appliance for gas and other burners consisting of a cap or hood made of fabric impregnated with the substances hereinbefore mentioned and treated as hereinbefore described.

The patent of September 1st, 1894, numbered 46,946, and the specification attached thereto and made part thereof, differs from the surrendered patent in respect only of the claim, which in the reissue, is as follows:—

I claim the method herein described of making incandescent devices, which consists in impregnating a filament, thread or fabric of combustible material with a solution of metallic salts of refractory earths suitable when oxidized for an incandescent and then exposing the impregnated filament, thread or fabric to heat until the combustible matter is consumed.

The specification of the English patent No. 15,286, granted to Dr. Von Welsbach for his invention, and which has been sustained in England by Mr. Justice Wills and by the Court of Appeal, is substantially the same as that contained in the first Canadian patent. In the specification of the English patent the inventor claims as his invention the manufacture substantially as described of an illuminant appliance for gas and other burners, consisting of a cap or hood made of fabric impregnated with the substances mentioned and treated as set forth. The description of the substances to be used in impregnating the fabric, and of the process of manufacture and treatment, are the same in the English and in the two Canadian patents. The differences occur in the language used in the specification to describe the claim. In the English patent the inventor claims as his invention the manufacture in a specified method of an illuminant appliance. In his first Canadian patent he claims the illuminant appliance manufactured in a specified method, and in the second Canadian patent he claims a specified method

of manufacturing such illuminating appliances; the method in each case being the same and described in identical terms. The method or process of manufacturing the illuminant appliance was, it is clear, new and useful, and the illuminant appliance the result or product of that method or process of manufacture was also a new and useful appliance. The process is not useful for any other purpose than the manufacture of such illuminant appliances, and apart from a question of equivalents, to which it will be necessary to refer presently, there is no known way of manufacturing or producing such illuminant appliances, except that which the inventor has described.

The rare earths particularly mentioned in the specification are the oxides of lanthanum, zirconium and yttrium, or to use the names by which such oxides are known, lanthana, zirconia, and yttria. The proportions in which these substances are to be compounded to obtain the solution with which to saturate the cotton fabric may, it is stated, be varied within certain limits, and the following proportions are given as suitable:—

- 60 per cent zirconia or oxide of zirconium;
- 20 per cent oxide of lanthanum;
- 20 per cent oxide of yttrium.

The oxide of yttrium may be dispensed with, the composition being then:—

- 50 per cent zirconia;
- 50 per cent oxide of lanthanum.

Instead of using the oxide of yttrium, ytterite earth, and instead of oxide of lanthanum, cerite earth containing no didymium, and but little cerium may be employed.

For part of the zirconia a mixture of magnesia and zirconia may be employed with a little loss of intensity of the light given out.

In these particulars also the two Canadian patents and the English patent are identical.

The formula given affords five examples of the compound that may be used. If magnesia is added the number is increased to ten. Cerite earth and ytterite

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earth, it appears, contain rare earths other than those mentioned, such as erbia and thoria, and if the proportions of the several substances mentioned be varied the number of compounds that may be used is increased indefinitely.

The invention, the subject of these patents, is described by one of the plaintiffs' witnesses, Mr. Waldron Shapleigh, in the following terms:—

The invention consists in the discovery of the fact that when certain of the oxides of rare earths are exposed to high heat in the filamentary form, they were coherent; so that after saturating say, a cotton fabric in a solution of such rare earths for producing said filamentary form, there would remain on burning out the carbonaceous and driving off the volatile matter, an exact duplicate of the original structure in the oxides of these rare earths, and that owing to the coherence of the particles, the structure would hold its shape, and owing to its durability and refractory quality, can be utilized as an incandescent.

Dr. Morton and Professor Chandler have in their evidence stated substantially the same thing in other words. It was known of course prior to Dr. Auer Von Welsbach's discovery that you could saturate a cotton fabric with a solution of certain salts, and that on burning out the cotton the earthy matter would be left in the form of the fabric. It was also well known that owing to their refractory quality the oxides of the rare earths mentioned, or most of them, became highly incandescent when exposed to heat. But it was not known that the oxides of such rare earths that would be left after the vegetable matter was burned out would have sufficient coherence and flexibility to be of any practical use as an incandescent. Dr. Morton says that it was a radical discovery to find that these refractory earths treated in this way would act in a manner that to-day to the scientific man is mysterious; that it was an utterly unexpected thing and not for a moment to be anticipated from anything then known. With that view Professor Chandler agrees. Referring

to the hood or mantle made according to the process described in the patent, he says that it differed from any device which had ever been introduced before for artificial illumination in its peculiar physical condition. Every thread, even the most minute fibres of the combustible tissue primarily employed for constructing the hood, was reproduced in the refractory earths. No one could, he says, have foreseen that the refractory earths would replace atom for atom every particle of the fabric, and that it would cohere. It was known that if one attempted to moisten any one of these refractory earths and knead them together to produce an incandescent fabric the result would be a failure because of want of coherence, and no one could have foreseen that the refractory earths produced by the ignition of the nitrate in the cotton tissue would possess properties so different from those which the earths prepared in another way exhibited. That, he adds, was a discovery of Von Welsbach.

The patent of the 2nd of March, 1886, was granted to Williams and his assigns for the period of fifteen years, but the partial fee required for the term of five years only was paid; and the parties entitled to the patent failed to pay the further fee required to keep the patent in force during the residue of the term of fifteen years. It being impossible after the expiry of the five years for the persons entitled to the patent to obtain from the Patent Office, in accordance with the provisions of section 22 of *The Patent Act*, a certificate from the Commissioner of the payment of such further fee, a special Act was passed to confer upon the Commissioner certain powers for the relief of Carl Auer Von Welsbach and others (1). This Act was assented to on the 9th of July, 1892, and authorized the Commissioner, notwithstanding what had happened, to

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(1) 55-56 Vict. c. 77.

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accept from the said Von Welsbach and Williams the applications and usual fees for the renewals or extensions of such letters patent for the remainder of the term of fifteen years from the date thereof; and to grant and to issue to such Von Welsbach and Williams the certificate of payment provided by *The Patent Act*.

It appears from the assignments in evidence that prior to the date of this Act, Williams had assigned his interest in the patent to one Arthur O. Granger for all of Canada, excepting the provinces of Quebec, New Brunswick, Nova Scotia, and Prince Edward Island, and to Messrs. Pearson & Buck, of Boston, in respect of the provinces named; and it is objected that this Act is not effective because the title to the patent was not at that time either in Von Welsbach or Williams. I do not think, however, that this objection should prevail. Williams retained at least a partial interest in the patent until the 2nd of April, 1892; and by the second section of the Act referred to, it was provided expressly that any person who had during the period between the 2nd of March, 1891, and the date of the extensions or renewals authorized by the Act, acquired by assignment or otherwise any interest or right in respect of the invention should continue to enjoy such interest or right as if it had not been passed—showing very clearly that it was the intention of Parliament to permit the payment of the usual fee for renewal or extension of the patent irrespective of the person who at the time the Act was passed would be entitled to the patent.

The question as to whether the Welsbach Incandescent Gas Light Company (Limited) were, on the 1st of September, 1894, the persons entitled to the new patent is also in controversy. Mr. Hellmuth for the plaintiff company thinks that the assignments in

evidence show that at that date the Welsbach Incandescent Gas Light Company (Limited) were solely entitled to the patent; but on this point, after examining the several assignments, I agree with Mr. Martin that there was an outstanding interest in Arthur O. Granger in respect of the provinces of Quebec, New Brunswick, Prince Edward Island, and Nova Scotia, excepting the city of Halifax. Granger, however, as appears from his affidavit of the 25th of August, 1894, made in support of the application for the reissue, was the general manager of the company, and in his affidavit he declares that the Welsbach Incandescent Gas Light Company (Limited), were at that date the sole owners of the said patent. I infer, therefore, that he had either assigned his interest to such company by some instrument not before the court, or that he was under the assignment mentioned merely a trustee for the company, and for this reason I think the objection that is made against the patent of September, 1894, on that ground, fails.

Another objection taken to the validity of the patent of September, 1894, is that the Commissioner had no authority or jurisdiction under the circumstances of the case to cause such patent to be issued. By the 23rd section of *The Patent Act*, it is provided that:

Whenever any patent is deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more than he had a right to claim as new, but at the same time it appears that the error arose from inadvertence, accident or mistake, without any fraudulent or deceptive intention, the Commissioner may upon the surrender of such patent and the payment of the further fee hereinafter provided, cause a new patent, in accordance with an amended description and specification made by such patentee, to be issued to him for the same invention for any part or for the whole of the then unexpired residue of the term for which the original patent was or might have been granted.

The first occasion on which we find any provision in any Canadian statute on this subject is in the Act

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1897 of the old Province of Canada, 12 Vict. c. 24, section 7, which enacts as follows:—

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That whenever any patent heretofore granted or hereafter to be granted as aforesaid shall be inoperative or invalid by reason of a defective or insufficient description or specification, if the error have or shall have arisen from inadvertency, accident, or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the patentee to surrender such patent, and to obtain a new patent to be issued to him for the same invention for the residue of the unexpired period of the original patent, in accordance with the patentee's corrected description and specification.

This provision was no doubt taken or adopted from the thirteenth section of the United States Patent Act of 1836, by which it is enacted :

That whenever any patent which has heretofore been granted, or which shall hereafter be granted, shall be inoperative, or invalid, by reason of a defective or insufficient description or specification, or by reason of the patentee claiming in his specification as his own invention more than he had or shall have a right to claim as new ; if the error has or shall have arisen by inadvertency, accident or mistake, and without any fraudulent or deceptive intention, it shall be lawful for the Commissioner upon the surrender to him of such patent, and the payment of the further duty of fifteen dollars, to cause a new patent to be issued to the said inventor for the same invention, for the residue of the period then unexpired for which the original patent was granted, in accordance with the patentee's corrected description and specification (1).

The defendant claims that the Commissioner had in the present case no authority to issue a new patent because the surrendered patent was not defective or inoperative by reason of insufficient description or specification or by reason of the patentee claiming more than he had a right to claim as new ; that there was no error in that respect and that therefore it could not be said that the error had arisen from inadvertence, accident or mistake. The plaintiffs' answer to that is that the decision of the Commissioner is conclusive. Referring to this question as it arises upon the United

(1) Walker on Patents 3rd Ed., p. 594.

States Patent Law it is said in the third edition of *Walker on Patents*, section 221, that

It is still an unsettled question whether the decision of the Commissioner that the existence of the statutory ground for a reissue exists when he grants a reissue is conclusive; or is a subject of review and possible reversal in a suit for infringement of a reissue.

In a note to the section referred to will be found collected for the use of counsel who have occasion to argue, and of judges who have occasion to decide, the question, a long list of the principal cases that support the negative of the proposition, and also a list equally long of those that support the affirmative. The same question arises upon the Canadian statute, but there is not, it seems to me, in the form in which the provision is now enacted, so much room for a difference of opinion and for a conflict of authority as there is in the United States. By the Canadian Act, as it was passed in 1869, and has been re-enacted since, the Commissioner may entertain the application for a reissue if the patent is deemed defective or inoperative for any of the causes mentioned. The use of the word "deemed" imports that a discretion, a judgment, is to be exercised. [*De Beauvoir v. Welch* (1).] But by whom? In the first place, perhaps, by the applicant; but in the end, and as a foundation for his jurisdiction, by the Commissioner. His jurisdiction does not depend upon the patent being in fact defective or inoperative for the reasons specified; but upon the patent being deemed for such reasons to be defective or inoperative. How is the court, in an action for the infringement of the new patent, to try out the question as to whether or not the Commissioner deemed the surrendered patent to be defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more than he had a

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right to claim as new? The patent might be neither defective nor inoperative, and yet the applicant and the Commissioner might be honestly mistaken and might in good faith deem it to be defective or inoperative. Must not the question in such a case be concluded by the action of the Commissioner? It seems to me that it must at least in an action for infringement of the reissued patent. In respect of the question as to whether the first Canadian patent in this case was in fact defective or inoperative for any of the reasons mentioned in the statute, I should, if it were necessary for me to come to any conclusion upon it, be inclined to agree with Mr. Martin that it was neither defective nor inoperative. But that, as I have said, is not the question upon which the jurisdiction or authority of the Commissioner of Patents is founded. That may be true, and still it may also be true that the Commissioner deemed it to be defective or inoperative for some one of the specified reasons; and in that case he had jurisdiction to entertain the application, and his action and decision must, I think, be taken to be final and conclusive.

Another objection to the patent, and perhaps the most important, is that the new patent is not for the same invention as that which was the subject of the earlier patent. The difference, as we have seen, between the two patents lies in the statements of the claim. In the patent of March, 1886, the inventor after stating in his specification, amongst other things, that his invention relates to the manufacture of an illuminant appliance, claims as his invention an illuminant appliance for gas and other burners consisting of a cap or hood made of a fabric impregnated with certain substances therein mentioned and treated as therein described. This is, it seems to me, a claim for an illuminant appliance manufactured in the way

or method specified and described in the patent. We have seen that the illuminant appliance which could be produced by the process described was a new and useful appliance, and that the process was also new and useful. In that state of circumstances the inventor was, it seems to me, entitled to a patent either for the process by which the appliance was produced, or for the appliance produced by that process, or for both; and that so long as it happens to be the case that the process described is not useful for any other purpose than that to which the inventor had applied it, and the appliance cannot be made by any other process, it is immaterial whether the patent is issued for the process by which the appliance is produced, or for the appliance produced by the process, or for both. In the new patent, the patentee claims, as has been seen, the method, described in the specification, of making incandescent devices which consist in:—

impregnating a filament, thread or fabric of combustible material with a solution of metallic salts of refractory earths suitable when oxidized for an incandescent, and then exposing the impregnated filament, thread or fabric to heat until the combustible matter is consumed.

The method or process here claimed is a method or process described in identical terms in the specification to the first patent. The word "device" is used instead of the word "appliance," but I do not see that the use of the former word instead of the latter in any way enlarges the claim. In respect of the use, in the process of manufacturing the hood or mantle, of certain refractory earths there is in the claim in the patent of September, 1894, no word of reference or limitation to the refractory earths mentioned in the specification; but it is conceded by counsel for the plaintiff that the words "salts of refractory earths" occurring in the statement of claim in his patent must be limited or restricted to such refractory earths as are mentioned in

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the preceding part of the specification, or to their equivalents. If this is a true construction of the specification, and I agree that it is, then the claim in this respect is not larger than the claim made in the patent of March, 1886; for while that claim is in its terms for an appliance made by impregnating a cap or hood with the substances mentioned in the specification, the law would give the patentee protection against the use of any such substances as would be the equivalents of the refractory earths so described. That has, I think, been determined in the English case before Mr. Justice Wills, and in the Court of Appeal, to which I have referred (1). There the defendant claimed not to have infringed the English patent to which reference has been made, because in making the impregnating solution lanthana was omitted and erbia substituted therefor; but it was held that notwithstanding this departure from the formula, if I may use the term, which the inventor had given for the making of his solution, the defendant in that case had infringed the patent. I am of opinion, therefore, that the new patent issued in this case was issued for the same invention as that for which the earlier patent of March, 1886, was issued.

It is also contended that the reissued patent is invalid because the applicant was guilty of laches in making his application for the reissue. The doctrine that the right of a patentee to a reissue is lost in certain cases by lapse of some time after the date of the expiry of the original patent and before the application for the reissue, has been established in the courts of the United States and recognized in Canada. The doctrine itself has no statutory support. The legislature has not either in the United States or in Canada

(1) *The Incandescent Light Co. System Ltd.* 13 R. Pat. Cas. Ltd. v. *The De Mare Gas Light*

required that an applicant for a reissue should come to the Commissioner within any definite or specified time. It is a doctrine that rests wholly upon the authority of decided cases. The object aimed at by the rule is good ; but the rule is, I think, open to some objection when enforced by a court. If it were applied by the Commissioner there would not be the same objection ; for if he refused to issue the new patent because the application had been made too late, the patentee would not have surrendered his original patent, and would still have the benefit of it, whatever that might be. But if the rule is enforced by a court very grave injustice may be done. Take, for illustration, a case in which there was a perfectly good and valid patent, but which was deemed defective or inoperative for some reason. The question whether it was defective or not might be a very abstruse and difficult question. The Commissioner deems it to be defective, and though a long time has elapsed he accepts the surrender of the original patent, one which was in fact good and valuable, and causes a new patent to be issued. Later the reissue comes in question in the court, and the more valuable the patent is the more likely it is to be infringed and to be brought into question, and the court says to the patentee: You were too late in making your application to the Commissioner for the reissue and for that reason, and that reason only, we refuse to sustain the new patent notwithstanding that the legislature has not imposed any such terms or conditions upon you or the Commissioner, and notwithstanding that we are not able to restore to you the use and benefits of your surrendered patent.

That is a rule that I should not care to adopt or follow unless compelled to do so by the clearest

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authority. If the reissue gives the patentee something that he was not entitled to, then he should be held not entitled no matter how promptly the application was made; but if nothing more is granted to him than that to which he was entitled when the original patent issued and the only effect of the reissue is to correct some error in the specification that arose from inadvertence, accident or mistake, I do not see why, after the issue of the new patent by the Commissioner, he should be prejudiced by any delay in making his application. But holding the view that I do in this case that the new patent is for the same invention as the surrendered patent, and that properly construed it is not a larger patent and does not extend to the patentee any greater rights or protection or monopoly than the surrendered patent, I think I have no occasion to come to any conclusion as to whether or not I am bound in dealing with such a case to apply the doctrine of laches.

It is also objected to the validity of the patent that the patentees have imported the invention contrary to the provisions of *The Patent Act* and that they have not manufactured it in accordance with the provisions of such Act. The principal objection on this ground is that they have imported the fluid for impregnating the cotton fabric, and have not manufactured it in Canada. I do not think I need add anything to what I said at the hearing as to that. I do not see that the plaintiffs are in any way bound by the statute to manufacture this fluid. I think it is open to them to buy it where and from whom they please, and that it is no breach of the conditions of this patent to import it. I am supported in that view by the reference that counsel gave me to a decision of the Court of Appeal of Douai, France (1), upon a like

(1) *Le Droit*, Jour. des Trib. No. 148, June 25th, 1896.

question arising in respect of the importation of this fluid into that country.

It was also made an objection to the validity of this patent that the patentees did not sell the illuminant appliance or any product of the process for which the patent issued, to any person in Canada desiring to use it. The case that was attempted to be made out on this point totally failed. It turned out that the witness who spoke of the matter, and who had been sent to the plaintiffs' office after this action was commenced did not ask to purchase one of their mantles or hoods, but asked to have such mantles or hoods attached to galleries that he took with him to their office. That the company's officers refused to do, but they did not refuse to sell, and they were at the time selling the cap or hood to anyone who desired to obtain it at what has not been challenged as a reasonable price. It turned out, however, in the course of the examination of one of the company's officers that at first the price for the hood or mantle was put at \$100, and that, it seems to me, might well be held not to be a reasonable price. But it was not shown that at that time any person desired to obtain one of the hoods or mantles, or that any demand was made for it, or that there was any refusal to sell it at a lesser price. If at that time and before the price was reduced, which was very soon after, anyone desiring to use or obtain the mantle had demanded it and had been refused except at the price mentioned, the question must of necessity have arisen as to whether or not the condition upon which the patent is held had not been broken. On the whole, I am of opinion that I ought not to declare the patent forfeited for any breach of the condition to manufacture in accordance with the provisions of the statute.

We come now to the question of infringement, and as to that the plaintiffs concede that unless they could have succeeded under the patent of March, 1886, in

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restraining the defendant from doing the acts complained of, they cannot succeed under the patent of September, 1894, that is, unless the thoria and ceria solution used by the defendant is an equivalent of the solution indicated and described in the specification to the first Canadian patent, the patent has not been infringed. Upon the evidence before the court, I find that the thoria and ceria solution used by the defendant is the equivalent of the solution mentioned in the specification to the first Canadian patent.

Before leaving this question of infringement I ought, perhaps, to refer to the contention made on behalf of the defendant that under any circumstances he would at least be entitled to import for use or sale illuminant appliances made in a foreign country in accordance with the process protected by the plaintiffs' patent. With that view, however, I cannot agree. I think that the law is well settled to the contrary, and I need only refer for this purpose to the cases cited by Mr. Hellmuth, viz.: *Elmslie v. Boursier* (1); *Wright v. Hitchcock* (2); *Von Heyden v. Neustadt* (3).

That, I think, disposes of the principal matters in controversy in this case. There were, however, some other objections that were taken at the hearing, but it is not necessary to add anything to what was then said. In the result, I find all the issues in favour of the plaintiffs, for whom there will be judgment with costs. The plaintiffs are also entitled to an injunction, and to an account of the profits made by the defendant in manufacturing, selling, letting or hiring of the illuminant appliances made in accordance with the process protected by the patent in question in this case.

Judgment accordingly.

Solicitor for plaintiffs: *C. A. Duclos.*

Solicitors for the defendant: *Foster, Martin & Girouard.*

(1) L. R. 9 Eq. 217.

(2) L. R. 5 Ex. 37.

(3) L. R. 14 Ch. D. 230.