

TREGO COMPANY, INC.,

PLAINTIFF,

AND

DOMINION CORSET COMPANY,

DEFENDANT.

1918

May 15.

*Patents—Subject matter—Corset—Novelty—Invention—Combination
—Prior art—Costs.*

Held, that a patent for supporting belts or bands in the nature of a corset was invalid for want of novelty or invention.

2. Where the patentee has merely adopted in the manufacture of his patented article old contrivances of a nature similar to those found in other articles of the same kind, and producing similar results, there is no invention to support the patent.

3. The Court, taking into consideration the conduct of a defendant leading up to the action, has a discretion to deprive him of his full costs although he succeeds in the action.

ACTION for the infringement of a patent.

Tried before the Honourable Mr. Justice Audette, at Montreal, Que., February 26, 27, 28 and March 1, 1918.

S. Casey Wood, for plaintiff.

L. A. Cannon, K.C., for defendant.

AUDETTE, J. (May 15, 1918) delivered judgment.

The plaintiff company brings its action, against the defendant, for an alleged infringement of the Canadian Patent, No. 158,542, bearing date October 27th, 1914, granted to the M. W. Schloss Manufacturing Company, the assignee of the patentee, Edgar Guggenheim, which said company in turn sold and assigned it with all right, title and interest to the plaintiff company.

1918
 TREO Co.
 v.
 DOMINION
 CORSET Co.
 Reasons for
 Judgment.

The grant contained in the patent is “for an al-
 “leged new and useful improvement in supporting
 “belts.”

The second paragraph of the specifications states :
 “This invention relates to *belts* or *bands* to be worn
 “around the body at the region of the waist for the
 “purpose of sustaining and preserving the natural
 “shape of the figure. While the device is in the form
 “of a belt or band, it is of considerable width and
 “therefore partakes of the nature of a waist or
 “corset.”

Proceeding further on with the specifications, to
 which reference will be hereafter made, we come to
 the claims, which are in the following language,
 viz.: “I claim:—

“1. A low corset, consisting of a flat body-portion
 “whose upper and lower edges are substantially
 “parallel and unshaped to the figure of the wearer,
 “said body portion being elastic in a longitudinal
 “direction and provided in the upper portion and at
 “substantially the waist line with a zone of elastic
 “but less yielding nature than the remainder of the
 “body portion for the purpose set forth.”

“2. A low corset, consisting of a flat-body por-
 “tion whose upper and lower edges are substantially
 “parallel and unshaped to the figure of the wearer,
 “said body portion being elastic in a longitudinal
 “direction and provided in the upper portion and at
 “substantially the waist line with a zone of elastic
 “but less yielding nature than the remainder of the
 “body portion, and hose supporters attached to the
 “body portion at points below the said less yielding
 “zone.”

The second claim is a repetition of the first, with
 the addition of the hose supporters attachment. The

hose supporters are not *per se* claimed as an invention, but are claimed as part of the second combination, or as a combination between the hose supporters and the other features or elements of claim No. 1. And I may say there would have been, under the state of the prior art, no justification for claiming *per se* these hose supporters attachment. They were attached to all manner of corsets before the date of the alleged invention.

Before approaching the merits of the patent, it is well to bear in mind that the grant in the patent is for "supporting belts." The specification refers to it as *belts* or *bands* partaking of the nature of a *waist* or *corset*, and the claims call it a "*low corset*," while at the trial it was continually referred to as a "girdle."

The patent is in itself very narrow.

By reference to the claims, specifications and drawings on the one hand, and Exhibits 7 and 8 on the other, the latter being the product of the patent, it will naturally occur to a casual observer that the least that can be said is that the article purporting to be manufactured under the patent differs materially from the article that appears to be contemplated by the patent. The upper and lower edges are not parallel, but are of different lengths; the stays are not placed in a V shape, as shown in the drawings. It is not, as described in the specification, "a simple, straight band of considerable width, which surrounds the body and emphasizes its natural shape by reason of inherent elasticity of the band," for the obvious reason that the elastic band does not extend from one end to the other. There are two adjuncts of different material

1918

TREG CO.
v.
DOMINION
CORSET CO.
Reasons for
Judgment.

1918
 TREO Co.
 v.
 DOMINION
 CORSET Co.
 Reasons for
 Judgment.

or fabric at each end which are not elastic. The product is *conic* and not unshaped.

However, the plaintiff's expert, heard at trial, contends that the plaintiff's corsets are not manufactured as per the patent, but with mechanical equivalents as needed by the trade; that they differ in structural details, but are within the language of the specification and claims and are full equivalents, and are substantially the same.

Counsel at bar for the defendant, relying on this difference between the patent and the product, claimed to have been manufactured thereunder, contends that the patent has become null and void, under sec. 38 of the *Patent Act*, for want of manufacturing in Canada, within 2 years from the date of the patent, the invention covered by the patent, as no extension for so doing appears to have been given as provided by sec. 39 of the *Patent Act*.

In the view I take of the case, it becomes unnecessary to make any pronouncement upon this point, and I will limit myself to the consideration of the validity of the patent itself, without considering the manufactured article.

Indeed, upon the enquiry as to whether or not the patent is good or bad, and as to whether the subject matter can be sustained by letters patent, regard must be had exclusively to the patent itself and not to the product of the same, or rather, as in the present case, not to the article the patentee has seen fit to produce under his patent.

Under the *Canadian Patent Act*, sec. 7, a patent may be granted to any person who has invented any new and useful art, machine, manufacture or composition of matter, or any new and useful *improvement* therein, which was *not known* or used by any

other person *before his invention thereof* and which has not been *in public use* or on sale with the consent or allowance of the inventor thereof for more than one year previously to the application for the patent.

The subject matter of the letters patent must be something new, useful and involving ingenuity of invention.¹ In order to support a patent the novelty must be the outcome of skilful ingenuity,² The primary test is invention and the question as to whether there has been invention is one of fact in each case.

And as was said in the *British Vacuum* case,³ different minds may arrive at different conclusions on the point as to whether or not there has been invention.

In the present case, however, we must enquire whether the alleged combinations imply invention and whether the result therefrom has not been anticipated. Commercial success, contrary to what was contended at trial in this case, is not a test of invention, although it may be of usefulness. Has the present patentee brought forth a new result consistent with the prior state of the art? That is what we shall have to enquire into.

Tracing the etymology of the word "corset", we find that it comes from the old French word "cors," (the Latin *corpus*), a diminutive of the word *corps* or body, the original object of which was the bringing out of a small waist. In the early days, among the Romans and the Greeks, long before the 14th century, when the conventional corset with stays first appeared, small bands of some fabric or an-

¹ *Nicolas, on Patent Law*, pp. 1, 20.

² *Frost*, p. 27.

³ 39 R.P.C. 209.

1918

TREG CO.
v.
DOMINION
CORSET CO.

Reasons for
Judgment.

1918

TREO Co.
v.
DOMINION
CORSET Co.
Reasons for
Judgment.

other were used in their stead, and, in course of evolution, reappeared in France at the time of the French revolution; but, in 1815, what has been called all through the trial the conventional corset with stays, came back again.¹

From Mr. Justice Gwynne's judgment in *Re Ball v. Crompton Corset Co.*² we also find that as far back as 1872, corsets made of "an elastic fabric of india-rubber webbing" were then in existence.

Can we not say that corsets existed from time immemorial, and that while the devices of some of them were protected by patent, others were not and were thus given to the public and are not therefore subject to the monopoly of a patent.

I think it may well be stated and conceded that there is no new element entering into the corset covered by the patent. Low corsets were in existence long before the date of the patent. Elastic material of different degrees of resiliency was also common in the art.

Counsel for the plaintiff claims that the patent "is for the *combination*, and the test of the combination is interaction. Each corset depends for its result upon the interaction of the general elasticity of the band, acting in interaction with the waist band, and that it is unshaped,—the whole band being unshaped to the body of the wearer."

Therefore, the claim is for the combination.

Let us now enquire into the state of the prior art. As a starting point, we have garment Exhibit "M," unprotected by patent and belonging to the public, which consists of a flat belt, a girdle waist band, comprising a flat body portion, upper and lower

¹ See *Larousse*, vo. Corset.

² 13 Can. S.C.R. 493.

edges parallel, of elastic material stretching longitudinally and with three zones of varying elasticity, the centre being more yielding. The difference between the plaintiff's patent and Exhibit "M" practically consists in a different distribution of the resiliency of the bands, placing the less resilient at the waist, widening the band and making an opening as in the ordinary corset.

Passing to garment Exhibit "L" (*corset sangle*), we find a large waist band or girdle, much higher or wider than Exhibit "M"; also, with a flat body portion,—waist band, 3 zones and all of elastic material. This corset or band, as Exhibits "7" and "8", manufactured by the plaintiff under the patent, is conic, being larger over the hips, narrowing at the waist, describing a small curve at the junction of the waist and top bands.

Exhibit "K" is another garment in the nature of a girdle, waist band, unprotected by patent, with flat body portion, 3 zones of elastic material and a waist band of greater resistance. This exhibit would appear to be shaped to the body, retaining, however, the conic shape above mentioned.

Exhibit "J" is still another garment or band, belt, girdle or corset of elastic material, and of different elasticity in the front. It is less resilient at the waist, and is much in the shape of the article manufactured under the present patent, conic-shaped and curving at the waist.

Coming now to Exhibit "B" (Exhibits "C" and "Q" being practically the same, comments on "B" will apply to them), a Claverie corset which, to all purposes, possesses all the elements of the combination covered by the plaintiff's patent, with, however, small differences, but mostly in details.

1918
 TREO Co.
 v.
 DOMINION
 CORSET Co.
 Reasons for
 Judgment.

1918

TREO Co.
v.
DOMINION
CORSET Co.
Reasons for
Judgment.

This garment (B), as well as M, L, K and J, was sold by the Claverie house here in Canada prior to the date of the alleged invention by the plaintiff.

In garment "B" we find, paraphrasing the patentee's claim, a *low corset*, which is what is claimed by the patentee. The body portion is *elastic in a longitudinal direction, and provided in the upper portion and at substantially the waist line with a zone of elastic but less yielding nature than the remainder of the body portion*. In thus describing Exhibit "B" I have used the language to be found in the plaintiff's claim No. 1, which is equally applicable to Exhibit "B".

Having purposely used the entire language of the claim, omitting, however, to be considered separately, the balance of the words, which read as follows: A flat body portion "whose upper and lower edges are substantially parallel and unshaped to the figure of the wearer." There is also all through these corsets the same peripheral tension. And the object and function of a claim in a patent is to determine the scope of the patentee's invention.¹

Now garments, Exhibits "7" and "8," the articles produced under the patent, are not parallel, as claimed in the patent and shown in the drawings, and while according to the experts heard on behalf of the suppliant they are not manufactured as per the mechanism of the patent, they are equivalents as needed by the trade, differing from the patent, according to him, in structural details, but remaining within the language of the patent, being full equivalents.

¹ *Barnett-McQueen Co. v. Canadian Stewart Co.*, 13 Can. Ex. 186 at 221.

Adopting this mode of reasoning to the claim in the plaintiff's patent, it is easy to find that while garment Exhibit "B" is not absolutely parallel, in the manner mentioned, it is "substantially parallel" within the meaning and language of the patent, differing slightly in structural details only.

Again, the claim of the plaintiff's patent describes his garment as "unshaped to the figure of the wearer." The garments, Exhibits "6" and "7", which he manufactures are conic, and therefore not actually unshaped, but enough so, according to the plaintiff's evidence, to come within the meaning and language of the patent. Garment Exhibit "B", compared with a conventional corset, would be pronounced unshaped, and while it contains small curves in structural details, adopting the language of the plaintiff's expert, can it not be said that it is "substantially unshaped" and still within the language and meaning of the claim of the patent, and therefore anticipating the plaintiff's patent?

Exhibit "B" has also edges of different elasticity to prevent the corset from curling.

In the result, comparing garment "B" and garments "7" and "8", would not this combination or their construction perform absolutely the same function? I cannot conceive that the principle involved in the plaintiff's patent was new at the date of the patent. After all, does not the plaintiff's article amount to a mere elastic band, of an undefined width to be placed around the body by way of support?

All of these articles, or articles similar to the exhibits above mentioned, were on the market and being sold to the public prior to the alleged invention. I shall now approach the consideration of that part of the evidence in respect of some of the American

1918

TREGO Co.
v.
DOMINION
CORSET Co.Reasons for
Judgment.

1918

TREGO Co.
v.DOMINION
CORSET Co.Reasons for
Judgment.

patents, and the publications, produced at the trial, in respect of these garments.

The American "Lackey" patent of 1906, Exhibit "A", disclosed a "girdle" consisting of a flat body portion whose upper and lower edges are not only *substantially, but actually, parallel*. The body of the girdle is made "of some loosely woven fabric which "is cut on the bias, so that it really yields to give "some fulness to the girdle at the top and bottom " * * * permitting it to *conform to the body of the "wearer"*. The waist-band is made of tape and is "therefore *less yielding than the rest of the girdle.*"

Another American patent (Exhibit "W"), granted in 1906 to Abadie Leotard, for a "waistband, belt and the like", was also filed at trial. The principal feature of this exhibit is that it is of elastic material of different degrees of resistance, the upper and lower edges are parallel and it is unshaped to the body of the wearer, and stretches longitudinally as in the plaintiff's patent.

Exhibit "X" is an American patent granted as far back as 1884 to one Craig, and is for a "corset" made of elastic material from top to bottom, *with 3 elastic zones of different degrees of resistance. The waistband being less yielding than the other portions of the corset.* The language used in this patent is worth noting when reading the plaintiff's patent, and according to one expert this corset and that of the plaintiff would produce equivalent results.

Exhibit "Y", an American patent, granted to one Digney in 1906, is a combination of abdominal support and hose-supporters as in claim No. 2 of the plaintiff's patent. It is a curved band or girdle com-

prising a plurality of zones, made of elastic webbing adapting itself to the shape of the body.

On the question of prior publication, as establishing the state of the prior art, the defendant produced a copy of "Femina", of March 15th, 1912, which had been used by defendant when manufacturing his own corset, and wherein we find, at page 27, cuts of corsets showing great similarity with the class of corsets in this case, and which possess the characteristic elements so much relied upon by the plaintiff. The description indeed reads as follows: "Le No. 1618, est une combinaison gainant absolument le corps qu'elle laisse souple et onduleux; "en tissu caoutché renforcé à la taille * * * "Le No. 1621 est une ceinture caoutchoutée. Cette "ceinture est renforcée tout autour du haut, du bas, "et de la taille, sans que son épaisseur en soit augmentée, ce qui la rend très résistante en lui permettant de suivre tous les mouvements du corps "sans se déformer."

In 1913 witness Amyot says he also had in his possession the publication called "The Corset and Underwear Review," and at page 33 thereof we find that among the corsets exhibited in September of that year there was, as described therein, "a corset of a webbing arranged in 3 sections, the top "and bottom section of elastic and the centre non- "elastic."

By way of supplement reference may also be had to the Claverie catalogues and circulars, viz., in Exhibit "D" at p. 35; Exhibit "F" at p.p. 18 and 19; in Exhibits "E", "H-a" and "H-b" at p. 2, and in Exhibit 10 at p.p. 12 and 13. These are practically cuts and plates having the features and elements found in Exhibit "B" discussed above, and

1918

TREGO Co.

v.

DOMINION
CORSET Co.Reasons for
Judgment.

1918

TREO Co.
v.
DOMINION
CORSET Co.
Reasons for
Judgment.

which in the result disclose the same or equivalent elements combined in substantially the same way and producing practically the same results as plaintiff's corset.¹

Having already considered the state of the prior art in corsets, I must in the result come to the conclusion that all the features, functions and contrivances claimed in the combination of the present patent are also to be found in other corsets, specifically or generally. The most the patentee has done was to adopt, without invention, in the manufacture of his corset, old contrivances of a similar nature found in other corsets and producing similar results. The adaptation of old functions or contrivances to a new purpose, especially to the same class of article, would not even constitute invention. There is no subject matter where invention is wanting.² Moreover, the combination claimed in this case does not imply invention.³

The proposition that the article in question has been a commercial success, and that it can be produced cheaper than before alone would establish a patent, is to my mind unsound, as it would have the effect of enlarging the patent law by bestowing upon successful commercial adaptations a privilege confined to an invention that is new and useful. Indeed, success cannot be said to be the test to a right to the privilege of a patent, because most of the time such success is due to business energy which does not enter in the consideration of the patent laws. And, indeed, if I find no "meritorious inven-

¹ See *Hunter v. Carrick*, 11 Can. S.C.R. 300.

² *Terrell on Patents*, 5th Ed., p. 38.

³ *British United Shoe Machinery Co. v. Fassell & Sons*, 25 R.P.C. 632; *British United Shoe Machinery Co. v. Standard Rotary Machine Co.*, 35 R.P.C. 33.

tion" in the plaintiff's patent, I do not destroy, as claimed at trial, the plaintiff's commercial success. They can go on, as Claverie and others have done in the past, and sell their goods, unprotected by a patent, on their merits and extend their trade in the article by business energy and capacity.¹

*Eagle Lock Co. v. Corbin Cabinet Lock Co.*² is authority for the proposition that, "There is no "patentable invention when the peculiar structure "necessarily resulted from the fact that the patentee "wanted to combine certain old elements, and a person skilled in the art would naturally group the "elements in the way the patentee adopted."

It certainly cannot be said that the combination claimed by the plaintiff's patent lies so much out of the track of former use as to evolve ingenuity of invention.

As already said, the functions of the combination claimed in the plaintiff's corset are substantially to be found in the Claverie corset, Exhibit "B", and others; and, as all the parts going to make the plaintiff's corsets are obviously old, he can only claim in respect of the combination, as he has done; but his combination is substantially anticipated both by patented and unpatented corsets, and this combination is obviously without ingenuity of invention, without which a patent cannot be sustained.

The combination of the patentee did not, considering the state of the knowledge of prior art, disclose any new functions or discovery which could, to my mind, amount to invention. I cannot perceive any ingenuity of invention in the plaintiff's patent, con-

¹ See *Terrell on Patents*, pp. 34, 35, 88, 90; *Waterous v. Bishop*, 20 U.C.C.P. 29.

² 64 F. R. 789.

1918
 TREO Co.
 v.
 DOMINION
 CORSET Co.
 Reasons for
 Judgment.

1918
 TREP Co.
 v.
 DOMINION
 CORSET Co.
 Reasons for
 Judgment.

sidering the state of the art and knowledge at the date of the patent.

Under our patent law a patent is granted as a reward for invention, whereby restraint upon commercial freedom in respect of the use of the patented invention necessarily results; and a court cannot be too careful in insisting that it is only when the requirements of the law have been satisfied by the patentee that the public will be prevented from using common and well-known articles or devices for a common purpose.

“There is no sufficient invention in merely applying well-known things, in a manner or to a purpose which is analagous to the manner or to the purpose in or to which it has been previously applied.”¹

In view of the prior art, I am of opinion that not only is there no contrivance or device that is new in the plaintiff's patent, but that there are no new features in the combination claimed, the same features having been previously obtained in other corsets.

The case of *Consolidated Car Heating Co. v. Came*² went even so far as to decide that “In an action for infringement of a patent, if the merit of the invention consists in the idea or principle which is embodied in it, and not merely in the means by which that idea or principle is carried into effect, the patentee must shew that *the idea or principle is new*; and must fail if the merit of his invention lies merely in a new combination of known features.”

¹ *Nicolas on Patent Law*, p. 23, and cases therein cited.

² [1903] A.C. 509.

The present patent relies on the functions performed by the combination of old and well-known devices; but in view of the knowledge of the prior art, it must be found that such known features of such combination were by no means new. Corsets of elastic fabric of zones of different resiliency, with less resilient band at the waist, with the features of the patent, were in existence before the date of the patent and performing in their combination the functions claimed. And paraphrasing the language of Ritchie, C.J., in *Ball v. Crompton Corset Co.*,¹ I come to the conclusion the plaintiff's patent does not possess any element of invention, and I can, in no sense, "find any creative work of an *inventive faculty* which the patent laws are intended to encourage and reward," and as already said, the fact that the plaintiff's patent has proved successful does not necessarily establish that it is an invention entitling him to a patent. There is in that case very apposite language in respect of a patent for corsets that will apply to the present case with great propriety and where the pronouncement was against the validity of the patent.²

In the case of *Yates v. Great Western R. W. Co.*³ it was also held that although the patented article was a most useful contrivance it could not be the subject of a patent as it was wanting in the element of invention.

The functions which the present patentee claims as new in his combination would, as well to a person of ordinary skill in the manufacture of corsets as to the unwary purchaser, appear, knowing the prior

¹ 13 Can. S.C.R. 475.

² See also *Williams v. Nye*, 7 R.P.C. 62.

³ 2 A.R. (Ont.) 226.

1918
 Taro Co.
 v.
 Dominion
 Corset Co.
 Reasons for
 Judgment.

1918

TREC Co.
v.DOMINION
CORSET Co.Reasons for
Judgment.

state of the art, to be old or even a case of "double use" involving no ingenuity of invention.¹

Perhaps I should not dispose of the case without offering some short observations with respect to Exhibits 14 and 15, which are copies of judgments delivered by the Courts of the United States upon the plaintiff's patent. Exhibit No. 14 is the copy of a judgment obtained by consent of the parties and as such does not amount to more than an arrangement or compromise between the parties therein mentioned. It is hardly necessary to say that it is a class of judgment upon which no reliance can be placed with the view of using it as a determination by the Court upon the validity of the patent. Then Exhibit No. 15 appears to be another judgment between the parties therein mentioned. Canadian Courts, like the English Courts, are accustomed to treat the decisions of the American Courts with great respect, although they are in no manner bound by them.² However, the case appears to be unreported, no reasons for judgment are available, and it is impossible to ascertain upon what ground the conclusions of this judgment were arrived at. I therefore, fail to conceive how I could make any use of these judgments.

The defendant company, besides attacking the validity of the plaintiff's patent, denies any infringement of the same, and, moreover, alleges it has ob-

¹ *Potts v. Crearer*, 155 U.S. 597. See also *Wisner v. Coulthard*, 22 Can. S.C.R. 178, *Copeland-Chatterson v. Paquette*, 38 Can. S.C.R. 451, *Northern Shirt Co. v. Clark*, 38 D.L.R. 1, 17 Can. Ex. 273, and cases therein cited; and *Wilson v. Meldrum*, Coutlée's Dig. S.C.R. 1039.

² See per *Halsbury*, L.C. in *Re Missouri Steamship Co.* (1889) L.R. 42 Ch. D. 330; per *Brett*, L.J., in *The Queen v. Castro*, L.R. 5 Q.B.D. 516; and per *Kekewich*, J., in *Re De Nicols*, [1898] 1 Ch. D. 403 at 410.

tained Canadian patent No. 171276 on August 8th, 1916, for manufacturing the article or corset which is now claimed by the plaintiff as an infringement of his corset. A subsequent patent is no defence to the infringement of a prior patent.¹ Had the plaintiff's patent been found good and valid, I would obviously, without any hesitancy, have found that the defendants had infringed. However, in the view I take of the case consideration of the question of infringement is unnecessary, except in respect of its bearing on the allowance of costs.

Coming to the question of costs, I must say that, in view of all the circumstances of the case, I feel somewhat perplexed. As a general proposition, if an action is dismissed for want of validity of the patent, it should *primâ facie* carry with it all costs in favour of the defendant; but there may be circumstances which would abate this *primâ facie* claim and justify the exercise of discretion by the Court to withhold full costs.²

There is nothing in the *Canadian Patent Act* to hamper the Court in the exercise of its discretion upon the question of costs, which in this case falls within the provisions of Rule 290, that has statutory force. It is, however, quite clear that there are, under the *English Act*, provisions dealing specifically with costs under certain circumstances, differing therefore from our Act. With this qualified observation I wish to refer to most apposite language which has fallen from the lips of some of the eminent Judges on this question of costs. Bowen, L.J., in *Badische Anilin und Soda Fabric v. Levinstein*³ says: "It seems to me that, without laying down

1918
 TREO Co.
 v.
 DOMINION
 CORSET Co.
 Reasons for
 Judgment.

¹ *Grip Printing & Publishing Co. v. Butterfield*, 11 Can. S.C.R. 291.

² *Vancouver v. Bliss*, 11 Ves. 463, 32 E.R. 1164.

³ 29 Ch. D. 366 at 419.

1918

TREO Co.
v.
DOMINION
CORSET Co.
Reasons for
Judgment.

“any hard and fast line, or trying to fetter our discretion at a future period in any other case, we are acting on a sensible and sound principle, namely, the principle that parties ought not, even if right in the action, to add to the expenses of an action by fighting issues in which they are in the wrong. It may be reasonable as regards their own interest, and may help them in the conduct of the action, that they should raise issues in which in the end they are defeated; but the defendant who does so does it in his own interest, and I think he ought to do it at his own expense.” See also *Bennington v. Hill*.¹

Again in *Dicks v. Yates*,² Jessel, M.R., said: “I think that the Court has a discretion to deprive a defendant of his costs though he succeeds in the action, and that it has a discretion to make him pay perhaps the greater part of the costs by giving against him the costs of issues on which he fails, or costs in respect of misconduct by him in the course of the action.”

Moreover, in the consideration of the question of costs I do not think that the tribunal is exclusively confined to the abstract result of the litigation; it may also consider the defendant's conduct previous to and conducing to the action. Is it not the duty of the judge, before arriving at any pronouncement, to consider the whole circumstances of the case from beginning to end? Everything which led to the action, everything in the conduct of the parties which actually prompted and originated the proceedings should be considered.

¹ 8 R.P.C. 326.

² 18 Ch. D. 85.

Had I not disposed of the present case upon the question of the validity of the patent, I would have found without hesitation, as already mentioned, that the defendant's corset constituted an infringement of the plaintiff's patent.

But in the present case there is more. The defendant did not only copy that corset manufactured by the plaintiff, which he alleges was not patentable, but he also, in 1916, applied and obtained from the Canadian Patent Office, a patent which is now filed of record as Exhibit No. 5, as alleged in his statement of defence. In the specifications of that patent, we find at 5 or 6 places the identical language which is also found in the plaintiff's patent. If the defendant was truly in earnest in believing the plaintiff's patent invalid for want of novelty or invention, how could he in earnest apply for a similar patent, taking from the plaintiff's patent the very same language and using it in his own specification? How can the defendant reconcile, with any consistency, the duality of this position?

Under all the circumstances of the case on this question of costs, I think justice will be done if the plaintiff were allowed a certain amount of costs on the question of infringement, and the defendant were given qualified general costs upon the issue of want of validity of the patent, considering the plaintiff was successful on the question of infringement; and those costs should not be as ample as in a case where no such circumstances as above mentioned had existed. And with the view of carrying out this principle, and avoiding the taxation of costs upon two issues with set-off and proceeding under the provisions of rule No. 290 of the Rules and Regulations of the Exchequer Court of Canada, I hereby direct

1918

TREO Co.
v.
DOMINION
CORSET Co.
Reasons for
Judgment.

1918

TREG CO.
v.
DOMINION
CORSET CO.REASONS FOR
JUDGMENT.

that the defendant's costs shall be hereby fixed and allowed at the sum of \$300 in lieu of taxed costs.

Therefore, the plaintiff's patent is found invalid for want of subject matter, or ingenuity of invention, and the action is dismissed with costs to the defendant fixed at the total sum of \$300.

Action dismissed.

Solicitors for plaintiff: *Rowell, Reid, Wood & Wright.*

Solicitors for defendant: *Taschereau, Roy, Cannon & Co.*