DETROIT RUBBER PRODUCTS, INC.....PLAINTIFF;

AND

REPUBLIC RUBBER COMPANY.....DEFENDANT.

1927

Sept. 20-22.
Oct. 22.

Patents—Invention—Prior Art

The patent in suit was for a channel rubber runway for slidable windows in automobiles. In respect to sliding windows, the channel, either of metal or rubber, with a fabric lining the groove and upper edges, which contact with the glass was known in the prior art. The "only idea claimed (as invention) was the extension of the fabric down the sides" to the bottom. A patent had previously been granted to one Matthews, for a channel, in which the fabric was carried completely around, but which was intended to be used for stationary windows.

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Held, that the idea of extending the fabric around the channel, was one which might well have occurred to an ordinary intelligent person, or any person skilled in the art, without any exercise of that inventive faculty which was essential to a valid patent, and that the present patent did not denote invention.

ACTION to have Canadian patent no. 243916 declared valid and infringed by the defendant.

The action was tried before the Honourable Mr. Justice Audette at Ottawa.

George F. Henderson, K.C., for plaintiff.

Russell S. Smart, K.C., for defendant.

The facts are stated in the reasons for judgment.

AUDETTE J., now (October 22nd, 1927), delivered judgment.

This is an action brought for an alleged infringement of the Canadian Patent No. 243,916, bearing date the 21st October, 1924, granted to Walter W. Metzger and subsequently assigned, namely, on the 9th September, 1926, to the plaintiff herein.

The controversy, in the present case, is between the plaintiff and the defendant Republic Rubber Company only, the action having been, by leave, discontinued with costs, at the opening of the trial as against the other defendants.

The Republic Rubber Company—which will hereafter be called the defendant—by its statement in defence, avers, among other things, that

if the Patent No. 243,916 is valid, which the defendant does not admit but denies, then the defendant has manufactured in the United States and sold in Canada to the other defendants herein, a channel rubber runway for slidable windows which would infringe the Letters Patent.

The issues are therefore narrowed down to the only question as to whether the plaintiff's patent is valid or invalid.

The grant contained in the patent is for a

certain new and useful improvement in

Channel Rubber Runways for Slidable Windows.

The claims read as follows, viz:—

What I claim is:—

1. In combination, a window frame member, a slidable glass window pane, a runway for such pane carried by said frame member comprising

a self-supporting rubber channel substantially rectangular in cross section having a friction-reducing fabric material covering its glass engaging surfaces and extending outwardly over the lips of the runway and then backwardly down the outer sides of the runway to a point where the edges of the material are concealed between the runway and the frame member.

2. In combination, a window frame member, a slidable glass window pane, a runway for such pane carried by said frame member comprising a self-supporting rubber channel substantially rectangular in cross section having a friction-reducing fabric material covering its glass-engaging surfaces and extending outwardly over the lips of the runway and then backwardly down the outer sides of the runway and onto the back of the runway so that the edges of the material are concealed and the runway is protected.

3. In combination, a channelled window frame member, a slidable glass pane, a runway for such pane mounted within the channel of said frame member and comprising a self-supporting rubber channel substantially rectangular in cross-section provided with a friction-reducing fabric material covering its glass-engaging surfaces and extending outwardly over the lips of the runway and then backwardly down the outer sides of the runway and on to the back of the runway so that the edges of such material are concealed and the runway is protected, said runway being movable laterally within the channel of the frame member to permit the glass pane to be shifted laterally relative to said frame member.

Having perused these claims and looked at exhibit No. 3, it is well to bear in mind that what is claimed as new and patentable is the fact of having a channel rubber runway lined with fabric on five faces: i.e., the bottom, two inside sides and two upper outer edges or faces—and to have added thereto the fabric lining to 2 or 3 other faces, namely: to the two outside faces and bottom.

The whole is succinctly stated by witness Fauver, the president of the plaintiff company, who says that the

only idea claimed is the extension of the fabric down to the sides, so that it would cover seven faces instead of five—

That is, carrying the fabric down the outer sides to the back. The patent is not for the channel or way, but for the outer lining.

Proceeding then to the consideration of the merits of the case as submitted, the outstanding question which presents itself for determination is as to whether or not the device in question, exhibit No. 3, covered by the patent, is *per se* subject-matter as involving any ingenuity of invention and further as to whether or not it has been anticipated in the prior art.

The patent is in itself very narrow and calls therefore for a narrow construction.

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This device or structure is really one of great simplicity involving devices and structures well defined in the prior art. And in the consideration of such matters is it not always necessary to consider the rights of the general public, as well as the prior art, to avoid monopolies on such simple devices as would occur to any one? Indeed is not the present idea of extending the fabric around, so to speak, one which might well have occurred to an ordinary intelligent person, or a person skilled in the art, without any exercise of that inventive faculty which is necessary as the ground for a patent. *Bonnard* v. *The London General Omnibus Co.* (1); *Haskell Golf Ball Co. Ltd.* v. *Hutchison* (2).

On the question of prior publication, as part of the prior art, the defendant sets up the plea arising out of sec. 7 of the Patent Act. Upon that question it will be sufficient to say that such plea must be established by clear and predominating evidence and not from conjecture. The evidence adduced upon that point is too faint to establish any substantial ground to build upon.

The history of the prior art shows first, as testified to by witness Brown, heard on behalf of the defence, the Hoof runway filed as exhibit "A" and described in the Hoof catalogue of 1918 at p. 6, which is a rubber runway or channel lined with fabric on five faces only. It is the same kind of runway as in the plaintiff's patent, excepting that the fabric is only on five faces. And the purpose of the fabric, in the inside of the channel, is to let the sashless glass slide readily up and down in such channel.

Then at p. 7 of exhibit A it is also disclosed that the runway No. 270 is a device

forming a sash for a window which can be used in a variety of ways in connection with sashless windows, as runways

. . . . Adding

If covered *inside and out* it makes a most desirable item in protecting glass against breakage.

At p. 8 of the same catalogue, No. 1150, we also find a steel channel all covered with felt.

These Hoof devices are not protected by a patent; but these structures—Nos. 270 and 1150—it would seem, dis-

(1) (1919) 36 R.P.C. 279; 38 R.P.C. 1.

(2) (1908) 25 R.P.C. 194, at p. 204.

close clearly the idea of covering the channel entirely with felt. It is true the channel is steel and not rubber, but this substitution of material is well settled by the case of *Ball* v. *The Crompton Corset Company* (1). The improvement of the patent in suit is claimed to be that the fabric extends either at the sides or at the sides and back. There is no evidence that Hoof's device was not a success, but as he was selling his device at 45 cents a foot as against 3 cents by the plaintiff, it is no wonder that Hoof's sale fell out when the plaintiff's device was placed on the market. That the plaintiff achieved a commercial success is not sufficient to justify the issue of a patent. See the authorities upon that point gathered and reviewed in re *Durable Electric Appliances* v. *Renfrew Electric Products Ltd.* (2).

Then comes the Fischer patent, exhibit G which at one time was declared in conflict with an application by the plaintiff. However, suffice it to say in that respect that Fischer is the Hoof device which was earlier than Fischer, except that in the latter the fabric is embedded in the walls of the groove or rubber.

The Matthews patent, exhibit D1 (1910) disclosed a channel rubber runway *lined with fabric all around* as shewn by the sample filed as exhibit D11. It is claimed to be used in a window sash and in this case the glass does not slide direct within the runway. It is a window sash intended for a railway, and this device is used in the sash to receive the glass instead of putty. However, this patent discloses a channel rubber runway, or a window pane seat, used in a sash, but there is nothing to prevent it being used with a sashless window in the manner provided by the plaintiff's patent, and it discloses a rubber runway all covered with fabric. It also has a groove at the back which would be only the more solid in the sash of the door.

It is used for a similar and analogous purpose—to avoid the rattling of a window. There would be no difficulty in using the Matthews device in place of the Metzger (p. 110).

The application of a well-known contrivance to an analogous purpose, without novelty in the mode of appli-

(1) (1886) 13 S.C.R. 469.
(2) (1926) 4 D.L.R. 1004 at 1007.

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cation, is not invention and is not a good ground for a patent. See *Northern Shirt Co.* v. *Clark* (1) and cases therein mentioned.

The adaptation of an old contrivance to a new purpose is not invention and there is no subject-matter when no ingenuity of invention has been exercised. Terrell, p. 38.

It may be well to add here what was said by the plaintiff's expert, witness MacRae, when questioned with respect to D1, and D11, viz:

Q. Then I am putting it to you that if the form of rubber covered U-shape, or channel member, call it what you will, shown in Matthews were used in any of the well known windows having sliding panes, so that the channel engaged the said pane, then you would have the plaintiff's structure?—A. Yes.

Q. I am only trying to clear the ground by seeing what the difference is, and I put it to you that if the form of fabric covered channel shown in Matthews were used in the known type of automobile window with the sliding pane instead of the fixed pane shown in Matthews, we would then have the same structure as shewn in exhibit No. 1, do you agree?—A. Yes.

Passing now to the O'Brien patent, Exhibit D2, of 1915, we find that it discloses a window pane which slides up and down in a runway used with window construction adapted particularly for use on motor vehicles. The side members of the frame are provided with grooves within which are flexible guides covered with plush. The runway is entirely covered with fabric or plush on its eight faces. There is nothing in the specification referring to metal channel, so that a rubber channel would be within the terms " flexible guides." Upon this point, witness MacRae heard on behalf of the plaintiff, testified as follows:

Q. And if in O'Brien I had a rubber channel, instead of what you claim metal, I would then, to all intents and purposes, have the plaintiff's structures as shewn in exhibit no. 1?—A. Yes.

Even if the plaintiff's claim were based upon the substitution of material, rubber for metal, this substitution could in no sense be taken as creative work of an inventive faculty as held in *Ball v. Crompton Corset Co., ubi supra.* No invention on O'Brien in the plaintiff's devices.

The Douglas patent, exhibit D3, relating to convertible automobile body shows a metal channel covered

(1) (1917) 17 Ex. C.R. 273, confirmed on appeal to the Supreme Court of Canada.

with fabric extending over the edges and down the sides, the lining covering extending to the back as well as the sides. (MacRae, evidence, p. 193.)

The Cheston English Patent exhibit D5 relates to window guides or metal channels for frameless sliding windows for automobiles, having for object the elimination of rattling, where the rubber or the like strip is covered with velvet or other suitable fabric. The metal channel is adapted to be enclosed or partly surrounded by "a flat strip of rubber and that rubber is covered with velvet." The metal channel has apertures in it and rubber corresponding projections. It is around the rubber that the fabric is placed. It is somewhat different from Metzger but for analogous purposes using almost analogous means.

The plaintiff's patent relies on functions performed by well-known devices abundantly disclosed in the prior art. The invention claimed here is part of and incorporated in patents of the prior art. Sustaining the plaintiff's device as invention would possibly affect the rights of Matthews and O'Brien, the patentees above mentioned, in that the plaintiff takes part of their disclosures. Moreover, the fact of only extending the fabric down over the sides—or at the back, upon which rests the very idea of the patent, cannot, even outside of the consideration of the prior art, be considered invention as it does not show or involve "any creative work of an inventive faculty."

The plaintiff's patent is made up of a group of well-known old devices and contrivances, and has been anticipated by similar and analogous structures. Its invalidity has therefore been established beyond all question; and that is the finding of the court in the case now before it. The action is dismissed with costs.

Judgment accordingly.