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 Jan. 14.

MICO PRODUCTS, LIMITED.....PLAINTIFF;
 VS.
 ACETOL PRODUCTS, INC.....DEFENDANT.

Patents—Specification—Claims—Subject-matter—Validity—Infringement

The patent in suit herein related to a window glass substitute. The patentee states that he employed a "reticular metallic base, the width of the meshes and size of the wire strands thereof being so designed as to insure maximum transparency and strength of the final product. The composition of the lacquer or filler used to produce, when dried, a thin, tough transparent coating or film between the wire meshes and firmly adhering to the strands of the base material, must be so selected as to not only withstand weather conditions but to possess the property of being a poor conductor of heat which makes the ultimate article specially suitable for specific uses such as green-houses, poultry houses and the like. We have found that cellulose acetate or cellulose nitrate mixed with a suitable plasticizer and the mixture dissolved in a suitable solvent, has given excellent results from the standpoint of producing a coating substance endowed with the above characteristics." The Specification ends as follows: "While our invention has been set forth in several modifications, it will be understood that others may be made by those skilled in the art without departing from the spirit and scope thereof. For example other compositions or lacquer may be found for coating the fabric or material other than those suggested and because of their inherent properties, will be especially valuable for such use,—but all such modifications are desired to be regarded as contemplated by the invention as defined in the appended claims." And he then claims: "An

article of manufacture comprising a reticular metallic base covered with a flexible transparent film adapted to wet the strands of said base and follow the expansion and contraction thereof, the thickness of said film being such that the outlines of the meshes of the base are substantially preserved in the surfaces of the film, whereby said surfaces are substantially divided into sections corresponding in number and general design to the meshes of the bases."

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Held: That inasmuch as the quantities of the ingredients to be used to successfully produce the object covered by the patent was nowhere given, the patent failed in this respect to comply with the provision of Section 14 of the Patent Act.

2. That as the final clause of the specification took in all the prior art and was a blanket claim, it was too wide and vague in view of the prior art, and failed in that respect to comply with the Statute. That a claim to every mode of carrying a principle into effect amounted to a claim to the principle itself and is bad.
3. That the questions of anticipation and subject-matter are so much bound up together that it would seem impossible to deal with one without touching the other.
4. That upon the enquiry as to whether or not the patent is good or bad, 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 the patentee might see fit to produce under a secret process outside and foreign to the patent.

ACTION to impeach and annul the Canadian letters patent for invention No. 270,927.

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

O. M. Biggar, K.C., for plaintiff.

C. C. Robinson, K.C., for defendant.

The facts are stated in the Reasons for Judgment.

AUDETTE J., now (January 14, 1930), delivered judgment.

This is an action to impeach or annul the Canadian patent, No. 270,927, issued on the 24th day of May, 1927, to Cello Products, Incorporated, whose name has been changed to *Acetol Products, Inc.*, assignee of Jules Colle and Achilles Colle, for "Glass Substitutes." The application for the Patent was filed on the 25th August, 1925.

In the language of the Specification (p. 2) the invention relates to a window *glass substitute* and more particularly to a novel and improved article of manufacture which can be utilized in various arts to take place of window panes and the like, being particularly applicable in the construction of enclosures when light diffusing and

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heat insulating properties are important factors such as greenhouses, hot-beds, cold-frames, poultry houses, chicken coops and the like . . .

Further on (at p. 5), the Patentees state:

In practicing our invention, we prefer to employ a *reticular metallic* base, the *width of the meshes and size* of the wire strands thereof being so designed as to insure maximum transparency and strength of the final product. The composition of the lacquer or filler used to produce, when dried, a thin, tough transparent coating or film between the wire meshes and firmly *adhering* to the strands of the base material, must be so selected as to not only withstand weather conditions but to possess the property of being a poor conductor of heat which makes the ultimate article specially suitable for specific uses such as greenhouses, poultry houses and the like. We have found that *cellulose acetate* or cellulose nitrate *mixed with a suitable* plasticizer and the mixture *dissolved in a suitable solvent*, has given excellent results from the standpoint of producing a coating substance endowed with the above characteristics.

Then further on, at p. 7, the Specifications set forth:

The lacquer or coating which we use to incase or enroll the strands of the base 1 may comprise a composition consisting of cellulose acetate and a plasticizer, the admixture being dissolved in a suitable solvent.

Cellulose acetates and cellulose nitrates belong to the general class of cellulose esters. The plasticizer is a material which, when added to the solution of cellulose esters, is a suitable solvent which confers upon that solution ability to produce when dry a film which will wet and adhere to the metallic base to which it is applied. It is non solvable in water and will prevent entrance of water in these films.

Plastifying agents and plasticizers mean the same thing.

Then claim 1, which covers everything, as there is no substantial difference in the five other claims, reads as follows:—

What is claimed is:

1. An article of manufacture comprising a reticular metallic base covered with a flexible transparent film adapted to wet the strands of said base and follow the expansion and contraction thereof, the thickness of said film being such that the outlines of the meshes of the base are substantially preserved in the surfaces of the film, whereby said surfaces are substantially divided into sections corresponding in number and general design to the meshes of the bases.

These extracts from the Specifications and claim, as above set forth, are made with the view to facilitate the comparison or *rapprochement* of the same to the prior art, as the case turns principally upon the question of anticipation.

The issues are narrowed down to the only question as to whether or not the defendant's patent is valid or invalid. The defendant's patent is far from being a pioneer patent. It is very narrow and therefore calls for a narrow construction.

Proceeding to the consideration of the merits of the case submitted, the outstanding question which presents itself for determination is as to whether the process or product in question covered by the patent is *per se*, in view of the prior art, proper subject-matter.

This process or product is one of great simplicity involving a subject-matter well defined in the prior art for a similar and analogous purpose.

The history of the prior art discloses the two products called respectively *Spondite* and *Vitrex*, together with prior patents describing a similar process and product for an analogous purpose.

The commodity claimed to be produced under the patent would seem to be and comprise a reticular metallic base,—the well known wire screening—not in any way earmarked—to be covered with a flexible transparent film adhering to the strands. The film is confined to a composition or solution of cellulose acetate or cellulose nitrate; with a plasticizer, generally speaking, the kind, nature or composition of which is not claimed by the patent.

Exhibit D was produced at trial as a sample of the defendant's product; but the evidence does not establish that it was manufactured by them and, what is more important, that it was manufactured according and under the patent and not under a secret process as distinguished from the patent, a matter to which reference will be hereinafter made.

The product *Vitrex*, samples of which, among others, are filed as exhibits 7 and 8, was sold on the Canadian markets, in February, 1923, in British Columbia, Alberta, Saskatchewan and Manitoba and was likewise advertised in the "Farm and Home" publication circulated in these provinces.

It seems in all respects similar and analogous to Exhibit D,—with perhaps a weaker wire—and used for similar and analogous purposes. It is also called "wire glass"—"substitute for glass." Its use and durability for interior purposes is not questioned; exhibit 8 is a portion of the material used on cold-frames for two years and which was recently cut off from the same.

Exhibit 7 was cut off a chicken-house, but was never exposed to the weather.

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Spondite is another similar "glass substitute,"—a wire mesh covered with cellulose and plasticizer. It was also sold and advertised in British Columbia, between 1920 or 1921, in 1922 and 1923. It was advertised as a general "glass substitute" for the analogous purposes mentioned in the defendant's patent. Exhibits 11 and 12 are filed as samples of the same. Witness Smillie, who went to Scotland in 1920, brought out with him a sample of "Spondite" in 1920.

The frame work in "Spondite" is copper wire and this commodity, it appears, was removed from the market because of the price of wire going up during the war.

Witness Glenn testified he can produce "Spondite," (exhibits 11 and 12), under the instructions found in the defendant's patent as coming within the scope of the patent in question,—and the converse is also true. A very important and controlling statement.

Then, besides these two glass substitutes, "Vitrex" and "Spondite," come a number of patents of the prior art in connection with the same subject-matter, which were filed by the plaintiff at trial, viz:—

Exhibit 14—British Patent—No. 1765—Johnson, 1855.

- " 15—British Patent—No. 128,274—Henry Dreyfus, Convention date—Aug. 3, 1916—U.K. 10 July, 1917.
- " 16—U.S. Patent—No. 314,483—Scarles—24 March, 1885.
- " 17—U. S. Patent—No. 342,345—Ford—25 May, 1886.
- " 18—British Patent—No. 16,656—de Chazelles—29 July, 1904.
- " 19—U.S. Patent—No. 1,308,426—Keil—1 July, 1919.
- " 20—U.S. Patent—No. 1,309,858—Jones—15 July, 1919.
- " 21—U.S. Patent—No. 1,354,551—Hansen—5 October, 1920.
- " 22—British Patent—No. 25,984—Henry Dreyfus—9 December, 1921.
- " 25—U.S. Patent—No. 1,497,989—Russel—17 June, 1924.

Witness Glenn has filed as exhibits 14a, 14b, 14c, 14d 14e the results of his experiments showing the products made under patent exhibit 14. They are made with similar wire screening upon which a film was wet or adhered to; they show what the patent covered.

The same witness, dealing with exhibit 15, filed also as exhibits 15a, 15b, 15c products of the results of his experiments under that patent.

This witness Glenn, who made these experiments, is a patent solicitor and an amateur chemist, having some laboratory facilities at his home. He states, among other things, that exhibit 15b was made with cellulose acetate, as in the defendant's patent, and dissolved in tetrachlorethane reinforced by metallic fabric. These exhibits although quite crude and made without the proper appliances, under these patents of the prior art, show clearly even from mere ocular observation that they come within the scope of the subject-matter of the defendant's patent.

Then exhibit 16 (Scarles) discloses a wire cloth to which a thin translucent film is applied. The formulae mentioned in this patent have been criticized by the defendant's witness Hawthorn as not adhering to the metallic base; but not from observation of an article produced thereunder, but merely from the suggestion of the solution therein described.

Ford's patent, exhibit 17, is another one of the same class as the previous exhibit and has reference to a waterproof and translucent covering for roofs and for other like purposes, consisting of wire gauze coated with an oxidized compound of linseed oil and litharge or other siccativ which covers up the wire and fills the meshes. It is light, flexible and transparent.

The British Patent of de Chazelles (exhibit 18) is a product of "armoured celluloid." It is an armature or core formed either of perforated or other plates, *wire*, and is enveloped in a bed or layer, or between two thin sheets of a *plastic material having nitrocellulose as its base*, such as is designated under the generic name of celluloid, and it has flexibility, rigidity and strength,—its uses being the same as the product of the defendant's patent.

The Kiel British patent (exhibit 19) is another one that has to do with an open-work material, such as wire screen-

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ing, producing a semi-transparent material by dipping the wire in a solution of sodium silicate or applying a heavy coating of the same upon it and turning out a product resembling stained glass.

The Jones patent (exhibit 20) is an invention having to do with the coating of a wire fabric with *cellulose acetate*, *cellulose nitrate* or any similar composition. This patent uses the same composition as that used by the defendant and expressly anticipates the defendant's patent.

The Hansen patent (exhibit 21) is also for a substitute for glass by closing the meshes of a wire fabric, producing a translucent sheet by dipping the screen into solutions described in the patent and having acetic acid among its ingredients.

The second Dreyfus British patent (exhibit 22) provides various proposals for the manufacture of sheets, webs, plates or the like of *nitrocellulose*, *acetyl cellulose* and other *cellulose esters* or compositions containing the same, reinforced by open-meshed metallic base, being employed as *glass substitute*, and makes use of plastifying agents,—just as in the defendant's patent.

The adherence of the film is, in the defendant's patent, done through the use of plasticizers with cellulose acetate; but the nature of the plasticizers is not defined or claimed in his patent, nor are the quantities, the quality or the kind anywhere therein described. And as disclosed by one witness at trial, one can manufacture under the prior patents the very article claimed by the defendant's patent.

Then the Russell patent (exhibit 23) provides a wire screen carrying a binder supporting a *plastic* composition producing a flexible or glass composition, using for his solution a silicate of sodium.

The products of these different patents as compared with the product of the defendant's patent and with exhibit D, have been conjecturally (i.e., without having ever seen the product, but from the mere reading of the patent), criticized, by the defendant's expert witness for their want of durability and adherence; but, he testified that the products (p. 116) suggested by these earlier patents would be perfectly satisfactory for interior purposes. However, whether the product is made under the prior art and

whether the defendant's patent is good or bad, so long as it is the same, there is anticipation.

Is not a peremptory answer and explanation to this criticism to be found in the testimony of Dr. Max Mueller, president of the defendant company since its incorporation in March, 1923, when it abandoned the name of Cello Products, Inc. This examination was taken, upon commission, at New York City.

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It results, among other things, from this evidence, that the defendant's product was first sold in 1923 and that they used *cellulose acetate since then*.

In the course of his examination, we find the following questions and answers, viz:—

Q. 22. What plasticizer was used? This question is objected to.

Q. 23. Am I correct in understanding from time to time you have used a variety of plasticizers in making this product?—A. I do not doubt that in some cases plasticizers were used, but these belong to one particular class that is adaptable to *cellulose acetate*.

Q. 24. What *class of cellulose do you use now?* The question was objected to, the witness answered thus.—A. I decline to answer.

Q. 25. Do you use tri-phenyl-phosphate at the *present time?*—A. I decline to answer.

Q. 26. Do you use an ingredient to make the product non-inflammable at the present time?—A. I decline to answer.

Q. 27. What salt do you use?—A. I decline to answer.

* * * * *

Q. 40. And I suppose the formula you *finally adopted* was the result of collaboration?—A. Yes.

Q. 41. That formula is a secret formula?—A. No, I do not think so.

Q. 42. Well, if it is not, I would like to have it.—A. Well, it might be secret from the point of view of quantities and of applications, etc.

Q. 43. Well, then we might say it is secret. *If by formula I mean exact names of ingredients, it is a secret formula.*—A. Yes.

* * * * *

Q. 54. Have you any knowledge of any difficulties being overcome by research work in order to make the product *weather proof* and capable of withstanding climatic conditions?—A. Well, all I can say is that we have made *our product more weather proof* and more durable than it was in the very beginning when we started. . . .

Q. 55. But what were the innumerable difficulties that you had to overcome?—A. We found that heat alternating with heavy rains deteriorated the product in a given time which, in our opinion, was too short to make the product really commercially successful, and we have made all sorts of attempts to correct this.

Adverting to all that has been said, I have come to the conclusion that the defendant's patent has been clearly anticipated by both the Spondite and Vitrex products and by the prior patents above referred to.

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The evidence of Dr. Mueller confirms and corroborates this necessary conclusion. Indeed, when the defendant's first manufactured their product according to their patent, they found, in the language used at trial, that the product was unfit for exterior use to make it commercially successful,—just the criticism offered on behalf of the defendant to the patents of the prior art and to Spondite and Vitrex.

What did then happen? The defendants realizing that their product—alike the product of the prior art—had a very limited length of life for exterior use, devised a new *preparation*, a new formula, and ceased to manufacture according to their patent which is and was absolutely anticipated by the prior art. This is further confirmed by Dr. Mueller's evidence when he affirms that they use now a secret process, being a formula "*respecting the exact names of the ingredients.*"

The defendants' patent has on its very face, compared with the prior art, been clearly anticipated. There is no evidence establishing that exhibit D is the product manufactured by the defendants under their patent or under their secret process. Under their patent they would produce nothing else but what was produced under the prior art. The specifications (at p. 7) called for the width of the meshes of ten to the inch; but exhibit D has 14 meshes to the inch, making the fabric stronger and the meshes to fill smaller and more numerous, thereby making the fabric or reticular metallic base stronger; but this degree of strength resulting from this departure does not *per se* amount to invention as compared to meshes of a smaller or larger width. Spondite is weaker because of a weaker reticular metallic base and with larger meshes.

Apart from the issue of invalidity based upon anticipation, as raised by the pleadings, the patent should also be impeached upon the question of subject-matter. Indeed the questions of anticipation and subject-matter are so much bound up together that it seems impossible to deal with one without touching the other. (*Pope Appliances Corporation v. Spanish River Pulp and Paper Mills* (1)).

Under the provisions of section 14 of The Patent Act (13-14 Geo. V, Ch. 23) the patentee must correctly and fully describe his invention and its operation. It shall set

(1) (1929) A.C. 269, at p. 275.

forth clearly the various steps in a process, or the method of construction, making or *compounding* . . . or *composition of matter*.

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Under section 7 of the same Act, a patent may be granted to a person who has invented something new, not known or used by any other person before his invention, etc., etc.

The application of old devices to a similar and and analogous subject, with no change of application and no result substantially distinct in its nature, will not sustain a patent, even if the new form of result has not been contemplated. *Blake v. San Francisco* (1); *The Northern Shirt Co. v. Clark* (2), and confirmed on appeal to Supreme Court of Canada (2).

The device exhibit D consists, at its best, in nothing else than using a stiffer fabric under its secret process with closer warp and woof stand of 14 meshes to the inch instead of 10 meshes to the inch as mentioned in the defendant's specifications. Even if the article placed upon the market were better than a previous article, it would not amount to invention and would, in this case, be the result of their undisclosed secret process not mentioned in the patent and which perhaps is the result of using a stiffer material with closer meshes.

It may, however, be said that there is even no invention in a mere adaptation of an idea in a well known manner for a well known purpose, without ingenuity, though the adaptation effects an improvement which may supplant an article already on the market. Exhibit D would, however, seem to have been anticipated, whether produced under the Patent or not. *Carter v. Leyson* (3).

Upon the enquiry as to whether or not the patent is good or bad, 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 he might see fit to produce under a secret process outside and foreign to the patent.

A patent for the mere new use of a known contrivance, without any additional ingenuity is overcoming fresh difficulties, is bad, and cannot be supported. If the new use involves no in-

(1) (1885) 113 U.S.R. 679, at p. 682. (2) (1917) 17 Ex. C.R. 273; (1917) 57 S.C.R. 607. (3) (1902) 19 R.P.C. 473.

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genuity, but is in *manner and purposes analogous* to the old use, although not quite the same, there is no invention.

as said by Lord Lindley, in the case of *Gadd and Mason v. The Mayor, etc. of Manchester* (1).

The specification of the defendant's patent ends by this clause:—

While our invention has been set forth in several modifications, it will be understood that others may be made by those skilled in the art without departing from the spirit and scope thereof. For example other compositions or lacquer (and the kind of plasticizers in these products not being defined and is not claimed) may be found for coating the fabric or material other than those suggested and because of their inherent properties. will be especially valuable for such use.—but *all such modifications are desired to be regarded as contemplated by the invention as defined in the appended claims.*

This clause, as it will be readily realized, takes in all the prior art. It is a blanket claim. It is too wide and vague in view of the prior art and also fails in that respect to comply with the statute. A claim to every mode of carrying a principle into effect amounts to a claim to the principle itself and is thereby bad. *Neilson v. Harford* (2); *Automatic Weighing Machine Co. v. Knight* (3).

The patentee cannot and must not throw the net so wide; but he must limit his claims to what he contends he might have invented and no more. This clause contains the mere subject of his speculations in his endeavour to grasp more than that to which he is entitled: what he only dimly and not clearly conceived and all the prior art. The public must know what they can infringe. *Incandescent Lamp Patent* (4); *Tyler v. Boston* (5); *British Thompson-Houston Co. Ltd. v. Corona Lamp Works Ltd.* (6); *British Vacuum Case* (7). There is no new element entering into the production of this product as compared with the prior art. Terrell on Patents 5th Ed. 38; Nicolas on Patent Law, 23, and cases therein cited. *Yates v. Great Western Ry. Co.* (8). The patentee must define and limit with precision what he claims he has invented, as distinguished from the prior art.

Under our patent law a patent is granted as a reward for invention, whereby restraint upon commercial freedom in

(1) (1892) 9 R.P.C. 516, at p. 524.

(2) (1841) 1 Web. P.C. 328, at p. 355.

(3) (1889) 6 R.P.C. 297, at p. 308.

(4) (1895) 159 U.S. 465 at 475.

(5) (1868) 7 Wall 327,330 (74 U.S.).

(6) (1922) 39 R.P.C. 49.

(7) (1911) 29 R.P.C. 309.

(8) (1877) 2 A.R. (Ont.) 226.

respect of the use of the patented invention necessarily results; and a court cannot be too careful in insisting that the requirements of the law in respect of the same have been duly satisfied and guard against allowing any restraint of trade resulting from a patent without merit and clearly anticipated.

Having regard to the prior art and looking to what was known and published at the date of the defendant's patent, I must find that the patent has been anticipated; that he has invented nothing and that there is no subject-matter where invention is wanting. All of the defendant's patent is to be found in the prior art. Its invalidity has been established beyond all question.

There will be judgment in favour of the plaintiff declaring the Canadian Patent No. 270,927, bearing date the 24th May, 1927, null and void. The whole with costs against the defendant.

Judgment accordingly.

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