

BETWEEN:

WILLIAM A WRIGHT & CHALON E. }  
CORSON ..... } PLAINTIFFS;

1925  
Feb. 24.

AND

BRAKE SERVICE LIMITED.....DEFENDANT.

*Patents—Invention—Combination—Equivalency—Patentability.*

*Held:* That in regard to combination patents, if a new combination or arrangement of known elements produces a new combination, or if it forms a new machine of distinct character or formation due to the co-operative action of all the elements, or if the several elements produce a new and useful result, or an old result in a cheaper or entirely advantageous way, such combination shows invention and may be the subject of a patent.

- 2. That invention is not capable of exact definition and is always a question of fact. That, *inter alia*, the fact that skilled workmen have failed to produce it or that it satisfied a long-felt want, are important facts in the determination of whether or not there was invention.
- 3. That a device constructed on the same principle, having the same mode of operation and accomplishing the same results as another, by the same means or by equivalent means, is the same device; and one cannot escape infringement by adding to or subtracting from a patented device or machine by changing its form or making it more or less efficient, while retaining its principle mode of operation.

ACTION to have it declared that the defendant is infringing the patent referred to in the statement of claim; and counter-claim to have plaintiffs' patent annulled.

Ottawa, December 15, A.D. 1924.

Action now heard before the Honourable Mr. Justice Maclean, President of the Court.

*R. S. Smart* and *J. L. McDougall* for plaintiffs.

*W. L. Scott K.C.* for defendant.

The facts are stated in the reasons for judgment.

MACLEAN J., now this 24th day of February, A.D. 1925, delivered judgment (1).

(1) NOTE:—See "Memorandum" to this volume.

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This is an action for infringement of a Canadian Patent granted to the plaintiffs on June 26, 1923, the patent being for improvements in methods and mechanism for drilling and applying brake band linings. The plaintiffs do not seriously allege infringement of all the claims of their patent, but only in respect of claims 1, 2, 3, and 4, and have disclaimed from the scope of claims 3 and 4, any drilling mechanism not used for the application of brake linings to brake bands. The defendant pleads the usual defence.

The purpose of the patent is to apply a lining to a curved apertured brake band by mechanical means. The important element disclosed in the patent is a drill in a rotatable tool holder, having a cylindrical portion for drilling a hole for a rivet, and a tapered portion for countersinking, and all in the same operation. In actual operation the drill operates upwards through the lining, until it reaches the hole in the brake band. The first part of the drill makes a round hole for the rivet, the latter part does the countersinking so as to enable the head of the rivet to be sunk well below the surface of the lining so that it will not come in contact with any hard surface when the brake band is being applied. The band with the lining inside in the workman's hands rests on a lever, the end of which is bifurcated so that it may straddle the tool, and which has a spring which normally elevates the lever. The principal function of the lever is to give the operator a steadier and better control of the work while he presses it downwards to engage the drill, and while drilling the hole in the lining. When the hole is drilled, the lever returns to its original position, and other holes are subsequently drilled in the same manner. It being important that the countersinking be sufficiently deep as to depress the head of the rivet below the surface of the lining, and yet not so far as to leave an insufficient thickness of the lining with which to firmly hold the rivet, a screw, which is adjustable, limits the downward movement of the lever, thus limiting and controlling the penetration of the countersinking tool. In applying a new lining to a brake band the lining is of course, without holes, but the band has, and as the drilling of the lining commences on the blind side, or from its face opposite the band, it is obviously important and necessary that the holes drilled on the blind side shall be in exact registration with the

holes in the band. To provide for this the mechanism has an aligning device, a pointer or finger, which is always in alignment with the drill and if the drill is in line with the pointer on the band side, the drill would necessarily be in line with the hole on the lining side. The mechanism is contained in a frame, and there is the necessary shafting gearing, etc., to drive the same by motor.

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It might be convenient here to say that in the lining of brake bands for use, say in automobiles, up to the time of Wright and Corson the same were usually applied by hand. The lining is usually of fine brass or copper wire with asbestos spun around the wire, and then woven into a fabric, and is not easily drilled. In applying the lining it was the usual practice to bore the hole in the lining from the outside of the brake band, that is to say by first going through the hole in the brake band and then through the lining. The countersinking was done with another tool and was a second operation, and while usually done manually it might also be done by a power countersinking drill. It is admitted that all the elements of the mechanism are old, but it is claimed they have been brought together in a new combination, and by which linings may be applied to brake bands. It is conceded also that such a machine facilitates such an operation. Manually, it requires according to the evidence, from an hour and a half to two hours and a quarter, to do what is done on Wright and Corson machine in from twenty to thirty minutes. It is also conceded that the workmanship is much superior to that manually performed.

The defendant's machine has a drilling and countersinking tool similar to that used in Wright and Corson. It has an adjustable plate which limits the degree of penetration. There is a gauge brake which determines the location of the hole inwards from the rim. If the hole in the brake band is one-half inch in from the rim, the gauge plate is adjusted so that there will be half an inch from the rim of the gauge plate to the point of the drill. This enables the operator to align the hole in the band with the tool. There is a vertical rib or line on the gauge plate, which permits the tool to be sighted by the operator. Then, the band may be placed against the gauge plate which would enable the operator to steady the brake band while in his hand during the drilling process. The defendant contends

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that this is not done in actual practice by experienced workmen. The machine operates in much the same way as Wright and Corson.

The plaintiffs' mechanism, if patentable, is a combination, as distinguished from a simple patent. According to long established principles, a combination may be composed of elements wholly new or wholly old, or partly new and partly old. In each case the combination is a means distinct from the elements, whether new or old. It is an instrument or operation, formed by uniting two or more subordinate instruments or operations, in a new idea of means. It is the combination of individual functions, so as to constitute a common function. A combination in a mechanism must consist of distinct mechanical parts, having some relation to each other, and each having some function in the organism. When these elements are so united that by their reciprocal influence upon each other, and by the joint and co-operating action of all the elements with respect to the work to be done, or in furtherance thereof, new or additional results are obtained, the union is a true combination. Altogether the authorities seem to support the proposition, that if in a new combination, an arrangement of known elements produces a new combination, or if it forms a new machine of distinct character or formation due to the co-operative action of all the elements, or if the several elements produce a new and useful result or an old result in a cheaper or entirely advantageous way, this is evidence of invention and fit subject matter for a patent.

The statute grants a patent to any person who invents a "new machine." Upon the evidence presented, novelty, which is the conventional name of "new" as used in the statute, has not been negatived. The plaintiffs' machine was a new one, when the patent was applied for, according to the evidence produced at the trial. There is no evidence of anticipation. There can be no question as to the usefulness and utility of the machine. For many years the lining of brake bands, prior to the plaintiffs' machine, was performed by hand. The time required in applying the lining to a brake band, with the plaintiffs' machine, is conceded to be enormously less, and with an improved quality of workmanship. If there has been a want for a long time, the satisfaction of that want should go a long way to show

invention. The machine is also compact and quite portable, which is also a valuable feature. Altogether there can be no doubt as to the usefulness and utility of the machine. This is proven by the reception it has received from the public. Its merit is that it does its work with speed, accuracy and quality.

There may of course be novelty and utility without invention. The statute requires that there be invention. The amount of ingenuity required to grant a patent is called invention. Invention is hardly capable of exact definition, and is always a question of fact. It is usual to settle the point by negative rules, which operate by a process of exclusion. For instance it is not invention, if there be evidence that skilled workmen could effect the invention in question, without difficulty, whenever required to effectuate the same. The fact that skilled workmen have failed to produce it, is proof of ingenuity, or at least affords very strong evidence of it. If there has been a want for a long time, the satisfaction of that want, should go a long way to show invention. Again this is not a case I think, where the doctrine of equivalency can be urged. It is clearly not a case where the mechanism is a mere aggregation, and I do not think that exception need be discussed. I quite confess that my first impression of the mechanism was, that it did not represent invention, and it may be that it is quite near the border line. But considering the immediate demand for such a machine, its conceded usefulness and utility, and there not being so far as I know, any established principle or rule, applicable to combination patents, which would exclude it as fit subject matter for a grant, I have after careful consideration reached the conclusion that the patent represents invention. Patent rights are intended as the reward for the introduction of a new machine, etc. True the elements are old, and perhaps it did not require much ingenuity to place them together. But, as Mersey L.J. observed in *British Vacuum Cleaner Co. v. London and S.W. Railway Co.* (1) not only are the elements placed side by side, but they are fitted and worked together in combination, in such a manner as to produce one machine which is both novel and useful. The combination does its work well and the machine is admittedly a practical suc-

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(1) [1912] 29 R.P.C. 309, at p. 333.

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cess, and is capable of achieving an end in a more advantageous way than was known prior to the invention. It has developed fresh advantages and overcome disadvantages. Invention lies not only in the competent use of the parts but in the appropriate advantages of adaptation for such uses. In the case of combination patents, the ingenuity disclosed is to be found altogether in the idea of putting old elements together, and even though it may require no great exercise of the inventive faculty, *Vickers Son & Co. v. Siddell* (1) I am therefore of the opinion that the plaintiffs' patent is valid.

One who claims a patent for a new machine thereby necessarily claims and secures a patent for every mechanical equivalent of that device, because within the meaning of the patent law every mechanical equivalent of a device is the same thing as the device itself. A device which is constructed on the same principle, which has the same mode of operation, and which accomplishes the same results as another by the same means or by equivalent means, is the same device. One cannot escape infringement by adding to or subtracting from a patented device or machine by changing its form, or making it more or less efficient, while he retains its principle and mode of operation. There is a wealth of authority for this proposition. That the idea, principle, and mode of operation of defendant's machine or mechanism is the same as Wright and Corson is particularly clear and not open to serious discussion. One has only to see the both machines to be convinced of this. The variants are such that any mechanic might have devised and adopted. The president of the defendant company, manufacturers of the defendant's machine, was once in the employ of the plaintiffs as a salesman, and in that capacity sold the plaintiff's machine. After leaving them, he decided to make and sell a brake lining machine, and ultimately developed and manufactured the machine now sold by the defendant company. In his evidence, Mr. Davis admitted that he got from Wright and Corson the idea of having the drill press upside down so that the drill came from the bottom instead of from the top. I have no hesitancy whatever in finding that the defendant's machine is the mechanical equivalent of Wright and Corson.

(1) [1890] 7 R.P.C. 292, at p. 304 et seq.

Accordingly, I find the defendant has infringed the plaintiffs' patent and the plaintiffs are entitled to the usual judgment in the case of infringement. The plaintiffs shall have their costs.

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*Judgment accordingly.*

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