

IN THE MATTER OF AN APPLICATION FOR LETTERS
PATENT.1918
Oct. 9.

LAVERS' HEELS PATENTS, LTD.,

APPELLANT.

Patent—Issue—Validity—Combination—Subject matter—Prior art.

The issuing of a patent does not make it conclusive or binding upon a litigant who questions its validity.

2. An application for a combination patent should not be refused on the ground that the subject matter is a combination of various separate elements, all of which are in existing patents, provided such elements are brought together in such a way as to be useful.

A PPEAL from a decision of the Patent Office rejecting an application for a patent.

Tried before the Honourable Mr. Justice Cassels, at Ottawa, October 9, 1918.

R. S. Smart, for appellants.

The Commissioner of Patents was not represented by counsel.

CASSELS, J. (October 9, 1918) delivered judgment.

Under the *Patent Act*, Revised Statutes of Canada, 1906, ch. 69, it was provided by sections 17 and 18 as follows:

“17. The Commissioner may object to grant a patent in any of the following cases:

“(a) When he is of opinion that the alleged invention is not patentable in law.

“(b) When it appears to him that the invention is already in the possession of the public, with the consent or allowance of the inventor;

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“(c) When it appears to him that there is no
“novelty in the invention;

“(d) When it appears to him that the invention
“has been described in a book or other printed pub-
“lication before the date of the application, or is
“otherwise in the possession of the public;

“(e) When it appears to him that the invention
“has already been patented in Canada, unless the
“Commissioner has doubts as to whether the pat-
“entee or the applicant is the first inventor;

“(f) When it appears to him that the invention
“has already been patented in a foreign country,
“and the year has not expired within which the for-
“eign patentee may apply for a patent in Canada,
“unless the Commissioner has doubts as to whether
“the foreign patentee or the applicant is the first
“inventor.

“18. Whenever the Commissioner objects to grant
“a patent as aforesaid, he shall notify the applicant
“to that effect and shall state the ground or reason
“therefor, with sufficient detail to enable the appli-
“cant to answer if he can the objection of the Com-
“missioner.”

By a statute passed by the Dominion Parliament
in the year 1913, ch. 17, it is provided as follows:

“1. The *Exchequer Court Act*, chapter 140 of the
“Revised Statutes, 1906, is amended by adding the
“following section immediately after section 23:

“23A. Every applicant for a patent under the
“*Patent Act* who has failed to obtain a patent by rea-
“son of the objection of the Commissioner of Pat-
“ents as in the said Act provided, may, at any time
“within six months after notice thereof has been
“mailed, by registered letter, addressed to him or

“his agent, appeal from the decision of the said
“Commissioner to the Exchequer Court.

“2. The Exchequer Court shall have exclusive
“jurisdiction to hear and determine any such ap-
“peal.

“3. The Exchequer Court shall have exclusive
“jurisdiction to hear and determine any now pend-
“ing appeals to the Governor-in-Council under sec-
“tion 19 of the *Patent Act*, and the Governor-in-
“Council shall transfer the said appeals and all
“documents and proceedings relating thereto to the
“Exchequer Court.”

The applicant for two patents, C. W. Lavers, peti-
tioned for a patent which is called serial No. 191,227
and the other serial No. 191,228.

After a long and protracted procedure in the Pat-
ent Office the application was finally rejected by the
examiner, and his decision being adopted by the
Commissioner, the applicant appeals to this Court
under the provisions of the statute hereinbefore
quoted.

The Commissioner was duly notified of the appeal
but did not appear on the hearing of the appeal.

Mr. Smart appeared for the petitioner, and urged
his case from the point of view of the applicant for
the patent. The Court received no assistance from
the Commissioner, with the result that an enormous
number of alleged anticipations have been waded
through by the Judge, unaided by any assistance or
help from the Patent Office.

If applications by way of appeal become numer-
ous in this Court, so much time will be required on
the part of the Judge to delve into all of these prior
patents that practically the time of one Judge would
be occupied as an appellate examiner from the Pat-

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ent Office. I do not think it is fair that such a burden should be cast upon the judiciary.

If the Patent Office take upon themselves to reject the applicant's claim for a patent, it seems to me that they should afford the Judge the assistance of counsel to sustain their findings, and that the matter should not be left to the Judge to grope through a long lengthy file and any number of previous patents unaided.

Under the circumstances of the case I have done the best I could. At the same time I feel that I may not be doing exact justice. It has to be borne in mind that the mere issuing of a patent does not make the patent conclusive or binding upon a litigant who desires to raise the question as to its invalidity; and therefore, if in reversing a decision of the Commissioner, as I intend to do, I feel that if I have erred, nobody is much hurt, as anyone will have the right to protest the validity of the patent in any other proceeding.

It is a matter of common knowledge that a large number of patents for invention issued by the Department have in litigated cases been declared by the Courts to be null and void, either because the so-called patents lacked the essentials of patentability or on account of the prior state of the art, etc. Every Judge, I think, is familiar with this proposition. I think that the examiner has erred in not granting the patent in the case before me.

Dealing first with the application for a patent, serial No. 191,227. The claim put forward is for a very strict construction patent. It is a very narrow patent, but nevertheless I cannot agree with the examiner in his reasons for disallowing the claim.

The first claim of the patent is as follows:

“A detachable heel of flexible, resilient, plastic material, having a plurality of recesses on its inner face or contact for the purpose of moulding the heel properly and permitting the entry afterwards of domed, headed pins for attachment, with a plurality of separated locking independent washers, embedded therein at the bottom of said recesses, permitting such heel to slide laterally into the locking position.”

The subsequent claims of the patent are mere structural modifications. Probably some of them lack patentability. I have not gone into them, as I do not think it is of much consequence if the patentee is entitled to the main claim.

On April 3, 1918, a letter is written signed by Thomas L. A. Richard, patent examiner, addressed to Messrs. Fetherstonhaugh & Co., Ottawa, the attorneys for the applicant. Mr. Richard states that: “The heel forming the subject matter of this application is built up of various separate elements each found in the prior art as disclosed in the references of record.”

He refers to certain patents, and then states: “All the references previously cited and mentioned in this case are shown to disclose all the features of construction of applicant’s device, and they are retained on record for the purpose of anticipations of the general structure as well as of details thereof.”

“2. From the foregoing it is seen that none of the features of applicant’s structure is novel *per se*, each and every one is found in one or the other of the references of record.

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“All the things united in this heel being old and
“not performing any joint function, each doing only
“what it has formerly done in former heels, their
“adaptation to this heel does not constitute a pro-
“per combination and amounts merely to aggrega-
“tion not involving invention.”

I cannot agree with this statement of the law. In nearly all combination patents the claim is for a combination of old elements. It is no answer to a claim for a combination that one element may be found in a prior patent, another element in another patent, etc. If the elements are brought together in such a way as to be useful, and a combination is produced entitling the applicant to a patent, I do not see that it is any answer to wade through a series of patents and to state that each of the elements can be traced in other previous patents. Unless there has been a disclosure of a similar combination the combination would be good assuming it to have the essentials requisite to a valid patent. To call it an aggregation is to my mind incorrect.

For instance, take the dome-headed pins. Unquestionably these pins perform their ordinary function, but if you remove them from the combination what happens? The whole thing falls to pieces.

It may well be that some of the subordinate claims lack the elements of a proper combination having regard to Mr. Richard's view and his citations. I leave it open to the Commissioner to reject, if so advised, any of these subsequent sub-combinations. All I direct is that the patent shall issue with the first claim.

I may add my opinion that I do not see that much harm would be occasioned by allowing it to issue with these subsequent claims. The patentee would

take them at his risk, and if properly advised would not jeopardize by inserting a lot of useless sub-claims.

In regard to the application for patent serial No. 191,228, Claim Number 1 reads as follows:

"1. In combination with a boot or shoe having a
 "permanent heel, a base plate thereon and a plurality
 "of headed domed pins, extending through the base
 "plate, such pins being formed with shoulders adapt-
 "ed to bear against the base plate and retain the
 "same in position, a detachable heel of flexible, re-
 "silient, plastic material having a plate embedded
 "therein formed with slots to engage slideably the
 "headed pins, and locking means extending between
 "the permanent heel and the detachable portion."

It is unnecessary to repeat what I have stated in regard to the previous application. Practically the same remarks apply to Mr. Richard's letter of April 3, 1918.

I think the patent should issue for the first claim of this patent, leaving it open to the Commissioner whether to grant or reject the sub-combination claims.

There will be no costs of these applications.

Solicitors for appellant: *Fetherstonhaugh & Co.*

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