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 *Mar. 20, 21.
 *Nov. 16.

THOMAS HUNTER (PLAINTIFF) APPELLANT ;

AND

MARGARET ANN CARRICK (DE- }
 FENDANT) } RESPONDENT

ON APPEAL FROM THE COURT OF APPEAL FOR ONTARIO.

Patent—Infringement of—Combination—New Result.

H. obtained a patent for an oven, claiming to have discovered a way of building the same so as to economise fuel; the patent consisted of a combination of five parts, none of which were claimed to be new, the alleged invention consisting merely of the result.

Held, affirming the judgment of the Court of Appeal, Strong J. dissenting, that the combination, being a mere aggregation of parts not in themselves patentable, and producing no new result due to the combination itself, was no invention, and consequently it could not form the subject of a patent.

APPEAL from a decision of the Court of Appeal for Ontario (1) setting aside a verdict for appellant (plaintiff below). In August, 1880, the appellant applied for and obtained a patent for a baker's oven (a patent having been previously granted to him, the specifications for which he had discovered to be defective) the object of which, as stated in the specification, was to economize fuel and allow the fire to be kept in the oven during the whole process of baking. The improvement for which the patent was applied for was stated to consist in placing a fire-pot within the oven but below the sole. Separate doors and dampers were provided for the fire-pot, and it was so arranged that it could be fed with coal during the whole process of baking.

*PRESENT.—Sir W. J. Ritchie C.J., and Strong, Fournier, Henry and Taschereau JJ.

(1) 10 Ont. App. R. 449.

The appellant stated in his evidence that what he claimed as his invention was as follows:—

1. A fire-pot or furnace placed within a baker's oven below the sole thereof, and provided with a door situated above the grate.

2. A fire-pot or furnace placed within a baker's oven, provided with a door above the level of the sole of the oven, and connected to the said furnace by an inclined guide.

3. In a baker's oven, a flue leading from below the grate to the main flue.

4. A baker's oven provided with a circular tilting grate, situated below the sole of the oven and provided with a door.

5. In a baker's oven, a cinder grate placed beneath the fire grate, in combination with a flue leading from below the grate to the main flue.

And in his specification he said: "What I claim as my invention is: In combination with a baker's oven, a furnace set within the oven but below the sole."

The Respondent, who carried on a bakery business in Toronto, having had occasion to build a new oven in connection with her business, the appellant brought suit against her for an injunction, alleging that such oven was made from the description in the specification for the above patent and was an infringement of the same. The respondent, in her statement of defence, denied that her oven contained the improvements set out in such specification, or any of them, or that it was an infringement of such patent, and the defence was also set up, that appellant's alleged improvements were not new and that the patent was void.

The cause was heard before Proudfoot V. C. who granted the injunction prayed for, and ordered a reference to the master to ascertain the damages sustained by the appellant. The Court of Appeal reversed this

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judgment, the majority of the Court holding that the subject of the appellant's patent was a mere aggregation of parts not new in themselves and producing no new result due to the combination itself, and therefore was not an invention, and, consequently, not patentable.

W. Cassels Q.C. for appellant.

The patent in question was a patent re-issued, and although the elements of it are old, we claim the combination as new. It is the simultaneous action of all the parts working jointly together that creates the result.

The learned counsel then reviewed the evidence, contending that the combination obtained a new result, and relied on the following cases: *Smith v. Goldie* (1), and cases therein cited; *Murray v. Clayton* (2); *Spencer v. Jack* (3).

Christopher Robinson Q.C. and *Dr. McMichael* Q.C. for respondent.

The evidence in this case clearly shows that the patent brought out no new element or factor; that there is neither novelty nor utility in the invention, and that, as a combination, it produces no new results, but is simply an aggregate of separate results. The learned counsel cited and commented on the following cases, *inter alia*. *Harriston v. Anderston Foundry Co.* (4); *Hinks v. Safety Lighting Co.* (5); *Adie v. Clark* (6); *Pickering v. McCullough* (7); *Cropper v. Smith* (8).

W. Cassels Q.C. in reply cited:

Otto v. Linford (9); *Fay v. Cordesman* (10).

Sir W. J. RITCHIE C.J.—(After stating the particulars

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| (1) 9 Can. S. C. R. 46. | (6) 3 Ch. D. 134. |
| (2) L. R. 7 Ch. App. 570. | (7) 104 U. S. R. 310. |
| (3) 2 L. T. N. S. 242. | (8) 26 Ch. D. 704. |
| (4) 1 App. Cases 574. | (9) 46 L. T. N. S. 35. |
| (5) 4 Ch. D. 612. | (10) 109 U. S. R. 468. |

of the alleged invention, and referring to the judgments of the court below.)

I agree with the majority of the Court of Appeal that the patent claimed by the plaintiff cannot be supported, and I think the appeal should be dismissed, on the ground that the plaintiff's invention was not properly the subject of a patent for the reasons given by the Court of Appeal.

STRONG J.—The appeal should be allowed with costs and the judgment of the Chancellor restored.

FOURNIER J.—I agree with His Lordship the Chief Justice that the appeal should be dismissed.

HENRY J.—The appellant seeks to recover from the respondent damages for the infringement of a patent right claimed by him under letters patent issued to him on the 26th August, 1880, for what is called "Hunter's Improved Oven." His claim in the specification is: "In combination with a baker's oven a furnace D set within the oven but below the sole A," and the patent right granted is for that combination. He claims nothing for any one or more of the several parts mentioned in the specification, which are employed merely to show the combination, and therefore we are to conclude none of them was new. They are described as follows:—

"In the drawing A is the sole of the oven; B its door, and C the raising over; in none of these do I claim anything peculiar, but instead of making the fire on the sole A, as is customary, I construct a fire-pot or furnace D within the oven, the grate E being below the level of the sole A. The fuel is fed through the door E, which can be made in any usual way; G is a cinder grate, either perforated as shown, or in any other form thought most desirable; an ash pit H, completes the furnace. The flues in the oven are of the usual kind, but in addition to that I make a special flue beneath the grate E, which is connected with the main flue of the oven E in any suitable manner; this flue has naturally a tendency to check the fire, and may be provided with dampers similar to those placed in the

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other flues. As is well known to those familiar with baker's ovens, a fire is made in the sole, and when the required temperature is obtained it is withdrawn, and the bread or other article to be baked inserted."

Henry, J. The respondent pleaded, amongst other things, as follows :

2. In answer to the fourth paragraph of the said bill I admit that I have lately built a new oven, but I deny that such oven contains the improvements claimed by the plaintiff in his patent in the said bill referred to, or any of them, or that my oven is an infringement upon the alleged patent of the plaintiff.

5. I am informed and believe, and charge the fact to be, that the means of heating ovens claimed by the plaintiff in his patent have been in public use in this Dominion for many years prior to the plaintiff's patent, and that there was and is no novelty and improvement on any other invention in the plaintiff's alleged invention.

6. I submit that there was not, prior to or at the date of the said patent, any novelty in the plaintiff's alleged invention, and that the same was not, nor was any part thereof, a new or useful invention or improvement upon a prior invention within the meaning of "The Patent Act of 1872." And that the improvements claimed by the plaintiff in his said patent are trifling and insignificant, and that the said alleged invention of the said plaintiff is not, and was not the subject of a patent, and could not be patented. And I further submit that the said patent is invalid and void.

7. I submit that the specifications filed by the plaintiff on his application for the said patent do not clearly and distinctly state the contrivances and things which the plaintiff claimed as new, and for which he obtained the said patent, and that they claim more than the said plaintiff could in any event obtain a patent for, and I therefore submit that the said patent is void.

8. I also submit that the said patent is void, because the same includes as new a contrivance which was, I believe, and charge the fact to be, well known and publicly used prior to the plaintiff's said patent.

The pleas therefore, put in issue all that was necessary to entitle the respondent to deny the infringement of the appellant's rights under the patent, and also to contest its validity.

By the evidence it is shown that all the combinations were used before the issue of the patent, except per-

haps, one flue which is referred to in the specifications as before shown, and is as follows :—

“The flues in the oven are of the usual kind, but in addition to that I make a special flue beneath the grate E, which is connected with the main flue of the oven in any suitable manner ; this flue has, naturally, a tendency to check the fire, and may be provided with dampers similar to those placed in the other flues.”

It will be observed on referring to the patent and specifications, that the first does not grant, and the latter does not claim, any right for the combination of the flue in question. They are both limited to a combination of “a furnace D set within the oven below the sole A.” The erection therefore, of such a flue by the respondent, would have been no infringement of the patent right, and it is shown also that in the erection of the oven by her no such flue was constructed and therefore there could be no infringement of the right. The evidence establishes the fact, to my mind very conclusively, that the combination claimed by the appellant was not new when he obtained his patent, and that furnaces set within the oven and below the sole had previously been made and used.

I am therefore of opinion that the appeal should be dismissed and the judgment of the court below affirmed with costs.

TASCHEREAU J. concurred with Ritchie C. J.

Appeal dismissed with costs.

Solicitors for appellant : *Blake, Kerr, Lash & Cassels.*

Solicitors for respondent : *McMichael, Hoskin & Ogden.*

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