

1955

\*Mar. 29, 30

\*May 24

SCULLY SIGNAL COMPANY ..... APPELLANT;

AND

YORK MACHINE COMPANY LIMITED . RESPONDENT.

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

*Patents—Infringement—Claims—Language of claims differing from that of specification—Applicability of doctrine of mechanical equivalents.*

\*PRESENT: Kerwin C.J. and Rand, Estey, Cartwright and Abbott JJ.

The appellant, owner of the Canadian patent to a signal device known as a liquid level indicator, designed for indicating the liquid level in fuel tanks, claimed the purpose of its invention was to provide a continuous audible signal until the liquid introduced into a tank reached a predetermined level, and that it accomplished this by a whistle which commenced to operate as soon as the liquid was introduced and continued until the latter reached a point predetermined by the extension of a tube into the tank. The whistle was stopped by the trapping of the lower end of the tube by the rising liquid. The respondent's device was designed for the same purpose and the audible device was also provided by means of a whistle but the vented gas went from the tank directly to the opening in the whistle. No dependent tube was used and the whistle was stopped by means of a cork suspended below the level of a casing by a rod. The rising liquid caused the cork and the rod to float upward until it covered the lower opening in the whistle and thus shut off the sound. In the Exchequer Court, Cameron J. held that the dependent tube constituted an integral and essential part of the appellant's invention; that the doctrine of mechanical equivalents did not apply and that the appellant had failed to establish an infringement.

*Held:* (Rand J. dissenting) that for the reasons given by the trial judge, the appeal should be dismissed.

*Per* Estey J. Throughout the appellant contended that a dependent tube projecting into the fuel tank was not an essential part of its invention and that, as in all other essentials the respective inventions were identical, an infringement had been effected. Upon the evidence it would seem that in any practical sense the dependent tube was essential to the efficient operation of the invention. A reading of the specification as a whole not only did not suggest any alternative meaning but in fact, supported the finding of the trial judge that "a second vent passage of smaller capacity" in claim 9 meant the dependent tube.

*Per* Rand J. (dissenting)—Although only the tube that extended into the tank was described as the means of signalling the required level, that circumstance could not be taken as intending to embody the tube as the essential means of the device for that purpose. The tube or the float being obviously means of completing the purpose of the invention, the latter as defined in claim 9 was infringed. The tube not being an essential element in the combination, the use of the float was that of a mechanical equivalent.

APPEAL from a judgment of the Exchequer Court of Canada, Cameron J. (1) dismissing the appellant's action for infringement of a patent. Affirmed.

*Christopher Robinson, Q.C.* for the appellant.

*G. F. Henderson, Q.C.* for the respondent.

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The judgment of Kerwin C.J. and of Abbott J. was delivered by:—

THE CHIEF JUSTICE:—For the reasons given by the trial judge this appeal should be dismissed with costs.

RAND J. (dissenting):—The patent in this appeal is an uncomplicated device for signalling the desired level of liquids in the course of filling closed receptacles. It has its most prominent use today in delivering fuel oil from trucks to tanks set up inside homes or other premises.

The device consists of an open casing of ample diameter for venting purposes, threaded into the tank. It is shaped at the bottom to provide a seat ordinarily engaged by a hollow hemispherical valve which, by being lifted, vents abnormal air pressure within the tank. In what the inventor considered its most effective form, through a small passage at the base of the valve a tube is introduced projecting downward into the tank, the upper end attaching to a whistling contrivance within the valve. The tube is of sufficient size to allow the escape of air under normal pressure while the tank is being filled. This escape causes the whistle to sound and it continues until the flow of air through the tube is cut off. This takes place when the rising oil traps the lower end of the tube at the predetermined level fixed by the depth of the tube in the tank. The smaller air passage is, until so trapped, at all times open to the air.

It would at once be appreciated by a person competent to deal with the contrivance that the essence of what the inventor has given to the public is the combination of the two means of venting the air under different pressures coupled with the signal automatically given when the determined level is reached by closing the smaller vent through action exerted by the rising oil itself.

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The respondent is charged with infringing this mechanism by another which as to valve and whistle is indistinguishable but which, for the purpose of announcing the required liquid level, makes use of a float reaching to the aperture of the lower whistle plate by means of a rod with a small flat cap sufficient to close it and consequently to stop the whistle signal. It is the substitution of this float for the tube which the respondent relies on to justify his device.

In both cases the closure of the vent leading to the whistle is effected by the rising liquid: in one case directly by trapping the lower end of the tube; in the other by trapping what is in reality the upper end of the tube. It is obvious that the tube can be of any length to meet any liquid level from the base of the valve downwards, and what both the tube and the float accomplish is the closure of the whistle vent by the action of the liquid.

The specification gives what I take to be a full and clear statement of that invention and the manner in which it can be carried into use. Although only the tube extended into the tank is described as the means of signalling the required level, I cannot take that circumstance as intending to embody the tube as the essential means of the device for that purpose. As the inventor stated in his evidence, the float was not only familiar and in fact, to one of the slightest mechanical knowledge, an obvious means for utilizing the liquid level, but it was tried out by him and rejected as inefficient. The tube represented what, in his opinion, was the best means; but it was a connecting link which could be furnished by another means once its function was appreciated.

The action is based on claim 9:—

In combination with a closed tank for the reception of fluid, a supply conduit leading into the tank, and a combined signal and vent device comprising a casing fixed in an opening in the upper portion of the tank, said casing having therethrough a vent passage of large capacity open at one end into the interior of the tank and open at its other end externally of the tank, a valve normally closing said passage, said valve being constructed and arranged automatically to open and vent the tank in response to abnormal pressure within the tank, means providing a second vent passage of smaller capacity, and an audible signal arranged to be sounded by gaseous fluid escaping through said smaller vent passage, the smaller vent passage and whistle being of such capacity as to vent the tank under normal filling conditions without unduly increasing the pressure in the tank.

Mr. Henderson stresses the phrase "means providing a second vent passage of smaller capacity". Necessarily, he says, this "means" and "passage" must be taken to be the tube, and so Cameron J. has found. But the specific mention of the tube in the other claims and its omission here, as well as the substitution of the word "means", are a clear indication that the terms are not interchangeable. It was said that the word "means" was ambiguous as to the tube or float; but this confirms the limit of the inventive idea: there is no ambiguity as to anything essential.

What is the smaller "passage"? In the assembly given it is the exit for the normal escape of air which is to operate the whistle. It has no necessary length whatever. It must be an opening through the bottom of the valve, but it need be nothing more. As an orifice in the valve it might itself reach into the tank depending on the depth of the casing and the shape of the valve.

The device of the respondent shows a short length, say, 3/16", within the casing as a passage leading to the whistle frame; but the lower plate of the latter could have been the face of the casing and the exit and passage would have been present and equally effective. What is required is a vent through the valve leading the air through the opening of the whistle plate, and the latter would ordinarily determine its size. It is, therefore, of no importance that the rising air be funnelled into the whistle opening by any convergence or fashioning of the casing or by an added tube. Length is not significant: outlet is the necessity. This clearly appears from figure no. 2 on the drawing annexed to the specification.

With that as the pith of the new idea, it was apparent to ordinary observation that the connection between the pre-determined liquid surface and the whistle aperture could be effected by a float as well as by a tube: the mouth of the tube was simply the extended orifice of the valve. There is nothing in either of these links inventive to the purpose in view and it is in that conception that claim 9 is framed. The tube or the float being obvious workable means of completing the purpose of the invention, the latter as defined in claim 9 has been infringed. To express it otherwise, the tube not being an essential element in the combination, the use of the float is that of a mechanical equivalent.

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It was urged that in this interpretation there is no utility where the valve orifice does not extend into the tank. That the closure of the small passage at the inside top of the tank would furnish a signal to a person filling the tank of more use than none at all is, on the evidence, uncontrovertible. But where the feature of the invented device has a continuous range of operative action patent to any one, the fact that the projection downward has a vanishing point is not material to the validity of the obviously more effective range.

It is finally argued that the device was anticipated and a number of specifications have been placed in evidence dating from 1867 to 1922. In none of them are the two essential features here, that is, the valve and the smaller vent through the whistle device, present. They do show the early familiarity with the idea of a whistle signal caused by escaping air before a rising liquid, and of the escape being cut off by the liquid itself as well as by means of a float. But they do not at all reach the requirements of the ground taken.

The combination is not otherwise challenged, and its efficiency has been demonstrated by the extensive market which has been opened to it. It met a widespread demand which, in a simple and ingenious manner, it supplied.

I would, therefore, allow the appeal and direct that the appropriate judgment be entered for the plaintiff in the court below.

ESTEY J.:—I agree with the reasons and conclusions of the learned trial judge and desire to add only a few words with respect to certain points raised at the hearing of this appeal.

Throughout, the appellant has contended that a dependent tube projecting into the fuel tank was not an essential part of its invention and that, as in all other essentials the respective inventions of the appellant and respondent were identical, an infringement had been effected by the respondent. In this appeal counsel particularly stressed that the learned trial judge was in error in not construing Claim 9 as applicable to the invention without the dependent tube. Claim 9 reads: (See p. . . ?)

The learned trial judge, in construing Claim 9, stated:

Nor am I able to find that Claim 9, whether read by itself or with the disclosure, is a claim for the device without the dependent tube. I agree with the submission of counsel for the defendant that the phrases, 'means providing for a second vent passage of smaller capacity' and 'an audible signal arranged to be sounded by a gaseous fluid escaping through said smaller vent passage,' mean the dependent tube and not the openings in the whistle itself.

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The fact is the phrase "dependent tube," though it appears in the disclosure, is not to be found in the Claims, where it is variously referred to as the "vent pipe," "vent tube" or "tube." Moreover, the word "means" appears in Claims 3 and 6, as well as 9. In fact, a reading of the specification discloses that the draftsman was not at pains to use words and phrases with the same meaning. In these circumstances it is not surprising that some difficulty is experienced in ascertaining the meaning of Claim 9. The language of Lord Justice Romer is appropriate:

One may, and one ought to, refer to the body of the Specification for the purpose of ascertaining the meaning of words and phrases used in the Claims or for the purpose of resolving difficulties of construction occasioned by the Claims when read by themselves. *British Hartford-Fairmont Syndicate, Ltd. v. Jackson Bros. (Knottingley) Ltd.*, (1).

See also *The P. & M. Company v. Canada Machinery Corp., Ltd.* (2); *Electrolier Manufacturing Co. Ltd. v. Dominion Manufacturers Ltd.* (3).

The purpose of the invention is to provide an audible signal which shall continuously operate until the liquid level has reached a predetermined point. Once that point is determined the dependent tube is projected into the tank to that point and as such it must be regarded as an essential part of the invention. It was suggested that the invention could be used without any dependent tube. That could only be in the special case where it was intended to fill the tank, in which event it was pointed out the sound of the whistle would diminish or taper off and thus indicate that filling of the tank should cease. Even in this limited application it would be more satisfactory to have some, though a short, dependent tube. Upon the evidence it would seem that in any practical sense the dependent tube is essential to the efficient operation of the invention.

(1) (1932) 49 R.P.C. 495 at 556. (2) [1926] S.C.R. 105 at 114.

(3) [1934] S.C.R. 436 at 440.

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A reading of the specification as a whole not only does not suggest any alternative meaning, but, in fact, supports the finding of the learned trial judge that "a second vent passage of smaller capacity" in Claim 9 means the dependent tube.

The appeal should be dismissed with costs.

CARTWRIGHT J.:—I agree that, for the reasons given by the learned trial judge, this appeal should be dismissed with costs.

*Appeal dismissed with costs.*

Solicitor for the appellant: *R. H. Soffrey.*

Solicitor for the respondent: *Gowling, MacTavish, Osborne & Henderson.*

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