

1932
*May 25.
*June 15.

SAMUEL MAILMAN AND OTHERS } APPELLANTS;
(DEFENDANTS)

AND

GILLETTE SAFETY RAZOR CO. OF } RESPONDENT.
CANADA, LTD. (PLAINTIFF).....

ON APPEAL FROM THE EXCHEQUER COURT OF CANADA

Patent—Validity—Alleged infringement—Subject matter—Nature, scope and purpose of claims in specification.

Respondent had obtained a patent for an improvement in blade holders. According to the specification, the invention was particularly applicable for detachably retaining blades in safety razors and blade stopping mechanism. A particular feature claimed was that a word or symbol, such as a trade-mark, might be outlined in the blade by means of apertures therein and the projection or projections on the holder might be arranged so as to enter one or more of said apertures to retain the blade in the holder. Another feature claimed was that the projections might be formed in the holder at one period to engage certain of the blade apertures and at another period the projections might be located in a position to receive any other of the apertures, thus enabling the manufacturer, by shifting the position of the projections, to preclude the use in the holder of blades produced by an unauthorized manufacturer. Respondent claimed that appellants had infringed the patent by selling blades, with certain positioned apertures, for use in respondent's holder. Respondent relied on, and its action for infringement was confined to, two claims in the specification, which were those having to do with the blade itself.

*PRESENT:—Anglin C.J.C. and Duff, Rinfret, Lamont and Smith JJ.

Held: Respondent's action should be dismissed. Judgment of Maclean J., President of the Exchequer Court of Canada, [1932] Ex. C.R. 54, reversed.

Anglin C.J.C. and Duff J. agreed in the result.

Per Rinfret, Lamont and Smith JJ.: Having regard to what was the sole subject matter in the issue, to the nature and scope of the claims in question, to the evidence, to the characteristics in the blade as presented by the claims, and to the purpose of the blade's design, there was no patentable invention in the blade, the claims in question in regard thereto in the specification were invalid and void, and therefore the present action for infringement did not lie.

The claim, in a specification, being primarily designed for delimitation, the monopoly is confined to what the patentee has claimed as his invention (*British United Shoe Machinery Co. Ltd. v. A. Fussel & Sons Ltd.*, 25 R.P.C. 631, at 650; *Pneumatic Tyre Co. Ltd v. Tubeless Pneumatic Tyre and Capon Heaton, Ltd.*, 15 R.P.C. 236, at 241).

The inventor must in his specification describe in language free from ambiguity the nature of his invention and he must define the precise and exact extent of the exclusive property and privilege which he claims (*French's Complex Ore Reduction Co. v. Electrolytic Zinc Process Co.*, [1930] Can. S.C.R. 462).

The idea of merely impressing a trade-mark in a razor blade by means of apertures in the blade, is not patentable.

A device designed exclusively for the protection of the particular manufacturer lacks utility within the meaning of the patent law and does not amount to invention in the patentable sense.

APPEAL by the defendants from the judgment of Maclean J., President of the Exchequer Court of Canada (1), holding that the plaintiff's patent in question was valid and that the defendants, by selling (as found by Maclean J.) razor blades for use in the plaintiff's blade holder, and containing, besides other apertures, all the apertures contained in the plaintiff's blade, and positioned as in the plaintiff's blade, thus enabling the blades sold by the defendants to be used in the plaintiff's blade holder, had infringed the plaintiff's patent.

The material facts of the case are sufficiently stated in the judgment of Rinfret J. now reported and in the said judgment of Maclean J. appealed from. The appeal was allowed and the action dismissed with costs.

O. M. Biggar K.C. and *M. B. Gordon* for the appellants.

G. F. Henderson K.C. and *E. G. Gowling* for the respondent.

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ANGLIN C.J.C.—I agree in the result of the judgment in this case, but, for want of opportunity to consider and analyze it in detail, cannot commit myself on the various propositions of law which it incidentally enounces.

DUFF J.—I agree in the result.

The judgment of Rinfret, Lamont and Smith JJ. was delivered by

RINFRET J.—The respondents brought action against the appellants, in the Exchequer Court of Canada, for the alleged infringement of certain claims of Canadian letters patent No. 287,676 owned by the respondents. The appellants filed a statement of defence denying infringement and invoking the invalidity of the claims. The court held the patent valid and found it had been infringed by the appellants. (1). Hence the present appeal.

The patent was applied for and granted “for an alleged new and useful improvement in Blade Holders.” In the specification, it is stated that the “invention relates to improvements in blade holders and is particularly applicable for detachably retaining blades in safety razors and blade stropping mechanism.”

One object of the invention is stated to be:

to provide a blade holder provided with one or more projections adapted to co-operate with a corresponding opening or openings in the interior of the blade between its marginal edges to retain the blade in the holder.

A particular feature of my invention is that a word or symbol, such as a Trade-Mark, may be outlined in the blade by means of apertures therein and the said projection or projections on the holder may be arranged in such a manner as to enter one or more of said apertures to retain the blade in the holder for shaving or stropping purposes.

There follows a description of the mechanical device whereby the blade is retained between the members of the holder, and then the specification runs as follows:

A further feature of my invention is that the means that retain the members of the holder together for use are provided with means in position to co-operate with the blade for positioning it in the holder when the members of the holder are separated to receive the blade, which last named means will release the blade when the retaining means is in position to retain the members of the holder against the blade, so that a blade that is not properly provided with apertures for the previously mentioned projections on the holder will not be retained therein for use.

(1) [1932] Ex. C.R. 54.

Reference is then made to the drawings, followed by a minute description of the blade holder and of the blade, of which it is declared that

it is provided with notches or recesses at its ends near the corners adjacent to the heel of the blade opposite its cutting edge, providing projections at the inner corners of the blade which are adapted to be opposed by lugs or projections located upon the inner portions of the arms or latches (attached to the holder) to oppose the blade projections.

(the function of these arms or latches being described);

and in order to retain the blade between said members (of the holder) when clamped against the blade I provide the blade with apertures (indicated) to receive corresponding projections extending inwardly from member 1 (of the holder) * * * The apertures of the blade are shown related in such a manner to one another as to produce a designation, such as a word or symbol. In the example illustrated the symbol DEFGH is shown * * *.

It is stated that, by means of the projections, "the blade will be prevented from sliding."

Another feature of the invention mentioned in the description is that the projections may be formed in the holder at one period to engage certain of the apertures of the blade, whereas at another period the projections may be located in a position to receive any other of the apertures. "By means of (this) arrangement,"

in case an unauthorized manufacturer of the blades should produce blades having apertures that correspond in location to the projections of (the holder) that have been made by the original manufacturer at one period, the latter manufacturer, by shifting the position of the projections * * * at another period would preclude the use in the holder of such unauthorized blades, because the apertures would not register with the last named projections * * *.

The description then goes on to explain how the "improved blade holder is adapted for use in a safety razor" and it winds up in this way:

While I have particularly referred to my invention with utilizing a designation, such as a Trade-Mark, name or symbol in a safety razor blade, it will be understood that my invention is not limited to such use since the designation may be formed by apertures or depressions in any desired member to indicate the manufacture of the same, which apertures or designations are so located with reference to positioning means carried by another member as will cause said members to properly register with respect to each other when the apertures or depressions and the projections are in co-operation.

Having thus described the invention and its operation or use as contemplated by the inventor, the specification ends with thirteen claims, two of which are limited to the

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razor blade, while the balance refers to the blade holder only or to the combination of the blade and the blade holder.

As between the parties, the case was concerned solely with the two claims dealing with the razor blade alone. This was made clear at the trial both by counsel for the respondents and by their expert witnesses. The action was confined exclusively to claims 1 and 2; and, in order to ascertain the exact scope of these claims, it will be preferable to transcribe them verbatim:

1. A razor blade having apertures or depressions in the form of a designation to indicate the manufacture of the said blade, the said apertures or depressions being so shaped and located that they will co-operate with different holders, such holders having sets of projections differing inter se but such that any one of such sets will prevent such razor blade from sliding or turning on the said holder.

2. A variation of the invention claimed in Claim 1 in which the apertures or depressions in the blade are so shaped and located that they will co-operate with different holders, such holders having sets of projections which have some but not all of the projections in common as and for the purposes set out in the first claim.

The only case the appellants were called upon to meet was whether or not the razor blade described in claims 1 and 2 was patentable as a new and useful manufacture and, if so, whether these claims had been infringed by them.

The question of the patentability of the blade is therefore first to be considered, for, if it be answered in the negative, the issue as to infringement becomes immaterial. On that question, as we read the judgment appealed from, the true effect of the findings of the learned trial judge is that there was invention in the combination of the blade and the blade holder, but that there was none in the blade itself.

The learned judge said:

Whether or not there is invention in Gaisman may first be considered. During the course of the trial I formed the opinion that the patent lacked subject matter but upon a more careful consideration of the case, I have reached another conclusion. I think there is subject matter and that the patent should be sustained. The patented improvement, and it is only an improvement, is, I think, novel; it cannot be said that the blade and blade holder combined in the manner described in the specification does not possess utility; there is no effective evidence of anticipation by prior publication. The general idea or principle of the alleged invention seems an ingenious one, and, I think, involved the exercise of the inventive mind. The means for holding the blade in position has advantages over the means formerly or presently employed in safety razors, for example, the well known Gillette safety razor, where the blade was pushed sidewise into a spring holder, and which, according to the evidence, was difficult at times to remove, and there was also the danger in so doing of

the user cutting his hand. Frequently, it was stated in evidence, that safety razors of this type had to be returned to the manufacturer in order to have the blade removed. The plaintiff's blade is very easily inserted in and removed from the blade holder, and with safety, and in this one respect alone the combination is, I think, an improvement over other known methods of retaining a blade in a blade holder. The idea of employing a blade holder of the type described with projections in the upper plate of the holder to co-operate with apertures in the blade, for holding the blade in the required position, must have required some, if only a small amount, of ingenuity. It cannot be said to be a common idea, or a natural development of an old idea, or one which would readily occur to workers in this particular art. No one had previously suggested it. The invention may be slight, and the patent a narrow one, but that does not mean there is not subject matter for a patent. The invention of course produces no new result and, I think, is protected only in respect of the particular means set forth in the specification. The other feature of the invention, that is, the provision of apertures in the blade by perforating a word or symbol, such as a trade-mark, may possess very practical merits, but that, I think, is but an optional method of using the invention the substance of which lies in the employment of a particular blade holder, with projections in the holder to co-operate with corresponding apertures or openings in the blade.

And later:

The apertures which the plaintiff has selected for the blade happen to spell its trade-mark, but the real importance of such apertures, so far as this case is concerned, is that the apertures—not the trade-mark—are definitely positioned to co-operate with the projections in the upper plate of the blade holder. It is the particular holder and the projections in the holder plate, and the apertures in the blade, designed to co-operate the one with the other, that constitutes the invention.

In our view, that was really conclusive of this case and, on these findings, having regard to the only issue between the parties, the action ought to have been dismissed.

The specification has two purposes. It must correctly and fully describe the invention and its operation or use as contemplated by the inventor (sec. 14, subs. (a)).

And the reason for that is that the information it gives must be sufficient to enable persons skilled in the art to make use of the invention after the expiration of the patent privilege. Further, it must "state" distinctly the things or combinations which the applicant regards as new and in which he claims an exclusive property and privilege.

And the object of that second requirement of the Act is to define the ambit of the monopoly and the exact extent of the exclusive rights granted in the patent.

Now, if we turn our attention solely to the specific claims relied on by the respondents as defining the article alleged to have been infringed, and if we analyze them, we find that the new blade is declared to be possessed of two characteristics:

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(a) apertures or depressions “so shaped and located that they will co-operate with different holders, such holders having sets of projections differing *inter se* but such that any one of such sets will prevent such razor blade from sliding or turning on the said holder”;

(b) these apertures or depressions should be “in the form of a designation to indicate the manufacture.”

Let us—as we should—examine the subject-matter of the invention so described, in the light of the evidence given at the trial by those having the technical skill and knowledge enabling them to understand the novelty or the utility of the new manufacture (*French's Complex Ore Reduction Co. v. Electrolytic Zinc Process Co.* (1)), always bearing in mind that claims Nos. 1 and 2 alone are to be taken into consideration.

As understood by the experts heard at the trial, these claims disclose the following:

(1) “the idea of prominently, indelibly and conspicuously indicating the origin of the manufacture of the blade”;

(2) “the combination of apertures which serve to locate the blade” and of other apertures “which have no other function” but to “indicate the origin” or, in other words, “perforations indicating origin and locating means”;

(3) “perforations which extend longitudinally across the blade so as to form a resilient section having anything to do with the cutting edge”;

(4) “apertures adapted to take more than one fixed design of lugs.”

Of these alleged characteristics, the one having reference to longitudinal perforations and resulting resiliency must be eliminated at once. Admitting for argument's sake that the perforations so made might “bring about a degree of elasticity in the blade which would enable it to assume a curved position” and that the blade would be improved if, instead of being solid, the “perforations make it more elastic and give it the desired curve,” the trouble is that the patentee made absolutely no claim for elasticity or flexibility.

The claim, in a specification, being primarily designed for delimitation, the monopoly is confined to what the pat-

(1) [1930] Can. S.C.R., 462, at 466.

entee has claimed as his invention. (Fletcher-Moulton L.J., in *British United Shoe Machinery Co. Ltd v. A. Fussel & Sons, Ltd.* (1); Lindley M.R., in *Pneumatic Tyre Co. Ltd. v. Tubeless Pneumatic Tyre and Capon Heaton, Ltd.*, et al. (2).) We must envisage the invention as claimed in the patent, not the invention which the patentee might have claimed if, in the words of Romer, J., "he had been well advised or bolder." (*Nobel's Explosives Co. v. Anderson* (3).) For that reason, the point about resiliency or elasticity is irrelevant. Further, it should be noted that it was not retained by the trial judge.

The next characteristic claimed for the blade in the shape of novelty is the combination of perforations indicating origin and locating means or—which is the same thing—of apertures adapted to take more than one fixed design of lugs and of others having no function other than to indicate the origin.

Leaving aside, for the moment, the object of indicating the origin (as to which something more will be said later), we are of opinion that the characteristic just mentioned is not invention, at least in the legal sense, even if, as a matter of fact, it may be asserted that there was novelty in the conception of the idea.

In that connection, the Story patent, dating back to the 5th of December, 1911, would have to be considered as a possible anticipation. Under that patent, the blade is provided with a polygonal orifice, preferably cruciform, strongly suggestive of a possible form of designation or trade-mark, co-operating with a projection in the holder; and, as in the impugned patent, certain parts of the orifice or aperture in the blade are alternatively functioning and functionless.

Assuming novelty, the apertures in the respondent's blade, so it is contended, are so shaped as to permit the projections on the holder to be varied or shifted from time to time and still anchor the blade to it. What obtained before, it is said, was a blade with two holes which could fit only with one kind of holders; the improvement consists in the fact that the new blade fits with several holders. But it is sufficient to resort to the evidence to discover the

(1) (1908) 25 R.P.C. 631, at 650. (2) (1898) 15 R.P.C. 236, at 241.
(3) (1894) 11 R.P.C. 115, at 128.

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fallacy of that contention. What the patentee really intended and what he wished to have patented was not a razor blade which could fit with several holders produced by different manufacturers, but a razor blade so perforated that it could fit only with his own holder on which he retained the faculty of shifting the projections from time to time. If that be so, at least two consequences follow: (a) the blade the patentee has claimed can be used only in cooperation with the holder he has described and, in that case, the subject-matter is a combination of which the blade is only an element; (b) the blade was devised exclusively for the protection of the manufacturer of the holder, and therefore it has no utility within the meaning of the patent law and there was no invention in the patentable sense. A patent granted for an invention of that kind lacks consideration, for the so-called invention is of no use to the public. Once it is designed merely for the protection of the particular manufacturer, the subject-matter is transferred from the field of patent law to that of the *Trade-Mark and Design Act*.

That brings us to examining the remaining characteristic claimed by the patentee and emphasized by the experts: the idea of prominently, indelibly and conspicuously indicating the origin of the manufacture of the blade or, as expressed in the claim itself, "a designation to indicate the manufacture of the blade."

During the course of the trial, it was suggested that the invention consisted in letters—"an aggregation of letters * * * with something added to them." In fact, the drawings sent in with the application and annexed to the patent contain only the letters DEFGH. That would hardly meet the requirements of definiteness imperatively prescribed in the *Patent Act*. The inventor must describe in language free from ambiguity the nature of his invention and he must define the precise and exact extent of the exclusive property and privilege which he claims (*French's Complex Ore Reduction Co. v. Electrolytic Zinc Process Co.* (1).) It does not seem probable that the patentee intended to claim the exclusive right of perforating any and all forms of holes in a razor blade. If he did, the claim

would be too wide and the specification in that respect would be void. Giving it a benevolent interpretation, we will accept one of the experts' suggestion that, "in order to satisfy the idea of the patent, (the perforations) must be in the form of a *trade* designation." Claim No. 1 refers to "apertures in the form of a designation." The description in the specification further indicates the "designation" as being "such as a Trade-Mark, name or symbol," and states that it "may be formed by apertures or depressions in any desired member to indicate the manufacture of the (blade)." In that sense, the claim enters the domain of trade-mark and is inspired by nothing more than the idea of protection for the manufacturer of the razor. Making apertures to indicate the manufacture of an article is plain common trade-marking. It comes to this that, to have any value at all, the apertures must impress the one particular trade-mark on the razor blade. In the respondent's case, it is the word "Valet."

What the patentee claims is really an obvious method of impressing a trade-mark on the razor blade. It does seem practical and useful, but, as was said by Lord Watson in *Morgan & Co. v. Windover & Co.* (1), utility alone, however great it may be, cannot by itself and in the absence of invention support a grant of letters patent. And we are unable to accede to the proposition that a man may patent the idea of impressing his trade-mark in a razor blade by means of apertures in the blade, without more, and thus prevent another man from impressing his trade-mark in a similar way in the blades manufactured by him. We would repeat with the trial judge:

The other feature of the invention, that is, the provision of apertures in the blade by perforating a word or symbol, such as a trade-mark, may possess very practical merits, but that, I think, is but an optional method of using the invention the substance of which lies in the employment of a particular blade holder, with projections in the holder to co-operate with corresponding apertures or openings in the blade.

As we have pointed out, the latter part of the above holding applies to the combination of holder and blade protected by the claims of the patent which were not in issue between the parties in this case. As for claims Nos. 1 and 2, they do not present characteristics of such a nature as

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may be made the subject of a patent privilege, and they should be declared invalid and void.

It thus becomes unnecessary to consider the complaint about infringement. The appeal should be allowed and the action should be dismissed, with costs both here and in the Exchequer Court.

Appeal allowed with costs.

Solicitors for the appellants: *Smart & Biggar.*

Solicitors for the respondent: *Henderson, Herridge & Gowing.*
