29, 1934

No. 63 of 1933.

In the Privy Council.

ON APPEAL

FROM THE SUPREME COURT OF CANADA.

BETWEEN

LIGHTNING FASTENER COMPANY LIMITED (Plaintiff) - - - - - - - - - *Appellant*

and

COLONIAL FASTENER COMPANY LIMITED and G. E. PRENTICE MANUFACTURING COMPANY (Defendants) - - - - - - *Respondents.*

Appellant's Case.

RECORD.

1. This is an appeal by special leave from a judgment of the Supreme Court of Canada dated the 25th of April 1933, holding that the more generally expressed claims of Sundback's patent No. 210202 dated the 5th of April 1921, of which the Appellant is the assignee, were invalid on the grounds of anticipation and lack of subject matter, and that the other claims had not been infringed. By this judgment the Supreme Court reversed a judgment of the Exchequer Court of Canada in which the action had been instituted; that Court held that the patent was valid and had been infringed and gave judgment accordingly for an injunction and a reference as to damages. p. 191. pp. 192-197. pp. 143-151.

2. The Appellant submits that the judgment of the Exchequer Court was right and that the Supreme Court failed to give effect to the principles of law laid down by both the House of Lords and the Privy Council as to the essential conditions which must be fulfilled by the Specification of a prior patent in order that it should constitute an anticipation, and by the Privy Council as to the facts which are to be regarded as relevant in determining the question of subject matter. The principal judgments to

which the Appellant refers are those given in British Thomson Houston *vs.* Metropolitan Vickers (1925) 45 R.P.C. 1, and Pope *vs.* Spanish River Pulp and Paper Mills (1929) 46 R.P.C. 23.

3. The patent relates to a machine for carrying out the complete process of manufacture of stringers for what are known as " slide fasteners," (or in England as " Zipp " fasteners), a name given to a means for closing apertures by equipping each side of the aperture with a tape carrying interlocking metallic members which are brought into engagement and released from engagement with one another by the movement along the aperture of a slider. A " stringer " for a slide fastener is the tape affixed along one side of the aperture to the edges of which the interlocking metallic members have been attached in spaced relation.

pp. 69-73. 4. The problem of making stringers by fully automatic machinery has been under continuous but unsuccessful attack from 1893 onwards. The only commercial machinery for making such stringers had been a pair of complementary machines devised by one Aronson in 1905. The use of the Aronson machines had been discontinued prior to 1914. Between 1914 and 1916 Sundback designed and built the machine, the patent for which is now in suit. This machine went into wide use in many countries ; in 1931, the last year before the trial, 40,000,000 slide fasteners, or double that number of stringers, had been made on such machines.

p. 32, ll. 26-34.

pp. 58-63. 5. In accordance with the process described in Sundback's patent there are separately fed to the machine a strip of metal and a fabric tape. By a succession of mechanical operations there are cut from the metal strip tiny pieces which are punched and shaped to form the interlocking members of a completed stringer. These interlocking members are fed to a point where they meet the edge of the tape to which they are attached by clinching preformed jaws which have been made at one end of the members on to the tape fabric. For a predetermined distance the tape moves by a series of small jumps so that successive members are attached to its edge at predetermined intervals. When the required number of members has been so attached, the tape automatically makes a longer jump, leaving a blank space of predetermined length. The attachment of a fresh series of closely set interlocking members then commences.

6. The result of the operation of the machine is the production of a series of stringers having fixed to one edge successive groups of interlocking members. The interval between the members in each group is usually of the order of 1/10th of an inch and the interval between the stringers of the order of five or six inches. To make completed fasteners the tape is cut midway between the stringers, and any two of these taken at random form a pair, which, upon being equipped with a slider and

appropriate end-stops, constitute a fastener adapted to close an aperture of a length corresponding to the stringer. In this form the fasteners are used instead of buttons or sets of hooks and eyes to close apertures of varying lengths, the outside edges of the tape and its free ends being attached to the material in which the aperture exists, usually by sewing.

7. The Respondents had constructed and used a similar machine. By their defence they denied that this constituted an infringement and also contended that the patent was invalid on the ground of anticipation by the Aronson patent No. 107456 of 1907 and by certain other earlier patent specifications relating to machinery for use in the manufacture of various articles such as barbed wire fencing, but which machinery was not proved ever to have gone into use. They contended that having regard to the prior publication in the Specifications of these patents, Sundback's patent was invalid, and that it lacked subject matter. p. 94, l. 33, ff. p. 55, l. 36. ff.

The trial took place before Maclean, J., President of the Exchequer Court of Canada and judgment was delivered on the 4th day of April 1932. The learned judge held that the Appellants' patent was valid and that it had been infringed by the Respondents. The judgment is set out in full at pages 144–151 of the Record. pp. 144-15

8. Evidence was given at the trial of the long unsuccessful efforts made to develop a satisfactory machine for making fastener stringers prior to the date of Sundback's patent. Mr. Frederick Ray, an independent Consulting Engineer of high standing, giving evidence on behalf of the appellants, expressed the opinion that the problem facing the inventor was a very difficult one which he himself would have thought quite impossible of satisfactory solution. pp. 69-73. pp. 22-26. p. 58, l. 4(

He said that the difficulty of attaching metal parts to a fabric tape, the contemplated small size of the former, and the high speed and the high degree of accuracy with which it was essential that a fastener stringer machine should operate, made the problem of the construction of such a machine different in kind from that presented to the inventors of the barbed wire fencing and other similar machines described in the earlier patent specifications. p. 58, l. 8, p. 59, l. 43

There is in the appellant's submission nothing in the evidence adduced by the Defendants which contradicts in any way the evidence of Ray and Sundback himself on these points.

9. In his judgment the learned President stated as follows :—

Upon the issue of anticipation : p. 147, l. 4: p. 148, l. 1

" I find nothing in the prior art relied upon by the defendants that is at all relevant to the controversy here on the point of

anticipation . . . The proper principle to be applied in testing anticipation is that the specification which is relied upon as an anticipation of an invention must give the same knowledge as the specification of the invention itself (Pope Alliance Corporation *vs.* Spanish River Pulp and Paper Company (1929) A.C. 275, 276). No one confronted with the problem of producing a machine like Sundback could turn to the prior art cited in this case and there find its solution. And that is the test. The prior art relied upon has to do with machines for the making of carding hooks and eyes, metallic strip fencing, barbed wire etc. To take something from one patent and then something from other patents and say ' this is Sundback ' is to make a mosaic which is not legitimate in law."

Upon the issue of subject matter :

p. 148, l. 37 to p. 149, l. 1.

" The art of combining two or more parts, whether they be new or old, or partly new and partly old, so as to obtain a new result, or a known result in a better, cheaper, or more expeditious manner, is valid subject matter, if it is presumable that invention in the sense of thought, design or skilful ingenuity was necessary to make the combination . . . In this case some parts of the combination may be old, yet it was a novel combination which produced a new and useful result, and substantial skilful ingenuity was required to produce the combination."

Upon the issue of infringement :

p. 149, ll. 41-47.

" In the claims relied upon by the plaintiff I do not think the patentee limits himself to the precise mechanism described ; it is in the principle or method of construction and operation in the broad idea of utilisation and arrangement of means substantially as described which automatically produce a finished stringer, wherein lies the essence of the invention, the claim to monopoly and not in the precise operating mechanism or means that are described."

And in conclusion :

p. 151, ll. 31-37.

" In substance the two machines are the same, every step in the operation of Prentice is substantially the same as in Sundback and is made for the same purpose. It seems to me that the whole principle, method and arrangement of Sundback is plainly evident in Prentice, and while the machines are not exactly alike, yet they are in substance alike ; they are designed to produce the same result and substantially by the same means or method."

10. The Respondents appealed to the Supreme Court of Canada (Rinfret, Lamont, Smith, Crocket, JJ., Latchford, C.J.), and on 25th day of April 1933 their appeal was allowed and the Court held that the Appellant's earlier claims were too wide in scope and must be limited to the particular means disclosed and that therefore there had been no infringement by the Respondents. Only one Judgment was delivered in the Supreme Court by Smith, J., and it is set out in full at pages 192–197 of the record. The Supreme Court held that the Respondents had not infringed the Appellant's patent upon its true interpretation. The interpretation placed upon the Appellant's patent by the Supreme Court was largely influenced by reference to a passage from Sundback's United States patent No. 1331884 (stated in the evidence to be for the same invention), although no corresponding passage appeared in the patent in suit.

p. 193, ll. 28-37.
pp. 30, 31, ll. 40, 41.

After reference to Brainard's patent No. 292467, dated January 24th, 1884, for a machine for attaching barbs to a twisted fence wire, and to Stover's U.S. patent No. 240477, dated April 19th, 1881, for fixing barbs to a fence ribbon, the judgment proceeds as follows :—

p. 193, l. 41.
p. 194, l. 4.

> " Speaking generally therefore, there was nothing new in devising a machine to form automatically and cheaply large numbers of like metal units and to set them on a suitable carrier element with regulated spacings. The problem remaining to be solved was the devising of a means by which, when the particular fastener units here in question were successively cut and formed from the metal strip they would be automatically carried on and placed with the jaws astride the corded edge of the tape to be there compressed on the tape as disclosed in the Aronson patent, thus avoiding the tedious and expensive manual operation necessary in the Aronson process for placing the jaws of the unit astride the edge of the tape."

p. 194, ll. 9-19.

The judgment thus concedes that Aronson had left a part of the problem unsolved. With reference to the earlier specifications for barbed wire and similar machinery it was stated :—

> " It is of course plain enough that these stringers could not be made on a barbed wire machine without much change or modification of the machine."

p. 193, l. 23.

After reference to Major's U.S. patent No. 525914, dated September 11th, 1894, for a machine for making and carding hooks and eyes, the Judgment proceeds :—

p. 195, l. 27.

> " It will thus be seen that the practice of forming and cutting units from a metal wire or strip, fed step by step into the machine and in the same machine automatically carrying the units successively as formed to a position where they are successively

p. 195, l. 44, ff.

clamped or clinched to a tape or other carrying element in spaced relation in groups of pre-determined length, was not new at the date of the Respondents' patent, and that the most that can be covered by the Respondents' patent is the particular method and the particular mechanism by which the result is achieved, and cannot cover all methods and all mechanisms by which that result is brought about (Tweedale *vs.* Ashworth, 9 R.P.C. 126, at 128 ; Miller *vs.* Clyde Bridge Steel Company, 9 R.P.C. 478, 479)."

Analogies to the specific operational steps carried out by the patented
p. 196, l. 14. machine are then referred to as to be found in the disclosure of Shipley's
p. 196, l. 22. U.S. patent 85249 dated December 22nd, 1868, for cutting teeth in metal
p. 196, l. 28. combs, in the disclosure of Major's barbed wire machine already referred
p. 196, l. 38. to, in an earlier machine said to have been used by one Prentice, in the
p. 196, l. 41. Specification of Olms U.S. patent 1114177 dated October 20th, 1914, for a machine for attaching discs to envelopes, and in Aronson's patent of 1907.

Having thus brought together a number of instances of alleged earlier resort to specific machine parts similar to those incorporated in the patented machine, the conclusions arrived at would appear to result in the Appellant's patent being invalid, and that the particular mechanism to which Sundback's invention must be restricted had not been adopted by the Respondents, by whom there had consequently been no infringement.

pp. 198, 199. 11. On the 10th day of July 1933 the Appellant applied by Petition to the Privy Council for special leave to appeal from the judgment of the Supreme Court of Canada and such leave was granted by order dated the 24th day of July 1933.

12. The Appellant submits that the judgment of the Supreme Court should be reversed, and that of the Exchequer Court restored for the following among other

REASONS.

(1) BECAUSE the Letters Patent No. 210202 are valid and have been infringed by the Respondents.

(2) BECAUSE the subject of the patent in suit was novel and useful and was good subject matter for the grant of valid Letters Patent.

(3) BECAUSE claims for a useful device cannot properly be held to have been anticipated by a mosaic of suggestions derived from prior specifications.

(4) BECAUSE the problem which Sundback solved was different in its nature from that to which the earlier inventors had addressed themselves.

(5) BECAUSE the Supreme Court has failed to apply the principles laid down by the House of Lords and the Privy Council in British Thomson Houston *vs.* Metropolitan Vickers (1925) 45 R.P.C. 1 and Pope *vs.* Spanish River Pulp and Paper Mills (1929) 46 R.P.C. 23.

(6) BECAUSE the Supreme Court was wrong in utilising a passage from Sundback's U.S.A. patent for the purpose of interpreting the Patent in suit.

(7) BECAUSE the judgment of the Supreme Court was wrong and ought to be reversed and the judgment of the Exchequer Court was right and ought to be restored.

J. WHITEHEAD.

STAFFORD CRIPPS.

No. 63 of 1933

In the Privy Council.

ON APPEAL

From the Supreme Court of Canada.

BETWEEN

LIGHTNING FASTENER COMPANY LIMITED (Plaintiff) - - *Appellant*

AND

COLONIAL FASTENER COMPANY LIMITED and G. E. PRENTICE MANUFACTURING COMPANY (Defendants) - - *Respondents.*

Appellant's Case.

WM. MORRIS,
Imperial Chemical House, S.W.1,
Agent and Solicitor for the Appellant.

The Solicitors' Law Stationery Society, Ltd., Law and Parliamentary Printers, Abbey House, S.W.1. WL2493B-20256A