THE CANADIAN GENERAL ELECTRIC COMPANY, LIMITED..... } PLAINTIFF;

1927
Jan. 26.
Feb. 10.

AND

FADA RADIO, LIMITED .....DEFENDANT;

(No. 7244)

Patents—Necessity of affidavit for re-issue—Improper affidavit for issue of —Untrue statement—Commissioner of Patents—Discretion.

An application for the re-issue of a patent was made by the plaintiff company under the Patent Act (R.S.C., 1906, c. 69). In support of their application they filed an affidavit purporting to be made by the company, instead of by an officer thereof.

Held: That as both the Patent Act and Rules in force at the date of the re-issue were silent on the matter, the Commissioner might properly require an affidavit in support of the application or might dispense with such formality, if he saw fit to do so.

2. That inasmuch as the sufficiency or validity of such affidavit is for the Commissioner to pass upon, and is solely to satisfy himself, when a patent has been granted, stating on its face that the patentee has complied with all requirements of the Patent Act, it was not competent to a defendant, sued for infringement of such patent, to attack the same as being void, because the affidavit accompanying the application was not strictly in compliance with the statute, and the court will not consider such a defence.

3. That even if the statement in the affidavit of the patentee, filed with his application for patent, that "his invention had not been patented to him or others . . . in any country" were untrue, this would not in itself be a ground for voiding the patent, in the absence of fraud. That a party sued for infringement of a patent could not invoke such an error, to void the patent.

4. That the purpose and effect of the post war legislation (Ch. 44, sec. 7, ss. 1 of 11-12 Geo. V, Dom.) was *inter alia* to extend the time within which one might apply for a patent in Canada, after having patented the same invention in another country, which legislation must be read as amending sec. 8 of the Patent Act; and that in consequence an application for patent made in Canada in 1919 was properly received, notwithstanding that the same invention had already been patented in another country in 1917, more than one year previous to the Canadian application.

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ACTION for infringement of patent.

Action tried before the Honourable Mr. Justice Maclean, President of the Court, at Ottawa.

Russell Smart, K.C., and *J. C. Macfarlane* for plaintiff.

George F. Henderson, K.C., for defendant.

The facts are stated in the reasons for judgment.

THE PRESIDENT, now this 10th February, 1927, delivered judgment (1).

This is an action for infringement of Canadian Patent No. 244,847, granted to the plaintiff on the 25th day of November, 1924, which was a re-issue of patent No. 196,390 granted to the plaintiff on the 20th day of January, 1920, the plaintiff being assignee of Irving Langmuir, the inventor.

The defendant admits user of the "grid leak" described in the plaintiff's patent, and relies altogether on legal defences touching the issuance of both mentioned patents. The defendant claims that the patent in suit is void because it was not accompanied by a proper affidavit, the petition requesting a re-issue of the original patent under the provisions of ch. 69, sec. 24, R.S.C., 1906, being accompanied by an affidavit purporting to be made by the Canadian General Electric Co., Ltd., the plaintiffs, which affidavit the defendant claims to be void. The defendant also claims that the original patent issued to the plaintiff was void because of untrue statements contained in the affidavit of Irving Langmuir, the inventor, accompanying the application for patent. The alleged untrue statement is that the inventor, Irving Langmuir, therein declared that his invention had not been patented to him or others, with his knowledge or consent in any country, whereas in fact it had been previously patented in Germany. The defendant also contends that the application by Langmuir for patent in Canada was made more than one year after the date of issue of the German patent, and that the patent was issued contrary to the provisions of the Patent Act, and was therefore void.

(1) An appeal has been taken to the Supreme Court of Canada.

The plaintiff substantially replied to those contentions as follows: that neither the Patent Act nor the Patent Rules require an affidavit to accompany the petition of the applicant for a new or re-issued patent, and its absence is not a ground for invalidity of the same; that any allegation in the petition or affidavit of an applicant for a patent, containing any untrue matter, is not fatal to the validity of a patent thereon granted unless the allegation was a material one; that the affidavit accompanying the petition for a new patent, purporting to be the affidavit of the plaintiff corporation, was substantially the affidavit of W. H. Nesbitt, secretary of the plaintiff company, that failure to properly describe the capacity in which the affiant made the affidavit does not void the same, that it was a sufficient compliance with the statute, if an affidavit was required at all, and that having been accepted by the Commissioner of Patents it is conclusive of the matter; that if the re-issued patent is valid, objection cannot now be taken to the original patent, which has been surrendered, and being no longer in existence, cannot therefore be the subject of attack.

Ch. 69, sec. 24, R.S.C., 1906, is to the effect that whenever a patent is deemed defective or inoperative for one reason or another, and that it appears that the error arose from inadvertance, accident or mistake without any fraudulent or deceptive intention, the Commissioner may upon the surrender of such patent, cause a new patent, in accordance with the amended description and specification made by such patentee, to be issued to him for the same invention. Under the provisions of this section, the plaintiff petitioned the Commissioner of Patents requesting that a new patent be granted to it, as assignee of Langmuir, in accordance with the amended description and specifications of the said invention. The affidavit accompanying this petition was in part as follows:—

> We the Canadian General Electric Company Limited of the city of Toronto, in the county of York, in the province of Ontario, Canada, make oath and say that the several allegations contained in our petition to the Commissioner of Patents * * * are respectively true and correct.

The affidavit was signed "Canadian General Electric Company Limited, W. H. Nesbitt, Secretary," and purported to be sworn before a notary public in the usual man-

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ner. The notary public in question, giving evidence at the trial, stated that Nesbitt, the secretary of the plaintiff company, swore to the affidavit before him, and signed the same in his presence. The affidavit was apparently accepted by the Patent Office as sufficient, and in due course a new patent issued granting to the plaintiff and its assigns the exclusive right of making, constructing, and vending in the Dominion of Canada the said invention. The patent recites the fact that the patentee had complied with all the requirements of the Patent Act.

It is not contended that a corporation may make a declaration or take an oath, but it is urged that the affidavit made by Nesbitt, an officer of the plaintiff company, is a sufficient compliance with the Act if an oath was at all required, notwithstanding the fact that Nesbitt failed to describe himself in the beginning of the affidavit as an officer of the plaintiff corporation and did not sign the affidavit as a person, but rather signed the name of the plaintiff corporation thereto. It does not appear to me that Ch. 69, section 24, R.S.C., 1906, required any affidavit or declaration to accompany a petition asking for the issuance of a new patent, neither did the rules then in force appear to require such a formality, although the prescribed forms contain a form of affidavit to be used in cases of this kind. The petition itself sets forth the grounds upon which a new patent was requested, and I am of the opinion after carefully considering the matter, that nothing more was necessary. The statute and the rules being silent on the matter, the Commissioner of Patents might very properly require an affidavit in support of the application, or he might dispense with such a formality altogether if he saw fit to do so. On the other hand if an affidavit or declaration was required by the statute, then I think the affidavit in question having been accepted by the Commissioner of Patents, and a new patent having issued, it is not now open to the defendant, to attack the patent upon such a ground. Any other state of the law would be productive of serious complications and frequently great injustice. In this connection see sec. 63 of the Exchequer Court Act.

Mr. Henderson on behalf of the defendant urged that the original patent was void because it contained matter

which was untrue upon a material point, and that this patent was therefore always void, and consequently a new patent, or a re-issued patent as it is usually called, could not therefore in law issue at any time. The particular matter challenged in the affidavit of Langmuir accompanying the original application, is, as I have already stated, the allegation that his invention had not at that time been patented to him, or to others with his knowledge or consent, in any country, whereas in fact it is claimed a patent had been issued in Germany to him along with another named Alexanderson, covering the same invention. The Canadian application in question was filed on October 9, 1919, and the German patent issued on July 5, 1917. The German patent issued jointly to Langmuir and Alexanderson, and the claims of that patent are not in fact exactly the same as in the Langmuir Canadian application of October 9, 1919, but contain further and different claims, and cannot strictly be said to be one and the same invention. I think therefore that the allegation in question cannot be said to have been untrue. Moreover there is no evidence before me that I can recall, which shows that Langmuir knew of the issuance of the German Patent. Further, I think that even if the patent issued in Germany was exactly the same as the Canadian patent granted on the application of Langmuir, it would not in itself be a ground for voiding the patent, in the absence of fraud which is not suggested, and I repeat what I have already said, that the patent having issued, I do not think any party in an infringement action can invoke an error of this kind, to void the patent.

The legal effect of failure to strictly comply with certain formalities of the statutes and rules regarding applications for patents has not apparently been the subject of discussion in reported cases in Canada or England, but it has been the subject of discussion in many American cases, and the conclusions there reached are, I think, sound.

In *Seymour* v. *Osborne* (1), the point was taken that the patentees did not make oath, before the patents were granted, that they believed they were the original and first inventors of the improvements for which the letters patent were solicited. Apparently there

(1) (1870) 11 Wall. [78 U.S.] 516 at p. 538

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was no proof that the oath required had been taken before the Commissioner, but the court suggested that it might have been taken before some other person authorized to administer oaths. The letters patent contained the recital that the required oath was taken before the same was granted, and the court was of the opinion that its recital, in the absence of fraud, was conclusive evidence that the necessary oaths were taken by the applicants, before the patent was granted. Inasmuch as Mr. Henderson contended that there was no evidence of error, inadvertance or mistake, supporting the application for a new patent, it is perhaps worth while pointing out that in this case the court also decided that the fact of the granting of a reissued patent closed all inquiry into the existence of inadvertance, accident or mistake, and left open only the question of fraud for the jury, and that where the Commissioner accepts the surrender of an original patent and grants a new patent, his decision in the premises, in a suit for infringement, is final and conclusive, unless it is apparent upon the face of the patent that he has exceeded his authority, that there is such a repugnancy between the old and new patent that it must be held, as a matter of legal construction, that the new patent is not for the same invention as that embraced and secured by the original patent. See also *The Auer Incandescent Light Manufacturing Co.* v. *O'Brien* (1). In *Whittemore* v. *Cutter* (2) objections were taken to the form of the oath of the inventor. Mr. Justice Storey there expressed the opinion that the taking of the oath was but a pre-requisite to the granting of the patent, and in no degree an essential to its validity. It might as well have been contended he said that the patent was void unless the thirty dollars required by the Patent Act had been previously paid. In *Wayne Mfg. Co.* v. *Coffield Motor Washer Co.* (3) the oath accompanying a reissued patent was attacked, because it was administered by the solicitor who procured the application. The patent recited that the required oath had been made by the applicant, and in the absence of fraud, it was held conclusive evidence of that

(1) [1897] 5 Ex. C.R. 245, at pp. 288, 289.

(2) [1813] Gallison's R. vol. 1, p. 429.

(3) [1915] 227 Fed. Rep. 987 at p. 990.

fact. The court held that papers in the files of the patent office, purporting to be an oath in a given case, even if void for lack of a jurat or other fault was harmless. In such a case, it was held, that the law presumes the oath recited in the letters patent was made orally, or was embodied in some other patent, and that it was to be presumed that the Commissioner will never issue a patent until he is satisfied that the applicant has somehow made oath to the facts to which the statute requires him to swear. When the Commissioner is so satisfied and recites the fact in the letters patent, all inquiries on the subject are foreclosed except in a case of actual fraud. In *Crompton* v. *Belknap Mills* (1) where the sufficiency of the affidavit was in question, the court said:—

> We are not satisfied the oath was not taken. The letters patent recite that it was * * *. But suppose the oath was not taken. Would the patent be void on that account? It was held otherwise by Judge Storey in *Whittemore* v. *Cutter supra*. The taking of the oath, though it be done prior to the granting of the patent, is not a condition precedent, failing which the patent must fail. It is the evidence required to be furnished to the patent office, that the applicant verily believes he is the original and first inventor of the art, etc. If he takes this oath, and it turns out that he was not the first inventor or discoverer, his patent must fail, and is void. So, if he does not take it, and still he is the first inventor, or discoverer, the patent will be supported.

One point more remains to be considered. Assuming that the German patent and the original patent granted upon Langmuir's application, refer to the same subject matter, it is contended on behalf of the defendant, that having patented in Germany on July 5, 1917, Langmuir should have applied within one year from that date for his Canadian patent, whereas in fact the Canadian application was not made until the 6th of October, 1919. This objection would of course be fatal to the plaintiff unless there is legislation modifying the terms of the Patent Act, which requires an application for patent to be made here within one year from the date of the issue of the first foreign patent for such invention. Chapter 44, sec. 7 (1) of the Statutes of Canada, 1921, enacts as follows:—

> A patent shall not be refused on an application filed between the first day of August, 1914, and the expiration of a period of six months from the coming into force of this Act, nor shall a patent granted on such application be held invalid by reason of the invention having been patented in any other country or in any other of His Majesty's Dominions

(1) (1869) 3 Fisher's Pat. Cases 536.

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or Possessions or described in any printed publication, or because it was in public use or on sale prior to the filing of the application, unless such patent or publication or such public use or sale was issued or made prior to the first day of August, 1913.

This provision clearly I think must be read in amendment of sec. 8 of the Patent Act to which I have just referred. The purpose and effect of this post war legislation was *inter alia* to extend the time within which one might apply for patent in Canada, after having patented the same invention in another country, and such application was not to be refused by reason of the invention having been previously patented in any other country unless this was done prior to August 1, 1912. This I think meets exactly this case, and I am of the opinion that the filing of the application and the patent issued thereon was within this statute, and which statute is I think conclusive upon the point. The plaintiff upon this point relies upon sec. 81 and 83 of the Treaty of Peace (Germany) Order, 1920, but I do not think any discussion of the same is now necessary.

The plaintiff's action is therefore allowed, and it is entitled to the relief claimed. The plaintiff will also have its costs of action.

Judgment accordingly.

Solicitors for plaintiff: *Macfarlane & Thompson.*

Solicitors for defendant: *Henderson & Herridge.*