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HER MAJESTY THE QUEEN.....PLAINTIFF;
 AND
 PERMELIE LA FORCE.....DEFENDANT.

Patent of Invention—Sci. Fa. to repeal same—Prior foreign invention unknown to Canadian inventor—Specification, interpretation of by reference to drawings—Practice—Right to begin.

The pneumatic tire as applied to bicycles came into use in 1890. It consisted of an inflatable rubber tube with an outer covering or sheath, which was cemented to the under surface of a U-shaped rim similar to that which had been used for the solid and cushion rubber tires which preceded it. This tube was liable, in use, to be punctured, and as the sheath was cemented to the rim of the wheel it was not readily removable for the purpose of being repaired. La Force's invention met that difficulty by providing for the use of a rim with the edges turned inward so as to form on each side a lip or flange, and of an outer covering or sheath to the edges of which were attached strips made of rubber or other suitable material, which fitted under such lips or flanges and filled up the recess between them. When the rubber tube is not inflated, this tire may readily be attached to or removed from the rim of the wheel; but when inflated the covering or sheath is expanded and the outer edges of the strips attached thereto are forced under the flanges of the rim, and the whole securely held in position by the pressure of the inflated tube upon such strips.

The defendant's assignor hit upon this idea in April, 1891, and in company with his brother made a section of a rim and tire on this principle in May following. On the 3rd of August in the same year a patent therefor was applied for in Canada and on the 2nd December following the defendant obtained it. In March, 1891, Jeffery, at Chicago in the United States, conceived substantially the same device and confidentially communicated the nature thereof to his partner and patent solicitor. On the 27th of July, he applied for a United States patent, and on the 12th day of January, 1892, such patent was granted to him. On the 5th of February, 1892, he applied for a Canadian patent which was granted to him on the first of June in the same year.

When in May, 1891, La Force's conception of the invention was well defined there had been no use of the invention anywhere, and

the public had not anywhere any knowledge or means of knowledge thereof.

Held, that the fact that prior to the invention of anything by an independent Canadian inventor, to whom a patent therefor is subsequently granted in Canada, a foreign inventor had conceived the same thing but had not used it or in any way disclosed it to the public, is not sufficient under the patent laws of Canada to defeat the Canadian patent.

2. That the drawings annexed to a patent may be looked at to explain or illustrate the specification.
3. Under the General Order of the Exchequer Court of Canada bearing date the 5th December, 1892, and the provisions of sec. 41 of 15-16 Vict. (U.K.) c. 83, the defendant in an action of *Scire Facias* to repeal a patent for invention is entitled to begin and give evidence in support of his patent, and, if the plaintiff produces evidence to impeach the same, the defendant is entitled to reply.

THIS was an action of *scire facias* to repeal letters-patent for an invention.

The facts of the case are stated in the judgment.

After the writ of *scire facias* was served and appearance entered by the defendant the following pleadings were delivered between the parties :

Declaration.

[TITLE OF CAUSE.]

“DOMINION OF CANADA, }
“To Wit: }

“Our Lady the Queen sent to Her Sheriff of the County of Carleton, or any other of Her Sheriffs in the Dominion of Canada, Her Writ clothed in these words :—

Writ of Scire Facias.

[TITLE OF CAUSE.]

“VICTORIA by the Grace of God of the United Kingdom of Great Britain and Ireland, Queen, Defender of the Faith.

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“To the Sheriff of the County of Carleton or any other of Our Sheriffs in the Dominion of Canada, Greeting:

“Whereas We lately by Our letters-patent sealed with the Seal of Our Patent Office in the City of Ottawa, in Our Dominion of Canada, and signed by the Honourable John Carling, Our Commissioner of Patents and one of Our Privy Council for Canada, and bearing date the second day of December, A.D. 1891, and registered in Our said Patent Office at Ottawa aforesaid as No. 37890, reciting that whereas Hippolyte Joseph La Force, of the City of Toronto, Ontario, shoemaker, had petitioned the Commissioner of Patents praying for the grant of a patent for an alleged new and useful improvement in pneumatic tires (he having assigned to the said Permellie La Force, of the said City of Toronto, all his right, title and interest in and to the said invention) a description of which invention is contained in the specification of which a duplicate is thereunto attached and made an essential part thereof, and had elected his domicile at the said City of Toronto, in Canada, and had also complied with the other requirements of *The Patent Act*, chapter 61, *Revised Statutes of Canada*, did by Our said letters-patent grant to the said Permellie La Force, her executors, administrators, legal representatives and assigns for the period of fifteen years from the date thereof the exclusive right, privilege and liberty of making constructing and using and vending to others to be used in Our Dominion of Canada the said invention, and in which said letters-patent, amongst other provisoes and conditions therein expressed, it was and is provided that the grant thereby made should be subject to adjudication before any court of competent jurisdiction and should be subject to the conditions contained in

the thirty-seventh and other sections of the Act aforesaid.

“And whereas We lately by Our letters-patent sealed and signed as aforesaid and bearing date the first day of June A.D. 1892, and registered in Our said Patent Office at Ottawa as No. 39035, reciting, amongst other things, that whereas Thomas B. Jeffery, of the City of Chicago, in the State of Illinois, in the United States of America, Cycle manufacturer, had petitioned the said Commissioner of Patents praying for the grant of a patent for alleged new and useful improvements in pneumatic tires, a description of which invention is contained in the specification of which a duplicate is thereunto attached and made an essential part thereof and had elected his domicile at Ottawa, Ontario, and had also complied with the other provisions of the said patent Act, did by our said last mentioned letters-patent grant to the said Thomas B. Jeffery, his executors, administrators, legal representatives and assigns for the period of fifteen years from the date thereof the exclusive right, privilege and liberty of making, constructing and using and vending to others to be used in the Dominion of Canada the said invention of him the said Thomas B. Jeffery.

“And whereas the said Thomas B. Jeffery, being desirous for the reasons hereinafter mentioned to impeach the first recited letters-patent bearing date the second day of December, A.D. 1891, granted to the said Permelie La Force as aforesaid, has obtained a sealed and certified copy thereof, and of the petition, affidavit, specification and drawings relating thereto, and has in accordance with the provisions in that behalf contained in the said Act and the Acts amending the same filed the said sealed and certified copies of said letters-patent, petition, affidavit, specification and drawings in the office of the Registrar of Our Exchequer Court of

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Canada and the said letters-patent and documents aforesaid are now as of record in the said Court.

“ And whereas We are given to understand that Our said letters-patent bearing date the second day of December, A.D. 1891, and numbered 37890 issued to the said Permellie La Force as aforesaid, were and are contrary to law in this that whereas the said Hippolyte Joseph La Force did in the said petition state that he had invented a certain new and useful improvement in pneumatic tires not known or used by others before his invention thereof, as set forth in the said specification and drawings accompanying said petition (being the specification and drawings attached to said letters-patent No. 37890).

“ And whereas the said Hippolyte Joseph La Force in the said affidavit did swear that he verily believed that he was the inventor of the alleged new and useful improvement in pneumatic tires described and claimed in the said specification and did swear that the several allegations contained in the said petition were respectively true and correct.

“ And whereas We are given to understand and be informed that the said Hippolyte Joseph La Force did not invent the said alleged invention in the said petition and letters-patent No. 37890 mentioned and claimed.

“ And also that the said Hippolyte Joseph La Force was not the true and first inventor of the said alleged invention of an improvement in pneumatic tires in said letters-patent No. 37890 mentioned and claimed, but that the said Thomas B. Jeffery was the true and first inventor.

“ And also that the specification to said letters-patent No. 37890 granted to the said Permellie La Force as aforesaid does not correctly and fully des-

cribe the nature of the invention claimed to be patented thereby.

“ And also that the specification to said letters-patent No. 37890 granted to the said Permellie La Force as aforesaid does not correctly describe the mode or modes of operating the said alleged invention in said letters-patent No. 37890 mentioned and claimed.

“ And also that no person from the reading of said specification or from perusing and studying the same would be able to manufacture and construct the said alleged invention so as to make the same useful, and that with the sole aid of the said specification and without assistance from the patentee and directions and information other than that contained in the said letters-patent the article attempted to be patented could not be manufactured.

“ And also that the said specification does not fully explain the principle and the several modes in which it is intended to apply and work out the said alleged invention.

“ And also that said specification does not state clearly and distinctly the contrivances and things which are thereby claimed as new and for the use of which the said Permellie La Force claims an exclusive property and privilege.

“ By reason and means of which said several premises the said letters-patent so granted as aforesaid to the said Permellie La Force were, are and ought to be void and of no force and effect in law.

“ And We, being willing that what is just in the premises should be done, command you Our sheriff of Our said county of Carleton or other Our said sheriffs that by good and lawful men of your bailiwick you give notice to the said Permellie La Force that before Us, in Our said Exchequer Court of Canada, she be and appear within ten days from the service upon her of such

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notice and of a copy of this writ, inclusive of the day of such service, to show if she has or knows anything to say for herself why the said letters-patent No 37890 as aforesaid so granted to her ought not, for the reasons aforesaid, be adjudged to be void, vacated, cancelled and disallowed, and further to do and receive those things which Our said court shall consider right in that behalf, and that you then return and have there the names of those persons by whom you shall have caused such notice to be given to the said Permelie La Force, of this writ, together with this writ immediately after the execution thereof.

“ Witness the Honourable George W. Burbidge, Judge of the Exchequer Court of Canada, at Ottawa, the twenty-fourth day of January in the year of Our Lord one thousand eight hundred and ninety-three and in the fifty-sixth year of Our reign.

(Sgd.) L. A. AUDETTE,

Registrar.

“ Whereupon on this present day, that is to say on the eleventh day of February, A.D. 1893, the sheriff of the city of Toronto returned to Our said Lady the Queen in Her Exchequer Court of Canada that by Alfred Wright Harris and James Dilworth, good and lawful men of his bailiwick, he had given notice to the said Permelie La Force as he the said sheriff was by the said writ commanded and thereupon the said Permelie La Force, by Messrs. Rowan and Ross her solicitors, comes, whereupon Sir John Sparrow David Thompson, Knight Commander of the most Honourable Order of St. Michæel and St. George, Attorney-General of the Dominion of Canada, Solicitor of Our said Lady the Queen, who for Our said Lady the Queen prosecutes in this behalf, being present here in Court in his own proper person, prays that the said letters-patent No. 37890 may be adjudged to be void,

vacated, cancelled, and disallowed upon the grounds in said writ mentioned and also upon the further ground that the said invention, as comprised in said letters-patent No. 37890 as patented, was not, at the time of the alleged invention thereof and is not, of any use, benefit or advantage to the public.

Delivered, &c.

Particulars of Objections.

[TITLE OF CAUSE.]

“The following are the particulars of the objections upon which the plaintiff will rely at the trial of this action with respect to the validity of the letters-patent No. 37890, granted to the defendant and in question herein:—

“1. That Hippolyte Joseph La Force did not invent the said alleged invention comprised in said letters-patent No. 37890, inasmuch as the said alleged invention had been invented by others prior to his invention thereof, particularly by said Thomas B. Jeffery in the writ of *scire facias* herein mentioned.

“2. That the said Hippolyte Joseph La Force was not the true and first inventor of the alleged invention comprised in letters-patent No. 37890, inasmuch as the said alleged invention had been invented prior to his invention thereof, by the said Thomas B. Jeffery, who was and is the true and first inventor thereof.

“3. That the said alleged invention comprised in said letters-patent No. 37890, as patented, was not at the time of the alleged invention thereof and is not of any use, benefit or advantage to the public.

“4. That the specifications and drawings annexed to said letters-patent and dated the 30th of August, 1891, do not correctly and fully describe the nature of the said alleged invention, or the mode or modes of operating the same, inasmuch as the said specifications do

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not describe in what manner or by what means the strips mentioned therein are to be attached to the said covering mentioned therein, or whether the said strips are to meet in the centre of the felloe or otherwise, or whether the inflatable rubber tube is required to be larger or smaller in diameter than the said outer covering, or how or in what manner the said rubber tube is to be inflated, and in other respects the said specifications are insufficient, ambiguous and misleading, so that an ordinary skilled artisan reading the said specification could not, with the sole aid thereof, and without directions and information other than that contained in the said patent, manufacture the said alleged invention; and further, that the said specifications do not state clearly and distinctly the contrivances and things claimed as new, and for the use of which the patentee claims an exclusive property and privilege in the said alleged invention.

“ Delivered, &c.

Pleas.

[TITLE OF CAUSE.]

“ The eighteenth day of February, in the year of Our Lord one thousand eight hundred and ninety-three.

“ 1. And the said *Permelie La Force*, by her solicitors, *Rowan & Ross*, as to the first suggestion in the writ of *scire facias* issued, herein contained, whereby it is suggested and alleged that *Hippolyte Joseph La Force*, in the said writ named, did not invent the said invention in the said writ mentioned, says that the said *Hippolyte Joseph La Force* did invent the said invention, and that the several allegations contained in the petition and affidavit filed by the said *Hippolyte Joseph La Force*, referred to in the said writ, were respectively true and correct.

“ 2. And as to the second suggestion in the said writ contained, whereby it is suggested and alleged that the

said Hippolyte Joseph La Force was not the true and first inventor of the said alleged invention, but that one Thomas B. Jeffery was the true and first inventor thereof, the defendant, Permellie La Force, says that the said Hippolyte Joseph La Force was the true and first inventor of the said invention, and that the said Thomas B. Jeffery was not the true and first inventor thereof.

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“ 3. And as to the third suggestion in the said writ contained, whereby it is suggested and alleged that the specification to the said letters-patent granted to the said Permellie La Force does not correctly and fully describe the nature of the invention claimed to be patented thereby, the defendant, Permellie La Force, says that the said specification does correctly and fully describe the nature of the said invention.

“ 4. And as to the fourth suggestion in the said writ contained, whereby it is suggested and alleged that the specification does not correctly describe the mode or modes of operating the said invention in the said letters-patent mentioned and claimed, the defendant, Permellie La Force, says that the said specification does correctly describe the mode or modes of operating the said invention.

“ 5. And as to the fifth suggestion in the said writ contained, whereby it is suggested and alleged that no person, from reading the said specification and from perusing and studying the same, would be able to construct the said invention so as to make the same useful, and that with the sole aid of the said specification and without assistance from the patentee, and instruction and information other than that contained in the said letters-patent, the article attempted to be patented could not be manufactured, the said Permellie La Force says that any person, with the sole aid of the said specification and without assistance from the patentee, and without instruction and information other than that

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contained in the said letters-patent, could easily manufacture the article thereby patented.

“ 6. And as to the sixth suggestion in the said writ contained, whereby it is suggested and alleged that the said specification does not fully explain the principle and the several modes in which it is intended to apply and work out the said invention, the said Permelie La Force says that the said specification fully explains the principle and the several modes in which it is intended to apply and work out the said invention.

“ 7. And as to the seventh suggestion in the said writ contained, whereby it is suggested and alleged that the said specification does not clearly and distinctly state the contrivances and things which are thereby claimed as new, and for the use of which the said Permelie La Force claims an exclusive privilege and property, the said Permelie La Force says that the said specification does clearly and distinctly state the contrivances and things which are thereby claimed as new, and for the use of which she claims such exclusive privilege and property.”

Delivered, &c.

Joinder of issue.

[TITLE OF CAUSE.]

The 21st day of February in the year of Our Lord one thousand eight hundred and ninety-three.

And the said Sir John Sparrow David Thompson, who for Our said Lady the Queen prosecutes as aforesaid, for Our said Lady the Queen joins issue upon the defendant's pleas and every of them.

Delivered, &c.

Evidence was taken at Toronto on the 20th and 21st October, 1893, and, by agreement, the argument on the questions of law was submitted on written factums.

Upon the opening of the case Mr. *Ritchie*, Q.C. for the defendant, stated that, under the practice applicable to this case, the defendant had the right to begin and reply on the issues raised in the proceedings. This happened by reason of the General Order of the Exchequer Court dated the 5th December, 1892, and sec. 41 of 15 & 16 Vict. [U.K.] c. 83, whereby it is enacted that the defendant in such a proceeding as this is entitled to begin and give evidence in support of his patent, and if the plaintiff produce evidence to impeach the same, the defendant is entitled to reply (1).

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The following contentions were submitted by *Ritchie* Q.C. and *Ross* for the defendant:—

1. There is nothing in any of the Canadian Patent Acts to displace the rule of law that, where there are two conflicting grants of letters-patent for a novel invention that which is first sealed is alone valid, and that subsequently sealed is of no force or effect whatever. [Cites *Hindmarch on Patents* (2); *Frost on Patents* (3); *Ex parte Dyer*, (4); *Foster on Scire Facias* (5); *Saxby v. Hennett* (6); *Barter v. Howland* (7).]

If a patent is actually sealed, no subsequent valid patent for the same invention can be issued unless *mala fides* is brought home to the first patentee. *Mala fides* being shown, the second patent in England was given an earlier date than the date of the patent first sealed, so absolute was the rule that a patent *prior tempore* was *potior jure*. [Cites 15 & 16 Vict., cap. 83 sec. 23; *Edmunds on Patents* (8); *The Patent Act 1883*

(1) This course of procedure is still followed in England in a proceeding by petition to repeal a patent. See as to that, and the burden of proof, *Terrell on Letters-Patent*, 2nd ed. p. 254, *et seq.*

(2) (Eng. ed.) P. 32.

(3) P. 237.

(4) *Holroyd on Patents* 59.

(5) Pp. 246, 247.

(6) L. R. 8 Exch. p. 210.

(7) 26 Gr. 135.

(8) P. 655, 685.

1894 sec. 13; *Ex parte Bates & Redgate* (1); *Saxby v. THE QUEEN v. LA FORCE*. *Hennett* (2).]
 In England if two applications are made on the same day, patents are issued to both applicants. [*Re Dering's Patent* (3).]

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2. The Canadian Patent Acts, unlike the American, afford a rival and earlier inventor no remedy against a patentee. Sec. 19 R.S.C. c. 61 provides only for cases of conflicting applications. The corresponding section of the American Act goes further and provides for an interference between an application and a conflicting unexpired patent, and it is made clear that priority of invention is to determine the rights of the parties. [Cf. sec. 19 R. S. C. c. 61 with sec. 4904 of the American Act in the Revised Statutes of the United States. See sec. 4918 of the latter as to interfering patents.]

If the inventor does not file an application and take issue with his rival in the Patent Office under sec. 19, but allows a patent to issue to the rival inventor, he is without remedy under our Patent Acts.

There is nothing in any of our Patent Acts to show that a rival inventor, even if he has a subsequent patent, is in any better position in attacking a prior patent than any third person who simply desires to make the invention public property. Sec. 34 of R.S.C. c. 61 says "Any person who desires to impeach..... may." The words "any person" mean "any British subject resident in Canada." [Cites *Macleod v. Attorney-General N.S. Wales* (4); *Jefferys v. Boosey* (5).] Jeffery is not entitled to the writ merely because he holds a subsequent patent. [Cites *Foster on Scire Facias* (6).]

3. If Jeffery has any remedy it is not by *scire facias*, which is a Crown action to repeal and cancel a patent

(1) L. R. 4 Ch. 577.

(2) L. R. 8 Exch. 210.

(3) 13 Ch. D. 393.

(4) (1891) A.C. 458.

(5) 4 H. L. C. p. 926.

(6) P. 256.

respecting which Her Majesty has been deceived or by which the public, her subjects, are prejudiced. [Cites *Hindmarch on Patents* (1).]

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The cases in which *scire facias* will lie, are set forth in *Hindmarch on Patents* (2). Jeffery being an alien is not entitled to the writ.

4. The words "first inventor," "true and first inventor," "novelty," "known" and "used," are all words familiar in English law, with a well defined signification. Their signification is a relative and not an absolute signification. The courts in England have never lost sight of the main consideration for the grant of letters-patent—the benefit to be derived by the British public from the right to construct, use and vend the invention on the expiration of the monopoly. They consider the public benefit rather than the merits of the inventor. Novelty within the realm only was required and the first introducer was considered the true and first inventor.

[Cites *Lewis v. Marling* (3), *Ex parte Scott and Young* (4), *Smith v. Davidson* (5).]

The words in the Statute of Monopolies "new manufactures within this realm" were seized upon as a reason for this interpretation. The section reads "..... grants of privilege..... of the sole working or making of any manner of new manufactures within this realm." The words therefore relate clearly to the territorial extent of the grant.

The real ground for simply requiring novelty within the realm is the policy of the law.

The policy of our patent law, as declared in the title and preamble of the first Patent Act of the Province of Ontario, 7 Geo. IV., c. 5, is the same as that of Eng-

(1) Eng. ed. p. 384.

(3) 1 W.P.C., 496

(2) Eng. ed. 378, 384.

(4) L.R. 6 Chy. 274.

(5) 19 C. of S. Cases, p. 695.

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land. The Act is entitled "An Act to encourage the progress of useful arts within this Province." The preamble recites the expediency of encouraging genius and arts within this Province. There has been no change in the policy of our law, and the phraseology of our Patent Acts is to be interpreted so as to further the declared object of the enactments.

The words "true and first inventor" appear in the statute of James I., secs. 5 and 6; in the Patent Law Amendment Act, 1852, sec. 10, *et seq.*; in the Act of 1883, secs. 34, 35, *et seq.*, and have been uniformly held to mean—not the first inventor in point of time but any true inventor or introducer of a manufacture, new to that portion of the public with whose welfare Parliament is concerned—the British public.

[Cites *Dollond's case* (1); *Hill v. Thompson* (2); *Ex parte Henry* (3).]

The words "first inventor" which occur in two minor sections only of R.S.C. c. 61, viz., secs. 16 and 24, mean any true inventor of a thing "not known or used by any other person before his invention thereof."

[Cites *Hindmarch on Patents* (4); *Lewis v. Marling* (5); *Higgins's P. C.* (6); *Gibson v. Brand* (7); *Pennock v. Dialogue* (8); *Shaw v. Cooper* (9); *Bedford v. Hunt* (10); *Merwin on Patents* (11); *Curtis on Patents* (12); *Reed v. Cutter* (13); *Robinson on Patents* (14).]

The American cases on prior invention are inapplicable under our Patent Act. Canadian legislatures have carefully avoided incorporating into our Patent Acts any of the phraseology of the American Acts, on

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| (1) 1 W.P.C. 43; 2 H.B. 1, 470. | (7) 4 M. & G. at p. 205. |
| 480. | (8) 2 Pet. p. 17. |
| (2) 1 W.P.C. p. 244. | (9) 7 Pet. 318, 319. |
| (3) L.R. 8. Chy. 170. | (10) 1 Mason 302. |
| (4) Eng. ed. pp. 33, 127. | (11) Pp. 621 and 687. |
| (5) 1 W.P.C. 496. | (12) P. 680. |
| (6) P. 261. | (13) (1841) 1 Story p. 590. |
| | (14) Vol. 1 p. 559 par. 391. |

which the doctrine of the race of diligence, interferences between conflicting patents, &c., are founded. The drift of our legislation has a contrary direction. The applicant for a Canadian patent need not now, as was formerly required, swear that he is the first inventor. In England from the statute of James I. to the present day the applicant must declare himself to be the "true and first inventor."

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[Cites *Edmunds on Patents* (1); *Pennock v. Dialogue* (2).]

6. Section 7 of R.S.C. c. 61 is the governing section of the Act. If La Force is within that section and a true inventor the patent issued to the defendant must stand. "Not known or used" means not known or used by the public. Now comes the question—what degree of public knowledge or use will defeat a patent? The sufficiency of such public knowledge or use is a question of fact or of inference from the facts of each case. The question is, does the evidence show that the public have become possessed of a knowledge of the invention or does it show such facts from which a public knowledge or use can be presumed or inferred?

[Cites *Harris v. Rothwell* (3); *Ex parte Henry* (4); *Carpenter v. Smith* (5); *Lewis v. Marling* (6); *Cornish v. Keene* (7); *Galloway v. Breaden* (8); *Bentley v. Fleming* (9); *Jones v. Pearce* (10); *Newall v. Elliott* (11); *Hills v. London Gas Co.* (12); *Morgan v. Seaward* (13); *Useful Patents Co. v. Rylands* (14); *Carpenter v. Smith* (15); *Curtis on Patents* (16); *Robinson on Patents* (17); *Walker*

(1) Pp. 665, 737.

(2) 5 Pet. 17.

(3) Griffin's Pat.C. 109, and cases there cited.

(4) L.R. 8 Chy. 170.

(5) 1 W.P.C. 534.

(6) 1 W.P.C. 492.

(7) 1 W.P.C. 508, 511, 512.

(8) 1 W.P.C. 529.

(9) 1 Car. & K. 587.

(10) 1 W.P.C. 124.

(11) 4 C.B.N.S. 266.

(12) 5 H. & N. 356, 364.

(13) 2 M. & W. 544.

(14) 2 P.O.R. 255.

(15) 1 W.P.C. 530.

(16) 4th Edition sec. 87a.

(17) Vol. 1 p. 427 note (2).

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on Patents (1); *Ellithorpe v. Robertson* (2); *Winans v. N. Y. & Haarlem Ry. Co.* (3); *Walker on Patents* (4); *Lyman Refrigerator Co. v. Lalor* (5); *Corn Planter Patent* (6); *Cahoon v. Ring* (7); *Johnson v. McCullough* (8); *Parker v. Hulme* (9); *Merwin on Patentability of Inventions* (10); *Putnam v. Hollender* (11); *Hall v. Bird* (12); *Brush v. Condit* (13); *Bonathan v. Bowmanville* (14); *Smith v. Goldie* (15); *MacLeod v. Atty. Gen. N. S. Wales* (16); *Jefferys v. Boosey* (17); *Metropolitan Board of Works v. L. & N. W. Ry.* (18); *Vanorman v. Leonard* (19).]

W. Cassels, Q.C., (with whom was *Gormully, Q.C.*) for the plaintiff contended as follows:—

The Canadian statute law relating to patents is derived from American rather than from English sources. The Canadian statutes themselves must be interpreted by the court, and in such interpretation changes in the language used in the various Patent Acts become very important as indicating the policy of the legislature.

The word "inventor" under section 7 of the Canadian Patent Act means first inventor. This has been the universal construction and is also made clear by secs. 16, 24 and 32 in each of which the expression "First Inventor" is used.

The "first inventor" under Canadian law is he who "first invents" whether in Canada or elsewhere. See Cons. S. of C. c. 34 s. 3 (1859) where the words used are "not known or used by others in this Province."

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| (1) P. 40, 41. | (10) P. 643. |
| (2) 2 Fish. p. 83. | (11) 19 Blatch. 48. |
| (3) 4 Fish. 1. | (12) 6 Blatch. p. 439. |
| (4) P. 39. | (13) 9 Brodix p. 594. |
| (5) 1 Bann. & A. 403 ; 12 Blatch. | (14) 31 U.C. Q. B. 413. |
| 303. | (15) 9 Can. S.C.R. 46. |
| (6) 23 Wallace 181. | (16) A.C. [1891] p. 458. |
| (7) 1 Fish. 397, 410, 411. | (17) 4 H.L.C. p. 926. |
| (8) 4 Fish. p. 175. | (18) 14 Ch. D. pp. 527, 528. |
| (9) 1 Fish. 45. | (19) 2 U.C. Q. B. p. 72.. |

[Cites *Smith v. Goldie* (1).]

In *Smith v. Goldie* the action had been dismissed in the Court of Chancery at the hearing before the Chancellor. On appeal, the Court of Appeal for Ontario confirmed this judgment on the ground that Smith's invention was not patentable. So that when on further appeal the Supreme Court of Canada gave judgment in favor of Smith it had to decide necessarily, 1st, that the invention was patentable and 2ndly., that Smith was the first inventor. Now Smith's Canadian and United States patents were both later in point of date than the Canadian patents of Lacroix and Sherman under which the defendants justified their infringements (2); so that the Supreme Court had necessarily to travel behind all these patents in order to determine that Smith was the first inventor, and to give his patent priority over the prior dated patents of Lacroix and Sherman.

The case of *Barter v. Howland* (3), if opposed to this view, is not law.

The meaning given to the words "True and First Inventor" in the English statutes is a very strained one. It would not be followed now if *res integra* in England; see the observations of Jessel, M. R. in *Plimpton v. Malcolmson* (4).

Secondly. "Any person" under section 7 includes "Foreigners"; in other words Foreigners and Canadians are placed exactly on the same footing. This appears clear from the previous legislation, and the whole scope of the Act, and the universal practice of the Patent Office.

[Cites Cons. S. of C. c. 34 s. 3; 32 and 33 Vict. c. 11 s. 6; 35 Vict. c. 26 s. 6; *Routledge v. Low* (5).]

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(1) 7 Ont. App: at p. 641. and 9 Can. S.C.R. 46. (2) See page 634 of 7 Ont. App.
 (3) 26 Gr. 135. (4) L.R. 3 Ch. D. p. 555. (5) L.R. 3 H. L. 117.

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Thirdly. "Not known or used by any person," quoting from sec. 6 of *The Patent Act*.

This language is taken from the United States statutes. The courts have always recognized the distinction between a case where it is sought to avoid a patent on the ground of anticipation and a case where the contest is between "rival inventors" who have each been granted patents as in this case.

[Cites *Merwin on the Patentability of Inventions* (1).
Walker on Patents (2).]

Fourthly. In a contest for priority between two rival inventors each of whom has obtained a patent, who is the first inventor is a question of fact. When the invention may be exhibited in a drawing or in a model, such invention will date from the completion of such a drawing or model as is sufficiently plain to enable those skilled in the art to understand it.

[Cites *Loom Company v. Higgins* (3); *Robinson on Patents* (4).]

The communications made by Mr. Jeffery to Mr. Gormully and to the patent solicitor are facts corroborative of the statement of Jeffery that he invented the invention on the 15th or 16th March, 1891, and are quite sufficient for that purpose.

In order to make out a case of publication to defeat a patent there must be a communication to the public or in public, but the cases on this point have no application to the facts and circumstances of this case.

Fifthly. As to the construction of the specification and drawing, he cites *The Patent Act*, secs. 13 and 28.

Sixthly. A patent is void if any material allegation in the petition is "untrue." (Cites *The Patent Act* sec. 28.)

(1) C. 8 p. 621 and c. 9 p. 689.

(2) Secs. 315 to 320.

(3) 105 U.S.R. 594.

(4) Sec. 132.

BURBIDGE, J. now (January 9th, 1894) delivered judgment.

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The main question to be determined in this case is, whether under the patent law of Canada a prior foreign invention of which the public had no means of knowledge is sufficient to defeat a patent issued to an independent Canadian inventor. The question arises upon issues joined in a proceeding wherein Thomas B. Jeffery, of the city of Chicago in the United States of America, Cycle Manufacturer, has sued out a writ of *scire facias* to repeal letters-patent, numbered 37890, for an improvement in pneumatic tires granted to the defendant as assignee of her husband Hippolyte Joseph La Force, of the city of Toronto, Shoemaker.

The pneumatic tire for bicycles came into use in 1890. It consisted of an inflatable rubber tube with an outer covering or sheath which was cemented to the under surface of a U shaped rim similar to that which had been used for the solid and cushion rubber tires that preceded it. In use, this tube was liable to be punctured, and as the sheath was cemented to the rim of the wheel it was not readily removed for the purpose of being repaired. The defendant's invention met that difficulty by providing for the use of a rim with the edges turned inward so as to form on each side a lip or flange, and of an outer covering or sheath to the edges of which were attached strips made of rubber or other suitable material which fitted under such lips or flanges, and filled up the recess between them. When the rubber tube is not inflated, such a tire may readily and without any special skill be attached to or removed from the rim of the wheel; but when inflated the covering or sheath is expanded and the outer edges of the strips attached thereto are forced under the flanges of the rim, and the whole is securely held in position by the pressure of the inflated tube upon such

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strips. It is not essential, it is said, that the latter should meet and fill up the space or recess between the flanges of the rim, but it is better that they should do so, and they are so represented in the drawing attached to the defendant's patent.

La Force, who in the course of his business had had occasion to repair pneumatic tires says that he hit upon this idea in the latter part of April, 1891, and that during the week preceding the 25th of May, following, he communicated his invention to his brother. On that day with the latter's assistance, he made, as an experiment, a section of such a rim and tire, and within two weeks thereafter, a rim and tire complete. In July he consulted Mr. Ridout, his patent solicitor, who on or about the 3rd of August applied for a patent for the improvement he had invented, and which is described in his specification and drawings attached thereto, and for which a patent was granted to the defendant, on the 2nd of December, 1891.

In 1888, Mr. Jeffery, the prosecutor, had taken out in the United States a patent for an "improvement in vehicle wheels" in which was described a method of attaching a solid rubber tire to the rim of the wheel more easily and quickly than was possible by the ordinary method when cement alone was used. The means described involved a rim with the edges turned in to form flanges, and lateral projections attached by cement to the solid rubber tire and "engaging under and between such flanges." This invention Jeffery did not make any use of in his business as the solid tire was going out. But when the pneumatic tires came in, it occurred to him that they could be secured to the rim of the wheel by means of edges or projections similar to those described in the patent of 1888. About the 9th of March, 1891, he made some cloth and tin models, and, on the 15th of the same month, a drawing,

showing three ways in which he thought his conception could be given effect to, one of which clearly involved the device or improvement covered by the patents subsequently issued to La Force and to himself. The drawing was shown to his partner, Mr. Gormully, on the same day, and the models to his patent solicitor, Mr. Burton, a few days thereafter. The fundamental idea, Burton says, of the invention indicated by Jeffery's partial models and sketches, that ran through all the several forms of the device which he indicated, was, that the tire and the rim should be provided with interlocking hooks or projections and recesses, so that the tire might be said to be hooked to the rim by the engagement of the hooks of the one with the hooks of the other, or the recesses of the other. For this idea, Burton, on the 26th of March, filed in the United States Patent Office, Jeffery's application for a patent, which was granted to him on the 16th of June, 1891. In the section of tire and rim shown in the drawing attached to the letters-patent, we see the strips of the sheath and the flanges of the rim engaging each other as hooks, and, as described in the specification, such strips and flanges form, what I may perhaps call, continuous interlocking hooks. But that was all; while in respect to the improvement for which the La Force patent issued, and for which Jeffery also subsequently obtained patents in the United States and in Canada, the strips attached to the sheath or outer covering of the tire, not only engage the flanges of the rim, but rest upon it, and receiving the pressure of the rubber tube when inflated, assist to hold the whole securely in position. This device was, as I have said, indicated on the drawing that Jeffery showed to Gormully on the 15th of March, 1891. About the last of that month he made a model of a section of a tire that illustrated part of it. On the 4th of July he made a sketch and

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description of the device which he explained to Burton on the 13th, and the latter on the 27th of the same month filed in the United States Patent Office an application for a patent therefor. The patent was granted on the 12th of January, 1892. On the 5th of February following, Jeffery applied for a Canadian patent for the same improvement, and obtained letters-patent therefor on the 1st of June, 1892.

The case, under the facts to which I have alluded, presents, it will be observed, a controversy between rival inventors in which the public have no special interest. If La Force's letters-patent are set aside the monopoly goes over to Jeffery. The latter does not in this case rely upon his 1888 patent as an anticipation of La Force's invention. That is an objection, which if maintained, would, I take it, be equally fatal to his own patent, and that is not the conclusion that he desires to reach in the present proceeding. He makes no admissions that might at some other time and place be invoked against him, but, with that qualification, I understand him to have introduced the evidence as to the 1888 patent to corroborate and strengthen his account of his invention of the improvement in pneumatic tires in question, not to show that in 1891 there was no novelty in such improvement. So far as my own view goes I am of opinion that La Force's invention was not anticipated by the Jeffery patent of 1888, but I do not understand the prosecutor to desire to raise that issue now. The novelty in 1891 and the utility of the invention are alike parts of his case, and of the defendant's. The simple question is, must La Force's patent be set aside in favour of Jeffery because the latter, an American citizen, residing at Chicago, had, two months earlier than La Force, invented and disclosed in confidence to his partner and to his patent solicitor, the improvement for which the patent issued,

although his application for a Canadian patent was not made until after La Force's had been granted. But before discussing that question I wish to refer briefly to the seventh section of *The Patent Act* (1), within the terms of which it was necessary for La Force to bring himself before he was entitled to a patent.

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By that section it is provided that any person who has invented any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement therein, which was not known or used by any other person before his invention thereof, and which has not been in public use or on sale with the consent or allowance of the inventor thereof for more than one year prior to his application in Canada, may on certain prescribed conditions obtain a patent granting to him an exclusive property in such invention. By the tenth section of the Act it is further provided that every inventor shall, before a patent can be obtained, make oath or affirmation that he verily believes that he is the inventor of the invention for which the patent is asked, and that the several allegations in the petition contained are respectively true and correct.

Now La Force, being an inventor of the improvement for which in August, 1891, he solicited a patent, and having no knowledge or means of knowledge of Jeffery's invention in March, 1891, of the same device, was, it will be seen, in a position to make the affirmation required by the Act. Prior to his application the invention had not been "in public use or on sale" in Canada, or for that matter elsewhere; and prior to his invention, which, regarded as a conception, may be taken to have been complete as early as the last of May, 1891, it was "not known or used by any other

(1) R. S. C. c. 61 s. 7.



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person" within the true meaning of these words, which have reference not to a secret use or the knowledge of an earlier inventor or of those to whom in confidence he may have disclosed it, but to such a publication or use as affords the public the means of information or knowledge of the invention. The improvement had not been used in public—had not in fact been used at all, and any knowledge there was of it, was not in any way open or accessible to the public. Jeffery knew of it, of course, for he had in March preceding invented it, and he had communicated his knowledge to Gormully and Burton, both of whom, however, stood in a confidential relation to him, and were interested, the one as a partner and the other as a solicitor, in keeping such knowledge from the public. In addition, Burton had on the 26th of March filed, in the United States Patent Office, Jeffery's application for the patent of June 16th, 1891, and if the latter should be taken to include the improvement for which La Force's patent was granted, the application contained a description of such improvement. I do not think that Jeffery's patent of June 16th covers La Force's invention, in which another and important element or feature comes into action; but whether it does or not is not important in this connection, for, at Washington, pending applications are preserved in secrecy until a patent has issued, and a description of an invention in an application for a patent filed in the Patent Office there is not a publication of such invention (1). In May, 1891, La Force's invention was new so far as the public was concerned, or had any means of information, and there is nothing in the circumstances to which I have referred to defeat his patent for want of novelty in the invention, or for any false allegation or suggestion in his petition.

(1) Robinson on Patents, ss. 16 of the Practice of the United States Patent Office. 552, 326 and note; Rules 15 and

It being clear, then, that La Force, when it was granted, was entitled to the patent sought to be impeached, we come back to the question to which I have alluded, and to an examination of the contention on which the prosecutor mainly relies—that under *The Patent Act of Canada*, he who, the world over, first invents anything, is entitled to a patent therefor, and to have set aside in his favour any letters-patent for the same thing that may, prior to his application, have been granted to a subsequent independent inventor. That contention is rested upon the following provisions of the Act. By the seventh section it is, as we have seen, enacted that any person who has invented any new and useful thing, may have a patent therefor; by the sixteenth section, the Commissioner may grant a patent for an invention already patented, if he has doubts as to whether the patentee or the applicant is the first inventor; by the twenty-fourth section, it is provided that if by any mistake, accident or inadvertence, and without wilful intent to defraud or mislead the public, a patentee has made his specification too broad, claiming more than that of which he or the person through whom he claims was the first inventor, or has in the specification claimed that he or any person through whom he claims was the first inventor of any material or substantive part of the invention patented, of which he was not the first inventor, and to which he had no lawful right, he may make disclaimer of such parts as he does not hold by virtue of the patent; and by the thirty-second section, whenever a plaintiff in any action of infringement fails to sustain his action, because his specification and claim embrace more than that of which he was the first inventor, and it appears that the defendant used or infringed any part of the invention justly and truly specified and claimed as new, the court may discriminate, and the judgment may be

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rendered accordingly. And it is said that the words of the seventh section, "any person who has invented," read with the other provisions to which I have referred, mean absolutely and without qualification the person who anywhere has first invented a new and useful thing. It is not denied that the law of England and of the United States is different. Although the words "true and first inventor, and inventors" occur in the Statute of Monopolies (1), one may, by the law of England, be "a first and true inventor," although he has in fact invented nothing. It is sufficient, if he be the first importer or introducer from abroad of a manufacture which up to the date of his importation had not been known within the realm. And as between rival inventors within the Kingdom, he is the true and first inventor who first discloses the invention to the public. In *The Househill Company v. Neilson* (2), Lord Chancellor Lyndhurst said that—

If the invention is in use at the time that the grant is granted, the man cannot have a patent, although he is the original inventor; if it is not in use, he cannot obtain a patent if he is not the original inventor. He is not called the inventor who has in his closet invented it, but who does not communicate it; the first person who discloses that invention to the public is considered as the inventor. The party must be an inventor, you need not say the inventor, because another may have invented it and concealed it; but in addition to his being an inventor, others must not use the invention at the time of the patent.

And in *ex-parte Henry* (3), Lord Selborne, L. C. said that, in the absence of fraud or communication, it would be no answer to an applicant for a patent, who had himself, by his own ingenuity, made a useful invention, and had applied for a patent before any one else claiming to have made the same invention, to allege that experiments had been going on, or even

(1) 21 Jac. 1 c. 3.

(2) 1 Web. P.C. 719.

(3) L.R. 8 Ch. 167.

drawings made, by another inventor. If such applicant were the true inventor, the circumstance of something having taken place somewhere else which was not disclosed to the world, and as to which no prior application had been made, would be no answer to him, even if it were shown that the two inventors were travelling very much upon the same lines, and that their minds were going very much to the same point at the same time.

Neither in the patent laws of the United States do the words "original and first inventor" mean absolutely the person who first invents. For no prior invention in a foreign country stands in the way of an independent inventor within the United States unless the result of the foreign invention has been published in a patent or printed book. If the foreign inventor of something which has not been so patented or published goes to the United States or entrusts his secret to an agent whom he sends there upon business connected with the invention, the date of his arrival there or that of his agent will be taken to be the date of his conception or invention. In the case of an invention within the United States the date of the conception is, in a contest between rival inventors, carried back to the first instant when the inventor can be shown to have first clearly apprehended his idea of the means; but in the case of a foreign invention to the date when it was patented or published in a printed book, or if not patented or published, to the moment when some person to whom the conception was familiar came within the limits of the United States (1). And as between two independent inventors within that country he who was the second to invent will become the original and first inventor within the meaning of the patent laws, if he is the first to reduce

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(1) Robinson on Patents, s. 382.

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the invention to practical form by embodying it in a machine capable of useful operation, and if the first inventor fails to use reasonable diligence in reducing the invention to practice (1). And one may, by the laws of the United States (2), be the first inventor of a lost art.

On the 20th of March, 1883, an International convention for the protection of industrial property was signed at Paris, to which eleven states, Belgium, Brazil, Spain, France, Guatemala, Italy, Holland, Portugal, Salvador, Servia, and Switzerland were parties. Great Britain was not one of the original signatories, but in 1884, Her Majesty's Government acceded to the convention so far as Great Britain and Ireland are concerned, and with the understanding that Her Majesty might accede thereto on behalf of any of her possessions on due notice being given through Her Government. No such notice has, I believe, been given in respect of Canada. The convention is not in force here, and I mention it only to show how far other countries have, where reciprocal advantages were obtained, thought it politic to go into the matter of giving a right of priority to foreign inventors. By the fourth Article of the convention it is provided that any person who has duly applied for a patent in one of the contracting states shall enjoy, as regards registration in the other states, reserving the rights of third parties, a right of priority for a period of six, or in case of countries beyond the seas, of seven months from the date of his first application. The subsequent application is antedated to the date of the first application and consequently is not defeated, as otherwise it would be, by prior publication or user in the protected interval (3).

(1) Robinson on Patents, s. 870      (2) Robinson on Patents, ss. 322 and note.      323.

(3) Edmunds on Patents, pp. 412, 600, 618.

I shall mention the laws of but one other country. By the law of Austria an invention is new if it is not known within the Empire either in practice or in a printed book or document accessible to the public; and from the date of his application the priority of right to the invention belongs to the applicant (1).

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It is clear then, I think, that the Canadian patent law is exceptionally liberal to the foreign inventor, if in a contest of priority with an independent Canadian inventor the former may, without any limit of time, or question of publication or application for a patent in his own country, carry back the date of his invention to the period when there his conception of it was clear and well defined. What the applicant for a patent of invention offers to the public for the grant thereof is the knowledge of his invention. But the public have no means of knowledge until he publishes or discloses the invention, and publication, therefore, forms an essential part of the consideration. If the invention is not new there is nothing to communicate to the public, and there is no consideration for the grant. Take the case under discussion. When La Force, in August, 1891, applied to the Commissioner of Patents for a patent for his invention, it was, as we have seen, new. He was in a position to and did communicate it to the public. His application when filed in the Patent Office was open to the inspection of the world (2). He had invented something. It was new, it was useful, and he published it. The consideration which he offered the Canadian public for the grant he solicited lacked in nothing, and it was justly given to him. What on the other hand had

(1) See Reports by Her Majesty's Secretaries of Embassy and Legation respecting the Law and Practice in Foreign Countries with regard to Inventions, presented to Parliament in 1873, pp. 4 and 5 Imp. Scss. Papers, Vol. LXVI.

(2) R.S.C. c. 61 s. 47.

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Jeffery to offer to the public, when in February, 1892, he came to the Commissioner with his application? Not the knowledge of the invention for which he asked a patent, for the public of Canada had been in possession of the information for six months. They had already bought it and paid for it with the grant made to the first applicant. What he had to offer was the affirmation that in a foreign country he knew of the thing two months before La Force knew of it, and that he had not in the interval anywhere given the invention to the public. With what in that allegation has the public of Canada the slightest concern? Of what moment is it to them, that in a foreign city a person knows of an invention that he is carefully keeping from the public? With what object would the patent law of Canada have regard to such a person? And why in his favour should it defeat an honest bargain that it had made with a Canadian inventor, destroy his property and work him a great wrong and injustice? One can understand how the Parliament of Canada, going farther, it is true, in that direction than the Parliament of the United Kingdom, or the Congress of the United States has as yet gone, has, in what it deemed to be the interests of the general public of the Dominion, made prior public knowledge or use of an invention anywhere, a bar to a Canadian patent therefor. But one fails, I think, to apprehend why it should in favour of a foreigner, on the ground only of his earlier conception of the invention, make void a patent issued for good cause and consideration to an independent Canadian inventor, for an invention that prior thereto had not been used in public anywhere, and of which the public in no part of the world had any means of knowledge. If that be the law it ought not to concern the judge whose duty it is to declare, obey and enforce it, that in its enforcement great

wrongs will be done. He is not the author of the injury and is free from responsibility for it. But he is, I think, in such a case, to be well satisfied that the intention and will of the legislature has been clearly expressed by itself, or declared by some authority whose decisions are binding upon him. We shall see, I think, that the words "inventor" and "first inventor" used in our patent laws have not always meant, absolutely and without qualification, the person who the world over first invented some new thing, and if they have that meaning now we should be able, it seems to me, to lay our hands upon some enactment of the legislature, or decision of the courts, whereby they acquired that signification, and by force of which so important a change was made in our laws.

By the common law of England which lies at the foundation of the laws of the Dominion, other than the civil law of Lower Canada, the King might in consideration of the good done to the commonwealth, grant a monopoly for a reasonable time to any one who by his own wit or ingenuity had made a new and useful discovery, or by his own charge or industry had brought any new trade or manufacture into the realm. In 1624 the Statute of Monopolies (1) was passed, by which the King's authority at common law to grant letters-patent for inventions was recognized and defined. By the sixth section of that famous statute, upon which letters-patent for inventions in England still depend, it was declared and enacted that no declaration thereinbefore mentioned should extend to any letters-patent and grants of privileges, for the term of fourteen years or under, thereafter to be made, of the sole working or making of any manner of new manufactures within the realm to the true and first inventor and inventors of such manu-

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(1) 21 Jac. 1 c. 3.



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factures, which others, at the time of making such letters-patent and grants, shall not use, so as also they be not contrary to the law or mischievous to the state, by raising prices of commodities at home or hurt of trade, or generally inconvenient. I am not aware of any decision that this statute was ever in force in any Province of Canada. In *Vanorman v. Leonard* (1), Chief Justice Robinson, expressing the view that an importer of an invention was not entitled to a patent under the Statute of Upper Canada, 7 Geo. IV. c. 5, referred to the decisions to the contrary upon the English statute, 21 Jac. 1, c. 3; but as there was a provincial statute, the question as to whether prior thereto the English statute had been in force, did not arise. It has, it appears, been held that for the purposes of the statute, Scotland is within the realm; but there can, I think, be no question that Her Majesty's dominions abroad are not (2), and the use of these words in the statute affords an argument, though it has never seemed to me a conclusive argument, against holding the statute to be in force in a settled colony. After England commenced to establish colonies or plantations, the use of the word realm in an Act would of course show an intention on the part of Parliament that it should not apply to the colonies or plantations. But with reference to earlier statutes of a general character applicable to the condition and circumstances of the people of a colony, and especially where such statutes were declaratory of the common law, I have never seen any difficulty in applying them to the colonies, although in terms they were limited to the realm. But the question is not of present importance, for whether the statute has ever been in force in any part of Canada or not, it is equally true

(1) 2 U. C. Q. B. 74.

(2) Per Jessel, M.R. in *Plimpton v. Malcolmson*, 3 Ch. D. 555. See also Chal. Op. 213; *Brown v. An-*

*nandale*, 1 Web. P.C. 444; *Robinson's Patent*, 5 Moo. P. C. 65; *Rolls v. Isaac*, 19 Ch. D. 268.

that tried by the law of England, which the Provinces of Canada, other than Quebec, received or adopted from the mother country, the contention of the prosecutor in this case cannot be maintained.

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The earliest statute on the subject of patents to be found in the legislation of the provinces constituting the Dominion, is the Act of Lower Canada 4 Geo. IV. c. 25, entitled: *An Act to promote the progress of useful arts in the Province*. By this statute, which was derived from the Act of the United States of 1793, it was recited that it was expedient, for the encouragement of genius and arts in the Province, to secure an exclusive right to the inventor of any new and useful art, machine, manufacture or composition of matter; and it was provided that, under prescribed conditions, letters-patent for any such invention might be granted to any subject of His Majesty who was an inhabitant of the Province. One of these conditions was that the invention should not be known or used at the time of the application, and another that the inventor should swear or affirm that he verily believed himself to be the true inventor or discoverer of that for which he solicited a patent (1). By the fifth section the inventor was given the right, in an action of infringement, to recover treble damages against the infringer, and by the sixth it was provided that in such an action the judgment should be for the defendant, with costs, and the patent should be declared void if it should be made apparent to the satisfaction of the court, the same having been specially pleaded, that the specification was insufficient (the concealment or addition having been made for the purpose of deceiving the public), or that the thing secured by the patent had not been originally discovered by the patentee, but had been in use or had been described in some public work anterior

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to the supposed discovery of the patentee, or that he had surreptitiously obtained a patent for the discovery of another person. By the seventh section provision was made, in the case of interfering applications, for an arbitration to determine to whom the grant should be made. And by the eighth section it was enacted that, on certain proceedings taken in the Court of King's Bench, the court might repeal any patent that had been obtained surreptitiously or upon false suggestion, or if it should appear that the patentee was not the true inventor or discoverer. I have referred to the American origin of this statute, and it will be found that other provisions of provincial statutes, which it will be necessary to mention, have been derived from a like source. That gives rise to the argument that where English and American decisions do not run on the same lines, as in controversies between rival inventors they do not, the latter rather than the former should, in the construction of Canadian patent law, be followed. I shall have occasion to refer to one or two incidents that make against that argument and tend to show that it was the intention of the legislatures of the several provinces of Canada, while adopting in a general way the language of the patent laws of the United States, to adhere, in respect of this question, to the principles and doctrines of the English law; but for the present I shall limit my examination of this statute, and the others to which I shall refer, to the words of the statutes themselves, and ascertain, if I can, what they mean in the connection in which I find them.

Now it will be observed that the seventh section of 4 Geo. IV. c. 25, respecting interfering applications, gives us no suggestion or hint as to whether in the case of rival inventors within the Province the one who first clearly conceived the invention or the one

who reduced it to practice and communicated it to the public was to be preferred. The enactments of later statutes on the same subject are equally silent and the question is to be determined by the other provisions of the statute. The applicant for a patent was not required to show that he was the first inventor, but that he was an original and true inventor or discoverer, and that the thing patented was new, that it was not known or used at the time of his application. Having shown these facts he got his patent, which once granted was certainly good against any knowledge or use of the invention outside of the Province and not accessible or open to the public, and, it seems to me, as well against any such knowledge or use on the part of a rival inventor within the Province. In 1829 the Act 4 Geo. IV. c. 25 was continued by 9 Geo. IV. c. 47 and its benefits extended to any subject of His Majesty, being an inhabitant of the Province, who should in his travels in a foreign country have discovered or obtained a knowledge of, and be desirous of introducing into the Province, any new and useful invention not known or used in the Province before his application. In 1831 inventions in the United States and in His Majesty's dominions in America (1), and in 1851 inventions in Her Majesty's dominions in Europe (2), were withdrawn from the operation of this enactment. With this limitation it re-appears in the tenth section of the Consolidated Statutes of the Province of Canada respecting patents for inventions (3), and continued in force in that Province until 1869, when it was repealed. Neither the courts of the United States nor Congress have ever recognized in any similar way the introduction or importation of any invention from a foreign country, and the enactment

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(1) 1 Wm. IV (L. C.) c. 24. (2) 14 and 15 Vict. (Pro. Can.) c. 79.  
 (3) C.S.C. c. 34, secs. 10 and 11.

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of this provision in 1831 by the legislature of Lower Canada, and in 1851, by the legislature of the Province of Canada, indicates, so far as it goes, an intention on their part in adopting the law of the United States as to patents to make it conform to English views and precedents.

The Act of Upper Canada 7 Geo. IV. c. 5, passed in 1826, follows closely the statute of Lower Canada 4 Geo. IV. c. 25 to which I have referred. In 1836 the latter Act, and 1 Wm. IV. c. 24 were repealed and their provisions re-enacted in 6 Wm. IV. c. 34, Lower Canada. Until after the union of the two Provinces there was no further change in the patent law of either Province.

By the first section of the Act of the Province of Canada 12 Vict. c. 24, passed to assimilate and modify the laws of Lower Canada and Upper Canada respecting patents of invention, it was provided that letters-patent might be issued to any person who was a subject of Her Majesty, and resident in the Province and who had invented or discovered any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement on any art, machine, manufacture or composition of matter or the principle thereof, the same not being known or used in the Province by others before his discovery or invention thereof, and not at the time of the application for a patent in public use or on sale in the Province with his consent or allowance. By the second section it was, amongst other things, enacted that whenever in an action for infringement it should satisfactorily appear that the patentee at the time of making his application for the patent believed himself to be the first inventor or discoverer of the thing patented, the same should not be held void on account of the invention or discovery, or part thereof, having

been before known or used in a foreign country, it not appearing that the same or any material or substantial part thereof had before been patented or described in any printed publication : and also that whenever the plaintiff should fail to sustain his action on the ground that in his specification of claim was embraced more than that of which he was the first inventor or discoverer, or if it should appear that the defendant had used or violated any part of the invention justly and truly specified and claimed as new, the court might exercise a discretion as to costs. By the eighth section of the Act it was declared that the patentee might make a disclaimer whenever by mistake, accident or inadvertence, and without any wilful default or intent to defraud or mislead the public, he had made his specification too broad, claiming more than that of which he was the original and first inventor, some material or substantial part of the thing patented being truly and justly his own, or had in his specification claimed to be the original and first inventor or discoverer of any material or substantial part of the thing patented, of which he was not the first and original inventor, and had no legal or just right to claim the same. In these sections we have the origin of the 32nd and 24th sections of *The Patent Act* upon which the prosecutor relies ; and as it is here that for the first time, in the Acts of any of the Provinces of Canada, we meet with the words " first inventor," and as there is no reason to think that these words have since acquired a signification different from that with which they were then used, it is important to ascertain, if possible, what that signification was.

Under the earlier Acts, and at the time when 12 Vict. c. 24 was enacted, the fact that a patentee was not absolutely the first inventor of the thing patented was not of itself, in either Lower or Upper Canada, fatal

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to his patent. If he were truly an inventor, and the invention new and useful, that was sufficient, and it would be none the less new because some one had a knowledge of it that he kept from the public, or because he had used it secretly. What would defeat his patent and prevent him from being in the eyes of the law the first inventor was the prior knowledge or use of the invention in public. Against such knowledge or use in a foreign country, except in the two cases mentioned of the invention being patented there, or described in a printed publication, the second section of the Act proposed to protect him, if at the time of his application he believed himself to be the first inventor or discoverer: that is if at the time he was an honest inventor and no pirate. The word "first" is here used, it seems to me, to express the idea of novelty, and does not indicate, and is not incident to any controversy of priority of conception between rival inventors. So too in the succeeding clause of the section, where the court was given a discretion as to costs when the plaintiff failed because in his specification of claim he had embraced more than that of which he was the first inventor or discoverer, or the defendant had used a part of the invention justly and truly specified and claimed as new, what is meant is evidently that the discretion might be exercised where the plaintiff failed because some part of that which he had claimed was not new, but on the contrary was at the time of his invention known to, or used by, the public, and which he could not therefore communicate to them. And that appears to me to be the sense in which the words "first and original inventor" were used in the eighth section of the Act. If the patentee being an inventor were the first to publish or make known the invention to the public, there was no occasion for him to disclaim anything. It was "truly and justly his own", and he

“ had a legal and just right to claim the same”. He was in fact within the meaning of the section “ the “ original and first inventor ” thereof. The provisions of the 2nd section of 12 Vict. c. 24 occur in the 15th section of the Act of the United States of 1836, to promote the progress of useful arts, and the provisions of the 8th section in the 9th section of the Act of Congress of 1837. There is, however, one important clause of the 15th section of the Act of 1836 which has never found a place in any Act of any Province of Canada. Dealing with the subject of defences to actions for infringement it was there provided, *inter alia*, that the defendant might set up as a defence and prove that the plaintiff had surreptitiously or unjustly obtained the patent for that which was in fact invented or discovered by another who was using reasonable diligence in adapting and perfecting the same. Here we have what has been thought to be a distinct recognition of the doctrine that a patent issued to one who was an independent inventor might be defeated by a prior undisclosed invention by another who was using reasonable diligence in adapting and perfecting the same. But there is no such provision in any Canadian Act. The corresponding defence as described in the statutes of the Provinces of Canada was that the patent should be void if the patentee had surreptitiously obtained it for the invention and discovery of another person (1). If, under the Provincial statutes, the patentee had not obtained the patent surreptitiously or on some false suggestion, that was an end of the matter so far as that defence was concerned. There

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(1) See Statutes of Lower Canada 4 Geo. IV. c. 25 s. 6; 6 Wm. IV. c. 34 s. 6; Upper Canada 7 Geo. IV. c. 5 s. 6; Province of Canada 14 & 15 Vict. c. 79 s. 8; 9; Prince Edward Island 7 Wm. C.S.C. c. 34 s. 27; Nova Scotia 3 Wm. IV. c. 45 s. 10; R. S. 1st S. c. 120. s. 11, 2nd S. c. 120 s. 11, 3rd S. c. 117 s. 11; New Brunswick 4 Wm. IV. c. 27 s. 9; IV. c. 21 s. 9.



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was no question as to whether some other person had not first conceived the invention which he was keeping to himself and proceeding with reasonable diligence to adapt and perfect. The omission of this provision from all the pre-confederation statutes, which in many respects were copied from the Acts of the Congress of the United States, affords, it seems to me, a strong argument against the view that the legislatures of the several Provinces intended, in adopting such Acts, to incorporate therewith the construction as to rival inventors which the courts of that country had placed thereon.

It is clear, of course, that the words "first inventor" do not, in the Act 12 Vict. c. 24 mean absolutely the first inventor the world over, because its advantages were limited to British subjects resident in the Province, and the provincial inventor was not affected by any foreign invention that had not, in the foreign country, been patented or described in a printed publication. But that does not entirely dispose of the prosecutor's contention, for if these words had reference to a contest as to priority of conception of the invention between rival independent inventors within the Province, it would be open for him to contend that when in 1872 foreigners were admitted to the benefits of the patent laws of Canada, they came in on equal terms with Canadians: and that anything which prior thereto, happening in Canada, afforded sufficient grounds for setting aside a Canadian patent in favour of an earlier inventor in Canada, would thereafter, occurring anywhere, afford grounds for setting aside such patent in favour of an inventor anywhere. I am not prepared to admit that the argument would be good. I think there is something to be said against it, and I should desire, before committing myself to it, to see clearly that Parliament intended to work such radical changes in

our patent laws. But, in the view I take of the statutes that I am discussing, that question is not reached. In my opinion the words "first inventor", used in the Statute 12 Vict. c. 24, had reference to questions of novelty and the publication and disclosure of inventions, and not to any controversy as to prior undisclosed invention.

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The Act 12 Vict. c. 24 was followed two years later by 14 and 15 Vict. c. 79, and in 1859 the two Acts were embodied in the 34th Chapter of the Consolidated Statutes of the Province of Canada, which, with an unimportant amendment in 1866, continued in force until 1869.

The first Act respecting patents for inventions enacted in the Province of Nova Scotia was passed in 1833 (1). Its benefits were limited to inhabitants of the Province who had resided there one year prior to the application for a patent. In later Acts the word "residents" is used instead of inhabitants. The applicant for a patent was called upon to declare that he was the true inventor or discoverer of the thing for which he solicited a patent, and that the invention had not to his knowledge been known or used in Nova Scotia or any other country. If it turned out that the invention had not been originally discovered by him but had been in use or described in some public work anterior to his supposed invention, the letters-patent were void. The law passed through several revisions but without material changes (2), and there is no occasion to follow its history, or to refer to a number of special Acts and exceptional provisions to be found on this subjects in the statutes of the Province (3). It is clear, I think, that the law

(1) 3 Wm. IV. c. 45.

(2) R.S.N.S. 1st S. (1851) c. 120, 2nd S. (1859) c. 120, 3rd S. (1864) c. 117.

(3) 15 Vict. c. 29; 16 Vict. c. 21; 20 Vict. cc. 72, 73; 23 Vict. c. 85; 24 Vict. c. 79; 25 Vict. c. 27 and 28 Vict. c. 4.

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of that Province did not demand of a patentee at the peril of his grant that he be absolutely the first inventor, but that he should be a true inventor, and that the invention should be one that had not been in use or described in some public work prior to his invention thereof. But once obtained, his patent was in no danger from any prior undisclosed invention. And the law of the Provinces of New Brunswick and Prince Edward Island was, it seems to me, on this subject the same (1). New Brunswick, I may state in passing, was the only Province in which, prior to the Union, foreigners were admitted to the advantages of the patent laws of the Province (2). We find in the statutes of this Province the provision as to disclaimer that we found in the Act of the Province of Canada of 1849, in which in the same way and connection, and I think with the same meaning, the words "first inventor" occur (3).

Coming then to the Patent Act of 1869 passed by the Parliament of Canada, we find its benefits limited to persons who had been resident in Canada for at least one year before the application for a patent. The provisions of the Act of 1849 respecting disclaimers, and the court's discretion as to costs where the specification was too broad, are to be found in the 20th and 25th sections of the Act; and invite the same observations as to the occurrence of the words "first inventor" therein. In both instances the words have reference to cases in which the patentee had claimed in his specification more than was new. That, in the Act of 1869, is made still clearer by reference to the 19th section (4), by which it was provided that whenever

(1) N.B. 4 Wm. IV. c. 27; 6 Vict. c. 34; 14 Vict. c. 35; 16 Vict. c. 32; R. S. N. B. cc. 118, 163; 19 Vict. c. 21; 23 Vict. c. 41; 25 Vict. c. 33; and P. E. I., 7 Wm. IV. c. 21.

(2) 14 Vict. c. 35.

(3) 16 Vict. c. 32 ss. 20, 21; R. S. N. B. c. 118 ss. 10 and 11.

(4) See also 22nd section of the New Brunswick statute, 16 Vict. c. 32.

any patent should be deemed defective or inoperative by reason of insufficient description or specification, or by reason of the patentee claiming more than he had a right to claim as new, but the error arose from inadvertence, accident or mistake and without any fraudulent or deceptive intention, the patent could be surrendered and a new one issued. In the 20th section the specification is described as being too broad because the patentee had claimed more than that of which he was the first inventor, and in the 19th section because he had claimed more than he had a right to claim as new. The defect in each case is the same, though differently described, and the question is equally in both cases one of want of novelty and not a controversy as to who, apart from any publication of the invention, was the first inventor.

In the Act of 1869, the expression "first inventor" occurs in another connection and for the first time. By the 40th section of the Act, it was, amongst other things, provided that the Commissioner might grant a patent to an applicant, although the invention had already been patented, if he had doubts as to whether the patentee or applicant was the first inventor or discoverer. The same provision occurs in the 40th section of the Act of 1872, and the 16th section of chapter 62 of *The Revised Statutes of Canada*. Has the expression, used in this connection, a meaning differing from that which attached to it in the earlier statutes? Again, it is clear that the words are not used without qualification or limitation, and that they do not mean the "first inventor" the world over; for the Act of 1869, in which they first occur, was, as we have seen, limited to residents of Canada, and an independent Canadian inventor's patent was not liable to attack because of any knowledge or use of the invention abroad not accessible

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or open to the public. Did the words, as used in the Act of 1869, mean more than that the Commissioner might issue the second patent where he had doubts as to whether the patentee or applicant was entitled thereto, and was that not a question of prior application or disclosure, rather than of prior conception of the invention? Is there any reason for making a new departure and inferring that Parliament intended to reward the person who first conceived, rather than the person who first disclosed, an invention to the public? For my part I see none, and there does not appear to me to be any difficulty in the way of holding that the words "first inventor," occurring in the 40th section of the Act of 1869, and in the corresponding sections of the later Acts, mean, as they did in the English Act, and in the pre-confederation statutes to which I have referred, the person who being a true inventor of some useful thing first discloses his invention to the public.

There is no occasion to go through the Acts of 1872 or 1887, and to dwell upon provisions that we have examined at their source and origin. In 1872 foreigners were, as we have seen, admitted to the advantages and privileges of the patent laws of Canada; but I see in the Act of that year no indication of any intention on the part of Parliament to confer upon them any special privileges. Up to that time the Canadian patentee was in no danger from the subsequent disclosure of any prior knowledge or use of the invention in any other country not accessible or open to the public thereof, and as I read the earlier statutes, he had nothing to fear because of such secret knowledge or use anywhere, and there is nothing in the Act of that year, or in any later statute, that requires any different construction to be put upon the patent law of Canada.

In *Barter v. Howland*, decided in 1878 (1), the facts were that the plaintiff, Barter, and one Smith, the

(1) 26 Grant 135.

assignor of the defendants, were independent inventors of a combination or improvement in a machine for dressing flour. Smith had constructed such a machine at Minneapolis in April, 1871. Barter swore that he had perfected his invention several months earlier at Faribault, Minnesota, but the evidence on that point was conflicting. Smith's Canadian patent was dated in April, 1873, Barter's on the 20th of January, 1874, on an application filed in the patent office in September, 1873. In dismissing the plaintiff's bill, Vice-Chancellor Blake said:—

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Smith, the assignor of the defendants, invented that which is covered by the two Canadian patents in question. He had a right, on the evidence before me, to apply for a patent, and he did so, and obtained his patent before any application was made by the plaintiff. Of the two inventors, the assignor of the defendants first obtained a patent. This being so, I do not see on what principle I can deprive them of the right of manufacturing and vending the articles, the subject-matter of their patent.

But it is said that this case is in conflict with *Smith v. Goldie* (1), and cannot now be supported. With that view I do not agree. In the latter case, as Mr. Ritchie pointed out, Mr. Justice Henry, with whom Mr. Justice Fournier and Mr. Justice Taschereau agreed, stated that the evidence left no doubt on his mind that Smith was the first and only inventor of the combination he claimed in his specification, and that he felt a little doubt that the other parties who had obtained the two contesting patents, had become acquainted with the combination by obtaining the knowledge of his discovery (2). The question in that case, then, was not one between independent inventors, but between an original inventor and those who sought to justify their acts under patents "surreptitiously obtained" for his invention; and his patent being otherwise held to be good, the defence failed as a matter of course. But that is not

(1) 9 Can. S.C.R. 46.

(2) 9 Can. S.C.R. 60.

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the question in the present case, nor was it the question in *Barter v. Howland* (1) which appears to me to have been well decided, and to be a distinct authority in the defendant's favour. In an earlier case, *Vanorman v. Leonard* (2) decided when the Act of 7 Geo. IV. c. 5 was in force, a plea that the plaintiff was not the first discoverer of the alleged invention, but on the contrary that the same had been wholly and in part publicly and generally practised, used and vended at Albany in the State of New York, one of the United States of America, before the said supposed discovery of the plaintiff, was held to be a good plea. Apart from a matter of pleading, the principal question discussed was as to whether the Act extended to an importer or introducer of an invention from abroad, and it was thought that it did not. The case on the plea, however, was one of want of novelty and I mention it principally to add that I understand the Chief Justice, when he said that the preamble of the Act 11 Geo. IV. c. 34 showed that the legislature did not consider that a patent right could under the former law be granted to any but the actual original inventor, to mean an original independent inventor, not necessarily the first inventor. If more were meant I should not be able to agree. The preamble of the Act recites that the provisions of 7 Geo. IV. c. 5 were confined to sole inventors, and that Horner, for whose relief the Act 11 Geo. IV. c. 34 was passed, was a co-inventor with one Keys, a foreigner. If that were not the true difficulty to be overcome, I think it probable that some publication or use of the invention in the United States stood in Horner's way; not that he had any thing to fear from any earlier undisclosed invention on the part of his "co-inventor".

(1) 26 Grant 135.

(2) 2 U.C.Q.B. 72.

In the result, I am of opinion that under the patent law of Canada a prior foreign invention, of which the public had no knowledge or means of knowledge, is not sufficient to defeat a patent issued to an independent Canadian inventor. Whether the same rule should be followed in cases of conflicting applications for patents, is another question. In the present case the patent having been issued, the Crown's power or authority in respect thereof is exhausted. If the patent be good, if there be no ground of impeachment, it must stand, and the second patent is waste paper. In the case of conflicting applications, the Crown has not parted with its power to make a grant, and there is provision for the appointment of arbitrators to decide between the applicants. In such a controversy, it seems to me that the first applicant, if he be a true inventor and the first to make known his invention to the public, should be preferred. If there is any doubt as to that being the law at present, or if it is not the law, I venture to hope that the doubt may be removed or the law changed, for not only is the rule a just one, as it gives the reward to the person who first communicates a knowledge of the invention to the public, but it is a convenient one in respect of the proof by which under it any question of priority may be determined. On the other hand, it appears to me that the doctrine that he who first conceives an invention is to be preferred to him who first reduces it to practice and gives it to the public, leads of necessity to an inquiry as to what men may have done in secret, and opens wide and dangerously a door to perjury and the fabrication of evidence. In the present case there is nothing to throw even a shadow of suspicion upon the honesty of either the rival inventors; but one may easily conceive of instances in which to support a case of prior conception of an invention, evidence that it would be impossible to meet or discredit might be falsely devised.

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The only other objection taken to the patent has reference to the specification. In the description the following clause occurs:—"On each side of the felloe "D a lip A is shaped to form a recess into which the "strip C will fit". And it is objected that the drawing may not be looked at to see what the recess is and how the strips fit into it. By the fifth clause of the 13th section of *The Patent Act* it is provided that one duplicate of the specification and of the drawings, if there are drawings, shall be annexed to the patent, of which it shall form an essential part; and the other duplicate shall remain deposited in the Patent Office. In *Smith v. Ball* (1), Chief Justice Robinson, referring to a similar question and statute, said that—

"Taking the plan and specifications annexed as if they formed part "of the contents of the patent, which we are not merely allowed, but "are directed to do by the seventh and eighth sections of the statute, "Consol. Stats. C. ch. 34, it seems to us that the alleged invention is "sufficiently described".

There can, I think, be no doubt that the drawings may be looked at to explain and illustrate the specification. If the defendant were attempting by reference thereto to limit his claim, or to enlarge it, in a manner not provided for in the specification, that would be another matter (2). But he is not attempting anything of the kind, and it seems to me that his specification, illustrated by the drawing attached thereto, is sufficient.

I find all the issues raised by the pleadings in the case in favour of the defendant, for whom there will be judgment with costs.

*Judgment accordingly.*

Solicitors for plaintiff: *Gormully & Sinclair.*

Solicitors for defendant: *Rowan & Ross.*

(1) 21 U.C.Q.B. 126.

L. R. 4 Ch. D. 607; *Clark v. Adie*,

(2) *Hincks v. Safety Lighting Co.*, L. R. 2 Ap. Cas. 315.