

1893 J. O. WISNER, SON & COMPANY } APPELLANTS;  
 \*Mar 17, 18. (PLAINTIFFS)..... }  
 \*June 24.

AND

COULTHARD, SCOTT & COM- } RESPONDENTS.  
 PANY AND OTHERS (DEFENDANTS) }

ON APPEAL FROM THE COURT OF APPEAL FOR ONTARIO.

*Patent—Combination—Old elements—New and useful result—Previous use.*

In an application for a patent the object of the invention was stated to be the connection of a spring tooth with the drag-bar of a seeding machine and the invention claimed was “in a seeding machine in which independent drag-bars are used a curved spring tooth, detachably connected to the drag-bar in combination with a locking device arranged to lock the head block to which the spring tooth is attached, substantially as and for the purpose specified.” In an action for infringement of the patent it was admitted that all the elements were old but it was claimed that the substitution of a curved spring tooth for a rigid tooth was a new combination and patentable as such.

*Held*, affirming the decision of the Court of Appeal, Gwynne J. dissenting, that the alleged invention being the mere insertion of one known article in place of another known article was not patentable. *Smith v. Goldie* (9 Can. S. C. R. 46) and *Hunter v. Carrick* (11 Can. S. C. R. 300) referred to.

APPEAL from a decision of the Court of Appeal for Ontario affirming the judgment of the Queen’s Bench Division by which the plaintiffs’ action was dismissed in respect to the patent in question.

The following statement of facts is taken from the judgment of Mr. Justice Sedgewick in this court:—

The plaintiffs carry on business at Brantford and the defendants at Oshawa, both as manufacturers of agricultural implements.

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\* PRESENT :—Sir Henry Strang C.J., and Fournier, Taschereau, Gwynne and Sedgewick JJ.

On the 22nd of February, 1887, the plaintiffs had letters patent granted to them (no. 26049) as assignees of one James Samuel Heath for alleged new and useful improvements in spring hoes (these letters patent being a reissue of letters patent no. 17833 granted to plaintiffs on the 6th October, 1883), and on the 24th October, 1883, the plaintiffs had granted to them, as assignees of Heath, another patent for alleged new and useful improvements in combined seeding and drilling machines under no. 17963.

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The allegation of the plaintiffs is, that the defendants had infringed both these patents by manufacturing and putting upon the market certain seeding and drilling machines containing certain of their patented improvements. At the trial the alleged infringements were by consent or abandonment reduced to two, namely: an infringement of claim no. 2 in patent no. 26049, and claim no. 2 in patent no. 17963. In the former patent the specification stated that—

The object of the invention was to simplify the construction of the spring hoe and to arrange it so that the drill hoe can be taken off and the cultivator tooth put in its place without removing a single bolt or disconnecting the lifting chain, and that it consisted in the formation and arrangements of parts as thereinafter specified.

And what was claimed as the invention was,—

2nd. “In a drill hoe or cultivator tooth having a projection to fit within the drag bar, and a notch formed on the top side of the said projection to fit on to the bottom side of the pivot pin, the combination of a strap, bolted or otherwise, fastened to the drag bar and extending below the notched projection, for the purpose of holding it against the pivot pin as specified.”

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In the latter case (which is the case to be considered in this appeal) the object of the invention was stated to be the connection of a spring tooth with the drag bar of a seeding machine, and the invention was claimed to be as follows :—

“ In a seeding machine in which independent drag bars are used, a curved spring tooth detachably connected to the drag bar in combination with a locking device arranged to lock the head block to which a spring tooth is attached, substantially as and for the purpose specified.”

The defence denied the novelty and utility of the alleged inventions. It set up that they were known and used by others previously, and were in public use or for sale for more than one year before the patents were applied for, and generally denied the alleged infringements.

The case was tried before Mr. Justice Ferguson, at Toronto, the trial lasting six days. Judgment was given in favour of the plaintiffs on both the claims above specified, and an injunction was ordered restraining the defendants from further infringement, the amount of damages by reason of the infringement being left to reference. Upon appeal by defendants to the Queen's Bench Division judgment was delivered dismissing the plaintiffs' action with costs. The plaintiffs thereupon appealed to the Court of Appeal. That court in delivering judgment found unanimously in favour of the plaintiffs as to claim 2 of letters patent no. 26049, but dismissed the appeal, (Mr. Justice Burton dissenting) with respect to claim 2, of letters patent no. 17963 ordering a reference to take an account of damages with respect to that claim and awarding to plaintiffs the whole costs of action, less one fourth. In pursuance thereof damages were awarded to plaintiffs in the sum of \$6,190. This amount together with costs

has been paid, and the claim as far as respects the letters patent no. 26049 has been finally settled between the parties. It is from the judgment of the Court of Appeal dismissing the plaintiffs' claim in respect to patent no. 17963 that this appeal is taken.

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*Ridout* for the appellant referred to *Harrison v. Anderston Foundry Co.* (1), and *Smith v. Mutchmore* (2).

*Arnoldi Q.C.* and *Rouf* for the respondent.

THE CHIEF JUSTICE and FOURNIER J. concurred in the judgment delivered by Mr. Justice Sedgewick.

TASCHEREAU J.—I am of opinion that the appeal should be dismissed.

GWYNNE J.—The present appeal relates only to claim 2 of letters patent 17963, dated 24th October, 1883. I am of opinion that this appeal should be allowed and the judgment of the learned trial judge restored, upon the grounds stated in the judgments of that learned judge and of Mr. Justice Burton, in the Court of Appeal for Ontario. The evidence clearly establishes, and it has been so found by the learned trial judge, that as a matter of fact in a combined seeding and drill machine in which independent drag bars are used, the introduction of a small curved spring tooth, detachedly connected to the drag bar in combination with the locking device arranged to lock the head block to which the spring tooth is attached, as in the appellants' machine, is a marked improvement upon machines formerly used for the same purpose in this, that it does attain its results in a much more useful and beneficial manner than machines formerly used for a like purpose did.

(1) 1 App. Cas. 574.

(2) 11 U. C. C. P. 458.

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This is all the novelty which the appellants claim for their machine the several parts being all old, but with great deference to the opinion of my learned brothers I am of opinion that the attaining such more useful and beneficial results is sufficient to support the letters patent granted for the machine producing such results.

SEDGEWICK J.—The points in controversy are well stated by Mr. Justice Ferguson in his judgment. He says:—

Then as to claim no. 2, in patent no. 17963. It is admitted that all the elements of this combination are old elements. It is also admitted that there was and is a combination prior in time to this and similar to it, excepting that in that combination the teeth used were rigid teeth and in this combination the teeth are curved spring teeth. The locking device is such a one as I have already endeavoured in some degree to describe. In regard to this combination the defendants say that it is simply inserting in an old combination a spring tooth attached by the same means as those before connecting the rigid tooth, and they argue that this cannot be a new combination. The view of the plaintiffs and the way in which their counsel states the matter do not, I think, differ widely, or perhaps not at all, from this. The plaintiffs admit that if a rigid tooth were substituted for a spring tooth the then combination would be old, and they say that what this virtually did was to take out of an old combination of old elements one of these elements, the rigid tooth, and to put in its place another and different old element, the curved spring tooth, thereby forming another and different combination which they say is a new combination, producing new and useful results.

According to the evidence of the witness (Mr. Ridout) the combination contains four elements: First, the independent drag-bars; second, the locking mechanism; third, a curved spring tooth; and fourth, means of detachably connecting the curved spring tooth to the drag-bar and locking mechanism. The witness says, and it is admitted, that these are old elements; that a curved spring tooth detachably connected to the drag-bar is old, and this does not seem to be disputed. As nearly as I can understand then the parties do not disagree as to the facts of the construction of the combination in question. They seem to differ chiefly in this:—the plaintiffs say that this is a new combination producing new and useful results. The defendants say that under such circumstances this cannot be a new combination.

The machine which has given rise to this litigation is called a combined drill and seeder. The machine itself was in part exhibited at the argument before us, and in the case there is a diagram of it. It has for its object two purposes : first, by means of what is called a drill hoe making a trench or furrow in the ground and depositing seed therein through a tube in the drill hoe ; and secondly, by substituting a spring tooth in place of a drill hoe, and with it breaking up the ground like an ordinary harrow. It is important to observe that the drill hoe and the spring tooth are not used at the same time. There is no mechanism in connection with the machine by which two processes, namely, the making of the furrow and depositing of the seed therein, and the harrowing of the ground, are carried on at the same time ; in other words, the machine is used at one time as a seeder only, and at another time, by means of a different instrument inserted therein, as a harrow or cultivator only. It is a complete machine for two purposes ; with the drill hoe attached it is a seeding machine only, and with the spring tooth attached it is a cultivator or harrow only. As Mr. Justice Ferguson stated, and as was admitted by the plaintiffs' counsel at the argument, there is nothing in any of the separate elements of this machine when used as a cultivator or harrow that is new ; neither the spring tooth nor the means of attaching that spring tooth to the drag bar, nor the drag bar itself, nor the locking mechanism by means of which the tooth springs back again into place when more than a certain strength is applied to it, nor any of the means by which the motive power is applied to the machine as a whole, is new, nor is there anything new in the machine when, by the removal of the spring tooth and the substitution of a drill hoe, it is used as a seeder, the drill hoe and spring tooth being attached to the drag bar in exactly

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the same way and by a process not now in question (although it was in question in respect to that portion of the plaintiffs' claim which has been settled, as I have above stated). In fact the machine in question, if used as a cultivator or harrow simply is all old ; if used as a drill hoe only it is likewise all old ; as a cultivator with one appliance it is an old machine and as a seeder with another appliance it is an old machine. The manufacturer may sell the one machine only, or the other machine only, or both machines, the purchase of both machines involving only the acquisition of the curved teeth or of the spring hoe. If the machine is sold without the hoes the purchaser has in his possession a cultivator every element of which and every combination of which is old ; so, too, if he purchase a machine without the teeth, he has in his possession a machine every element of which and every combination of which is likewise old. But beyond this there is in the market, as I understand, a machine like the present, designed for the same objects, in which cultivator, teeth and drill hoes are interchangeably used, but in that machine the cultivator tooth, instead of being a spring tooth, is rigid, and it is from this difference, and from this difference alone, that the plaintiffs maintain the patentability of the machine in question and assert that it, as a whole, produces a known result in a more useful and beneficial way. But there is likewise upon the market a machine like the present, in so far as it fulfils the office of a cultivator or harrow, with curved spring teeth attached to a drag bar, with locking mechanism, &c., &c.

The principles of law involved in this case are well understood ; they were very fully discussed in the case of *Smith v. Goldie* (1), before this court in 1882, when the late Chief Justice delivered an elaborate judgment,

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

holding that the invention involved in that case was patentable, and in the case of *Hunter v. Carrick* (1), in 1885, where an alleged invention was held to be otherwise. The first and fundamental requisite in order to entitle to a patent is, that the machine is new. Its production must have required the existence and exercise of the inventive faculty, whether the idea of the invention was a happy hit, as has been expressed, or the result of patient and laborious investigation. There must be an exercise of skill and ingenuity to entitle it to the protection of an exclusive grant. *Saxby v. Gloucester Waggon Co.* (2). An invention is likewise patentable if it consists in the improved application of existing machines to materials whether new or old, if there be a new and beneficial combination and application of well known machines; a patent properly limited to and claiming this combination will be valid. *Wright v. Hitchcock* (3). And if a combination of machinery for effecting certain results has previously existed and is well known, and an improvement is afterwards discovered consisting for example of the introduction of some new parts, or altered arrangement of some parts of the existing constituent parts of the machine, an improved arrangement or improved combination may be patented; *Foxwell v. Bostock* (4); or, as was stated by Lord Hatherley in *Harrison v. Anderson Foundry Co.* (5) before the House of Lords:—

A new combination of old parts producing a new result or producing a known result in a more useful and beneficial way is patentable.

And it was upon that principle that *Smith v. Goldie* (6) in this court was determined. The law is similar in the United States. In *Loom Company v. Higgins* (7) it is stated that,—

(1) 11 Can. S. C. R. 300.

(2) 7 Q. B. D. 305.

(3) L. R. 5 Ex. 37.

(4) 4 De G. J. & S. 298.

(5) 1 App. Cas. 582.

(6) 9 Can. S. C. R. 46.

(7) 105 U. S. R. 591.

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It might be laid down as a general rule, though perhaps not an invariable one, that if a new combination and arrangement of known elements produce a new and beneficial result never obtained before it

Before applying these principles to the case in hand I feel bound to call attention to the claim as now put forward by the appellants. What they now claim to be an invention is an alleged combination in one machine of what was formerly two machines, namely, a cultivator and a seeder, the cultivator having spring teeth instead of rigid teeth. What they claim in the patent as the object of invention is to connect a spring tooth with a drag bar of a seeding machine, and what the inventor claims as his invention is in a seeding machine—

in which independent drag-bars are used, the curved spring tooth detachably connected to the drag-bar in combination with a locking device, arranged to lock the head block to which the spring tooth is attached.

In my judgment the wording of the claim as put forward in the patent conveys little or no meaning and certainly does not in terms describe the combination now contended for, and upon the authority of the *Keystone Bridge Co. v. Phoenix Iron Co.* (1), *Burns v. Meyer* (2), *Hinks v. Safety Lighting Company* (3), I am inclined to think the appellants would have to fail on this ground. But I am not disposed to rest my judgment upon this point, but rather upon the substantial question: Whether, under the circumstances of this case, the alleged invention, so far as this specific claim is concerned, is the subject of a patent.

In considering this question it must be kept continually in mind that the plaintiffs have already received damages by reason of the defendants' infringement of a patent held by them covering this machine, in so far

(1) 95 U.S.R. 274.

(2) 100 U.S.R. 671.

(3) 4 Ch. D. 607.

as the attachment of the drill hoe or the spring tooth, as the case may be, to the drag bar, and the action in connection with both of the locking devices are concerned. The plaintiffs' claim is that the mere use of a curved spring tooth in a machine, which by the use of a tooth or a hoe may be either a cultivator or a seeder respectively, has been patented to them by the patent in question, and that the defendants' use of a spring tooth in such a machine is an infringement.

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Now, I am not able to see that the machine in question is a combination at all within the meaning of the cases which hold a combination patentable.

There are upon the market cultivators with independent drag bars and locking devices in which curved spring teeth are used. This machine, so far as the claim in question is concerned, is that machine and nothing more. This machine so far as the evidence goes produces the same results as the other in precisely the same way or, if in a different or more beneficial way, not by reason of the tooth being curved and flexible, but by reason of the improvements which the plaintiffs in other inventions have secured to them in connection with the attaching of a hoe or tooth, whether rigid or flexible, to a drag bar. The new and beneficial results, if any, have been produced not by the curved spring tooth but by other means, the curved spring tooth not being the occasion of these results. If there had been invented a new tooth of certain specified curves and other stated dimensions and shape, which upon trial was found to produce better results than any other curved tooth in existence, that doubtless might have been the subject of a claim itself but there is no such claim here. The plaintiffs insist upon their exclusive right to use a curved spring tooth in any machine which may be used both as a cultivator and a seeder. It appears, too, that in this case there is no

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combination at all. The combination mentioned in the cases is a combination which produces a result; here, there is no use at the same time of the tooth and the drill hoe. The idea of attaching a tooth to a drag bar at one time and for one purpose, and of attaching a hoe to the same drag bar at another time and for another purpose, does not involve, in my judgment, the exercise of the inventive faculty, any more than the harnessing of a wagon to a horse on one day for one purpose and the harnessing of a sleigh to the horse on another day for another purpose, or in the attaching to an engine of a freight train on one day and a passenger train on another. The idea itself is not new. The plaintiffs themselves had previously obtained a patent for an invention the object of which was to simplify the construction of a spring hoe and to arrange it so that the drill hoe could be taken off the drag bar and a cultivator tooth put in its place. The cultivator tooth there specified was not a rigid tooth but a curved flexible tooth.

As the learned Chief Justice in the Court of Appeal suggests, the mere insertion of one known article in place of another known article, namely, a tooth into a known machine, is not a patentable matter. If, as I have already intimated, there was some useful and novel device in the method of such insertion, or in securing or producing a new or more beneficial result after such insertion was made, the question would be altogether different. The plaintiffs' machine, although called a combined drill and seeder, is not a combination; it is not one machine but two machines. In so far as it is either (as respects this claim), it is wholly an old machine, and in neither case does it produce according to the evidence any new or useful result, even although it may be admitted that a machine which, with one mechanism attached can do one thing,

and another mechanism attached can do another thing, 1893  
 is a most useful machine. A horse that draws both a WISNER  
 carriage and a sleigh is a more useful animal than a v.  
 horse that draws a carriage only. COULTHARD.

It seems to me that the claim of the plaintiffs, if al- Sedgewick  
 lowed, would be to prevent any manufacturer from J.  
 any time hereafter manufacturing a machine for seed-  
 ing and cultivating purposes together of which a  
 curved spring tooth forms part. I am not prepared to  
 give to the plaintiffs such a far reaching monopoly.

In my opinion this appeal should be dismissed.

*Appeal dismissed with costs.*

Solicitor for appellants: *John G. Ridout.*

Solicitors for respondents: *Roaf & Roaf.*

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