

29, 1934

In the Privy Council.

No. 63 of 1933.

ON APPEAL  
FROM THE SUPREME COURT OF CANADA.

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BETWEEN

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

AND

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

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CASE FOR THE RESPONDENTS.

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1. This is an appeal by Special Leave by the Lightning Fastener Company, Limited from the judgment of the Supreme Court of Canada dated the 25th day of April 1933, allowing an appeal by the Colonial Fastener Company Limited and G. E. Prentice Manufacturing Company from the Judgment of the President of the Exchequer Court dated the 4th day of April 1932 in an action wherein Lightning Fastener Company Limited was the Plaintiff. RECORD. p. 191. p. 143.

2. The action was instituted by Statement of Claim and Particulars of Breaches dated the 17th day of April 1931. p. 1.

10 3. The action was brought for alleged infringement of Letters Patent of Canada No. 210202 dated the 5th day of April 1921 (expiring the 5th day of April 1939) for "machines and methods producing straight and curved fastener stringers" issued to the assignee of Gideon Sundback the claims alleged to be infringed being all of the claims in the patent numbered 1 to 20, but the Appellant at the trial chose to rest his case on Claims 1, 2, 3, 7, 8, 10 and 19 only. p. 215. p. 18, l. 46.

4. The Defence of both Defendants was delivered on the 27th June 1931, with particulars of objections to the validity of the Patent. p. 5.

RESPONDENTS' CASE.

RECORD.  
p. 143. 5. The action was tried on the 3rd, 4th and 5th February 1932, Judgment was delivered on the 4th April 1932, in favour of the Plaintiff Appellant.

p. 191. 6. The present Respondents appealed to the Supreme Court of Canada and judgment on the said appeal was delivered on the 25th April 1933 in favour of the present Respondents.

p. 198. 7. Special leave to appeal to His Majesty in Council from the said judgment of the Supreme Court of Canada was granted on the 24th July 1933.

8. The questions raised by the present appeal are :—

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1. Whether Claims 1, 2, 3, 7, 8, 10 and 19 of Canadian Letters Patent No. 210202 are valid; and

2. Whether the said claims are infringed by the manufacture and use of a certain machine hereinafter referred to as "the Prentice Machine."

p. 122, ll.  
41-47.

p. 123, ll.  
1-9.

9. The Respondents do not contest that the particular machine which is described in Canadian Letters Patent No. 210202 is novel and has in certain of its features sufficient inventive ingenuity to support Letters Patent. They contend, however, that the particular features of the machine described upon which novelty and subject matter depend are not present in the Prentice Machine, and further that unless the claiming clauses mentioned in the preceding paragraph hereof upon which the Respondents are alleged to infringe are limited in their construction to these particular features they are so wide as to be invalid.

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10. In order to appreciate the nature of the invention it is necessary to describe first of all the purpose which the machine in question has in view.

Ex. U, Book of  
Patents, p. 69.  
Physical  
Exhibits  
M and N.

11. Prior to the application for the said Patent, namely, in the year 1912 there had already been granted a British patent to Mrs. Katherina Kuhn Moos and Henri Forster, No. 14358 of 1912, for a particular form of fastener for wearing apparel and the like, which is now generally known as a "Zip" or "Zipper" fastener, and which is described in the said specification as being of the type wherein two staggered rows of fastening members are adapted to be brought into locking engagement with each other by means of a slide moved along the two rows.

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12. The slide fastener known as a "zipper" is used to close a longitudinal opening or slit and consists of two lengths of cloth tape disposed on opposite edges of the opening to be fastened, each tape edge next the opening bearing a series of spaced metal units, the units on one tape being staggered in position with respect to the units on the other tape and all the units being so shaped as to interlock, the series on one length with the series on the opposed length of tape when brought together by a slider which envelopes the two interlocking edges and is manually movable thereon. Specimens of fasteners as made by both parties are in evidence.

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Exhibits " E " " F " 21 and 22  
(Physical Exhibits).

13. In these fasteners each individual interlocking unit has jaws at one end to straddle and be compressed on the edge of the tape, which edge is beaded or corded to afford a strong seat for the unit. The projecting interlocking end of each unit is formed with a projection on one side and a recess or socket in the opposite side. The opposing series of units are interlocked through the action of the slider by nesting the projection of each unit of one series in the socket of the adjacent unit of the other series.

RECORD.

14. The object of the machine the subject of the Letters Patent in suit is to enable the individual metal units of such fasteners to be pressed  
10 out of a metal strip and fastened on to the lengths of cloth tape previously referred to in a continuous operation.

15. The machine of the patent in suit comprises guides and punches for receiving a long strip of metal stock from which are stamped the metal interlocking units. To carry the unit from the point where it is cut out to the point where it is pressed into form, and subsequently to the point where its open-jawed end is set astride the tape, the machine replaces the cut-out unit in the blank from which it has been cut. The blank then carries the unit along through the machine, and at the same time protects it from distortion at several points. One is where the unit is pressed into  
20 form, and the edges of the blank are tightly gripped by guide plates at each side. Another is where the jaws of the unit are clamped together (to hold the unit) on the tape; this is done by positively actuated side punches striking the blank and through it, bending the jaws over the beaded edge of the tape.

p. 61, ll.  
10-29.p. 115, l. 44-p.  
116, l. 4  
EX. I, p. 217, ll.  
18-20.p. 116, l. 12  
to p. 117, l.  
26.p. 113, ll.  
38-42.

16. The tape is fed into the machine in long lengths by feed mechanism which feeds the tape along step-by-step for a number of short distances, one unit being affixed at each step. When the desired number of units for one group has been affixed, the tape is fed or advanced a longer step so as to provide a gap or space between groups of units.

p. 62, ll. 19-  
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17. Elsewhere and thereafter the tape as it comes off the machine is cut apart between successive groups of units so as to provide a number of separate stringers, each stringer having a single series or group of closely spaced units. All the metal units and all the stringers being substantially identical, any two stringers having the same number of units, can subsequently be manually assembled together with slider and stops to constitute one complete fastener.

p. 63, ll. 9-  
22.

18. The process, therefore, broadly considered, comprises punching units of the form required from a metal blank, carrying them into position, and pressing them on to the beaded edge of the tape so as to form the desired  
40 straight or curved fastener stringers.

19. The Respondents contend that the general idea indicated in the preceding paragraph is old, and that the real invention of the Patent in suit is limited to the specific means by which the punched-out metal elements

RECORD. are conveyed through the machine to the tape, and the specific means by which, after such conveyance, they are attached to the tape.

Exhibit I,  
p. 217,  
ll. 16-31.

20. In the said Specification the individual metal elements are first punched from the metal band, are then restored into position in the metal band, and are so carried along to the point at which they meet the tape to which they are to be attached, the metal band thus acting as a carrier.

In their conveyance towards the tape they are acted upon by further punches which form the jaws by which they are to be attached to the tape, and by punches which form the projections and recesses transversely disposed to these jaws. On meeting the tape the individual metal elements are clamped thereon by punches acting not upon the elements themselves but upon the metal band from which they were punched. 10

21. The Respondents contend that the two novel features of the said Patent are the use of the metal band in the manner indicated, to act as a carrier for the punched-out elements, and the clamping of the jaws of such elements on to the tape by punches operating not upon the elements themselves but upon the band metal carrier.

p. 116, l. 10.  
p. 114,  
ll. 6-16.

22. Neither of the features indicated in the preceding paragraph are present in the machine alleged in this action to constitute an infringement of the said Letters Patent. 20

p. 95, ll. 19-  
22.

23. The Prentice Machine comprises an old Manville punch press, of which he had a number in the factory, and which was mechanically identical with the Manville press shown on page 3 of the Manville catalogue, Exhibit P (not printed) and like nearly all punch presses, had a step-by-step ratchet and pawl feed for the metal strip from which the punchings are formed, dies and punches suitable for the turning out of a unit of the desired shape, one punch contacting the metal strip on the first down stroke of the press to form the pin and socket, while on the second down stroke a second punch cut out the unit around the previously formed pin and socket and pushed it

p. 95, ll. 1-3.  
p. 64, ll. 29-36;  
p. 99, ll. 19-22.

p. 97, ll. 10-13;  
p. 113, ll. 11-13.

down to a lower level in the press. To attach the punched-out unit to the tape there was placed behind it at said lower level a reciprocating slide, moved by the punch head. On the upstroke of the press the slide moves 30

p. 97, ll. 16-  
31.

forward with the unit in front of it, pushing the jaws of the unit astride the cord of the tape and against rocking pincers which bend them together. To feed the tape step-by-step to receive successive punchings the ratchet and pawl feed used for feeding the metal strip was duplicated. The regular ratchet and pawl feed mechanism gave the tape a uniform step-by-step feed.

p. 99, ll. 6-7;  
p. 106, ll. 31-36.

p. 113, ll.  
26-28.

In order to get a long step after a series of uniform short steps, to group the fasteners, a secondary ratchet and pawl feed mechanism was adopted. In this feed motion the first ratchet and pawl mechanism advances the strips uniformly step-by-step for the desired number of steps, and the secondary ratchet and pawl comes into action at intervals, due to the long interval between the teeth of its ratchet, and gives the strip a jump feed. 40

24. In support of their contention as set out in paragraph 20 hereof that the general operation of the invention the subject of the Patent in suit was old, the Respondents relied upon a number of prior documents and prior users. RECORD.

25. Punch presses were in common use years before either of the parties applied them to making stringers for slide fasteners. The witnesses on both sides agree to the common and ancient use of such presses. An example of the old punch presses will be found in the Manville press used by Prentice in the Prentice machine, shown in the 1908 catalogue of the E. J. Manville Machine Company of Waterbury, Connecticut. p. 95, ll. 1-14.  
Exhibit P,  
not printed.

It is an old and common practice, to provide punch presses with one or more shaping and cutting tools and dies according to the required shape of the article to be made. Prentice's application to his punch press of a die for forming the pin and socket and the punch for cutting out the unit is in its original aspect a very old process. p. 95, ll. 12-14.

26. The "Securo" tape fastener was in 1902 or 1903 made on a machine which automatically attached the individual snap fastener members to tape in the desired spacing. The snap fastener members themselves were made in a separate machine and fed from a hopper into an affixing machine one at a time down a chute under a punch press which pressed their fastening prongs through the tape and clinched them there. The tape was fed through the machine under the affixing press by a ratchet feed device, step-by-step, for the several uniformly spaced members of a group, and then by means of a longer tooth on the ratchet wheel, the tape was fed a longer distance to provide the gap between groups. p. 87, ll. 32-38.

27. Male fastener members were fixed to one length of tape; female fastener members were fixed to another long length of tape, each tape was then cut up by hand between groups of fasteners, and the respective lengths assembled to make the completed fasteners. The machine for making these fasteners was used by Prentice's then company in regular commercial production about the years 1902 and 1903. p. 87, ll. 19-20.

28. In this "Securo" tape machine we find within Prentice's personal experience as superintendent of the Traut & Hine Manufacturing Company the prototype of his mechanism for automatically feeding fastener units to a tape, attaching them to the tape one by one in a punch press, advancing the tape step-by-step to attach a group of units in spaced relation on the tape, and then giving the tape a long step or jump feed to separate the groups by a long space or gap. The purpose of the machine was the same in both cases, namely to apply fastener members on tapes in groups of predetermined length separated by a longer space so that the stringers so formed could be cut apart through the gap and the individual lengths assembled in pairs to be sewed to the opening in a garment or the like. The differences in the two machines comprised only the mechanical changes dictated by the differences in the units themselves. p. 87, ll. 19-38.

RECORD. 29. Among the most important prior documents relied upon by the Respondents were :—

Ex. J, Book of Patents, p. 19.  
RECORD.  
Ex. B, p. 200.

(a) Major U.S. Patent No. 525914 of 1894.

(b) Aronson's Canadian Patent No. 107456 of 1907.

Ex. J, Book of Patents, p. 39.

(c) Stover's U.S. Patent No. 240477 of 1881.

Ex. J, Book of Patents, p. 49.

(d) Brainard's U.S. Patent No. 292467 of 1884.

RECORD. 30. It was in November, 1925, that Prentice began the construction of a machine for making stringers of the Kuhn-Moos type on a commercial scale. The machine was completely laid out and in course of construction in December, 1925, was completed in January, 1926, and its operation in regular commercial production was begun in February, 1926. The short length of time taken for its development, with other circumstances— including the utilization of a standard form of punch press by Prentice, and the well-known use of many forms of punch process in machines for making and attaching units to stringers of various kinds—is corroborative of the Respondents' contention that mechanical skill only was involved in the development of the Prentice Machine.

p. 98, ll. 4-7.  
p. 94, l. 37-  
p. 95, l. 7.  
p. 105, ll. 24-  
26; ll. 41-45.

31. Every feature and every action of the Prentice machine is common, and of standard practice known to every one acquainted with the small metal working arts. The only possible exception consists of the rocking pincers which clamp the jaws on the tape and these are not described or claimed in the Patent in suit.

32. The Respondents will therefore contend that the Prentice machine involves no invention over what was standard practice prior to the date of the Patent in suit. They will rely hereunder as a defence to the action upon the well-known passage from the Judgment of Lord Moulton in *Gillette Safety Razor Company v. Anglo-American Trading Co. Ltd.* reported in 30 R.P.C. at page 465. The passage in question occurs at page 480 line 42 to page 481 line 4, and in substance amounts to this, that where a defendant can demonstrate that that which he is doing differs from that which has been done of old only in non-patentable variations, he is entitled to succeed either upon the ground of invalidity of the Plaintiff's Patent or upon the ground of non-infringement; and that the defence "that the alleged infringement was not novel at the date of the Plaintiff's Letters Patent is a good defence in law."

33. The Respondents will contend that the Judgment of the learned President of the Exchequer Court was erroneous, in that *inter alia*, he decided the case upon a general review of the Patent in suit without sufficiently condescending upon the construction, validity, or infringement of the specific claims of the said Patent.

34. It is provided by the Patent Act 1923 R.S.C. 1927 c. 150 s. 14 (i) that "The specification shall . . . (c) end with a claim or claims stating

distinctly the things or combinations which the applicant regards as new and in which he claims an exclusive property and privilege. So also the Patent Act, 1906, R.S.C. 1906, c. 69, under which the Patent in suit was granted provided as follows :—

RECORD.

S. 13. The specification . . . shall state clearly and distinctly the contrivances and things which he (the applicant) claims as new and for the use of which he claims an exclusive property and privilege.

35. The Respondents will further contend that the learned President misdirected himself in that he applied too generally to the case the doctrine of *Proctor v. Bennis*, 4 R.P.C., page 354. The Respondents will contend that the said doctrine is not properly applicable to a Patent, the Specification of which is in the form of the Specification of the Patent in suit, wherein there are a large number of claims, in fact twenty in number, and wherein an attempt is made in each claim to define with precision the ambit of the monopoly claimed.

36. The Supreme Court of Canada on the other hand, as the Respondents contend rightly, analysed each claim of the said Specification alleged to be infringed and found, as the Respondents contend rightly, that Claims 1, 2 and 3 must in order to be valid be limited to the specific means disclosed and were therefore not infringed by the Prentice machine, while Claims 7, 8, 10 and 19 covered nothing new and were therefore invalid, and that there was no new invention in the Appellants' machine except the particular mode of carrying the units, after being formed, automatically to the position where the jaws are set astride the corded edge of the tape.

37. The Respondents submit that the appeal should be dismissed for the following among other

### REASONS

1. Because the Respondents have not infringed the said Letters Patent;
2. Because the claims of the said Letters Patent alleged to be infringed are invalid.
3. Because the alleged infringing machine was not novel or patentable at the date of the Patent in suit.
4. Because the judgment of the Exchequer Court was erroneous and was properly reversed.
5. Because the judgment of the Supreme Court of Canada was correct and should be affirmed.

W. TREVOR WATSON.  
FRANK McCARTHY.

In the Privy Council.

No. 63 of 1933.

ON APPEAL  
FROM THE SUPREME COURT OF  
CANADA.

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BETWEEN

LIGHTNING FASTENER COMPANY LIMITED  
*(Plaintiff) Appellant*

AND

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

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CASE FOR THE RESPONDENTS.

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