CORRESPONDENCE

Infringement of Process Claims

TO THE EDITOR:

In a comment and subsequent letter published in the Review ((1957), 35 Can. Bar Rev. 86 and 481 at p. 482) I criticized Canadian and British cases holding that process claims could be infringed by the sale of a product made in accordance with the claimed process and expressed the opinion that if these cases ever were good law, they are so no longer.

I have received from Mr. L. J. Fisher, a patent attorney of Johannesburg, South Africa, a copy of a judgment of the Court of the Commissioner of Patents for the Union of South Africa in the case of *Aktiebolaget Astra Apotekarnes Kemiska Fabrieker and Willows Francis Pharmaceutical Products, Limited*, published in the South African Patent Journal of August 14th 1957, which is presently under appeal. This was an opposition to the grant of a patent and the interesting part of the judgment relates to the request of the applicant to amend its specification to include a claim to the product when prepared by any of the processes claimed. This brought up the question as to whether the process claims would protect the product without the addition of a product claim.

The court refused to follow the English decisions "in view of the modern conception of the purposes of claims and the limitation of the monopoly conferred by a patent to the subject matter actually claimed . . . ."

The following excerpts from the South African judgment may be of interest to those who may have read my earlier comments:

> It is clear therefore, —and is in fact conceded by applicant's counsel— that it would not be competent by way of amendment, to add to purely process claims in a specification, a claim to an article absolutely, and unrelated to the process claims. He relies, however, on an established principle in English law that a process claim is wide enough to extend to the article manufactured by the patented process, and to extend that process monopoly also to the article, although there is no specific claim covering the article or product as such.
>
> That viewpoint was first adopted in England in the case of *Elmslie* v. *Boursier* (1869) L.R. 9 Equity 217 in which it was held that goods

manufactured abroad by the employment of a process patented in England and imported into England, were included in the monopoly conferred by the patented process, so that the un-authorized sale of such goods in England infringed the patentee's rights under his process patent . . . .

Mr. Welsh on the opponents' behalf concedes that as regards the general principle above stated, the English authorities are against him, but stresses the fact that the principle referred to above was established in the remote past at a time when the scope and function of the claiming clauses in specifications were as yet ill-defined and unsettled and had not undergone the very radical development, or assumed the vital importance accorded to claims in more recent times.

In support of his argument he referred to numerous authorities which emphasise the vital part played by the claims in a specification at the present time.

In *Electric and Musical Industries* v. *Lissen* (1939), 56 R.P.C. 23 (H.L.) it was held that the boundaries of the monopoly are fixed by the plain words of a claim. The patentee may not restrict or expand or qualify what is expressed in a claim by borrowing some particular gloss from other parts of the specification.

In that case Lord Russel of Killowen is reported to have said:

"The function of the claims is to define clearly and with precision the monopoly claimed, so that others may know the area within which they will be trespassers. Their primary object is to limit and not to extend the monopoly. What is not claimed is disclaimed. A patentee who describes an invention in the body of a specification obtains no monopoly unless it is claimed in the claims—as Lord Cairns said 'there is no such thing as infringement of the equity of a patent'." . . .

The principle that a purely process claim automatically affords a monopoly to the article produced thereby, was also adopted in some of the earlier American cases. Comparatively recently, however, that principle was fully and exhaustively considered and departed from in the case of *Amtong Trading Corporation*, reported in No. 75 Federal Reporter, 826.

The Court of Customs and Patent Appeals (consisting of 5 judges) in an appeal from the United States Tariff Commission, on a question of law, held:

"(a) a product patent protects only the invented or discovered article, and a process patent protects only the method of making the article;

(b) The sale of an unpatented product made by a patented process does not infringe the process patent, nor does the use of an unpatented process infringe a product patent." . . .

I have quoted at length from the United States judgment because it seems to me that the reasons which prompted that court to review the authorities and where necessary to overrule earlier conclusions, may well commend themselves to other tribunals, particularly in view of the modern conception of the purposes of claims and the limitation of the monopoly conferred by a patent to the subject matter actually claimed to the entire exclusion of everything howsoever

not so claimed in the claims, as properly interpreted, if need be, in the light of the specification.

However that may be, considerable new light has been shed upon the matter, and I feel that I am at large to determine the point now in issue by reference either to the principle first laid down in the English judgment in 1869 and since adopted in Great Britain, or to the conclusions arrived at by the United States court in its Judgment above quoted.

The latter judgment appears to me to be in consonance with the clearly defined distinction between process claims and article claims as emphasized in our courts, and with the definition of "patented article" to which I shall presently refer.

Moreover, its adoption would give practical effect to the judgment of the courts of Great Britain as to the scope and purpose of claims in a specification.

G. E. MAYBEE*

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Assumption of Risk and Negligence

TO THE EDITOR:

Mr. Douglas J. Payne's stimulating note on assumption of risk and negligence in your October issue raises the question what is meant by "the plaintiff consented to the risk"? What must be proved to establish (a) the absence of a duty to take care, or, alternatively, (b) the defence of *volenti?* Some recent authorities require proof not merely that the plaintiff consented to the risk of being injured, but that he consented to bear that risk at his own expense. In Salmond[1] it is said that ". . . the true question in every case is: *did the plaintiff give a real consent to the assumption of risk without compensation;* did the consent really absolve the defendant from the duty to take care?" (my italics).

Judicial authority for this view will now be found in a judgment of Lord MacDermott, L.C.J. in *Kelly* v. *Farrans Ltd.*,[2] when he says:

> In claims for damages for personal injury caused by negligence the question raised by a plea of volenti is not whether the injured party consented to run the risk of being hurt, but whether he consented to run that risk at his own expense so that he, and not the person alleged to be negligent, should bear the loss in the event of injury.

Although Lord MacDermott then goes on to say "In other words, the consent that is relevant is not consent to the risk of injury but consent to the lack of reasonable care that may pro-

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[1] The Law of Torts (11th ed., 1953) p. 41.
[2] [1954] N.I. 41 at p. 45.

duce that risk.", I suggest that it is all the more necessary to pose the question of assumption of risk without compensation if one adopts Mr. Payne's view that no duty of care is owed to a person who consents to a risk. The alternative view postulates that the plaintiff consented to the defendant's being negligent. Without express agreement, this is, in fact, improbable in most cases.[3] If it is only necessary to prove that the plaintiff consented to the risk, the distinction between what Dr. Glanville Williams[4] describes as the physical risk and the legal risk may be confused, and by proving the plaintiff's consent to the physical risk, the defendant may succeed in discharging himself from liability. It is therefore hoped that Mr. Payne's interesting note will provoke further discussion of this most difficult problem.

W. A. LEITCH*

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The Dying Doctrine of Recrimination

TO THE EDITOR:

The article on "The Dying Doctrine of Recrimination in the United States of America" in the November issue and particularly the case of *DeBurgh* v. *DeBurgh* (1952), 39 Cal. 2d 858; 250 P. 2d 598 illustrates a striking similarity to the view which has been taken by the Canadian courts.

In England both in the case of a petition for divorce or for judicial separation the court is not bound to pronounce a decree if it finds that the petitioner had, during the marriage, been guilty of adultery. The law in the Canadian provinces having divorce courts would appear to be similar. However, in England it is the duty of the solicitor to ask his client if he or she is seeking a divorce, in clear and unambiguous terms, if he or she has committed adultery. *Shiers* v. *Shiers* (1942), 22 All E.R. 417 *Barnacle* v. *Barnacle*, [1948] P. 257.

There is, however, no provision of substantive law in Ontario which would require a plaintiff in a divorce action to disclose his or her adultery in the pleadings or in a confidential written state-

[3] Lord Bramwell in *Smith* v. *Baker*, [1891] A.C. 325 at p. 344 said "In the course of the argument I said that the maxim *Volenti non fit injuria* did not apply to a case of negligence; that a person never was *volens* that he should be injured by negligence—at least, unless he specially agreed to it; I think so still."

[4] Joint Torts and Contributory Negligence (1951) p. 308. "Physical risk is the risk of damage in fact; legal risk is the risk of damage in fact for which there will be no redress in law."

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ment to the court, or at the trial. *Howe* v. *Howe*, [1937] O.R. 57. Ontario Rule 783 states:

> (1) Where a party who has been guilty of a matrimonial offence intends to ask at the hearing that the discretion of the Court shall be exercised in his favour,
>
> (a) the statement of claim or counterclaim shall contain a special prayer to this effect, and
>
> (b) a statement signed by such party setting forth all the facts relating to such offence and the grounds upon which the exercise of the discretion is asked shall be placed in a sealed envelope and filed with the statement of claim or counterclaim as the case may be.
>
> (2) Such statement shall be open to the inspection of the Attorney-General but, except by the direction of a Judge given at any time prior to the final disposition of the action, shall not be open to inspection by any other person.
>
> (3) The Judge presiding at the trial may peruse the statement and may order it to be re-sealed or to be communicated to the opposite party or to be otherwise dealt with as he sees fit.

The grounds upon which a Canadian or English court will exercise discretion relate to the interest of the parties themselves, the children of the marriage and the community at large. It was held in the case of *Gracie* v. *Gracie*, [1943] S.C.R. 527, that when a divorce has been granted by the trial judge in exercise of his discretion, notwithstanding the adultery of the plaintiff, the appeal court cannot substitute its discretion. The English Court of Appeal however has in *Blunt* v. *Blunt*, [1942] 2 All E.R. 613 ruled that it could review the exercise of discretion by a trial judge and it did in fact reverse the decision of the trial judge. The *DeBurgh* case however, seems to put the burden upon the defendant showing a cause of divorce against plaintiff to satisfy the court "that in spite of the mutual misconduct shown there is some benefit to be derived from continuing the marriage either to the parties themselves through a reconciliation or to their children or that he himself is the lesser offender". Under Canadian and English law, obtaining of discretion appears to be a burden wholly to be discharged by the plaintiff.

At page 1053 of the article it is stated that "Under the *DeBurgh* case the trial judge may 'if it is possible' grant a divorce to both parties." Just such a divorce was granted in *Love* v. *Love*, an unreported case in the Ontario High Court dated April 2nd 1952. In this case the defendant wife and the co-respondent both admitted the adultery alleged against them and the defendant wife, as plaintiff by counter-claim, asked for the discretion of the court and otherwise complied with Ontario Rule 783. The plaintiff denied the adultery throughout. The late Mr. Justice Chevrier granted a decree *nisi* to the plaintiff husband and then in dealing with the

counter-claim for divorce by the defendant wife against the plaintiff he also granted her a decree *nisi*.

It is interesting to note that although adultery was proved against each of the parties to the marriage the learned trial judge saw fit to grant a decree *nisi* to each of them even though only the defendant spouse had asked for the discretion of the court. The failure of the plaintiff to comply with Rule 783 was not mentioned by the learned trial judge in his reasons for judgment.

In the case of *P.* v. *P.*, [1951] W.W.R. 704 Mr. Justice Shepherd of the Supreme Court of Alberta, in a case in which the wife was plaintiff and the defendant husband counter-claimed for divorce, exercised discretion and pronounced a decree in favour of each.

MILTON A. CADSBY*

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Canada's Immigration Policy

TO THE EDITOR:

I read Mr. Saul Hayes' review of Professor Corbett's recent book, "Canada's Immigration Policy: A Critique" ((1957) 35 Can. Bar Rev. 983), with considerable interest, the more so as I had been honored by being invited to make a few suggestions to Professor Corbett on portions of his work.

Mr. Hayes, in his review, refers to the work of the Canadian Bar Association being in part responsible for certain changes in the Act. It is regrettable that these changes were not more widespread. Indeed, the work of the Canadian Bar Association in this field since 1954 has consisted mainly of an exchange of correspondence between the former Minister and a special sub-committee appointed by the Council, none of whose findings have been made available to the general membership of the Association.

I have handled a great many immigration cases during the past number of years, and have taken an active interest in the Association and elsewhere in an effort to expose the dire need for procedural changes in the administration of the Act. It was refreshing to find a non-legal approach to this problem provided by Professor Corbett's book.

In his review, Mr. Hayes refers to section 20 (4) of the Regulations, which creates prohibitions against certain persons. It should be noted that section 61 of the Act which empowers the Governor in Council to make regulations for carrying into effect the purposes and provisions of the Act, including the prohibiting or

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limiting of admission of persons by reason of nationality, citizenship, ethnic group, occupation, class or geographical area of origin, etc., employs virtually the same language as the former section 20 (4) of the Regulations. In the case of *Ex parte Brent*, [1956] S.C.R. 318, the Supreme Court of Canada held that this power could not be re-delegated to special inquiry officers across Canada, each of whom might attach a totally different meaning to these classifications in his application thereof. As a result of this decision, the Regulations were amended in May, 1956, but it is interesting to note that the new section 20 starts out with the words: "Landing in Canada of any person is prohibited except where the person falls within one of the following classes of persons, . . ."

The entire Act is based on a negative concept and the Regulations have been kept strictly in line with such a theory. While it is difficult to argue with the principle that a sovereign state has a right to set its own immigration policy, however oppressive and confined such policy might be, it is nevertheless desirable that the administration of such policy be governed by what we lawyers have come to regard as fundamental principles of justice, fair play, reasonableness, or any other term which the reader prefers.

Even on practical grounds, it is difficult to appreciate the reasoning behind the Department's ruling that no lawyer shall under any circumstances be permitted to be present with his client upon the hearing of the client's application for permanent landing in Canada. To be left to cool one's heels in a bare ante-room, or even barer corridor, while one's client is being interrogated behind closed doors on a matter which is usually of the utmost importance to that client is not calculated to make any lawyer love the Department or help him to understand why, of all other Government Departments, this has to be the slowest to accept and put into force procedural principles which have been taken for granted for so long elsewhere.

A lawyer approaching the Immigration Act for the first time must be struck by the fact that it is a politician's rather than a lawyer's statute. Resting as it does on such a narrow basis of ministerial discretion, the whole structure is necessarily top-heavy with bureaucratic confusion and inconsistency. The so-called Mackenzie-King policy of making immigration a privilege may perhaps be well justified in a new country, but the administration of that policy would, in the submission of many, be better entrusted to a permanent board of immigration appeals consisting not of former employees of the Department, as is now the case, but chosen from a cross-section of the people of Canada.

THOMAS C. MARSHALL*

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Foreign Judgments in Quebec

TO THE EDITOR:

Mr. Walter S. Johnson, Q.C.'s, article on Foreign judgments in Quebec in the October issue gives us, in a masterly way, the historical background of and current problems under article 210 of the Quebec Code of Civil Procedure, derived from article 121 of the Code Michaud of 1629, which provides that:

> Any defense which was or might have been set up to the original action, may be pleaded to an action brought upon a judgment rendered out of Canada.

Interesting and illuminating as is the historical background of article 210, questions of the following type seem to remain unanswered:

(1) Will a Quebec party holder of a money judgment from a Quebec Court, which had (international) jurisdiction in the case, be satisfied if in an action brought upon the judgment, for example, in Vermont, *res judicata* effect is denied there to the Quebec judgment regularly obtained and the judgment creditor is forced, as under article 210, to argue and prove his case all over again?

(2) What is the justification—other than "statute"—for denying *res judicata* effect to money judgments regularly obtained in, for example, Vermont if conclusive effect is given under like conditions to judgments from, for example, New Brunswick?

(3) What argument can support the Code Michaud view that a party which had its "day in court" in a court with proper jurisdiction, should not be bound everywhere by the judgment duly obtained in that court?

(4) What rights deserving protection are violated under the doctrine recognized in the common-law world and prevailing in the civil-law world that conclusive effect shall be given to a money judgment duly obtained in a foreign court with (international) jurisdiction, the defenses of fraud and public policy being reserved?

It is this type of question which is likely to be asked and discussed in New York in September 1958 at the conference of the International Law Association which has "Recognition of Foreign Judgments" on its agenda.

KURT H. NADELMANN*

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The Juvenile Delinquents Act

TO THE EDITOR:

I was most interested to read the excellent article of Judge Schreiber contained in the November issue.

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I would like to draw attention to the procedure adopted in *Regina* v. *P.M.W.* reported in (1955), 16 W.W.R. (N.S.) at p. 650. I will quote the opening paragraph of the report which clearly states the circumstances and procedure followed.

> Although the accused was charged under the Juvenile Delinquents Act, R.S.C. 1952, ch. 160, the act complained of would, if proved, have justified a conviction for murder in an ordinary court. Crown counsel suggested that there were only two courses as between which the Juvenile Court judge could choose, viz., transfer the charge of murder to the ordinary courts or retain the case in the Juvenile Court, but the judge said that no authority had been cited to him to support that proposition and that in the absence of authority he would not accept it, but would adopt a third course. He said that, although on the face of the charge the act complained of amounted to murder, it also amounted to any charge which is included in a charge of murder, and, therefore, to a charge of manslaughter. He said he had always taken the view that the transfer to the ordinary courts should be a transfer on a specific charge and not merely a transfer of the person of the accused without relation to a specific charge; and that, since he knew of no authority or near authority which prohibited his doing so, he had decided, even on the assumption that there would be evidence to sustain a conviction for murder, to order that the accused be prosecuted for manslaughter.

So far as I know the procedure followed was novel but is most satisfactory since it makes available all of the facilities of the ordinary courts without exposing a juvenile to the mandatory death penalty.

A. D. POOL*

Books Received

The mention of a book in the following list does not preclude a detailed review in a later issue.

A Grammar of American Politics—The National Government. By WILFRED E. BINKLEY and MALCOLM C. MOOS. Third edition. New York: Alfred A. Knopf, Inc. 1958. Pp. xvi, 806, ($6.00)

Cases on Income Tax. Compiled and edited by JOHN G. MCDONALD; foreword by G. F. CURTIS. Toronto: Butterworth & Co. (Canada) Ltd. 1957. Pp. xl, 695. (No price given)

Civil Law Litigation in Turkey, A Comparative Study of Anglo-American and Continental Civil Procedure and Judicial Administration, as manifested in the systems in effect in the United States and Turkey. By DELMAR KARLEN and ILHAN ARSEL. Ankara: Legal Research Institute,

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Faculty of Law, University of Ankara. New York: New York University Graduate School of Public Administration and Social Service. 1957. Pp. xii, 279. (No price given)

Leading Cases in Constitutional Law. By O. HOOD PHILLIPS. Second edition. London: Sweet & Maxwell Limited. Toronto: The Carswell Company Limited. 1957. Pp. xix, 465. ($7.45)

Le Droit de Superficie. par JEAN-GUY CARDINAL. Modalité du Droit de Propriété. Préface de Me MAXIMILIEN CARON. Montreal: Wilson et Lafleur. 1957. Pp. 286. (No price given)

The Alien and the Immigration Law. A study under the direction of EDITH LOWENSTEIN. Published for the Common Council for American Unity. New York: Oceana Publications. 1958. Pp. xii, 388. ($7.50)

The Composition of Legislation. By ELMER A. DRIEDGER. Ottawa: The Queen's Printer. 1957. Pp. xxiii, 286. (No price given)

The Constitutional Law of Great Britain and the Commonwealth. By O. HOOD PHILLIPS. Second edition. London: Sweet & Maxwell Limited. Toronto: The Carswell Company Limited. 1957. Pp. xl, 835. ($8.50)