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No. 40 of 1950.

In the Privy Council.

ON APPEAL
FROM THE SUPREME COURT OF CANADA.

UNIVERSITY OF LONDON
W.C.1.

12 NOV 1958

ADVANCED
LEGAL STUDIES

15271

BETWEEN

**MINERALS SEPARATION NORTH AMERICAN
CORPORATION (Plaintiff)**

Appellants

AND

NORANDA MINES LIMITED (Defendant)

Respondents.

Case for the Appellants

BIRD & BIRD,

5-11 THEOBALD'S ROAD,

LONDON, W.C.1,

Appellants' Solicitors.

Patents—Infringement—Validity of Patent—To determine whether a patent “correctly and fully describes the invention” the Specification must be read as a whole—Claims which include substances harmful to the process are invalid—The Patent Act, 1923, S. of C., c. 23, ss. 7 (1), 14 (1)—The Patent Act, 1935, S. of C., c. 32, s. 61 (1) (a).

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NORANDA MINES LIMITED (Defendant) *Respondents.*

Case for the Appellants

RECORD.

Vol. V, p. 1149.

1. This is an Appeal from a Judgment of the Supreme Court of 10 Canada dated 5th December 1949 in a patent action in respect of infringement of four claims of the Specification of the Appellants' Letters Patent No. 247576. The Supreme Court by a majority of four Judges to one (Rand, Kellock, Estey and Locke, JJ., in favour, Kerwin, J., dissenting)—

(A) reversed with costs a Judgment of the President of the Exchequer Court of Canada (Thorson, P.) in so far as he decided that claim 9 of the said Specification was valid and infringed by the Respondents ;

(B) upheld the decision of the Learned President in so far as he decided that claim 6 of the said Specification was invalid ; 20

(C) decided that claims 7 and 8 of the said Specification, not dealt with by Thorson, P., were invalid, and that claim 8 was not in any event infringed.

2. The substantial questions in this Appeal are two, and raise important and difficult questions of patent law relating to the validity of claims 9 and 6 respectively of the said Specification, as follows :—

(A) As to claim 9, the extent and application of the so-called “dictionary principle” in the consideration of patent claims i.e. in what circumstances it is legitimate to control the *prima facie* meaning of a word or words in such a claim by reference to the body 30 of the Specification.

(B) As to claim 6, in what circumstances it is legitimate as a matter of construction for the Court to give a special meaning to words used in a patent claim in order to avoid absurdity or inconsistency.

3. As to question (A) above there was a clear conflict of judicial opinion below, Thorson, P., in the Exchequer Court and Kerwin, J., in the Supreme Court holding claim 9 to be limited in accordance with the "dictionary principle" so as to preserve its validity, and the remaining members of the Supreme Court apparently ignoring the said principle and holding the claim according to its prima facie meaning to be too wide and therefore invalid. 10

As to question (B) above, with the exception of Kerwin, J., who did not mention claim 6, all the Judges below held that the said claim could not properly be construed in the manner sought by the Appellants but was invalid for ambiguity.

HISTORY OF THE CASE

4. The Appellants are a Company incorporated under the laws of the State of Maryland, United States of America and have their principal place of business at 11 Broadway, New York, in the State of New York, United States of America. The Respondents are a Company incorporated under the laws of the Dominion of Canada and have their head office at 941 Dominion Square Building, Montreal, in the Province of Quebec. 20

Vol. V, pp. 915-922.

5. Letters Patent No. 247576 were granted on 10th March 1925 to the Appellants as assignees of Cornelius H. Keller, who filed an application for the same in the Canadian Patent Office on 23rd October 1924.

6. On 1st March 1943 the Appellants commenced an action against the Respondents alleging infringement of claims 6, 7, 8 and 9 of the said Letters Patent by the Respondents at their mine continuously during the preceding period of five years and claiming the usual relief.

Vol. V, p. 1110.

7. The action came on for trial before Thorson, P., President of the Exchequer Court, on 13th November 1944 and on 28th May 1947 Judgment was delivered to the effect that claim 9 of the said Letters Patent was valid and infringed and claim 6 was invalid. The Learned President did not deal with claims 7 and 8. 30

Vol. V, p. 1149.

8. On 24th June 1947 the Respondents gave notice of their intention to appeal to the Supreme Court. In due course the appeal was heard by Kerwin, Rand, Kellock, Estey and Locke, JJ., Kerwin, J., presiding, and on 5th December 1949 by a majority of four judges to one (Kerwin, J., dissenting), the appeal was allowed and all four claims of the said Letters Patent held invalid, Kerwin, J., who dealt only with claim 9, held that that claim was valid and infringed. 40

Vol. V,
pp. 1150, 1151.

9. On 5th June 1950 the Appellants presented a Petition for Special Leave to Appeal to the Privy Council. The Petition was heard by Lords Simonds, Oaksey and McDermott on 18th July 1950 and Special Leave to Appeal was granted.

10. The said Letters Patent expired in 1943 shortly after the present action was brought and no question of the grant of an injunction to restrain infringement therefore arises, the relief claimed being damages only. A number of similar actions by the Appellants against other companies were also begun about the same time and all these actions have been stayed pending the result of this Appeal.

THE INVENTION

11. The invention described and claimed in the Specification of the said Letters Patent relates to a method of concentrating mineral ores known as "froth flotation." Valuable metals found in the earth's crust are seldom in the free state in the form of pure metal but are usually chemically combined with sulphur, oxygen or other elements. Further as found in nature they are normally intergrown or cemented into masses with much larger quantities of other unwanted minerals, for example, silicates. Such combinations are known as ores. For the purpose of recovering the valuable metals it is essential to separate those minerals, known as the "values," which contain the metals to be recovered, from the worthless minerals known as "gangue." Many natural ores also contain compounds of more than one metal in which case there may be two or more classes of values which it is necessary to obtain separately in order to produce the several pure metals. 10

12. Separation of the metal itself from its ore involves a chemical operation, known as smelting, since the metals are chemically combined with other elements in the ore. On the other hand separation of the values from the gangue involves a physical operation, since these substances are not chemically combined but intimately mixed together. Froth flotation is a well-known and widely practised method of effecting such physical separation.

13. The method discovered in the year 1905 comprises essentially the following steps :— 30

(A) The ore as mined is after preliminary crushing ground in water sufficiently to separate the values from the gangue leaving the grinding mill as a mixture known as an ore pulp.

(B) Further water is added to the ore pulp so that the ratio of water to ore is about 4 to 1.

(C) A substance known as a frothing agent is added to the diluted pulp which is then violently agitated with simultaneous introduction of air so that very large numbers of bubbles form and rise to the surface as a froth. In addition to forming the froth the frothing agent causes the values to adhere to the air bubbles and thus to rise with them to the surface, leaving the gangue below in the residue of the pulp, known as tailings. 40

(D) The froth still supporting the values is then removed, the valuable minerals thus recovered in the froth being known as the concentrate.

In order to adapt the process to various ores, the water with which the ore is mixed may be made acid, alkaline or neutral, as desired, by the

addition of suitable reagents, e.g., sulphuric acid. The water carrying the ground ore in the apparatus used for the agitation and introduction of air bubbles is called "the circuit" because it is used again after the solids have been removed therefrom, and a circuit is described as acid, alkaline or neutral as the case may be.

14. The action of the frothing agent can often be enhanced by the addition of further suitable substances, sometimes known as "collecting agents" or "modifying agents," which are adapted to co-operate with the frothing agent but do not themselves necessarily have any froth-producing effect. Letters Patent No. 247576 were based on the discovery that among those sulphur derivatives of carbonic acid known as "xanthates" there are a number of such agents which are soluble and which, in conjunction with a frothing agent, have a remarkable effect in increasing the efficiency of the froth flotation process. The Claims cover the use of these substances in conjunction with frothing agents in the froth flotation process, but not the substances themselves, which were old. 10

15. The value of the invention to those engaged throughout the world in the froth flotation of ores has been very great. The learned President of the Exchequer Court, after detailing the advantages of the invention and its extensive use all over the world, found that the invention was a very meritorious one and upheld claim 9. In the Supreme Court, Kellock, Rand, Locke and Estey, JJ., although holding that all the claims sued upon were invalid, all drew attention to the merit of the invention, ". . . a very useful invention which became dominant in the art" (Kellock, J.); "The invention was one of great value to the mining industry and brought in a group of agents of which there had been no previous knowledge or experience" (Rand and Locke, JJ.); "That such improvements were effective is clearly established and infringement is admitted if the patent is valid" (Estey, J.). 20

Vol. V, p. 1131,
ll. 34, 35.

Vol. V, p. 1135,
ll. 25-27.

Vol. V, p. 1141,
ll. 13-15.

THE ATTACK UPON VALIDITY 30

A. ANTICIPATION

16. The validity of the said Letters Patent was attacked on a large number of grounds notably anticipation, insufficiency and ambiguity, all of which were considered at length by Thorson, P., in the Exchequer Court. In that Court one of the main attacks was anticipation by a document published some 8 years earlier, namely, Bulletin No. 2 (Exhibit 93) dated 15th August 1925 by R. B. Martin. After dealing in detail with this disclosure and the relevant evidence, Thorson, P., stated: "The defence of anticipation of the invention, in my opinion, fails completely." 30

Vol. V, p. 1107,
ll. 44, 45.

17. In the Supreme Court Kerwin, J., dealt shortly with the questions of anticipation and decided that all the evidence led to the conclusion that Martin did not know the value or use of xanthate as such and was not aware of the invention that Keller later made. None of the other learned Judges in the Supreme Court found it necessary to consider this ground of attack, as their Judgments were confined to the questions of insufficiency and ambiguity. It is not proposed to deal in detail in this Case with the 40

arguments and evidence which led Thorson, P., and Kerwin, J., to decide this question in the Appellants' favour, but the Appellants desire to rely upon such decisions and the reasons given therefor.

B. INSUFFICIENCY

18. In the Exchequer Court Thorson, P., summarily dismissed all other grounds of attack except that based on section 14 (1) of the Patent Act, Statutes of Canada, 1923, Chap. 23, which he also rejected after careful consideration.

Section 14 (1) is as follows :—

“ 14.—(1) The specification shall correctly and fully describe 10
the invention and its operation or use as contemplated by the inventor. It shall set forth clearly the various steps in a process, or the method of constructing, making or compounding, a machine manufacture or composition of matter. It shall 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.”

19. The section requires first, that the description of the mode of performing the invention contained in the body of the specification shall be correct and sufficient, and secondly, that the claims, with which the 20
specification shall end, shall state distinctly the monopoly claimed. In this respect it is submitted that the requirements are the same as those of English law relating to Letters Patent and that the same principles apply.

20. The attack of insufficiency was directed primarily against 10
paragraphs 2, 3 and 4 of the description which read as follows :—

“ 2. This invention relates to the froth-flotation concentration of ores, and is herein described as applied to the concentration of certain ores with mineral-frothing agents in the presence of certain organic compounds containing sulphur.

3. It has been found that certain sulphur derivatives of carbonic 30
acid greatly increase the efficiency of the froth-flotation process when used in connection with mineral-frothing agents. The increased efficiency shows itself sometimes in markedly better recoveries, sometimes in effecting the usual recoveries with greatly reduced quantities of the usual mineral-frothing agents, and sometimes in greatly reducing the time needed for agitation to produce the desired recoveries.

4. The invention is herein disclosed in some detail as carried 40
out with salts of the sulphur derivatives of carbonic acid containing an organic radical, such as an alkyl radical and known as xanthates, as the new substance. These form anions and cations in solution. Excellent results were also obtained by agitating ore pulps with the complex mixture produced when $33\frac{1}{3}\%$ of pine oil was incorporated with an alcoholic solution of potassium hydrate, and xanthates or analogous substances were produced by adding carbon disulphide to this mixture.”

21. In the Exchequer Court Thorson, P., found emphatically that the description in the specification was amply sufficient and, in particular, that the words and phrases to which objection was taken by the Respondents on the ground of ambiguity and indefiniteness were clear and unambiguous. Several of these words and phrases appear later in the claims. He stated, for example, "In my opinion the term 'alkyl radical' has the exact precise meaning that was given to it by Mr. Higgins" (a witness for the Appellants) "and I do not think that any skilled metallurgist or chemist engaged in froth flotation could have failed to understand the term according to such meaning or would have been misled into thinking it had the wider meaning suggested as possible by Dr. Purves" (a witness for the Respondents). "Only such xanthates as form anions and cations in solution are contemplated by the inventor," and "This concludes the analysis of the description of the invention so far as it relates to the use of xanthates. I have come to the conclusion that it is precise and as reasonably clear from avoidable obscurity or ambiguity as the difficulty of the description permits. A person skilled in the froth flotation art would, in my opinion, have no doubt as to the class of xanthates whose use was proposed by the inventor." 10

Vol. V, p. 1066,
ll. 18-24.

Vol. V, p. 1068,
ll. 17, 18.

Vol. V, p. 1069,
ll. 24-30.

It is to be noted that the "class of xanthates" here referred to, by Thorson, P., is limited by two requirements; they must be (1) "alkyl xanthates," i.e., contain an alkyl radical and (2) "soluble," i.e., forming anions and cations in solution. 20

The learned President summarised his findings on sufficiency of the description in the following words:—

"The defendant thus fails in all its attacks upon the disclosures portion of the specification. In my view, any person skilled in the froth flotation art on reading the specification would know what the invention related to and what it was. He could have no doubt as to its ambit or scope. Moreover, he could with the specification and his knowledge of the art put the invention into effect as successfully as the inventor could do himself. He is directed to the use of the best substance without any need for experimentation and can then deal with the other substances found to be useful as he chooses under the conditions mentioned. There are no misleading statements to put him off the track. He had been given the necessary warning if he is dealing with an acid circuit. The inventor has, I think, fulfilled the duty of full disclosure required of him by section 14 (1) of the Act." 30

Vol. V, p. 1078,
ll. 25-38.

The Appellants rely strongly on the statement by the learned President cited above. He has here in the Appellants' submission not only set out accurately and completely the legal requirements involved but also correctly concluded on the facts of this case that the Specification of Letters Patent No. 247576 is amply sufficient. As will be seen later this finding of sufficiency of description is of paramount importance in the resolution in the Appellants' favour of the attack of ambiguity of the claims. 40

22. In the Supreme Court, Kellock and Estey, JJ., do not appear to have made any clear distinction between the objections of insufficiency of description and ambiguity of claim (see paragraph 19, *ante*). They held

that both the description and the claims were ambiguous and, therefore, that the requirements of the Statute were not satisfied. The majority (Kerwin, Rand and Locke, JJ.), on the contrary, upheld the finding of Thorson, P., upon the question of sufficiency of description, Kerwin, J., stating "Without detailing the evidence which appears in the President's reasons I may state that I am satisfied that Keller's disclosure was limited to a certain kind of xanthates, which did not include cellulose xanthates and heavy metal xanthates" and Rand and Locke, JJ., "Taking the specification in its totality, Keller has, I think, met the requirement of the statute: no competent metallurgist would have any difficulty in 10 grasping the discovery in all its essentials."

Vol. V, p. 1119.
ll. 41-45.

Vol. V, p. 1135.
ll. 3-6.

23. The Appellants rely strongly upon the findings of the Exchequer and Supreme Courts that the description in the body of the specification was amply sufficient to enable a metallurgist to understand the invention and to choose such xanthates as would ensure success in the performance of the froth flotation process, for if the word "xanthate," a technical term, is found to be clear and unambiguous when used in the descriptive part of the specification, it cannot, in the Appellants' submission, justifiably be held to be ambiguous in the claim. (See *British Thomson-Houston v. Corona Lamp Works, Ltd.*, below). 20

C. AMBIGUITY

24. Having disposed of the question of insufficiency of the description in favour of the Appellants, both courts then turned their attention to the claims sued upon. They read as follows:—

"6. The process of concentrating ores which consists in agitating a suitable pulp of an ore with a mineral-frothing agent and an alkaline xanthate adapted to co-operate with the mineral-frothing agent to produce by the action of both a mineral-bearing froth containing a large proportion of a mineral of the ore, said agitation being so conducted as to form such a froth, and separating 30 the froth.

7. The improvement in the concentration of minerals by flotation which comprises subjecting the mineral in the form of a non-acid pulp to a flotation operation in the presence of a xanthate.

8. The improvement in the concentration of minerals by flotation which comprises subjecting the mineral in the form of a non-acid pulp to a flotation operation in the presence of potassium xanthate.

9. The improvement in the concentration of minerals by flotation which comprises subjecting the mineral in the form of a 40 non-acid pulp to a flotation operation in the presence of a xanthate and a frothing agent."

CLAIM 9

25. The argument against claim 9 was two-fold:—

(A) that the claim claimed the use of any "xanthate" in the widest sense and was therefore invalid because it included substances which would not work;

(B) that there was no disclosure in the specification to warrant the restriction to a "non-acid pulp," and that for this reason the claim was bad (see para. 32, *post*).

26. The first attack was based upon the contention that the term "a xanthate" in claim 9 included cellulose xanthate and the xanthates of calcium, copper, cobalt and ammonium all of which it was alleged did not improve the froth-flotation process or even were inimical to it. The argument, therefore, turns upon the proper construction of the words "a xanthate" in their context in claim 9 of the specification.

27. The Respondents in their argument relied strongly upon the case of *B.D.V. Ltd. v. Canadian Celanese Ltd.* (1937 S.C.R., p. 221) wherein the specification concerned the manufacture of fabrics using thermoplastic derivatives of cellulose. It was an essential feature of the invention that this thermoplastic material should be in a fibrous form; this was disclosed in the body of the document but not claimed. The Supreme court held that it was not possible to import this restriction into the claims. The Respondents also relied upon the cases of *Molins Machine Co. Ltd. v. Industrial Machinery Co. Ltd.* (55 R.P.C. 31), *Ingersoll Sergeant Drill Co. v. Consolidated Pneumatic Tool Co. Ltd.* (25 R.P.C. 61), *British Hartford-Fairmont Syndicate Ltd. v. Jackson Bros. (Knottingley) Ltd.* (49 R.P.C. 495), (51 R.P.C. 254 (H.L.)). In all these cases the Court refused to limit wide and general language used in the claims by reference to more restricted language taken from the body of the specification. 10 20

28. In the submission of the Appellants the cases cited above have no application where, at the date of the patent in question, the expression under consideration in the claim is a technical term sufficiently explained and defined in the descriptive part of the specification. In the present case the words "a xanthate" constitute such a technical term which has been found by both Courts to be so sufficiently explained and defined. The principles of construction which must be followed in such circumstances are, in the Appellants' submission, those which were clearly in the minds of Thorson, P., and Kerwin, J., and were laid down by the House of Lords in the case of *British Thomson-Houston Company Limited v. Corona Lamp Works Limited* (39 R.P.C. 49). In that case the words "of large diameter" held to be amply sufficient and unambiguous in the description of the body of the specification, were held to be equally clear and unambiguous when they occurred in the claims. Viscount Haldane, at page 67, line, 36 of the Report, stated as follows:— 30

"We have to scan the specification with the closeness which is required in the case of any instrument conferring a monopoly, but, subject to this, all we can legitimately do is to apply the ordinary rules for the construction of written instruments. One of these, which is relevant in the case before us, is that the instrument must be read as a whole. The Claiming Clauses, for example, are not to be taken as standing in complete isolation. For if the Patentee has used in these clauses expressions which he has already adequately interpreted in the body of his specification, he is entitled to refer to the specification as a dictionary in which the meaning of the words he uses has been defined." 40

Thus in the present case where the xanthates to be used have admittedly been adequately identified in the descriptive part of the specification, the patentee is entitled to refer to the description as defining and limiting the word xanthate when used in the claims.

29. The reasoning of and principles enunciated by the House of Lords in the *Corona* case have been frequently followed by the Supreme Court of Canada, for example, in such cases as *Western Electric v. Baldwin International Radio of Canada* (1934 S.C.R. 570) and in *Smith Incubator Co. v. Seeling* (1937 S.C.R. 251). In the latter case Rinfret, J., as he then was, all other members of the Court concurring, stated at page 260 : “ the claims 10 must be construed in the light of the specification ; and that is to say, that the specification must be considered to assist in comprehending and construing the meaning—and possibly the special meaning—in which the words or the expressions in the claims are used.”

30. The Appellants submit that the words “ a xanthate,” where they occur in the claims, constitute a technical expression and are not ordinary words in everyday use with a general and well-understood meaning, that the expression “ a xanthate ” was not even a common technical expression nor one well understood by a flotation operator in 1924, the date of the said Letters Patent, and that in such circumstances the expression when used 20 in the claims must be given the meaning attached to it in the body of the specification. Thus only those bodies are included in the expression “ a xanthate ” as are soluble, in the sense in which a froth-flotation expert would understand that term (i.e., forming anions and cations in solution) and as contain an alkyl radical.

31. Claim 9 when thus properly construed does not cover the use of the substances contended for by the Respondents, namely, cellulose xanthate and calcium, copper and cobalt xanthate. Cellulose xanthate is excluded because it is neither soluble as required nor does it contain an alkyl radical, and calcium copper and cobalt xanthates are excluded by the Respondents' 30 admission that they are insoluble. In fact the three last substances are irrelevant since, as Thorson, P., found, there was no evidence that they do not work in the process. Kerwin, J., in the Supreme Court expressed the same view. A further substance, ammonium xanthate, was also argued to be covered by the claim, but was similarly rejected by Thorson, P., for a number of reasons which need not be detailed in this Case.

32. The further contention of the Respondents that claim 9 is invalid because there is no disclosure in the body of the specification to warrant the restriction to a non-acid pulp, is in the submission of the Appellants without foundation in law. The inventor has disclosed that 40 his invention can be used, if proper steps are taken, in all types of circuit, and such a disclosure is adequate to permit him, if so advised, to make a claim to any type of circuit. There is no requirement, statutory or otherwise, that an inventor shall claim the whole of his invention in any one claim, and it is clearly competent for him, as he has done in claim 9, to restrict his claim to one or more types of circuit if he wishes to do so.

33. It is submitted by the Appellants that claim 9 is valid for the reasons given by Thorson, P., and Kerwin, J., and that the other learned

Judges in the Supreme Court (Kellock, Rand, Locke and Estey, JJ.) in holding that claim 9 was bad on the ground that it included cellulose xanthate, were in error. In so doing they did not give proper weight to the well settled principles of construction set out in paragraph 28 hereof which in the Appellants' submission must be applied in the present case.

CLAIM 6

34. The main attack on claim 6 was directed against the words "alkaline xanthate" therein, the Respondents' argument being that the words were so ambiguous that no meaning could be attached to them.

35. The evidence conclusively showed that all xanthates were neutral salts. The learned President found that the term "alkaline xanthate" appeared to be a contradiction which did not when taken by itself and read literally make sense. A mistake thus made must in the Appellants' submission, be corrected as a matter of construction so that the intention of the document may prevail. The Appellants therefore contended that the words "alkali-metal xanthate" should be read in place of the contradiction "alkaline xanthate" the former being the obvious intention of the document when read as a whole. Claim 8, for example, refers to "potassium xanthate," this substance being a typical body falling within the broader term "alkali-metal xanthate" which includes also for example, sodium xanthate. The latter body is not claimed separately but is equally suitable with potassium xanthate for the purpose in question.

36. Thorson, P., stated in his Reasons for Judgment that to give to the words "alkaline xanthate" the meaning "alkali-metal xanthate" would be to amend the claim and not to construe it and he held the claim bad on the ground of ambiguity and obscurity. In the Supreme Court Kerwin, J., did not deal with claim 6, Kellock, J., although holding that the term was a contradiction and that something else was intended considered that the intention was ambiguous and the claim invalid. Rand and Locke, JJ., were inclined to the view that the expression should be read as "a xanthate in which the metal or radical which replaces the hydrogen atom is that which comes from an alkali." They held that even so the claim would cover sodium and potassium cellulose xanthate, which were admittedly harmful in the process, and was therefore bad. Estey, J., stated that all the claims were infected with the ambiguity of expression which he found in the descriptive part of the Specification and were therefore invalid.

37. In the Appellants' submission it is a well-established canon of construction (see for example the words of Lord Wensleydale in *Theellusson v. Rendlesham* (7 H.L.C. 429 at page 519) that in construing a document the ordinary grammatical meaning of words is to be taken unless this leads to some repugnancy absurdity or inconsistency in which case the sense of the words must if possible be modified to avoid such absurdity or inconsistency. The rule cannot of course be applied if it is not possible to attribute any meaning at all to the words in question. In the present case however the meaning of the words "alkaline xanthate" is plain,

viz., a xanthate which is alkaline. Since however all xanthates are neutral this plain meaning is absurd and it must be recognised that a mistake has been made. In such circumstances it is in the Appellants' submission the duty of the Court, if it can, to modify the words so as to enable the intention of the document to prevail. The intention of the document and of claim 6 in particular is to be gathered clearly from inter alia the words "adapted to co-operate with the mineral-frothing agent to produce by the action of both a mineral-bearing froth containing a large proportion of a mineral of the ore" which immediately follow the phrase "alkaline xanthate" in question. In the Appellants' submission the words clearly 10 define the characteristics of the xanthates claimed and limit the claim to xanthates which produce the desired effect. If therefore the words "alkali metal xanthates" are read in the claim in place of the words "alkaline xanthates" there is no question of the claim covering, as Kellock, J., held it would cover, potassium *cellulose* xanthate for no cellulose xanthate is adapted to produce the desired effect. Such a definition by result is one of the type approved for example in the case *No Fume, Ltd. v. Frank Pitchford & Co.* (52 R.P.C. 231).

38. It is submitted that the Court in substituting sensible words 20 for words leading to an absurdity is not amending a document in the manner held to be objectionable, for example, in *Norton and Gregory v. Jacobs* (54 R.P.C. 58 and 271 (C.A.)). In that case Lord Greene, M.R., held that the words "a reducing agent" in the claims could not as a matter of construction be limited so as to exclude reducing agents which any chemist of ordinary skill would know to be unsuitable. In this connection he stated at page 276, line 36: "To adopt the latter proposition would not be to construe the specification but to amend it, and it would, in our opinion, be mere self-deception to hold otherwise." It appears that Thorson, P., wrongly relied upon the reasoning of the Learned 30 Master of the Rolls in this case and omitted to draw a distinction between cutting down the ambit of *clear* words in a claim by reference to technical evidence, on the one hand, and avoiding a manifest absurdity by the adoption of a reasonable construction of a phrase in itself contradictory if read literally, on the other hand. Claim 5 refers correctly to an *alkali-metal* "salt of an ethyl sulphur derivative of carbonic acid . . .," typical examples being the potassium and sodium xanthates referred to in the description. It is submitted that on the proper construction of claim 6 in the light of the specification as a whole as read by the notional skilled addressee there can be no doubt that the words "alkaline xanthate" 40 in claim 6 ought to be read as "alkali metal xanthate." Further the requirement in the claim that the alkali metal xanthate should be "adapted to co-operate with the mineral-frothing agent to produce by the action of both a mineral-bearing froth containing a large proportion of a mineral of the ore" clearly excludes in the Appellants' submission any xanthate such as cellulose xanthate which will not produce the required result.

39. The Appellants therefore submit that properly construed as set out above claim 6 is valid and that the Learned Judges in both Courts were in error in holding that it was invalid for the reasons given.

CLAIM 7

40. Thorson, P., in the Exchequer Court, did not find it necessary to deal with the validity of claim 7 as he had already found claim 9 to be valid ; in the Supreme Court, Kerwin, J., did not deal with the claim for the same reason. Kellock, J., however, considered that claims 7 and 9 could be dealt with together and dismissed claim 7 as invalid on the ground that " a xanthate " was so ambiguous that the claim did not fulfil the requirement of definitions laid down in section 14 (1) of the Act. Rand and Locke, JJ., made the same finding and further held that the claim, when read together with the other claims, particularly claim 9, must be construed to mean that the operation was to be performed in the absence of the normal frothing agent. Estey, J., held that all the claims including claim 7 were infected with the same ambiguity that he found in the disclosures part of the specification. 10

41. With regard to the finding by Rand and Locke, JJ., that the wording of claim 7 is such as to include a process where a xanthate is used without a frothing agent, the Appellants submit that such a construction is at variance with the instructions of the specification and particularly with the statements contained in paragraph 3 of the said specification. It is there made clear that the invention only relates to substances which are to be used in conjunction with the normal frothing agents and in fact states that such substances are not valuable as frothing agents themselves. It is stated for example in paragraph 6 of the specification that " in general the substances referred to are not mineral-frothing agents—producing only a slight scum, and some evanescent frothy bubbles, when subjected to agitation which would produce mineral bearing froth on an ore pulp in the presence of a mineral-frothing agent," thus clearly indicating that the inventor is only interested in their marked effectiveness at improving the behaviour of normal frothing agents. Furthermore, the words in claim 7 " subjecting . . . to a flotation operation in the presence of a xanthate " must be read in the light of the fact that a " flotation operation " is a well-known term in the art denoting a process involving the use of normal flotation agents. Consequently, the phrase " in the presence of a xanthate " when read in such a context must in the Appellants' submission be taken to signify that the xanthate is to be used in a normal flotation operation and its use is therefore in addition to and not in substitution for the normal frothing agent. 20 30

42. The Appellants submit that the words " a xanthate " in claim 7 must be construed in accordance with the principles set out above in relation to the same words in claim 9. The Appellants, therefore, repeat the submissions set forth in paragraph 27–31 hereof and submit that claim 7 should be held to be valid. 40

CLAIM 8

43. As already stated in paragraph 22 of the Petition for Leave to Appeal it will not be contended that claim 8 is infringed and it is not therefore proposed to deal further with this claim.

INFRINGEMENT

44. A minor point was taken by the Respondents to the effect that the Appellants were guilty of laches and acquiescence in not having brought the action until a few days before the expiry of the patent. In view of the statement of Fletcher Moulton, L.J., in *Vidal Dyes Syndicate v. Levenstein, Ltd.* (29 R.P.C. 245 at p. 259) that it is settled law that a patentee need not attempt to stop an infringement when he first learns of it, this contention was not pressed by the Respondents in the Exchequer Court. The point was not, however, abandoned and the Appellants submit that the law is accurately set out in the judgment of Fletcher Moulton, L.J., above referred to. The Appellants therefore contend that they have been guilty neither of laches nor of acquiescence and that if the patent be held valid and infringement be found they are entitled to relief. 10

45. The Respondents have admitted the use of numerous substances in the process of froth-flotation carried out at their mines during the twelve years preceding the filing of the Statement of Claim. There is no doubt that many of these substances fall within the scope of claims 6, 7 and 9, the actual substances used and their manner and date of use being set out in Exhibit M2.

The Appellants submit that if any one of the three claims, in respect of the validity of which the present appeal is brought, is held to be valid, then such claim must also be held to have been infringed. 20

CONCLUSION

46. The Appellants will rely upon the reasons given in the Judgments of Thorson, P., and Kerwin, J., for their findings that claim 9 of the said Letters Patent is valid and infringed and will submit for the reasons given herein that claims 6 and 7 of the said Letters Patent are also valid and infringed.

47. The Appellants will submit that the Order of the Supreme Court of Canada should be reversed and that the Order of Thorson, P. in the Exchequer Court should be restored in so far as it relates to claim 9, and that the Orders both of the Supreme Court and of the Exchequer Court, in so far as they relate to claims 6 and 7, should be reversed for the following among other 30

REASONS

- (1) BECAUSE on its proper construction claim 9 read in the light of the Specification as a whole is limited to alkyl xanthates which are soluble and is valid and infringed.
- (2) BECAUSE on its proper construction claim 6 read in the light of the Specification as a whole is limited to alkali metal xanthates which are adapted to co-operate with a mineral frothing agent so as to produce by the 40

action of both a mineral bearing froth containing a large proportion of a mineral of an ore and is valid and infringed.

- (3) BECAUSE on its proper construction claim 7 read in the light of the Specification as a whole is limited in the same way as claim 9 to alkyl xanthates which are soluble and to processes in which both such a xanthate and a frothing agent are used and is valid and infringed.
- (4) BECAUSE the attacks of anticipation and ambiguity made upon claim 9 fail for the reasons given by 10 Thorson, P., in the Exchequer Court and by Kerwin, J., in the Supreme Court and because the same attacks made upon claims 6 and 7 fail for the reasons given herein.
- (5) BECAUSE the attack of insufficiency made upon the Specification fails for the reasons given by Thorson, P., in the Exchequer Court and by the majority of the Learned Judges in the Supreme Court.

LIONEL HEALD.

J. P. GRAHAM. 20

In the Privy Council.

ON APPEAL

from the Supreme Court of Canada.

BETWEEN

**MINERALS SEPARATION
NORTH AMERICAN
CORPORATION** (Plaintiff) *Appellants*

AND

NORANDA MINES LIMITED
(Defendant) *- Respondents.*

Case for the Appellants

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