

whether the purchase of the stock of a trading company is in the sense of law and in the sense of the trust-deed an investment. I am of opinion that it was not. I think it was a partnership in a company, and that the trustees became partners. The shares that were bought formed their contribution of the capital. But there can be no investment of money, so-called, where the trustees become partners. In investing money the trustees remain outside of the company. Here the trustees joined the company, and so far as money was concerned all that they did was to pay what was their stipulated share of the capital. Therefore I am obliged to come to the conclusion that the purchase of these shares—the joining of the company by the trustees as partners—was a breach of trust. I regret extremely that I am obliged to come to this conclusion, but I see no escape from it unless on considerations of sympathy with those who have been very ill-used, and the law cannot be disregarded that wrongdoers like the pursuers here may not reap the benefit of their own discreditable misconduct.

On the last part of the case I have no difficulty. I agree with the Lord Ordinary that the lending of money to the Scottish Amicable Securities Company was within the powers conferred by the trust on his trustees. I think there is no reasonable doubt on this subject. Judgment ought therefore to be pronounced to this effect.

LORD YOUNG, LORD RUTHERFURD CLARK, and the LORD JUSTICE-CLERK concurred.

The case was thereafter continued in order that certain matters might be adjusted before an interlocutor was pronounced.

Counsel for the Appellants—D. F. Mackintosh—Dickson. Agent—David Turnbull, W.S.

Counsel for the Respondents—Mackay—H. Johnston. Agents—Henderson & Clark, W.S.

Thursday, May 24.

SECOND DIVISION.

[Lord Kinnear, Ordinary.]

HUTCHISON AND OTHERS v. PATTULLO AND OTHERS.

Patent — Construction — Disconformity between Provisional and Complete Specification.

The provisional specification of a patent for improvements in treating oils and fats set forth—“This invention has for its object the treating of oils and fats in an improved manner and so as to render them more suitable for various applications, and it consists in subjecting the oil whether mineral, vegetable, or animal, or the fat, to a temperature about equal to that of boiling water for eight or ten days, the oil or fat being exposed to air in layers of about half-an-inch in depth. . . . The treating of vegetable or animal oils or fats in the described manner has the effect of at once developing

any tendency to thicken, so that when the thus thickened oil or fat is thinned to the desired consistency by combination with the mineral oil it forms a superior lubricant having less tendency to thicken when in use. The thickening of the vegetable or animal oils or fats, which is believed to be due to oxidation, makes them better adapted for saponification and other uses besides that of forming lubricants.” The complete specification set forth—“My said invention has for its object the treating of oils and fats in an improved manner, and so as to render them more suitable for making lubricants, and it consists mainly in subjecting the oil, whether mineral, vegetable, or animal, or the fat, to heat, whilst exposed to the air in shallow layers. . . . In practically carrying out my said invention in dealing with vegetable or animal oils or fats, I prefer to expose them in shallow pans or dishes to the combined action of atmospheric air and heat, with or without the addition of water, for a lengthened time. The addition of water accelerates the process, but the colour of the oxidised oil or fat is generally paler if treated without water. . . . The mixing of a thickened or oxidised vegetable or animal oil or fat with mineral oil to form a compound of consistency and quality suitable for a lubricant is part of my invention, irrespective of the precise means adopted for thickening or oxidising the oil. . . . What I believe to be novel and original, and claim as the invention . . . is—(1) The subjecting of oils and fats in shallow layers to the joint action of air and heat, substantially as and for the purposes hereinbefore described. (2) The combining of oxidised or thickened vegetable or animal oils or fats with mineral oils, substantially as and for the purpose hereinbefore described.”

In an action of damages for infringement of the patent, in which it was proved that the defenders had thickened vegetable and animal oils by the influence of air and heat for the purpose of mixing them with mineral oil as a lubricant, but that their method of applying the air and heat was different from that described in the patent—*held* (1) that if the first head of the pursuers' claim in his patent was to be regarded as a claim for a process, the defenders' process constituted no infringement, as it was a different process; (2) that if it was to be regarded as a claim for a product, the patent was bad on the ground of want of novelty, there being no novelty in the mere thickening of mineral or vegetable oils by the influence of air and heat, apart from the particular process employed; and (3) that the complete specification was disconform to the provisional specification, in respect that the second head of the claim in the complete specification claimed as part of the invention the combination of thickened vegetable and animal oils with mineral oils, irrespective of the process by which the thickening had been effected, whereas the provisional specification was limited to the thickening of vegetable and mineral oils in the particular manner therein

described, and that the patent was therefore void in law.

Patent—Infringement—Prior Use—Trade Secret.

In an action of damages for infringement of a patent the defenders pleaded prior use, and in support of this plea adduced as witnesses persons from the manufactory from which they had purchased the article said to constitute the infringement. These witnesses deponed that they had been in use to manufacture the article for a period long prior to the date of the pursuers' patent, but that they kept their process a secret from the public outside their works as long as they could. It also appeared that it did not become matter of public knowledge until after the date of the pursuers' patent.

Held that the patent was invalid by reason of prior use.

This was an action of damages for loss sustained in respect of an infringement of a patent, at the instance of Robert Hutchison, the patentee, and the firm of Hutchison, Main, & Company, oil manufacturers, Glasgow, of which he was a partner, against Pattullo Brothers, oil refiners, Glasgow.

The patent in question was obtained by Hutchison in 1873 for "improvements in treating oils and fats for making lubricants." Animal and vegetable oils, which are known as fat oils, besides being dear, have a tendency to thicken in use from the action of the atmosphere so as to clog the machinery which they are intended to lubricate. Mineral oils are too thin, except for light machinery, and mineral oils and fat oils cannot be advantageously mixed in their natural state, because the fat oils, with the exception of castor oil (which is only imperfectly soluble in mineral oil), are not of a sufficient gravity to bear dilution with the thinner mineral oil. Hutchison averred that he had succeeded in discovering a method of treatment by which he thickened fat oils in such a way as to enable them to be advantageously mixed with mineral oil, and to form a satisfactory lubricant. His provisional specification, dated 10th October 1873, was as follows:—"This invention has for its object the treating of oils and fats in an improved manner, and so as to render them more suitable for various applications, and it consists in subjecting the oil, whether mineral, vegetable, or animal, or the fat, to a temperature about equal to that of boiling water for eight or ten days, the oil or fat being exposed to air in layers of about half-an-inch in depth. The elements of the process may be modified; thus, with a greater depth or lower temperature, the treatment must be prolonged. In the case of mineral oil an alkali or alkaline carbonate or alkaline earth, by preference in solution or suspended in water, is added to the oil before heating it, and the treatment has the effect of removing the blueness or fluorescence which is considered objectionable in some mineral oils, and of rendering the oil more suitable for combining with a vegetable or animal oil or fat to make a good lubricant. The treating of vegetable or animal oils or fats in the described manner has the effect of at once developing any tendency to thicken, so that when the thus

thickened oil or fat is thinned to the desired consistency by combination with the mineral oil it forms a superior lubricant, having less tendency to thicken when in use. The thickening of the vegetable or animal oils or fats, which is believed to be due to oxidation, makes them better adapted for saponification and other uses besides that of forming lubricants." The final specification, which was dated 7th April 1874, was as follows:—"My said invention has for its object the treating of oils and fats in an improved manner, and so as to render them more suitable for making lubricants, and it consists mainly in subjecting the oil, whether mineral, vegetable, or animal, or the fat, to heat whilst exposed to the air in shallow layers. One important object of my invention is to oxidise or thicken vegetable or animal oils or fats so as to render them better adapted for mixing with mineral oils to form lubricants of various qualities. The treating or oxidising of vegetable or animal oils or fats in the manner indicated is believed to have the effect of at once developing any tendency to thicken, so that when the thus thickened oil or fat is subsequently thinned to the desired consistency by being mixed with a suitable mineral oil it forms a superior lubricant, having less tendency to thicken when in use. In practically carrying out my said invention in dealing with vegetable or animal oils or fats I prefer to expose them in shallow pans or dishes to the combined action of atmospheric air and heat, with or without the addition of water, for a lengthened time. The addition of water accelerates the process, but the colour of the oxidised oil or fat is generally paler if treated without water. The duration of the treatment has in practice to be regulated to suit the kind or quality of the oil or fat operated upon, and is best ascertained by trial. I may, however, state by way of example that if lard oil is exposed without water in a depth of one-half to three-quarters of an inch, and the heat is maintained at about 212 degrees Fahrenheit it continues to increase in body and specific gravity for eight or ten days and nights. It is then of about the same body and specific gravity as castor oil, and will readily mix with mineral oil in any proportion. The mixing of a thickened or oxidised vegetable or animal oil or fat with mineral oil to form a compound of consistency and quality suitable for a lubricant is a part of my invention, irrespective of the precise means adopted for thickening or oxidising the oil. In the case of mineral oil to be used for forming a lubricant I add to the oil an alkali or alkaline salt or alkaline earth, by preference in solution or suspended in water, and then expose the oil to the action of atmospheric air and heat, and the treatment has the effect of removing the blueness or fluorescence which is considered objectionable in mineral oils, and of rendering the oil more suitable for combining with a vegetable or animal oil or fat to make a good lubricant. Owing to the great variety in the sources and modes of production of mineral oils, and their various qualities and degrees of purity, the treatment requires to be adjusted by means of practical trials to each kind. I may, however, state as an example that with most Scotch shale oil, which has been well refined, ten to fourteen days will suffice for a depth of oil of a few inches, the temperature maintained being about 212 degrees

Fahrenheit. The proportion of alkali required is very small, and if caustic alkali is used it will be sufficient, if when it is well mixed with the oil its presence is barely detected by the taste. In treating mineral oil the depth need not be limited, but a better result as regards colour is obtained when the oil is heated in shallow layers. Having thus particularly described my said invention, and the manner of performing the same, I have to state that what I believe to be novel and original, and claim as the invention secured to me by the hereinbefore in part recited letters-patent, is—1. The subjecting of oils and fats in shallow layers to the joint action of air and heat, substantially as and for the purposes hereinbefore described. 2. The combining of oxidised or thickened vegetable or animal oils or fats with mineral oils, substantially as and for the purpose hereinbefore described.”

The pursuers in Cond. 2 stated that the invention was of great commercial value, and commanded a very large commercial sale. In Cond. 3 the alleged infringement was thus stated—“It has recently come to the pursuers’ knowledge, and it is the fact, that the defenders have for many years past, without any right or liberty to do so, been using the said invention and infringing the said letters-patent. In particular, they have for several years past been regularly and habitually buying, using, and selling large quantities of vegetable and animal oils and fats which had been treated and oxidised or thickened in the manner described in the specification of said letters-patent, or in a manner substantially the same. They have thus infringed the said letters-patent. They have also for many years past, in their premises in Glasgow, been combining oxidised or thickened vegetable or animal oils or fats with mineral oils for the purpose and in the manner, or in a manner substantially the same as that described in the specification of said letters-patent; and they have thus made and they have also sold large quantities of lubricants of various qualities in violation of said letters-patent. When so buying, using, selling, and combining of oils and fats as aforesaid, the defenders were well aware of the pursuers’ said letters-patent, and that the said oils and fats so bought, used, and sold by the defenders had been made or treated in infringement of the pursuers’ said patent, and that the defenders in buying, using, selling, and combining as aforesaid were infringing the said letters-patent.”

The defenders averred—(Stat. 2) “The only thickened or oxidised oil or fat which the defenders, so far as they know, have purchased, or used or sold or mixed or combined with mineral oils to form a lubricant is a substance known as lardine. . . . The said substance has been in common and extensive use, and has been a familiar article in the market for many years, and known to be so by the pursuers. Lardine was offered to the defenders by first-rate manufacturers in the ordinary course of business through their respective agents or travellers. . . . The said manufacturers are Messrs Charles Price & Company, London; Messrs Palmer & Company, London; Messrs C. H. Handasyde & Company, Dalkeith. The said substance, as the defenders are now informed, consists of seed oil oxidised or thickened, but not by the process or

method of treatment set out in the said Robert Hutchison’s specification. The defenders had no means of ascertaining, and it cannot be ascertained from any examination of the said substance as purchased and used by the defenders, by what process or method of treatment it was made or prepared. This substance was bought and used by the defenders in the limited quantities mentioned in good faith and in entire ignorance of the pursuer Robert Hutchison’s patent.” (Stat. 3) “The letters-patent granted to the said Robert Hutchison are invalid. 1. The alleged invention, at least in so far as regards the combining or mixing of oxidised or thickened vegetable or animal oils or fats with mineral oils to form lubricants, being the second part set out in the foresaid amended specification, was not the subject-matter of a grant of letters-patent within the meaning of the Patent Acts. There is no ingenuity or invention displayed in the said second part. 2. The specification, even as amended, was disconform to the provisional specification lodged by the said Robert Hutchison with his petition on or about 10th October 1873, and claims an invention different from or not embraced in that disclosed in the provisional specification. There is no sufficient distinction between what was old or was in use and known at and prior to the date of the said letters-patent, and what was new or claimed as new by the said alleged inventor. Further, there is claimed as new, inventions which were old and well-known at the date of the said patent. 3. The specification as amended was insufficient and was unintelligible. It does not particularly disclose the nature of the invention and in what manner it is to be performed. 4. The alleged invention was not new or original. At least material parts of the said alleged invention were not new or original. The said Robert Hutchison was not the first and true inventor of the alleged invention described in the said letters-patent and relative specifications, and it was not first published in Great Britain by him. . . . The said alleged invention, or inventions similar to it, or substantially the same with it, was published and described in Chambers’ Encyclopædia, vol. vii., 1865, under the heading ‘Oil Refining;’ Mechanics’ Magazine, vol. xl. p. 205, and vol. lxvi. p. 129. The said alleged invention was also publicly used in Great Britain at and for many years prior to the date of the letters-patent by the following among others, viz.—Messrs Price & Company, oil manufacturers and merchants, at their works at Erith, Kent, and Milwall in London; Messrs J. & W. Wilson, oil merchants, at their works in Liverpool. . . . and by manufacturers generally in Scotland and England. The subjecting of oils and fats to the joint action of air and heat for the purpose of oxidising or thickening them so as to render them more suitable for making lubricants, was not novel or original, having been used prior to the date of the said patent and down to the present time by the foresaid” Messrs Price & Company and J. & W. Wilson “at their respective works aforesaid, and by manufacturers generally in Scotland and England. Further, the combining oxidised or thickened vegetable or animal oils or fats with mineral oils for forming lubricants was not novel or original. Oxidised or thickened oils or fats, vegetable or animal, have been commonly used

from a period long prior to the date of the said letters-patent down to the present time, for combining with mineral oils to form lubricants, and for other purposes, by the foresaid Messrs Price & Company, and by oil refiners and merchants generally, and by members of the public throughout Scotland and England. The said alleged invention was not of public practical utility. Many methods or processes for securing the object of the alleged invention were in general use prior to the date of the said letters-patent, and were more effective and economical. The said alleged invention constituted no improvement on the treatment of oils or fats previously known and used for the purpose of making lubricants."

The pursuers pleaded—" (1) The defenders having infringed the said letters-patent as aforesaid, and having thereby caused loss to the pursuers, the defenders are liable therefor."

The defenders pleaded—" (1) The pursuers' averments not being relevant or sufficient in specification of particulars of the alleged infringements, the action should be dismissed with expenses. (2) The said alleged letters-patent being invalid in respect of (a) disconformity between the provisional specification and the final specification; (b) insufficiency and unintelligibility of the said final specification, the defenders should be assoilzied. (3) The alleged invention for which the said alleged letters-patent were granted not being, at least *quoad* a material part thereof, competently the subject-matter of a grant of letters-patent within the meaning of the Patent Acts, the said letters-patent are not valid or effectual. (4) The said alleged letters-patent are not valid or effectual in respect (a) the said Robert Hutchison was not the first and true inventor of the alleged invention described in the said letters-patent and specification; (b) the alleged invention was publicly known prior to the date of the said letters-patent; (c) the alleged invention was publicly used prior to the said date; (d) the alleged invention is of no public practical utility. (5) The material averments of the pursuers being unfounded in fact, the defenders should be assoilzied with expenses. (7) The defenders not having infringed the letters-patent granted to Robert Hutchison, assuming the same to be valid, should be assoilzied."

On 12th March 1887 the Lord Ordinary (KILNEAR) pronounced this interlocutor:—" Finds that, in so far as regards the second head of the claim in the complete specification, the said specification does not set forth a new and original invention with sufficient clearness and precision to sustain a patent: Finds that, in so far as regards the said second head of the claim, the complete specification claims an invention larger than and different from that disclosed in the provisional specification: Therefore finds that the patent is void in law: To this extent and effect sustains the defences, dismisses the action, and decerns: Finds the defenders entitled to expenses, &c.

"*Opinion.*—The pursuers' patent is challenged on various grounds, which involve disputed matters of fact. But the objection taken to the second head of the claim arises upon the construction of the specification alone; and I think the validity of the objection may be determined without subjecting the parties to the expense of a proof.

"By this second head the pursuer claims as part of the invention secured to him by the patent, the combining of oxidised or thickened vegetable or animal oils or fats with mineral oils, substantially as and for the purpose hereinbefore described.' There is no question that the purpose of the combination is to make a lubricant. But the only part of the specification in which the supposed invention of a combination of oils for that purpose is described, is a single sentence where the patentee says—'The mixing of a thickened or oxidised vegetable or animal oil or fat with mineral oil, to form a compound of consistency and quality suitable for a lubricant, is a part of my invention, irrespective of the precise means adopted for thickening or oxidising the oil.' These last words appear to me to be the material words to consider in construing this claim. In the previous part of the specification the patentee had described a particular method of treating vegetable or animal oils or fats for the purpose of oxidising or thickening the oil so as to make it suitable for a lubricant, and in the immediately following paragraph he describes a particular method of treating mineral oil for the same purpose. These processes are the inventions claimed under the first head of the claim, and if the patent is good it will protect the pursuer against the unauthorised use of oils prepared in the manner described, whether the animal or vegetable and the mineral oils are used separately or in combination. But when he comes to describe the mixture which he claims under the second head, he does not confine his claim to oils which have been treated by his own methods, but claims as part of his invention the mixing of oils of the kind described irrespective of the means by which they have been prepared or made suitable for mixing. It appears to me that this part of the specification does not set forth a new and original invention with sufficient clearness and precision to sustain the patent, because the process of mixing oils which are supposed to be suitable for being mixed either requires no invention at all, or if it does require invention, the process is not disclosed.

"The specification assumes that in order to be suitable for a lubricant the compound must be of a certain quality and consistency. But the patentee gives no information as to the means by which the necessary consistency and quality are to be obtained.

"If it depends entirely on the original quality or treatment of the separate oils, there is no invention in bringing them together and mixing them. If it depends upon any adjustment of proportions, or upon any process in making the mixture which it requires study or ingenuity to discover, there is no explanation of the process to be found in the specification. It is not immaterial that in describing his own treatment of the oils the patentee alleges that it is one of the advantages of his system that it makes the animal and mineral oils respectively more suitable for combining with one another. I assume that the process for which he claims this advantage is a novel and meritorious invention. But he does not say that it is the only means of preparing oils so as to be suitable for mixing. On the contrary, he assumes that there may be other methods, because he makes his claim for

the compound wide enough to include oils which have been thickened or oxidised by some other method than his. The assumption of the claim therefore is, that the manufacturer may be possessed of oils which are not only suitable for mixing but which have been specially prepared for that purpose, either by means that are known to all the world, or by some method which he has discovered by his own ingenuity, and yet that he cannot mix them without infringing the pursuers' patent. It does not seem likely that there should be any difficulty in mixing oils which are suitable for mixing. But if there is the patentee has not explained where it lies or how it is to be removed.

"Another construction of the specification was suggested, by which the patentee's invention was supposed to be the thickening or oxidising of oils, irrespective of the precise means by which they might be thickened or oxidised. And if this were so, he might be entitled to include in his claim all oxidised or thickened oils, whether used separately or in combination. But then the patent would be bad as a patent for a principle independently of any method for carrying it out. And accordingly the patentee has sufficiently guarded against this misconstruction by the first head of his claim, when he makes it clear that his invention does not consist in thickening or oxidising oils, but in subjecting them for that purpose to a particular process which he describes."

"If I am right in thinking that by the second head of his claim the pursuer claims as part of his invention the mixing of oils which have been treated by other methods than those claimed under the first head, the complete specification claims a different invention from that set forth in the provisional invention, which is confined to one particular process for oxidising oils, by exposing them to the joint action of air and heat."

The pursuers reclaimed to the Second Division, who on 29th June 1887 recalled the Lord Ordinary's interlocutor and remitted to him to proceed as accords.

A proof was allowed. The general character of the alleged prior use by Price & Company, to whom the case on that branch of it came wholly to relate, appears from the Lord Ordinary's second note, *infra*.

John Harvey, a partner of Price & Company, gave this evidence—"We did not at first offer to the trade the thickened oil in an unmixed state, because we supplied consumers with the compound and not manufacturers of lubricants. In fact, so long as we could keep the process pretty well to ourselves it paid us better to get both profits by supplying the total compound than by supplying thickened oil to the manufacturer, who would proceed to make the compound and get his profit out of that. We managed for a long time to keep the matter to ourselves. At the same time, as regards this process which was going on in our works, it was not in any way kept secret any more than any other process in the works. It was patent to all the workmen who were concerned in it, and we sold the manufactured oil all over the world. We used to treat probably from eight to ten tons at a time in each tank. In a busy season we can treat sixty or seventy tons of the heavy oil in a week.

About 1869 we did about forty tons a week. Eventually the method was more widely promulgated. One of our employes was dismissed, and he disclosed the secret to a rival firm. After that we found that these thickened oils were put largely into the market by other people than ourselves. The term lardine was invented by a French clerk whom we had for the purpose of selling thickened oil on the Continent."

J. D. Palmer, a partner of Palmer & Company, gave this further evidence on the same matter—"It was in 1880 that we first began to blow oil in the way we have been doing lately. A man came to our office one day bringing with him two samples of oil, and asked me whether I would be inclined to employ him. He said he was able to take the one sample, and by processes of which he was the master turn it into the other. The one sample was evidently much more viscous than the other. He stated that he had been in Price & Company's works, but had ceased his connection with them. We accordingly allowed him to put up machinery with the view of doing that. He did not communicate the process to us in the first instance. He asked employment to carry out the process secretly himself, and said he would divulge it if we gave him an agreement for a certain number of years. This we eventually did, and he then divulged it. He told me it was a process which he had brought from Price & Company's place. We put up machinery and proceeded to blow oil. These oils became thicker, and we mixed them with mineral oil and sold them in the trade."

On 10th January 1888 the Lord Ordinary (KINNEAR) assolized the defenders.

"*Opinion.*—The object of the pursuer's invention, as expressed in the specification, is the treatment of oils and fats in an improved manner, so as to make them more suitable for lubricants. In his evidence he says that prior to 1873, when his invention was made patent, the lubricating oils known to the trade were very unsatisfactory. Animal and vegetable oils, which are known as fat oils, were dear, and they had a tendency to thicken in use from the action of the atmosphere, so as to clog the machinery which they were intended to lubricate. Mineral oils which had recently come into use were too thin, except for very light machinery; and mineral oils and fat oils could not be advantageously mixed, because the fat oils, with one exception, were not of sufficient gravity to bear dilution with the thinner mineral oil. The one exception was castor oil; and from causes which have not been explained, castor oil is not soluble, or only imperfectly soluble, in mineral oil. In that condition of matters, the pursuer says that he set himself to discover a method of thickening the mineral oil so as to obtain as the result an oil of sufficient gravity for heavy machinery, which should be free from the tendency of fat oils in their natural condition, to thicken in use. And his case is that he has discovered a method of treatment for that purpose, by which he thickens fat oils in such a way as to enable them to be advantageously mixed with mineral oil, and to form a satisfactory lubricant. The process which he has thus discovered is described in his specification as consisting 'mainly in subjecting

the oil, whether mineral, vegetable, or animal, or the fat, to heat while exposed to the air in shallow layers.' But he explains that the main purpose for which he subjects mineral oil to this process is to remove what he describes in the specification as the blueness or fluorescence, which is considered objectionable in mineral oils, and the purpose with which he subjects fat oils to the same treatment is to thicken or oxidise them.

"I do not think it at all doubtful that the pursuer's process, which he has protected by his patent, has in fact the valuable effect which he ascribes to it. The oil by being exposed to the air in the manner described becomes oxidised, and it has been proved by experience that this oxidised oil may be produced of any thickness or gravity that may be desired up to the gravity of castor oil; that the oil so treated is readily mixable with mineral oil, and that the mixture has no tendency to thicken in use. Whether the thickening of the oil is entirely due to oxidation does not appear to be certain, but the thickening and oxidation, according to the evidence, are always found together; and at all events it is not disputed that the result which the pursuer desired to obtain, and has obtained successfully, is due to the exposure of the oil to the combined action of air and heat, which causes oxidation.

"The product, according to the evidence, is of considerable commercial value, and the pursuer alleges that his invention has had a great effect upon the trade; that it has enabled mineral oil, which before could not be used for lubricating work at all, to be used in enormous quantities when mixed with thickened vegetable oil, and that the thickened oil has been so largely used that it has come to be known in the trade by a special name which has been given to it, and is called lardine.

"The defenders are said to have made use of this invention and infringed the patent by purchasing lardine, manufactured according to the pursuer's method by Messrs Price & Company, Messrs Palmer & Company, and Messrs Handasyde, and combining it with mineral oils to form a lubricant, or selling it for the purpose of being so combined. There can be no doubt that the lubricant purchased by the defenders, and manufactured by these London firms, and sold under the name of lardine, is a thickened vegetable oil, or that the thickening is produced by a process by which the oil is oxidised by the combined action of air and heat. But it is an entirely different process from that described in the pursuer's specification, and before considering whether it falls within the scope of his patent or not I think it is desirable to see exactly what the process is, and what is the history of its use by the firms in question.

"The evidence upon both of these points is perfectly distinct. The process in question was adopted first by Messrs Price & Company of London. It differs from the pursuer's process in this respect, that instead of being exposed, as he directs, in shallow layers, the vegetable oil is put into circular vessels 10 feet in diameter by 6 feet 6 inches deep; in the interior of these vessels there is an arrangement of pipes, for conducting air, steam, and cold water; the oil is heated by the application of steam, and air is blown through the heated oil, which, under this

treatment, becomes oxidised so as to enable it to be mixed advantageously with mineral oil. I think it proved that this is a more expeditious and economical method than the pursuer's, because it enables larger quantities of oil to be treated in a given time. But it undoubtedly resembles the pursuer's in this respect, that the oil so treated is oxidised by the action of heat and air alone, and being so oxidised, it is found to possess the advantages which he claims as the special merits of his process.

"I think it proved that this process had been in use in Messrs Price & Company's manufactory for many years before the pursuer began his experiments in 1873. Mr Harvey, a partner of that firm, says that he found it in operation when he joined the firm in 1869. Mr Colls, who has been in their employment since 1871, says that it has been in operation during the whole time of his service; and Mr Dodd, their general manager, says that it began so far back as 1862. He says that in the winter of 1861-62 he was present at a conversation between Mr Price, a former partner of the firm, and Mr Keats, their consulting chemist, who is now dead, in the course of which they discussed a lecture about to be given by a Mr Hubbard on the thickening of oils by oxidation; that Mr Keats attended the lecture, and afterwards made certain experiments, and ultimately instructed the witness to fit up an apparatus of the kind now in use; that this was done, and that since this first beginning in 1862 the firm has been carrying on the process continuously, and with success.

"It is suggested that the process thus described was borrowed from that disclosed in Dunn's patent of 1843, for 'purifying and bleaching oils and fats,' and that its true purpose was not to thicken but to purify the oil. All of the witnesses whom I have mentioned say that they never heard of Dunn's patent; and what is more important, they all state most positively that their purpose was not to bleach but to thicken. If this is true, and I see no reason to doubt their testimony, it is of no consequence whether their process was originally borrowed from Dunn's or not. Nor should I have thought it very material, even if it were shown that Messrs Price & Company's apparatus was originally constructed for the purpose of bleaching, provided it has been used in fact for the purpose of oxidising, and so of thickening, for a period beginning before 1873. That their process is in fact identical with Dunn's there can be no doubt. But they carry it on further than he directed, for the purpose of producing an effect which he did not foresee or did not disclose. He describes a process of blowing air through oil for the purpose of bleaching and not of thickening. But it is in evidence that it is impossible to bleach effectually without thickening to a certain extent; that thickening is an essentially progressive process; and that the greater or less extent to which the oil may be thickened depends upon nothing but the quantity of air blown through it.

"The question therefore is, Whether this process was in fact employed by Messrs Price & Company before 1873 for the purpose of oxidising animal or vegetable oils, so as to produce a lubricant, either to be used alone, or to be mixed with mineral oils? The evidence, to my mind,

leaves no room for doubt that it was so used, and with a view to the advantages described in the pursuer's specification. Mr Harvey says that since he joined the firm in 1869 they have been in the habit of treating fat oils in the manner described, of mixing the oils so treated with mineral oils, and of selling the compound to a very large extent in their business. And the evidence of the two managers is to the same effect. It is true that in the earlier years they did not thicken to the same extent as they do now; but that is not of material importance, because thickening to an appreciable extent, will involve an infringement or an anticipation of the pursuer's patent, provided it be produced by a process which will fall within his claim. Taking the gravity of rape seed or cotton oil, in their unoxidised condition, Mr Harvey's evidence is that in 1869 they used to thicken to 930 or 940, whereas they now thicken to the gravity of castor oil (969), which is given in the pursuer's specification as an example of the effect of his process, and to much higher gravities. He cannot give the exact date when they began to use the higher gravities. But the material considerations are that the advance is not due to any new discovery, but to the natural progress of the manufacture, and to a great increase in the number of mineral oils available for mixing; and secondly, that the process of which the pursuer complains as an infringement is exactly the same as that in use in 1869. The only difference is that the oil is treated for a long time, so that a greater quantity of air may be blown through. . . .

"It is said, however, that the evidence as to Messrs Price & Company's process is not trustworthy. This is a question of credibility, as to which it is enough to say that I see no reason to doubt the veracity of the witnesses, and that I accordingly accept their testimony as true. Their statement is in no way inconsistent with the evidence as to the great increase which is said to have taken place in recent years in the consumption of lardine. The pursuer has failed to prove that this is to be ascribed to his invention. It is not important that the name of 'lardine,' which he says has been given to his product, appears to have been invented by a French clerk of Messrs Price & Company to denote the blown oils of that firm. But it is more material that there is no evidence that the pursuer's patent, or the process which it describes, had become known to manufacturers or dealers in oils until shortly before this action was raised. Lardine had undoubtedly become known as an article of commerce, but his invention was not known, and it is certain that it was not from his invention that Price & Company and Palmer & Company, who would appear to be the largest manufacturers, have borrowed their process.

"If this view of the facts is correct the question which has been raised as to the construction of the specification is of little importance, because if Messrs Price & Company's process differs substantially from the invention which is claimed to be novel there is no infringement; and, on the other hand, if it does not substantially differ, the patent is invalidated by the prior use, which in that case must be held to be established. But since the question of fact is in controversy, it

may be proper to consider also the question of construction. It is said that the pursuer's invention consists—first, in the discovery that it is possible to thicken fat oils without decomposition and without the addition of any foreign substance by heat and air alone; second, in the discovery that it is possible to mix oils so thickened with mineral oils so as to form a lubricant; and third, in the elaboration of a particular process for applying the discovery in practice. The invention that is claimed as novel is therefore said to be the thickening of oils by exposing them to air and heat, either by the method described or by any other method which operates exclusively by air and heat. I am unable to adopt this reading of the specification. Without taking Messrs Price & Company's process into consideration at all there is evidence that before 1873 it was known generally that the exposure of fat oil to air would have the effect of thickening it, and also that the process would be accelerated by heat. I do not think it proved that this was generally recognised as a principle which could be applied to any practical effect so as to produce an article of commercial value. But it is proved by the evidence of Mr Allen and Mr Falconer King that these general facts were known. I do not think that if the pursuer's specification be fairly construed with reference to the statements which he gave in the box as to the experiments which he made and the purpose of these experiments, that he represents himself to have discovered either of these facts as an entirely new principle. I think that what he does claim to have discovered is—first, that fat oils may be thickened by treating them in the particular manner which he describes—that is, by subjecting them to heat and air in shallow layers; and secondly, that when animal or vegetable oils have been so thickened or oxidised they will mix with mineral oils. And accordingly when he comes to define what is novel and original in the process which he describes he states his claim under two separate heads—the first of which relates to the treatment of unmixed oils and fats; and the second to the mixing of oxidised or thickened vegetable or animal oils with mineral oils. But under the first head he limits his claim in clear and distinct terms to the subjecting of oils and fats in shallow layers to the joint action of air and heat, substantially as and for the purposes described. That is not a claim for the oxidation of oils by any other method than that described; it is a claim for the particular process described for the purpose of oxidising or thickening. It may still be a perfectly good claim for a new invention, which is a fit subject for a patent, even although it be proved, as I think it is, that a different method of oxidation had been publicly used by Messrs Price & Company before the pursuer's invention was made patent; and it follows that Messrs Price & Company's process would not be an infringement if it were later than the pursuer's patent.

"It is said that the second claim is intended to cover any method of oxidation which operates by heat and air exclusively, but the second claim is not for the treatment of unmixed oils, but solely for the mixing of fat oils already treated in the manner described by the pursuer, or oxidised in some other manner with mineral oils. There can be no infringement under this second

head of the claim, unless the oil thickened or oxidised in whatever manner has been mixed. There is no infringement by merely oxidising or thickening. In construing this second claim without the information which is now to be obtained from the evidence as to the nature of the process which is described, it appeared to me objectionable for the reasons stated in my former opinion. The special subject of this claim is not the treatment of the oil but the mixing of the oil after it has been treated. The assumption of the claim therefore is, that the manufacturer is possessed of oils which have been treated in such a way as to make them fit for mixing; and that being so, the pursuer goes on to say, 'If he mixes the oils which have been so treated, then he infringes my invention.' It appeared to me that the process of mixing oils already treated in such a way as to render them suitable for mixing, either involved no invention or skill or ingenuity at all—and in that case there was no proper subject for a patent—or else that it did involve some skill, ingenuity, or special knowledge, and in that case the process was not described, and the evidence which has been led has not in my opinion displaced that objection. I think the pursuer has proved, and so far I agree with his view of the evidence, that in the great majority of cases there is no difficulty in effecting the mixture which required any further explanation by the patentee than that which he has given. But if that be so, then the mere process of mixing is not a subject for a patent. But then it is said, and there is evidence to that effect, that in the case of oils of certain specific gravity there is so great difficulty in mixing them that it cannot be known without experiment in what proportions they will effectually mix. If that is sufficient to create a serious difficulty, then the process is not explained by the patentee. If the specification is to be construed as claiming a product, that will not remove the objection, because in that case the patent would cover every mixture of mineral oil and oxidised fat oils irrespective of the method of oxidation.

"For these reasons I am of opinion that the defenders ought to be assized."

The pursuers reclaimed, and argued—(1) The prior use had not been proved. But (2) even granting that the process had been so used, the pursuers were entitled to protection in virtue of their patent. Prior use was equivalent to prior publication—the theory of the patent law being that in return for publication for the benefit of the public, the State agreed to give the inventor the exclusive right of manufacture for a certain time. Even then though Price & Company and others had been using it secretly and without intimation to the public, the pursuers, as true and original inventors, and in virtue of their patent, were entitled to protection. It would be unjust if the man who gave the public the benefit of his invention was to be shut out of it just because another had practised the same invention in secret—*Johnston on Patents*, 83; *Sykes v. Watson*, February 2, 1866, 4 Macph. 349; *Smith v. Davidson & Wilson*, March 11, 1857, 19 D. 691, per Lord President, 698; *Hancock v. Someroock*, 39 Newton's L.J. 158, per Williams, J.; *Neilson and Others v. Harford and Others*, June 9, 1841, 1 Webster's Patent Cases, 331; *Heath v. Smith*,

January 23, 1854, 3 Ellis & Blackburn's Rep. 256. (3) The patent was a patent for a product—for three products indeed. In the first place, for oxidised or thickened fat oil; secondly, for better coloured mineral oil; and thirdly, for a combination of the two. A new application of an old principle might be the subject of a patent, and the patentee, by specifying one method of producing that new application, was not to be held as tied down to that method. The defenders' process though different from the pursuers' was within the pursuers' patent.

Argued for the defenders—Prior use had been proved in fact, and it was not secret prior use in any such sense as would deprive it of its legal effect in invalidating the pursuers' patent—*Tenants' case*, 1798, 1 Webster's Patent Cases, 125; *Stead v. Williams*, September 2, 1843, 2 Webster's Patent Cases, 126; *Carpenter v. Smith*, 1842, 1 Webster's Patent Cases, 540. (2) If the pursuers' patent was a patent for a process, then it did not strike at the defenders' process, which was admittedly different; if it was a patent for a product, it was bad for want of novelty, oxidised oil being no novelty. (3) The complete specification claimed a combination of mineral and fat oil, the latter being oxidised according to any process, and not necessarily according to the pursuers'. The provisional specification was confined to the pursuers' process. Consequently the patent, in so far as it was a claim for a combination, was bad.

At advising—

LORD JUSTICE-CLERK—In this case we have before us a question under a patent, or rather a question as to an existing description of a patent right. It has been the subject of a very full investigation, and we have a very full opinion from the Lord Ordinary in regard to the question at issue. We have now to decide that question.

When the case came before us, in the first instance, Lord Kinnear, we found, had decided it on the patent itself—that is, upon the provisional specification and the amended specification, and he held that the patent was not a good one, but a bad one. It was our view, however, that we should have the whole case before us, and accordingly we recalled that judgment, and remitted to him to allow a proof both as to the substance of the patent itself, and also as to the question of infringement. After proof the Lord Ordinary pronounced judgment, in which he said he held the view still which he took of the case when it was previously before him upon the legal import of the patent. He had also come to be of opinion that there had been prior use of a part of the alleged invention, or of a part of that invention, and that there had been no infringement of anything in which the pursuer had a patent right.

I have come to be of opinion, and that very clearly, that upon both points with which the Lord Ordinary deals his Lordship is right. I shall only say a sentence or two in addition to the very full exposition of his views with which the Lord Ordinary has favoured us.

The invention is of this kind. A patentee has sometimes rather hard measure. His invention may be very useful and very profitable to those who use it, and yet he may have so expressed himself in his patent as not to be entitled to ob-

tain the protection which the patent was intended to provide, and that either from discrepancies between the original specification and the descriptions in subsequent specifications applicable to the same thing, or from flaws or omissions in the specific words in which his claim is mentioned. There are a variety of grounds of that kind which may lead to the result which I have pointed at. In former days, certainly, I used to think that such cases were hard upon inventors.

In this case, however, while I feel that Mr Hutchison is a meritorious inventor, or at least a meritorious observer of the results which he has patented or endeavoured to patent, I rather think his difficulties have arisen from the very nature of the operation itself, and the subject-matter to which the patent applies.

Putting aside technicalities, there were two results which Mr Hutchison endeavoured to protect by patent, and which were decidedly meritorious. In dealing with these fat vegetable oils the difficulty they seem to have found was that they got coagulated, and were unfit therefore for use as lubricants—or rather, that in the use of them the coagulation or viscosity of the oil prevented them from being used as lubricants. From observation and experiment Mr Hutchison found that if the fat or vegetable oils were exposed to the operation of the atmospheric air and heat in open vessels for a sufficient length of time, and at a sufficient temperature, the result was to remove that tendency to thickening, and to render the oil more adapted for a lubricant.

In the second place, he found—and this was a remarkable part of the invention—that after the fat or vegetable oils had been used and treated in that manner they were capable of combining with the mineral oils. The ordinary fat or vegetable oil had been found incapable of such a combination. Perhaps “combination” is not the right word, for it was more a mixture that was desired and intended. The two—mineral and vegetable oils—would not mix together, and as of course mineral oil had come to be a very large article of commerce, it was desirable that traders should be able to mix it with the ordinary fat or vegetable oils.

Now, it is to protect those two things that this patent was intended. It was for that object that it was obtained. And the question in the first place is, Is that patent a good one? Is it a good patent according to the rules by which such patents are ordinarily proved? The object of a patent is to give a monopoly or protection to an inventor. That means that other persons—all other persons—are prevented from doing what he proposes to do in his patent unless by licence from him. It is a prohibition and a monopoly.

The Lord Ordinary has decided that this patent is bad, and he has given the reasons which have led him to that conclusion. He has given these reasons at considerable length, and I shall just summarise the more important of them in a few sentences.

I rather think that on the documents themselves there is a variance—and a fatal variance—between the original specification and the amended specification. The original specification evidently contemplated the adapting of the patent to a process, the mechanical means of attaining a particular end, and the particular end was to attain

the two-fold results I have already mentioned. Accordingly, he says in the original specification that his patent consists in the exposing of the oils to the atmosphere. He says—“This invention has for its object the treating of oils and fats in an improved manner, and so as to render them more suitable for various applications, and it consists in subjecting the oil, whether mineral, animal, or vegetable, or the fat, to a temperature about equal to that of boiling water for eight or ten days, the oil or fat being exposed to air in layers of about half-an-inch in depth.” That is the first paragraph of the provisional specification. And then he goes on to say in the last paragraph—“The thickening of the vegetable or animal oils or fats which is believed to be due to oxidation makes them better adapted for saponification and other uses besides that of forming lubricants.” But when he comes to enlarge his specification, and to amend it after the patent was got, it is quite plain that his view in regard to that had changed. The claim which he makes in the amended specification is not for a process. The process of the shallow layers, and the application of heat, is not treated as an essential part of the invention at all. On the contrary, he says—“In practically carrying out my said invention in dealing with animal or vegetable oils or fats, I prefer to expose them in shallow pans or dishes to the combined action of atmospheric air and heat, with or without the addition of water, for a lengthened time. The addition of water accelerates the process, but the colour of the oxidised oil or fat is generally paler if treated without water.” That is the way in which the oxidation, which is the source of the particular operation and of the alteration on the fat, ought to be carried out. But he only says that he prefers to do that in that particular manner, and when he comes to speak of the mixing of the animal and vegetable oil, he says—“The mixing of a thickened or oxidised vegetable or animal oil or fat with mineral oil to form a compound of consistency and quality suitable for a lubricant is a part of my invention, irrespective of the precise means adopted for thickening or oxidising the oil.” Now, I am of opinion that that of itself would have exposed this patent to considerable hazard—indeed to very great hazard. It is not a patent for the application of a principle, because the application of heat, or the temperature of the atmosphere, is not a principle, at all events it is not a principle here. It is not specified. It is not an essential part of the invention. It is not a necessary part of the invention. It is for the plainest possible reason that the oxidation in question might be performed in a great variety of ways irrespective altogether of the particular mechanism suggested but not patented on the part of this patentee.

Now, without going any further I should have come to that conclusion. I think that the patent as it stands is not a patent of a principle. It is not a patent of a process. It is a pointing out of an advantageous mode of dealing with ordinary mechanical agents not invented by the patentee. That pointing out is not at all exclusive, and it might embrace a great variety of modes not comprehended in this patentee's description.

I think the views I have now expressed lie at the very foundation of the claim which is here

made. The only novelty is in the second branch of the claim, where he claims the mixing of the fat and mineral oils. But if there is a claim for a process he does not publish either why the mineral oils should mix with the vegetable, nor does he show any mode in which he claims that that can be done.

I think that the views of the Lord Ordinary, which he has elaborated with great care, truly turn on the pivot I have mentioned.

Then, as to the prior use, the novelty, and the infringement, I concur with the Lord Ordinary. I think it is very doubtful if any infringement is here libelled, much less proved. But in any case the Lord Ordinary heard the evidence and saw the witnesses, and as far as the argument at the bar went in the way of impugning the honesty and credibility of those witnesses, the Lord Ordinary has expressed himself as satisfied with that part of the case, and I need not enter into it.

On the whole matter therefore I am of opinion that the interlocutor reclaimed against ought to be adhered to.

LORD YOUNG—I am of the same opinion. I have been hesitating as to whether I should say anything except that I concur with your Lordship and with the Lord Ordinary. I should like to point out, however, that the pursuer is not seeking protection for his patent. His patent is now expired, and has been expired for about a year, and it was on the very eve of its expiry that this action was brought. It had only a few months to run. The action therefore was not for an interdict, or as our neighbours in the south would say, for an injunction, but was brought for damages for alleged infringement. The patent expired in December 1887, and the action was raised in December 1886.

I may here say that I share your Lordship's doubt whether the statement of infringement here is relevant so as to found an action of damages. The only statement is in Cond. 3, and I think it is of very doubtful relevancy indeed. But two questions were argued to us. One of those questions regarded a matter of fact, whether the process described or referred to in the patent, and wherein the invention was said to consist, was new at the date of the patent—that is, whether this gentleman was the first and true inventor, or whether there had not been prior user. The Lord Ordinary in his note to his second judgment, which proceeded upon the evidence, says—"The question therefore is, whether this process was in fact employed by Messrs Price & Company before 1873 for the purpose of oxidising animal and vegetable oils, so as to produce a lubricant, either to be used alone, or to be mixed with mineral oils? The evidence to my mind leaves no room for doubt that it was so used, and with a view to the advantages described in the pursuer's specification." And it was conceded by the learned counsel for the pursuer, and indeed could not be denied, that there was evidence to that effect, abundant and conclusive, if the witnesses who gave it are to be believed. Of course it was conceded that if the fact was so upon the evidence, the patent was bad. It was further conceded, and could not have been contested, that the fact referred to was established if the witnesses who

gave evidence to that effect were trustworthy. Upon this matter, which really came to be the question, the Lord Ordinary expresses himself thus—"It is said however, that the evidence as to Messrs Price & Company's process is not trustworthy. This is a question of credibility as to which it is enough to say that I see no reason to doubt the veracity of the witnesses, and that I accordingly accept their testimony as true." Reasons were urged and arguments stated why we should disbelieve the witnesses who were examined in presence of the Lord Ordinary, and whom he believed. Of course we attended to the reasons urged to that end, and to the argument stated to us. The result in my mind is the same as in your Lordships, that I agree with the Lord Ordinary. I have not been moved to doubt the testimony on which he relied, or doubt the credibility of the witnesses who were examined before him, and whom he believed. And that is really the end of the case upon the facts. Observe, it would require a very strong case indeed to induce a court of review to arrive at another conclusion as to the credibility of the witnesses who were examined before the Lord Ordinary, and to impute to them what it would be mere euphemism to call other than perjury. To disbelieve the evidence of these witnesses is to say that they did not give true evidence.

That concludes the case upon the facts. But I am also of opinion with the Lord Ordinary, and with your Lordship, that the patent is bad in law, and that for the reasons fully explained in the Lord Ordinary's note to his last judgment. I do not at all dissent from the views explained in his first note. I think the patent is a bad patent in law—that there is no patented invention set out or specified. I repeat that I think the alleged infringement is of doubtful relevancy, as contained in the article to which I have referred. Therefore upon all the grounds which have been brought before us, and argued to us, I am of opinion that the action is not well founded, and that the defenders are entitled to absolvitor, and with expenses.

LORD RUTHERFURD CLARK—I am satisfied that the pursuer made independently an important discovery when he found that animal and vegetable oils oxidised or thickened by the action of air and heat readily combined with mineral oil so as to make a good lubricant. So far there may be material for a patent. But the defenders maintain that the patent is bad on various grounds.

In the argument which we heard the pursuer maintained that his patent was a patent for a product, or rather for three several products. As this was the construction which the pursuer adopted, I take it to be the most favourable that could be advanced on his behalf. Viewing the patent in this light, I find that the products are, first, vegetable or mineral oil thickened or oxidised by the action of air and heat; second, mineral oil clarified by the same process; and third, the compound formed by the mixture of the thickened or oxidised oil with mineral oil.

It follows that as each of these products is claimed as falling within the patent, each of them must be a novelty or invention. If not the patent is necessarily bad.

I shall now consider the first product. I

should have great difficulty in believing that at the date of the patent it was not known that vegetable and animal oils could be oxidised or thickened by the action of air and heat. It seems to be the obvious and necessary result of the application of these agents. But this matter is not left in doubt. For Mr Falconer King says—"It was known long before 1873 that vegetable and animal oils would thicken by exposure to air. It was also known that heat would accelerate the process." It was not suggested by the pursuer that this statement was not true, and for my part I cannot see any reason to doubt its truth. If this be so, the product which the pursuer claims as his invention is not new, and if it be old the patent is invalid. There is neither novelty nor invention.

But the pursuer, as I understood, maintained that the product was claimed with a qualification, inasmuch as the words of the first claim run thus—" (1) The subjecting of oils and fats in shallow layers to the joint action of air and heat, substantially as and for the purposes hereinbefore described." If the patent be for a product, as the pursuer contends, and if the words which I have quoted qualify or limit the claim, the meaning must be that the pursuer claims the product when made in a particular way and for a particular use. But he very expressly disclaimed all novelty in the process, and apart from this disclaimer I can see neither novelty nor merit in it. If therefore the process were part of the invention which is claimed by the pursuer, there would be much to say against the validity of the patent. But if the process be put aside, there only remains the specified purposes or uses.

It would seem to be the law that there cannot be a patent privilege for a new use of an old invention, even though there be merit in the discovery of the new use—*Kay v. Marshall*, 5 H.L. Cases, Clark & Finely 425. But putting that question aside, let me consider what the uses are which are specified by the pursuer. I have said that he discovered that the thickened oil would combine with mineral oil so as to make a good lubricant. That is not the only use in connection with which the thickened oil is claimed as a novelty. The claiming clause uses the plural—"the purposes hereinbefore described." What are these purposes? One undoubtedly is to combine the thickened oil with mineral oil. The other, so far as I see, can be nothing else than to use it by itself as a lubricant. The specification sets out—"My said invention has for its object the treating of oils and fats in an improved manner, and so as to render them more suitable for making lubricants, and it consists mainly in subjecting the oils, whether mineral, vegetable, or animal, or the fat, to heat whilst exposed to the air in shallow layers." Further it says—"One important object of my invention is to oxidise or thicken vegetable or animal oils or fats so as to render them better adapted for mixing with mineral oils to form lubricants of various qualities." Reading these sentences together, it is plain enough that the preparation of the animal and vegetable oils, so as to make them better adapted for mixing with mineral oils, is not the sole invention which the pursuer claims. The words "one important object," as well as the plurality in the claiming clause, are conclusive on that point. If so, the animal and vegetable oils are

treated in the manner described in the specification with a view to a use apart from the admixture of mineral oils, or in the words of the specification "for making lubricants." I take that to mean that the thickened oil is itself to be used as a lubricant. There is no other use suggested, and if the use was to be a part of the claim, the pursuer was bound to specify it. It is certain, as I have already said, that the thickened oil is claimed as being adapted to more than one use.

The result in my opinion is that the product claimed by the pursuer as his invention is a known product, manufactured by a known process, and intended for a known use. For I do not think that it can be said that there can be any novelty or invention in using thickened oil as a lubricant.

For these reasons I think that the patent is bad, and I have stated them in order that I might deal with the argument which was submitted to us. But I have further to say that I concur in the views expressed by the Lord Ordinary in his note.

The Court adhered.

Counsel for the Reclaimers—D.-F Mackintosh — Dickson. Agents—Davidson & Syme, W.S.

Counsel for the Respondents—Graham Murray — Kennedy. Agent—Gregor Macgregor, S.S.C.

Friday, June 1.

FIRST DIVISION.

[Lord Kinnear, Ordinary.

MORE (GRAEME'S TRUSTEE) v. GIERSBERG.

Bankruptcy—Trustee—Tantum et tale—Breach of Trust by Bankrupt—Personal Bar.

The trustee in a sequestration raised an action against the bankrupt's sister for payment of a debt alleged to be due by her to the bankrupt. As the defender was resident abroad the pursuer used arrestments to found jurisdiction in the hands of the executor of a lady who had left a legacy to the defender. The defender denied that the arrestments had the effect of founding jurisdiction, as the executor had no funds in his hands belonging to her. She averred that by her antenuptial marriage-contract all funds to which she might acquire right during the subsistence of the marriage were made over to the marriage-contract trustees for behoof of the spouses in liferent, and for the children of the marriage in fee. The pursuer replied that the marriage-contract had not been intimated to the executor at the date of the execution of the arrestments. The bankrupt was one of his sister's marriage-contract trustees.

Held (*dis. Lord Shand*) that as the trustee in the sequestration took the bankrupt's estate *tantum et tale* he was barred by the breach of duty on the part of the bankrupt in not intimating the marriage-contract, from making the legacy effectual for the payment