

except that which they derive from the disponers, and that is only the right to enter in room and place of the disponers under the charter as it stands. There is no suggestion on record that the original vassals could have set aside the charters. It appears that they continued to possess for twenty years without raising any question whatever as to their liability as vassals, and we are bound to assume, in the first place, that their title expresses exactly the terms of the contract on which they agreed to take the lands, and secondly, that they were perfectly well aware when they accepted it of everything that is contained in the Act of Parliament, and therefore that they had no right to complain of the defect which the pursuers allege. But if that be so, the original vassals cannot get rid of their liability except by finding a disponent to take their place. But the disponent can have no other right as against the superior but that of the disponent in whose place he stands, and therefore it seems to me to be out of the question to maintain that he can reduce a feu-charter which was unimpeachable at the instance of the disponent, and so to extinguish the feu-right and relieve the disponent, as well as himself, of all liabilities of the contract of feu. But I do not think their case would be better if we were to assume, contrary to the fair implication of their own statement, that they were entitled to get rid of their contract as against the original vassals. They appear to me to be in this dilemma. If the contract with the original vassals is unimpeachable they have no ground of complaint, because they have obtained exactly the right which they contracted to purchase. If, on the other hand, they are entitled to get rid of the contract of sale and its consequences, their remedy is to reduce the dispositions on which they are entered, and in that case they have no concern with the lands, and no title or interest to object to the charters.

On the whole, therefore, I am unable to see any tenable ground on which the action can be supported.

In the view I have taken, the question whether the pursuers' right has been validated by the positive prescription does not arise, and I think we should not consider it, both because it is not necessary to the decision of the case and also because it cannot in my opinion be well raised or effectually decided between the parties to this action. It can only arise on the assumption that the defenders have in the first place exceeded their powers by including too large an area in one feu, and in the second place failed to protect the trust-estate by importing the conditions of the statute into the title which they granted to the pursuers' authors, in such a way as to make them binding upon singular successors, because it is obvious that the vassal cannot prescribe against his own title, and therefore cannot acquire a right inconsistent with the conditions of the Act of Parliament if these have been well expressed in the title. Accordingly, to enable the defenders to maintain their plea of prescription, they found it necessary to argue that the conditions of

the Act of Parliament have not been made to affect the title, because they have not been so expressed as to satisfy the requirements either of the Act itself, which prescribes the method by which its conditions are to be made effectual, or of the general law established by the Conveyancing Statute. I doubt whether the trustees have any title to state that plea. The assumption is the argument that the pursuers' title may be challenged as *ultra vires* of the trustees at the instance of some future beneficiary who will not be bound by their actings, or by the concurrence of all the existing beneficiaries in the defence stated in this action. But, if such a hypothetical beneficiary, at whose instance the title might be challenged, is not bound by the acts of the trustees, he will not be bound by a judgment pronounced upon a plea stated by the trustees to support their acts. I should, therefore, have thought that, if the trustees were otherwise entitled to insist in their argument founded upon prescription, this is not a competent action for its disposal, because the judgment would not afford a conclusive answer to the beneficiary whose challenge is assumed as the ground of the trustees' title to maintain the argument in question.

LORD ADAM and the LORD PRESIDENT concurred.

LORD M'LAREN was absent.

The Court adhered to the interlocutor of the Lord Ordinary.

Counsel for the Pursuers—H. Johnston—W. Campbell—Cullen. Agent—James S. Sturrock, W.S.

Counsel for the Defenders—Dundas—Craigie. Agents—J. W. & J. Mackenzie, W.S.

Friday, December 13.

SECOND DIVISION.

[Sheriff-Substitute of
Aberdeenshire.]

GILL v. CUTLER.

Jurisdiction—Sheriff—Foreign—Interdict.

A firm of paint manufacturers in Aberdeen, who had taken out a patent for a paint for gilding, raised an action of interdict in the Sheriff Court against a firm of painters and colour merchants in Aberdeen, to prohibit them from making, using, and selling a certain paint which they alleged was an infringement of their patent. This paint was manufactured in Birmingham, and the Birmingham manufacturer craved to be sisted as a defender in the action, on the ground that he had the real interest in opposing the patent. He was accordingly sisted, and thereafter the original defenders withdrew from the action, interdict being pronounced against them of consent. The action then proceeded against the remaining

defender, and, after a proof, interdict was granted against him as craved.

Held on appeal (*diss.* Lord Young) that the Sheriff had jurisdiction.

Opinion contra by Lord Young, on the ground (1) that interdict having been granted against the original defenders, no further question remained to be tried in the case, and (2) that if the alleged infringement was proved, no effectual remedy could be given by a judgment of the Sheriff against the foreign defender.

Patent—Validity—Prior Use.

When the validity of a patent is contested on the ground that there has been prior use, it is sufficient to show that the combination patented has been publicly used, although (1) it may not have been publicly sold, and although (2) the persons using it were not aware of the chemical constituents of a particular article (obtainable in the market) which formed an ingredient in the combination.

In July 1893 Alexander Ogston Gill and William Smith Gill, both of the firm of Farquhar & Gill, paint manufacturers, North of Scotland Colour Works, Aberdeen, raised an action against William Coutts & Sons, painters, 216B Union Street, Aberdeen, in which they prayed the Court "to interdict the defenders by themselves or by others from infringing the Letters-Patent Number 2261091, dated and sealed the twenty-eighth day of December Eighteen hundred and ninety-one, granted to the pursuers for 'improvements in and relating to paints and lacquers,' and in particular to interdict the defenders by themselves or others from making, offering for sale, selling or using, without the consent, licence, or agreement of the pursuers, a paint in which collodion or dissolved liquid pyroxylin is used as the essential element, this being combined or mixed with bronze or other metallic or alloyed substances in a powdered state, to form a paint or a lacquer for gilding purposes manufactured in the manner described in the said letters-patent, and the specification relative thereto, or in manner substantially the same, and from further or otherwise infringing the said letters-patent, and to grant interim interdict; and also to ordain the defenders to pay to the pursuers the sum of fifty pounds sterling with the legal interest thereon from the date of citation to follow till paid."

Immediately after the action was raised William Cutler, manufacturer, Cannon Works, Constitution Hill, Birmingham, lodged a minute in which he craved to be sisted as a defender along with William Coutts & Sons, as he was the party really interested in the action, being the manufacturer of the permanent gold enamel paint referred to in the petition. He was accordingly sisted, and at a subsequent stage William Coutts & Sons lodged a minute in which they stated that they had no interest in the letters-patent in question, and consented, with the concurrence of the defender Cutler, to decree of interdict being

pronounced against them without expenses or damages. Decree on these terms was pronounced on 10th November 1894, and the action thereafter proceeded against William Cutler as sole defender.

The pursuers, *inter alia*, averred—" (Cond. 2) For a number of years the pursuers, who have for long made a speciality in the manufacture of various paints and enamels which have obtained a ready sale all over the world, were engaged in extensive research and experiment with the view of providing a new or improved paint particularly suitable as a gold, silver, or bronze paint, and also the production of a lacquer or varnish for use in combination therewith. (Cond. 3) The result was the invention of paints and lacquers known as 'Bonaccord Liquid Gold,' or 'Patent Gold Paint,' and these were duly patented by pursuers under Letters-Patent No. 2261091. (Cond. 4) The pursuers are the true and first inventors of the said paints and lacquers, which form a very valuable invention, better than any preceding knowledge of the trade and of great commercial usefulness. By their excellence as a substitute for gold leaf and by their general utility they have earned a high reputation in the trade, and their success has brought into the field several so-called gold paints. (Cond. 5) In particular, a preparation called 'Patent Permanent Gold Enamel Paint,' or 'Permanent Gold Enamel Paint,' and purporting to be manufactured by the defender William Cutler, who describes himself as patentee and sole manufacturer, has, in contravention of the Patents Act of 1883, been made up in style similar to those used by pursuers, and extensively sold through Great Britain by defender Cutler, and in Aberdeen by defenders Cutler and Coutts & Sons, who have thereby rendered themselves liable to a fine not exceeding five pounds for every offence. The defender William Cutler, by specification, No. 768892, dated 23rd April 1892, applied for letters-patent for his said preparation, but his application having been opposed by the pursuers on the ground that it infringed their patent, was on 16th December 1892 rejected by the Comptroller-General. Notwithstanding the said decision the defender William Cutler has placed in the market the said preparation marked 'Patent,' or with his name thereon as patentee. . . . (Cond. 7) The defender William Cutler has been manufacturing in Birmingham or elsewhere, and selling and using, the said preparation throughout England and Scotland in infringement of the pursuers' said patent; in particular, he refuses to desist from the manufacturing, selling, or using of the said 'Patent Permanent Gold Enamel Paint,' or 'Permanent Gold Enamel Paint.' . . .

The defender did not deny that the gold paint manufactured and sold by him was practically identical with the pursuers', and that an infringement of the pursuers' patent had been committed if that patent was to be regarded as valid, but he pleaded that the pursuers' letters-patent were invalid on three grounds. The first of these grounds was that the pursuers were not the first and

true inventors of the paint in question, the same having been publicly used, or at least publicly known, prior to the pursuers' patent. The second and third grounds of defence are referred to in the Sheriff-Substitute's interlocutor, but as no decision was pronounced by the Court upon them, they need not be further referred to.

The Sheriff-Substitute (DUNCAN ROBERTSON) heard proof, the result of which sufficiently appears from the interlocutors and opinions.

On 16th January 1895 the Sheriff-Substitute pronounced the following interlocutor:—"Finds in fact (1) that pursuers have obtained a patent, dated 28th December 1891, and numbered No. 22610⁰², for improvements relating to paints and lacquers; (2) that the claim made, as set forth in specification was for a combination of collodion or dissolved liquid pyroxylin with bronze powder or other metallic or alloyed substance in a powdered state for the purpose of forming a paint or lacquer for gilding purposes; (3) that defender Cutler has since the date of said patent been manufacturing and selling a paint composed of dissolved pyroxylin and bronze, &c. powders, which is practically identical with the paint described in pursuers' said specification: Finds, with reference to annexed note that the defender has failed to prove as contended by him (1) that there has been prior use or prior knowledge, in the sense of the patent laws, of the invention set forth in pursuers' said patent either by defender himself or by anyone else; (2) that the patent is invalid, in respect that in addition to a paint, the pursuers in their said specification claimed the use of collodion as a lacquer, which was admittedly not novel; and (3) that the invention as described in the said specification is an impossible one, or that said specification is grossly misleading: Finds that the pursuers are the first and true inventors of the invention as described in said patent, and that defender has infringed said patent: Therefore repels the defences, declares the interim interdict already granted perpetual, and decerns: Finds further that the defender is liable in damages to the pursuers, assesses same at the sum of £5 sterling, for which decerns against the defender William Cutler: Finds the pursuers entitled to expenses against the said William Cutler," &c.

In his note the Sheriff-Substitute, after considering the two grounds of defence based on defective or erroneous specifications, dealt with the defence of prior use as follows:—" (3) There remains, therefore, only the argument having reference to prior use or anticipation, and I have put this last, as I have found it the most serious. There is no prior publication alleged, but the defender avers and says he has proved (1) that he himself made and used and gave to the public his paint, which was an anticipation of pursuers', prior to the date of pursuers' patent; and (2) that the witness Denham, of Ballantine & Co., of Edinburgh, had also used this paint in the sense of the patent law prior to pursuers' patent. (1) As regards

defender himself, the facts as proved seem to me to be as follows:—About the year 1887 defender came to know of a preparation called 'kristaline,' sold by a Mr Hartley, in Birmingham, as agent for an American company. Kristaline was sold as a lacquer or varnish, and for about a year after he knew it first defender used it as a lacquer over metal. He was in the way then of using in his business a gold paint made of terebene and bronze powder, and about 1888 he began to coat this with the kristaline. About March or April 1888, accident, more or less, led him to try mixing the kristaline with bronze powder to see how it would act as a paint, when it was found to act very well indeed. From that time up to March 1892 defender states that he continued to make small quantities of gold paint with kristaline. He has only brought evidence of one actual sale of the paint during that period, viz., 5s. worth to the witness Bendall, and that was rather to try as an experiment than in the ordinary course of business; but I think in addition it is clear he gave a certain number of bottles to the French Wreath Company without charge, in order that they might touch up and renew metal-bound glass cases, &c., got from him. Defender's son also (the witness Walter Cutler) speaks to getting 5s. from a Mr Hope for regilding some frames, but that was rather as a gratuity than actual payment. Defender was in the way of using this kristaline as a lacquer as well as a paint; and I find that for both purposes the quantity he got from May 1888 to September 1890 was sixteen quarts, and he continued at about the same rate down to March or April 1892. Keeping in view the amount and nature of prior use so spoken to, and the further fact that when the paint was supplied no one could tell what it was composed of, I think upon the authorities a nice question might have arisen, whether what defender had done had gone beyond the region of experiment, and was sufficient prior use to exclude a subsequent patent; whether this was 'use in public so as to come to the knowledge of others than the inventor.' But this case presents another feature which to my mind seriously alters the complexion of the alleged prior use. Defender was using kristaline to combine with bronze, &c., powder; but, in point of fact, up to and even after the date of pursuers' patent—in fact, up to the end of March 1892—defender did not know what kristaline was. He no doubt knew it was a lacquer, and that it was called a celluloid lacquer by the sellers, for that appears on some of the invoices; but as to how it was composed he was absolutely ignorant. I think we may take it now as proved (though as to this the proof is not very satisfactory) that kristaline is pyroxylin dissolved in amyl acetate, and that a paint made with it is identical with pursuers'—but even as to this we are pretty much dependent on the analysis of one sample. But at the time when pursuers took out their patent, all that defender knew was that a lacquer with a fancy name, the composition of which he was quite unac-

quainted with, but which was sold by an American company in Birmingham, made a good gold paint when combined with bronze powder. If the company that sold the kristaline had failed, defender's paint was put a stop to, or if for some reason they had slightly altered the nature of kristaline, it might quite well be that it would have been useless for a paint, and defender would have been helpless. It seems to me that a good test of the matter is this—Had the defender at the date of pursuers' patent discovered enough to take out a patent himself, and had he made this discovery known to the public? I think there can be no doubt this question must be answered in the negative. Defender could not have patented the combination of kristaline and bronze powder without knowing what kristaline was, and if so, his prior use of the article was not of the intelligent and understanding nature which in my opinion would be necessary to come in the way of the pursuers, who had unquestionably honestly invented the paint for themselves. The defender himself was quite conscious of this, for we find both him and his son stating that they were most anxious to find out the composition of kristaline, even going the length of asking Mr Hartley, the agent for the sale, what it was; and the moment that the son by accident did so, about March 1892, the defender at once applied for a patent. This application was refused at the instance of the pursuers, who objected, and I must say that the position taken up by the defender with regard to his application for a patent is not to my mind in his favour. He now pleads prior use by himself as an objection to pursuers' patent; but if it is a good objection to pursuers' patent, it must have equally stood in the way of defender getting a patent, and defender must have known this when he applied. He says now he was not serious in applying for a patent, that it was done for advertising purposes; but I confess I have difficulty in taking this off his hands.

“On this point, therefore, of prior use by the defender, my opinion is that the prior use, even if sufficient in extent to void the patent, which is at least doubtful, was not of a character to anticipate pursuers' patent in respect the person using had no knowledge or understanding of the composition of kristaline, and therefore did not know the actual materials of which the paint he was making was composed.

“There only remains the alleged prior use of a similar substance by Mr Denham. And I should say, before referring to this, that the admission of this evidence was strongly objected to by the pursuers. I should in all probability have refused it if it were not that the proof of necessity was adjourned for some months after the first two days, and before Mr Denham's evidence was taken. Notice of the proposal to lead this evidence having been given before the first day's evidence, pursuers had thus ample opportunity of inquiring into and meeting the alleged use by Messrs Ballantine or Mr Denham. If I

had arrived at a different conclusion as to the effect of Mr Denham's evidence from what I have, in all probability the fact that notice of this evidence was not given at the proper time would have had a very great effect on the question of expenses. As, however, I have come to be of opinion eventually that Mr Denham's evidence as to the use by him does not turn the scale as against pursuers, this question of expenses does not fall to be considered. Mr Denham seems to me to have been practically in the same position as Mr Cutler with regard to the matter. He discovered exactly what Mr Cutler did, namely, that kristaline with bronze powder made a good gold paint, and his use of what he discovered up to December 1891 was even less than Mr Cutler's. His whole evidence as to dates is vague, but it is certain he used a very small quantity, and of that he sold nothing, and in no way made his discovery public prior to the date of pursuers' patent. No doubt he spoke to Mr Ballantine about it, but he was his partner, and that was not in any sense making it public. No more was the making of presents of a few articles covered with it, for, as already stated, no one getting these articles would know what they were painted with. On this ground, therefore, I should be inclined to hold that Mr Denham had made no public use of the combination prior to December 1891. But, further, to my mind exactly the same objection applies to Mr Denham's knowledge as I have found fatal to Mr Cutler's. I don't think he knew what he was using, and I don't think that if the sale of kristaline had been stopped he could have made the paint, at any rate at first, or without experiments, which, as he is not a chemist, he apparently could not have made himself. No doubt he says his partner told him what kristaline was made of, and that they knew when they first got it, and also that they had made some of it themselves (though when that was does not appear, probably after December 1891), still when asked how to make it his answer is 'by dissolving celluloid in acetate of amyl.' Being asked what is celluloid, he answers 'I don't know.' Apparently, from the evidence of Mr Ellis, celluloid is not at all the same thing as pyroxylin, but includes camphor, and if kristaline is made of dissolved celluloid, it is not the same as dissolved pyroxylin, and the combination of kristaline and powder is not or may not be the same thing as pursuers' patent. I do not lay so much stress on this, however, as on the fact that Mr Denham cannot give even now an explanation of the composition of the substance which he gives as the essential element of kristaline, and that being so, certainly he was not in a position, from his own knowledge and without assistance or experiment, to apply for a patent for the paint in question.

“On all the grounds of defence, therefore, I think defender has failed, and pursuers are entitled to the remedy they seek.” . . .

The defender appealed to the Second Division of the Court of Session.

When the case came up for hearing, the Court raised the question of jurisdiction, and desired argument thereon.

Argued on the question of jurisdiction—It was competent for a foreigner to prorogate the jurisdiction of a Scots court, either the Court of Session or the Sheriff Court—Erskine, i. 2, 27; *White v. Spottaswoode*, June 30, 1846, 8 D. 952; *Longmuir v. Longmuir*, May 21, 1850, 12 D. 926. Prorogation was all the more competent where what the petitioner complained of was a wrong done within the jurisdiction of a Sheriff for which the foreigner was said to be responsible—*Waygood & Company v. Bennie*, February 17, 1885, 12 R. 651. The complaint here was that an infringement of a Scots patent had been committed by an Englishman who sold to retail dealers in Aberdeen. Even if the defender had desired to plead no jurisdiction, he had barred himself from doing so by his appearing voluntarily in the Scots Court as a respondent, and consenting by minute to the prayer of the petition being made applicable to him.

On the merits, argued for respondent and appellant—The evidence here showed that there had been prior use of the article patented. The appellant had made public use of it in the course of his business, and not merely experimentally. The patent was therefore bad, and interdict should not be pronounced—Edmonds on Patents, p. 40, and cases there quoted; *Humphreston v. Syer*, 1887, 4 P. O. Rep. 407; *King, Brown, & Company v. Brush Electric Light Corporation, Limited*, July 1890, 17 R. 1266.

Argued for petitioner and respondent—The use by the appellants of the article in question was experimental. It was secret use as distinguished from public use. Others might have made the discovery, but the petitioners were the first who had made their bargain with the public in regard to it. The patent was a good one, and the interlocutor of the Sheriff-Substitute should be affirmed—*Smith v. Davidson & Wilson*, March 11, 1857, 19 D. 691, opinion of Lord Pres. McNeill, 695; *Hancock v. Somervell*, 1851, 39 Newton's London Journal 158; *Hills v. London Gas-Light Company*, 1860, 5 H. of L. Cas. 312.

At advising—

LORD TRAYNER — The question in this case upon which the parties are at issue is the validity or invalidity of letters-patent granted to the pursuers on 28th December 1891. The subject of the patent was a certain gold paint and lacquer, of which the pursuers claim to be the first and true inventors, and this action was brought to have the defender interdicted from making, selling, or using (without the pursuers' licence) a gold paint which the pursuers allege to be an infringement of their patent right. Before dealing with the question of the validity of the patent, I must advert to a matter not raised by the parties, but upon which some discussion took place before us. The pursuers carry on their business in Aberdeen, and having found that Messrs Coutts & Sons, painters there, were using

or selling a gold paint got by them from the defender Mr Cutler, who is a manufacturer in Birmingham, they brought this action originally against Messrs Coutts. As an interdict against them in the terms prayed for would, if granted, interfere very materially with what Mr Cutler regarded as his interests by practically excluding his gold paint (said to be an infringement of the pursuers' patent right) from the Scotch market, he appeared and craved leave to sist himself as a party to the cause. This leave was granted, and Mr Cutler was duly sisted as a party. Thereafter Messrs Coutts, having no interest to discuss the question of the validity of the pursuers' claims, consented to interdict being pronounced against them, and retired from the case. The case thus came to be an action of interdict at the instance of an Aberdeen firm against a defender resident in Birmingham, and in this state of the facts it was questioned whether this Court could grant any interdict against a defender not subject to its ordinary jurisdiction, whether there was a relevant case for granting such an interdict, and whether such an interdict could be to any extent effectual. Parties were ultimately heard before us on the merits of the cause, without any decision being pronounced on the questions I have just indicated, but it is necessary now to deal with these questions, and I will do so before entering upon what I have said is the question on which the parties are at issue. In ordinary circumstances, no doubt, Mr Cutler would not be subject to the jurisdiction of this Court, being an Englishman carrying on his business and residing in England. But where he voluntarily submits himself to our jurisdiction, or the jurisdiction of any Court in Scotland, I cannot doubt that he is as much subject to that jurisdiction as if he were a native or resident Scotchman. This has long ago been decided, and of this the cases of *White*, 8 D. 952, and *Longmuir*, 12 D. 926, may be cited as examples. So far as jurisdiction is concerned, Mr Cutler having voluntarily appeared in the Scotch Court as a defender to try the question with the pursuers of the validity of their patent (and that was the question which the pursuers and Mr Cutler joined issue upon), is in the same position as if he had raised in Scotland a reduction of the pursuer's patent. In the latter case he would have been the pursuer of the action; in the present case he is the defender,—but the jurisdiction of the Court is the same in either case. Mr Cutler could not be compelled to appear in our Courts in either character, but having voluntarily appeared in our Court, in the one character or the other, the Court has jurisdiction to try and determine the question he submits to the Court, and having such jurisdiction is bound to exercise it. With regard to relevancy, it appears to me sufficient to refer to the fifth article of the pursuer's condescendence, in which it is distinctly averred that the defender Cutler has extensively sold throughout Great Britain and in Aberdeen the particular gold paint which is said to be an infringement of the

pursuers' right. If sold illegally in Aberdeen, the Sheriff of that county had the right to interdict it,—the defender charged with the illegal act being competently before him, as in this case I have shewn he was. Nor have I any doubt as to the interdict, if granted, being effectual. The interdict of the Sheriff of Aberdeen, if affirmed by us, would in practical effect be an interdict applicable to all Scotland,—all inferior judges would follow the judgment pronounced by us. The effect of our judgment, however, goes farther even than that. For the defender Mr Cutler and the pursuers having submitted to a competent Court the question between them as to the validity of the pursuers' patent, any judgment pronounced on that question will be *res judicata* between the parties, and finally determine that question, certainly in Scotland, and probably throughout the United Kingdom. That being so, I have no hesitation in proceeding to the decision of the case from any anticipation that such judgment would be ineffectual. I admit that we could not enforce our interdict, by sentencing an Englishman to suffer punishment by imprisonment for breach of interdict, unless we could apprehend him in Scotland. But the interdict granted against him here, *causa cognita*, could easily be made effectual against him elsewhere. Besides, the question of interdict is a minor question. The real question submitted to us under this application—the question the parties have agreed in asking us to decide—is whether the patent is valid or not, and an application for interdict is a competent and usual mode for raising such a question.

Proceeding now to the merits of the cause, I observe that the defender does not seriously deny that the gold paint manufactured and sold by him is the same as the pursuers', and that an infringement of the pursuers' patent has been committed if that patent is to be regarded as valid. Its validity however is challenged on the three grounds set forth in the Sheriff-Substitute's note, which may conveniently be stated thus—(1) prior user, and (2) defective or erroneous specification. The former of these is the most serious, and I deal with it first accordingly.

The pursuers' invention is thus described by them in their complete or final specification:—"A paint in which collodion or dissolved liquid pyroxylin is used as the essential element, this being combined or mixed with bronze or other metallic or alloyed substance, in a powdered state, to form a paint or a lacquer for gilding purposes." The paint manufactured by the defender, which is said to be an infringement of the pursuers' patent, is composed of a liquid called Hartley's kristaline, combined with bronze or other metallic substance in a powdered state. Hartley's kristaline has been well known and been sold commercially from a period considerably anterior to the pursuers' patent. If this kristaline is not "dissolved liquid pyroxylin," then obviously there has been no infringement, for dissolved liquid pyroxylin is the "essential element"

in the pursuers' invention. The pursuers, however, say that it is, and one of them in his evidence states that he has analysed the kristaline and found "that it was pyroxylin dissolved in amyl acetate." It follows that kristaline and bronze power combined produce the pursuers' patented paint. It is the pursuers' case that this is so; it is this combination of which they complain as an infringement. Now, I think it is abundantly proved that in the year 1888 the defender made a paint of this combination, and used it both as a paint and as a lacquer in the ordinary course of his business, that the special articles sold by the defender to his customers in trade were painted with this paint; that he has ever since continued to make, use, and sell the same kind of paint; that on more than one occasion prior to the date of the pursuers' patent the defender sold the paint so made by him to persons desiring to use the same, and who did use it as a paint, and that he furnished it, without charge, to trade customers (I refer to the French Wreath Company) at their request, prior to the date of said patent, to enable them to touch up or re-paint articles sold and supplied to them by the defender, which, originally painted by the defender with the same kind of paint, had got tarnished or damaged. I think it is also proved that the witness Denham made the same paint by combining kristaline and bronze powder in February 1891—a date anterior to the patent—and that he and his firm have "continued ever since using this combination." Mr Denham says, "My company have sold this mixture," but by some oversight, which it is difficult to explain, neither party asked Mr Denham when such sale began to be made. While, therefore, it cannot be said to be proved that Mr Denham or his firm sold this paint before the date of the patent, it is proved that Mr Denham painted or decorated a pair of vases "with this combination," which he gave to a friend in June 1891. It is unnecessary in support of what I have said to refer to passages in the proof; they have all been read over by the counsel for the parties more than once, and commented on at length. It is the less necessary to do so, because the Sheriff-Substitute's judgment does not proceed on any view of the facts materially different from what I have stated, the only difference probably being that the Sheriff-Substitute doubts whether it has been sufficiently established that the defender ever sold the paint which he has made. He does not doubt that he used it himself, and that he gave it away to customers and friends. The question then comes to be, whether, taking the facts as I have stated them (or even subject to the Sheriff-Substitute's doubt), they amount to proof of prior user. On this question the Sheriff-Substitute's judgment is favourable to the pursuers, and I am of opinion that that judgment is erroneous.

I think the Sheriff-Substitute has proceeded upon a mistaken view of what it is that constitutes prior user. He seems to think (1) that the pursuers' alleged invention could not be anticipated by the de-

fenders' paint, unless the latter had been sold to the public; and (2) that it could not anticipate the pursuers' patent unless the public had knowledge "what it was composed of." Neither of these elements are essential to that prior use which will anticipate and so void a patent. In *Betts v. Neilson* (L.R., 4 Ch. Ap. 436) Lord Chelmsford said that it was not "necessary that the patented article should have been previously manufactured for sale," and it is the result of several decisions (see *Edmonds on Patents*, 43), and writers on patent law are agreed, that actual sale of the article said to anticipate the patent need not be proved in order to constitute prior use. The words of the letters-patent themselves, indeed, lead to this view, for there the patent is declared void if the invention has been in prior "public use," which, of course, might very well exist without public sale. Then as to the notion that the public must know what the article is "composed of" before it can anticipate a patent, I think the Sheriff-Substitute has fallen into error by misapprehending the statement often made that there must be disclosure as well as use. But that disclosure does not mean that the public shall know as much about the article used as the maker of it knows. It means that the thing must be disclosed to the public and not kept by the maker of it to himself. It is the use of the thing in public, as distinguished from the use in private by the inventor—public use involves disclosure. In the case of *Carpenter* (9 M. & W. 300) a patented lock was held to have been anticipated by the fact that a similar lock had been used by "an individual on a gate adjoining a public road." There was no suggestion in that case that the lock on the gate had been examined by any member of the public so as to ascertain its peculiar construction, or that any such examination or knowledge arising therefrom on the part of the public was necessary to constitute public use. Public use, as Lord Abinger said in *Carpenter's* case (and the dictum is quoted with approval by Lord Chelmsford in the case of *Betts v. Neilson*), "means a use in public, not by the public." I think there is no room for doubt that the use by the defender of his own paint was of this character. It is quite true (and perhaps this may be what was passing through the mind of the Sheriff-Substitute) that in order to obtain letters-patent the inventor must disclose his secret to the public in return for the temporary monopoly conferred upon him. But such a disclosure as that is not necessary to the prior use, which will anticipate and so void a patent. The Sheriff-Substitute, however, does not proceed to his conclusion in favour of the pursuers upon the ground that prior use had not been sufficiently established with so much confidence as he does upon another ground. He says:—"The prior use, even if sufficient in extent to void the patent, which is at least doubtful, was not of a character to anticipate pursuers' patent, in respect the person using had no knowledge or understanding of the composition of kristaline,

and therefore did not know the actual materials of which the paint he was making was composed." In this opinion I cannot concur. The defender found in the market an article called kristaline, and he found another called bronze powder. He combined them, and got a gold paint. But, according to the view of the Sheriff-Substitute, the combination is not his invention, nor can its use anticipate the same invention by another, because he cannot tell what are the constituents, chemically or otherwise, of the articles he has combined. How far back is his knowledge to go? Suppose he had analysed the kristaline and found that it was dissolved pyroxylin, must he then proceed to find out what pyroxylin is, and what the solvent was? If this is required from the defender for anticipation, what is to be required from the pursuers for their patent? They are in the dark as to the chemical constituents of their pyroxylin. They supply a formula descriptive of it, but the pyroxylin so described will not dissolve in ether or alcohol, or other solvent of that type (for so I think the words "or other solvents" in the specification must be read), as they say it will. But if it was enough for them, as I think it would have been, without giving any formula, to say that their invention was dissolved pyroxylin combined with metallic powder, why should it not be enough to anticipate the patent for the defender to say that he had used or sold paint composed of metallic powder combined with kristaline—kristaline and dissolved pyroxylin being the same thing? That the defender did not know the composition of kristaline was of no importance to the public who took and used his combination, and who could have bought kristaline under that name in the market; it was of no use to the defender beyond this, that if he had known the constituents of kristaline he could have made it for himself instead of buying it ready made. The Sheriff-Substitute does not seem to notice that neither the pursuers nor defender is asked how they make bronze powder, the other substance used in the combination, or whether they know of what it is composed. I suppose, however, a knowledge of that is as essential—or non-essential—as a knowledge of how to make kristaline.

I am of opinion that the prior use by the defender of his gold paint was an anticipation of the pursuers' patent, and that that patent is consequently void. I do not therefore consider it necessary to consider the defender's objection to the pursuers' specification—one of which, at all events, I think of a serious character.

LORD JUSTICE-CLERK—The pursuers hold a patent for a paint for gilding. It specifies as an essential element of the composition that collodion—that is, pyroxylin or gun-cotton—dissolved in ether or some other solvent named, is used by mixing with it bronze or other metallic powder to form a paint or lacquer for gilding purposes. They petitioned for interdict against a firm—Messrs Coutts of Aberdeen—to prohibit

them from selling a certain gold paint in infringement of their patent-rights. These defenders did not consider that they had any sufficient interest to impugn the validity of the pursuers' patent, and consented to interdict, but the defender Cutler, who was the maker of the paint sold by them, craved leave to be sisted as a defender to defend the action, and he was accordingly sisted, and the case proceeded before the Sheriff-Substitute.

His defence truly takes the form of an attack upon the pursuers' patent, as having been anticipated by prior user of the combination which they claim. The case went to proof on this defence, and the Sheriff-Substitute has upheld the pursuers' patent and granted interdict. I am unable to agree with the judgment he has pronounced, and am of opinion that the defence based on allegation of prior user has been sufficiently established.

The material used in the paints of the pursuers and the defender are the same. It is not disputed that Hartley's kristaline which the defender uses is just dissolved pyroxylin—indeed, it is proved by the pursuers that Hartley's preparation is just pyroxylin dissolved in amyl acetate, and it is of course on the ground that they are the same that they maintain infringement of their patent.

The defender, admitting that his article is the same, maintains that the pursuers' patent was anticipated, as he made and publicly used the paint in 1888, and up to the time of the taking out of the pursuers' patent in 1891 continued to do so. I am of opinion that the defender has proved that he made this material and used it in his business, that he sold articles made in the ordinary course of trade which had been gilded by it, and that he supplied the mixture itself to customers for practical use in touching up articles gilded by him with this paint, and supplied by him in the course of business; also that he gave a bottle of it to a customer to gild a frame with it. The evidence upon this part of the case seems to me to be conclusive, and indeed the view of the Sheriff-Substitute himself upon this matter is in accordance with what I have expressed. I would only make this additional remark, that the law as laid down in the decided cases does not require that there should be actual sales to the public, but only such public use as brings the subject of the patent to the knowledge of members of the public, as distinguished from mere secret and experimental use, such as a private trial, with a view to consideration of the value of the invention before taking out a patent. I hold also that it is established that Mr Denham also made and used the same article prior to the pursuers' patent.

But the Sheriff-Substitute seems to have been led away by the idea that even if the defender used publicly a combination the very same as that afterwards patented by the pursuers, such use would not invalidate the patent if the defender were at the time ignorant of the analytical details of any substance they used in making their com-

ination. He expresses this very distinctly. I cannot agree with this view of the Sheriff-Substitute, which seems to have been a view that the defenders themselves also had in their minds. I hold without doubt that if anyone discovers a useful and valuable combination of substances for some purpose of trade, and uses and sells that combination publicly, then such user is sufficient to prevent any other person from afterwards effectually protecting the same combination by a patent as being a new invention of his own. There is no novelty, and therefore there can be no good patent, which must be the disclosure of an invention of novelty. If a known article that can be bought in the market is called by a patentee by its known name in describing a combination of it with other materials as being his invention, it would not be a good objection to his patent to aver that the patentee did not know the chemical ingredients of the article named, nor disclose its chemical composition in his specification. Equally it must hold that if such a combination is publicly used, it is an anticipation of a subsequent patent, although the person who made it up and used it was not aware of the constituent elements of a particular article obtainable in the market, which formed one ingredient of the combination. I have no doubt in holding that if public use is made of a combination of articles purchasable in ordinary trade, that is public disclosure of the combination, so as to make the obtaining of effectual rights by patent for the combination at any subsequent time impossible, it is a use in a public way of the combination which is in question, and not a conveying to the public mind of minute details about the composition of ingredients. Here the defender put together certain articles obtainable in the market, and produced a useful article by the combination, and he used this combination in his business, and sold and gave it for practical use to his customers. That seems to me to make the validity of a subsequent patent for an article which is made by precisely the same combination not maintainable. I therefore would move your Lordships to recal the Sheriff-Substitute's interlocutor, and to pronounce findings to the effect that the alleged invention of the pursuers was publicly used and known prior to the date of the letters-patent founded on by the pursuers, and accordingly that the prayer of the petition falls to be refused.

LORD YOUNG—I have given all the attention in my power to this case, all the more so because my opinion and views differ, not only from those of both parties, but also from those which both of your Lordships have adopted regarding the regularity of these proceedings. I think that it is material that attention should be directed to the irregularity of these proceedings almost from the first. The petitioners are paint manufacturers in Aberdeen, and in 1891 obtained letters-patent for a certain paint which they believed they had invented. The appellants, who became the respon-

dents in this petition, are paint manufacturers in Birmingham, carrying on the same kind of business in Birmingham as the pursuers carry on in Aberdeen. It appears from all the statements of the petitioners before us and their averments on record that the respondents, the Birmingham manufacturers, made and put into the market paint which the petitioners thought was an infringement of their patent—[*Here his Lordship read articles 5 and 7 of the condescence as quoted in the narrative*]. Now, I think that it is quite distinctly stated, and it is apparently in accordance with fact, that Cutler had for a considerable period before 1893 been manufacturing paint in Birmingham, which the petitioners believe, I have no doubt on plausible grounds, to be an infringement of their patent, and that he has put that into the market in England, in Scotland, and abroad. One would have supposed that a patentee, whether he was in Aberdeen or in Birmingham, or wherever he was, if he wished a legal remedy, would proceed in the ordinary way by action in a proper court which could effectually try the question and give the proper remedy. But the Aberdeen patentees selected one particular retail dealer in Aberdeen, and they might equally well have selected a dealer in Kirkwall, and said—“You have got some of the paint of the Birmingham infringer, and we will try the question of his infringement with you here in Aberdeen.” I do not for a moment question the jurisdiction of the Sheriff Court of Aberdeen to try the validity of a patent right, and whether there has been an infringement of a patent right by a retail dealer. I quite understand that the Sheriff of Aberdeen has jurisdiction to restrain any infringement of a patent, though I do not think he could decide as to the validity of the patent. The Sheriff, in the exercise of his discretion, should have granted interdict on caution, but should have sent the petitioners to try the validity of their patent elsewhere with the real infringer.

I quite appreciate what Lord Trayner said, that when this extraordinary, I do not say irregular, petition was presented, the man really interested in this petition, viz., the manufacturer in Birmingham, might have come forward and said that the interdict would interfere with his business, and that he would appear and defend, so that no interdict would be pronounced. That is indeed the only rational ground for the Birmingham manufacturer's appearance in the case at all. But the first thing he does after appearing is to consent to the interdict prayed for being granted against the original defenders, therefore he was not there to prevent interference with his business by Coutts & Sons being interdicted. Then what reason was there for his appearance? It could not be to prevent interdict against himself; there was no question of that. Was it to get this case tried in Aberdeen? I have not been able to find any rational ground for his interference, unless it be that the Birmingham manufacturer was sagacious

enough to know that if the other firm was so foolish as to expose their whole case in Aberdeen, it would be the best possible thing for him. He would have the case tried, and his opponent's case disclosed, before a judge who was absolutely incompetent to deal with him, and who could not prevent him from selling the paint in Birmingham.

Cutler cannot have sisted himself to defend Coutts & Sons, because the first step taken was to interdict them by a now absolutely final judgment; they are absolutely interdicted, therefore no one could by sisting prevent that—the only interdict asked—being granted. I think that this was as irregular a proceeding as could be. It is said that there was a conclusion for damages, and that this transferred to Cutler. But there is no conclusion for damages against Cutler as the petition originally stood, so that the only damages could be against Coutts & Sons for what Coutts & Sons sold. What did they sell? There is no evidence on the point, but it is said a few shillings' worth. There is no allegation against Cutler for which damages could be given. Suppose an action of damages brought against the retail dealer who sells the paint. I suppose the action could be brought in the Small Debt Court, but whether there or in the Sheriff Court, the idea of the Inferior Court entering into the question of the validity of the patent, or as to whether it had been infringed by a firm in Birmingham, in an action of damages against one of a thousand retail dealers who sold a bit of it—is that rational? I altogether condemn this course of procedure. There is no precedent for it. Such a thing never occurred before, and I hope will never occur again. I think that the only regular course was for the Aberdeen manufacturers to proceed against the Birmingham manufacturer who manufactured and put in the market paint which was an infringement of their patent, and to proceed against him before a court which could deal with him and restrain him from doing what was wrong.

This procedure would lead to this, that a patentee in Birmingham might arrange with another manufacturer in the next street to try the question in the Sheriff Court of Aberdeen against some Aberdeen retail dealer to determine the validity of his patent.

I feel so strongly that this case is so unprecedented and so inexpedient that I must express my strong condemnation of it. Holding this view, I think it more in accordance with my duty to refrain from expressing any opinion on the question whether the manufacture in Birmingham of the paint in question was an infringement of the patent rights of the Aberdeen manufacturer.

LORD RUTHERFURD CLARK was absent.

The Court pronounced the following interlocutor:—

“Sustain the appeal, and recal the interlocutor appealed against: Find in fact (1) that the pursuers have obtained

letters-patent dated 28th December 1892, numbered 2216091, for improvements relating to paints and lacquers; (2) that the invention for which said letters-patent were granted is described in the complete specifications by the pursuers as a paint in which collodion or dissolved liquid (pyroxoly) pyroxylin is used as the essential element, this being combined or mixed with bronze or other metallic or alloyed substances in a powdered state to form a paint or a lacquer for gilding purposes; (3) that the defender Cutler in the year 1888, and from that date down to the 28th December 1891, made, sold, and publicly used, both as a paint and a lacquer for gilding purposes, a paint composed of dissolved liquid pyroxylin combined or mixed with bronze powder or other metallic substances, and that he has since said 28th December 1891 continued to make, sell, and publicly use the same; and (4) that the paint so made, sold, and publicly used by said defender was the same as that for which said letters-patent were granted: Find in law that the pursuers' letters-patent foresaid are invalid and void on the ground of prior public use: Th. refore assoilzie the defender Cutler from the whole conclusions of the action, and decern."

Counsel for the Pursuers—Solicitor-General, Graham Murray, Q.C.—Salvesen—Younger. Agent—Alex Morison, S.S.C.
Counsel for the Defender—Ure—Hunter. Agents—Dagleish, Gray, & Dobbie, W.S.

Tuesday, December 17.

FIRST DIVISION.

[Sheriff of Stirling, Dumbarton, and Clackmannan.

WHYTE v. WHYTE.

Process — Appeal — Competency — Interlocutor of Sheriff bearing to be Pronounced of Consent—Power of Court to Order Inquiry.

When a final judgment of an inferior court bearing to be pronounced of consent is appealed against, and the appellant alleges that in fact no such consent was given by him, the Court has full power to order inquiry into the fact whether such consent was given.

A Sheriff-Substitute decerned in favour of a petitioner upon the preamble that the agent for the respondent had stated at the bar "that he now withdraws his opposition" to the application. The respondent appealed to the Court of Session, and asked the Court to review the judgment on the merits, alleging that the Sheriff-Substitute was in error as to the fact of opposition having been withdrawn. Held that the appellant having neither proposed nor agreed to accept a remit to

the Sheriff-Substitute to report on the question of fact, the appeal must be dismissed.

George Whyte presented a petition in the Sheriff Court of Stirling, Dumbarton, and Clackmannan, craving the Sheriff to decern him executor-dative *quod* one of the next-of-kin to his deceased sister Mary Logan Whyte. The petition was opposed by Miss Fanny Whyte, a sister of the deceased, who maintained that she had been appointed executrix-nominate under a mutual settlement executed between her and the deceased. On 24th May 1895 the Sheriff-Substitute (GEBBIE) pronounced an interlocutor, finding that the mutual settlement had been revoked by a subsequent writing of the deceased, and continuing the cause. Miss Fanny Whyte appealed against this interlocutor to the Court of Session, which, on 4th July 1895 dismissed the appeal as incompetent.

On 30th September 1895 the petitioner lodged a minute in the Sheriff Court craving that he should be appointed executor-dative in terms of his petition, in respect that the Court of Session had dismissed Miss Fanny Whyte's appeal. On 8th October the Sheriff-Substitute sisted further procedure to enable the respondent to lodge a competing petition. On 15th October 1895 the Sheriff-Substitute pronounced the following interlocutor:—"The agent of the respondent having stated at the bar that he now withdraws his opposition to the minute for the petitioner, the Sheriff-Substitute decerns the petitioner executor-dative in terms of his petition."

The respondent Miss Fanny Whyte appealed to the Court of Session.

The appellant stated at the bar that the Sheriff-Substitute was mistaken in supposing that she had withdrawn all opposition to the petition. All that her agent had stated was that his client did not propose to lodge a competing petition. The appellant accordingly argued that the Sheriff-Substitute's judgment was open to review by the Court.

The respondent in the appeal denied at the bar the appellant's allegation as to what occurred in the Sheriff Court, and alleged that the Sheriff-Substitute on being applied to by the appellant's agent had declined to alter the interlocutor in any material respect. The respondent accordingly argued that, the Sheriff-Substitute's judgment bearing to be of consent, the appeal must be dismissed.

At advising—

LORD ADAM—The interlocutor of the Sheriff-Substitute appealed against is as follows:—"The agent of the respondent having stated at the bar that he now withdraws his opposition to the minute for the petitioner, the Sheriff-Substitute decerns the petitioner executor-dative in terms of his petition." The minute referred to, after alluding to the appellant's previous unsuccessful appeal, goes on:—"The petitioner respectfully craves the Court to appoint him executor-dative in terms of his petition." It is clear, therefore, upon the face