

Friday, June 21.

(Before the Lord Chancellor, Lord Hatherley,  
Lord Blackburn, and Lord Gordon.)

BAILEY v. J. & D. ROBERTON.

(*Ante* vol. xiv. 348, 4 R. 545.)

*Patent—Provisional and Final Specifications—Disconformity between these—Validity of Patent.*

Circumstances in which held (*aff.* the judgment of the Court of Session) that a patent was invalid, on the grounds (1) that the claim in the complete specification was wider and of a different kind from that in the provisional specification; and (2) that the claim for an invention by the patentee was not a novelty, because a particular mode of using it was previously known to the public, and admittedly was in prior use.

*Observed* by Lord Hatherley, that in cases raising the question of the validity of a patent, where the patentee is not himself a party, it is the proper course that he should be called as a witness.

In the provisional specification of a patent the object of the invention was stated to be "to preserve animal substance . . . for a long time, and so that the same substance when so preserved . . . cannot be distinguished when cooked from the like substances derived from similar animals which have been recently killed." To effect this object a certain quantity of gelatine dissolved in hot water was to be added to a solution of bisulphite of lime. In their final specification the patentees claimed the use of the solution of bisulphite of lime without mixing it with gelatine and water.

The respondents J. & D. Robertson were butchers in Glasgow, who used bisulphite of lime in a pure state for preserving meat. They purchased it without the consent of the patentees from the manufacturers, and to put an end to that practice this petition for interdict was presented in the Sheriff Court of Lanarkshire.

The averments, pleadings, &c., of the parties are fully set out in the previous report of the case (vol. xiv. 348). The First Division of the Court of Session (*diss.* Lord Deas) affirmed the judgment of the Sheriff of Lanarkshire (Dickson), and gave judgment in favour of the respondents.

The petitioner appealed to the House of Lords.

At delivering judgment—

LORD CHANCELLOR—My Lords, the arguments in this case at your Lordships' bar have occupied some time, and the materials are of some length, but I shall have occasion to take up a very short portion of your Lordships' attention for the purpose of the observations which I have now to make. I own I am perfectly satisfied with the decision of the majority of the Court of Session, and I propose to conclude with a motion which will in substance affirm their decision, subject to one alteration in the interlocutor in point of form which I will mention more particularly by and by.

Now, my Lords, the first question in this case throughout has appeared to me to be—and I

think your Lordships will agree with me—What is the meaning of the provisional specification in the case? What is the invention which is described in that provisional specification? That is the foundation of the whole of the claim of the appellants. Whatever be the invention which is there described, that is the invention which the appellants inform the Crown they have discovered, and in respect of which they ask for the protection of a patent; that is the invention in respect of which the patent is given to them; and whatever be that invention, it became their duty to specify it, and not another or a different invention, in the complete specification.

Now, my Lords, looking at the provisional specification, and looking at it, in the first instance, without reference to any external evidence as to any peculiar meaning in the terms of it—taking it like any other document which your Lordships might have to construe—I cannot for a moment doubt, without any minute examination of the sentences of it, that the conclusion at which any person must arrive after reading that provisional protection is this, that the invention which those who wrote out the provisional specification conceived they had made was not an invention merely of the chemical application of bisulphite of lime to animal substances such as meat and fish, but was a mode of applying a coating or film to the outside of animal substances, which coating or film was to consist of gelatine or some substance of the same kind mixed with a solution of bisulphite of lime. In that way you were to obtain a wash, and you were to use it as a coating, and upon that point I may say that I observe the term "coat" or "coating" is used not less than six times in this very short specification. It is to be put on by dipping or brushing, and if the first coating is not sufficient it is to be repeated two or three times; it is then to be left to harden or to solidify, and the animal substance is to be thus preserved; and when the time comes for it to be used the coating is again to be softened with water by steeping, and thus to be removed.

My Lords, of course it would have been possible, if it had been in the mind of the inventor, to have said, What I have invented is this—I have discovered the great advantage of bisulphite of lime as applied to the surface of animal substances, but I find it cannot be conveniently applied without some medium in which it is to be placed for the purpose of making it adhere to the surface of the animal substances, therefore I claim to use it in a medium consisting of gelatine, and to put it on in that way. He might have done that, but that I repeat is not what has been done. What has been done is a statement of an invention such as I have described in the first instance, and not any other invention. My Lords, I may add that if that be the invention, so far as any evidence which has been adduced in the case is concerned, it appears to me not only to be a subject for a patent, but as regards novelty to have been at this time a perfectly new invention, for I have heard no evidence to show that this application to animal substances had been practised before.

Now, that being the conclusion at which I should arrive, looking at the provisional specification as it stands, it is satisfactory to my mind to find that a scientific witness, who is brought

forward as the leading witness for the appellants, appears to be exactly of the same opinion, because I find that Dr Wallace, who had said in his evidence-in-chief, speaking of the complete specification, which I will afterwards come to, that the essence of the patent as evidenced by the complete specification was the application of the bisulphite of lime pure and simple for the preservation of animal substances, is asked with regard to that—"Do you find any indication of that in the provisional specification?" to which he answers, "No, he takes in gelatine along with it in the provisional specification." Lower down this question is repeated to him—"Is a solution of bisulphite of lime pure and simple" (for that is the point) "disclosed in any way by the provisional specification?" to which he answers, "No, he does not mention the use of it by itself." Dr Wallace does not venture to say, nor does any other scientific witness that I can find venture to say, that such was the state of science, and that such was the knowledge and invention of the time that any person taking up this provisional specification would have known at once that he was entirely to disregard the mention of gelatine, to treat it as though it was not there, and at once to march to the conclusion that the invention was the application of bisulphite of lime pure and simple. No person makes any statement of the kind. Therefore your Lordships have the satisfaction of finding that the evidence outside the provisional specification leads, as it seems to me, exactly to the conclusion at which you would naturally arrive from the perusal of the provisional specification itself.

My Lords, starting from that, I must repeat the question which I took the liberty of putting to the learned counsel for the appellants at the bar. Supposing the provisional specification had been in terms of the complete specification, would it have been possible upon it to have maintained an action against the present respondents for infringement? Mr Webster felt, I think, the necessity of answering this question; he proposed to answer it by saying that an action could be maintained; but it seems to me—I do not know how it appeared to your Lordships—that the moment he undertook to establish that he was obliged to pass away from the provisional specification, and to treat it as though he could read into it the claim made in the complete specification. I therefore prefer to rest upon the evidence of the witness I have referred to—a witness who was obliged to answer that it was impossible to say that that which was done by the respondents is struck at by the wording of the provisional specification.

Now, I pass to the words of the complete specification. Is the complete specification in accord with the provisional specification? If it goes no further than the provisional specification goes, then, in my opinion, the complete specification may well describe a fit and proper subject for a patent; and it may be maintained as a specification for an invention which, so far as regards the evidence in this case, is a new invention. But if it goes beyond that—if it claims that which was put by way of interrogation to Dr Wallace—the use of bisulphite of lime pure and simple—then, if your Lordships agree with what I have already said, you will, I think, be of opinion that it makes a claim different from and larger than the claim

in the provisional specification. Now, what says the complete specification? I need not go through it, as it has been already before your Lordships. Your Lordships see that the first sentence, which is the material one to refer to, proceeds thus—"The manner in which our said invention is performed is as follows:—'We employ a solution hereinafter distinguished as solution No. 1, being a solution of bisulphite of lime (usually expressed by the formula  $\text{CaO}, 2\text{SO}^2$ ) in water of about the specific gravity of 1050, which specific gravity we find preferable to that of 1070.'" And so far as regards the solution No. 1, the complete specification ends there as to any separate use to be made of it, with one exception, which I will mention afterwards. The complete specification then goes on to speak of what are termed solution No. 2, solution No. 3, and solution No. 4. Each of those other solutions, Nos. 2, 3, and 4, is formed by taking the solution No. 1 as a basis, and admixing it with certain other component parts, and if it is the case that solution No. 1 is set up merely as a basis to be afterwards admixed with No. 2, No. 3, and No. 4, then, inasmuch as your Lordships find an accurate and complete description of the manner in which the solutions of No. 2, No. 3, and No. 4 are to be used and applied, certainly the complete specification is open to no charge of being defective as not showing how the invention is meant to be performed. But, on the other hand, if the solution No. 1 is not only set up as a basis to be afterwards admixed with No. 2, No. 3, and No. 4, but to be used by itself pure and simple, then, my Lords, I am bound to say that I must concede the cogency of the observations of the learned Judges in the Court below, that there is absolutely no statement of any kind of how the solution No. 1 is to be applied or used.

I said there was one exception, and that exception makes more general the statement which I have made. The one exception is that where there is a statement that "when animal substances are to be transported dry in wooden casks or other vessels, the interior of such casks or vessels should before use be saturated with solution No. 1" (that is, solution No. 1 pure and simple) "and then allowed to dry, but for this we make no claim." Therefore, in the only instance in which throughout the whole of the complete specification they speak of any use or application of solution No. 1 pure and simple, in that only instance they say that they make no claim with regard to the solution No. 1 at all. My Lords, it appears to me therefore that if you are to read this complete specification as making a claim for the independent and separate use of solution No. 1, you at once are obliged to arrive at the conclusion that there is no mode pointed out in the specification of how that solution No. 1 is to be applied. My Lords, the question was asked, How comes it in practice that solution No. 1 has been used, and how came private butchers to know how to use it, because undoubtedly this solution No. 1 pure and simple has been used.

My Lords, I do not think it necessary to refer to the contents of a document which is mentioned in some of the judgments of the learned Judges, and which appears not to be in the process; but this does appear, that in some way or other when the solution No. 1 came to be used by the patentees pure and simple they accompanied it with the circulation of cards in which somehow

or other (perhaps it is better for us not to inquire how) they explained the manner in which solution No. 1 was to be applied. The importance of this I am bound now to state. If the complete specification does not set up No. 1 as a solution to be used separately pure and simple, then the complete specification will be in accordance with the provisional specification, and the patent may be, for aught I know, a perfectly valid patent. But if, on the other hand, the complete specification claims the solution No. 1 and the use of it separately as an invention pure and simple, then indeed the appellants may be able to show that the respondents have infringed that use. But, on the other hand, they can only do so by claiming an invention through the medium of the complete specification, which is not mentioned in the provisional specification, and as to the mode of exercising or applying which they cannot in that specification point out any claim or any information given to the public.

My Lords, that seems to be simply the case as regards the difference between the provisional and complete specifications. Now, if the complete specification conveys, as I suggested it might be construed, merely the statement that solution No. 1 is a basis to be afterwards used in the manner I pointed out with regard to solutions Nos. 2, 3, and 4 with reference to the evidence in that case, I see no evidence that such use had been anticipated or ever before had taken place. But if the claim of the complete specification is to the use of solution No. 1—that is, of bisulphite of lime pure and simple—then it seems to me that the appellants at once fall into the danger of having been anticipated by the use which was admitted to have taken place in the case of Rattray, because in the case of Rattray's patent it is admitted between the parties that the "solutions of bisulphite of lime were publicly used for the preservation of animal substances by William Rattray, chemist, Aberdeen, but that only in the manner described in the specification No. 8/7 of process." My Lords, there is therefore this admission that they were used. The manner in which they were used, if they were used for the preservation of animal substances, seems to me quite immaterial, because what the appellants are obliged to contend for is that there is a claim by them in the complete specification for the use of solution No. 1, being a solution of bisulphite of lime without any description of the way in which it is to be applied. It is an absolute claim to the use in any way of the bisulphite of lime. But if in any way (it matters not how) Rattray did apply it before, then they have claimed an application of that which in some way or other was applied by Rattray before.

On this point I am obliged to admit entirely the justice of the question put by Lord Shand in the Court below. Says Lord Shand—Suppose that Rattray after this patent were to do what he is admitted to have done before, what answer could he give to these patentees, if they are right, who say that there is secured to them by their complete specification the absolute user of the solution of bisulphite of lime pure and simple? My Lords, he could have no answer. It would be nothing for him to say, "Oh! yes, I use it; but I use it only in such a way." They would reply, "Look at our complete specification. We have said nothing as to the way in which it is to

be used. We have claimed it for the preservation of animal substances. You are using it for the preservation of animal substances, and therefore you are infringing our patent. But if he did this before the patent was issued, then the patent, according to that construction, is open to the charge of want of novelty." That is the whole of the case, but I am extremely anxious not to assent to any form of interlocutor which absolutely pronounces this patent to be invalid. I do not desire to say that it is invalid; it is only invalid if a construction is attempted to be put upon it which would be sufficient to restrain the present respondents from doing what they have been doing. If a limited construction be put upon it—a construction which would make it in accordance with what I hold to be the meaning of the provisional specification, I see no reason—and I do not think it necessary to decide that question—why it may not be a valid patent.

My Lords, when I said that there was an alteration of the interlocutor of the Court of Session which I would suggest, what I referred to was that the interlocutor as it now stands appears to be open to this interpretation, that it pronounces definitely once for all that the patent is invalid. That appears to me to be unnecessary, and what I would suggest to your Lordships as an alteration of the wording would be this. I should propose to your Lordships to omit from the words "find that the complete specification" down to the word "therefore," and in place of the wording of the interlocutor as it is there printed to insert the words—"Find that the complete specification, if large enough to cover the employment of bisulphite of lime for the preservation of animal substances as practised by the defenders, would claim an invention larger than and different from that disclosed in the provisional specification, and would be open to the objection of want of novelty and of want of a sufficient description of the manner in which the invention is to be performed." The interlocutor will then proceed—"Therefore find that the patent is not valid and effectual to secure to the patentee the invention or supposed invention used by the defenders as aforesaid. To this extent and effect sustain the defences." My Lords, I think of course that that alteration ought not to make any difference as to the costs of the appeal, but that they should be paid by the appellant.

LORD HATHERLEY—My Lords, I entirely concur in the view which has been taken by my noble and learned friend on the woolsack in this case. If I think it necessary to add only a very few words to what has been said, it would be rather to explain for my own satisfaction the grounds upon which I concur with him than to add any new light to the observations on the point of law. I think there can be no doubt in reading the provisional specification in this case that intending as the applicants for the patent then did, to preserve as they say, not meat which already was in a preserved state—not meat which was in the nature of dried meat or the like—but fresh meat soon after it was killed, and to preserve it, as they express it, in such a manner as that the flesh would retain the appearance that it might present immediately upon or soon after death, they proceeded evidently to set forth a process by which

that end was to be attained. Now, without the slightest difference of expression with regard to the two subject-matters which they intended to use for preserving the meat—without the slightest difference of expression as to the efficacy of the one or the other—they propose that in certain quantities there should be mixed together this substance which is called bisulphite of lime, which appears to consist of sulphate of lime, the solid substance, and sulphurous acid, in which that solid substance becomes soluble, and which may then be called, and at all events is now at this time sufficiently known, whatever may have been the case before the date of the patent in question, as bisulphite of lime. That is the one substance; the other substance to be put to that to make up the mixture for the purpose of preserving the meat was gelatine. The appellants say that this gelatine was added, and must have been known to everybody to have been added to the mixture intended to have the effect desired, solely for the purpose of fixing the solid parts of the compound—the lime, for instance—which had been put into the common mixture, and to bring the whole to solidify, so as to present a compact surface which would keep the meat in the fresh state that was wanted; when required for use, the meat, before being cooked, was to be washed to remove all that adhered to the surface.

Now, it is said that the bisulphite, as far as it had any known power, was a distinct antiseptic, as it was called in the course of the argument. We do not find the word "antiseptic" used anywhere in the patent, but we may presume that the bisulphite of lime was the stronger of the two ingredients of which the patent was composed. At the same time, I cannot admit, as was suggested in opening by the learned Attorney-General, that anybody knowing at all the properties of gelatine and how to deal with it would have known that gelatine could have no antiseptic properties and could only be used for the purpose he described. So far from that being the case, I venture to think that anything that excludes the oxygen of the air excludes the approach of the enemy, if I may describe putrefaction as being the enemy. The antiseptic, as it has been termed, or the bisulphite of lime, fights the enemy hand to hand, and seems, as some of the witnesses say, to have the power through the medium of the sulphuric acid, which has been used before for purifying purposes, of overcoming or repelling that which is being attacked, or at all events of warding off the attack which has been made for a short time.

Now, anybody who has read the provisional specification through, which I do not propose to do as it has already been read during the course of the argument and commented upon by the Lord Chancellor, would say that from beginning to end there is no separation of those two ingredients. They are placed in the very fore-front of the specification, and are described as to their composition, as to the heat to be applied, and as to the specific gravity compared with water of the mixture—all that is perfectly well taken care of, and is described, as has been said already; and if the complete specification does really no more than carry this invention into effect, it might, for all I know, be a fair foundation for a patent. But then, if you take that to be the patent, as has already been observed, Mr Robertson has not

infringed it; he has not used the mixture of gelatine and bisulphite of lime; he has used bisulphite of lime simply; and that is the only accusation against him upon the present inquiry. Therefore he would be free from all impeachment of infringement of the letters-patent.

But then, in order to embrace Mr Robertson within the meshes of the patent, it is said that in effect he has violated the patent itself, because the complete specification does something more, and that has been the great difficulty which the appellants have laboured under all through. They are obliged to say that there is something more, else they cannot catch Mr Robertson, and if they do say there is something more they involve themselves in a considerable difficulty. Now, what happens is this—In the complete specification certain mixtures are spoken of, the first being the composition No. 1, that not being a mixture of any two things, but being bisulphite of lime in a liquid state. Then follow Nos. 2, 3, and 4, all of which are compounds of bisulphite of lime with some substance or other—some with gelatine; one for the purpose of injection into the veins of the animals (which does not appear in the provisional specification at all, but in one of the objects mentioned in the complete specification). That was to be mixed with salt; but in no single operation is there any direction as to the use of bisulphite of lime alone without any other material, except in the case mentioned by the Lord Chancellor, namely, the case of saturating the casks in which animal substances are to be packed dry, which for good reasons the patentees say they do not claim. They do not claim the lining of casks with it, and I say with good reason (for I stopped the learned Attorney-General upon that point), because that has nothing to do with this case. That has reference rather to Medlock's patent, which is a patent relating to the preservation of beer, in regard to which it appears part of the procedure is with this bisulphite of lime to deal with the casks in which the beer is contained. That was very much the same process as dealing with the casks which contain the meat, and therefore that could not be claimed without exhibiting at once the defect of want of novelty.

Now, if we read the patent as meaning nothing more than the use of bisulphite of lime in these various states of mixture, I am not prepared to say that that may be erroneous on the part of the patentee, but if we are asked to do anything more, then we find that he falls into the difficulty that he has distinctly claimed a more extended right in his complete specification than he did in his provisional specification—more extended in this sense, because whereas the provisional specification would say that one must for these purposes have gelatine and bisulphite of lime, if the complete specification is to be construed as entitling him to shut out others from the use of the bisulphite alone, he must say, I claim also a patent for doing this without the assistance of gelatine.

My Lords, it appears to me to be most unfortunate in this case, and I do not think it is the common practice in the case of an invention, that the patentee should not have been called. I do not know that there is any explanation why he has not been called, but if he had been called he might have been asked a few questions which

would have considerably assisted us in coming to a conclusion upon the facts. But your Lordships must see that one of the points in which the provisional specification differs from the complete specification is, that one cannot feel any certainty that at the time the letters-patent were granted upon his complete specification he really had invented the things which he afterwards says he had invented. When one finds that there is a discrepancy between the two specifications there is grave reason for suspecting that any alleged invention, so far as it exceeds or transcends the original specification, has been supplemented by further discovery. If that is so, how are we to take it? If we are to take it in the enlarged sense, it is undoubtedly struck at in the matter of novelty by Rattray's patent. We cannot say of any individual patent—That patent is no novelty; but we have an admission on the record that Rattray did use that very material—this bisulphite of lime—coupled with this restriction, that he only used it pursuant to his patent. Therefore we are brought to consider his patent, and we are brought to consider his use of this very material which it is said nobody else must use. Now, the course that he takes is plain—it is for the preservation of organic substances; it goes rather further than the mere question of meat, which is the subject dealt with under the pursuer's patent here, and he says that he has two inventions in respect of dealing with organic substances—one process is that in which he preserves meat by sulphurous acid, by which he says he can preserve the meat for some time. Then he says his second process is the packing of organic substances so as to continue longer in a state of preservation; and in order to continue them in a state of preservation he says he takes preserved substances (I agree with the learned attorney's general observations) and not fresh meat, and then he proceeds to describe the mode of applying the wet process. Now, this preserved meat here referred to is not meat preserved with sulphurous acid simply, to which the first part of his patent relates, but meat preserved in any mode in which meats are preserved, whether by salting, drying, or smoking, or the like. Then he enters into the main points of his invention, and he says—"As to the second part of my process, which relates more particularly to organic substances treated by my first process, I deal with them in this way," and then he proceeds to say how, but at the same time maintaining a generality of expression implying that he means to apply these two processes—the dry process and the wet process—to all meats which are preserved. Then he proceeds to use the bisulphite of potash. There is some dispute as to whether the dry process is included in it, because there was some suggestion about the earth which is used being reduced to a powder, which it is said cannot be done. I will not pursue that question as to the bisulphite of potash, but at all events as to the wet process he used bisulphite of potash. It is submitted upon the record that that was used during the interval between Rattray's patent and the pursuer's patent, and it would deprive the pursuer's patent of novelty unless it might be said that it might be left as an open question to be decided hereafter whether there is a possible opening for a patent as for a new invention where a leg of pork has been plunged into this liquid formed by the bi-

sulphite of lime or potash, and not a ham or other preserved meat. The conclusion is that it is a discovery applicable to every sort of organic matter, whether vegetable or animal; and it must be recollected that in the second process where he introduces this bisulphite of potash he applies the process entirely to the purpose of preserving meat. I quite agree with the proposal of the Lord Chancellor as to what shall be done in the case.

**LORD BLACKBURN**—My Lords, I entirely agree with what has been said by the noble and learned Lords who have preceded me. I do not think it necessary to go into much detail in what I am about to say. I would first say what occurs to me upon the question upon which the interlocutor of the Court below entirely proceeds, of what is called the nonconformity of the complete specification with the provisional specification. I take it that when you consider the history of patents in England there is not very much difficulty in construing the Statute of 1852, upon which it all turns as far as regards this particular case. This is a Scotch case, but I think that the Scotch Patent Law has entirely adopted and incorporated the English.

The Patent Law, dating from the time of James, gave a monopoly solely to the invention of the first inventor; it therefore gave a monopoly solely to that invention which was his invention—he could not claim an invention greater than the title of the patent, but the titles were of extreme generality. It is in this particular instance "for improvements in preserving animal substances"—almost any kind of thing would come under that description; the mere title gave very little instruction. Then, in the time of Queen Anne the Attorney-General of the day instituted what was obviously a very great improvement; he made it a condition that the patentee should within six months particularly "describe and ascertain" the invention and the manner in which it was to be performed; if not, it should be void. If that was done at the end of six months, that specification fixed what was the invention for which the patent was granted. Then during the six months it would have been, and before specifications were invented it must have been, a question of evidence as to what was the invention for which he went to the Crown, and for which the Crown granted a monopoly, and the traverse of that would also be the proof. Then came the Statute of 1852, which introduced a further amendment. It enacted that when persons went to apply for letters-patent they should deposit a provisional specification. That provisional specification describes the invention in terms very different indeed from those in which the final specification describes it. In the former case, instead of saying, "It shall particularly describe and ascertain the nature of the invention, and in what manner the same shall be performed," all that the statute says is, that in the provisional specification which the applicant leaves with the law officer of the Crown when he applies for a patent he shall state the nature of the invention—no more than that—and then when the law officer of the Crown to whom it is referred has looked at it, and finds it does state the nature of the invention, but thinks the nature of the invention is too large or too vague, he may require the applicant to amend it, but if not,

then he grants a certificate to use the patent publicly, without at all thereby making a present of the discovery to the public; and when it came to be a question whether or no what he was doing during that six months was outside the patent, I take it the process must have been to say, Look at the nature of the invention described in the provisional specification and say whether this which you have been doing, and which you say was a part of the patent, is fairly within the nature of the invention you have described—in that case you are protected, but if it is a new and separate invention and a different one, then you are not protected. I cannot but think that when that is once looked at it becomes pretty clear that when the nature of an invention has been described in the provisional specification in the way which has been mentioned, if something is found out during the six months to make the invention work better, or with respect to the mode in which the operation may be performed—a thing which is very likely to happen when in carrying out his invention the inventor finds that some particular bit will not work so smoothly as he expected, and it is necessary to add a little supplement to it—still the nature of his invention remains the same, and it is no objection that in the complete specification which comes afterwards the invention or application is described more particularly and in more detail, or even that there has been more discovery made, and so as to make the invention which is described in the provisional specification really workable. If nothing more is done than that, I think it is good, but as soon as it comes to be more than that, and the patentee says in the provisional specification, I describe my invention as A, and in the complete specification says, I hereby describe A and also B, then as far as regards B it is void, because the letters-patent were granted for the invention that was described in the provisional specification, and do not cover the invention that is described in the other.

Now, my Lords, applying that principle to the present case, it becomes necessary to see what was the provisional specification and what was the complete specification—What do they mean? I need say very little on this head, because I agree completely with what has been said both in the Court below and with what has been since said by your Lordships, but I may mention this, that the state of chemical or general knowledge at the time when this patent was granted in 1866 appears, I think, very clearly as to this. I do not find that there is any discrepancy in the evidence at all in respect to this point. It had been known for a long time that sulphurous acid had the power of stopping fermentation, and that, including other fermentations, it had the power of stopping the fermentation which ends in putrefaction. It had also been known—I will not say for how long—that the earths and salts which were combined with sulphurous acid had the same effect. It was explained by Dr Wallace that whilst the sulphurous acid is being applied to the earthy substance, or the salt (the oxygen of the atmosphere combining with it turning the salt, which was the sulphate of lime, into plaster of Paris or gypsum), the sulphurous acid is slowly let off. I have nothing to do with whether that is the right theory or not—the result is a fact that was known—if we want to make certain

that that fact was known, nothing can be better for the purpose than what we find in Medlock's own specification in 1861. There, talking of how he purifies fermented liquor by sulphurous acid, he says in very clear language—I wish to introduce sulphurous acid into the beer for the purpose of preventing it from fermenting further and becoming sour; he also says (I am giving his statement colloquially) I find that it will do as well if I put in a salt of sulphurous acid. I find a great many salts of sulphurous acid of all the salts, and I have tried a great many. I find that the effect of the bisulphite of lime (whether that is the technically correct word or not is not important) does best, and putting that into the vessel in which the beer is, it prevents the acetous fermentation which does the mischief. As the oxygen of the atmosphere combines with the bisulphite of lime it turns it into pure and simple sulphate of lime, an earthy salt, which does no harm at all, but collects in the barrels, and does rather good than harm by making them air-tight.

Now, taking the provisional specification, I can not bring my mind to doubt that the gentleman who drew it thought that the salt of sulphurous acid, which is made by lime—the bisulphite—was useful for preventing decay in anything, and consequently preventing decay in fresh meat, but he probably thought that to make it useful for preserving fresh meat we must bring it into contact with the fresh meat. I cannot but think that his intention when he drew the specification was this—Fix it with gelatine, and paint it on when it is warm. The gelatine will freeze, and then the sulphite of lime, which is embodied in the gelatine, will remain and form a coating, and even on a journey it will not shake off, and no doubt that is true enough. If the bisulphite of lime is simply sprinkled or painted upon the meat and allowed to dry, the salt as it is deposited lying loose upon the surface of the meat, I cannot but think it highly probable that if it were carried any distance in a butcher's cart or by railway the shaking during the locomotion would remove it, whereas if it were covered with gelatine it would remain. I think it very probable that what was described in the provisional specification might turn out a useful invention in that regard—whether it is or not will be considered hereafter when the question arises; but what Mr Robertson, the defender, here has done is no infringement of that; it is an infringement rather of what is added—of the claim which the patentee in his complete specification makes when he says—“I take the bisulphite of lime and use that simply.” If that claim is made as a complete claim and a new one, then I quite agree with Lord Shand in the view he puts, that if that were a new thing it would be the subject of a patent itself, and ought to have been the subject of a separate patent, and cannot be tacked on to the other invention which was stated in the provisional specification. If that be not claimed here, which is the only alternative, then there has been no infringement, because what Mr Robertson has done has been no infringement of the provisional specification though it may be of the other.

My own impression at all events is, that if it is an infringement, still the appellant would not be able to recover even if it were a new matter. I should be sorry if that were so

because I think it would come to this, that if it were really a beneficial discovery the inventor would have made the public a present of it when he never meant to do so. Therefore I am glad to think that if ever so many patents had been taken out for this additional claim they would not have been valid, because the material would have been used before, and it is perfectly clear to my mind that when we look at the evidence it is shown to be so.

I have already said what I consider to be the nature of the chemical knowledge possessed in 1861. Mr Medlock's patent, which I quoted, is a month or two afterwards, or about the same time as Rattray's, and therefore taken out under about the same amount of chemical knowledge. Now, what Rattray says in his description of his process is this—First of all, he tries to cure the meat by sulphurous acid in a way which I daresay would make it very unsightly and perhaps very unpleasant to the taste, and I daresay the patent did not prove a success on that account. Then he proceeds to say—"After that has been done, I would pack it in one of two ways." Having reference to the treatment described in the first part of the invention, though he does not confine himself to that, he says in his specification—"I dip them into a solution of either of the alkaline or of the earthy sulphites." "I then allow the substances to drain, and expose them to the air for about two hours in a warm place, so that the water contained in the solution of the salt remaining on the surface may evaporate and leave the dry salt on the surface of the preserved substances." He then says he will take any sulphite, and that, as it is pointed out in the evidence, is a matter which would prevent the operation of his patent from becoming beneficial. It is well known that some of the earthy sulphites in a dry form are rank poison, and that would be a very serious objection indeed to their use for the preservation of meat, that others, while not poisons, are objectionable. We know that the alkaline sulphite of soda, for instance, turns into Glauber salts; the sulphite of magnesia turns into epsom salts, and we know what the effect of that upon the human body would be; and sulphite of lime turns into plaster of Paris. I have no wish to find myself swallowing any quantity of plaster of Paris, although it might not do much harm—it might be a thing that might do better than any other, but these are all objections which may be very strong ones against Rattray's specification. Then comes the addition for the purpose of avoiding proof—the appellants admit that Rattray did use sulphite of lime, and having done that, do they not state here as clearly as can be—"I take the solution of sulphite of lime, one of the earthy substances." That sulphite of lime we must remember is soluble in sulphurous acid, and becomes what is called bisulphite—I take that solution of bisulphite of lime and dip the meat into it. I let the meat dry until a dry salt forms upon the surface of the meat, and that stops the progress of decay. Now, in this case what is it that Mr Robertson has done; he has not taken fresh meat and dipped it into the solution, but he has taken fresh meat and spread the matter upon it with a brush. I cannot say that I see much difference whether he had taken fresh meat and spread the solution with a brush or Mr Rattray had taken it and dipped it into the solution; it would be just as much an infringement as before.

Now, because Rattray says that he does it for the purpose of stopping decay in partially preserved meat, can it be said, taking the instance which my noble and learned friend just now gave, that Mr Rattray could be stopped, and that it could be said—You have dipped a ham into the bisulphite of lime, and so stopped the putrefaction, but I say you shall not dip a leg of fresh pork into it. I think you cannot do better than take the old illustration. The old illustration was—You cannot take out a patent saying you have eaten soup with a spoon. I will take out a patent for eating pea soup with a spoon. You have taken out a patent for sweeping an old carpet with a new broom. I will take out a patent for sweeping a new carpet with an old broom. I quite agree there may be cases in which there is real invention and discovery, though an apparent application of an old principle. The best case for illustration is one in which I believe the patent was granted, but the invention was not found practicable. About 30 years ago, an ingenious man seeing the plastic nature of the dough of flour, and knowing that the Neapolitans spin all kinds of macaroni out of it very ingeniously indeed, came to the conclusion that if he could only manage to take red-hot iron almost melting, he by an analogous process could spin gas-pipes, but the principle failed in practice, as you might suppose it was rather a difficult thing to do. Nobody would have doubted if he had succeeded in it it would have been a very great invention. But there is no such invention here; it is merely saying the exact mode in which Mr Rattray has been preserving his semi-cured meat is to be prohibited to him when it is applied to meat which is not cured at all. I must say it strikes me that it would not be a good patent at all.

It now only remains for me to say that I think that the amendment which has been suggested in the interlocutor by the Lord Chancellor is a very desirable one. Whether it would produce the practical result of doing any good or not I do not know. You will not be able to stop Robertson by it from doing what he has done now, but you will be able to stop him from packing in casks any perishable things, and I think it is fair that that should be done.

But there is further the objection taken that the specification does not describe the mode of application in a sufficiently practical way. I have more difficulty about that than about any other matter in the case, because I feel that men with common skill and common knowledge can take a hint very speedily and apply it. I am loth to say that the patent is bad on that account if one has not evidence about the novelty of it, but in the present case I am inclined to think that there is sufficient to show that the patent is bad on that ground also. If the other grounds are fatal, it does not matter whether that is fatal or not.

I may add that one of the things which weighs in my mind is the exceedingly well put interlocutor of the principal Sheriff (Dickson). I will not read it now, because it would perhaps take rather a long time, but beginning "Upon the question of fact the pursuer contends," and going down to "get the full benefit of it," the first part was adopted both by the Lord President and Lord Shand, and it contains the fullest summary of the reasons applicable to it.

On the whole, it strikes me that the result is this, that if there be an infringement of the invention as described in the full specification, it is an infringement of a part which is not within the nature of the invention as described in the provisional specification, and if it be a part moreover of the specification, there is a failure to specify the means of doing it, and there is a want of novelty. Upon all these three grounds—and I think any one of them should be sufficient—I think the judgment of the Court below should be affirmed.

LORD GORDON concurred.

Interlocutor of Court of Session affirmed, with variation proposed by the Lord Chancellor (*supra*), and with costs.

Counsel for Appellant—The Attorney-General (Holker, Q.C.)—Webster, Q.C.—Lawson. Agent—J. Henry Johnson, Solicitor.

Counsel for Respondent—Aston, Q.C.—MacClymont. Agent—Andrew Beveridge, Solicitor.

Thursday, June 27.

MACKENZIE v. BANKES.

[Before the Lord Chancellor, Lord Selborne, Lord Blackburn, and Lord Gordon.]

[*Ante*, Nov. 30, 1877, p. 173, 5 Rottie 278.]

*Property—Loch—Riparian Owner—Joint-Property in Two Pieces of Water separated by Narrow Channel.*

In an action of declarator of joint-right or common property in a piece of water alleged to be part of an inland loch, in which the pursuer and defender had equal rights, the latter asserted that he was the sole owner and the only riparian proprietor of the water, which bore a different name, and was separated from the loch by a causeway erected upwards of forty years previously, and not since taken exception to.—*Held* [affirming judgment of Court of Session—*dub.* Lord Blackburn] that the two pieces of water must be held to be separate lochs, judging, *inter alia*—[1] from their difference of name; [2] from the configuration of the ground; and [3] from the existence of the causeway for the period of prescription.

*Review* by Lord Blackburn of the common law regulating the rights of different parties in respect of their occupation of property along the banks of a lake.

This was an action concluding, *inter alia*, for declarator that the pursuer had along with the defender a joint-right or common property in the loch called the Fionn Loch, and particularly in that part of it called the Dubh Loch, and a joint-right of boating, fowling, fishing, and exercising all other rights in or over that loch, and that the defender had no exclusive right thereto. There was also a conclusion for damages. Neither party had any express grant, and the lands of both bordered upon Loch Fionn, of which they

were the sole riparian proprietors. The Lord Ordinary [CRAIGHILL] had found for the pursuer, but the Second Division [*dub.* LORD GIFFORD] reversed the Lord Ordinary's interlocutor, and assailed the defender [Nov. 30, 1877, *ante* p. 173, 5 Rottie 278.]

The pursuer appealed to the House of Lords.

At delivering judgment—

LORD HATHERLEY—My Lords, the case submitted to your Lordships' decision in the present appeal is one which depends, as it appears to me, entirely upon a matter of fact. We have had a very able argument both upon the facts and upon the law of this case. Without disparaging the other arguments, we are, I may say, particularly indebted to Mr Mackintosh for the very able argument which he has brought before us when the case was under consideration the other day.

My Lords, the law seems now to be completely settled, and the cases which have been referred to may, I think, be disposed of at once, because the decision must, as I have said, turn upon the facts of the particular case. The case of *Scott v. Napier*, 3 Macph., H. of L., 35, and still more the former case of *Cochrane v. Lord Minto*, H. of L., July 5, 1815, 6 Pat. App. 139, or those two cases put together, will pretty well elucidate all that need be said upon the law; and I assume that if the appellant in the present case had been enabled to prove that the two pieces of water which have acquired by some means or other the names of Loch Fionn and Loch Dubh respectively were within the principle of the Scotch law, by which it appears that the proprietors bordering on a lake have in regard to certain matters, which I shall mention afterwards, a common right in respect of such occupation along the banks of the given lake he would have succeeded. If the appellant could have proved that these two sheets of water formed one lake, so as to bring himself within the decisions which have already been given with respect to lakes of that character, then I apprehend he ought to succeed in this appeal.

I was very much struck by the clear way in which Mr Mackintosh at the outset of his argument said that he proposed to argue the question. Having established from text-writers and from decided cases, that there is a common right on a lake, he said—What is the common right to be, and what is the unity of the lake which gives rise to that common right, and not only gives rise to it but limits its extent? He said—and I confess, my Lords, I followed him and agreed with him in that view—it must be with reference to the character of the right which is said to be exercised. Now, in the present case the right is a common right on the piece of water which the appellant says is only one lake—the common right of boating, fowling, and fishing. One can understand how it is that that common right has grown up. A person proceeding from property of his own to fowl or to fish upon a lake could not be conveniently arrested the moment he arrived at the *medium filum ex adverso* of his land, or the moment he traversed the boundaries which might be drawn on the extreme north and south or on the extreme east and west of his land. The case of *Cochrane v. Lord Minto* was cited. I need not dwell long upon that case, for it has no application to the present, but when it was fully looked into, and the papers searched