

## SECOND DIVISION.

SYKES v. WILSON AND SONS.

*Reparation—Patent—Infringement—Issues.* Statement of the law as to what defences may be urged in an action of damages for infringement of a patent, and form of issues and counter-issues adjusted.

Counsel for Pursuers—Mr Gordon and Mr Millar. Agents—Messrs MacRitchie, Bayley, & Henderson, W.S.

Counsel for Defenders—The Solicitor-General and Mr Gifford. Agents—Messrs MacLachlan, Ivory, & Rodger, W.S.

The pursuers in this action are Reuben and Philemon Sykes, of Huddersfield, machine makers, and the defenders are William Wilson & Sons, woollen manufacturers, Bannockburn, and the object of the action is to recover damages for the alleged infringement of a patent for the invention of "improvements in machinery or apparatus employed in the spinning, twisting, and roving wool and other fibrous substances." Letters-patent for this invention are said to have been granted to the pursuers on the 27th of January 1860, and sealed the 3d of July 1860, and one of the improvements claimed as thereby patented is the application to continuous spinning, roving, or twisting machines of a glass ring and ring-flyer of steel, of an improved shape, by which the holes of these machines are enabled to regulate the tension of the threads during the process of winding and twisting with less liability to breakage. The pursuers found also upon other letters-patent, dated 13th November 1862, and sealed January 1863, in regard to which they say that the invention thereby patented relates to the manufacture of the rings used in substitution for the ordinary flyers employed in machines for spinning, doubling, and twisting wool and other fibrous materials, and consists, *firstly*, in making such rings of malleable cast iron, and afterwards hardening the same by the agency of heat; the said rings being used in the same manner and for the same purpose as the glass rings described in the specification of letters-patent granted as aforesaid, and bearing date 27th January 1860, No. 208. The said invention, it is said, consists, *secondly*, in varying the form of the said rings from that represented and described in the specification in the patent of 1860 above-mentioned, so as to dispense with the bead or rounded projection on the inner side at the upper part thereof, which bead is intended to prevent the ring-flyer from leaving the ring during its rotation. For this purpose the ring is formed with the inner side bevelled off at the upper part instead of with a bead or rounded projection, and the lower part of the inner side is bevelled in the opposite direction—that is to say, so that the diameter of the ring is less at the upper part of the bevelled or inclined side than at the lower, thereby having a tendency to prevent the ring-flyer from leaving the ring.

It is alleged by the pursuers that from the 1st of October 1863 to the raising of the present action the defenders used the ring-flyer described in the specification, and covered by the said letters-patent of 1860, and that during part of the same period they also used a ring of the shape, material, and manufacture covered by the said letters-patent, dated 13th November 1862, and sealed 13th January 1863, and described in the relative specification. During the remaining part of the same period it is said they used a ring of the material and manufacture covered by and described in the said last-mentioned patent and relative specification, and they so used the said ring-flyer and the said rings by applying them to twisting machines within their works at Bannockburn. All this is said to have been done without leave of the pursuers, and in violation of their rights under the said patents.

In defence the defenders pleaded—

"1. The alleged letters-patent founded on by the

pursuers, are null and void, or invalid, in respect the alleged inventions mentioned therein, and in the relative specifications and drawings, do not embrace or contain any subject-matter which can legally be made the subject of a patent.

"2. The said letters-patent are null and void, or invalid, because the machinery or apparatus described therein do not display any ingenuity or invention, and are of no use or public utility, and do not accomplish the ends or objects which they profess to serve.

"3. The said letters-patent are null and void, or invalid, in respect the pursuers are not the true and first inventors of the said alleged inventions, or of any part thereof.

"4. The said letters-patent are null and void, in respect that the said alleged inventions were publicly known and used at and prior to the date of the said letters-patent respectively.

"5. The said letters-patent are null and void, in respect the said alleged inventions are not sufficiently or intelligibly described or explained, and so as to enable a workman of ordinary skill to put the alleged inventions into practice.

"6. The said letters-patent are null and void, because the pursuers, in the specifications and drawings, do not sufficiently distinguish between what is old and not claimed by the pursuers, and what is alleged to be new and claimed by them.

"7. The said letters-patent are null and void, in respect the said alleged inventions are not inventions of any new manufacture within the meaning of the said letters-patent, or of the statutes authorising the granting of letters-patent.

"8. The defenders not having infringed the letters-patent founded on by the pursuers, or either of them, they are not liable in damages to the pursuers.

"9. The whole material averments of the pursuers being unfounded in point of fact, and their pleas bad in law, the defenders should be assozied, with expenses."

The case came before the Court on the adjustment of issues. It was advised to-day.

The LORD JUSTICE-CLERK said—The Court thought it right to consider the argument submitted at the adjustment of issues, because we feel strongly that in a branch of law so extremely artificial as the law of patent it is extremely desirable that the form of pleading as well as the form of issues should be definitely settled, so as to avoid as much as possible any misunderstanding or mis-carriage; and I shall now state the result of our deliberations at some greater length than is usual when adjusting issues. The pursuer of an action of infringement comes into Court as patentee with a Crown grant, which he produces, and which constitutes his title to sue; and if any objection arise to the form of grant—as, for example, if it is said that the letters-patent are not in proper form for constituting a grant, or that no proper specification has been made—these are objections to the title to sue, and are therefore objections of a preliminary nature. But if, as in the present case, there is no such objection to the title to sue or to the Crown grant, then it is desirable that that should be made matter of admission; and accordingly it is almost the universal practice that an issue of infringement is pre-faced by such an admission. All that remains for the pursuer to undertake is in the first instance to establish acts of infringement, and for that purpose he takes an issue. The patent, however, which is introduced, with an admission that the Crown grant has been expedite, is liable to many objections in point of law; and there are special defences applicable to these, and they are the subject of special issues. The special defences that can be urged in an action of infringement are quite settled; they cannot be modified; they are all of a technical character, and are all to be found within the statute of monopolies and the letters-patent. His Lordship quoted the Act of Parliament for the purpose of ascertaining the objections that

are competent under it to a patent. These are (1) that the subject-matter is not patentable; (2) that the patentee is not the first inventor; (3) that there has been prior use; (4) that the subject of the patent is not of general public utility. In the letters-patent, again, there are conditions introduced which raise all these four objections except the first, and there is an additional condition which requires the patentee to enrol a specification describing his invention and the manner of performing it; so that taking the Act of Parliament and the letters-patent together, they raise five different grounds of objection to a patent; and these are the only possible defences that can be pleaded against an action of infringement, except always, of course, the plea founded on a general denial of infringement. In the present case these objections are all well stated. Leaving out the eighth and ninth pleas, the former being a denial of infringement, the other pleas resolve themselves into the five objections to the patent. The first and the seventh are objections, stated in different words, to the subject-matter; the second is an objection to the public utility of the patent; the third raises the objection that the patentee is not the first inventor; and the fourth is that there has been prior knowledge of the patent. The fifth objection is that the specification does not conform with the conditions of the letters-patent; and the only remaining plea is the sixth, which alleges that the pursuer does not distinguish between what is old, and therefore not claimed, and what is new, and therefore claimed. That plea is a further extension of the objection that there has been prior use of the patent, or that the patentee is not the first inventor, and is a modification of these pleas, combined with a well known principle of patent law that if the old matter be so mixed up with the new as to be inseparable, then the whole patent is bad. That is a principle of law a little beyond the plea involved in the third and fourth pleas of the defenders. Now, the first ground of defence, that the subject-matter of the patent is such that a patent could not legally be granted, is a question of law and not of fact, and therefore there is no special issue required for it. It is not a question of law to be determined before the trial, because before the Court understand the specification the Court cannot determine what the subject-matter is. But still it is a matter of law and not of fact, with which the jury have no concern. The other four defences do require special issues; but then there are four only, and not five, and the objection to the issues is that five are wanted to try four questions. Under the third plea the defender has proposed two issues; but the Court are of opinion that neither of them is the proper issue to try the question raised by the third plea, and still less is it competent to try the question under two issues. It is difficult to reconcile the authorities on the point of what constitutes such difference as would entitle a patentee to take out a patent, some apparently holding that the man who first publishes a patent is the inventor, others that the invention of it is required. The proper issue here will be one which shall follow as strictly as possible the terms of the Act of Parliament and the conditions of the letters-patent, and will be whether the pursuer was not the true inventor; and under this issue it will be open to the defenders to maintain any objection to the claim of originality and true invention, except the objection of prior use, which is raised under another issue.

The following are the issues adjusted—the first two being those of the pursuer:—

“It being admitted that the pursuers obtained the letters-patent, No. 5 of process, dated 27th January, and sealed 3d July 1860, and filed the specification, of which No. 6 of process is a certified printed copy:

“It being also admitted that the pursuers obtained the letters-patent, No. 7 of process, dated 13th November 1862, and sealed 13th January 1863,

and filed the specification, of which No. 8 of process is a certified printed copy—

“1. Whether, from the 1st of October 1863 to the 18th of November 1864, or during part of said period, and during the currency of the said first-mentioned letters-patent, the defenders did, at their works at or near Bannockburn, wrongfully, and in contravention of the said letters-patent, use the invention described in the said first-mentioned letters-patent and specification?

“Whether, from the 1st of October 1863 to the 18th of November 1864, or during part of said period, and during the currency of the said second-mentioned letters-patent, the defenders did, at their said works at or near Bannockburn, wrongfully, and in contravention of the said letters-patent, use the invention described in the said second-mentioned letters-patent and specification?

“Damages laid at £500, with interest from 18th November 1864.

OR,

“1. Whether the pursuers are not the first and true inventors of the invention described in the said first-mentioned letters-patent and relative specification?

“2. Whether the invention described in the said first-mentioned letters-patent and specification was publicly used in the United Kingdom prior to the date of the said letters-patent?

“3. Whether the said invention described in the said first-mentioned letters-patent and relative specification is not practically useful for the purposes therein set forth?

“4. Whether the description contained in the said specification is not such as to enable workmen of ordinary skill to practice the said invention so as to produce the effects set forth in the said first-mentioned letters-patent and specification?

“5. Whether the pursuers are not the first and true inventors of the invention described in the said second-mentioned letters-patent and relative specification?

“6. Whether the invention described in the said second-mentioned letters-patent and specification was publicly used in the United Kingdom prior to the date of the said letters-patent?

“7. Whether the said invention described in the said second-mentioned letters-patent and relative specification is not practically useful for the purposes therein set forth?

“8. Whether the description contained in the said last-mentioned specification is not such as to enable workmen of ordinary skill to practice the said invention so as to produce the effects set forth in the said second-mentioned letters-patent and specification.”

#### FLEEMING v. HOWDEN AND DUNLOP.

*Entail—Clause—Irritancy—Declarator.* A deed of entail having provided that in the event of any of the heirs of tailzie succeeding to the peerage, the estate should then devolve on the next heir—held by the whole Court (1) That on the occurrence of the event, the estate devolved *ipso facto* on the next heir, without the necessity of any declarator; and (2) That the next heir was entitled to the rents from the date of the succession to the peerage in competition with the trustee on the last heir's sequestrated estate, and a person holding a disposition and assignation to the rents from the last heir.

Counsel for the Pursuer—The Solicitor-General and Mr Pattison. Agent—Mr Thomas Ranken, S.S.C.

Counsel for the Defenders—Mr Patton and Mr Millar. Agents—Messrs Scott Moncrieff & Dalgetty W.S., and Mr George Wilson, S.S.C.

In an action of declarator, adjudication, and payment originally raised at the instance of the late