

I am therefore prepared to hold the allegation irrelevant, and to repel the plea founded on it.

On the second point, I concur in the opinion of the Lord Ordinary, and have nothing to add to what he has said.

LORD COWAN—Having regard to the legal questions raised in the record, and the argument under the reclaiming note, I am of opinion that no sufficient ground has been stated which should lead us to disturb the interlocutor of the Lord Ordinary.

The legitim claimed by the pursuer is by the law of Scotland undoubtedly due to him, as the only child of the marriage of his parents. At the date of his death his father was a domiciled Scotchman, and he had no power to test upon his whole moveable estate to the detriment of that right of succession which by law the pursuer has in his father's executry, unless the same has been satisfied or discharged. Accordingly, this is what the defender, the second wife of General Trevelyan, as his general donee under his settlement of 1871, maintains to be the actual state of matters. No express or special discharge of the legitim is alleged ever to have been executed. No provision in express satisfaction of his legal right is alleged to have been settled on the pursuer by his father. Yet, by the law of Scotland such special discharge, except in very peculiar circumstances, which do not here exist, is indispensable to exclude the claim of legitim.

The defender, however, maintains, in the first place, that by antenuptial contract entered into in England between the pursuer's father and mother, when the parties were both of them domiciled in England—a certain provision was made for the children of the intended marriage, and that this provision, according to the law of England, "operated as a full discharge of all legal or other claims which the issue so provided for could prefer against the succession of their parents." From the statement in the first article of facts set forth by the defender it does not appear that any general settlement of the father's estate, either at the date of the marriage or at his death, was made by the contract. All that is alleged is that a sum of £5000 by the father and the sum of £6167, 3s. consols by the father, were given over to trustees for behoof of the issue on the death of the surviving parent. This being the nature of the provision to which the defender refers, the first matter for consideration is, whether it is necessary to make inquiry as to the law of England? That this course has been followed in some cases may be true, and I observe in the case of *Hog v. Lashly* the opinion of English Counsel was taken by this Court as to the effect by the law of England of certain provisions contained in an English contract which had been entered into before the marriage as regards the *jus relictae*. I do not think, however, that this course should be adopted in the present case.

(1) The provision in the contract is stated to have consisted of a sum of money, set apart, subject to the liferent of the spouses, as a separate fund for the children, not by their father alone, but by the mother also; and this fund they could claim as theirs, and if not actually given over to the trustees, was a debt claimable rateably out of the general estates of both parents. In such a question as the present there is no difficulty in dealing with such a provision without having recourse to the law of England, there being no technical words or phraseology employed requiring to be interpreted by that law.

And (2) it is for the law of Scotland to judge of the effect of such a provision upon the right to legitim, asserted by the pursuer, inasmuch as it is not alleged that by the law of England any interest in or share of the moveable estate of the father is capable of being vindicated by his children upon his death domiciled in England. In this respect there is a distinction between the claim of the children for legitim and the interest of the wife to share in the goods in communion. By the law of England there is a corresponding right of dower in the wife, the implied discharge of which by an English contract may, when alleged to have been discharged, be matter for inquiry. It is different as regards the legitim, there being no right whatever in the children similar to that by the English law, capable of being impliedly discharged.

Accordingly, in the case of *Hog v. Lashley*, the Court there, in the question as regards the legitim, judged of the effect of a provision in an antenuptial contract, very similar to the present, without having recourse to English Counsel to ascertain the effect of the English contract (*Hog v. Lashley*, April and May 1792, 3 Paton's Ap.), but at once proceeded to judge of it exclusively by our own law. But where the question of the alleged implied discharge of the *jus relictae* by the English contract came before the Court (*Hog v. Lashley*, March and November 1804, 4 Paton's Ap., 586), recourse was had to English lawyers as to the effect of the contract in extinguishing the wife's right of dower, and how far thereby her *jus relictae* might be affected, becoming exigible by our law on the change of domicile to Scotland. We have here to deal only with legitim, which, as there stated, is truly a right of succession, and is an interest which the law gives to children on the father's death, and thus differing in its character from the wife's share in the goods in communion, which may, when she predeceases, be made effectual during the husband's life.

On the second branch of the case we have to consider only the effect of the fifth plea for the defender, which exclusively relates to outlay for, and advances made to the pursuer by his father; and as to this point the decisions referred to by the Lord Ordinary in his note support his interlocutor. No plea is stated, and no argument was maintained, with regard to the right of the pursuer to claim the whole legitim without bringing into computation the marriage-contract provision, in so far as it was provided out of the father's estate. No question of that kind, therefore, requires to be considered.

LORD BENHOLME and LORD NEAVES concurred.

Counsel for Pursuer—Solicitor-General and Kinnear. Agents—Mackenzie & Kermack, W.S.

Counsel for Defender—Watson and Glog. Agents—Gillespie & Paterson, W.S.

Friday, March 14.

SECOND DIVISION.

[Sheriff of Lanarkshire, Glasgow.]

DUBS AND COMPANY v. W. THOMSON.

Patent—Interdict—Onus of Proof.

In an action by the holder of letters-patent

concluding for interdict on account of alleged infringement of the patent—held (1) that the adoption by the respondent of a mechanical equivalent for a portion of the process patented was an infringement of the patent; (2) that the respondent had failed to prove an allegation of public use of the invention before the date of the provisional specification.

This was an appeal from the Sheriff-Court of Lanarkshire, against the interlocutor of the Sheriff-Substitute (CLARK). On July 1869 Mr Thomson, an engineer in Glasgow, presented a petition to the Sheriff against Dubs and Co. Locomotive Engine-Builders, Glasgow, setting forth “that the petitioner is the inventor of ‘improvements in tools or apparatus for expanding and cutting tubes and metallic rings, part of which is applicable for withdrawing ferules from the ends of boiler tubes.’

“That this invention was protected by letters-patent, dated 18th August 1868, and sealed the 16th February 1869, a copy of which is herewith produced.

“That in the specification filed by the petitioner on the 17th February 1869, in pursuance of the conditions of said letters-patent, the said invention is described as consisting, *inter alia*, of (first), ‘The arrangement and construction of tube and ring expanders, in which expanding cones are placed in a reverse position to a central cone, having a proportional amount of taper by which the whole length of the sides of the expanding cones are brought to bear simultaneously against the sides of the ring or tube, as described in said specification, and shown on the drawings accompanying the same; and (second), The method of expanding or pressing the cones against the tube or ring by means of a nut placed on a central screwed spindle, as also therein described, and shown on the accompanying drawings.’

“This invention has in practice been found to be greatly superior to the tools or apparatus formerly in use for expanding and cutting tubes, &c., and has led to a considerable demand for it, and also to several attempts to infringe the petitioner’s patent therein. Among others, the respondents, Dubs and Company, have infringed the rights secured to the petitioner by said patent, by making, using, and vending tools or apparatus for expanding tubes and metallic rings, made according to one or other of the modes in which the said invention is practically carried into effect, set forth in said specification, and drawings accompanying the same, or which are such close imitations thereof, particularly of the mode illustrated by figure seven on said drawings, as not to be distinguishable from the same, and that without holding any authority or licence from the petitioner for so doing.

“That the petitioner has frequently desired and required the respondents to desist from so making, using, and vending such tools or apparatus, but they refuse, at least delay so to do, which renders the present application necessary.” The petitioner therefore prayed for interdict against the respondents making, using, or vending, tools such as those specified, and described in the letters patent.

On July 20th 1869, interim interdict was granted, and thereafter a proof at considerable length was entered into. Ultimately the Sheriff-Substitute (CLARK) pronounced the following interlocutor and Note:—

“Glasgow, 13th May 1872.—Having heard parties’ procurators, and made avizandum, Finds that in

1868 the petitioner obtained letters-patent for the invention of ‘Improvements in tools or apparatus for expanding and cutting tubes and metallic rings, part of which improvements is applicable for withdrawing ferules from the ends of boiler tubes,’ and that these were dated the 18th February 1869, the specification of which forms No. 6 of process: Finds, for the reasons set forth in the subjoined note, that without obtaining any authority or licence from the petitioner, the respondents have infringed the rights secured to him by the said patent, to his loss and damage, therefore declares the interdict already granted perpetual: Finds the respondents liable to the petitioner in expenses: Allows an account thereof to be given in, and remits the same, when lodged, to the Auditor of Court to tax and report, and decerns.

“Note.—In 1868 the petitioner obtained letters-patent for the invention of ‘Improvements in tools or apparatus for expanding and cutting tubes and metallic rings; part of which improvements is applicable for withdrawing ferules from the ends of boiler tubes.’ These were dated the 18th August 1868, and were sealed the 16th February 1869, and form No. 6 of process. The invention thus secured by patent was found valuable, and capable of being made the source of considerable emolument to the petitioner.

“The petitioner avers that the respondents have infringed the right of monopoly so secured to him, and have made and vended tools and apparatus intended for the same purposes, and either practically identical with, or such close imitations of, his invention, as not to be distinguishable therefrom. He has accordingly brought the present action of interdict.

“In answer, the respondents do not deny that they have made and used tools and apparatus for the purposes foresaid, but they allege various grounds in respect of which they consider the present application incompetent. These grounds may be briefly stated as follows:—1. They impeach the petitioner’s patent on the ground that he was not the true and original inventor. 2. They contend that they themselves had invented and perfected the tube expanders which they are sought to be interdicted from using; and that the petitioner’s alleged invention was a mere copy of this, fraudulently abstracted from their works, and made the subject of the letters-patent. Lastly, they contend that the alleged improvements on which the petitioner now stands are not in fact covered by his patent.

“The evidence led on both sides has been very voluminous, and though the Sheriff-Substitute has gone very carefully over it, he does not think it necessary to do more than refer to its general results. Now that the proof has been closed, it is obvious that a certain portion is irrelevant, and that much might have been dispensed with altogether.

“The first ground of defence impeaches, as already stated, the validity of the letters-patent as not being warranted by originality on the part of the inventor. Now, it is unquestionably sound law that when it can be shown that the invention for which a patent has been obtained is not that of the patentee, his patent is worthless, and will secure him no monopoly. But it must be observed that the *onus* of proving this lies on the respondents, for the patent itself is *prima facie* evidence of originality. See as to this *Russell v. Chrichton*, 19th June 1838, 16 S., 1155. In point of fact, this

must be so, for otherwise the advantages of letters-patent would be very elusory; in every case of infringement the patentee would have to establish the originality of his invention, and the same proof would have to be repeated as often as new contraventions of his rights had to be repressed. Starting then from the presumption raised by the letters-patent, the real question comes to be, Have the respondents succeeded in proving that the invention patented was not that of the petitioner?

"Now, after carefully and anxiously weighing the evidence, the Sheriff-Substitute has come to be clearly of opinion that the respondents have entirely failed in establishing their contention. In this, as in other inventions of a mechanical kind, the root or germ is often to be traced back to previous inventions, and many surrounding appliances often exist to which it bears a certain resemblance. Yet this is no objection against its originality, so long as the application is new, or the improvement marked. The men who invented moveable types, patent floats, or breach-loading rifles, were not the less entitled to originality because their inventions were improved applications of appliances already known in less perfect forms. It is necessary to keep this principle in view in the present case; because otherwise much of the evidence led by the respondents might seem to have a weight beyond its real value. It would appear that for some time past various devices for expanding tubes were in operation in the trade—one patented as Dudgeon's being very much used. They all, however, were found to labour under certain grave disadvantages, and it is plain there was room for the efforts of a successful inventor. As far back as the year 1867 the petitioner, it appears, had hit upon what seemed a plain improvement, viz., that which constitutes the principle of the invention of his patent. The mode of best applying this principle he improved from time to time; and by April 1868 he had got a tool made in Dixon's Ironworks, in which it was so well applied as to be used with great and obvious advantage. Still further improvements suggested themselves, and at length, in August following, he lodged his provisional specification, and in February 1869 the final specification, when the patent was sealed. In all these, from first to last, the principle was entirely the same—the variations constituting the improvements being simple in the details. Up to the date, at least, of the provisional specification, no other person had hit upon or utilized the petitioner's discovery; and therefore he is plainly to be considered the original inventor.

"On the other hand, it would appear that the respondents had likewise come to be aware of the imperfections of the existing tools, and particularly those of Dudgeon's patent, one of whose tools they had purchased. It would then appear that they set about making some improvements, or attempted improvements, of their own, and in one way or another ended with producing the tools for the making of which they are sued under the present action.

"Now, assuming for the moment that the respondents, without any hint from the petitioner, had, by following out their own investigations, arrived at the same results in substance as did the petitioner, the question arises, Would this entitle them to impeach the petitioner's patent? Certainly not—unless, indeed, they could show that they had made their invention public before the petitioner lodged his provisional specification. For in

point of fact the monopoly which a patent confers is granted in the interests of the public; and he only is entitled to such patent who first makes his invention public. To fall upon a new invention, and to keep it secret, benefits no one. It is not, therefore, the priority of invention, but the priority of discovery, in which the public is concerned. (See *Smith v. Davidson and Wilson*, March 11, 1857, 19 D. 601.)

"But it does not appear to the Sheriff-Substitute that the facts disclosed in evidence warrant even this view in the present case. There is really no evidence of even simultaneous invention. It would rather appear that the respondents got their idea of the tools they are now interdicted from making from the petitioner's invention, and that they only succeeded in making them after the provisional specification had been lodged.

"The second ground of defence is—that the petitioner actually purloined from the respondents the very invention which he now seeks to interdict them from using. The Sheriff-Substitute cannot but regret the incident which they have laid hold of to support this allegation, reflecting as it does anything but credit on the conduct of the petitioner's son, and saying very little for the workmen who did not at once report such proceedings to their employer. But it does not appear that the petitioner was himself any party to this affair, and—what is of still more importance,—it is clear that it has no bearing on the present question. The alleged purloining took place long after the provisional specification had been lodged, and therefore could have nothing to do with priority of invention. It was argued, no doubt, that the final specification differs greatly from the first, and that it was just the idea caught from the respondents' draft that enabled the petitioner to make the changes in the latter. The facts, however, do not come up to this. It must be observed that so long as the original specification clearly embodies the principle, it is quite legitimate to make in the final specification such alterations in detail as may seem necessary; and it does not appear that in the present case there is any greater difference between the one specification and the other than this amounts to. Even if it could be shown that the respondents had arrived at the same results with the petitioner before his final specification was lodged, this would avail them nothing unless they could also show that the second specification was not a legitimate expansion of the first, or that they had made their invention public before the first specification was lodged. The Sheriff-Substitute is unwilling to moot the question at all, but if it were necessary for the decision of the case, he would rather be inclined to the opinion that the respondents had unwarrantably possessed themselves of the petitioner's invention, than that the petitioner had purloined their diagrams to enable him to complete his final specification.

"The last ground relied on by the respondents, viz.—that the improvements on which the petitioner takes his stand as having been infringed by the respondents do not fall under his patent, does not appear to rest on any solid foundation. If these improvements, as they are termed by the respondents, are not covered by the specification, it is difficult to see what is covered by it. All the figures annexed to the specifications are mere illustrations of the same principle. They differ in details of drawing; but that is of no moment. The

invention is one; the applications may be various, and any one who contravenes the patent in one of its applications is guilty of infringing of the monopoly, and ought to be interdicted.

"In conclusion, the Sheriff-Substitute would remark that in dealing with the evidence, and more particularly the productions, he has, in regard to the construction of the words of the specifications, and the question of identity or non-identity of the tools, been guided by his own judgment; but has been glad to find it confirmed by the weight and general drift of the scientific evidence. He grounds his judgment in the following propositions:—The patent is *ex facie* proof of original invention; the general drift of the evidence supports this presumption. Simultaneity of invention cannot avail against priority of discovery; the respondents have since the date of the patent made and used tools of the kind falling under its monopoly without license from the petitioner; he is therefore entitled to interdict as craved."

The petitioner pleaded (1) That being the inventor and patentee of improvements in tools or apparatus for expanding and cutting tubes and metallic rings, he had the exclusive right, by himself or those duly authorised by him, of making, using, and vending the same. (2) That the respondents having infringed the petitioner's rights, and having refused to desist from so doing, he was entitled to interdict against them as craved. And (4) that the right to the invention in question being recognised and secured by the letters-patent founded on, the defenders could not competently challenge that right in the present action.

The respondents pleaded in answer (1) that they were entitled to be assoilzied, having in no way infringed the patent. (2) That the pursuer was not entitled to interdict, as not being the true and first inventor of the improvements in question. And (4) that the pursuer having fraudulently, collusively, and improperly acquired and abstracted the defenders' improved tube expander, or the drawing or tracing thereof, his right or supposed right to the same under the alleged letters-patent was void, and the same should be disregarded, as giving him any ground for asking the interdict craved.

Authorities—Coryton on Patents, 92, 93, 94, 99 and 259; *Newall v. Elliot*, 27 Law Jour. (C. P.) 337; *Hously v. Campbell*, March 6, 1843, 2 Bell's App. 44; *Carpenter v. Smith*, 9 L. and W. 300; *Sykes v. Wilson & Sons*, Feb. 2, 1866, 4 Macph. 350; *Peun v. Bibby*, Nov. 1866, 2 Law Rep. C. App. 127; *Macnee and Others*, June 12, 1855; *Peale and Mandatory*, Feb. 23, 1863.

At advising—

LORD JUSTICE-CLERK—In this case we have had the advantage of a very full and a singularly able argument from the bar. The two questions that have been argued were, in the 1st place, whether the defenders (the present appellants) Dubs & Co. were in truth the inventors of a material part of the improvement claimed in the specification, and whether (for in truth the allegation comes to that) the pursuer Thomson pirated and purloined that part of his invention. The 2d question is, whether the invention itself had been publicly used before the date of the enrolment of the provisional specification.

In regard to the first, the allegation is, and there is a great deal of evidence on that matter, that the particular implement which is said to be a material part of the general invention was invented and

drawn in the office of the appellant before the date of the final specification. The allegation is that the provisional specification did not indicate these improvements at all, and that they only appeared in the final specification in February 1869, after the drawing had been purloined from the office of the appellant.

The nature of the invention is simply this—that whereas previously the mode of fixing the tubes on the boiler was performed under the patent of Richard Dudgeon, by means of a tapering or conical rod which worked upon certain cylinders, and thereby the cylinders were pressed against the sides of the tubes, the present invention performs the same result in a more perfect way, in this respect, that under Dudgeon's patent the cylinders were unequally protruded or pressed out, the result of which was that they came in contact with the tubes unequally—part of the surface of the cylinders coming in contact with the tube before the other—and therefore the work which they made was unequal, and in order to remedy that Thomson's invention or improvement consists in this, in the first place, that there is a reverse cylinder—a cylinder which is to expand those that are to press upon the tube, meets the others reversely, and those which were complete cylinders in Dudgeon's patent are now shaped conically, so that when the one is pressed against the other, the surface (as I understand it) of these cones is a plane, and comes in contact on every part with the tube at the same time. That is effected, in the first place, by the shape of the cylinder being made conical, and, in the second place, by the reverse cone meeting these, and in that way making their surface a plane. But, in addition to that, there is, instead of percussion, which was necessary under Dudgeon's patent, the application of a screw, the result of which is that without any danger from fracture of the tubes or the machinery, the same result is more perfectly obtained. That may not be a scientific, but I think it is a sufficient explanation of the general features of this alleged invention. Originally, under the description in the provisional specification, the mode of keeping the expanding cones in their place was by letting in one end of what are called slots, and dove-tailing them together. It was necessary to have some mode of doing that, and that was the mode described and indicated in the provisional specification. It was not necessary, however, in the provisional specification even to have gone so far. But the ultimate specification states two methods—1st, the one that had been indicated in the provisional specification—of dove-tailing the ends of these expanding cones in the slots; the other, a mode by using a band of india rubber at the base of the cones, or at one end of the cones, and a piece of wire at the other; and in the ultimate specification these two modes are stated as part of the method in which the substance of the invention may be put to practical use. Now, it is said that that last improvement—the alternative in the specification—was the invention of Dubs; and a great deal of evidence has been led upon that. It is said that it was purloined by the son of the pursuer, and that that accounts for its finding its way into the ultimate specification. I don't think it necessary to give any opinion on that matter. The evidence on that subject is very conflicting. It is certainly quite clear that the son of the pursuer did take away a drawing on which a similar machine was delineated,

with similar appliances for keeping the expanding cones in their place. That is certain. It is said, on the other hand, that that had been long ago anticipated by the pursuer himself; and it is said that No. 11, which is one of these models that we have here, was unquestionably made in April 1868, long before the drawing is said to have been in existence. I should be sorry to have to decide between the conflicting statements on these matters. There is a great deal of evidence both ways, and the evidence is not only conflicting to a certain extent, but is utterly irreconcilable. And therefore, putting that aside, I gladly fall back upon the more general question, which is whether these two modes of keeping the expanding cones in their places was a material part of the invention: and I am very clearly of opinion that it was no material part of the invention; that the two modes described were mere mechanical equivalents of each other, and mechanical equivalents as to the mode of carrying out that new adaptation of the general mechanical appliances in which the invention consists—the invention consisting substantially, first, of the reverse cone, and, secondly, of the application of the screw to the reverse cone so adjusted. The law upon that matter is perfectly well settled now, that you cannot by the mere adoption of a mechanical equivalent for a portion of a patent process, use a process or a machine without committing an infringement. It sometimes may be a difficult enough question whether what is used is substantially a new adaptation, or whether it is only an adaptation of known mechanical forces, but that is not a question to be determined in this case; and I am quite clear that the use of an india-rubber band in order to keep these expanding cones in their places is only one, not of two, but of a great number, of mechanical contrivances that might, according to the will or convenience of the user of the machine, be adopted for that purpose. But I think here that no mechanical contrivance of that kind to attain the simplest result possible would entitle the party to use the substance of the invention—the reverse cone, the screw, and the shape of the expanding cones—in violation of the patent of the pursuer. I need not go farther into the law on that matter. I don't apprehend that there is any doubt on the general principle, the question being, Is it a mechanical improvement or a mechanical novelty? Is it new, or is it only an equivalent? In this case I am quite clear that it is only an equivalent. There seems to be great doubt whether it be an improvement or not, but at all events, I don't think it is claimed in the specification as part of the invention, and I don't think it was a material part of the invention, whether claimed or not. In regard to the amount which it is necessary to specify in the specification for a patent, that also is clearly enough settled. There must be rules and instructions given, so that a workman of ordinary skill may be enabled, from the description to use the patent if it be for a machine, or for a combination of mechanical appliances, to put them together and use them for the purpose of the patent. That is required, and it is all that is required. And I apprehend that in pointing out these matters, either the slots in the first alternative, or the india rubber band in the second, were necessary to enable the workman to make the machine doubtless, but certainly did not supersede or exclude other mechanical appliances with the same object in view. Therefore it

is quite unnecessary to consider whether the defenders Dubs & Co., really invented this mode of keeping these expanding cones in their places. I don't think it signifies whether they did or not. They were not the inventors of the substance or the material part of this patent process or patent machine. As to the other matters, they were merely equivalents for each other, and I don't think Dubs was entitled to use the whole patent process even if it were true that he was the first to light upon this mode of keeping the expanding cones in their places. The second point is, whether this invention itself—I mean the reverse cone, and the screw, and the conical shape of the expanding cones—was used publicly before the date of the provisional specification in August 1868. Now, there is no doubt at all that that was not in specific form stated on record, and probably if proof had been led in regard to it specifically, it might have been excluded. As it is, I don't know that any proof was intended to be led upon it; but the proof which has been led raises the point; and Mr Watson candidly admitted that he could not object to our drawing the legal results from the evidence which is before us. But we must not leave out of view, in considering this, that it is a case stated in defence, and which the defender is necessarily the person bound to prove. The *onus* lay on him of showing, and indeed of specifying, the former public use which he alleges of this patent invention. There is no specification in the record of that, and what I understand he says he has proved is, that two machines or two instruments of this kind, were sold to the Caledonian Railway, and sold to and used by the Railway Company prior to August 1868; and he also says that in Dixon's work the whole of these instruments have been used for at least three months from April to August 1868. In the first place, as regards the use in Dixon's work, I think we cannot look at that at all. It is quite clear that these were trials. The use that was made of them was no doubt known to the workmen, but it was not public use. The very purpose for which Thomson applied to Dixon's people for leave to use their work for experiments in this matter, was in order that they might be able, without having the matter made public, to perfect the invention which he thought he had made; and the use was given for that specific purpose, and for no other. None of the workmen imagined that this was an ordinary thing in the market at the time these various improvements were being made. The footing on which the machines were used on the boilers was notorious in the work, although they were no doubt used in the ordinary way. I think the authorities are quite distinct that a long course of experiment which can only be satisfactorily done in the practical work to which the invention is to be applied, and upon the full scale of ordinary work—a series of trials of that kind do not constitute public use, and do not deprive the patentee of the benefit of his invention or labour. It would be very hard if it did. The Caledonian Railway matter stands in a different position, for certainly if Thomson had sold one of these instruments to the Caledonian Railway before the date of enrolling his provisional specification, there can be no question, as was admitted by Mr Watson, that he would have lost the benefit of his patent. But I am not in the least convinced that anything of the kind happened. My strong impression is that

nothing of the kind happened, because it seems to me, so far as I can read the evidence, that although it is perfectly true that two of these instruments were sold to the Caledonian Railway, it is not proved that they were sold before the date of the provisional enrolment. I think it is proved that they were sold after the date of the provisional enrolment. Goodfellow says that one of his first tube expanders was brought to the works by the pursuer in the beginning of 1868, and he goes on to say that they bought one, but he does not say they bought it at the time it was brought for exhibition, nor does he state at what date he bought it. He goes on, however, to say that after trying it he found it was imperfect, and he made a design for one which is No. 24. He says there was a variety of drawings of No. 24, dated in 1868, without any month specified, but it seems that upon one of them the date of July 1868 was found. Heron says that it was not in the beginning of 1868, but in May or June 1868, that the pursuer's expander was tried, and then he says that No. 24 was made in October 1868; and M'Kirby says he made No. 24 from drawings which he got in October 1868, and that the second of the two instruments that were furnished by the pursuer was got in January 1869. From all this I infer that Goodfellow is entirely mistaken in the date that he attributes to the drawing of No. 24, that he got the first of these tools after August 1868 and before October, that having tried it after the patent had been enrolled, and finding that it did not altogether answer, he then made the drawings of No. 24, which he gave to the fitter who made the tool in October 1868, and that it was in January 1869 that the second of these tools was furnished. That is the impression made on my mind, and it is greatly confirmed by the two letters appended to the proof, in which the manager of the company says 'we got two of these tools, but we paid a royalty at the time,' which seems to imply that the patent was in existence at the time. But whether that be so or not, it clearly lay on the defender to clear that up, for there could be no difficulty in ascertaining whether the purchase was made and the royalty paid. We have nothing of that kind. Therefore I think the defender has failed to prove the prior use on which this plea is founded.

These are the only two matters which have been argued, and on these I am of opinion, first, that that which is said to have been purloined from the defender was no material part of the invention, but was only a mechanical equivalent for things that were part of the specification, and, in the second place, that it is not proved that the invention itself was publicly used prior to the date in August 1868 when the provisional specification was enrolled.

I am therefore for adhering to the Sheriff's judgment.

LORD COWAN—On the leading question to which your Lordship has referred, I quite concur in the view that your Lordship has stated, and all the more that substantially they are the views on that part of the case that are embodied in the very useful and able note of the Sheriff-Substitute. There are other points that he disposes of which were not argued before us. As to the question stated by Mr Balfour—which does not seem to have been embodied in the record in the inferior court, and which is not referred to by the Sheriff-Substitute

in his note—there might have been room for saying that it ought not to have been made the subject of debate in this Court, and that some proof might have been necessary upon it. But we are freed from all difficulty as to that by the frank admission of Mr Watson for the respondent, who did not object to the competency of its being raised on the proof before us. That question is whether there is evidence of prior use of this invention—prior, I mean, to the date of the provisional specification in August 1868. I entirely concur with your Lordship in holding that that defence must be supported by the party who alleges that there was prior use so as to destroy the patentee's right; and had the case been tried in the Jury Court, it would have been an issue to the precise effect I have stated, taken on the part of the defender. That being the state of the question as put to us, all we have to consider is, whether that issue has been proved or has not been proved, so as to support that defence. It is an issue of fact. There is no law embodied in it, and we just return our verdict on the proof as it is presented to us in these papers, as the jury would have done on the parole evidence led in support of it had there been a jury trial, and my opinion is in accordance with the view stated by your Lordship, that the defender has failed in that issue, and that had it been before a jury the verdict ought to have been given in favour of the patentee.

LORD BENHOLME—Your Lordships' judgment in this case expresses entirely my opinion. The case has been argued in a very able and exhaustive way, and our judgment is placed upon grounds that are to my mind perfectly satisfactory.

LORD NEAVES—I quite concur.

Their Lordships found the respondent entitled to expenses.

The Court pronounced the following interlocutor:—

"Find that the appellants have infringed the rights conferred on the respondents by the letters patent libelled: Find that the appellants have failed to prove that any material part of the invention classed in the said letters patent was invented by the appellants, or was not invented by the respondent. Find that the appellants have failed to prove that any material part of the said invention claimed was publicly used prior to the date of the said letters patent; Therefore dismiss the appeal,—affirm the judgment appealed against: Find the appellants liable in expenses in this Court, and remit to the Auditor to tax and report, and decern.

Counsel for Appellant—Solicitor-General and Balfour. Agents—Webster & Will, S.S.C.

Counsel for Respondent—Watson and Asher. Agents—Macnaughton & Finlay, W.S.