

From the point of view of the public I must say that it appears to me that it would be an almost intolerable nuisance for foot-passengers to be stopped or warned in passing through the foot-passengers' gates at level-crossings when a train is due but not in sight, in the same way as requires to be done in the case of vehicles and cattle, for the passage of which large gates have to be opened and the transit of which across two lines of rails is necessarily a comparatively lengthy and troublesome proceeding.

I accordingly think the Lord Ordinary's judgment should be adhered to.

**LORD PEARSON**—While I agree in the result arrived at by the Lord Ordinary, I think it right to add that I regard this as a very narrow case in both its branches, and my doubt as to whether it can be withheld from a jury without at least some risk of injustice has not been entirely removed.

The **LORD JUSTICE-CLERK** concurred with **LORD ARDWALL**.

**LORD LOW** and **LORD DUNDAS** were sitting in the Valuation Appeal Court.

The Court adhered.

Counsel for the Pursuer (Reclaimer)—**Morison, K.C.**—**D. P. Fleming.** Agent—**Hugh Fraser, Solicitor.**

Counsel for the Defenders (Respondents)—**Hunter, K.C.**—**Hon. W. Watson.** Agents—**Hope, Todd, & Kirk, W.S.**

Friday, March 19.

## FIRST DIVISION.

[**Lord Salvesen, Ordinary.**]

**LYNCH AND OTHERS v. PHILLIPS & COMPANY.**

*Patent—Infringement—Combination of Known Elements—Validity—Claim—Old and New—Ship's Roaster.*

In an action of interdict by the patentee of a ship's roaster against an alleged infringer, *held* (1) that, though the elements of the patent were all old the patent was not invalid on the ground of anticipation, the combination of the elements being novel and meritorious; and (2) that as the patentee's claim was not for a new part in an old combination, but for a new combination of old parts, "substantially as set forth," it was not necessary to have stated in the claim what was old and what was new, provided the patentee had shown by his claim what was the new combination, the combination itself being both the merit and the novelty—*Foxwell v. Bostock*, 1864, 4 De G. J. & S. 298, distinguished and commented on.

*Observed per the Lord President*—"I cannot help saying that in my opinion there is really nothing left of

*Foxwell v. Bostock* as applied to a combination patent."

*Patent—Combination—Infringement—Mechanical Equivalents.*

In an action of interdict by the patentee of a ship's roaster against an alleged infringer, *held* that, though the respondent's roaster might differ in particulars, as he had taken by slight variations or mechanical equivalents the substance of the complainant's invention, which was the novel and meritorious combination, he had infringed the patent, and interdict *granted*.

On 10th January 1908 **Thomas Massey Lynch, engineer, Waterloo, Lancashire, and Henry Wilson & Company, Limited, ironfounders, Cornhill, Wapping, Liverpool**, brought a note of suspension and interdict against **John Phillips & Company, ship-furnishing ironmongers, Glasgow**, in which they sought to have the respondents interdicted from infringing letters-patent, Nos. 8699 of 1897 and 3524 of 1898, granted to the complainants for "improvements in culinary roasters."

The following narrative is taken from the opinion of the Lord Ordinary:—"The complainants are grantees of letters-patent obtained by them in 1897 and 1898 for improvements in culinary roasters, and they seek interdict against the respondents infringing same. Infringement is denied, and the validity of the letters-patent is challenged on the usual grounds.

"The two grants of letters-patent may for practical purposes be treated as one, for the first patent applied for was not accepted until 2nd April 1898, six weeks after the date of the application for the second. The substance of the invention disclosed in the application of 1897 was a special form of roaster suitable for use on board ship, and consisted of a closed oven with front doors, within which there was a fireplace, vertical spits secured at both ends, and adapted to be rotated by clockwork or other mechanical means. In the invention disclosed in the 1897 specification the spits were not capable in one case of being removed away from or nearer to the fire, and the devices for doing so in the other cases were not of a satisfactory kind, and the patent of 1898 dealt mainly with improvements in the design of the spits by which these defects were obviated. The form of the casing, however, and the position and arrangement of the fireplace within it are the same in both specifications. The fireplace extended across the whole breadth of the casing at the back, the front portion forming the roasting chamber. The floor of this chamber consisted of a plate extending from the grate bars to the front of the apparatus, and is described in the earlier specification as an ashpit. This plate in the 1897 patent served as a drip-tray, but in the 1898 patent it formed merely the support of a drip-tray, which could be pushed in and drawn out in recesses in the frame. The design of the casing was such that it could be fitted into a corner, the necessary access to the roasting chamber

and to the fire being obtained from the front and from one or other of the sides.

“No roasters made according to the 1897 patent were ever sold, the patentees having evidently become convinced before the publication of the specification that to make the invention a success it was necessary that the vertical spits should be rotated by a mechanism supplied from an electrical motor or otherwise; and that provision should be made for moving the spits and their contents from and up to the fire. Hence the improvements contained in the patent of 1898, which consisted in a special construction arrangement and mode for operating the spits as therein described. In this patent the spits were described as consisting of a bow frame, or the like, having cross attachable pins or screws on which the meat would be secured, and the lower end of the frame would work in a pivot, whilst the upper end would have a shaft upon it, revolving in bearings on the upper part of the frame. The device for moving the spits between the fire and the front of the roaster consisted of a carriage on rails or wheels; and a similar arrangement at the top with mechanism for rotating the spits within the frames in all positions, and capable of being thrown out of gear by a simple lever action.

“Only one vessel was fitted with a roaster made in exact accordance with the drawings appended to the 1898 specification, for the complainers at once devised certain minor improvements. For instance, they provided a means for drawing out the gravy tray through an opening in the casing without opening the oven doors; they removed the mechanism by which the spits were rotated from a position on the outside of the upper part of the casing to one inside the casing frame at the top, where it could be protected from smoke and dirt; and the frame which connected the two trolleys, or other means for moving the spits to and fro, was modified from a cage of four vertical bars to a single stay bar. These improvements and simplifications were suggested in the course of the manufacture of the roasters. The complainers retained, however, the substance of the patent of 1897, which I take to consist of the special form of casing, with the open fire within, and the roasting chamber between the fireplace and the oven doors, in which the vertical spits secured at top and bottom and capable of rotating were arranged; and the substance of the patent of 1898, which I take to consist in the improvements in the spits and the mode of actuating same already referred to.

“I hold it proved that prior to 1897 no self-contained roaster of the kind described in the complainers’ first patent had ever been used on board ship. The ordinary roasting jack, familiar in domestic use, in which the meat was suspended on a hook and rotated by clock-work, could not be utilised on board ship in consequence of the movement of the vessel, and roasting was accordingly carried on in practice in ovens to which the heat was transmitted through iron plates. This method was

open to some objections,—for instance, the rolling of the ship was apt to transfer the gravy from one kind of roast to another; and as passenger ships became more and more luxurious a demand grew up for an apparatus in which the operation of roasting could be carried out before an open fire and with arrangements under which different kinds of meat could be roasted at the same time and so that the gravies were kept separate. This demand the complainers’ invention was designed to satisfy, and having in view the relatively small number of vessels for which elaborate cooking on an extensive scale was required, the complainers’ invention has met with a large measure of success. During the ten years that have elapsed since the publication of the patent about a hundred roasters of the complainers’ model have been supplied by them, their customers including all the large ocean-going passenger lines. The respondents, who are rival traders, have themselves had inquiries from ship-owners to supply patent roasters, and they have in fact supplied at least three vessels with such roasters. For the first two they placed the orders with the complainers; but having formed the opinion that the complainers’ patent was bad, or that it was so limited that it might be evaded by varying the parts, they took upon themselves to supply a similar roaster to a steamer called the ‘Avon.’ They were at once challenged for doing so, and as they maintained their right to manufacture roasters according to the pattern supplied to the ‘Avon,’ the present proceedings were instituted to determine the question.”

The complete specification of the 1897 patent stated—“This invention has reference to roasters for roasting meat, poultry, game, and the like, wherein the meat or other viand is roasted before a fire; and the chief object of the present invention is to provide improved apparatus suitable for use in all respects on board ship. . . .

“Having now particularly described and ascertained the nature of this invention and in what manner the same is to be performed, it is to be stated that the invention is not restricted to this particular arrangement of apparatus or the construction or form of its parts shown in and set forth with reference to the drawings, but that what is claimed in respect of the herein described roaster is:—(1) A roaster, comprising a casing, a fire within same, and a chimney or gas and smoke outlet, closing in doors, a chamber in front of the fire-place having within it trees or spits on which the viands are roasted and supported so as to prevent swinging freely about; substantially as set forth. (2) In a roaster, the arrangement of a fire-place at the back with a chimney above and ash-pit below, extending from directly under the bars to the front, and separated from the roasting chamber above by a partition; substantially as set forth. (3) In a roaster, having within it a fire-place, and adapted to act as described, the spits and their supports arranged and operating substantially as set forth. (4) In a roaster of the

kind described, the arrangement of chimney and ventilating valve; as set forth. (5) In a roaster of the kind herein referred to, the grate comprising the fire bars, the front grate bars, catch plate, supporting frame and ashpit enclosed behind by the plate and above by a plate; as set forth with reference to and shown in the drawings. (6) The roaster, having parts arranged, combined, and adapted to operate, as shown in and set forth with reference to the drawings."

The claims in the 1898 patent were:—

"(1) In a ship's or analogous roaster, a containing case having within it an open fireplace, and a vertically disposed frame, adapted to be moved up to and away from the fireplace, and carrying in or on it a revolvable or moveable spit; substantially as set forth. (2) In a ship's or analogous roaster, a vertically disposed spit frame comprising rigid vertical bars and a base having rollers; railways on which said frame runs up to and away from the fire; and a spit carried by bearers above and below within said frame, and adapted to revolve in said bearings; substantially as set forth. (3) In a ship's or analogous roaster, a rigid vertically disposed spit frame supported and adapted to move to and fro on its lower end, and supporting within it by lower and upper bearings the upper and lower ends of a spit; and a horizontally disposed rotatable shaft arranged in connection with the upper part of the spit frame; and gearing between said shaft and the upper part of the spit, by which said spit is rotated from said horizontal shaft; substantially as set forth. (4) In a ship's or analogous roaster, the combination of a rigid spit frame with rollers; the spit, the lower and upper ends of which are mounted and revolve in bearings in said frame; and rails on which the rollers may run to and fro in the roaster; substantially as set forth. (5) The roaster consisting of the parts arranged and adapted to operate particularly as set forth with reference to and shown in the drawings."

The respondents denied infringement and pleaded, *inter alia*—"3. The prayer of the note should be refused, in respect that the letters-patent are invalid for the following reasons, viz.—(1) The specifications founded on are not sufficient and do not sufficiently distinguish between what is old and what is new; (2) The claims in said specifications are too wide; (3) The complainers' alleged inventions are not novel; (4) There has been anticipation and prior publication of the alleged inventions founded on; (5) The subject-matter contains no invention and involves no ingenuity; and (6) The alleged inventions are of no utility."

On 9th July 1908 the Lord Ordinary (SALVESEN), after a proof, granted interdict as craved.

*Opinion.*—" . . . [After the narrative *ut supra*.] . . . It sufficiently appears from what I have already said that the complainers' invention has, in my opinion, sufficient utility to support the patents,

provided they are not open to challenge on other grounds.

"The respondents maintain that the patents are bad on the grounds (1) of want of subject-matter, and (2) of anticipation; and they found upon a whole series of prior patents from which the state of the art with regard to culinary roasters prior to 1897 may be gathered.

"It is not necessary that I should examine these specifications in any detail. Assuming in the meantime that the complainers' patent is for a new combination, I find nothing that at all resembles it in the various inventions founded on. The idea of a spit rotated by hand or by mechanical means was of course old. Means had also been devised by which such spits, with the meat upon them, could be shifted to a greater distance from the fire. Some of the specifications reveal forms of casing so arranged that the fireplace and roasting chamber formed part of one apparatus. In these cases, however, the design was entirely different and quite unsuited for use on board ship, and in no case had the suitability of the apparatus for use in a moving cooking chamber been considered. Nowhere is a vertical spit described which was fixed at both ends; and in some of the inventions founded on the heat of the fire did not operate directly upon the meat to be roasted, but was transmitted through iron plates as in an ordinary range-oven. In the apparatus patented by Jubber it is true the fire is constructed so as to be open on three sides, and hanging spits actuated by a smoke-jack in the chimney are shown on the drawings, but the apparatus described is apparently not self-contained, and, in any event, it would require great adaptation and considerable ingenuity to fit it for the purpose which the complainers' device serves. Besides, none of the previous designs shows a fireplace with an ash-pit extending to the front of the casing, the top of which, whether accidentally or not, forms such an important feature of the complainers' invention. Even if the patentees had had before them all the information that has been collected for this case, I think they could not, without much experiment, and without the application of that limited amount of ingenuity which suffices to support a patent for a new combination, have devised the patented article. I am accordingly prepared to negative both these contentions.

"As usual, however, the validity of the patent is imperilled by the claims. In the 1897 patent there are no less than six claims, although the complainers' case is that five of them mean substantially the same thing. Even on this footing the respondents attack the patent on the ground that the first claim is too wide and would cover other inventions, as, for example, the patent by Lake of 1875. There is this much force in the objection, that if the words at the end of the claim 'substantially as set forth' are omitted, Lake's apparatus seems to contain all the elements which are set forth in claim 1. The two combinations, however, are essentially

different. Lake's is described as a vertical metallic cylinder; and apparently he never contemplated that it might be made of a rectangular shape. His fireplace, besides, was not within the casing, but was fitted to an opening made for its reception in the cylinder, and means were provided for removing it from the cylinder in which the vertical spit was placed; and with this form of apparatus I do not see how more than one spit could have been rotated by the mechanical device described, which consisted of a special form of smoke-jack. There are other material differences which I do not detail, because if I am right in holding that the claim is limited to the special combination described in the specification, there can be no doubt that it is an entirely different combination from the one which Lake patented. Claim 6 is admitted to be synonymous with claim 1; and as regards claims 3, 4, and 5, although in form they are special claims, I think they fall under Lord MacLaren's dictum in the case of *Van Berkel*, S.C. 1907, p. 165, and 'when fairly read mean only the use of the separate parts in connection with the other parts of the combination.' This is clear enough as regards 4 and 5, which are preceded by the words 'in a roaster of the kind described'; but I think the words in the third claim 'any roaster having within it a fireplace and adapted to act as described' have really an equivalent meaning. The second claim is undoubtedly in a different position, because it claims generally in any roaster the arrangement of a fireplace at the back, with chimney above and ashpit below, extending from directly under the bars to the front, and separated from the roasting chamber above by a partition substantially as set forth. Accordingly, if an arrangement of this kind had been in use prior to the patent, this claim would have been invalid. It is conceded, however, that this was a novelty; and the claim cannot be attacked on the ground of anticipation. It is said that in the specification itself there is nothing to indicate that this arrangement was any more novel than the other devices described; but that is sufficiently disclosed by the fact that it is the only thing for which there is a separate claim. I am accordingly of opinion that these objections fail.

"The 1898 patent also embraces five claims. The first four are all limited by the initial words 'in a ship's or analogous roaster.' What the word 'analogous' exactly means in this connection it is difficult to understand; but I apprehend that a claim will not be invalid because a meaningless adjective had been introduced. In such a roaster what is claimed in the first claim is a vertically disposed frame adapted to be moved up to and away from the fireplace, and carrying in or on it a revolvable spit substantially as described; and I fail to see that the detailed explanations of the various parts contained in the three following claims differentiate these claims in any way from the first. If so, the improvement claimed is not open to objection on the score of anticipation; for although various

forms of spit are disclosed in the earlier patents which could be moved up to and away from the fireplace, and although a frame had been devised for carrying a revolvable spit, the particular combination of parts was entirely novel, and certainly had not been thought of as specially suitable for a ship's roaster. In particular, the device of a trolley seems never to have been thought of as a means of shifting the frame backwards and forwards. I am therefore of opinion that the objections to the first four claims fail, and the fifth, which is the usual omnibus claim, was not subjected to any criticism.

"There remains the question whether the respondents have infringed the patent. There can be no doubt that the ship's roaster, as actually manufactured by the respondents, is in all material respects identical with that which the complainers were at the time in the habit of supplying under their patent. The respondents, however, maintain that the apparatus so supplied was substantially a new combination which had not been protected; and they are undoubtedly entitled to demand that the comparison should be made between the invention as patented and the roaster which they supplied to the 'Avon.' When this comparison is made, a number of differences are disclosed. Thus the frame carrying the spit is described in the 1898 patent as consisting of four vertical bars, and in another part of the specification as consisting 'of a number of frame bars or standards,' whereas the complainers now use a single stay bar, and the respondents also one bar divided into two branches at the foot. Great stress was laid by the respondents upon this difference, which undoubtedly constitutes an improvement. It was, however, in my opinion, a fairly obvious variation of the original device, and was adopted by the complainers themselves in the course of manufacture almost from the first. Similarly, the respondents use a somewhat different method of connecting the stay bars or frame with the mechanism by which it is moved backwards and forwards. In all essential particulars, however, they have, in my opinion, to use the language of L. J. Cotton in *Proctor v. Bennis*, 36 Ch. Div. p. 754, 'taken by slight variations or mechanical equivalents the substance of the patented combination, so as to produce the same result by practically the same means,' and have so exposed themselves to the penalties of infringement. The casing with the special form of fireplace and roasting chamber in front, which was the feature of the 1897 patent, is adopted by the respondents practically in its entirety; and so also the special frame carrying the revolvable spit which is the essential feature of the 1898 patent. It does not help the respondents, even though it be conceded that they have made various improvements on the patented apparatus, as for instance in the drip pans and the means of moving the spit-frame backwards and forwards without opening the doors of the casing and the like. For these improvements, assuming they required invention,

they might conceivably have taken out a patent; but without the prior patentees' consent they would not be entitled to use the original invention. A patent, even for a combination, cannot be evaded by merely grafting upon it improvements, however meritorious. On the whole matter, I reach the conclusion that the complainers are entitled to the interdict they seek."

The respondents reclaimed, and argued—(1) The complainers' patent was invalid in respect that it claimed too much. It claimed the previous inventions of Jubber, Calder, and Lake, and failed to distinguish what was old from what was new. The words "substantially as set forth" did not limit the claim to a claim for a combination only—*Cassel Gold Extracting Company, Limited v. Cyanide Gold Recovery Syndicate*, [1895] 12 R.P.C. 232, at p. 257; *Parkinson v. Simon*, [1895] 12 R.P.C. 403, at p. 411. *Esto* that the patent was for a combination, it was still invalid, for the combination itself was old and the mere improvement of a particular item therein did not entitle the improver to a patent for a new combination—*Curtis v. Platt*, (1863) L.R., 3 C.D. 135, note, 35 L.J. (Ch.) 852; *Clark v. Adie*, (1877) L.R., 2 A.C. 315; *Moore v. Bennett*, [1884] 1 R.P.C. 129, at p. 143; *Harrison v. Anderston Foundry Company*, (1876) L.R., 1 A.C. 574. Claims 1 and 5 were therefore invalid. (2) Assuming the patent was valid, then the reclaimers had not infringed, for the reclaimers' invention was different in essential particulars. The complainers were tied down to the exact mechanism which they had detailed and the reclaimers' invention was different. They, therefore, had not infringed—*Curtis v. Platt* (*cit. supra*); *Proctor v. Bennis*, (1887) L.R., 36 C.D. 740. The respondents' roaster was not a colourable imitation of the complainers' invention, for it was an admitted improvement.

Argued for respondents—The Lord Ordinary was right. The complainers' patent was for a combination, and as such it had not been anticipated. The test was, could a skilled person reading *Jubber* have constructed *Lynch*? Clearly he could not. Claims 1 and 5 were not too wide, for they were limited by the words "substantially as set forth" to the particular uses set forth in the specification, *i.e.*, to the combination. They were therefore valid—*Brooks v. Lamplugh*, [1898] 15 R.P.C. 33, at p. 49. The complainers' patent had not been anticipated, for none of the prior inventions could do what this combination could do. Invention had been applied to old parts, and that entitled the inventor to a patent. In a combination patent, such as this, it was not necessary to distinguish what was old from what was new, provided what was claimed was a new combination—*British United Shoe Machinery Company, Limited v. Fussell & Sons, Limited*, [1908] 25 R.P.C. 631.

At advising—

LORD PRESIDENT—This is an action for infringement of two patents dealing with a ship's roaster. The reclaimers really

could only contend very feebly that there had not been infringement here, and I do not wonder, because I think nobody who looks at the respondents' machine and compares it with the patents can have any doubt that it was an infringement. In other words, I have come to the conclusion upon the facts, without the slightest difficulty, that in the words of Lord Justice Cotton in *Proctor v. Bennis*, L.R., 36 Ch. Div. p. 754, as quoted by the Lord Ordinary, the respondents here have taken by slight variations the substance of the patented combination.

The real argument before your Lordships did not turn upon that but turned upon the validity of the patents. The pursuers' patents were attacked on two grounds. They were attacked first upon the ground that by the only possible construction that could be put upon them they were anticipated. That was the first ground. A good many specifications have been tabled in the case, but eventually I think the only two on which any real stand was made were the specifications of Lake and of Jubber. I do not think myself that there is the slightest ground for holding that either the patent of Lake or that of Jubber anticipates the present patents. I need scarcely say that the thing here is old—that is to say a roaster, which means a device for roasting meat in front of a fire, is obviously old. Accordingly the patent, such as it is, is what is known as a patent for a combination, where the thing itself is old, and the parts, or at least nearly all them, are old, but the combination is new. I mean that is the theory of the patent. That being so, it is, of course, trite law that the question upon the merits is, Is it or is it not a new combination? I would make this remark, which I shall have to repeat when I come to the second argument, that although it is not conclusive, it is certainly a great help to holding in fact that the combination is new and meritorious to find that it will do something that no other combination has been able to do before.

Speaking in general terms, I describe the 1897 patent thus—it is a combination consisting of a self-contained arrangement which contains a fire, a set of vertical spits, provision for mechanically turning these spits, and provision for holding the spits both at bottom and top so that the plane of the spit is always kept in the same relation to the plane of the front of the fire. One can easily see points of utility in that. Being self-contained it allows, first of all, of the heat not being dispersed, secondly, it allows for an arrangement in connection with the gravy, and then the points of the spit being maintained at both top and bottom makes it peculiarly apt for dealing with the class of requirement which is set forth in the forefront of the patent, namely, the roasting of meat at sea. Of course, the idea of roasting meat by twirling joints in front of the fire is almost as old as history. I suppose it was originally done by some form of string before the spit jack turned up, and it certainly was done, as we know from the word, by a small boy called

a turnspit. As time went on there were various devices for turning the spit by means of smoke jacks, bottle jacks, and so on. But one can easily see that if the spit was so disposed that it was free to oscillate, the movements of a ship would be such that the meat would be thrown against the fire. That is my general description of the 1897 patent.

The general description of the 1898 patent is that it has certain features in common with the 1897 patent which I have described, but that, over and above that, and I think making a new and meritorious combination, it also has a provision by which the spits, still maintained vertically, may be approached to or receded from the fire, by that means obtaining this useful result that different classes of meat or game can be roasted at different distances from the fire at one time from another. I mean that one class can be roasted at one distance and another class, say of game, can be roasted at another—an object of utility that is well known to cooks.

Now, as to the alleged anticipations, taking first Lake—that patent it seems to me is not the same combination, because the arrangement in Lake was not an arrangement with a self-contained fire but an arrangement which could be moved to and fro from the fire. Taking Jubber, the fatal point about Jubber is, that although it has a self-contained arrangement, it has oscillating spits, and therefore would have been absolutely and perfectly useless on board ship. Accordingly I have come, without really much difficulty, to the conclusion that these two patents of 1897 and 1898 were new combinations.

The second ground of attack was upon the form of the claim, and on that we had a great deal of argument. I do not think much was said against the claim in the first patent. In fact the only thing that was said that made any impression on my mind was that the claim in the first patent was so worded that it would have included Lake. I agree with the Lord Ordinary that that is not the case. I do not think you can construe it so as to include Lake; I think obviously it is describing a combination perfectly different from Lake. It only professes to be a claim for a particular combination; it does not profess to be a master patent.

But the argument upon which the respondents' counsel most insisted was an argument against the wording of the first claim of the patent of 1898. I feel it necessary to say something about that, because I am not sure I altogether agree with the Lord Ordinary in the way in which he has read this claim. The case on which the respondents particularly founded was the case of *Moore v. Bennett*, 1 Patent Reports 129, in which, in the course of his judgment, Lord Selborne explained *Foxwell and Bostock*, 4 De Gex, F. & G. 310, and the well-known passage in *Foxwell and Bostock* which has been so often quoted to us, viz., that if the combination was old and the thing founded on was truly only a new part of the combination, then the claim of the patentee

must state what is the new part he claims. Now the Lord Ordinary has read this claim as if it were a claim only for a vertically disposed frame, that is to say for a part, and read in that way that would get out of the difficulty. But I cannot so read it, because it is not a vertically disposed frame, but it is a ship's roaster, a containing case having within it an open fireplace, and a vertically disposed frame adapted to be moved up to and away from the fireplace and carrying in or on it a moveable spit. I have no hesitation in reading that first claim as a claim for a combination. But then I come next to consider—Is not that a perfectly good claim as it stands? It is a good claim obviously if it is for a new combination. I cannot help saying that in my opinion there is really nothing left of *Foxwell and Bostock* as applied to a combination patent.

I find nowhere my views better expressed than by Lord Justice Buckley in a case which I do not think was quoted at the Bar, the case of the *British United Shoe Machinery Company v. Thomson*, where he says, as reported in 22 Patent Reports, at p. 198—"I will endeavour to explain in my own language what I understand to be the result of *Foxwell v. Bostock* and the cases which have followed upon it. Assume a known machine. If the invention consists in an improvement or addition to that machine, say a gridiron pendulum which is introduced into a clock, the patentee must indicate and claim the improvement or addition. He cannot claim the whole improved machine. He must say what part of it he claims. But if his invention be for a new arrangement and user of the constituent parts of a known machine in a particular way so as to produce a useful result, then *Foxwell and Bostock* does not apply. In the former case say nine parts are old and one is new, the inventor must say which is new. In the latter case all the parts are old; his invention is not an invention of any one of the parts; his invention lies in so arranging and using parts each and every of which is old, as to achieve some useful result. In the latter case, *ex concessis*, all is old except that no one ever before so arranged and used the constituent parts as the patentee arranges and uses them. In that case, to use the words of Lord Cairns in *Harrison v. Anderston Foundry Company* (L.R., 1 App. Cas. 574, at p. 578), 'the combination itself is, *ex necessitate*, the novelty.'" Lord Cairns in *Harrison v. Anderston Foundry Company* has often been quoted, but I take that very passage where he says—"If there is a patent for a combination, the combination itself is, *ex necessitate*, the novelty; and the combination is also the merit, if it be a merit, which remains to be proved by evidence."

Now here it is obvious that all the parts are old, and I cannot help thinking that the difficulty which sometimes arises arises from the slight confusion of mind into which we are all liable to slip by not remembering that it is one thing to say that a thing is old or new and it is another

thing to say that a combination is old or new. For instance, take a clock. As a clock it is as old as the hills. But you may make a clock in a way that as a combination would be perfectly new. There can be no doubt that the first man who made an electric clock would have a perfectly good patent for an electric clock, although there had been clocks from time immemorial. I think, taking Lord Cairns' judgment, he would have handed in his claim and have claimed nothing but his combination as described. If he had done so, I do not think he could be held to say that he had invented a clock—what he had invented was an electrical arrangement by which the hands are driven, and so on, but the combination itself would be the merit and novelty.

There is another judgment, which is too long to quote, but of which I express my humble approval and admiration. It is the judgment of Lord Justice Moulton in the case of the *British United Shoe Machinery Company v. Fussell & Sons*, in 25 Patent Reports, 631. There is one passage in which he puts this matter of what are the necessities of the form of a claim in a nutshell, although it is in the form of a criticism of the argument of the counsel before him. He says (at p. 651)—“If I were to sum up my criticism of the point which Mr Terrell seeks to make, I should say that a man must distinguish what is old from what is new by his claim, but he has not got to distinguish what is old and what is new in his claim. If the combination which he has claimed and for which he asks a monopoly is novel, that is sufficient.”

Now I entirely agree with that, and applying that to this case I think the combination here was novel. It was a thing made up entirely of old parts, because the spits, trolleys, fire doors, containing case, and gravy dripper in this sense were all old, but they were not arranged in that particular way. Taking again what, as I have already said, I consider is a very useful test—Will the thing do something that has never been done by a roasting machine before? In both of the patents I answer yes. The first patent is doing what has never been done before, namely, keeping in a self-contained machine suitable for placing in a ship, meat at a steady distance from the fire, and the second, while doing what had never been done before except by the first machine, did also something else, viz., gave an appliance which would allow of roasting at one distance from the fire and roasting at another. Therefore it was a new combination. It is different from the case of a man who invents a gridiron pendulum and substitutes it for one part of a known combination. His improved pendulum does nothing except what an old pendulum has done before, or does it a little better. But it is different when you put in something which does not do simply better what an old part of the combination has done before, but gives the combination as a whole the power of doing something which the first combination could not do;

then that seems to me to create a combination. And I think, as I say, that the argument really was based upon a fallacy which I quite confess is exceedingly easy for anyone to drop into, by not remembering that an old thing is one thing and an old combination is another, and a new thing is one thing and a new combination is another. Where the whole thing is new then you are in the domain of what has often been called a master patent. Where it is not that, but where you have not invented a thing for the first time but have merely made a new combination, the result is different. There is a difference between merely improving upon a combination by making one piece of it rather better, and introducing something quite new by which you to a certain extent change the character of the whole combination. That I think is this case. Therefore upon the whole matter I am of opinion that the Lord Ordinary's judgment is right and ought to be adhered to.

LORD KINNEAR—I concur.

LORD PEARSON—I also concur.

LORD M'LAREN, who was present at the advising, gave no opinion, not having heard the case.

The Court adhered.

Counsel for Complainers (Respondents)—Sandeman — Black. Agent — R. Ainslie Brown, S.S.C.

Counsel for Respondents (Reclaimers)—Hunter, K.C. — Hamilton. Agents — Carmichael & Millar, W.S.

Friday, March 19.

#### FIRST DIVISION.

LORD RUTHVEN AND ANOTHER *v.*  
PULFORD & SONS.

(See *Lord Ruthven v. Drummond*, 1908, S.C. 1154, 45 S.L.R. 901.)

*Arrestment—Aliment—Arrestment of Alimentary Income for Arrears of Alimentary Debts.*

The holders of a decree for payment of an alimentary debt incurred in previous years arrested in the hands of trustees the income for the current year due to the debtor from an alimentary fund.

*Held* that the arrestment was valid—*Monypenny v. Earl of Buchan*, July 11, 1835, 13 S. 1112, *followed*.

*Husband and Wife—Joint Estate—Alimentary Fund—Income of Alimentary Fund Destined to Husband and Wife “during their Joint Lives upon their Joint Receipt.”*

The income of an alimentary fund held in trust was destined to a husband and wife “during their joint lives upon their joint receipt.”