adopted made it unnecessary to decide as to this item, but if it were added to the sums with which the trustees have been credited the balance would still be against them if the appellant's statements with regard to the value of the property were established.

I should have contented myself with making these observations, which are sufficient for the disposal of this appeal, had it not been that in the Court below the learned Judges have expressed themselves with regard to the conduct of these trustees and of trustees generally in terms to which I cannot assent. The Lord President, with the concurrence of Lords Mure and Adam, said (15 Sess. Cas. (4th series) 423)—"The conduct of trustees in borrowing money under any circumstances is highly imprudent. If it turns out to be a mistake, it subjects the trustees to personal liability." I do not know whether by these words the Lord President intended to lay down a principle of law or a proposition of fact; the result in either aspect might prove very unfortunate so far as the interests of beneficiaries are concerned. A trustee would incur unnecessary risk (which his duty in no case compels him to do) if he borrowed in order to pay debts prudently and with a reasonable prospect of securing a considerable reversion to the beneficiaries, and he would be justified for his own protection in at once selling, to the destruction of their interests, although no prudent person (himself included) thought it the better course to pursue. But there is really no such rule in existence. All that the law requires from a trustee who has power to sell or borrow is, that he shall follow the dictates of ordinary prudence in adopting the one course or the other, and the question whether he did or did not act prudently is one of fact which must be solved according to the circumstances of each case.

Looking to the terms of Mr Binnie's trust-deed, I see no reason to doubt that the trustees had implied power either to sell or borrow for the purpose of paying debt if the exigences of the trust required it; and I am consequently of opinion that the conduct of the trustees in borrowing and not selling raises a question of prudent management only. If it were not for the unbending rule which they laid down as to the imprudence of borrowing in any circumstances, there might be difficulty in reconciling the views which the learned Judges took of the conduct of these trustees with the considerations which led them to fix the value of the property at £36,748. These were that house property in Glasgow became in the end of 1857 greatly depreciated in value and in many cases unsaleable. In that state of the market I cannot help thinking that prudent men would have been most reluctant to sell if that step could by possibility be avoided. I have thought it proper to make these remarks with no desire to prejudge any question which may arise when the facts are ascertained, but in order to guard against its being supposed that in my opinion the appellant will be necessarily entitled to prevail in this action if he succeeds in proving the value which he has alleged.

I am accordingly of opinion that the interlocutors appealed from, in so far as these concern the appellant, ought to be reversed and the cause remitted to the Court of Session with directions to allow the appellant a proof of his averments with respect to the value of the heritable property, and to the respondents a proof of their averments relating to the circumstances which induced the trustees to borrow on its security. If the appellant had asked in the Court below for the restricted proof which has been allowed him here, I see no reason whatever for supposing either that the respondents would have resisted the motion or that the Court would have hesitated to grant it, and I am therefore of opinion (seeing that the appellant sues *in forma pauperis*) that there ought to be no costs of this appeal.

LORD FITZGERALD—My Lords, I entirely concur in the judgment, and have nothing to add.

The cause was remitted to the Court of Session with directions to allow the appellant a proof of his averments with respect to the value of the heritable property, and to the respondents a proof of their averments relating to the circumstances which induced the trustees to borrow on its security.

Counsel for the Pursuer (Appellant)—Shaw—A. S. D. Thomson. Agents—Scoles & Company, for Marcus J. Brown, S.S.C.

Counsel for the Defenders (Respondents)—Lord Adv. Robertson, Q.C.—J. Shiress Will, Q.C. Agents—Bircham & Company, for Henry & Scott, S.S.C.

Thursday, August 8.

(Before Lords Herschell, Watson, and Fitzgerald.)

WALKER, HUNTER, & COMPANY *v.* HECLA FOUNDRY COMPANY.

(*Ante*, vol. xxv., p. 491; and 15 R. 660.)

Copyright—Design—Infringement—Patents, Designs, and Trade Marks Act 1883 (46 *and* 47 *Vict. cap.* 57)—*Interdict.*

The holders of a certificate under the Patents, Designs, and Trade Marks Act 1883 for the copyright of a registered design for kitchen-range fire-doors, the design being for "a range fire-door with moulding on top, the moulding forming part of range, shape to be registered," applied for interdict against an alleged infringement.

Held (*aff.* the judgment of the First Division) that as the outline of the moulding on the fire-door complained of was an obvious imitation of the registered design, it was an infringement thereof.

This case is reported *ante*, vol. xxv., p. 491, and 15 R. 660.

The respondents in the suspension and interdict appealed.

At delivering judgment—

LORD HERSCHELL—My Lords, this is an appeal from an interlocutor of the First Division refusing a reclaiming-note against an interlocutor of the Lord Ordinary finding it proved that the appellants at your Lordships' bar had infringed the respondents' exclusive privilege of making

for sale fire-doors of the pattern produced, and interdicting the appellants accordingly.

The respondents in November 1884 registered a design, the nature of which was stated in the application to be—"Range fire-door with moulding on top, moulding forming front of range, shape to be registered."

The drawing which accompanied the application showed a rectangular door for a fire-range, with a moulding at the top of it of a form which appears to be known as ogee.

The sole question for determination is, whether a fire-door manufactured by the appellants is an infringement of the right secured to the respondents by the registration of their design? It undoubtedly is so if it is either the same design or a fraudulent or obvious imitation of it.

The Lord Ordinary in delivering his opinion used the following language—"Now, upon the question whether there is here an infringement, nothing was said to the contrary to the complainers' proposition that mere differences in the outline of the moulding would not take the respondents' design out of the patented copyright. That seems to me perfectly clear, because there is nothing original in the moulding, and in the claim of registration it is made evident that the registration was claimed, not for the particular moulding, but for the material form given by placing a moulding—any suitable moulding—upon a fire-door in the described position. Well, then, I have to consider if there was no exclusive privilege claimed for the particular pattern of moulding, whether the exclusive privilege is limited to the case of a moulding which exactly fits into the adjoining mouldings so as to present a continuous flowing surface, or whether it is not a privilege granted for putting such a moulding upon a fire-door in such a manner as to exclude air, and to accomplish the object which had been previously accomplished by putting the moulding upon the fire-cover or fall-bar." The Lord President adopted this language of the Lord Ordinary, and the view which he had taken of the subject-matter of the claim of the present respondents.

My Lords, with all respect for these learned Judges, I cannot but think that they took into account elements which were not proper to be considered for the purpose of determining what was the design protected by the registration, and whether there had been an infringement of the copyright in that design.

By section 6 of the Patents and Designs Act of 1883 "design" is defined as meaning any design applicable to any article of manufacture or to any substance, "whether the design is applicable for the pattern, or for the shape or configuration, or for the ornament thereof." In the present case the applicant declared that it was for "the shape" that he desired registration. Under the designs part of the Act of 1883 I do not think the object which the designer has in view in adopting the particular shape, or the useful purpose which the shape is intended to serve, or does serve, ought to be regarded in considering what is the design protected. The scheme of this part of the Act is entirely different from that relating to patents for inventions, where the object attained by the invention for which the patent is granted is of course very material to the inquiry what is the subject-matter, and whether there has been an infringement. I cannot agree therefore that the registration was claimed, or could be claimed, "not for the particular moulding," but for the form given by placing "any suitable moulding" upon a fire-door in the described position, or that a privilege was granted "for putting a moulding upon a fire-door in such a manner as to accomplish" a particular object. I think the protection was granted for the shape, and for that alone, and that in such a case when an infringement is alleged the only question is, whether the shape of that which is impeached is the same, or whether the other is an obvious imitation of the other, without reference to whether it does or does not accomplish the same useful end. I quite agree with what was said by Lord Shand in *Walker* v. *The Falkirk Iron Company*, that "the Act in this branch gives protection only to the shape or configuration or to the design for the shape or configuration in such a case as the present. The result of such protection may be, however, to secure important advantages such as attend a mechanical contrivance if these advantages should be the result, directly or indirectly, of the shape or configuration adopted." But this is a mere incident. If such advantages are obtained it is only because no shape not substantially the same, and which is therefore not an infringement, will achieve the same end. The test of infringement must always be whether the shape is or is not the same. If it be, then the exclusive privilege has been infringed, even though the same object be not accomplished; if it be not, then, though the object be accomplished, there has been no infringement. In the present case, for example, by a very slight deviation from the design, which would scarcely be apparent, the air might be admitted to the fire. I do not think that a person making such a fire-door could successfully answer the complaint that he had infringed the rights of the proprietor of the design by showing that when applied to a range it would not exclude the air.

It seems to me therefore that the eye must be the judge in such a case as this, and that the question must be determined by placing the designs side by side, and asking whether they are the same, or whether the one is an obvious imitation of the other. I ought perhaps to qualify this by saying that as a design to be registered must by section 47 "be a new or original design, not previously published in the United Kingdom," one may be entitled to take into account the state of knowledge at the time of registration, and in what respects the design was new or original when considering whether any variations from the registered design which appear in the alleged infringement are substantial or immaterial.

Applying the test which I have laid down, I have come to the conclusion that there has been a violation of the respondents' rights. There are no doubt certain distinctions between the door shown on their drawing and that manufactured by the appellants. But to establish this is not enough to free them from liability. By section 58 of the Act it is not lawful for any person to apply either the design, "or any obvious imitation thereof," in the same class of goods in which the design is registered. It is impossible in such a case as the present to give reasons for the opinion formed. I can only say that to me it appears without doubt that the door complained of is an obvious imitation of the registered design.

I therefore move your Lordships that the

judgment appealed from be affirmed, and the appeal dismissed with costs.

LORD WATSON—My Lords, the evidence led before the Lord Ordinary shows that until 1884 kitchen-ranges were commonly made with a cornice or ogee moulding running along the whole front of the range, that part of the moulding which is opposite to the furnace being invariably attached either to the fire-bar or to the hot-plate which forms the cover of the range. In November of that year the respondents registered in terms of the Act of 1883 the drawing or design of a door which in compliance with the statutory rules issued by the Board of Trade they described as a "range fire-door with moulding on the top, moulding forming part of front of range, shape to be registered."

The witnesses appear to have generally agreed that the attachment of the moulding to the fire-door, or making it part of the door itself, as shown in the respondents' design, was an improvement upon previous arrangements, because it obviated various disadvantages which were inseparable from these arrangements. That may be so, but in my opinion such considerations are of no relevancy in the present case. It is quite immaterial for the purposes of registration under the Act of 1883 whether a design is useful or devoid of utility. All that the statute requires, in order to its registration and protection is that it shall be new or original, and shall not have been previously published in the United Kingdom, and the person registering acquires no exclusive right except to the shape and configuration of his design. If his design should be calculated to serve some useful purpose, it is nevertheless open to every member of the public to attain the same end by using an article which differs from it in shape and configuration. The statutory prohibition which constitutes the measure of his privilege is to the effect that so long as his copyright endures it shall not be lawful for any person without his licence or consent in writing to apply his design, "or any fraudulent or obvious imitation thereof," in the class of goods in which such design is registered.

Accordingly, the only relevant consideration in any question of infringement is, whether the article complained of is a copy or a fraudulent or an obvious imitation of the registered design. The observations which were made by Lord Westbury in *Holdsworth* v. *M'Rea*, 2 Eng. & Ir. App. 388, with reference to the Acts now repealed, are in my opinion equally applicable to the provisions of the recent statute. His Lordship there said—"Now in the case of those things as to which the merit of the invention lies in the drawing or in forms that can be copied, the appeal is to the eye, and the eye alone is the judge of the identity of the two things. Whether therefore there be piracy or not is referred at once to an unerring judge, namely, the eye, which takes the one figure and the other figure and ascertains whether they are or are not the same."

I agree with my noble and learned friend on the woolsack that the appellants' fire-door is an obvious imitation of the respondents' registered design, and I am therefore of opinion that this appeal must be disallowed.

LORD FITZGERALD—My Lords, I concur in the two judgments which have just been delivered. I may remind your Lordships that in the course of the discussion at the bar one of the learned counsel, I think it was the Attorney General, as counsel for the respondents, asked us to put the two things side by side, and said that we should see by a look that the article produced by the appellants was an obvious imitation of the registered design of the respondents. My Lords, I looked minutely at the two things then, and I came to the conclusion that the door of the appellants' was clearly an obvious imitation of the registered design of the respondents, and from that moment I thought the argument was at an end.

The interlocutor appealed from dismissed with costs.

Counsel for the Appellants—Sir R. E. Webster, Attor.-Gen., Q.C.—Chadwyck Healey. Agents—Martin & Leslie, for J. & J. Ross, W.S.

Counsel for the Respondents—Asher, Q.C.—Ure. Agents—Grahames, Currey, & Spens, for Auld & M'Donald, W.S.

NOTE.—The case of *Rae* v. *Meek*, decided in the House of Lords on August 8th, will be reported in the beginning of the succeeding volume.

END OF VOLUME XXVI.