

The Court refused the application of the pursuer, and found none of the parties entitled to expenses.

Counsel for Pursuer—Graham Murray, Q.C.—W. C. Smith. Agent—James Purves, S.S.C.

Counsel for Defenders Ross and Macrae—Guthrie. Agents—Henry & Scott, W.S.

Counsel for Gunn & Cameron—Lord Adv. Balfour, Q.C.—W. Campbell. Agents—J. & J. Galletly, S.S.C.

Counsel for Alexander Mackenzie—Strachan. Agents—W. & J. L. Officer, W.S.

Wednesday, December 21.

SECOND DIVISION.

[Sheriff of Lanarkshire.]

THE CERA LIGHT COMPANY *v.* DOBBIE & SON.

Patent—Anticipation—Disconformity between Provisional and Final Specification.

A patent was taken out for the purpose of adapting ships' lamps for burning solid paraffin and other oils that freeze at a low temperature, the mode of melting the oil being the bringing of heat from the flame of the lamp by means of a conducting copper plate or wire into the body of the lamp. The provisional specification stated that the conductor was carried down inside the vessel to the bottom "near" the wick-tube; the final specification stated that the conductor was carried down "near or soldered to one side of" the wick-tube.

Held that the patent was invalid, because (1) a conductor from the flame placed near the wick-tube was not a new and patentable invention, having been anticipated by another patent, and (2) no invention of a conductor in metallic contact with the wick-holder was foreshadowed in the provisional specification.

On 19th May 1885 James Gilchrist, binnacle maker, Glasgow, obtained a patent for improvement in ship lamps. In the provisional specification the invention is thus described—"This invention has reference to improvements in or connected with the construction of ships' binnacle lamps and side lamps, and other lamps which only require to radiate or reflect their light out through a portion of a segment of the circle round them, the object of the invention being to adapt such lamps for burning solid paraffin or paraffin scale, naphthaline, or such oils as cocoa-nut oils which freeze or solidify at low temperatures. . . . The improvements consists in fitting thereto a rod, plate, or band of copper or other conducting metal at the back of the wick-tube or tubes, such conductor being carried up through the top of the lamp vessel outside

to a funnel or plate which is heated by the flame. The lower end of this copper plate is carried down inside the vessel to the bottom near the wick-tube, which is also carried well down, so that both the plate and wick-tube conduct the heat imparted to their upper ends from the flame outside to their lower ends inside, which being down into the paraffin or frozen oil melts it first in the centre of the vessel around the wick, and as the heat increases liquifies the whole contents of the lamp, so that the wick can then conduct this melted oil to its upper end, where it burns bright and clear." In the complete specification the improvements were thus set forth—"My said improvements specially consist in fitting close to the back or one side of the wick-tube or tubes, a rod, plate, or band of copper, or other good heat-conducting metal. This heat-conductor is soldered to the cap of the wick-tubes, and is carried up as a rod or stem through the neck and top of the lamp vessel outside this, close to and higher than the flame, . . . and has mounted on it, by a deep conducting split spring stem above the flame, a conical funnel, which is heated by the flame. . . . The lower end of this copper or other metal heat-conductor is preferably made broad as a plate, and carried down inside the vessel to the bottom near or soldered to one side of the wick-tube or tubes, which are also carried well down, so that both the plates and wick-tubes conduct the heat imparted to their upper ends from the flame outside and from the heat-receiving funnel and rod to their lower ends inside, which being down into the paraffin or frozen oil or hydrocarbon, melt it first in the centre of the vessel around the wick-tubes, and loose the wick below, and as the heat increases the plates liquify the whole contents of the lamp vessel, so that the wick can then conduct this melted hydrocarbon or oil to its upper end, where it burns bright and clear. . . . Having now particularly described and ascertained the nature of my said invention, and in what manner the same is to be performed, I declare that what I claim is—First, The arrangement and combination of parts . . . of ship and other signal lamps for the purposes and substantially as herein described. . . . Second, In ship and other signal lamps, and connected with their wick-tubes, the arrangement and combination of heat-receiving and conducting metal rods and plate surfaces . . . for the purposes and substantially as herein described. . . . Third, In ship and other signal lamps, the fitting and connecting with their tubes of a heat-receiving and conducting rod, plate, or band carried down below the flame into the lamp, and high above or over it, either with or without a moveable funnel or plate piece over the flame." To the specification there was a drawing annexed showing the heat-conductor attached to a plate fastened to the wick-holder.

The patent was afterwards acquired from James Gilchrist by the Cera Light Company, Limited.

In 1891 the Cera Light Company raised

an action in the Sheriff Court at Glasgow against Alexander Dobbie & Son, nautical instrument makers, Glasgow, in which they prayed the Court to interdict the defenders from infringing Gilchrist's patent, and to find them liable in damages.

In their condescendence the pursuers averred that the invention contained in Gilchrist's patent substantially consisted of "a combination of a heat-receiving rod or wire, placed above the flame, and a wick-containing tube or holder, both being continued down into the hydrocarbon vessel of the lamp, where they are in metallic contact with each other, and conduct or transmit the heat of the flame down to the hydrocarbon so as to melt it as well as heat the wick-conducting tube, and so accelerate or assist the ascension of the melted hydrocarbon or oil to the burner."

The defenders lodged defences, in which they averred that Gilchrist's patent was invalid in respect the specification disclosed no new invention of practical utility, and that it had been anticipated by, *inter alia*, Cochrane's patent dated in 1822, and Fyfe's patent dated in 1881.

Cochrane's patent was for "certain improvements in the construction of lamps whereby they are rendered capable of burning concrete oil, animal fat, and similar inflammable substances." His mode of melting the tallow in the lamp was as follows—A bar or rod of metal, bent into a kind of frame, was so fixed as to pass above the flame, and descend on on each side through the top of the lamp reservoir into the inside of the lamp, where the ends were soldered to a wire or rod of metal passing round in a circle at the bottom of the reservoir.

In 1884 the Young Mineral Oil Company had been making and using miners' lamps which were a modification of a patent taken out by Mr Fyfe, their manager, in 1881. In these lamps there was a wire bent in the form of a disc above the flame, and carried down near to the wick-holder to the bottom of the inside of the vessel, where it bent round in the form of a circle.

After a proof, the Sheriff-Substitute (ERSKINE MURRAY) on 29th July 1892 found that Gilchrist's patent was invalid, "the object of it having been anticipated by lamps in actual use the year before, made for Young's Mineral Oil Company as a modification of Fyfe's lamps for miners," and assoilzied the defenders.

The pursuers appealed, and argued—They did not claim for Gilchrist's patent the invention of a new principle, but a special combination. The distinctive feature of the patent was the connection between the heat-conductor and the wick-tube. The cap of the wick was part of the wick-tube. It was an old idea that the wick-tube itself by reason of its nearness to the flame would communicate heat to the contents of the lamp, but it was a new idea to make the wick-tube a conductor by uniting it with the heat-conductor. This new idea was carried out by Gilchrist's

patent. It might be said that it was not embodied in the provisional specification, but the function of the provisional specification was not to show the method by which the invention was to be carried out. A new combination of known points was a good patent, and it required a very limited amount of novelty to support a patent which did not introduce a new principle but merely a special combination, and here might be a valid patent even although the invention was only one of degree—*Hinks & Son v. Safety Lighting Company*, December 14, 1876, L.R., 4 Ch. Div., Sir George Jessel's opinion, 615; *Vickers, Sons, & Company v. Liddell*, August 7, 1890, L.R., 15 App. Cas., Lord Herschell's opinion, 501 and 502; *Lane Fox v. Kensington Electric Lighting Company*, August 10, 1892, L.R., 3 Chan. Div., Lord Justice Lindley's opinion, 429; *Gadd v. Mayor of Manchester*, November 4, 1892, 9 Times' L.R., Lord Justice Lindley's opinion, 43; *Thomson v. Moore*, June 3, 1889, 6 P.O.R. 426; *Moore v. Thomson*, July 17, 1890, 7 P.O.R. 325.

Argued for defenders—(1) If the invention patented by Gilchrist was the bringing down of the heat-conducting wire near to the wick-holder, the patent was invalid, because it was anticipated by Cochrane's and other patents. The wire in this patent might be placed nearer the wick than in some others, but no ingenuity was required in bringing two things nearer one another, and that by itself was not patentable—*Kay v. Marshall*, May 8, 1839, 2 Webster's Patent Cases, 34, Chief-Justice Tindall's opinion, 75; *Herrburger, Schwander, et Cie v. Squire*, November 17, 1888, 5 P.O.R. 581. (2) If the invention claimed was the bringing the heat-conducting wire in contact with the wick-tube, that was not a feature of the invention set forth in the provisional specification, and there being thus a disconformity between the provisional and the complete specification, the patent was invalid—*Bailey v. Robertsons*, February 23, 1877, 4 R. 545, June 21, 1878, 5 R. (H. of L.) 179; *Penn v. Bibby*, December 6, 1866, L.R., 2 Ch. App. 127.

At advising—

LORD JUSTICE-CLERK—The purpose of this action is to interdict the defenders from making or selling a lamp of a particular construction.

Before going into the contested matters, it may perhaps be well that what is not in dispute should be stated. The pursuers' patent has for its purposes to make more easy the use of thick or what are called frozen oils in lamps, and that is to be effected by catching the heat of the flame, where I suppose it is greatest, viz., at the top of the flame, by a disc or funnel or coiled-up wire of copper, that being carried down into the body of the lamp into the oil, for the purpose by the action of the heat carried by connection along this conductor of so far liquifying the oil as to aid the wick in its capillary action, and enable the wick to bring the liquified oil up to its top end in order that it may be there lighted and used as an illuminant.

The purpose, as the specification describes it, is, that this wire or conductor may melt the oil, first in the centre of the vessel round the wick-tubes and the loose wick below the tubes, and as the heat increases and passes further down liquifying the whole contents of the vessel, so that the wick can then draw melted hydrocarbon or oil to its upper end, where it burns bright and clear.

That being the purpose, what is maintained is two-fold, viz., that the pursuer has patented an arrangement whereby this conductor which is carried down into the body of the lamp is brought "near to" or is "soldered to" the wick-tube. Now, these are either two separate things or the one is explanatory of the other. Let us take it, first, that they are two separate modes. The first mode is by bringing the conductor near the wick. Now, it is alleged by the defenders that if that is claimed as the invention it was anticipated; that other lamps had been constructed before, and were in use, by which the conductor from the body of the flame or the top of the flame was brought near to the wick-tubes for the purpose of liquifying the frozen oil, and thus enabling the wick to do its duty. The Sheriff-Substitute has found that a lamp constructed, and in use before this patent was taken out, and which is called Fyfe's lamp, is an anticipation. I must say that it looks very like it. There is the same wire disc above the flame; there is the conductor carried from the disc down past the wick-holder—near to it certainly—in its whole length near to the wick-holder, and also further down near the wick itself after it has passed the holder, and thereafter it is carried round the bottom of the vessel. I think it looks very like the petitioner's arrangement indeed. It is said, however, that there are certain points in which there is important difference. I doubt that, but in the view I take of this case it is unnecessary to decide whether Fyfe's lamp is an anticipation or not. I should be inclined to hold, if it were necessary to go upon Fyfe's lamp, that it was an anticipation, but then there is another lamp invented by a man of the name of Cochrane, or patented invention, of which we have a complete description in the section or drawing, which shows us exactly how it works.

In that lamp the conductor is carried down somewhat differently, because it is carried across the flame in the first instance, and then is carried down on each side of the flame, and then into the vessel, and its two branches curve outwards and away from the wick-tube, and pass down to the extremities of the sides of the vessel, and is there joined to a circular conductor, which goes round the vessel inside.

It is said that that is not an anticipation of this patent, because the way in which the two wires are brought down cannot be described as bringing them near the wick-holder. Now, in the first place, I must remark upon the word "near," that it is in no sense an exact term, and I do not think it is a term which expresses anything de-

finite at all. It must be taken necessarily, if it is a good word, to describe the invention in connection with the special process to which the patent relates. It is plain, I think, that in all the lamps—Fyfe's, Cochrane's, and the pursuers, and in all the other lamps to which our attention has been called, where the wire is brought down from the flame—the object and intention is the same, viz., that the oil may reach the wick in a liquified state. It is equally plain that it never could reach the wick in a liquified state from a conductor of heat carried down into the material unless that conductor is placed sufficiently near to the wick-tube as to ensure that the frozen oil which is between that conductor and the wick-tube is thereby liquified up to the wick-tube. Now, it is quite plain that if you have a very thick oil—a very frozen oil—the conductor must be nearer up to the wick-tube than it would require to be in the case of oil which was not so very stiff. In that case it must be so as to secure that the solid material or viscous material is melted sufficiently to pass through the holes in the wick-tube to the wick itself—in such a state that the wick will be able to do its capillary duty of drawing the liquid oil up. Where no particular oil is specified, but only oils which are not in a freely liquid state at ordinary temperatures, it is quite plain that when the word "near" is used it must mean near enough to effect that object as ascertained by practice. That is plain to demonstration, because it is certain that, taking Cochrane's specification, if the arrangement in that specification had only the effect of liquifying oil far away from the wick it could never effect the only object for which it was there. Unless in heating the oil it succeeds in heating it sufficiently close to the wick-holder to enable the wick-holder to act upon the liquid it cannot be efficient. Therefore as the object is sufficiently to liquify the oil in aid of the proper action of the wick, and the fulfilment of that object depends upon the position of the conductor being more suitable for the particular consistency of the oil, it is quite clear that the word "near" as used in this or in any other specification must be relative to the particular oil you are dealing with. Therefore I think that in Cochrane's specification, which it is not said was a useless invention, and in Cochrane's description of his lamps, we have a plain indication of a wire brought near to the wick-holder for the purpose of liquifying the oil, and, in my opinion, that is an anticipation of the specification in question, if the case turns upon whether you can patent a conductor brought "near" to the wick-holder.

This ground would be sufficient to dispose of the case if that was what was really meant by the specification, and if the words "or soldered" do not mean something different, but only that the conductor may be fixed near the wick-tube by solder. But then Mr Murray in the debate threw over altogether the claim for a conductor brought near to the wick-holder. He maintained that the point in his specification, and the

one upon which he founded, was this—That in the specification the words were “or soldered to one side of the wick-tube or tubes,” and that that really was the novel invention which he was entitled to claim. In the specification, I may say in passing, the conductor, as it is brought down in the drawing attached to the specification, is attached to a plate or plates, which are attached in turn to the wick-holder or wick-holders. In practice I understand that now the lamps are made by passing the wire in a spiral round the wick-holder and soldering it at certain points to it, but I do not think that that makes any real difference. But then, unfortunately for the pursuers’ case, if what he claims is a metallic attachment to the wick-holder, that is a thing which was never shadowed forth in his provisional specification, because there is nothing of that nature in the provisional specification, and what is shadowed forth as being an invention is that a copper plate is carried down the inside of the vessel to the bottom near to the wick-tube. There is nothing more in the provisional specification.

I thus come to the opinion that the patent, if it is a patent founded upon an attachment to the wick-holder, is bad, because there is no shadowing forth of the essential part of the invention in the provisional specification which was given in. Therefore upon both points in the specification—the one being “near” and the other “solder to”—I hold that if they are only descriptive of one thing, then the patent was anticipated, because there were other lamps in use and other lamps published by specification which affected the same, and the same method practically. If the “soldered to” is a different thing, as was maintained by Mr Murray, I am of opinion that it is not covered by the provisional specification, and that therefore the pursuers cannot succeed.

I propose, therefore, that our judgment should be to the same effect as that of the Sheriff-Substitute, only I do not put it upon the same ground as regards Fyfe’s lamps, because I think we have a stronger case in Cochrane’s specification, and I put it also upon the further ground as applicable to the case as argued by Mr Murray, that the provisional specification does not shadow forth what is claimed as the invention.

LORD YOUNG concurred.

LORD TRAYNER—I agree. I am not like your Lordship quite prepared to dispose of this case upon the ground taken by the Sheriff-Substitute. Indeed, I am not sufficiently familiar with Fyfe’s lamp to enable me to form a judgment upon it, and I should have made myself better acquainted with Fyfe’s lamp if it had been necessary to decide the case upon the ground on which the Sheriff-Substitute has proceeded. But I agree with your Lordship that there are sufficient grounds for deciding the case to the same effect as that pronounced by the Sheriff-Substitute. These two grounds which your Lordship has stated may be

summarised in a sentence, thus—If the pursuer’s invention is for a wire or helix near to the wick-tube, then I think that has been anticipated by Cochrane; if his invention is, on the other hand, that the copper wire or helix shall be attached to the wick-tube, then that invention is not foreshadowed in his provisional specification at all. Therefore I concur with your Lordship on both these grounds that the appeal ought to be dismissed.

LORD RUTHERFURD CLARK was absent.

The Court pronounced this judgment—

“Recal the interlocutor of the Sheriff-Substitute, and find that the pursuers’ alleged invention consists of the bringing of heat from the flame of the lamp by a conducting-wire into the body of the lamp for the purpose of bringing heat to the oil near the wick-holder and the wick below the wick-holder: Find that the invention, as foreshadowed in the provisional specification consists in bringing the conductor near to the wick-holder: Find that such conductor from the flame placed near the wick-holder is not a new and patentable invention, having been anticipated by other inventions in which similar conductors were used for a similar purpose, and in particular by the lamp invented or patented by Cochrane by specification No. 4651, obtained in 1822: Find that the pursuers’ claim that by Gilchrist’s specification the bringing of the conductor from the flame into metallic contact with the wick-holder is within Gilchrist’s patent, and that the defender should be interdicted from manufacturing, selling, or using lamps in which the conductor is placed in such contact with the wick-holder: Find that the pursuers are not entitled to make any such claim under Gilchrist’s patent, no such invention of a conductor in metallic contact with the wick-holder being foreshadowed in the provisional specification: Therefore assoilzie the defenders from the conclusions of the action.”

Counsel for Pursuers—Graham Murray, Q.C.—Salvesen. Agents—J. & J. Ross, W.S.

Counsel for Defenders—Dickson—Ure. Agents—Martin & M’Glashan, S.S.C.