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r.  
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After hearing counsel, it was  
Ordered and adjudged that the appeal be dismissed, and  
that the interlocutors therein complained of be affirmed,  
with costs.

For Appellant, *Al. Wedderburn, Henry Dundas.*

For Respondents, *Ja. Montgomery, Alex. Murray.*

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Dr. JOHN ROEBUCK and SAMUEL GARBET, *Appellants ;*  
Messrs. WILLIAM and ANDREW STIRLING, } *Respondents.*  
Merchants in Glasgow, - -

House of Lords, *27th May 1774.*

PATENT—PREVIOUS USE.—A patent obtained for an invention in  
Scotland, is invalidated by proof of previous use in England.

This was a suspension and interdict brought by the appellants, owners of a patent obtained by them, for an invention for extracting spirit of vitriol from sulphur and saltpetre, in vessels of lead, and likewise, also for purifying the same, in vessels of lead, which was done by heating these over fire. The spirit was used among manufacturers for staining, printing, and bleaching linen, &c. They prayed to have the respondents, merchants in Glasgow, interdicted from using their invention, at their works in Glasgow. Long before the date of the patent, the appellants had been, at least for 20 years, in the private use of the invention, at their works in Prestonpans,—keeping it a secret from all, and enjoying a monopoly of the benefits which it conferred.

Originally the oil of vitriol was made from setting the sulphur on a fire; and hanging over the burning sulphur a bell or hollow vessel of glass, which condensed the fumes of the sulphur, and made the spirit or oil, trickle down the sides of the glass. Afterwards an improvement was effected, which had in view to prevent a large portion of the fumes from escaping into the open air, which took place by the above mode. This was by distilling the oil or spirits from calcined vitriol, in glass retorts, by means of a strong fire.

The late Dr. Ward effected a further improvement, so as to produce a saving in expense, and to admit of selling the article cheaper, which was by burning the sulphur in close vessels, by means of a mixture of saltpetre, by which the

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whole fumes of the sulphur, being prevented from evaporating, were condensed, and became oil or spirit of vitriol. The only vessels used by Dr. Ward were made of glass; and the next improvement made was that of the appellant, Dr. Roebuck, who alleged in the suspension, that after considerable expense, and making many experiments, the suspenders at last discovered, that oil or spirit of vitriol might be prepared, by burning sulphur in close vessels *made of lead*, and that the same might also be rectified or concentrated in vessels of *lead*.

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The bill was passed to try the question; and interdict *ad interim* granted.

Before the Lord Ordinary, (Lord Justice Clerk), the respondents contended that the appellants' patent was bad:—1st, Because the substitution of *lead*, in place of *glass vessels*, was no new discovery, being only a small variation *in the method of conducting the manufacture*: 2d, That it could be no new discovery at the time of granting the patent, because the appellants had carried on the manufacture in that method for 20 years preceding that period: 3dly, That at the time the patent was granted, this method of manufacturing oil, or spirit of vitriol, in vessels of lead, was known to, and practised by various other people, both in England and Scotland. It was answered, 1st, That where a *new mode* of carrying on a manufacture, beneficial for the public, is discovered, the Crown may effectually grant an exclusive privilege to the inventor of that *new mode*, leaving the other known modes of carrying on that manufacture free to every other person. 2d, That they had of course taken a long time to mature their discovery,—they had been at great expense in making experiments, and were in exclusive possession, for several years prior to the patent, of the invention, which, in so far as was in their power, they kept secret. 3d, And they denied that their invention was known, and in public use, either in Scotland or England, and that no prior use, by mere private or clandestine operations, on principles similar to the appellants, nor private experiments, will be effectual to invalidate their patent, as it was incumbent on the respondents to prove a public *exercise and use* prior thereto.

The Lord Ordinary, of this date, having ordered a proof Mar. 10, 1773. of the prior use, *prout de jure*, and proof being led accordingly, it was proved that one of the respondents had had the appellants' invention communicated to him by one of

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their own workmen.—They also proved, that it was previously known, and in use in England, Some other witnesses employed in works at Battersea, Bewdley, in England, and Mr. Steel and his brother, who carried on a manufactory near Edinburgh, refused to appear to give their evidence, stating that they carried on their work by a secret process, and refused to give evidence as to their mode of manufacture. But while there was pretty clear evidence of its having been previously known and practised in England, there was no such proof of previous use in Scotland. The only person who had known and practised the invention in Scotland was Mr. Steel and his brother, and this was only commenced, not before, but long subsequent to the date of the patent; so that a question arose upon the effect of the proof, Whether, though the invention was proved to have been practised in a foreign country, viewing England as such, proof of previous use there could invalidate a Scotch patent, the privilege of which extended, as the patent bore, “*Quod ejus publicum in illa parte dict. regni nostri Magnæ Britannæ Scotia vocat. usum et exercitum non esse novam inventionem,*” &c., and therefore only to Scotland? It was observed, that it was common, in an English patent, passing under the Great Seal of England, to apply and get the patent extended to Scotland, thereby showing that an English patent passing under the Great Seal of England, could not extend to Scotland. But, in answer to this, it was argued, that, by the treaty of Union, all parts of the United Kingdom were placed under the same privileges and restraints in regard to such matters of right and trade, and, therefore, that previous use in England was sufficient to invalidate a patent in Scotland, even though that patent only extended to Scotland.

Mar. 10, 1774. The Court, of this date, pronounced this interlocutor:—  
 “On the report of the Lord Justice-Clerk, find, in respect  
 “it appears from the proof adduced, that the art of making  
 “oil of vitriol from a mixture of sulphur and saltpetre in  
 “vessels of lead, was at the time, and before the date of  
 “the letters patent in favour of the appellants, known to,  
 “and actually practised by different persons in England;  
 “therefore the Lords find the letters orderly proceeded,  
 “and decerns.” Thus refusing the interdict (injunction).

Against this interlocutor, together with the preceding interlocutors, the present appeal was brought.

*Pleaded for the Appellants.*—Every original discoverer of an invention, or an importer of a foreign invention, useful to the public, may obtain a patent for such invention. The appellants are the discoverers and inventors of the present invention, which, after great labour, time, and expense bestowed on their part, they have made useful to the public and reduced the former expense of the oil of vitriol some 30 per cent. They at first kept it a secret, but finding that they were likely to be deprived of the benefit of the discovery, by the unlawful and clandestine attempts of others in obtaining a knowledge of it, they applied for, and obtained a patent, whereby they are entitled to the exclusive right of exercising it for the term allowed. Nor is it any answer to this to say, that the appellants' invention is not an original invention, but only an improvement on an invention formerly in use, because the act 21 James VI. § 6, gives the benefit to a new method, a process not formerly in use, and which in its results lowers the price of the commodity below that formerly in use. Nor does it invalidate their patent, that, at the date of the patent, the same method was practised by the appellants themselves, as well as by others in England and Scotland; because they were, during the course of these years in which they kept it secret, only maturing their invention, and bringing it into completion. And, so soon as it attained this perfection, they disclosed it to the public, and obtained a patent therefor. They are, therefore, entitled to protection in that right, so long as no proof has been brought, either of previous discovery or use in Scotland. The evidence, slender and imperfect as that is, of previous use in England, will not affect the patent, because England must be viewed as a foreign country in respect to Scotland, and, in that view, the appellants are entitled to the full benefit of the patent, even though they had not been the first discoverers, but only the first importers of an invention. Seeing, therefore, that they were the original inventors of this improvement, by which an article of manufacture was cheapened 30 per cent., and also seeing that no proof exists of prior use in Scotland, but only proof *there*, of a use subsequent to the date of the patent; and looking also to the facts led in evidence, that the use of it in England is traced to a knowledge surreptitiously obtained through the medium of one of their workers, who left the works and went to England, the previous use in that country ought not to invalidate the patent.

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*Pleaded by the Respondents.*—The validity of every patent depends upon the circumstances in which it has been obtained. A patent, obtained on the allegation that the applicant is the original inventor, will not be good, if it turns out that he is not so, and all patents obtained by disguising, suppressing, or concealing the truth, will, in like manner, be ineffectual. Accordingly, this is precisely the circumstance in which the case stands, because the appellants' petition induces the belief that his invention is a new manufacture, then for the first time discovered. It did not disclose the fact, that Dr. Ward had obtained a patent for his invention, nor that *they themselves*, and others in England, had carried on that invention, under the cover of these leaden vessels. All this was concealed; and they apply for their patent, on the representation that the invention was new, and that it was their invention. But, as the change of the mere material of the vessel could not entitle it to the character of a new invention, it was necessary to disclose that the invention was not new—that another patent existed—and to shew what part of this invention was the appellants'; instead of this, he states, that, so far as he “knows or believes, the same has not been discovered or used by any person or persons, except by him and his partner, and by their agents or servants.” Leaden vessels had been used in England long prior to the date of the patent; whereas the claim supposes them to be the original inventors, which they have not proved themselves to be. It also supposes the invention to be difficult, but an invention cannot be difficult that is already known and in use; and the mere change of the *vessel* from *glass* to *lead*, in which the sulphur was heated, did not suppose any difficulty, but such as might suggest itself to every one. Accordingly, oil of vitriol was in use to be made in leaden vessels in England long prior to the date of the patent, as well as in practice in Scotland by the appellants and others, all which was proved or admitted.

After hearing counsel, it was

Ordered and adjudged that the interlocutors complained against be affirmed.

For the Appellants, *E. Thurlow, Ja. Montgomery, Al. Wedderburn.*

For the Respondents, *Al. Forrester, Alex. Murray.*

Unreported in the Court of Session.