effect; but in the absence of any such plea, and taking the case on the footing that Brodie was indebted to the Association in a sum exceeding £500, I have come to the conclusion that the assignees cannot raise any question against the complainer.

Lord Shand—The law of this question is accurately stated in Bell's Commentaries, vol. ii. 131, 6th ed.—"The right to compensate passes against assignees, if once vested, against the cedent by a proper concourse before assignation. But if debt be assigned, and the assignation intimated before the counter debt arises, the concourse is prevented, and there is no compensation;" and I think that the decision your Lordships have arrived at is in accordance with the law there stated. When Brodie got this certificate the state of affairs was this—The assets of the Company consisted of three blocks of buildings, valued at £3900, but burdened with a bond for £4817. The remaining assets were trifling, and there was close on £2000 due to different banks, so that the actual state of affairs was that there was a deficiency of £3000. Now, I do not think that Brodie's certificate put him in any better position than any one who had furnished goods to the Association. The moment he presented it he would be met by the answer—"We have no funds; you must yourself contribute to pay it, and many other claims, so that there is a larger sum due by you than to you." That raises at once a question of compensation. It would be very inequitable that Brodie's assignee should get a higher right than Brodie himself had—it would be inequitable to the other partners; the assignees were bound to see what the value of Brodie's claim was.

On that short view, that the defence raises at once a claim of compensation, I think it is a clear answer to this claim. Any debt arising afterwards would not have been pleadable; but I think that here, as the debt was due, there was concourse, and the assignee is in no better position than the cedent.

The Court adhered.

Counsel for the Complainer—Solicitor-General (Macdonald) — Asher — Robertson — Darling. Agents—Lindsay, Paterson, & Co., W.S.

Counsel for the Respondents—Lord Advocate (Watson)—Trayner—Kinnear—Maclean. Agent—Patrick S. Beveridge, S.S.C.

Wednesday, December 22.

FIRST DIVISION.

[Lord Rutherfurd Clark, Ordinary.

DUDGEON *v.* THOMSON & CO.

Patent—Infringement—Combination.

Circumstances in which *held* that there were such essential differences between two tools, which both effected the expansion of boiler tubes by means of rollers, that one of them was not an infringement of a patent previously obtained for the other—*diss.* Lord Deas, who thought that the differences did not amount to more than a "colourable evasion" of the prior patent.

This is the sequel of the cases reported before, of dates 17th March and July 5, 1876 (vol. xiii, p. 384 and 629; the former reported also in 3 Rettie, p. 604).

The Lord Ordinary, after hearing proof led, reported the evidence to the Court, under the provisions of the Act of Sederunt 11th July 1828.

The complainer contended that the manufacture carried on by Thomson & Co. was a breach of the interdict granted on his application on July 4, 1873 (11 Macph. 863).

The respondent answered that the alterations on the tool manufactured by him, that had been made since the date of the interdict, were such that it could no longer be said to be an infringement of the complainer's patent, and consequently could involve no breach of interdict.

What these alterations were, and what was the outcome of the evidence, will be found in the opinion of the Lord President.

At advising—

Lord President—This is a petition and complaint for breach of interdict. The interdict was granted by Lord Mackenzie, Ordinary, and his interlocutor was affirmed by this Division of the Court on 4th July 1873. That interdict was "to prevent William Thomson, engineer in Glasgow, from infringing" Dudgeon's "letters-patent by making, vending, or using, in whole or in part, the improvements in apparatus used in expanding boiler tubes described in the specification filed on 30th August 1866, in pursuance of the proviso contained in the said letters-patent, and in particular from making, vending, or using any apparatus for expanding boiler tubes constructed or used in the manner described in the said specification, or in manner substantially the same, and from infringing the said letters-patent in any other manner or way." The patentee, Dudgeon, had obtained a patent for a certain invention for improvements in the apparatus for expanding boiler tubes, and his allegation was that Thomson was using a tool substantially the same as that described in his specification. That allegation we thought well-founded, and adhered therefore to the interlocutor.

Now, first, we must have a distinct notion of the tool described in the specification. Since the case was last before us there has been lodged a disclaimer and memorandum of alterations, but I do not think that that is material—the nature of the invention remains unaltered. The object of the complainer's invention is "to enable the ends of boiler tubes to be expanded in the holes in the flue sheet." There is no doubt that the ordinary mode in use before this invention was very rude and unsatisfactory; it was done by mere violence, and the favourite method was to expand the tube by putting into it a series of swages radiating from a common centre, and then to expand the tube by driving in a tapering plug with the blows of a heavy hammer. The invention of the complainer is to expand the tubes by the application of pressure rollers to the interior, so that the metal is expanded by rolling, in contradistinction to the old system of driving it outwards by hammering. Now, that is an obvious idea; the difficulty is to find a good mode of doing it. The patentee does not claim the invention of expansion by rolling—for that would be dangerous—and accordingly he shows that he does not intend

to monopolise the principle of expanding by rolling, but only a particular mode of doing so. He describes in his specification the best mode of constructing a tool for this purpose, and in the end of his specification he tell us what it is that he claims. What he claims is "the combination in an expanding tool of the following implements, viz., the roller, roller-stock, and expanding instrument—these three operating in combination substantially as set forth." Now, in order to expand the tube by rolling, it is necessary that the roller should not only turn on its own axis, but the rollers must be pressed strongly against the sides of the tube; therefore the double action necessary in every tool of this kind is rolling and pressure. Now, the way in which the patentee proposes to accomplish this object is by having rollers so adjusted that they shall be made to diverge from the axis of the tool and so press against the sides of the tube, and to effect that he suggests a certain mechanism—the rollers must of course be so adjusted in the roller-stock as to be capable of being pressed outwards, and therefore the rollers are fixed in radial slots, which permit them to move outwards from the centre of the stock; that is no part of the invention, but that is a mode suggested of embodying the invention. He suggests another—that is by a spring ring fixed into a ring groove in the roller-stock, so as to hold the rollers together when they are pressed out. But he does not confine himself to these; any other adjustment that will make the rollers, as they turn on their axis, diverge from the axis of the tool and press against the sides of the tube will be equal to what he calls his invention. Now, what is to be the power that is to accomplish this? That he designs as a tapering plug inserted in the centre of the tool, and its effect is that as it is worked gradually into the tool—or as some of the witnesses say, is swallowed by the tool—the rollers are made to diverge, to work on the radial slots or the spring ring so as to be pressed outward from the axis of the tool and against the interior of the tube. It is clear that to work this there must be rollers capable of being pressed outwards and a tapering plug capable of pressing them out as the metal of the tube expands. But he does not confine himself to the tapering plug as the active mechanism of his invention; he does not say what other mechanisms there may be, but this he does say—"In all the above-described modifications of the roller-expanding tool, at least one roller is combined with a tapering plug;" and then follows these words—"or its equivalent, by whose action the roller is forced outwards in the tube, and with a stock or holder by which the roller is prevented from twisting sidewise as it is turned round in the tube." Now that makes it plain that whatever the equivalents may be, they must all force the rollers outwards by their action, and press them against the interior sides of the tube. The tapering plug has two actions, first, that which we have described; but it has also a rotatory action, which is common to the rollers, and as they rotate on their axis the metal is expanded. When he says—"what is claimed, therefore, as the invention to be secured by letters-patent is the combination in an expanding tool of the following implements, viz., the roller, roller-stock, and expanding instrument, these three operating in combination substantially as set forth," what are we to understand? Is it not that there must be rollers made to diverge from their axis and press against the tube, and an active mechanism which shall cause them to do so?

Now, we were of opinion in granting the interdict that Thomson was using a tool of that kind; no doubt not exactly the same as any of the modifications described in the specification, but it was merely a colourable imitation of the patentee's tool. I shall best express the grounds on which I, at least, proceeded by reading a few words from my own opinion—"Now there is no doubt in the world that although the respondent in his specifications adopts different language from that which is used in the complainer's specification, he does use in combination rollers and a roller-stock, and a tapering plug for the purpose of expanding tubes by rolling, and that is the subject-matter of the complainer's patent. It is quite true that in the case of the respondent's tool there is produced what he calls perfectly parallel expansion; while a tool made in terms of the complainer's specification will not give perfectly parallel expansion. That may be, for aught I know, an improvement. But then observe how that improvement is brought about. It is by a slight modification of that which is the subject-matter of the complainer's patent. He tapers the roller-stock as well as the tapering-plug, and makes the taper of the one correspond precisely with the taper of the other, so that the effect is that the tube is expanded exactly as much for the whole length of the roller. Each roller produces exactly an equal expansion throughout its whole length; and the roller of the complainer not being tapered so as to correspond with the taper of the plug, produces not an equal or parallel expansion of the tube, but an expansion which in the tube is of a tapering nature." And—"Then, again, it is said that the one differs from the other in this, that whereas the tapering-plug is inserted from the outside, and is driven in the case of the complainer's patent, *e converso* in the case of the respondent's tool it is introduced from the inside and drawn outwards by means of a screw and nut." The sole points of distinction were that the taper or skew of the roller was made to correspond with the taper of the plug in an opposite direction, and therefore to produce what is called a "perfectly parallel expansion," and that the plug was introduced from the inside and drawn outwards by means of a screw and nut.

The question comes to be whether the tool used since by Thomson comes within the description of the original patent? The tool lately used by Thomson certainly differed from Dudgeon's tool in some very remarkable particulars, and the question is whether these variations take it out of the patent? In the first place, the rollers of Thomson's tool are not made to diverge from the axis of the tool, and therefore it is by no such divergence that they are made to press against the tube. Accordingly a tapering-plug is not required, and would be out of place; and its equivalents are equally out of place, for Thomson could not use any tapering-plug or any modification of a tapering-plug. In short, the means of expanding the metal is different altogether, and is not contemplated by the complainer. No doubt Thomson uses rollers, and to make these rollers work he is obliged to use a roller-stock; but with

these two points the resemblance comes to an end. Thomson's rollers are fitted in a different way for a different purpose, and act in a different way. Thomson, in the best form of his tool, has a plug in the centre of his tool, but it is not tapering, and does not force out the rollers by its action, and therefore it is not intended to do anything more than communicate a rotary motion to the rollers. The means by which Thomson effects his object of pressing the rollers against the tubes is entirely different. He makes his tool a tapering or skew tool. The whole contour of the roller-stock and tool is different. It is conical in shape. The effect is that the tool works itself into the tube, and gets swallowed by it. The result is that the metal is gradually rolled out, first by that portion of the tool whose circumference is smallest, and then by the parts of greater circumference. It is essential in Thomson's tool that it should constantly work into the tube, not like the roller-stock in the patentee's tool, which must always remain stationary. Now, if the patentee is not entitled to claim all methods of expanding tubes by rolling, which he does not claim, and if every other method except that combination which he has claimed is free to the public, I think that this is a different method, and therefore not protected by his patent. This cannot be said to be a modification of the roller-expanding tool, wherein rollers are combined with a tapering-plug or an equivalent expanding instrument, by whose action the rollers are made to diverge, or are forced outwards in the tube. Thomson has no expanding instrument of that kind, and his rollers are not made to diverge from the axis of the tool. He accomplishes his object in a totally different way. No doubt there is a plug in both cases that communicates a rotary motion to the rollers, and in that respect they act in the same way, but that is only one and not a material part of the invention. The other is essential to the working of the tool. Thomson's may be used without a plug at all, not so satisfactorily, but still it may be so used with all its characteristics. Such a tool has been produced here, and the patentee admits that he could not complain of it, so that the identity is limited to this, that they each have a plug. The patentee's tool can never be used in the same way as Thomson's; it can never be swallowed by the tube; the roller-stock must remain quite stationary—a state of matters which, he suggests, may be secured by means of a guage, it being useful to maintain the tool in the same position in the sheet.

For these reasons I come to the conclusion that Thomson's tool, as he uses it, is no infringement of the patent.

Lord Deas—I concurred at the time in the observations made by your Lordship on the occasion of granting this interdict, and I refer to those observations as applicable to the tool at that time. Thomson has set himself with great ingenuity to devise a tool that shall overcome the objections then made. The question is—Has he succeeded? I do not go into details, but I have had great difficulty in holding that the alterations have got him out of the infringement. The combination which Dudgeon distinctly states in the end of his disclaimer as the invention claimed by him is this—"The combination in an expanding tool of the following implements, viz., the rollers, roller-stock, and expanding instrument, these three operating in combination substantially as set forth." Now, I agree that with reference to the roller and the roller-stock in Thomson's improved instrument we find them there. The whole question is, Whether we have the expanding instrument or an equivalent for it; for in the outset of that part of the specification which I have read there are these words—"In the above-described modifications of the roller-expanding tool, rollers are combined with a tapering-plug (or its equivalent, by whose action the rollers are forced outwards in the tube)." Now, there the patentee does not confine himself to one method. He says, "tapering plug or its equivalent." Now in Thomson's tool we have, I think, "an equivalent by whose action the rollers are forced outwards in the tube." Your Lordship's observations came to this, that it is in the fact that the equivalent for the tapering-plug does not in Thomson's instrument force the rollers out, that the sting of the matter lies, and that it is that that prevents this from being an infringement of Dudgeon's patent. There is therefore a very nice question here, but I am disposed to think that that fact does not get Thomson out of the objection to his instrument as an infringement. He certainly does not accomplish the object of the tool in precisely the same way as Dudgeon does. His tool does not force out the rollers in the same way or in the same sense as Mr Dudgeon's instrument does. The plug enters the instrument at the opposite end. The necessity of forcing the rollers out is avoided by this instrument being skewed, so that in going into the boiler tubes it accomplishes its purpose by the rollers being larger at one end than the other. As these rollers go in the same expansion is produced as in Dudgeon's instrument is effected by pressing the rollers outwards. There is that difference; but is it sufficient to prevent it from being an infringement? I incline to think it is merely a colourable evasion by this variation. It is a variation suggested by attending to the principle of Dudgeon's invention, and I am not satisfied that that variation gets him out of Dudgeon's specification. I have the greatest respect for your Lordship's opinion, and the greatest doubt about my own, but I do not think that there is sufficient variation to take Thomson's invention out of the scope of Dudgeon's patent.

Lord Mure—This is a nice and delicate question, as most of the questions of this nature indeed are, but after giving the whole matter my best attention I have come to the same conclusion as your Lordship in the chair. The first point is, What is the invention of Dudgeon in his second specification? It appears to me that there is not there included every means by which rollers can roll out metal tubes. It must be considered to be merely one method of expanding such tubes, the mode being described. He says it is invented as an improvement on the old method of driving them out by hammering, and he describes his method. Now, in that description he specifies two distinct things—1st, the use of radial slots to enable the rollers to turn; and 2d, that divergence of the series of rollers which is produced, and whereby the metal is expanded. It is by the forcing out of these rollers that the expansion of the metal tubes is effected. He makes that quite

clear in the end of his specification—[*Reads the passage read by the Lord President and by Lord Deas*].

There is a difference taken between the expression "expanding tool" and "expanding instrument." The "expanding tool" is the three things, the roller, roller-stock, and tapering-plug in combination; the "expanding instrument" is that tapering plug which can only act where there are radial slots or something equivalent, which will allow the rollers to be pressed outwards. There is a guage too in Dudgeon's tool, to keep the instrument at the same part of the tube, for it is only by that means that you get the necessary expanding power; that is the way Dudgeon's patent works. Now, we have seen both instruments, and the first thing that strikes one in Thomson's patent is that there is no divergence of the rollers; they are fixed in the stock; they are skewed, however, so as to make the tool conical in its shape, and therefore it must, in short, be in motion to act successfully, entering the tube gradually until you come to the thickest part of the tool, when the expansion is complete. Therefore, I think that in principle Thomson's patent is different, and so is the mode of operation, and therefore I am satisfied that there is no infringement.

Prayer of petition refused.

Counsel for Complainer—Lord Advocate (Watson)—Balfour—Hunter. Agent—D. Curror, S.S.C.

Counsel for Respondent—Asher—Jameson. Agents—Auld & Macdonald, W.S.

Saturday, December 23.

FIRST DIVISION.

[Sheriff of Lanarkshire.

HARVEY *v.* DYCE.

Jurisdiction—Slander—Privilege—Damages—Judge—Sheriff.

Held that a Judge has absolute protection for words spoken by him in his judicial capacity against an action for damages.

Observed (*per* Lord President) that no Judge is irresponsible, but no Judge is responsible in an action of damages.

John Harvey, writer in Lanark, and procurator in the Sheriff Court there, raised this action against the Sheriff-Substitute of Lanarkshire, residing in Lanark, concluding for £1000 of damages and *solatium* due to him in consequence of the defender having slandered him while debating a case in the Sheriff Court. The expressions complained of were "that the pursuer was an insane man," and "that he was a juggler," and further, "that he was a liar."

The defender admitted that on the occasion referred to he had occasion to observe on the manner in which the pursuer was conducting the debate before him; but pleaded—"(1) The action is incompetent in the Sheriff Court of Lanarkshire, or any other inferior Court. (2) There being no case stated by the pursuer relevant to infer that the defender acted in the matter complained of extrajudicially, beyond his powers or competency as a Judge, the action is not maintainable to any effect. (3) The defender, having in the matter complained of acted regularly in the exercise of his judicial functions, in good faith and with probable cause, and the contrary not being relevantly or competently averred, the action is untenable. (4) Generally, the action being raised against a judicial functionary in respect of matter occurring in the course of his judicial functions, and for alleged damage said in consequence to arise, is an incompetent action, and the statements thereof are not relevant to infer the conclusions."

The Sheriff of the county remitted the case to another of his Substitutes (GALBRAITH), who sustained the 1st, 2d, and 3d pleas, and assoilzied the defender. In a note annexed to his judgment he assigned as his ground of judgment the incompetency of dealing with an action such as the present in the Sheriff Court. On the general ground of incompetency he gave no opinion.

The Sheriff (DICKSON) adhered, but added the following note:—

"*Note*—The Sheriff-Substitute bases his judgment on the ground of his not having jurisdiction to entertain the action, supposing (for the sake of argument) that it were competent in another Court. The Sheriff is not prepared to adopt this view, for which, so far as he knows, there is no authority. He prefers to reserve his opinion upon it as involving a question of difficulty which it is not necessary to decide, seeing that he has no doubt that, upon the authorities quoted by the Sheriff-Substitute, as well as upon principle, the action is incompetent either in this Court or in any other Court."

The pursuer reclaimed, and argued—The case of *Haggart's Trustees* v. *Lord President Hope*, quoted against him, had no application to an inferior Judge. If the Supreme Court had no jurisdiction to entertain this action, what remedy was there? Besides, although a Judge might be protected by his judicial functions to a certain extent, in using the language alleged he *ipso facto* laid down his judicial position and its privileges.

The defender argued—This case is altogether incompetent. The law is, that a Judge on the judgment-seat has an absolute immunity against actions of damages.

Authorities—*Haggart's Trs.*, June 1, 1821, 1 S. 46, and H. of L. 2 Shaws Appeals 125; *Hamilton* v. *Anderson*, June 18, 1858, 3 Macq. 363; *Scott* v. *Stansfield*, 3 Law Reports (Exchequer) 220 (C-B. Kelly's opinion).

At advising—

LORD PRESIDENT—I am of opinion that this action is not maintainable. The allegation of the pursuer is that on the 4th of April the defender, "while he was sitting in judgment as Sheriff-Substitute in the Court at Lanark, and hearing the pursuer in a debate on an action at his instance against James Lindsay, missionary, Lanark, and before and in presence of William B. Allan, Sheriff-Clerk-Depute," and various other persons, did slander the pursuer. It has been settled by a series of judgments both in this country and in England that against an action so laid the privilege of a Judge is absolute. No Judge is irrespon-