THE LAW

OF

PATENTS FOR DESIGNS

CONTAINING

A REFERENCE TO THE VARIOUS STATUTES ENACTED IN THE UNITED STATES ON THE SUBJECT; AND THE OPINIONS IN FULL, WITH CAREFULLY PREPARED SYLLABI, OF ALL REPORTED CASES ON THE SUBJECT, ADJUDGED IN THE SUPREME COURT AND CIRCUIT COURTS OF THE UNITED STATES; TOGETHER WITH AN APPENDIX CONTAINING THE OPINIONS IN FULL OF ALL REPORTED PATENT OFFICE DECISIONS RELATING TO APPLICATIONS FOR DESIGN PATENTS.

BY

HECTOR T. FENTON,

Counsellor-at-Law.

PHILADELPHIA:

WILLIAM J. CAMPBELL,

LAW PUBLISHER,

740 SANSOM STREET,

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PREFACE.

So little attention has been given to the subject of Design Patents by text writers on Patents for Inventions, that the author need scarcely apologize for his attempt to prepare a useful but brief treatise on the principles governing protection for such inventions, as deduced from the statutes that have been enacted from time to time in the United States, the decisions of the Supreme Court and Circuit Courts of the United States in cases founded on such patents, and the reported rulings of the Patent Office authorities on applications therefor.

In order to make the work more full and perfect, and of wider practical use to patent practitioners and solicitors, all the reported cases, both in the Courts and the Patent Office, to December 31, 1888, have been incorporated in the volume. The opinions are given in full, and instead of a digest, the tables of cases contain an abstract of the points decided, name of judge, district where decided, date of decision, where cited, affirmed, overruled or reversed, and the subject-matter and date of patent involved; and the cases are collected and arranged under the appropriate chapters relating to the subject-matter and questions discussed therein. The author has attempted to set forth in the treatise or comments on the points decided by the cases, the true principles which govern the law; to point

out the proper meaning of the statutes; to properly classify the decisions so that it can be readily seen which are right and which are wrong in the light of subsequent authority; and, where necessary, to explain what is doubtful and obscure therein. As this could not be done by simply classifying and recording what has been decided by the courts, recourse has been had to a brief discussion of those fundamental and general principles by the application of which it may be determined with reasonable certainty what the law is where it has not been judicially interpreted.

U. T. F.

PHILADELPHIA, June, 1889.

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THE LAW OF PATENTS FOR DESIGNS.

CHAPTER I.

Of the Statutes under which Letters Patent for Designs have been and are now authorized to be granted in the United States.

SECTION 1. Although the Congress of the United States as early as April 10, 1790,[1] did, by Act of that date, provide for carrying into effect the provisions of Article 1, Sect. 8, of the Constitution, authorizing the grant for limited periods to authors and inventors, of the exclusive right to their respective writings and discoveries, the general classification therein of subjects of invention so entitled to be protected thereby, excluded, by implication at least, any new and original design for ornamentation to be placed upon, or any new and original configuration of, any article of manufacture; and it was not until 1842[2] that Congress enacted a law specifically including these inventions or pro-

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[1] Act of April 10, 1790, 1 Stat. at Large, 109.

[2] Act of August 29, 1842, Sect. 3, 5 Stat. at Large, 543:

"SECTION 3. And be it further enacted, That any citizen or citizens, or alien or aliens having resided one year in the United States and taken the oath of his or their intention to become a citizen or citizens, who by his, her or their own industry, genius, efforts and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, or any new and original design for the printing of woolen, silk, cotton or other fabrics, or any new and original design for a bust, statue, or bas relief, or composition in alto or basso relievo, or any new and original impression or ornament, or to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture, not known or used by others before his, her or their invention or production thereof, and prior to the time of his, her or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use and sell and vend the same, or copies of the same, to others by them to be made, used or sold, may make application in writing to the commissioner of patents, expressing such desire, and the commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent: *Provided*, That the fee in such cases, which by the now existing laws would be required of the particular applicant, shall be one-half the sum, and that the duration of said patent shall be seven years, and that all the regulations and provisions which now apply to the obtaining or protection of patents, not inconsistent with the provisions of this act, shall apply to applications under this section."

ductions as subject matter for which Letters Patent might be granted.

SECT. 2. The Act of 1842, Sect. 3, made no distinction between a citizen and an alien who was a resident and had declared his intentions more than one year previously, in the right to apply for and obtain such a patent. It differed from the general law in the phraseology defining the character of the invention, in that in lieu of the words "invented or discovered," the words, "invented or produced" are used, preceded by the words, "by his, her, or their own industry, genius, efforts, or expense," which, or any substitute for which, do not appear in the general law then or since existing relating to patents for other classes of inventions. The act also made a distinction in the term or duration of the patent, limiting it to seven years; or one-half the term for which other patents were then granted, and imposing a fee of but one-half of the amount charged for other patents. The concluding portions of this act, however, provided that all the then existing regulations and provisions applicable to the obtaining or protection of other patents, not inconsistent therewith, should apply to *applications* under this section. Very few design patents were granted under this act, and the books contain no Patent Office decisions, and but three litigated cases in the courts, founded on patents applied for or granted in pursuance of this law.[1]

SECT. 3. The Act of August 29, 1842, was repealed and supplied by the Act of March 2, 1861[2]. The Act of 1842

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[1] Root *v.* Ball, 4 McLean, 177; Sparkman *v.* Higgins, 1 Blatch. 205; Booth *v.* Garrelly, 1 Blatch. 247.

[2] Act of March 2, 1861, Sect. 11, 12 Stat. at Large, 246:

"SECTION 11. And be it further enacted, That any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken the oath of his or their intention to become a citizen or citizens, who, by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, any original design for a bust, statue, or bas relief, or composition in alto or basso relievo, or any new and original impression or ornament to be placed on any article of manufacture, the same being formed in marble or other material, or any new and useful pattern or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein to make, use, and sell and vend the same, or copies of the same, to others by them to be made, used, or sold, may make application in writing to the Commissioner of Patents, expressing such desire, and the Commissioner, on due proceedings had, may grant a patent therefor, as in the case now of application for a patent, for the term of three and one-half years, or for the term of seven years, or for the term of fourteen years, as the said applicant may elect in his application: *Provided*, That the

enumerated the following four general subjects for design patents, viz: (1) "Any new and original design *for* a manufacture, whether of metal or other material or materials, (2) *or any new and original design for the printing of woolen, silk, cotton, or other fabrics*, (3) *or any new and* original design for a bust, statue, or bas relief or composition in alto or basso relievo, (4) or any new and original impression or ornament (or), to be placed on any article of manufacture, the same being formed in marble or other material [or any new and useful pattern, or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed in, any article of manufacture], (5) or any new and original shape or configuration of any article of manufacture." The words enclosed in brackets above are clearly a repetition of, or inclusive of, the subjects of one or more of the other classifications; while class (1) is inclusive of (3). The Act of 1861, with respect to the subject matter of design patents, contains exactly the same phraseology above quoted, excluding the words italicized, and including the words in brackets; which goes to show that the latter is inclusive of the former.

SECT. 4. The Act of 1861, Sect. 11, did not distinguish between the persons to whom by the Act of 1842 a design patent might be granted, but it did make a material alteration as to the term or duration of such patents. Instead of a fixed term of seven years, the Commissioner had power under the Act of 1861 to grant the patent either for three and a half years, seven years, or fourteen years, as the applicant might elect in his petition or application,[1] he paying the graduated fee provided by the act, for the term so selected. The act also provided for a seven years' extension upon the same terms and restrictions then provided by law with respect to other patents.[2] It was by the concluding section of this Act of 1861 that all other patents were to

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fee to be paid in such application shall be, for the term of three years and six months, ten dollars; for seven years, fifteen dollars, and for fourteen years, thirty dollars; *And provided*, That the patentees of designs under this act shall be entitled to the extension of their respective patents, for the term of seven years, from the day on which said patents shall expire, upon the same terms and restrictions as are now provided for the extension of letters patent."

[1] The applicant must make his election in his original application. He cannot do so afterwards by amendment. Ex parte Mayo. Com. Dec. 1870, page 14.

[2] The books contain no reported instance of any extension granted under this act.

be thereafter granted for the term of seventeen years, and extensions thereof were prohibited. It is also to be noted that both the Acts of 1842 and 1861 provide for the grant of a patent only where the design was "*not known* or *used by others* before his, her, or their invention or production thereof, and *prior to the time of his, her, or their application for a patent therefor.*" The language is significant, in view of the phraseology of the then existing law with respect to other patents which were permitted if the invention was "not known or used by others before his or their invention or discovery thereof, and not, at the time of his application for a patent in public use or on sale, *with his consent or allowance* as the inventor or discoverer."

SECT. 5. These statutes were repealed and entirely superseded by the consolidated Patent Act of July 8, 1870.[1] Sections 71 to 76 inclusive, only, of that act apply to design patents. This law abolishes all discrimination between citizen and alien applicants, and also in lieu of the words "not known, etc., prior to application for a patent therefor," found in the Acts of 1842 and 1861, substituted the words "patented or described in any printed publication." The

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[1] Act of July 8, 1870, Sect. 71 to 76, 16 Stat. at Large, 198:

"SECTION 71. And be it further enacted, That any person who by his own industry, genius efforts and expense has invented or produced any new and original design for a manufacture, bust, statue, alto relievo or bas relief; any new and original design for the printing of woolen, silk, cotton or other fabrics; any new and original impression, ornament, pattern, print, or picture to be printed, painted, cast or otherwise placed on or worked into any article of manufacture; or any new, useful and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented, or described in any printed publication, may, upon payment of the duty required by law, and other due proceedings had, the same as in cases of inventions or discoveries, obtain a patent therefor.

"SECTION 72. And be it further enacted, That the commissioner may dispense with models of designs when the designs can be sufficiently represented by drawings or photographs.

"SECTION 73. And be it further enacted, That patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may in his application elect.

"SECTION 74. And be it further enacted, That patentees of designs issued prior to March two, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries issued prior to the second day of March, eighteen hundred and sixty-one.

"SECTION 75. And be it further enacted, That the following shall be the rates of fees in design cases: for three years and six months, ten dollars; for seven years, fifteen dollars; for fourteen years, thirty dollars; for all other cases in which fees are required, the same rates as in cases of inventions or discoveries.

"SECTION 76. And be it further enacted, That all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries, not inconsistent with the provisions of this act, shall apply to patents for designs."

graduated term or duration, three and a half, seven, or fourteen years, as elected in the application, remained the same as under the Act of 1861. The subject matter for which the patent could issue also remained the same as under the preceding law, but more closely adopting the phraseology of the Act of 1842. The application for the patent was to be by "due proceedings had, the same as in cases of invention or discoveries." This act also provided for an extension of design patents then in force, issued *prior* to March 2, 1861,[1] but not authorizing any extension of patents issued by virtue of its provisions; while it was also ruled, by the Patent Office authorities, though clearly erroneously, that the repealing clause of this act took away the right of extension of design patents issued after March 2, 1861, and under the provisions of the law of that date.[2]

SECT. 6. The laws relating to design patents, in force on the 22d of June, 1874, formed Sections 4929 to 4934 of the Revised Statutes[3] of the United States, adopted and approved by Congress by law of that date. These sections are a reprint in substance, and almost in phraseology, of

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[1] The Patent Act of 1861 extended the term of patents for inventions to 17 years, and prohibited any extension thereof; but expressly authorized a seven year extension of design patents issued under *that* act.

[2] Ex parte Sperry, Com. Dec. 1870, page 139.

[3] Rev. Stat. U. S., Sect. 4929 to 4934:

"SECTION 4929. Any person who, by his own industry, genius, efforts, and expense has invented and produced any new and original design for a manufacture, bust, statue, alto relievo or bas relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the fee prescribed, and other due proceedings had, the same as in cases of inventions or discoveries, obtain a patent therefor.

"SECTION 4930. The Commissioner may dispense with models of designs when the design can be sufficiently represented by drawings or photographs.

"SECTION 4931. Patents for designs may be granted for the term of three years and six months, or for seven years, or for fourteen years, as the applicant may, in his application, elect.

"SECTION 4932. Patentees of designs issued prior to the 2d day of March, eighteen hundred and sixty-one, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries issued prior to the second day of March, eighteen hundred and sixty-one.

"SECTION 4933. All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries not inconsistent with the provisions of this Title shall apply to patents for designs.

"SECTION 4934. The following shall be the rates for patent fees: * * * In design cases, for three years and six months, ten dollars; for seven years, fifteen dollars; for fourteen years, thirty dollars."

the Act of 1870 in so far as it relates to the subject under consideration. It is now the existing law, saving only that the sections of the Revised Statutes,[1] relating to suits for infringement, were supplemented by an Act of Congress, approved February 4, 1887,[2] providing an arbitrary minimum amount of damages to be recovered, under the circumstances mentioned in the act, for infringement of design patent, in cases where for want or failure of proof of actual profits received or damages suffered, nominal damages only could have been recovered; but without taking away the right of any patentee to prove and recover actual damages and profits in excess of the minimum amount for which a verdict or decree shall be rendered for any such infringement.

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[1] Rev. Stat. U. S., Sects. 4919 and 4921.

[2] Act of Feb. 4, 1887, 24 Stat. at Large, page 387:

"SECTION 1. Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That hereafter, during the term of letters patent for a design, it shall be unlawful for any person other than the owner of said letters patent, without the license of such owner, to apply the design secured by such letters patent, or any colorable imitation thereof, to any article of manufacture for the purpose of sale, or to sell or expose for sale any article of manufacture to which such design or colorable imitation shall, without the license of the owner, have been applied, knowing that the same has been so applied. Any person violating the provisions, or either of them, of this section shall be liable in the amount of two hundred and fifty dollars; and in case the total profit made by him from the manufacture or sale, as aforesaid, of the article or articles to which the design or colorable imitation thereof has been applied exceeds the sum of two hundred and fifty dollars, he shall be further liable for the excess of such profit over and above the sum of two hundred and fifty dollars; and the full amount of such liability may be recovered by the owner of the letters patent, to his own use, in any Circuit Court of the United States having jurisdiction of the parties, either by action at law or upon a bill in equity for an injunction to restrain such infringement.

"SECTION 2. That nothing in this act contained shall prevent, lessen, impeach, or avoid any remedy at law or in equity which any owner of letters patent for a design, aggrieved by the infringement of the same, might have had if this act had not been passed; but such owner shall not twice recover the profit made from the infringement."

CHAPTER II.

Of the qualities and requisites of a Design to render it patentable.

SECTION 1. The power of Congress, under the Constitution, to enact laws to protect by patent the exclusive right, for limited periods, to the use of novel designs, can only be by virtue of Cl. 8, sec. 8, Art. 1 of that instrument authorizing grants by general or special laws, or by both, to authors and inventors, of the exclusive right, for limited periods, to their respective writings and discoveries. Hence it was said by an able and learned judge in a very early case[1] founded on a design patent, that to support the grant, the patentee must have been an *inventor*, and he must have made an *invention;* that is to say, the design sought to be protected must be more than a mere fanciful sketch or form, or more than a mere aggregation of forms, figures, letters, or ornaments; in brief, it must be a new and original design, involving ingenuity.

SECT. 2. Designs have been, and are, the subject of statutory protection, not only in the United States, but in the principal European States, though, in the latter, under a wholly different classification. In the former, they are treated as inventions, but in the latter, as a species of trade-mark or copyright property. In the former, they were not recognized as entitled to protection until the passage of the Act of August 29, 1842; whereas, in Europe, they have received statutory protection since before the present century; as early as 1737 in France, and in England, first by Statute of 27 Geo. 3, Ch. 38, enacted in 1787. In the United States they are necessarily treated as included within the Constitutional terms "writings and discoveries," whereas, in England, they are not so classified, and where simple deposit of a photograph or drawing of the design, with a statement of the nature thereof, *i. e.* whether it be for con-

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[1] Northrup *v.* Adams, 2 B. & A. 567. See also Wooster *v.* Crane, 5 Blatch, 232, and Simpson *v.* Davis, 12 Fed. Rep. 144.

figuration or for ornament, the name of the author or *proprietor*, and the class of goods to which the design is applicable or intended to be applied, is all that is necessary to obtain protection[1]; and no requirement is there made that the design shall necessarily involve invention, or be more than a mere aggregation of words, figures, lines, or ornaments, provided that the whole be novel in the sense of being distinguishable from what is already in use in the same class.

SECT. 3. Much difference of opinion has existed as to whether or not design patents were confined to ornamentation only, as defined in the Acts of 1842 and 1861, and as these statutes were construed by the Supreme Court in Gorham Co. *v.* White; since, in the subsequent Act of July, 1870, and the Revised Statutes, the word *useful* appears for the first time in conjunction with the words *new and original* in including form or configuration of an article as patentable subject-matter under the design section. Diametrically opposite opinions on this point are to be found in the earlier decisions of the Patent Office, but better opinion at this time seems to be that *useful*, in the statute, means ornamental utility, and not functional utility. Since the Act of 1870, the Circuit Court for the District of New Jersey, in a well considered case[2] decided in 1883, held that design patents differ from patents for inventions or discoveries in that they have reference to appearance rather than utility; that their object is to encourage the arts of decoration rather than the invention of useful products; and that a picture or design which merely pleases the eye is a proper subject for such a patent, without regard to the question of utility.

SECT. 4. The Supreme Court in an opinion by Mr. Justice Nelson[3] construed the Act of 1861, as respects patentable subject matter under that act, to the effect that the claim must be for an original design, or impression, or ornament, or picture, or pattern, and the like, wholly irrespective of the means of producing it; and was called upon in that case to distinguish between the patentability under the

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[1] The Patents, Designs, and Trademarks Act, 1883, 46 & 47 Vict. C. 57.

[2] Theberath *v.* Rubber, etc. Harness Trimming Co. 15 Fed. Rep. 246.

[3] Clark *v.* Bousfield, 10 Wall., 133.

design patent act, of form or configuration which produces a design or impression, and the resultant design produced. The case arose on a patent for an improvement in machines for graining pails, in which one of the claims was for an elastic bed on which the designs for graining the several staves of the pail were impressed upon a single united mass, and the design transferred to the pail by passing the latter over the bed. The court was of opinion that the arranged figure in the elastic bed was not the one intended to be protected by the Design Act of 1861, but the one which is transferred to the pail, where its beauty is first visible to the eye; and consequently held that the claim was properly the subject of a mechanical or functional patent and not of a design patent.

SECT. 5. In construing the Act of 1861, Judge Benedict held[1] that while the act as respects form or configuration of an article does not require functional utility in the thing sought to be protected, it does require that the shape produced shall be the result of industry, effort, genius, or expense, and must also be held to require that the shape or configuration sought to be secured shall also be new and original as applied to articles of manufacture. The case arose upon a patent for a design for a reel for containing or holding ruffles, dress-trimmings or other goods, consisting of two parallel disks of pasteboard connected by four bits of wood, the pasteboard being cut in the shape of a rhombus with the angles rounded; and the claim was for the form of the reel. A reel as an article of manufacture being old, and the rhombus form being that of a well-known mathematical figure, the court held that it did not involve patentable novelty under this act to originally apply an arbitrarily selected old form to a well-known article of manufacture.

SECT. 6. In a suit on a patent issued under the Act of 1842, Judge Nelson held[2] that the invention claimed was a "design for a manufacture," of an ornamental button. The design was described in the patent as consisting of two distinct characters, to be used in combination, in order

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[1] Wooster *v.* Crane, 2 Fisher, P. C. 583.
[2] Booth *v.* Garrelly, 1 Blatch., C. C. Rep. 247.

to insure the beauty of the article; first, the configuration of the mold or block having radial indentations thereon forming the foundation of the button; and second, winding the block with silk threads of various hues or colors, and radially arranged by the mode of winding therein described, so as to produce an ornamental face on the button. The court said the patent was not for the manufacture of a new and ornamental button, but for a *new and ornamental design* in the manufacture of the article. This case is instructive not alone as illustrating patentability under the act, but because the patent undoubtedly comprised in the one grant two separate and distinct claims, one for the form or configuration of the button mold and the other for the surface ornamentation of the completed button.

SECT. 7. As illustrative of what does *not* present patentable subject matter under the design patent statute, it was held in 1880[1] that a card for pearl buttons, covered with tin foil, arranged in bands, to hold pearl buttons in rows of three or four, was not such an invention, for the reason among others that the so-called design did not apply to the article itself, but the card was merely for presenting the article—the buttons—in a more convenient, or perhaps more pleasing form, to an intending purchaser; and holding without qualification, that merely changing the mode of keeping and presenting an article for sale, without changing its form or appearance, and that did not affect the article itself, would not support a design patent.

So also, it was doubted whether it was a proper subject-matter for a design patent to claim making sieves with a flaring edge, so they could be nested one within the other.[2]

And again, a claim in a design patent for a meat packing can, of pyramidal shape as its distinctive feature, which was evidently founded on functional utility only, was held to be of doubtful validity, on the ground of non-patentability under the statute.[3]

SECT. 8. In the leading case of Gorham Company *v.* White,[4] as decided in the Circuit Court, and which was

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[1] Pratt *vs.* Rosenfeld, 3 Fed. Rep. 335.

[2] Adams & Westlake Manufacturing Company *vs.* St. Louis Wire Goods Company, 3 Bann. & Ard. 77, S. C. 12 O. G. 940.

[3] Wilson Packing Company *vs.* Clapp, 13 O. G. 368.

[4] Gorham Company *vs.* White, 7 Blatch. C. C. Rep. 513.

founded upon a patent for "design for the handles of table-spoons, etc.," the design patented was held to be composed of two elements—the outline or form of the handle, and the surface ornamentation upon it. That configuration as well as surface ornamentation was embraced within the statute, and that the object of the former may solely be increased utility, while the object of the latter may be solely gratification of the artistic or æsthetic sense; and that to negative novelty the prior design must possess substantial identity, and not merely a general resemblance sufficient perhaps to mislead a casual observer, without proper attention, to mistake one for the other. And finally that a patent for a design, like a patent for improvement in machinery, must be for the means of producing a certain result or appearance, and not for the result or appearance itself. The plaintiff's patent was consequently held to be for the described means of producing a certain appearance in the completed handle of a spoon.

SECT. 9. The Supreme Court, however, in the same case, on appeal,[1] held that the thing invented or produced for which a design patent is given is that which gives a peculiar or distinctive appearance to the manufacture or article to which it is to be applied, or to which it gives form. The statute contemplates not an abstract impression but an aspect given to these objects enumerated. It is the appearance only, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public for which the patent is given. The appearance may be the results of peculiarity of configuration, or of ornament alone, or of both conjointly, but in whatever way produced, it is the new thing or product which the patent law regards. And as the acts of Congress embrace only designs applied, or to be applied, they refer to finished products of invention, rather than to the process of finishing them, or to the agencies by which they are developed.

SECT. 10. The test of novelty or identity as defined by the Supreme Court in Gorham Co. *v.* White,[2] will, it is apprehended, not be found easy of application in all cases with

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[1] Gorham Company *vs.* White, 14 Wallace, 511.

[2] Gorham Co. *v.* White, 14 Wallace, 511.

anything like satisfactory results. No doubt it was well applied in that case. The court held that identity was to be determined, not by a critical comparison of the design patented with that which preceded or followed it, but by the effect on the eye of an ordinary observer; and that expert comparative testimony was to be rejected, together with immaterial differences in details not affecting the resultant appearance of the whole; adding, however, that the court did not mean to say that in determining whether two designs were substantially alike, differences in the lines, the configuration, or the modes by which the aspects they exhibit, are not to be considered; but deciding that resultant effect is the controlling consideration. The opinion in this case reversed the decision of the court below[1] on every ground on which the judgment was founded, but the decree of reversal was non-concurred in by three of the Justices who sat at the hearing of the appeal.

SECT. 11. It is important to note that neither in the case of Gorham Co. *v.* White, nor in the case of Holdsworth *v.* McCrea,[2] a leading English case cited and approved therein, was any defense made on the ground of want of patentable novelty, or any evidence of the state of the art introduced. As in construing functional patent claims, such evidence is of the first importance, no good reasons exist why it is not equally applicable in design patent cases. It can scarcely be controverted that a new and original and patentable design may be specifically different as a whole or in any of its several and, perhaps, segregable parts, yet generically like a prior design, in an artistic, if not in a legal, sense; although the Patent Office authorities held in a very well considered recent decision,[3] that under the definition of identity of design, by the Supreme Court in Gorham Co. *v.* White, such would not be patentably different. An earlier ruling of the Patent Office in an elaborate opinion,[4] held to the contrary; while a learned text writer[5] on the subject, considering that opinion in

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[1] Gorham Co. *v.* White, 7 Blatch. 513.
[2] Holdsworth *v.* McCrea, 2 App. Cas. H. of L. 388.
[3] *Ex-parte* Gerard, 43 O. G. 1235 and 1240 (2 cases).
[4] *Ex-parte* Bartholomew, Com. Dec., 1870, page 103.
[5] Simonds on Design Patents, page 139.

view of the later decision in Gorham Co. *v.* White, doubts the advisability of attempting the general introduction of generic claims into design patents.

SECT. 12. The most common subject of designs is surface ornamentation; and it has been much discussed as to whether mere arrangements of colors might constitute a patentable design. In an early Patent Office decision[1] it is said that a *mere* substitution of one color for another possesses no element of originality, and indicates no exercise of genius, and cannot, therefore, become the subject of a patent, neither can any blending or arrangement of colors, unless a new æsthetical effect is produced, or original idea indicated. Both branches of the ruling are seemingly correct. The same decision, however, contains the admission that, subject to the qualification mentioned, it is not intended to rule that no design patent could, under any circumstances, be based on colors only. A case arose in New York, decided in 1887, in which the court said that the patent was an attempt to secure to the patentee a monopoly of all ornamentation upon rubber mats by which variations of light and shade are produced by a series of ridges and depressions, without regard to any particular arrangement or characteristics of the lines, except that they are to be parallel. That as it was not new to produce contrasts and variations in light and shade by depressions or elevations in various materials, as wood, plaster, corduroy cloth, etc., it was not patentable novelty to transfer the same to rubber mats, and held the patent void because the claims did not extend to, or cover anything which "embodies a new impression or effect produced by an arrangement or configuration of lines which introduces new elements of color or form."[2]

SECT. 13. The same doctrine, applicable to employer and workman, that holds in case of functional patents, has been applied to designs, in an early case decided in New York in 1846,[3] wherein it was ruled that to constitute an inventor (of a design), it is not necessary that he should have the manual skill and dexterity to make the drafts. If the

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[1] *Ex-parte* Weinberg, Com. Dec. 1871, page 244.

[2] N. Y. Belting, etc., Co. *v.* N. J. Car Spring, etc., Co., 30 Fed. Rep. 785.

[3] Sparkman *v.* Higgins, 1 Blatch. C. C. Rep. 205. But see, also, Streat *v.* White, 35 Fed. Rep. 426.

ideas are furnished by him for producing the result aimed at, he is entitled to avail himself of the mechanical skill of others to carry out practically his contrivance.

SECT. 14. In suits founded on functional patents the defence is frequently made that the thing claimed is a mere change in form, proportion, or degree, not producing thereby any new or different result; so in design cases the same defence of non-patentability for the same reason would seem to be applicable, as illustrated in an unreported decision made in 1873, by the Circuit Court for the Southern District of New York, in Collender *v.* Griffiths[1], which was a suit on a design patent for bevelling the sides of billiard tables, and wherein the court held that it being shown that ordinary tables with sides bevelled inward from the top had been known before, it did not constitute invention patentable under the design act to so bevel the sides of billiard tables in order that the player may advance his foot further under it; that it was a mere question of judgment, not invention, how far the bevel should be carried, and that making the bevel deeper for a specific purpose did not change the substance or render the design patentable.[2]

SECT. 15. The law of combinations is equally applicable to design. As in mechanical devices, a mere aggregation of designs, like a mere aggregation of mechanisms, do not constitute patentable combinations arising to the dignity of invention. As in combinations of mechanism, to be patentable, they must co-act to produce a united result, so in designs a mere grouping together of old ornaments or designs to be patentable as a new design must produce as a whole a new effect, result, or appearance, due to all the parts as a unit, and not resulting from the separate appearance of each of the separate or separable parts. There must be originality and the exercise of genius involved. Mere artistic dexterity in grouping is not enough; it may be likened to mere mechanical skill as applied to subjects of functional patents.[3]

SECT. 16. The subject of patentability on the face of the patent was discussed in a case which arose on a design

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[1] The opinion in this case is contained in full on page 51, Simonds on Des. Pat.

[2] See also *ex parte* Parkinson, Com. Dec. 1871, p. 251.

[3] *Northrop v. Adams*, 2 Bann. & Ard., 567; S. C. 12, O. G. 430.

patent for a banner rod,[1] consisting of an imitation of a straight twig with the bark on. The court dismissed a motion for an injunction with the remark that the design was so simple and natural as to readily suggest itself to one skilled in upholstery; adding that the Design Act presupposes a greater degree of genius that this device exhibited.

SECT. 17. Other illustrations of non-patentability are found in cases involving what, in suits on functional patents, would be called analogous uses or mere double uses. The adaptation of old devices or forms to new purposes, however convenient, useful, or beautiful they may be in their new role, is not invention.[1] An apt illustration of this is found in gas drop-lights or newel-post lights, where a gas-jet is passed through any well-known bronze figure, and so adapting to a useful purpose that which was before purely ornamental, which, while it may exhibit good taste and judgment, lacks the element of invention and involves merely judicious selection of existing forms.

SECT. 18. It is now tolerably well settled that design patents stand on as high a plane as other patents, in that they require to support them the exercise of the inventive or originative faculty in as high a degree. Arbitrary selections of existing forms for the first time applied to a new subject, without any distinctively novel change resulting therefrom, will not constitute patentable subject matter for a design patent, but if there follows any special adaptation of the old form to the new use whereby a substantially novel appearance, either in surface or in configuration, in an artistic or æsthetic sense, the resultant whole would be patentable.[3]

SECT. 19. Equally true is it that mere change of material, though it may produce novel and highly ornamental effects, in an artistic sense, will not constitute patentable novelty, because such effects are novel only in degree and not in character; for illustration, an artist's proof of an engraving printed upon a satin surface brings out the beauty of the picture, and is novel in an artistic sense, as

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[1] Osborn *v.* Judd, 38 O. G., 1132.

[1] Northrup *v.* Adams, 12 O. G. 430.

[3] Western Electric Manufacturing Company *v.* Odell *et al.*, 18 Fed. Rep. 321.

compared with the same picture printed in the ordinary way upon paper, but the design—the picture—is the same; it is only different in degree and not in character. Application of this rule was made in a case decided in 1886,[1] in which the patent was for a curtain and loop, the claim being in effect for the substitution of a *metallic* loop or chain, of any approved form, for a silk or woolen loop, as fastening for and in connection with a hanging or portiere curtain. The argument was that the metallic chain was in pleasing contrast with the curtain, and had, in connection with it, a beauty of appearance, was an ornament to it, and gave to it a peculiar and distinctive appearance; but the court ruled the case on the ground, that whether that were so or not, the mere change of material alone did not constitute design patentability within the purview of the statute.

SECT. 20. Unity of design constitutes another very important question in design cases, and it may be laid down as a general rule that where there is no necessary connection between two designs or parts of a design, there is an absence of unity to render them a single patentable design. For illustration, an inkstand and its stopper;[2] a mirror frame and its sconce attached thereto;[3] the form or configuration of an article, and the surface ornamentation thereof which is equally applicable to other forms of articles.[4] Whether it consists of form or surface delineation, or both, the design must be one entire and integral thing. While it is true that a completed design may consist partly of form and partly of surface ornamentation, it cannot consist of several integral different designs of either character merely aggregated, so as to produce the several parts individually and separately, nor so that these parts may be separately applied to other and different articles, or parts of articles, of manufacture.

SECT. 21. The legal distinction between patentable combinations and mere aggregations of old parts, as applied to other patents, is quite as applicable to designs. Unity of

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[1] Post *et al. v.* Richards Hardware Company, 26 Fed. Rep. 618.

[2] *Ex parte* Brower, Com. Dec. 1873, p. 151.

[3] *Ex parte* Patitz, 25 O. G. 980.

[4] *Ex parte* Gerard, 43 O. G. 1243.

design, in the broad meaning of that phrase, as now accepted, would seem to cover this distinction, but there may be cases in which it is not so, and which are purely instances of non-patentable aggregations. A notable illustration is found in a case decided in 1882,[1] in which one claim of the patent was for an ornamentation for a newel post; the design of the claim consisting of an arrangement of scrolls, bead, and roses. The court said that the difficulty with the claim did not arise from want of novelty in the forms employed, nor yet in the want of novelty in the arrangement of them, but in concluding that the scroll, roses, and bead when arranged as described in the claim, constitute a single ornament. There was no commingling of the lines forming the scroll, the bead, and the roses, and no new idea embodied in the method of their arrangement. All that has been done is to place these distinct and well-known ornaments one above the other, without the production of any such combined effect as to entitle the whole to be treated as a new and original ornament; and no new ornament has, in fact, been produced thereby.

SECT. 22. An *improvement* of a thing presupposes a likeness to the thing improved, hence, in designs, there can be no such thing as a patentable *improvement* in the sense in which that technical term is used with respect to functional patents; for the reason that, while the "state of the art" may, perhaps, be inquired into in construing a design patent, the claim, if it be sustained at all, must be, not for the details of the picture in its entirety, as in mechanical combination claims, but for the predominant or distinguishing features only; and as a mere *improvement* must necessarily involve these, it is substantially, in a legal sense, identical with the original, under the test of identity laid down by the Supreme Court;[2] otherwise, if it does not involve these in the eye of an ordinary observer, it is not an improvement so-called, but an entirely different design.

SECT. 23. In this connection, Judge Wheeler remarked in a case decided in 1881,[3] in which the patent expressly stated in the specification that it was for a new and *im-*

[1] Simpson *v.* Davis, 12 Fed. Rep. 144.
[2] Gorham Co. *v.* White, 14 Wall. 511.
[3] Wood *v.* Dolby, 7 Fed. Rep., 475.

proved design, that the words were equivalent to new and *original*, as expressive of a new and distinctive design; improved as compared with others of the same class or character; and that although evidence of the state of the art showed designs of the same class or kind, some even the same in more or less important parts, yet taken as a whole the patented design was to be considered new and original since none of the alleged anticipations were like it in *appearance*, either in outline or detail. Hence, a design so improved, in the common acceptation of that term, is really new and original, because if not so improved as to render it distinctively different from the old, in appearance, to the extent that it may be easily distinguishable therefrom by ordinary observers, it lacks patentable novelty, and remains and is the same design within the true meaning of the design patent law.

SECT. 24. It is seen therefore that the same test of identity, applied to determine the issue of infringement, as laid down by the Supreme Court in Gorham Co. *v.* White, is to be applied to determine the issue of patentable novelty, where the court is called upon to consider that question in view of evidence of the state of the art, or more properly of prior designs of the same genus, class or character. Yet, cases may arise in which it seems extremely difficult to apply the rule inflexibly, in view of the fact that the Supreme Court has recently ruled[1] that a design patent claim is good which simply claims the thing shown without pointing out and distinctly claiming, or even describing, the particular part or parts or arrangement of parts, distinguishing its originality from what preceded it in the same class of ornamental designs.

SECT. 25. The same test of identity, is applicable to form or configuration, as well as to surface ornamentation, and was so applied in a case[2] where the patent covered in three separate claims the external form as an entirety, the ornamentation, and finally the appearance resulting from both the elements of form and ornamentation. The subject matter of the patent was a stove, and evidence of the state

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[1] Dobson *v.* Dornan, 118 U. S., 10.

[2] Perry, *et al.*, *v.* Starrett, 3 Bann. & Ard. 485; S. C. 14, O. G. 599.

of the art, both as to configuration and ornamentation was introduced, which showed many parts like that of the patented design; but admitting that, the court said (mentioning the different parts of the patented design, some new and some old), that all these parts were made symmetrical of themselves and in respect to each other, and connected together with appropriate devices, and formed into a harmonious whole, in a manner that could not be done without inventive genius and creative skill; and that the resulting appearance presented a clear case of patentable novelty under the statute.

The following selected cases, of those reported in this volume, illustrate the subject matter discussed in the preceding chapter.

EMMA C. WOOSTER *v.* JASON CRANE, *et al.*

U. S. Circuit Court, Southern District of New York.

Decided October 7, 1865.

2 Fisher's Pat. Cas., p. 583.

1. Patent for design issued under Act of 1861, purported to cover the form, for a reel for containing ruffles, trimmings, etc., of a well known geometrical figure. Held, the reel itself being old as an article of manufacture, it did not involve patentable novelty under this statute, to apply this particular shape to this particular article.
2. While that statute does not require utility in the design, it does require that it should be the product of more than chance selection of any well-known form or figure to be given to an article of manufacture, and from which no advantage can be derived other than incidental use as a trade-mark.

Thomas P. How, for complainant.

S. F. Freeman, for defendants.

BENEDICT, J. This is a bill in equity, filed to recover damages for an alleged infringement of a patent issued October 20, 1863, for a design for a reel.

The article in question is a reel for containing ruffles, ladies' dress trimmings, and other goods, and consists of two parallel disks of pasteboard, connected by four bits of wood, on which the ruffle is wound, between the pasteboard sides.

The pasteboard is cut in the shape of a rhombus, with the angles rounded; and what the patentee claims is "the design and configuration of the reel."

The statute relied on, as giving to the complainant the right sought to be enforced, is the act of March 2, 1861.

Section 11 of this Act is as follows:

"Section 11. And be it further enacted, that any citizen or citizens, or alien or aliens, having resided one year in the United States, and taken oath of his or their intention to become a citizen or citizens, who, by his, her, or their own industry, genius, efforts, and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material, or any new or useful pattern, or print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture, not known or used by others before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor, and who shall desire to obtain an exclusive property or right therein, to make, use, and sell the same, or copies of the same to others, by them to be made, used, and sold, may make application in writing, to the commissioner of patents, expressing such desire, and the commissioner, on due proceedings had, may grant a patent therefor as in the case now of an application for a patent."

I am not aware that any judicial construction has been given to the portion of this act considered applicable to this case. No authorities were cited on either side showing any adjudication upon the question involved. There seems to me, however, to be little doubt as to what should be the construction to be put upon it, when sought to be applied to a case like this.

In this case, the reel itself, as an article of manufacture, is conceded to be old and not the subject of a patent. The

shape applied to it by the complainant is also an old, well-known mathematical figure. Now, although it does not appear that any person ever before applied this particular shape to this particular article, I cannot think that the act quoted above was intended to secure to the complainant an exclusive right to use this well-known figure in the manufacture of reels. The act, although it does not require utility in order to secure the benefit of its provisions, does require that the shape produced shall be the result of industry, effort, genius, or expense, and must also, I think, be held to require that the shape or configuration sought to be secured, shall at least be new and original as applied to articles of manufacture. But here the shape is a common one in many articles of manufacture, and its application to a reel cannot fairly be said to be the result of industry, genius, efforts, and expense. No advantage whatever is pretended to be derived from the adoption of the form selected by the complainant, except the incidental one of using it as a trade-mark. Its selection can hardly be said to be the result of effort even; it was simply an arbi'_ary, chance selection of one of many well-known shapes, all equally well adapted to the purpose. To hold that such an application of a common form can be secured by letters patent, would be giving the Act of 1861 a construction broader than I am willing to give it. The decree must, therefore, be for the defendant.

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CLARK *v.* BOUSFIELD.

Supreme Court, U. S. *Decided December Term, 1869.*

10 Wallace, U. S. Sup. Ct., p. 183.

1. A patent issued in 1864 for fourteen years in pursuance of the Act of July 4, 1836, for an invention entitled "An improvement in machines for graining pails," with two claims, one for an elastic bed containing a design, on which paint or coloring matter is placed, so that the design should be transferred to staves of a pail rolled across the bed; the other claim being for arranging the elastic bed in a series of designs to produce on the pail the appearance of separate and distinct staves;

held, to be for a machine, and not for a design, on the ground that the design was the finished appearance on the face of the pail, and not the arranged figure on the elastic bed.

2. The design statute of 1861 could apply only to the finished design after transferrence to the pail, where its artistic beauty was first visible. The *means* of producing this was properly patentable under the statutes relating to functional patents.

On certificate of division between the judges of the Circuit Court, for the Northern District of Ohio, the case being this:

The Patent Act of July 4, 1836, "to promote the progress of the useful arts," authorized the patenting of any "new and useful art, machine, manufacture, or composition of matter," and gave an exclusive right to the patentee for a term of fourteen years, with a privilege of renewal for seven in certain cases, but this act did not allow a patent for mere designs.

The eleventh section of an Act of March 2, 1861, entitled "An Act in addition to an Act to promote the progress of the useful arts," extends this privilege of patent. It secures to the inventor or producer of any original design, etc., or any new and original impression or ornament, to be placed on any article of manufacture, etc., or any new and useful pattern, or print, or picture, to be either worked on, or printed, or painted, on any article of manufacture; or any new and original shape or configuration of any article of manufacture not known or used before, etc., a patent for the exclusive property therein; and it gives this right for a term of years, different from the term granted by the Act of 1836, to the inventor of a machine, etc.

With both acts in force, R. & A. Cross obtained, December 27, 1864, a patent for a new and useful improvement in machines for graining pails, and other analogous uses.

The nature of it, as declared by them in the schedule to the letters patent, consisted in constructing an elastic bed containing the impression or impressions of the device to be grained upon the pail, in separate panels, each panel to be of different design, so that by moving the pail over the same the various designs would be stamped upon the pail, thus producing a pail whose staves were painted in imita-

tion of different kinds of wood. The patentees then described the instrument or machine, which they stated to be a box, into which the elastic material, with the required designs to be grained upon the pail, is placed, and which might, according to their statement, be constructed of wood or iron, or any other suitable material, and so shaped (describing the shape minutely), that when the pail was adjusted properly upon the bed, and rolled upon and over it, the upper or large end of the pail should follow the outer curve of the bed, and the lower or smaller should follow the interior or smaller curve with exactness and precision.

"The elastic bed," they say, "may present one continuous or uniform design if desired, or it may be arranged in blocks or staves, each of different designs, so that the pail grained thereon or thereby shall present the appearance of being constructed of different kinds or species of wood.

"The elastic bed may be composed of any suitable impressible material, as rubber or leather; but a compound of glue and molasses, such as is used for printers' rollers, is preferred."

The patentees then described the contrivances for working the elastic bed in connection with the pail, so as to effect the graining of the latter. By this contrivance, the pail, they state, is readily rolled by hand across the bed, leaving upon it the desired design or figure, or the pail may be suspended on handles, and the elastic bed itself moved beneath it, in a suitably arranged groove or track, producing the same result. The patentees then set forth their claims, the first two of which only are material.

First.—"We claim constructing the bed of the elastic material used in graining machines, in the form herein shown, substantially as, and for the purposes specified."

Second.—"We claim arranging the elastic material aforesaid, whether curved or rectangular in form, in a series of distinct staves or designs, substantially as, and for the purposes herein shown and set forth."

On a suit below by Clark and others, assignees of Cross, the patentee, against one Bousfield, for infringement, it was suggested, on behalf of the defendant, that the second claim was for nothing more or other than a design to be im-

pressed on the bed; and if this was so that the claim would be void, as a patent could not properly contain a valid claim for a machine, and contain also a claim for a design; that the two things were patentable under different acts, and for different terms of time.

The judges of the Circuit Court were accordingly divided upon the question whether the second claim in said letters patent was for anything patentable other than under the already mentioned Section 11 of the Act of March 2, 1861. And if not, whether the patent was not void.

Messrs. J. Canfield and A. G. Riddle, for the plaintiff.

We admit, that if this second claim is, in substance, a claim for a design, instead of a claim for a principle in an apparatus, it should have been patented under the Act of 1861; but if it is for a principle in an apparatus, then we assert that it does not come under the Act of 1861, but under the Act of 1836. Now, Judge Grier, in Corning *v.* Burden (15 Howard, 268), has thus defined the principle patentable as a machine.

"It is for the discovery or invention of some practicable method or means of producing a beneficial result or effect itself. It is when the term process is used to represent the means or method of producing a result, that it is patentable; and it will include all methods or means which are not effected by the mechanisms or mechanical combination. But the term process is often used in a more vague sense, in which it cannot be the subject of a patent; thus, we say that a board is undergoing the process of being planed, grain of being ground, iron of being hammered or rolled. Here the term is used subjectively or passively, as applied to the material operated on, and not to the method or mode of producing that operation, which is by mechanical means or the use of a machine, as distinguished from a process. In this use of the term it represents the function of a machine, or the effect produced by it on the material, subjected to the action of the machine.

But it is well settled that a man cannot have a patent for the function or abstract effect of a machine, but only for the machine which produces it."

This language is both concise and correct; and, tested

by it, our second claim is for the machine which produces the effect, and not for the effect itself. In other words, it is for the machine which grains a pail in staves, which staves represent different kinds of wood, and not for the impression upon the pail, representing staves of different kinds of wood.

The means of producing this effect on the pail is our machine, which comes under the Act of 1836; the effect, as produced, is a design which comes under the Act of 1861, and for which we claim nothing.

Mr. George Willey, with a printed brief of Messrs. George Willey, John E. Cary, and H. S. Sherman, contra.

The nature and object of the invention, as stated in the specification, contemplated a design and the construction of a bed corresponding with the shape of the design, but as an obvious sequence or incident of the design. Nothing is claimed on the material, or box or bed, or its material, nor as to form could anything be claimed in the way of invention, inasmuch as it involves the mere measurement of surface, the simplest of mechanical operations. Then it says, "the elastic bed may present one continuous or uniform design, if desired, or it may be arranged in blocks or staves, each of different designs," meaning block or stave designs.

Again, it speaks of "different designs arranged in staves," which is but another form of representing stave designs. Again, it speaks of the "pail being rolled across the bed and grained in staves in imitation of various woods or marbles." The specification does not say series of separate pieces or blocks, but a "series of distinct staves or designs," and the specification speaks of "different designs arranged in staves, impressed upon a single united mass, so as to produce the same effect as when constructed in separate blocks," evidently treating staves and designs as synonymous or convertible, the word "staves" meaning stave designs; so that, from all these considerations, it is obvious that stave designs impressed on a bed, whether curved or rectangular, for the purpose of transferring said stave designs to a pail, or "other analogous uses," or to rectangular

objects, is the substantial object or meaning of this second claim. If this be so, then the doubt suggested below is well founded, and the plaintiff has no valid patent.

Mr. Justice NELSON delivered the opinion of the court.

It will be seen, by reference to the eleventh section of the Act of 1861, that if the second claim is patentable under this section, it must be a claim for an original design or impression or ornament or pattern or picture and the like, wholly irrespective of the means of producing it. The patent is simply for the design, etc., itself. In order to understand the full meaning of this second claim, it will be useful to settle the meaning of the first, as the two are intimately connected.

The first, as we have seen, is for constructing the bed for the elastic material used in graining machines in the form shown, and for the purposes specified. The patentees describe it as a box or bed, and which may be constructed of wood or iron, or of any other suitable material.

This box or bed is made for the purpose of holding the elastic material, whether of rubber or leather, or the compound of glue and molasses, which is preferred. Now, the second claim is for arranging the elastic material when placed on this box or bed, whether curved or rectangular in form, "in a series of distinct staves or designs," for the purpose specified; that is, for the purpose of graining pails in the variety of colors or figures described. The elastic bed may be arranged, as is stated in the specification, so as to present one continuous or uniform design, or it may be arranged in blocks or staves, each of different designs, so that the vessel shall present the appearance of different kinds of wood, as rosewood, oak, walnut, and others. It may also be constructed of separate pieces or blocks, as shown in the drawing, or the material may be a single united mass, impressed by different designs arranged in staves, so as to produce the same effect as when constructed in separate blocks. The two claims, as we see, are closely connected, and each essential to the complete construction of the instrument or apparatus, which, when put into practical operation by the contrivances pointed out in the specification, can accomplish the desired result, which result is

the graining of the exterior body of the pail with a variety of colors and figures.

The learned counsel for the defendants insists that this second claim is only an arrangement of designs, and, in a limited sense, he is no doubt right, but in its connection with the first claim, and with the machine for transferring the design to pails, it is more; it is a part of the machine or instrument, and an indispensable part; it is the elastic bed of rubber, or of leather, or compound of glue and molasses, of any arranged figure or design, that constitutes an element in the machine, and which, with the curved box and contrivances for working the instrument, produces the desired result.

The figure or design is but incidental, and as such has no other protection than that which the patent secures to the inventor of the machine. The right to the use of the machine carries along with it the right to use the designs.

The arranged figure in the elastic bed is not the one protected by the eleventh section of the Act of 1861; that is, the one which is transferred to the pail or wares, where its beauty is first visible to the eye. While it remains in the elastic material it exhibits no more beauty than if engraved on stone or metal.

It may be that the inventors of the machine for impressing figures or designs upon pails or other wares would not be protected from using figures or designs, the right of property in which had been secured to the original inventor under this eleventh section, but they may clearly use any and all not thus protected. The machine in question is invented for reducing to practical use these figures and designs, and will make them profitable to the original inventors or owners of them if they choose to employ it.

We are of opinion that the first question should be answered in the affirmative, and the second in the negative.

FRANK NORTHRUP, *et al. v.* SAMUEL ADAMS.

U. S. Circuit Court, Eastern District of Michigan. Decided, 1877.

O. G. Vol. 12, p. 430.

1. Design patents are subject to the general principles of construction applicable to mechanical patents. A combination or aggregation of old designs producing no new appearance is not patentable.
2. When, in a design of a rectangular provision safe, the only originality consisted in the use of two vertical panels in each wall, and a familiar moulding around the top and bottom, the patent was held invalid.

Mr. Hunt, for complainant.

Messrs. J. W. McGrath and Geo. H. Lothrop, for defendant.

This was a bill for the infringement of a design patent for a provision or cheese safe. The specification describes a rectangular base, with a top supported by four corner posts, with an intermediate stile or support, dividing each side into vertical panels, all of which are covered with wire cloth of fine mesh. The front side is made to open as a door, which is single, but folds upon itself, the two parts being hinged together at the center stile. Around the base is an ogee molding, and a similar one is run around the top to serve as a cornice. A lighter molding of the same pattern is run around the edge of each panel, and a pleasant effect is produced by staining all of the moulding a dark color, varnishing all the rest of the wood work, leaving it in its natural color. The claim was as follows: *As a design for a cheese safe, the rectangular cage shown, having two vertical panels on each wall, a molded top, A, and a molded base, A'.* The defences set up in the answer were: First, That the invention was in public use for more than two years prior to the application for a patent; Second, the invention was not patentable.

BROWN, J. Complainant claims his patent by virtue of that clause of R. S., Sect. 4,929, which extends the protection of the patent laws to any new and original design

for a manufacture, or "any new and original shape or configuration of any article of manufacture not known or used by others," before his invention or production thereof. The law applicable to this class of patents does not materially differ from that in cases of mechanical patents, and "all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries . . . shall apply to patents for designs." (Sect. 4,933.)

The same general principles of construction extend to both. To entitle a party to the benefit of the act, in either case there must be originality and the exercise of the inventive faculty. In the one there must be novelty and utility; in the other, originality and beauty. Mere mechanical skill is insufficient. There must be something akin to genius—an effort of the brain as well as the hand. The adaptation of old devices or forms to new purposes, however convenient, useful, or beautiful they may be in their new role, is not invention. In the case of Bannage *v.* Phillippi, 9 Official Gazette, 1,159, the Acting Commissioner of Patents decided, I have no doubt correctly, that the use of a small model of the Main Centennial Building for paper weights and inkstands was not patentable.

Another apt illustration of this is put by Simonds, Design Patents, p. 194, of one who took a familiar statue of a shepherd boy, thrust a gas-pipe through the leg and arm, and applied it to the purposes of a drop-light. Here was good taste undoubtedly, but not invention. He merely succeeded in making that which was before purely ornamental serve a useful purpose.

It is true patents have apparently been issued for designs frivolous in themselves, or new adaptations of old designs; but, as remarked in an excellent opinion by Commissioner Leggett, in the case of Parkinson, Simonds on Design Patents, p. 101, "the practice of the office in granting design patents has been not only liberal, but lax." In the later decisions of the office, a stricter construction has been given to the law, and one more consonant to the familiar principles applied to mechanical patents. If a combination of old designs be patentable at all, of which I have some doubt, the combination must be such as to produce a new appearance. If the effect produced be simply the aggre-

gation of familiar designs, it would be patentable. For example, if one should paint upon a familiar vase a copy of Stuart's portrait of Washington, it would not be patentable, because both elements of the combination, the portrait and the vase, are old; but if "any new and original impression or ornament" were placed upon the same vase, it would fall within the express language of the section.

Apply these rules to the case under consideration. Rectangular safes, essentially similar to complainant's, covered with wire cloth, have been made and used for many years. When constructed of large size, each side was divided into panels by a vertical stile; when of smaller size, no such division was made. As the difference in size would not be patentable, so the division of each side into panels is none the more so. The only novelty then, in this patent, is the use of an ogee moulding about the top and bottom, and the combination of this with paneled sides is claimed as complainant's invention. Mouldings of this description, however, have been used for centuries, and applied, not only by way of ornament in architecture, but to articles of furniture and the decoration of interiors. The embellishment of a provision safe with this ancient design is simply the adaptation of a well-known ornament to a new purpose. The result is pleasing in appearance, but not entitled to the protection of the patent laws as novel or original. Rectangular safes were formerly used for the exhibition of cheese in shops; but of late years they have been supplanted by a round safe, with the top divided and connected with hinges, so as to permit one-half of it to be thrown back. The present design appears simply to be a restoration of the old style with a rolling bottom, for the more convenient handling of the cheese, and the addition of a simple moulding around the top and bottom, giving it undoubtedly a more pleasing appearance. While the patentee showed some taste in the manufacture of this article, and while it may have become popular and valuable to him, it does not seem to me to possess the originality without which no manufacture can be patentable.

It results that the bill must be dismissed with costs.

ADAMS & WESTLAKE MANUFACTURING COMPANY *v.* ST. LOUIS WIRE GOODS COMPANY.

U. S. Circuit Court, Eastern District of Missouri.

Decided September Term, 1877.

O. G., Vol. 12, p. 940.

The swaging of the several parts of the sieve together being an essential element of the invention set forth in plaintiff's patent, a preliminary injunction was refused, it appearing that the defendant accomplished the joining by double seaming.

Doubted whether it is a proper subject for a design patent to make sieves with a flare so that they can be nested one within another; and, if so, the design lacks novelty.

Coburn and Thacher, for plaintiff.

S. S. Boyd, for defendant.

Motion for preliminary injunction.

TREAT, J. The bill was based on Letters Patent No. 106,597, August 23, 1870, for "improvement in sieves," and on Letters Patent No. 4,637, February 7, 1871, for "design for sieves," granted Robert J. Mann. This opinion was stenographically reported, and afterward revised by the judge.

I have received a note from counsel for plaintiff, in which they desire the result of the action of the court to be certified to them. I have not had time to write an opinion in this matter. But as this case has been presented in a hurried way, as the court was very much occupied at the time, and as it will come up hereafter on its merits, I will merely state the conclusions so far as this motion is concerned.

The claim in the patent is for—

"The combination of the loop a and sieve-cloth c, when the edge of the sieve-cloth is clasped in the hoop and there fastened by swaging, substantially as shown."

Without going into an elaborate disquisition with regard to these matters, it must suffice that this patent has been twice established as a valid and subsisting patent, and for the purposes of this motion must be so treated by this court.

Thereupon, only one inquiry is presented: Is the sieve, as used by defendant, an infringement thereon?

(Illustrating.) This is defendant's sieve separated into parts.

If we go through the mechanical combination involved in their use by the defendant, and into the mechanical combination for which the plaintiff as assignee has a patent, we will find, according to the claims of the patent, the essential element is, that the sieve is placed into proper position with regard to the loops and swaged, which results in tightening the sieve below, and produces this convenient effect in the form indicated, whereby the rim remains, so that the plaintiff's sieve, thus produced, may effect results which sieves of this character are intended to produce. Now, plaintiff does not claim, and cannot claim, that the wire sieve is, simply in connection with the rim, patentable, because both of those things existed anterior to his patent.

What, then, is his patent? It is that, in connection with a metallic rim, he produces a sieve by swaging, which works out the results here shown. On the other hand, defendant takes the wire sieve, which is not new at all, connected with the rim, which is fastened by what is known in the mechanical arts as "double-seaming." There is nothing new in double-seaming. It is a mode known long before this patent as one for fastening not only lid-heads of cans, etc., but for a variety of other purposes.

Hence, for the purposes of the present motion, it is only necessary for this court to determine, first, that the essential element in plaintiff's patent is a combination of a loop with a sieve-cloth, whereby the edge of the sieve-cloth is clasped within the loop and fastened by swaging.

Now, the connection of a sieve-cloth with the loop in itself is not his patent, unless the swaging follows. And he had no patent, except for the combination. It is a combination patent. Swaging is the important element in determining this patent.

What is swaging? It is a mechanical device whereby compression is produced in a variety of forms other than a plain surface, whether it be curved, hexagonal, or otherwise. The essential element and advantage of the patent of the plaintiff is, that by swaging, he fastens his sieve to

the rim by a swaging process, which tightens the sieve itself, and thereby necessarily produces the rim below, so that the sieve itself does not rest on a line with that rim. Thus, if it were brought over externally with regard to it, the sieve would rest on the rim; but, by being swaged in the mode here indicated, not only produces the rim, but tightens the sieve-head by but one operation, and, so far as the swaging is concerned, produces the required result.

The defendant simply resorts to an old and well-known mode of double-seaming, which is entirely distinct and different from plaintiff's mode. Double-seaming is simply double-bending a metallic material so that the wire of the sieve passes through one loop with another over it, and thus, by fastening the sieve together retains its position without any swaging at all. There is nothing new in the double-seaming process as a mode of fastening. You may fasten a preserve or any other can by the double-seaming process, which is entirely simple in itself, old and well-known to every housewife and every mechanic. But swaging is an entirely different matter. It is the producing of a given form and given result by the use of what are known as "swaging tools," which tools produce from the two parts any form that you desire produced. Thus, a straight impression (illustrating), parallel as two books produced by compression, is no swaging at all. By swaging, you may make them take any desired form. If you wish to produce a curved form, and one tool is pressed convex against a concave surface, the material between will take the curved form.

There is nothing new at all or strange in placing two things parallel with each other, and with sufficient application of force squeezing them together. There is nothing new in that. It is as old as the use of two parallel forces. But by the use of swaging, you may give any form you desire, consequent upon the use of swaging tools. This patent, then, is for the use of a swaging tool in the manner described in the claim, which accomplishes the result therein stated.

The defendant uses no swaging tool, but resorts to the old and well known mode of double seaming. This is the essential element on which this bill is founded.

The second element is for a design patent.

But before passing on that I will remark that, looking at the affidavits filed by the plaintiff and defendant with regard to the alleged infringement of the combination patent, if the matter rested solely on the affidavits, the weight of testimony would be entirely against the plaintiff. But there are certain matters, as the Supreme Court of the United States has decided as consonant with right reason, which the court can always consider independent of affidavits—of such general principles as are supposed to be known to every one of ordinary intelligence. Now, every one of ordinary observation and intelligence has known for a long period of time what double-seaming is, and though he may not have known the name, he may or may not have known what swaging is. The testimony before the court shows what swaging is, and in the light of these matters the court determines that it is an essential element to plaintiff's patent that swaging should be used in connection with his loop and tightening process.

The second matter involved in his bill is what is called a "design patent," concerning which there are one or more affidavits presented. This is the question to be considered first. What is a design patent? Complainant insists that he is assignee of the design patent, whereby through flaring—a conical section—these sieves may be nested. Without going into the discussion whether this is within the meaning of the patent law, a design patent, which is extremely doubtful, it must suffice to say that, in the light of the affidavits and common experience, the alleged design is nothing new. And even if it fell within the meaning of the patent law—a patentable design—there is no novelty in it. Putting one thing in another, and making a little flaring instead of rectangular, is an old matter.

Third. Plaintiff claims that this defendant has infringed his trade-mark. He says that his product is called a "metallic sieve," and puts it on the market as "Mann's metallic sieve." This is his trade-mark.

Defendant's sieve bears the name of this corporation—"The St. Louis Wire Goods Company." Defendant sends its product on the market under its specific brand. So far as any pretense exists here that the trade-mark exists in the

words "metallic sieve," disconnected from the words "Mann's metallic sieve," there can be no foundation for an injunction. The metallic sieve is nothing new. It is well known. But if this defendant had designated his sieve "Mann's metallic sieve," he would have infringed his trade-mark. He stamps on the metallic sieve his own name, thus indicating that it is his own manufacture, and consequently he does not fall within any rule known to trade-marks.

This matter has been thrust upon me in the midst of other business, and I have not had time to write an opinion; but it is immaterial in this stage of the inquiry. I treat the patent as valid, and I treat as an essential element of that patent the swaging process whereby plaintiff's result is produced. As defendant's result is obtained by other than the swaging process, there is no infringement.

The defendant's product is produced by double-seaming, which is entirely distinct and separate from swaging, and known long before this patent was issued.

As to the design patent, it is doubtful whether it falls within the purview of the patent law. If it does, it has no novelty.

As to the plaintiff's trade-mark, it is not used by defendant, and hence the motion for provisional injunction is refused.

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WILSON PACKING COMPANY, *et al.* v. CLAPP.

U. S. Circuit Court, Northern District of Illinois. Decided 1878.

O. G., Vol. 13, p. 368.

1. The main and principal features of the art of preserving fruits, vegetables and meats, in hermetically sealed cans or packages being old, whether a patent for each particular article of canned goods "as a new article of commerce" can be sustained as a new invention, *Quære.*

2. Courts should not be hasty or inconsiderate in granting injunctions at the instance of the holders of such patents against other manufactures of similar goods. Preliminary injunction accordingly dissolved, leave to make motion to such effect based on suitable affidavits being granted at the time of the injunction.

3. Doubted whether a frusto-pyramidal shaped packing-can with rounded corners for containing preserved meat, and which facilitates its removal in solid mass, is as a form or configuration a patentable design, because lacking in novelty for analagous purposes.

4. The defendant having neither made nor sold goods in the similitude of complainants' goods within the district where suit was brought, the preliminary injunction was dissolved; ordinarily such process cannot run beyond the district from whence it issues.

Messrs. Munday & Evarts, Messrs. West & Bond, Mr. John N. Jewett, and Mr. T. A. Goodwin, for complainant.

Messrs. Eldridge & Tourelotte, Messrs. Noble & Orrick, and Messrs. Coburn and Thatcher, for defendants.

BLODGETT, J. On the fifth day of January last a motion was made by said complainants, based on the bill and affidavits previously filed, for an injunction restraining the defendants from putting up, manufacturing, or selling canned cooked corn-beef in such manner as to infringe upon certain patents belonging to complainants, and particularly described in the bill. The bill and affidavits were not read, but both parties being represented by counsel, it was conceded that a case was made for an injunction, and an injunction order was accordingly entered as prayed, with the understanding that defendant might move for the vacation of said order as soon as counsel could prepare their affidavits. The affidavits were soon after filed, and the motion submitted upon the allegations and proofs of the respective parties, and the briefs and arguments of counsel.

The bill charges that complainants own the three patents relating to the subject matter of packing and preserving meats in hermetically sealed cans or packages.

The first of said patents was issued in 1864 to W. C. Marshall, the second was issued in 1874 to W. J. Wilson, and the third was issued in 1875 to J. A. Wilson. All these patents have been reissued, and two of them (the Marshall and one of the Wilson) within the past year.

The claims are, briefly, for canned meat put up in the manner described "as a new article of commerce;" and

for some special improvements in the cans or packages, the principal of which is the shape of the can, the Wilson can being made in the form of a section of a pyramid with rounded corners, whereby the solidly-packed contents of the can are turned out in a firm mass or cake by cutting off the bottom or large end of the can, so that the beef can be readily cut in slices for the table.

The process of preserving fruits, vegetables, and meats in hermetically sealed cans or packages is not new or original to these patentees.

In 1810, M. Appert published in France the details of the process then lately discovered by him for preserving fruits, vegetables, and meat by parboiling or cooking them so as to expel the fixed air, and then sealing them up in air-tight cans, bottles, or jars.

This discovery was considered of so much importance to the world that the French government paid M. Appert 10,000 francs for making it public, and the art has since then been extensively practiced both in this country and in Europe.

The Appert process was afterward improved by Durand, Doukin, Gamble and others in England, and by Winslow and others in this country, so that canned food of various kinds had become an article of commerce long before the date of either of complainants' patents. 9, Encyclopedia Britannica, 767: title, Food, published in 1855. 13, New American Cyclopedia, published 1863: title, Preservation of Food, page 569.

The main and principal features of the art being so old, it will be at least a nice question how far a patent for each particular article of canned goods, "as a new article of commerce," can be sustained as a new invention. I do not mean to be understood as now saying that such patents are invalid for want of novelty. I only intend to say that I think courts should not be hasty or inconsiderate in granting injunctions at the instance of the holders of such patents against other manufacturers of similar goods.

And had the whole facts been brought to my notice as they are now, at the time the original motion was made, I feel sure I should not have granted the injunction. So far as the complainants' patents cover the cans they use, no

special proof is put into the record. To the eye, the cans used by complainants and those said to have been sold by defendant appear to be, externally, substantially alike.

But I doubt whether the pyramidal shape, which is the distinctive feature of complainants' can, is a patentable device.

It would seem to be a shape so often adopted in other packages and molds, when it is desirable to turn the contents out whole or solid, as to be no longer novel. Still, it may be patentable,—I only intimate a doubt,—and say that I think a court should be cautious in regard to such a patent.

Aside from the objections that apply directly to the patents, it does not appear from the record that this defendant has ever made or sold any goods in the similitude of complainants' goods in this district.

He is the agent of a St. Louis packing company for the sale of their goods in New York City, and does no business, and has no place of business, in this district.

A preliminary injunction ought not, therefore, to issue against him in this district, because such a process cannot run beyond the terminal limits of the district—certainly not in an ordinary case—such as is made in this record. A case possibly might be made upon extraordinary facts, which would justify such an issue, but such a case is not made here.

It also appears that, immediately on the entry of the order in this case, circulars and notices were sent outside of the district to parties engaged in the trade dealing with the complainant's competitors, intended to alarm such persons and injure the trade of competing manufacturers.

This strikes me as hardly justifiable under the circumstances. I think complainants, if they have faith in their patent, should make their attack directly on such competitors as they claim are infringing their patents, and contest the question squarely with them.

This class of goods has now, according to the proofs, gone into very general use as an article of food, and can be found for sale in most family groceries; and it seems to me not the right course to attack these dealers, and annoy and intimidate them by threats of patent suits.

The course taken by complainants suggests the charge that they intend to obtain many of the advantages of an injunction by harassing and interfering with the business of a rival without taking the risk of a direct suit with that rival, where they would be responsible for the consequences of their act. Such may not have been their purpose, but it is liable to such construction.

The injunction is dissolved.

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PRATT AND ANOTHER *v.* ROSENFELD AND ANOTHER.

Circuit Court, Southern District New York.

Decided June 14, 1880.

2 Fed. Rep., p. 335.

1. A design for a card of buttons, divided into spaces covered with foil by narrow bands, with a dozen of pearl buttons in rows of three by four to each space, is not a "new, useful, and original shape or configuration of an article of manufacture" within the meaning of Section 4929 of the Revised Statutes, relating to the granting of patents.
2. Cards for buttons, faced with foil and divided into spaces by bands, were well known and in common use prior to such design, and there was, therefore, nothing in this arrangement rising to the level of inventive skill.

George C. Lay, Jr., for plaintiffs.
Edmund Wetmore, for defendants.

WHEELER, D. J. This suit is brought upon Design Patent No. 7914, for a design for a card of buttons, divided into spaces, covered with foil, by narrow bands, with a dozen of pearl buttons in rows of three by four to each space.

The statute (Rev. St., Sec. 4929) authorizes the grant of a patent to any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statue, *alto-relievo*, or bas relief; any new design for the printing of woolen, silk, cotton, or other fabrics; any new and original

impression, ornament, print, or picture to be printed, painted, cast, or otherwise placed on or worked into, any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof.

The subject of this patent is not covered by this statute, unless it is included in the term "manufacture." The buttons are, however, the principal thing, and they are not changed at all, either in form or appearance, by the patented invention. It affects nothing but the card; and that is not a card for buttons, to be used for successive sets, but a card of buttons, which constitutes a mere method of putting them up for sale, to attract customers; not on account of anything at all about the thing sold, but wholly on account of the manner of arranging it for sale.

In Langdon *v.* De Groat, 1 Paine, C. C. Rep. 203, the invention was for folding thread and floss cotton in a manner different from the ordinary mode, whereby it would sell quicker and higher. The Court said: "The article itself undergoes no change, and the whole of the improvement—for it is a patent for an improvement—consists in putting up skeins of it, perhaps of the same size in which they are imported, decorated with a label and wrapper, thus rendering their appearance somewhat more attractive, and inducing the unwary not only to give it a preference to other cotton of the same fabric, quality, and texture, but to pay an extravagant premium for it.

"Now, that such contrivance—for with what propriety can it be termed a useful art, under the constitution—may be beneficial to a patentee, if he can exclude from the market all other retailers of the very same article, will not be denied; and if to protect the interests of the patentee, however frivolous, useless, or deceptive his invention may be, were the sole object of the law, it must be admitted that the plaintiff has made out a satisfactory title to his patent. But, if the utility of an invention is to be tested by the advantages which the public are to derive from it, it will not be perceived how this part of his title is in any way whatever established. It is said that many ornamental things are bought, of no intrinsic value, to gratify the

whim, taste, or extravagance of a purchaser, and that for many of these articles patents are obtained. This may be so, but in such cases there is no deception, no false appearance, and the article is bought to be used with all its decorations and ornaments, which may have been the principal inducements to the purchase, and which will last as long as the article itself."

In this case the buttons are to be used by the purchaser, but the card is not, either with them or by itself. The design does not apply to the manufacture proper, but only to the arrangement of it for sale. Putting an article into a more convenient form for sale without changing its qualities or properties, is not patentable as an improvement in the article. Glue Co. *v.* Upton, 97 U. S. 3. So, merely changing the mode of keeping and presenting an article for sale, without changing its form or appearance, will not support a patent for a design. There should be something affecting the article itself. Further, cards for buttons faced with foil and divided into spaces by bands, were well known and in common use. Those for pearl buttons may not have been divided into dozens, in rows of three by four, but they were divided so that dozens could be readily cut from the card, in two rows of six and one of twelve; and there were cards divided into spaces for several dozens by such bands as the patent describes; and cards of cloth buttons spaced for dozens in rows of three by four. With these things known, there was nothing rising to the level of inventive skill in arranging pearl buttons by dozens on cards in three rows of four.

Let a decree be entered dismissing the bill of complaint with costs.

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SIMPSON *v.* DAVIS.

Circuit Court, E. D. New York. Decided March 13, 1882.

12 Fed. Rep., p. 144.

1. A claim is not defeated merely because scrolls and ornamentation similar in effect to the scrolls and ornamentation described have before been employed, if a new idea is embodied in the method of their arrangement.

2. The statute permits a patent for any new, useful, and original shape or configuration of any manufacture; and where the arrangement of ornament and shape is new, useful, and original, the invention is patentable.

Edwin H. Brown, for plaintiff.
N. H. Clement, for defendant.

BENEDICT, D. J. This action is brought upon a patent owned by the plaintiff, which, it is alleged, has been infringed by the defendant. The patent is for design No. 12,026, and was issued November 9, 1880, to Henry Textor. The specification states that Henry Textor is the originator and producer of a new and improved design for newel posts, the character of which is illustrated by a drawing accompanied by a description. There are eleven claims. Only the fifth, the sixth, and the eleventh are relied on here. It is not disputed that the defendant is engaged in manufacturing newel posts, similar in ornament, shape, and configuration to the newel posts described in the plaintiff's patent. The similarity is so great, that a photograph of the plaintiff's newel post is admitted to correctly represent the newel post made by defendant. No question in regard to the infringement is therefore raised, but it is contended that the patent is void for want of novelty as well as of patentability in the subject matter.

The fifth claim of the patent is for "a design for the upper portion of a newel post, consisting of the scrolled ornaments l, and the bead m, the roses or rosettes n, upon each side, as specified." The statute (Rev. St. Sec. 4929), authorizes a patent for any new and original ornament to be cast or otherwise placed on any article of manufacture. The subject matter of the claim under consideration is for an ornament, not for a newel post or a part of a newel post having a new and original shape or configuration, but for an ornament intended to be placed upon a newel post. The claim does not seek to secure the scroll by itself, nor the bead by itself, nor the roses by themselves. Each of these is an ornament, but neither of them is new. The claim, therefore, seeks to cover these forms associated together in the manner described as composing a single orna-

ment. In the matter of ornamentation, mere juxtaposition of old forms is doubtless sufficient to authorize a patent for an ornament when, by means of such juxtaposition, accomplished by industry, genius, effort and expense, the old forms are made to become component parts of an ornament substantially new in its effect. But the result of the industry, genius, effort and expense employed must, as I suppose, be a single ornament, which, taken as a whole, can be considered to be the embodiment of a new idea in ornamentation. The amount of the novelty may be small, but the effect of the ornament must, to some extent at least, be new. The ornament may, in this sense, be new and original, although all the forms used in its composition are old and well known forms of ornamentation.

The claim under consideration is therefore not defeated when it is shown that scrolls similar in effect to the scroll described in the claim, and that beads and roses such as those described, have often before been employed in the ornamentation of newel posts. The difficulty with the claim does not arise from want of novelty in the forms employed, nor yet in the want of novelty in the method of arranging these forms, because, simple as the arrangement is, the case furnishes no evidence that a scroll and roses were ever before arranged one above another, with only a bead between. But I find it difficult to consider that the scroll, roses, and bead, when arranged as described in the claim, constitute a single ornament. There is no commingling of the lines forming the scroll, the bead, and the roses; no new idea seems to be embodied in the method of their arrangement. All that has been done is to place these distinct and well-known ornaments one above the other, without the production of any such combined effect as to entitle the whole to be treated as a new and original ornament. No new ornament has in fact been produced. If, therefore, the plaintiff's action rested upon the fifth claim of his patent alone, I should hesitate to uphold it.

The sixth claim is for "a design for the cap of a newel post, consisting of the gable-like projection, e, having rounded or curved outlines, the recessed or sunken scrolled ornaments, s, the foliated moulding, t, and the fillet, u, as specified." The statute authorizes a patent for "any new

and original design for a manufacture;" and this claim is intended to cover such a design. The first question presented by this claim is whether the cap of a newel post is a manufacture within the meaning of the statute. The testimony shows that the cap of a newel post is a distinct article often manufactured by itself, but never used except in connection with other parts, which, taken together, go to make up what is known as a newel post. Upon this testimony I incline to the opinion that the article described in the sixth claim, namely, a cap of a newel post, may be held to be a manufacture; but whether this be so or not seems of no importance in view of the seventh claim of the patent, which is for the whole newel post, including the cap. The statute permits a patent for any new, useful, and original shape or configuration of any article of manufacture. The seventh claim describes an article of manufacture, namely, a newel post of a certain shape or configuration, and having, among other distinctive features, the ornaments described in the fifth claim, and the cap described in the sixth claim.

Against this claim the only defence made is that the distinctive features of the newel post described were to be found in other newel posts prior to the date of the plaintiff's invention, and many of them, in fact, copied by the inventor himself from newel posts erected in New York. But here the difficulty with the defence is that there is no evidence that any newel post substantially similar in shape and configuration to the one described in the plaintiff's patent had ever before been designed. The arrangement of ornament and shape presented by the plaintiff's post is new, useful, and original. The several experts testify that the newel post described in the patent would not be considered, either by the trade or by those wishing to buy such articles, to be similar to any of the other newel posts put in evidence; and the proof is that as between the plaintiff's newel post and the one most similar to it of all those put in evidence, the demand has been twenty to one in favor of the plaintiff's post. Moreover, the defendants have thought it worth the while to copy the plaintiff's post exactly.

I am therefore of the opinion that the seventh claim of the plaintiff's patent can be upheld, and that the patent secures to the plaintiff the exclusive right to make newel

posts such as are in said claim described. The fact being undisputed that the defendants have made newel posts similar to the post described in the seventh claim, it follows that the plaintiff is entitled to an injunction as prayed for, and also for an accounting.

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WESTERN ELECTRIC MANUFACTURING CO. *v.* ODELL AND OTHERS.

District Court, N. D. Illinois. Decided October 29, 1883.

18 Fed. Rep., p. 321.

1. Letters patent issued on the 15th of February, 1876, to Charles W. Lewis, for a design for the dial of an annunciator, held invalid for want of novelty.

2. It is now tolerably well settled that design patents stand on as high a plane as utility patents, and require as high a degree of exercise of the inventive or originative faculty. In patentable designs a person cannot be permitted to select an existing form, and simply put it to a new use, any more than he can be permitted to take a patent for a mere double use of a machine; but the selection and adaptation of an existing form may amount to patentable design, as the adaptation of an existing mechanical device may amount to patentable invention.

Geo. P. Barton, for complainant.

James L. High, for defendant.

BLODGETT, J. This is a bill filed by the complainants as owners of a patent issued on the fifteenth day of February, 1876, to Charles W. Lewis, for a design for the dial of an annunciator. The defendants demur to the bill, and raise upon the demurrer the question of the validity of the patent for want of novelty. The scope of the patent is best stated in the language of the patentee himself in his specification. He claims to have invented a design for the face or dial of an annunciator, of which the following is description:

"a represents the face or dial-plate of the annunciator, and is shown slightly in perspective. b represents the figures on the dial-plate, which are intended to be the same

as the number of the rooms with which the annunciator is connected. Letters are sometimes used instead of figures. *c* are pointers or indicators which turn to the figures or letters indicating the room from which the call is made. The dial is made a dark color or jet black. The figures, b, are made of the color of gold leaf, and the indicators are made of light metal color by preference. But I do not wish to limit my invention by making the figures of gold color, and the indicators light metal colors, because the same contrast could be produced by making the indicators gold color and the figures light metal color, which would produce substantially the same appearance in connection with the black ground. I have not represented the different colors in the drawing, but have shown the different parts, so that, when taken in connection with these colors, my invention will be limited to the contrast of colors, substantially as above specified; my design, consisting of the dark dial-plate, and the bright figures and indicators or pointers of different bright colors, making a contrast of colors, and presenting a very attractive appearance."

I find the law on the subject of design patents so well condensed and stated in a little work lately published by Mr. Simonds, that I cannot do better than read his summary, as stated on page 212:

"For a time it was the practice of the Patent Office to grant these design patents for almost any subject matter presented, and with little or no inquiry as to whether any degree of patentable origination had been exercised. It is now tolerably well settled that design patents stand on as high a plane as utility patents, and require as high a degree of exercise of the inventive or originative faculty. In patentable designs a person cannot be permitted to select an existing form and simply put it to a new use any more than he can be permitted to take a patent for a mere double use of a machine; but the selection and adaptation of an existing form may amount to patentable design, as the adaptation of an existing mechanical device may amount to patentable invention."

In support of this enunciation of the law, Mr. Simonds quotes from Wooster *v.* Crane, 2 Fisher, Pat. Cas. 583, as follows:

"The act, although it does not require utility in order to secure the benefit of its provisions, does require that the shape produced shall be the result of industry, effort, genius, or expense, and must also, I think, be held to require that the shape or configuration sought to be secured shall at least be new and original as applied to articles of manufacture."

So, also, in Northrup *v.* Adams, 2 Ban. & A. 567, it is said: "The same general principles of construction extend to both. To entitle a party to the benefit of the act in either case, there must be originality and the exercise of the inventive faculty. In the one there must be novelty and utility; in the other originality and beauty. There must be something akin to genius—an effort of the brain as well as the hand. The adaptation of old devices or forms to new purposes, however convenient, useful or beautiful they may be in their new role, is not invention. . . . If a combination of old designs be patentable at all, of which I have some doubt, the combination must be such as to produce a new appearance. If the effect produced be simply the aggregation of familar designs, it would not be patentable. For example, if one should paint upon a familiar vase a copy of Stuart's portrait of Washington, it would not be patentable, because both elements of combination—the portrait and the vase—are old; but if 'any new and original impression or ornament' were placed upon the same vase, it would fall within the express language of the section."

In Gorham Co. *v.* White, 14 Wall. 511, the Supreme Court said: "In whatever way produced it is the new thing produced which the patent law regards."

I have read enough to show that the text of Mr. Simonds is fully sustained by the authorities quoted.

The patent in this case is for a mere black dial-plate, upon which the inventor places a gold letter or figure indicating the number of the room, and a white metal pointer. There is no border or configuration upon the dial or around it of a peculiar or ornamental character, nor is there a cornice or binding of any kind, but simply a bald, black face, with the gold-colored figures or letters, and the silver or light metal-colored hands or indexes; nothing new or

original in the shape or ornamentation of the dial-plate, figures, or pointers is shown or indicated. The only trouble I have had with the case has been whether the court could import sufficient of what we call common knowledge into the case to say, on demurrer, that this was an an old device applied to a new use. While the case was on argument I drew my watch from my pocket, as I thought the analogy was a fair one, and opening it I found substantially the combination on its face or dial, with merely a change of the colors, that is shown on this patented dial-plate; that is, I found a white face instead of a black one, and black figures indicating the hours, and metal or gold-colored hands, so that there was the same contrast of colors as that on which this inventor claims to base his patent. There were the three elements, the white face, the black figures, and the gold-colored pointers, making the precise combination for the purpose of contrast which the inventor says is the gist of his invention. An examination of the decision of the Supreme Court of the United States in Brown *v.* Piper, 91 U. S. 37, satisfies me that the court can, from its common knowledge, say that the design covered by this patent is only a new use of an old and well-known device. Certainly there is nothing more completely within the scope of common knowledge than the dial-plate of a watch. The clock before us in this room presents nearly the contrast the inventor claims for his device, and you can hardly walk the streets without finding in nearly every signboard the same contrast of colors for the purpose of making an ornamental and attractive sign. As I have already suggested, if in connection with this contrast of colors, there had been a border around the dial-plate of a new and original composition in combination with these old parts, with the old contrast of colors, the patent might be sustained; but there is no such combination here.

The demurrer to the bill, therefore, is sustained, and the bill dismissed for want of equity.

POST AND OTHERS *v.* T. C. RICHARDS HARDWARE CO.

Circuit Court, District Connecticut. Decided February 11, 1886.

26 Fed. Rep., p. 618.

1. A claim for "a new and original design for a curtain and loop, consisting of an ornamental metallic chain in connection with a curtain adapted to be gathered to the side of the window and be held by said chain, substantially as described," construed to be, so far as the chain is concerned, for any ornamental metallic chain used to loop curtains.
2. If the substitution of any metallic loop for a silk or woolen loop for curtains can be called a "design," it is clear that it is not a patentable design.
3. The mere substitution of one material for another in the construction of, or for the purpose of, an ornament, the ornament to be of any approved form, cannot properly be patentable. There is nothing which the law deems "new" in a mere change of that sort.

William Edgar Simonds, for plaintiffs.
Frank L. Hungerford, for defendant.

SHIPMAN, J. This is a bill in equity to restrain the infringement of Design Patent No. 11,947, issued to Edgar S. Gergason, August 17, 1880, for a curtain and loop. The complainant having made profert of the patent, the defendant has demurred upon the following grounds:

"(1) That it appears upon the face of the letters patent recited in said complainants' bill of complaint that the Commissioner of Patents exceeded his jurisdiction in granting and issuing said letters patent. (2) Because it appears upon the face of the letters patent recited in the said complainants' bill of complaint, that said invention or discovery, if any such there be, is not a design within the meaning of the Act of Congress in such case made and provided, and cannot be protected by letters patent therefor; that is to say, the alleged design is not a 'new and useful design for a manufacture, bust, statue, *alto-relievo*, or bas relief;' not a 'new and original design for the printing of woolen, silk, cotton, or other fabrics;' nor a 'new

and original impression, ornament, patent, print, or picture to be printed, painted. cast, or otherwise placed on or worked into any article of manufacture;' nor a 'new, useful, and original shape or configuration of any article of manufacture.' (3) Because the claim of said design letters patent does not cover any patentable invention, but is for matters and things which do not involve patentable novelty, in view of the well-known prior act, of which the court will take judicial knowledge."

The specification described the patented design as follows:

"Heretofore curtains have been looped back at the sides by means of cords or braids, ornamental or otherwise, which have been attached to the sides or casing of the window or door, and passed around the folds of the material. These loops have been made of silk or woolen, or of an inferior material covered with silk or woolen, and have been of a perishable nature, soon becoming frayed and moth eaten. The leading feature of my design consists in looping back a curtain by means of an ornamental chain in the place of the customary cord. The curtain is of that class which is gathered to one side and looped. The chain consists of a series of links, with a ring at each end, which rings are passed over an ornamental hook attached to the side of the casing of the window or door to which the curtains are applied. One end of the chain can be permanently united to the hook if desired, as it is only necessary to unhook one end to loop or unloop the curtains. . . . My invention is especially adapted to curtains made of heavy, rich, and ornamental silk or woolen goods, and particularly to those which are hung upon metallic bars or supports at the top, the whole presenting a superior symmetry and finish, much more elegant than when the curtains are looped back by cords in the customary manner. The chains can be made of a variety of ornamental forms, and with a high degree of finish, and will retain their beauty for an almost unlimited period of time."

The claim is for a "new and original design for a curtain and loop, consisting of an ornamental metallic chain in connection with a curtain adapted to be gathered to the side of the window, and be held by said chain, substantially as described."

It will be observed that no new form or shape or fold is given to the curtain, and that the loop has no new form, shape, or impression; but, on the contrary, it may have a variety of forms. It is the old loop of silk or woolen, but it is made of metal. Nothing is requisite except that it shall be metallic, and shall be ornamental. The patent is for any ornamental metallic chain used to loop curtains.

The plaintiffs urge, with truth, that the metallic chain is in pleasing contrast with the curtain, and has, in connection with the curtain, a beauty of appearance, and is an ornament to the curtain, and that "the thing invented or produced for which a (design) patent is given, is that which gives a peculiar or distinctive appearance to the manufacture or article to which it may be applied, or to which it gives form." Gorham Co. *v.* White, 14 Wall. 511. It is therefore claimed that the patented thing is a "design" within the meaning of the statute. It is not clear that the substitution of any metallic loop for a silk or woolen loop is a "design" of the character which the statute contemplates; but, without deciding that question, it is clear that if such a change can properly be called a design, it is not a patentable design. The mere substitution of one material for another in the construction of or for the purpose of an ornament, the ornament to be of any approved form, cannot properly be patentable. There is nothing which the law deems "new" in a mere change of that sort.

The demurrer is allowed.

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KRAUS, *et al.*, *v.* FITZPATRICK, *et al.*

Circuit Court, S. D. New York. Decided February 24, 1888.

34 Fed. Rep., p. 39.

1. Design patent No. 13,620, dated February 13, 1883, and granted to Frank Walton, being for a design for corsets, readily distinguishable by ordinary persons from those of any prior design, is valid.
2. The fact that the ornamental form or shape constituting the design, adds to the utility of the article, does not affect its patentability as a design.

Robert H. Duncan, for orators.
Lawrence E. Sexton, for defendants.

WHEELER, J. This suit is brought upon Design Patent No. 13,620, dated February 13, 1883, and granted to Frank Walton, assignor to the orators, to run seven years, for a corset. The principal features of the design, as specified in the claim, are a ribbed band at the lower edge, extending from the extreme front up over the hip, and down to the rear portion, and a series of ribs each side of the central hip-line, beginning at the top and extending downward, and diverging on to the ribbed band. The shape given to the corset by extending the lower edge up over, instead of around the hip, appears to add to the utility of the corset as an article of manufacture, as well as to its appearance. The patent is not, however, for an article of manufacture as such, which would have to be taken out under other provisions of the law than those relating to design patents; but is merely for the new appearance given to the article by constructing it according to the design. But the fact that a corset made according to the design would have that utility would not appear to make the design any the less patentable, if in itself, as a design, it was sufficiently new. The test of infringement of a design patent appears to be the existence of such similarities as will lead ordinary persons to think the articles in question are the same. Gorham Co. *v.* White, 14 Wall., 511; Jennings *v.* Kibbe, 20 Blatchf., 353; 10 Fed. Rep., 669. The test of novelty would, therefore, appear to be the existence of such differences between articles embodying the patented design and those existing before as would be recognised by the same class of persons. Lehmbeuter *v.* Holthaus, 105 U. S., 94. The nearest approach to the design of this patent shown by the evidence, and the one most relied upon by the defendants, is that shown in the patent to Paul I. Hertzog, No. 12,773, dated February 21, 1882. That has the ribbed band at the lower edge, but not extending up over the hip so far; and it does not have the series of ribs, distinguishable from the rest, on each side of the hip line. Most of the special features of this design are to be found separately, in prior things, but they are nowhere combined so as to make such an

effect as a whole; and that is what is to be looked at. Perry *v.* Starrett, 3 B. & A., 485. As a matter of fact, in this view, it clearly enough appears that corsets of this design would be readily distinguishable by ordinary persons from those of any prior design. The patent appears, therefore to be valid. Infringement is not disputed, and is clear; so clear that it shows the results of copying. The orators are, therefore, entitled to a decree.

Let a decree be entered that the patent is valid; that the defendants infringe; and for an injunction and an account according to the prayer of the bill, with costs.

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OSBORN *v.* JUDD, *et al.*

U. S. Circuit Court, Southern District of New York.

Decided November 20, 1886.

38 O. G., p. 1132.

A preliminary injunction will not be granted to restrain the infringement of a "design for a banner-rod, consisting of a conventional imitation of a straight twig with the bark and slantingly-cut ends," the section which relates to design patents demanding, it may be supposed, the exercise of more genius than is exhibited by it.

Mr. Joshua Pusey, for the complainant.
Messrs. Briesen & Steele, for the defendants.

SHIPMAN, J. This is a motion for a preliminary injunction against the infringement of a design patent. The design is sufficiently stated in the claim, which is as follows:

"The design for a banner-rod herein shown and described the same consisting of a conventional imitation of a straight twig with the bark on and slantingly-cut ends."

I have great doubt whether there is anything which shows genius or which indicates the work of an inventive mind, and therefore whether there is anything patentable in merely making a banner-rod to imitate measurably a straight twig with the bark on. This natural and simple design for a banner-rod would, I think, readily suggest itself to the up-

holsterer. There is so much reason to suppose that the section which relates to design patents demands the exercise of more genius than is exhibited in the patented design, the motion should be denied.

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NEW YORK BELTING AND PACKING CO., *v.* NEW JERSEY CAR-SPRING AND RUBBER CO.

Circuit Court, S. D. New York. Decided April 13, 1887.

30 Fed. Rep., p. 785.

1. It is not novelty which will sustain a design patent to transfer to rubber, or to a rubber mat, an effect or impression to the eye which has been produced upon other materials or articles by contrast or variation of light and shade.
2. Where such a patent is merely an attempt to secure to the patentee a monopoly of all ornamentation upon rubber mats, by which variations of light and shade are produced by a series of ridges and depressions, without regard to any particular arrangement or characteristics of the lines, except that they are to be parallel, the patent is invalid.

A. von Briesen, for complainant.
W. H. L. Lee, for defendant.

WALLACE, J. It is insisted by demurrer to the bill that the patent sued upon is invalid upon its face for want of novelty. In determining the question, the Court can only consider such familiar facts as fall within the category of those things of which judicial notice will be taken. The patent is for a "design for a rubber mat." The patentee states in the description, that "in accordance with the design, the mat gives, under the light, different effects, according to the relative position of the person looking at it. If the person changes his position continuously, the effects are kaleidoscopic in character. In some cases, moire effects, like those of moire or watered silk, but generally mosaic effects, are produced. Stereoscopic effects, also, or the appearance of a solid body or geometric figure, may at times be given to the mat, and under proper conditions, an ap-

pearance of a depression may be presented. The design consists in parallel lines of corrugations, depressions, or ridges, arranged to produce the effects as above indicated. I may divide the mat by a number of imaginary lines, representing a projection of any geometrical figure, and in each of the sections so formed, make parallel corrugations or alternate ridges or elevations, the different sets of corrugations making with each other the proper angle to give the effects sought for. To give the moire effects, I usually make the ridges and depressions undulating, while maintaining the parallel position with relation to each other. I desire, therefore, to have it understood that I do not intend to limit the design to parallel corrugations, which are straight throughout any considerable portion of their length, but that it includes the undulating ridges and depressions, or other disposition or formation in which the corrugations alter their direction irregularly, or in which they may be straight for a certain distance, and then formed in undulations, and that it includes the corrugations arranged in concentric circles, in spirals, in zigzags, or according to any desired figure."

The claims are as follows:

(1.) A design for a rubber mat, consisting of corrugations, depressions, or ridges in parallel lines, combined or arranged relatively, substantially as described, to produce variegated, kaleidoscopic, moire, stereoscopic, or similar effects, substantially as set forth. (2.) A design for a rubber mat, consisting of a series of parallel corrugations, depressions, or ridges, the lines of the said corrugations being deflected at one or more points, substantially as set forth. (3.) A design for a rubber mat, consisting of a series of parallel corrugations, depressions, or ridges, arranged in sections, the general line of direction of the corrugations in one section making angles with or being deflected to meet those of the corrugations in the contiguous or other sections, substantially as described."

The patent is an attempt to secure to the patentee a monopoly of all ornamentation upon rubber mats by which variations of light and shade are produced by a series of ridges and depressions, without regard to any particular arrangement or characteristics of the lines, except that they

are to be parallel. Although there is an illustration in the drawing, and although each claim is for a design "substantially as described," the language of the specification is carefully expressed, so as not to restrict the claims to the design shown in the drawing, but so that the first claim shall include every variety which can be produced by the arrangement of corrugations, depressions, or ridges in parallel lines; the second, all obtainable when by the arrangement the corrugations are deflected; and the third, all obtainable when, by the arrangement of corrugations in sections, those of one section make an angle with those in contiguous or other sections.

It was not new to produce contrasts and variations in light and shade, or stereoscopic effects, by depressions or elevations in the surface of materials. It was old to do this by arranging them in parallel lines, as is wood, plaster, and corduroy cloth. It is not novelty which will sustain a design patent to transfer to rubber, or to a rubber mat, an effect or impression to the eye which has been produced upon other materials or articles by contrast or variation of light and shade. The design of this patent is not new, unless it embodies a new impression or effect produced by an arrangement or configuration of lines which introduces new elements of color or form. This is not claimed.

None of the claims can be limited to a design which produces any definite or concrete impression to the eye.

The demurrer is sustained.

NOTE.—See also the following Patent Office decisions, contained in the appendix at end of this volume, in further illustration of what is patentable subject matter under the Design Patent Statutes. *Ex parte* Bartholomew, C. D. 1869, p. 103; Bonnage *vs.* Phillipi, 9 O. G. 1159; *ex parte* Doolittle, 2 O. G. 275; *ex parte* Fairchild, 3 O. G. 232; *ex parte* Fenno, C. D. 1871, p. 52; *ex parte* Crane, C. D. 1869, p. 7; *ex parte* King, C. D. 1870, p. 109; *ex parte* Norton, 22 O. G. 1205; *ex parte* Oglesby, 3 O. G. 211; *ex parte* Parker, 13 O. G. 323; *ex parte* Parkinson, C. D. 1871, p. 251; *ex parte* Seaman, 4 O. G. 691; *ex parte* Shoeninger, 15 O. G. 384; *ex parte* Solomon, C. D. 1869, p. 49; *ex parte* Stetson, 36 O. G. 343; *ex parte* Traitel, 25 O. G. 783; *ex parte* Tyler, C. D. 1871, p. 106; *ex parte* Weinberg, C. D. 1871, p. 244; *ex parte* Whyte, C. D. 1871, p. 304.

CHAPTER III.

Of the Letters Patent, and of the application therefor.

SECTION 1. After various changes by the several Acts of Congress, the term for which design patents may now be issued, is fixed at three and a half, seven, and fourteen years respectively, at the election of the applicant, upon the payment of a fee of ten, fifteen, or thirty dollars, according to the term selected, in the order named.

But the election must be made and the appropriate fee paid at the time of filing the application;[1] it cannot be changed afterwards.[2]

Nor can an application filed for a mechanical patent be changed by amendment into an application for a design patent,[3] or *vice versa*;[4] nor can a functional patent taken for what is properly a design, be construed to be for the design.[5]

SECT. 2. It is provided by Sect. 4933 of the Revised Statutes that all the provisions and regulations for obtaining or protecting patents for inventions or discoveries not inconsistent with the sections of the Revised Statutes relating to other inventions or discoveries and patents therefor, shall apply to patents for designs; and Section 4929 authorizing patents for designs, and defining the subject matter of such patents, the graduated term and fee therefor, provides that the same may be granted upon "other due proceedings had, the same as in cases of inventions or discoveries."

The Patent Office authorities have held that the section of the general law relating to caveats *is* inconsistent with design subject matter, and not applicable thereto, on the ground that no entity of a design can exist in an incomplete condition.[6]

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[1] *Ex parte* Mayo, Com. Dec., 1870, p. 14.
[2] *Ex parte* Haley, 44 O. G. 1399.
[3] *Ex parte* Sellers, Com. Dec., 1870, p. 58.
[4] *Ex parte* Bailey, 37 O. G. 781.
[5] *Cone v. Morgan Envelope Co.*, 4 B. & A. 107.
[6] *Ex parte* Carty, 44 O. G. 570.

No reason exists, however, why a design patent may not be re-issued for defects in the specification; though it has been held, properly, that a mechanical patent cannot be reissued in divisions, one for the mechanical features, and the other for the design.[1]

SECT. 3. There is no good reason why the provisions of the general law relating to the filing of *disclaimers* and the effect thereof, should not be applicable to design patents.

With respect to *interferences*, however, the general law has frequently been applied; and interferences declared not only between two design applications, a design application and a previous design patent, a design application and a previous mechanical patent, but also between a mechanical application and a previous design patent.[2]

With respect to *extensions*, it has been previously remarked in the chapter on the statutes, that they are now entirely prohibited by the general law.[3]

SECT. 4. Much learned argument has been written, with respect to functional patents as to the effect on a subsequent patent or application therefor, of description, without claim, in a prior patent to the same inventor, of the whole or part of the invention subsequently claimed; the weight of authority being that such description in a prior patent to the same inventor constituted no legal abandonment founded on any supposed implied dedication to the public.

The general law, however, raises such a presumption, and bars a subsequent patent, only in cases where the application therefor was filed more than two years after the date of the first patent.

In design cases, however, there are conflicting Patent Office decisions on this subject. So far as they are inconsistent with the rule above laid down, they are believed to be unsound.[4]

SECT. 5. It is scarcely necessary to remark that it is not permissible to include more than one design invention in a single patent. By this it is not meant that a patent may

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[1] *Ex parte* Stuart & Bridge, Com. Dec., 1870, p. 15.

[2] Collender *v.* Griffith, 3 O. G. 91.

[3] See *Ex parte* Sperry, Com. Dec., 1870, p. 139.

[4] *Ex parte* Collender, Com. Dec., 1872, p. 217; Collender *v.* Griffith, 3 O. G. 91 and 267; *Ex parte* Kohler, 4 O. G. 53; *Ex-parte* Palmer, 21 O. G. 1111; *Ex-parte* Stuart & Bridge, Com. Dec., 1870, p. 15; see, also, Collender *v.* Griffith, 2 Fed. Rep. 206.

not properly contain more than a single claim for an integral complete design, because such a design may be made up of segregable parts or combinations of parts equally novel with the whole, and equally patentable;[1] for a single article of manufacture may unite patentable novelty of form with novel surface ornamentation, the whole making up a complete design as a unit, and patentable as such. But what is not allowable is the claiming in a single patent of more than one of the separate subject matters of the design section of the statute when they are not necessarily parts of a unit, or are capable of, or intended for, separate use in or on different and distinct articles of manufacture.[2]

SECT. 6. *As appearance only is to be considered*, because it alone constitutes the thing patented, and not the means of producing it, the conclusion necessarily follows that the specification must describe that only; and all else, such as mode of manufacture, material, function, &c., have no place in such a specification,[3] and are irrelevant surplusage. Draughtsmen of design specifications frequently find it extremely difficult, for this reason, to describe some designs without reference to such irrelevant matters, but this is only because the case in hand is so near the border line of non-patentability as a design; because a design such as contemplated by the statute must be fixed and determined and capable of specific description either in words or by illustration.[4]

SECT. 7. All those provisions of the general law relating to the requisites of the specification and claim would seem to apply to design patents, particularly so because of the requirements of Section 4933, Rev. Stat.; hence it follows that there should be clearness, exactness, and particularity, both in the description and claim;[5] and that the interpretation of the statute,[6] in Seymour *v.* Osborne,[7] to the effect

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[1] *Ex parte* Bailey, Com. Dec., 1879, page 142; *Ex parte* Rogers, 13 O. G. 596; Root *v.* Ball, 4 McLean, 177.

[2] *Ex parte* Brower, Com. Dec., 1873, p. 151; *Ex parte* Gerard, 43 O. G. 1235; *Ex parte* Patitz, 25 O. G. 980.

[3] *Ex parte* Diffenderfer, C. D. 1872, p. 154; *Ex parte* Fairchild, C. D. 1873, p. 45; *Ex parte* Norton 22 O. G. 1205; and see *Ex parte* Traitel, 25 O. G. 783, and *Ex parte* Tyler, Com. Dec., 1871, p. 106.

[4] *Ex parte* Neidringhaus, 8 O. G. 279.

[5] *Ex parte* Neidringhaus, 8 O. G. 279; Untermyer *v.* Jennot, 20 Fed. Rep. 503.

[6] Sect. 4888, Rev. Stat.

[7] 11 Wallace, 516, 540.

that a specification consisting of a *written* description concluding with a particularized and specific claim, and accompanied by a drawing, was an essential prerequisite to a valid patent for a machine, it should perhaps be equally so for a design.

It is quite true that a design may be fully described to the mind by lines in a drawing, yet the statute, in express words, requires a specific and particularized *written* description and claim *in addition* to a drawing. However, the Supreme Court, with one dissenting voice, in a recent decision,[1] has held with respect to surface ornamentation, at least, that a drawing thereof, accompanied by a specification which simply referred to the drawing without attempting to describe the alleged invention, and concluded with a claim for the thing "shown," was a sufficient compliance with the statute. It is to be regretted that this laxity was countenanced by the court of last resort, for its effect is practically to reduce the grade of such patents, and convert them into simple certificates of registration of a drawing.

SECT. 8. Much difference of opinion has existed among patent practitioners, as to the essential requisites of a design specification, and while undue laxity in the preparation of such specifications has been heretofore permitted by the Patent Office, it is to be noted that more recently design patent applications have been closely scrutinized, and the same degree of care and particularity of description and claim required of applicants in the preparation of specifications for such patents, as for patents for other inventions. More especially has this been so with regard to the claims.

It has already been remarked that the doctrine of generic and specific claims obtaining with mechanical patents has no place in the law of design patents,[2] and the reasons therefor stated.

SECT. 9. It cannot be doubted, however, that as the doctrine of mechanical or functional equivalents obtains in patents for inventions of that class or character, a similar doctrine of artistic or æsthetic equivalents would be logically proper in design cases. What amounts to the

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[1] Dobson *v.* Dornan, 118 U. S. 10.

[2] *Ex parte* Gerard, 43 O. G. 1235 and 1240, 2 cases. [NOTE.—This case overrules in this respect, *ex parte* Bartholomew, Com. Dec., 1869, p. 103.] But see Meers v. Kelly, 31 Fed. Rep. 153.

same thing, in point of fact, has been the practice of the Patent Office in allowing drawings, descriptive matter, and claim for not only the original and main design, but for variations or modifications thereof that include sufficient of the distinctive features to preserve the identity of the completed design;[1] and the practice has been recognized by the courts as proper and legitimate.[2]

SECT. 10. It was ruled as early as 1870,[3] that there was no valid objection either in the law or by reason of the subject matter to introducing two or more claims or clauses of claims into the same patent; because in many cases it would be necessary so to do to fully protect the actual invention. As where form and surface ornamentation both go to make up the complete invention; or where there are segregable parts of a single design, such as a carpet and its border. But as a design must be an entire, complete, and integral thing, it cannot consist of aggregations of separate parts applicable to different uses and purposes.[4] Hence the claim must be framed for the entire design, and distinctive, segregable, integral parts thereof; and it is improper to introduce into the specifications separate clauses of claim for portions of the design capable of being attached to different forms to make up an entire whole.[5]

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[1] *Ex parte* Bartholomew, Com. Dec. 1869, p. 103; *Ex parte* Gerard, 43 O. G. 1240.

[2] Miller *v.* Smith, 5 Fed. Rep. 359.

[3] *Ex parte* Sheppard, Com. Dec. 1870, p. 22. See also, *Ex parte* Beattie, Com. Dec. 1879, p. 142; Dobson *v.* Carpet Co., 114 U. S. 439.

[4] *Ex parte* Gerard, 43 O. G. 1235; *Ex parte* Patitz, 25 O. G. 980.

[5] *Ex parte* Pope, 25 O. G. 290; *Ex parte* Rogers, 13 O. G. 596.

The two following cases illustrate the subject matter of several sections of the preceding chapter.

UNTERMEYER *v.* JEANNOT AND OTHERS.

Circuit Court, S. D. New York. Decided June 6, 1884.

20 Fed. Rep., p. 503.

The prominent claim in a patent design being figures in relief, a photograph of the design, since it does not show the relief, does not sufficiently describe the design in the absence of a minute description in the specification.

Rowland Cox, for complainant.
Birdseye, Cloyd & Bayless, for defendants.

WHEELER, J. This suit is brought upon Design Patent No. 12,485, dated September 20, 1881, and granted to the orator for a watch case. The design consists in the representation of a locomotive engine and tender upon a railroad track, with ornamental plants in the foreground, the whole surrounded by a ring of dots and an ornamental border. There are two claims: one for the engine and tender on the track and ornamental plants; and the other for the same, surrounded by the ring of dots and ornamental border. An accompanying photograph of a watchcase shows the style of the locomotive, tender, and track, the form of the plants, the size and frequency of the dots, and the characteristics of the border; but none of these are described in the specification or claims, except by name. The engine and tender and some of the other parts are said to be shown in relief; and the alleged infringement shows the same in relief. There were watchcases before having representations of locomotives and tenders on railroad tracks, surrounded by wreaths and ornamental borders and rings of dots, and engines with flowers in the foreground surrounded by scroll-work and borders, but none with such work in relief, unless cases like the alleged infringement were made before, as the defendants' evidence tends to show. With these things in existence before, the orator could not have a valid patent for anything but his peculiar design as distinguished from the former designs. Railway Co. *v.* Sayles, 97 U. S. 554. The alleged infringement has a line of fence posts between the plants and railroad track; they are not surrounded by a row of dots, but are by an ornamental border. The design, therefore, is not exactly the orator's design. The form

of the defendant's case, the view of the engine, and the workmanship are very much like the orator's. These similarities, in connection with the fact that the same parts in each are made in relief, bring the cases to near enough alike to lead a common observer, having the interest of a customer, to think they were the same when seen at different times. But the orator is not entitled to, and is not seeking any relief on account of imitation of his goods or workmanship. Relief against infringement of his patent is all that he can properly or does ask here. If the photograph does not show parts in relief, the claims are neither of them for those parts in relief.

Miller *v.* Smith, 5 Fed. Rep. 359, is relied upon to show that representation in the photograph would be sufficient without description in the patent or claim. That case as reported, however, does not appear to hold the photograph to be sufficient alone. The language of the opinion seems to imply that there was further description, and a claim accordingly.

The claims are the essential parts which the public are to look to and scrutinize to ascertain their rights, and must control. Burns *v.* Meyer, 100 U. S 671. Taking out the raised features and comparing the defendants' case with the orator's patent, instead of with the manufacture, and infringement will hardly appear. The design is not the orator's design, as patented, nor sufficiently like it to present the same substantial appearance to purchasers. The defendants, therefore, do not infringe.

Let there be a decree dismissing the bill of complaint, with costs.

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HENRY D. CONE *v.* MORGAN ENVELOPE CO.
SAME *v.* WHITING PAPER CO.
SAME *v.* LEWIS J. POWERS.

Circuit Court U. S., District of Massachusetts.

Decided January, 1879.

4 Ban. & Ard. P. C., p. 107.

1. Embossed lines on writing paper being old, and ogee lines embossed on paper being also old, the mere change of the

spaces of the ogee lines, so that they might be used for writing paper, does not constitute invention.

2. Mechanical and design patents, distinguished.
3. Letters patents No. 158,249, granted to Henry D. Cone, December 29, 1874, for ruled paper ; held invalid.

Causten Browne and Charles F. Blake, for the complainant.

J. P. Buckland and A. K. P. Joy, for the defendants.

LOWELL, J. The case numbered last upon the docket is named first, because most of the evidence was taken in that case, though all three were argued together.

It appears by the bill that the plaintiff, Cone, took out two patents; one for a new article of writing paper and the other for an improvement in the method of making the paper. The plaintiff proceeded against the Morgan Envelope Company upon both of his patents, and, a demurrer for multifariousness having been interposed, he amended his bill, giving in evidence only patent No. 158,249, dated December 29, 1874, in which the claim is: "As a new article of manufacture, writing paper whereof the lines are embossed by or with an ogee pattern, which exposes a like face on opposite sides."

In amending. the charge of infringement was changed, and now reads as follows: "But that the respondent, the Morgan Envelope Company, in violation of your orator's rights, has manufactured and sold to others, large quantities of paper like that secured to your orator in and by his said Letters Patent of December 29, 1874, No. 158,249, which manufacture of said paper was by the use of the invention secured to your orator by his Letters Patent of February 10, 1874, No. 147,239." This second patent having been left out of the case, the defendants object that it is impossible for the Court to decide whether they have infringed or not, within the allegation of the bill. The plaintiff contends that the charge includes both patents, jointly and severally, and that he may prove an infringement of either, as well as of both. It appears to me that the allegation is, that the paper which has been made and sold was made by the patented method. It is analogous to the case in

which it appears that the patentee had discovered a new kind of oil and a new way of making it, and the Courts expressed the opinion that he might have claimed both; yet, his claim being for "the above-described new manufacture of deodorized heavy hydrocarbon oils * * * by treating them substantially as hereinbefore described," they decided that he had not claimed the new article, as distinct from the mode of its preparation. Merrill *v.* Yeomans, 1 Holmes 331; affirmed, 94 U. S. 568.

This objection, however, applies to only one of the three cases; and a decision of the merits will be necessary.

The "ogee" form of ruled paper described and claimed, means that there is embossed upon the surface an elevation and depression, which will be interchanged on the two sides (the embossing being, I suppose, made by a single operation,) so that when cut, the transverse section will present the appearance or pattern known in architecture and other arts as an ogee pattern. The advantage of the paper itself is that it corresponds on both sides, and presents, on both, an elevation and an accompanying depression, which take the place of other forms of ruling.

Ink lines of various colors, to aid in writing, were, of course, old and well-known. It is proved that writing paper had been made before 1874, with several kinds of lines formed in or upon the substance of the paper. There was paper for writing, embossed upon one side, with a corresponding depression on the other. Wall papers which might have been used for writing, had been embossed with an ogee pattern; but the ogee lines were so close together as to form a corrugated surface, and there was nothing in the mode of spacing of those papers to assist the eye or hand in writing.

In this state of the art, the first question is: Whether a patent can be sustained for a new article, independently of the means of making it, which has the ogee lines, at suitable distances, for aid in writing?

I am of opinion that such a patent cannot be sustained. Embossed lines on writing paper being old and well-known, and ogee lines embossed on paper being equally so, there was no room to claim invention for a distinct and new product merely by changing the spaces of the ogee lines

so that they might be used for writing paper. The utility was of the same kind as in the older products. Of late years, the Supreme and Circuit Courts have had many occasions to pronounce upon patents which claim a new product or article. Among these are some which resemble the case at bar: See Smith *v.* Nichols, 1 Holmes 172; affirmed, 21 Wall. 112; Union Paper Collar Company *v.* Van Deusen, 10 Blatchf. 109; affirmed 23 Wall. 530; Glue Company *v.* Upton, 6 Off. Gaz. 837; Needham *v.* Washburn, 7 Off. Gaz. 649; Brown *v.* Piper, 91 U. S. 37. In one of these cases, cited by the defendants, Mr. Justice Clifford says: "New articles of commerce are not patentable as new manufactures, unless it appears in the given case that the production of the new article involved the exercise of invention or discovery beyond what was necessary to construct the apparatus for its manufacture or production." 23 Wall. 563. Paper having been ruled with ink on both sides, and with embossed lines on one side, it did not require invention to emboss it on both sides.

It was suggested in the argument for the defendants, that the plaintiff's paper came within Section 4,929 of the Revised Statutes, authorizing patents to be issued for designs, which mentions, among other things, any original impression or ornament to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture. The plaintiff, admitting this as one possible view of the case, maintains that the patent which he already holds may answer as a patent for a design. Patents for designs are not granted for a uniform term of seventeen years like those for articles of manufacture, but for three years and six months, or seven years, or fourteen years as the applicant may in his application elect. I do not know but this patentee might have elected a shorter term, which has now expired. A still more serious objection is that the rule of infringement is different in the two classes. A patent for a new article of manufacture is trespassed upon by an article having the same sort of utility arrived at by the same or similar means, whereas the test in a patent for a design is similarity to the eye. Gorham Company *v.* White, 14 Wall., 511. It would, therefore, be unfair to the public, not only as respects the term of the patent, but the na-

ture of the grant, to construe one sort of patent as being of the other sort; and I think it clear that the statute intends the particular kind of grant to be set out in the deed.

For these reasons, the entry in all the cases must be: Bill dismissed with costs.

NOTE.—See also the following Patent Office decisions, contained in the appendix at end of this volume, governing the practice in that department, in applications for Design Patents. *Ex parte* Beattie, 16 O. G. 266; *ex parte* Brower, C. D. 1873, p. 151; *ex parte* Carty, 44 O. G. 570; Collender *vs.* Griffiths, 3 O. G. 91 and 267; *ex parte* Diffenderfer, C. D. 1872, p. 154; *ex parte* Fairchild, 3 O. G., 232; *ex parte* Gerard, 43 O. G. 1235 and 1240; *ex parte* Kohler, 4 O. G. 53; *ex parte* Mayo, C. D. 1870, p. 14; *ex parte* Neidringhaus, 8 O. G. 279; *ex parte* Palmer, 21 O. G. 1111; *ex parte* Patitz, 23 O. G. 980; *ex parte* Pope, 25 O. G. 290; *ex parte* Rogers, 13 O. G. 596; *ex parte* Sheppard, C. D. 1870, p. 22; *ex parte* Stuart & Bridge, C. D. 1870, p. 15; *ex parte* Sperry, C. D. 1870, p. 139; *ex parte* Whyte, C. D. 1871, p. 304.

CHAPTER IV.

Of prior use, and herein of want of novelty, utility and ingenuity.

SECTION 1. It was held in the first reported design patent case,[1] decided in 1846, that without an averment of abandonment, a plea that the thing patented had been publicly used before the application, without averring also that such use has been for more than two years, was demurrable; and that the general patent act of March 3, 1839, permitting such use for not more than two years prior to application for patent, was applicable to designs. And the same view was incidentally expressed in a later case decided in 1847.[2] As both these cases arose on patents issued under the act of 1842, it may be doubted if the ruling was correct, as that statute, as well as the act of 1861, only authorized such a patent when the invention was "not known or used by others before his invention or production thereof, and prior to his application for a patent therefor." The subsequent rulings of the Patent Office were certainly not in accord therewith.[3] The present law (Act of July, 1870, and Sec. 4,929, Rev. Stat.) omits this qualifying language; hence the general law, which permits of a public use for not more than two years prior to application for patent, is now applicable to designs.

SECT. 2. In a case decided in 1880[4] founded on two design patents, both issued under the provisions of the Revised Statutes, the Court was of opinion that there was no presumption of abandonment by reason of the patentee exhibiting his design in a previous mechanical patent; and that abandonment, in fact, did not follow from such act until after two years public use.[5] No doubt abandonment

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[1] Root *v.* Ball, 4 McLean, 177.

[2] Booth *v.* Garrelly, 1 Blatch. 247.

[3] *Ex parte* Stuart & Bridge, C. D. 1870, p. 15; *ex parte* Kohler, 4 O. G. 53. See reasons, Chapter I, Section 4.

[4] Burton *v.* Town of Greenville, 3 Fed. Rep. 642.

[5] Sparkman *v.* Higgins, 1 Blatch. 205.

by public use for any period of time before application, may take place, as in other cases, but that is always a fact to be proven and not presumed from any facts not amounting to actual proof.[1]

SECT. 3. Prior publication, by patent or otherwise, will defeat a design patent, as in other cases; but, from the nature of the subject matter, it is clear that *expert* proof in support of the identity or dissimilarity, as the case may be, of the patented design with that shown in a prior patent or publication stands on a very different footing from such evidence introduced under similar circumstances in suits on functional patents. It is not admissible to establish general resemblance or the contrary, but only to aid the court in determining how far the similarity or dissimilarity in appearance is due to the means employed in each case to produce that result in order to arrive at a proper conclusion as to whether two designs shown are or are not substantially identical.[2]

SECT. 4. Novelty is negatived, in whole or in part, by evidence of the state of the art which shows that the distinguishing characteristics or features of the patented design are old. Such evidence, however, has a very limited effect in design cases and is to be cautiously received and weighed; because it is usually very difficult to select any one feature of a design, a line, a flower, a curve, &c., and say, with any degree of certainty, what effect *on the whole* is produced by its presence or absence. Illustrations of the effect of such evidence are found in the following four different classes of cases:

a. Meers *v.* Kelley[3] was on a patent for a photograph album leaf consisting of an elevated border or frame, enclosing an inner border with a roughened or pebbled surface; and within this, pockets apparently raised, for the purpose of holding the pictures, thus making three mats or frames. The evidence showed that album leaves with pebbled surfaces, and smooth borders surrounding pebbled pockets, &c., were old. The court held that if the claim was limited to the specific design shown, it might be good; but if con-

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[1] Booth *v.* Garrelly, 1 Blatch. 247.
[2] Gorham Co. *v.* White, 14 Wallace 511.
[3] Meers *v.* Kelley, 31 Fed. Rep. 153.

strued to include generally a plain border inclosing a pebbled border, which inclosed a pocket, it was void for want of patentable novelty.

b. Collender *v.* Griffith,[1] was on a patent for a billiard table. The design consisted of the slanting form of the sides together with the ornamentation thereof. The element of configuration, which was the leading feature, having been proven to be old, the claim fell unless construed to be for the two elements of form and ornamentation as a unit.

c. Jennings *v.* Kibbe,[2] was on a patent for a fringed lace fabric consisting of a series of stems and loops arranged in a particular manner, the fabric being used in connection with an article of dress called a nubia. The nubia with which it was compared had lace fringes consisting also of a series of stems and loops, but differently arranged. The court held that they were not substantially identical, because the similarity in appearance, of the completed article, was not due to what was invented and claimed by the patentee. This was a case of infringement and not prior use, but the principle is precisely the same, as it is only a question of substantial identity in both cases.

d. Foster *v.* Crossin,[3] was on a patent for jewelry pins of the form of a fork or a spoon "with the outline edge of the plate turned backward at a nearly uniform distance from its front." Evidence of the state of the art was introduced which showed that jewelry pins in the form of a fork and of a spoon were old, and the question of patentable novelty turned upon whether those old forms or the peculiar rounded and finished form of the edge constituted the distinctive feature of the whole design. The court took the latter view and sustained the patent upon that construction.

SECT. 5. Evidence of the state of the art, which includes both prior patented and unpatented designs, may defeat the patent also on several other grounds than absolute want of novelty, for it may disclose that the patented design is a mere aggregation of old ornaments, so that the patent could not be sustained either for the whole or any of its separable parts;[4]

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[1] Collender *v.* Griffith, [See page 88 of this book.]
[2] Jennings *v.* Kibbe, 24 Fed. Rep. 697.
[3] Foster *v.* Crossin, 23 Fed. Rep. 400.
[4] Simpson *v.* Davis, 12 Fed. Rep. 141.

or such evidence may disclose such a slight difference between the patented design and what preceded it as to show a lack of invention or ingenuity,[1] or that it is a mere double use of existing forms,[2] or a mere change of material producing the novel appearance claimed;[3] or if old forms are merely brought together with such adaptations to each other as would be made by the exercise of ordinary skill of workmen in the trade, such would not present patentable novelty under the design law;[4] but a re-arrangement of such parts with changes in some, or all, of proportion and style, and so connected together with appropriate devices to form a harmonious whole producing a substantially new effect, is patentable.[5]

SECT. 6. Evidence of the state of the art has been considered in several design patent cases, in which the patent involved was for ornamentation merely, and also where the patent in suit claimed both configuration and surface ornamentation as a unit; and the same force and effect was given to such evidence as in suits on mechanical patents. In Collender *v.* Griffith the claim was absolutely defeated on such evidence. In Crocker *v.* Cutter Tower Co., the evidence of the state of the art went so far that the court had serious doubt if what remained constituted invention.

SECT. 7. Determination of the issues of novelty and of patentable novelty in view of the state of the art, depends upon the proofs in any particular case in which they arise, except so far as they depend on matters of fact, of which the court will take judicial notice without proof—matters of common knowledge. The latter is the rule that was applied by the Supreme Court to mechanical patents, in Brown *v.* Piper,[6] and Slawson *v.* R. R. Co.,[7] and kindred cases. And it was applied in a design patent case by Judge BLODGETT—Eclipse Mfg. Co. *v.* Adkins,[8] in which the question was raised by demurrer to the bill, and although

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[1] Osbourn *v.* Judd, 38 O. G. 1132. Adams, &c., Co. *v.* St. Louis, &c., Co., 12 O. G. 940. Crocker *v.* Cutter Tower Company, 29 Fed. Rep. 456.

[2] Western Electric Manufacturing Company *v.* Odell, 18 Fed. Rep. 321.

[3] Post *v.* Richards Hardware Company, 26 Fed. Rep. 618.

[4] Perry *v.* Starrett, 14 O. G. 599.

[5] id.

[6] 91 U. S. Rep. 37.

[7] 107 U. S. Rep. 649.

[8] 36 Fed. Rep. 554.

the learned judge in that case refused to dismiss the bill on that ground, he stated, without qualification, that he should not hesitate to apply the rule in a proper case, on a design patent, which justified its application. In Post *v.* Richards [1] Judge Shipman sustained the demurrer to a bill founded on a design patent, the defence to which was rested on that and analogous grounds.

SECT. 8. In two design cases the well-known doctrine in general patent law, applicable to inventor and workman, was applied; and it will be readily perceived that this doctrine would be much more difficult of application in a design case than it would be in the case of a mechanical patent. These two cases were decided, one in favor of the patent and the other against it, so that they are quite instructive as to the proper application of the rule in design cases. The first was Sparkman *v.* Higgins,[2] in which the patentee merely made suggestions, superintended the making of a design, suggested alterations, disapproved of the resultant experimental design, and finally secured the adoption of his views in the design subsequently patented, while it was also admitted that the workman had no copy before him while doing the work, which was to that extent, and in that limited sense, original. Upon these facts the court said that to constitute an inventor, it was not necessary that he should have the manual skill and dexterity to make the drawings. That furnishing the ideas for producing the result he was entitled to avail himself of the mechanical skill of the draftsman, and that under the facts as stated, the devising of the pattern or design was in this sense the invention of him who gave the directions therefor. This was a design for a floor oil-cloth. The other case was Streat *v.* White,[3] which was a patent for a design to be printed on textile fabrics, to imitate the genuine woven fabric commonly known as "seersucker." The patentee was not the first to conceive the idea of making an imitation, by printing, of the genuine woven fabric, by blending together cross lines by shading, but this latter part of the design was the work of the engraver who produced

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[1] 26 Fed. Rep. 618.
[2] 1 Blatch. 205.
[3] 35 Fed. Rep. 426.

it, under simple instructions to imitate a photographic copy, furnished to him, of the genuine seersucker. The court held that there was nothing new in making or conceiving the idea of making a mere copy of the genuine woven fabric, but that the novel and distinctive feature of the thing invented, viz: the means by which the imitation was produced, the blending of the shaded lines, was exclusively the work of the engraver, and not that of the patentee, and hence dismissed the bill.

SECT. 9. The letters patent are *prima facie* evidence of novelty and utility,[1] and proof of infringement operates to estop the defendant from denying the latter.[2] By *utility*, however, is not meant functional utility, it may be remarked, but artistic or æsthetic usefulness, though it is entirely immaterial whether the patented design is more graceful or more beautiful than preceding designs, provided it be novel.[3] The offer of the letters patent in evidence, therefore, casts upon the defendant, equally as in suits on other patents, the burden of satisfying the court beyond a reasonable doubt, by appropriate and admissible evidence, that the defense of prior knowledge and use has been established.[4]

The following selected cases illustrate the subject matters of the preceding chapter.

DAVID ROOT *v.* BALL & DAVIS.

Decided July Term, 1846.

4 McLean, C. C. Rep. 177.

1. In an action on a design patent issued under Act of 1842, it is not sufficient to aver a public use prior to application, unless the plea aver abandonment. Under Act of 1839 such use must have been for two years prior to application, to defeat the patent.
2. No patent can validly issue for two distinct inventions, but the

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[1] Lehnbeuter *v.* Holthaus, 105 U. S. 94.
[2] Ibid.
[3] Ibid.
[4] Dreyfus *v.* Schneider, 28 Fed. 491.

same patent may include a claim for the combination as well as for the parts of which it consists.

3. It is no defence that the patentee, before issue of patent, sold some of the patented articles without stamping thereon notice of his application.

4. To constitute infringement, it is not necessary to copy the thing patented, in every particular. It is sufficient if the defendant's design produces substantially the same appearance.

Fox, for the plaintiff.
Hart for the defendant.

OPINION OF THE COURT. This is an action for an infringement of a patent. The plaintiff declares against the defendants for violating a patent right granted for a design of ornamental parts of a stove, dated 9th of September, 1845, with the ordinary breaches.

The defendants pleaded:

1. The general issue.

2. Because, before the date of the patent. on the 6th of January, 1844, stoves constructed upon the plan of the stove patented by the plaintiff, with the same general design and combination of the ornamental parts, were publicly made and sold by the defendants at the district, etc.

3. Because, before the date of the application for the said letters patent, on the 1st of November, 1844, and hence on till the date of said application, stoves constructed on the plan of the stoves patented by the plaintiff, with the same general design and combination of the ornamental parts, were publicly for sale by the plaintiff himself at the district, etc.

4. Because, before the date of issuing the patent, on the 1st of January, 1845, and thence on the date of the same, stoves constructed upon the plan of the stove patented by the plaintiff, with the same general plan and combination of the ornamental parts, were publicly for sale by the plaintiff himself at Cincinnati, etc.

5. Because, at the date of application for said letters, on November 1, 1844, and thence till the date of said application, stoves constructed upon the plan of the stove

patented by the plaintiff, with the same general design and combination of the ornamental parts, were in public use, and for sale in the city, etc., by the consent and allowance of the plaintiff himself.

6. Because, before the date of issuing said letters patent of the plaintiff, on the 1st of January, 1845, and thence continually till the date of the patent, stoves constructed upon the same plan with the stove patented by the plaintiff, with the same general design and combination of the ornamental parts, were in public use and for sale at the city, etc., by consent and allowance of the plaintiff himself.

To the 2d, 4th, and 6th pleas, the plaintiff demurred, and joined issue on the 3d and 5th.

The pleas demurred to, allege that before the issuing of the patent, stoves of a similar design and combination were in use and for sale. And this, it is contended, is no answer to the plaintiff's action. By the 7th section of the act of 3d of March, 1839, it is declared that no patent shall be held invalid by reason of any such purchase, sale, or use prior to the application for a patent, except on proof of abandonment of such invention to the public, or that such purchase, sale or prior use has been for more than two years prior to such application for a patent.

None of the pleas state that the use spoken of was more than two years prior to the application for the patent, and this is indispensable to render the patent invalid. Independently of this statute, the plea would have been bad, as the application for a patent must protect the right of the inventor, and the delay which may occur, in the patent-office, in making out the patent, cannot operate to the injury of the applicant. On both grounds, therefore, it is clear that the pleas demurred to constitute no bar to the plaintiff's action, as they do not show that the patent is invalid, by abandonment or otherwise.

When an abandonment is relied on, it should be stated in the plea, and the facts on which the pleader relies, as showing an abandonment. The present is different from the former law (Shaw *v.* Cooper, 7 Pet. R. 292). The jury were sworn to try the issues joined and witnesses were examined.

George H. Knight, in September, 1844, was employed

by plaintiff to make out the specifications, which are stated in the patent.

Elias J. Peck is a pattern-maker, and he says that Root's stove was sold in the fall of 1844. And from other witnesses it appeared that Root's stove was put up early in the year 1845. Several designs were shown to ornament cooking stoves similar to the plaintiff's, but the figures differ.

It is admitted that the application and specifications on which the plaintiff's patent issued, were filed the 15th of December, 1844.

It is objected to the plaintiff's patent that two distinct things cannot be united in the same patent. This is true when the inventions relate to two distinct machines; and the reason assigned is, that it would deprive the officers of the government of their fees, and in other respects would be inconvenient. But the same patent may include a claim for a combination, and an invention of some of the parts of which the combination consists. A patent for a combination is not infringed by the use of any part less than the whole of the combination (Moody *v.* Fiske, 2 Mason 112).

It was objected by the defendant, that, as a penalty is imposed on a patentee for selling an article unstamped, and as stoves were sold by the plaintiff made before the patent, and which were not stamped, the plaintiff could not recover. But the court overruled the motion, saying that the matter started could have no influence in this case.

The court instructed the jury that, as there was no notice or plea, which authorized the defendant to show a want of novelty in the invention claimed by the plaintiff, they would disregard the evidence which had been given on that head. There is no notice appended to the plea of the general issue to that effect, nor do the special pleas make a want of novelty a ground of defence. They would seem to rely on the effect of an abandonment. Or, at least, that the right of the plaintiff did not originate with the discovery, or the application for a patent, but with the emanation of his patent. And the jury were instructed, if they should find that the defendants had infringed the plaintiff's patent by using, substantially the same device, as ornamentation on the same parts of the stove, they would of course

find the defendant guily, and assess such damages, as, in their judgment, the plaintiff was entitled to. To infringe a patent right, it is not necessary that the thing patented should be adopted in every particular; but if, as in the present case, the design and figures were substantially adopted by the defendants, they have infringed the plaintiff's right. If they adopt the same principle the defendants are guilty. The principle of a machine is that combination of mechanical powers which produces a certain result; and, in a case like the present, where ornaments are used for a stove, it is an infringement to adopt the design so as to produce, substantially, the same appearance.

The jury found for the plaintiff, and assessed their damages at twenty-five dollars. Judgment.

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DON ALONZO BOOTH *v.* JULIUS GARELLY, *et al.*

Decided October Term, 1847.

1 Blatch. C. C. Rep. 247.

1. Design for figured silk buttons, consisting of the form of the mold or block forming the foundation of the button, wound with silk threads laid in radial indentions on the mold; the design patent for which (issued under Act of 1842) did not describe the process of winding, but only the mode of securing the silk thread upon the mold, to wit, in the radial indentations; held, to be for the resultant effect, viz: the radially formed ornamental surface.
2. The specification described several different radially formed ornaments, the claim being broad enough to cover the several species.
3. The general Patent Act of 1839, allowing prior public use for less than two years, by an inventor, prior to application, held applicable to design patent issued under Act of 1842; but such prior public use being set up as constituting an abandonment, held to be a question of fact for the jury.
4. Whether the public sale, before application for patent, of the button, in this case, was a sale of the design, within the meaning of the statute, suggested, but not decided.

Samuel Sherwood, for plaintiff.
Abijah Mann, Jr., for defendants.

NELSON, J. The letters patent to the plaintiff, were issued July 24th, 1847, for "a new and ornamental design for figured-silk buttons."

The design is described as consisting of two distinct elements or characters, to be used in combination, in order to insure the beauty of the article First: the configuration of the mold or block, having radial indentations thereon, forming the foundation of the button. Second; winding the said block with silk, in the manner thereafter described. The beauty and effect of the design, it is said, depend upon these two things, which together form the design, and without which it cannot be produced. Accompanying the patent are several drawings, representing wooden molds, with different radial figures cut upon the faces of them, and also others wound with silk of different colors, presenting samples, of figured buttons of various hues. The mode of securing the thread with which the mold is wound, to prevent the same from slipping, is particularly described, and suggestions are made that the mold can be varied to any figure desired, and also that the silk covering may be varied in its combination of colors. The process of winding the silk upon the mold is not described. Then follows the claim, which is, "the radially formed ornaments on the face of the mold of the button, combined with the mode of winding the covering of the same, substantially as set forth." The patent is granted under the Act of August 29th, 1842, (5 U. S. Stat. at Large, 543, Sec. 3), which authorizes the granting of the same for any new and original design for a manufacture, or any new and useful pattern, or any new and original shape or configuration of any article of manufacture, not before known or used by others. The invention in this case falls within the first clause of the section, if within any, as a "new and original design for a manufacture"—a design for the manufacture of an ornamental button. It was supposed on the argument, by the counsel for the defendants, that the process of winding the mold with the silk thread constituted a part of the invention; and that if it could be shown that this was

not new, but had been known and in public use before, the patent was void. This process is not described in the specification, and we are inclined to think it was not intended to be claimed. The mode of winding claimed to be new, is the arrangement of the different colored threads in the process, so as to produce what is called the radially formed ornaments on the face of the button. For this purpose and to this extent, the description, in connection with the drawings, appears to be sufficiently full and explicit, and a person of ordinary skill in the art would, probably, find no difficulty from the description as given, in working the silk ornaments of varied color and shade, upon the face of the mold.

It is admitted that the patentee manufactured these buttons and put them into the market on sale, some two or three months before he made application for his patent, and it is hence insisted that the "design" has been abandoned to the use of the public. It is claimed, however, that in every instance of sale, he gave notice that he was preparing to apply for a patent, and intended to secure his exclusive right to the invention. The evidence on the point of abandonment raises a question of fact, which must be settled upon the trial of the suit at law, which is now pending between the parties.

The seventh section of the Act of March 3d, 1839, (5 U. S. Stat. at Large 354,) provides that every purchaser of a newly invented machine, manufacture, or composition of matter, from the inventor, prior to his application for a patent, shall be held to possess the right to use the article, and to vend it to others to be used, but that the patent shall not be held to be invalid by reason of such prior purchase, sale or use, except on proof of abandonment of the invention to the public, or that such purchase, sale or prior use, has been for more than two years prior to the application. As the sales in this case were made but a short time before the application, the question will be upon the abandonment—a question of intention upon the facts proved.

There may be some doubt whether the sale of the manufactured button by the inventor, amounts to a sale of the thing invented, within the meaning of this seventh section.

If the button be regarded simply as a product of the

invention, it is clear that a sale of it would not be a sale of the invention; for, a sale within the provision must be a sale of the invention or patented article. The patent is not for the manufacture of a new and ornamental button, but for a new and ornamental design in the manufacture of the article. The "design," however, is worked upon the face of the button, and may, therefore, perhaps, be said to be sold with it. In this view, a sale of the button would be a sale of the "design," the thing patented, and not simply of the product of the invention. The novelty of the invention is denied by the defendants, and it is admitted that large quantities of the article, in packages marked as imported from Paris, were sold by the patentee before his application for the patent, thereby affording an implication against him as the original inventor, and in favor of the allegation of the defendant.

Upon the whole, therefore, we shall withhold an injunction until the plaintiff's right shall have been established in the suit at law.

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BURTON *v.* THE TOWN OF GREENVILLE.

U. S. Circuit Court, District of New Hampshire.

Decided July 21, 1880.

3 Fed. Rep. 642.

1. Suit on Patent No. 10,497, for a design of a street lamp post, not defeated by previous mechanical patent showing the outline of the *form* of the design, in part, but not its finished ornamentation.
2. Evidence being adduced that a street lamp post had been publicly made and sold more than two years prior to the patentee's application for a patent, and which, while not embodying all the features, shown or described, did contain all that the claims of the design patent could fairly be interpreted to cover; held sufficient to avoid the patent.

George E. Betton, for complainant.
Stearns & Butler, for defendant.

LOWELL, C. J. The complainant has taken out and now owns two patents for designs of a street lamp: No. 9,488, September 5, 1876, and No. 10,497, February 19, 1878. The former describes and shows by a drawing a lamp post, with an enlarged base and a similar shaft, surmounted by a cap. From the cap projects an overhanging curved arm, from the lower and free end of which depends a chain made fast to the outer corner of a bracket, in which the lamp or lantern is set. This bracket has projections loosely fitting the post, so that the lantern can be moved up and down. The lamp is suspended under the center of the arch or arm. The patentee claims "a design for street and park lamps, composed of the upright post with enlarged base, the arched arm, the chain, the bracket, and a lamp placed below the arch, all substantially as shown and described."

The second patent describes and shows a design which differs from the first in certain particulars. It has two lanterns, one on each side of the post. The bracket which holds the lantern is more complete, having lower edges and sides, so as to form a carriage or cage, rather than a bracket; and this is upheld by a bail or handle, which is attached to the middle instead of one corner of the carriage, and thus brings the lantern directly under the free end of the arm, instead of under its curved part or arch. The claim is for the design for a lamp post, consisting of the post, carriage, bails, lamps, chains, and arches, all substantially as shown and described. Between the arches there is an ornament in the form of an acorn, which is mentioned in the specification, but not in the claim. The application for this patent was filed January 18, 1878.

It is considered by both parties to the suit that the two lanterns of the drawing are duplicates, and that if the patent is valid, it is infringed by the use of a lamp post like the patent 10,497 in all respects, except that it has but one lantern. The posts charged as infringements have but one lantern, but in other respects are almost exactly like the patented design. The plaintiff had obtained a mechanical patent, June 13, 1876, No. 178,508, for an improvement in street lamps, and his drawings represent a lamp post of similar design, with No. 9,488, except that it has four lan-

terns on one post. A question is made by the defendants whether an inventor is not to be presumed to abandon his design when he exhibits it in the drawings of a mechanical patent. I do not see why this consequence should follow until the design has been in use for two years; but I do not decide this point, because the plaintiff's second patent shows a much improved design, and he relied entirely upon that patent in his brief and his argument. I agree with him that the mechanical patent and its duplicate design do not anticipate the more pleasing and finished design of No. 10,497.

The defendants, in their answer, rely on two mechanical patents to John M. Bruce, for lamp posts with chains and weights, the first of which is earlier than the earliest of Burton's, and has a more extensive claim. This patent was applied for November 14, 1874, and issued December 22, 1874; and thereafter Bruce appears to have dealt somewhat extensively in lamp posts having these mechanical contrivances. But his patents do not show posts like the plaintiffs. The first has two posts, between which the lantern is hung, and the second has brackets to set up the lantern against a wall. As designs, therefore, they cannot be held to anticipate Burton.

The amended answer avers that on the 8th of November, 1875, Bruce caused a design to be drawn and publicly exhibited, which is identical with that of the plaintiff. Bruce testifies that he did, in fact, make and sell lamps substantlike the plaintiff's design, long before the latter obtained his patent. Those complained of as infringements were set up in the defendant town twenty months before the plaintiff's application for Patent 10,497 was made. They resemble so closely the model, C, which the plaintiff produces as representing his patented design, that it is almost impossible to believe that one was not copied from the other. But Bruce had no opportunity to copy anything from the plaintiff, because the plaintiff made nothing, unless it were a model, to which Bruce had no access, until October, 1876; while these lamps were put up in May, 1876, within two miles and a half of the plaintiff's house. In August, 1876, the plaintiff applied for, and in September obtained, his patent, No. 9488, for a much inferior design. Yet he

now thinks that he invented the better form about September, 1875.

Bruce exhibited publicly to a committee and certain inhabitants of the town of Peterborough, New Hampshire, November 8, 1875, a drawing of the lamp post, which he was ready to sell them, and which is like the patented and infringing design. He testifies that he made others like it, excepting the ornament on the top, which forms no part of the plaintiff's claim, as early as November, 1874.

I am much inclined to believe, upon the evidence, that Bruce invented this design, and that Burton, when he took out his patent, No. 10,497, knowing this, intended to claim only the post with two lanterns.

However this may be, I am of opinion that Bruce had put this design into public use, and had offered it for sale as early as November 8, 1875, which was more than two years before the plaintiff's application, and therefore avoids his patent.

Bill dismissed with costs.

HUGH W. COLLENDER *v.* WM. H. GRIFFITH.

SAME *v.* SAME.

U. S. Circuit Court, So. Dist. N. Y. Decided 1873.

1. Evidence of prior knowledge and use is not admissible unless notice thereof be given in the pleadings as required by the statute.
2. The proofs establishing that billiard tables with the sides beveled inward from the top had been known before, it does not constitute invention, under the design statute, to construct such a table with a much deeper bevel than had previously been used in other tables. Such change is merely a change in degree and not a substantially new form or configuration for a manufacture involving patentability under the design laws.
3. If the patent for the design include as a part thereof the specific ornamentation shown on it, it might be valid for both the form and the ornamentation, as a unit. Not thus construed, Design Patent No. 4973, dated June 6, 1871, held invalid.

4. A person cannot copyright a print, cut or engraving of an article he has on sale so as to prevent others who have an equal right to sell a similar article from using a like engraving of their own goods in advertising them. Such is not a work of art, print, lithograph or engraving having any value or use as such, and therefore not within the statute.

WOODRUFF J. These two suits were submitted together upon the same proofs. The only question argued by counsel was, whether the testimony of certain witnesses called to prove the want of novelty in the alleged invention or new design, and who mention the knowledge and use thereof by persons not named in the defendant's answer, is competent. On that question I must hold that the evidence of the knowledge and use by persons not so named is incompetent, and must be rejected. The court has no discretion on the subject. Such knowledge and use is not a defense, under the statute, available to the defendant. It is therefore rejected. The counsel, on the argument of the question above stated, submitted the cases on the merits on briefs then or afterwards submitted. The one suit is founded upon a patent for a design for a billiard table; the other upon a copyright of an engraving exhibiting a view of the same billiard table, with its ornamentation by carving, &c.

As to the first, I am of opinion that, in view of the state of the art and the proof of the prior existence and use of billiard tables similar in form, there was no ground for such a patent. In truth, as a form of construction or configuration, it was not novel in any such sense that its adoption constituted invention. This is proved without the testimony which I have above rejected as inadmissible under the pleadings. It is to be remembered this is not a patent for the billiard table itself, or for anything new in its actual construction, but only for a design embracing its shape or configuration, by whatever means it is effected.

The principal, if not the sole, feature claimed is, the form of beveled sides and ends. Tables and designs for tables having such beveled sides and ends, both straight or in the form technically called "ogee" are shown to be old and in public use long before complainant's alleged invention. This is so clearly established that the argument in behalf of the com-

plainant proceeds mainly upon the ground that the inclination or bevel is greater in the complainant's design than in the others. It is at least doubtful whether that is true as to some of such prior designs; but, in any view of that point, the subject was one of degree of inclination and bevel, to be determined as matter of judgment—in view of the purpose such bevel is adapted to serve, and not matter of new discovery or invention. It embraced no new idea. In either, the inward inclination of the lower part of the sides of the table, receding from the outer edge of the top or cushion bar, enabled the player to stand with one knee partially under the table, for convenience in some part of his playing. The extent of such recess was mere matter of judgment in the manufacture, looking to the purpose for which it was desirable. Had the complainant invented something new in the mode of construction of the sides of the table—some new device by the use of which a table could be constructed with a greater bevel or inward inclination than was before practicable, or a new device by which a new result was produced in making any beveled side, that might perhaps have been secured to him; but I think it clear that a mere design which is practically a suggestion that a greater degree of inclination of the sides will make the table more convenient, when other tables already existed which, with a view to the same useful result in kind, were constructed with a similar bevel, is not invention, nor the proper subject of a patent. If it be possible, however, to include in the complainant's patent not merely the form or configuration of a billiard table, but its peculiar ornamentation, then the complainant must fail, because the defendant does not use the complainant's ornamentation. I state this hypothetically, because, unless the complainant be confined to the specific ornamentation which his design exhibits, then there is nothing in that feature.

As to the copyright, these views are in a large degree applicable to that, also; and, besides, the engraving claimed to be the subject of copyright is not a work of art, print, lithograph or engraving having any value or use as such. It is a mere copy of what the complainant has patented as a design, and constitutes the mode in which complainant advertises his tables. The defendant, having the right to

make his own tables as he does make them, has an equal right to advertise them by showing the public their appearance by engraving, lithograph, or photograph.

The bill of complaint must be dismissed with costs.

COLLENDER *v.* GRIFFITH, *et al.*

U. S. Circuit Court, Southern District of New York.

Decided May 4, 1880.

2 Fed. Rep. 206.

1. A previous design patent, granted more than two years before a mechanical patent describing the same form for a billiard table, does not render the latter void, because while the form or shape may be the same in both patents, the subject-matter of the claims of the two patents is different; one being for shape or configuration only, and the other for mechanical function; and also because the invention claimed in the mechanical patent is not necessarily inclusive of the thing claimed in the previous design patent.
2. A billiard table having the broad side rails bevelled or inclined inward, as compared with the old curved or ogee form, shown by evidence to have sufficient advantage and utility to support a patent.
3. Evidence in this case showing that tables similar to those described in the patent were in use in this country many years prior to the patent, the bill is dismissed.

George Harding and H. D. Donnelly, for plaintiff.
Dickerson & Beaman, for defendant.

BLATCHFORD, C. J. This suit is brought on reissued letters patent granted to the plaintiff June 1, 1875, for an "improvement in billiard tables," the original patent having been granted to him as the inventor, December 23, 1873. The specification says:

"Previous to my invention, it has been customary, in the construction of billiard tables, to form the body of the table with vertical sides, extending downwards from lines

a short distance within the outer edges of the cushion rails, or with what are generally designated as straight or vertical side rails; and previous to my invention, nearly all billiard tables manufactured and used in this country have been made according to this plan. A great variety of designs in the finish and ornamentation, and in the shape of the legs, have been devised and carried into use, and many and great improvements in the past few years have been made in the construction of the beds, cushions, and details of the table, for which numerous patents have been granted to me and to other billiard table makers, until nearly all the requisites of a perfectly working and unique apparatus or machine appeared to have been attained; but one serious inconvenience and disadvantage still remained, in the shape of the body of the table. It was necessary, on account of the weight of the bed, and to provide for a sure and lasting support of the same, to have the side rails, or the body of the table, of considerable depth; and their arrangement in vertical planes, extending downward in the requisite distance, has proved a source of great disadvantage to the player, in preventing him from assuming a position with his leg nearest the table, by which he might be enabled to place and conveniently hold his bridge hand as far over on the bed table, or as far away from the cushion as possible, in the execution of shots in which the cue ball rests far from the cushions, and thus avoid the use of the bridge, which, to most players, is objectionable, and which it is of great advantage to dispense with as much as possible.

"It had also been customary, previous to my invention, to make billiard tables with the sides of the body run under somewhat after the fashion of what are known as 'French' tables or 'ogee' tables; but in all this kind of tables the sides or broad rails have been so formed and so arranged relatively to the extreme upper edge of the table, or to the edge of the cushion rail, that the lower part of the sides, or that portion likely to be on a level with the bended knee of the player, obstructed the advance leg of the player; besides which objection the legs of the table were not placed far enough under to be always entirely out of the way of the players' feet, and the curved or ogee form of the sides rendered the manufacture of such tables very ex-

pensive. My invention has for its object to overcome all these objectionable features in the structure and form of the table, and to provide a billiard table which, while it shall be equally as strong and durable in construction as either of the kinds heretofore made, and equally as desirable in all other respects, shall embody the great advantage of having its broad rails (or the lower portion of its sides) and feet so located as to be always entirely out of the way of the legs and feet of the player, and so as to permit the player to place his bended knee as far under the cushion rail and table bed as may be necessary to effect the placement of his bridge hand as far as possible from the cushion, and at the same time properly support his centre of gravity or maintain his equilibrium; and to these ends and objects my invention consists in a billiard table in which the broad rails are so bevelled or inclined under, and so arranged with the cushion rails (or edge of the table) and the table bed, that while the latter shall be properly supported, the broad rails shall always be out of the way of the player's bended knee, as will be hereinafter more fully explained.

"To enable those skilled in the art to make and use my invention, I will more fully explain the construction and operation thereof, referring by letters to the accompanying drawings, in which Figure 1 is a side elevation, and Figure 2 a vertical cross section of a billiard table, made according to my invention. The bed, B, the cushion rails, C, with their attached cushions, e, and the legs, a, which support the body of the table, are all made in about the usual most approved manner; but the side rails, f, or sides of the body of the table, are made as arranged, as seen in an oblique, in lieu of the usual vertical, or nearly vertical, position, their upper edges being located as far under the table, and away from the cushion rails as they can be placed, and afford a proper support to the edges of the slabs composing the bed.

"The figure represented by the body thus formed is that of an inverted frustrum of a pyramid, instead of being about rectangular in its appearance, as in most of the tables heretofore made. The sides, f, should be bevelled or inclined inward, as they descend from the cushion rails or under side of the bed, at about an angle of from thirty

to forty degrees, or quite sufficiently to permit the player to place his leg in the proper position for reaching as far as possible with the bridge hand, but no further than is necessary for this purpose; because if the angle or flare be increased, the structure is proportionately weakened, the capacity of the body or plane to sustain vertical strain being lessened as such inverted frustrum-mural frame is flattened out. At figure 2, I have illustrated part of a player's figure, to show the convenient and advantageous position which the player may assume in playing, and which position it would be utterly impossible to assume were the sides, f, extended down in the usual manner about vertically.

"It will be seen that the bevelling of the sides or broad rails of the table, as shown and described, permits the player to so extend his bended knee under the table, and so place his foot and posture himself, as to maintain his equilibrium perfectly while reaching over the table to make his bridge; and that the arrangement of the bevelled sides with the bed and cushion rails, as shown and described, renders the support of the bed as perfect, and the whole structure as durable, as in tables made with the old-fashioned vertical broad rails. Any one skilled in the art appreciates the importance of affording the best possible support to the bed throughout the whole extent of the plane of the table, so that it will not get out of level. It will also be seen that while, in a table made according to my invention, the body will be equally as strong as, if not stronger (with the same amount of material) than a table made the old way, by the convergence of the sides, f, as they descend, the legs, d, are brought further under the table, and more out of the way of the player's feet. The construction of such a table as herein shown and described is no more expensive than one with the vertical sides, and may be ornamented and elaborated to the same extent that other tables can be, while at the same time the inclination or obliquity given to the sides, and the consequent location of the legs further under the table, give to the whole machine or contrivance a lighter and more beautiful appearance.

"It will be understood that the angle of inclination of the sides, f, may be varied somewhat from the position or inclination shown, without departing from the spirit of

my invention, the gist of which rests in the idea of having the planes of the broad rails, f, so inclined or bevelled under as to permit the placement of the player's leg and foot as I have explained, and so combined and arranged with the bed and cushion of the table as to afford the most effectual and permanent support of the bed by the said broad rails. I am aware, as I have already remarked, that previous to my invention what are commonly known as French tables have been made and used; but my invention should not be confounded with any such construction of table, which differs materially from my improved billiard table in these essential and material particulars, among others, viz:

"First. In the French (or ogee) tables the sides of the body, or those parts corresponding to what are called in American tables the broad rails, were so combined and arranged with the cushion rail and bed that the lower portions of the body (that part on about a level with the bended knee of the player) were not located any further under the table, and out of the way of the player, than were the lower portions of the bodies of the old-fashioned, vertical-sided American tables."

"Second. On the French tables the curved form, or the ogee shape of the body, rendered the cost of the construction so great that the manufacturer of such tables could not compete with the manufacturer of either the plane vertical-sided tables or my improved bevel tables."

The claim is as follows: "In combination with the bed and projecting cushion rails, the bevelled sides or broad rails, f, the whole constructed and arranged substantially in the manner and for the purposes described."

Infringement is proved and is not contested. The defences insisted on are that the patent is invalid because the plaintiff was not the original and first inventor of the combination claimed in the patent, because the same invention was described by him in a prior patent, and because the invention claimed was not, in itself, a patentable invention. The original patent of December, 23, 1873, was applied for January 16, 1872.

On the sixth of June, 1871, letters patent were issued to the plaintiff for a design for a billiard table. The specifi-

cation says: "My invention relates to a new shape and design for billiard tables. Previous to my invention billiard tables have generally been made with the sides to extend down vertically from the lower side of the rail. In this shape, since the body of the table has to be rather deep to give strength to it, it is rather inconvenient for the player to get his leg in a position which will enable him to reach over the table, and hence this form of construction is objectionable. This objection has, I believe, been partially overcome by a design of some of the French tables, the deep side pieces of which run downward in a sort of ogee form; but this shape, composed of curved surfaces, renders the cost of manufacture of the table much greater than is compensated for by the advantage of greater convenience to the player. I propose, by my design, to overcome the difficulty found in the shape of body or sides, as the tables have been generally made, and render the design and appearance of the table much handsomer; while, at the same time, the cost of manufacture shall not be increased at all. In the accompanying drawing I have shown, in elevation at figure 1, and in vertical cross section at figure 2, a table of my new design or shape. In the drawing, A is the body or main frame of the table; B, the bed; C, the cushion rails; D, the legs; and E, the cushions; all of which are made about as usual, except that the main frame is made so that the sides of the body of the table run under or flare at about an angle of 30 or 40 degrees, as shown at f. The inclined sides, f, it will be seen, are perfect planes, so that the expense of getting out the stuff and putting together, and the veneering, is no more than in the manufacture of the vertical-sided tables now generally made. The inclined or flared sides, f, may be ornamented, panelled, etc., to any desired extent. By reference to the figure drawn at figure 2 it will be seen that the player can so extend his leg under the table, when made as shown, as to enable him to reach further over the bed, which is a great convenience, and enables the player to easily reach many shots, which, on the tables as now made, have to be played with the bridge."

The claim is in these words: "The design for billiard tables, as herein shown and described."

The specific defence set up in the answer, in connection with the design patent, is that the invention patented by the mechanical patent was described in the design patent before it was invented by the plaintiff. What exact defence is intended by this statement is difficult to see. In argument it is contended for the defendant that, as the mechanical patent was issued December 23, 1873, more than two years after the issuing of the design patent, which was issued June 6, 1871, the mechanical patent is void because the original mechanical patent describes and claims the same thing which is described in the design patent. The application for the mechanical patent was filed January 16, 1872. The statutory defence allowed by section 61 of the act of July 8, 1870, (16 U. S. St. at Large, Sec. 208, now Sec. 4,920 of the Revised Statutes,) is that the thing patented "had been in public use or on sale in this country for more than two years before the patentee's application for a patent, or had been abandoned to the public." No such defence is set up in the answer, nor is any such defence proved by the evidence. The fact that the original mechanical patent was issued more than two years after the design patent is of no importance. The claim of the design patent is a claim to shape. The claim of the re-issued mechanical patent is a claim to a mechanical combination. The shape of the structure may be the same as the shape in the design patent, but the subject-matter of the two claims is not the same. The shape covered by the claim of the design patent may be attained without following the mechanical combination claimed in the re-issued mechanical patent.

It is apparent, from the evidence, that there is sufficient utility and advantage in the structure with the broad side rails made of bevelled or inclined planes, in the way of cheapness of construction, as compared with a curved or ogee form, to support the patent. For the same reason the prior structures, which did not have the broad side rails made of bevelled or inclining planes, but had them curved or ogee in form, are not an anticipation of the claim of the re-issued mechanical patent. But the evidence of Daniel D. Winant and of Strong V. Moore is sufficient to show the prior existence of billiard tables containing the combi-

nation covered by the plaintiff's re-issued patent. I refer to the bevelled tables which Winant says he repaired in New York, and which were imported tables, and were made like any other table, except that the broad rail was bevelled, the cushion rail projecting over the bed of the table, and the bed projecting over the frame. I refer also to the billiard tables constructed like the defendants' infringing tables, which Moore saw in New York nearly 50 years ago, the broad rail being a straight bevel, made of flat plank and veneered. These former tables appear to have gone out of fashion, and been replaced by the vertical-sided tables, and then to have come into repute again. It is apparent, from the evidence, that in these former tables, so testified to by Winant and Moore, not only did the bevelled plane of the broad rails place the broad rails and the legs out of the way of the players's knee, but the arrangement of the broad rails with the cushion rail and the table bed was such that the table bed was properly supported, the cushion rail projecting over the bed.

I do not deem it necessary to refer to any of the testimony as to other prior tables, or as to drawings of prior tables, as it results from the foregoing considerations that the bill must be dismissed, with costs.

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PERRY *et al. v.* STARRETT.

U. S. Circuit Court, Southern District of New York.

Decided October 17, 1878.

(O. G., Vol. 14, p. 599.)

[S. C. 3 Bann. & Ard. 485.]

1. An interference in the Patent Office in which priority of invention was awarded against the patent in suit does not conclude the complainant from maintaining his action thereon. The question before the office did not directly concern the existing patent, but whether another should issue to the contesting applicant, and however it might be were the parties the same, since the respondent here was a stranger to the former proceeding there is no estoppel.

2. To constitute a new design that would be patentable as such, it must be so different from all others existing before as to appear to be such to ordinary observers.

3. The patent granted to John S. Perry and others, May 26, 1874, for a design for stoves, held under this rule to be valid; the first claim being interpreted to cover the element of external form as an entirety, without regard to that of the individual parts; the second, the element of ornamentation; and the fifth, the appearance resulting from the combination of the two elements of form and ornamentation.

4. Held that these claims were infringed by the unlicensed sale of a stove "having both form and ornamentation so like those to which said claims relate, that whether regard be had to such form or to such ornamentation separately, or to the combined effect of the two, the stoves so sold are calculated, by reason of such resemblance, to deprive the complainants of a part of that market to which, under their patent, they are exclusively entitled."

5. The Hecla, adjudged to be in appearance substantially like the patented design (the Argand), the general effect, both of form and ornamentation being the same, notwithstanding minor differences which require study and fixing them in mind to enable a person to tell one from the other when they are not side by side.

6. Infringement of a design patent may exist, notwithstanding that the alleged infringing article is made to carry a distinguishing name or distinguishing marks of other character.

WHEELER, J. This bill is brought for an alleged infringement of Design Patent No. 7,456, issued May 26, 1874, for a design for stoves called the "Argand."

The defenses are want of novelty in the invention patented; that the patent is void because it claims too much; and denial of infringement.

The statute provides, among other things, that any person who by his own industry, genius, efforts, and expense has invented and produced any new and original design for a manufacture or ornament to be cast on any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or

described in any printed publication, may obtain a patent therefor. Act of 1870, Sec. 71; Rev. Stat., Sec. 4,929.

This patent was issued under this statute, and has five claims. The first is for the form and outline of the parts for a design for a stove; the second, for the ornamentation for a design for a stove; the third, for any one of the plates having the form and outline for a design, all as described and represented; the fourth, for the ornamentation as a design for any one of the plates; and the fifth, for the form and outline and ornamentation for a stove each as represented. The first, second, and fifth are the only ones upon which a decree is sought

It might be questionable whether the first claim could stand, for the parts of a design separately, as a design, from its nature, is an entirety, if it is anything. But, however that may be, it is insisted for the orators that the claim is in effect for the form and outline of a design for a stove.

The parts together would constitute the whole, and perhaps it is the same as if the mentioning the parts had been left out. Then it would be for the form and outline of the design. These claims, with the first thus considered, stand as claims for the form and outline and ornamentation as separate designs, and for them together as one design.

As the novelty of the invention is in issue, it is necessary to ascertain what designs of this sort were in use before it, for it must be new with reference to all others known or used before.

There is controversy as to whether one kind of stoves, as it embodies the design for the form of a stove or the ornaments, was in existence or not. This controversy is with reference to the Smith stoves, so called, said to have been like defendant's Exhibit 15, which itself had not then been made, and none like it that had been, are shown. Mr. Smith, the inventor of that stove, applied for a patent for his design after the one in suit had been granted, and a question of interference between him and these patentees was raised in the Patent Office and decided by the Examiner of Interferences. In making that decision it was found that Smith was the first inventor of the design he sought a patent for.

It is argued for the defendant that this finding is conclu-

sive here. But by the provisions of the statute it would not be conclusive upon the validity of the Smith patent, even so far as question upon it might arise in court. (Rev. Stat., Sec. 4,914) The patent of the orators was not there in controversy. The question to be determined was whether a patent should be issued to Smith. The finding was incidental to that question. And, however it might be as between the orators and Smith, it was not any finding between the parties to this suit. The defendant was not a party there, and could not be bound, and such estoppels must be mutual to be operative. If both parties are not bound, neither is.

That a stove of substantially the same construction as Exhibit 15 was in existence before, appears upon the evidence beyond any fair doubt. That it had the same ornamentation does not satisfactorily appear. The shape of the shell was probably substantially the same. There may have been slight differences and may not. The stoves called the "American," and the "Lighthouse," and the "Oriental" were in existence before.

The ornamentation of the Smith stoves, which were in existence before, is not shown to have been at all like that of the orator's stove, the Argand. Assuming the shape of those Smith stoves to have been like that of Exhibit 15, they had not, as a whole, the form and outline of the Argand. There are some features of them and of the Argand that are considerably alike. Their legs, ash-pit sections, and lower mica sections, with their rear extensions, and their upper mica sections, except as to the rear extension of that of the Argand, are in shape quite similar. The rest of them are very different from each other. The bases of the Lighthouse and the Argand, the reservoir sections of the American and the Argand, the tops and urns of the Lighthouse, the Oriental, and the Argand, are all somewhat alike.

Upon these similarities it is argued for the defendant that the patentees have only taken those parts of the other designs, and put them together, in mere aggregation, to produce their design, and that in so taking them and putting them together they did not accomplish anything patentable. It is quite clear that any one who should take pages of

leaves from several books, and put them together in a new book, or take parts of several musical compositions, and put them together into a composition by themselves, would not be entitled to a copyright for these productions. Reed *v.* Carusi, Dist. of Md., 1845, 8 Law Rep., 410. And if all the patentees did was to take the legs of the Smith stove, the base of the Lighthouse, the ash-pit and mica sections of the Smith stove, the reservoir and top of the American, and the urn of the Oriental, and join them together, it is also clear that they did nothing entitling themselves to a patent. Binns *v.* Woodruff, 4 Wash., 48; Wooster *v.* Crane, 2 Fisher, 584. Or, if they did no more than to join them together with such adaptations to each other as would be made by the exercise of the ordinary skill of workmen in that trade, probably they did not. But the evidence shows that they did much more than either. Although the legs of the Argand and of the Smith stove are *cyma reversa* in general form, those of the Argand are quite different from the others in proportion and style. The base of the Argand is not exactly like that of the Lighthouse. The curves of its ash-pit section are different from those of that section of the Smith stove. The lower mica section of the Smith stove is convex below and concave above in outward form, while that of the Argand is slightly convex throughout. The lines and curves of the mica section of the Argand are different from those of the Smith stove, and in the Argand the rear extension, to include the exit pipe, is carried upward on that section. while in the Smith stove it is not. And the top and the urn of the Argand differ somewhat from those of either the Lighthouse or the Oriental.

All these parts were made symmetrical of themselves, and in respect to each other, and connected together with appropriate devices, and formed into a harmonious whole in a manner that could not be done without inventive genius and creative skill. The result was different from anything used or known before.

In Gorham Company *v.* White (14 Wall. 511), it was held that to constitute infringement of a design patent, the designs must be so similar as to appear to ordinary observers to be the same, and that they need not be so near alike as

to appear to be the same to experts. It would seem to follow that to constitute a new design that would be patentable as such, it must be so different from all others existing before as to appear to be such to the same class of ordinary observers. Tested by this rule, upon the effect of all the testimony in the case, as well as upon an inspection of the stoves themselves, and considering the Smith stoves to have been in form like Exhibit 15, the Argand was new in design in its form and outline. And so of the ornamentation. Well-known devices for ornamenting in different places upon different articles, were employed; but they were arranged with reference to one another, and upon different parts of the stove with reference to what would be suitable there, so as to produce a new effect. It follows directly that the new form of the stove and new ornamentation upon it together made up a new design for the whole. It was invented and produced by the industry, genius, efforts, and expense of the patentees, and according to the statute they were entitled to a patent for the form and ornamentation separately, and for the whole together. If the first claim had stood as a claim for the different parts of the design severally, as described in the specification, there might be a question as to whether some of these parts by themselves were not so nearly like the corresponding parts of some of the existing designs as to be substantially the same, and so whether they had not claimed some parts to which they were not entitled. But, upon the construction given to that claim, no such question arises, and it is not shown in any manner that they did in any of their claims really claim too much. And if it did it does not appear that they have done so with any willful default or intent to defraud or mislead the public, without which the patent would not be absolutely void. Rev. Stat., Sec. 4916; O'Reilly *v.* Morse, 15 How. 62. Upon these considerations the patent as to the first, second, and fifth claims appears to be valid

What is claimed to be an infringement is the sale of stoves called by the name of "Hecla." The question as to this part of the case must be as to the substantial identity of the design of them with that of the Argand, within the rule in Gorham Company *v.* White. The most

potent evidence is a comparison of the stoves. In appearance they are substantially alike from top to bottom, and so whether viewed as a whole or section by section. There are minor differences, both in form and ornamentation, but the general effect is the same. It requires study of the differences that exist, and fixing them in the mind, to be able to tell one from the other when they are not side by side. They are not only so alike as to deceive ordinary observers, but so as to deceive dealers, large and small, and the ordinary observation of experts, without they go far enough to observe what are really trade-marks. This is not only the result of a comparison of the stoves, but it is the effect of the testimony. It is said that they can be distinguished by their names as well as by these marks, and that, therefore, no one could be deceived. This might be true if the names or trade-marks would always be observed, but they may not be. And, if they should always be, the right to have the products bearing the design distinguished from others is not what is granted by the patent. The patent gives the exclusive right to make, vend, and use stoves of that design during the life of the patent. Knowledge of the origin of the patented articles may not be, and probably is not often, the object of the purchaser. The patentees have given the public the benefit of the design as the fruit of their skill and outlay, and the orators are entitled to a monopoly of the products embodying it during the prescribed time.

Let a decree be entered for an injunction and an account accordingly, with costs.

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THEBERATH *v.* RUBBER & CELLULOID HARNESS TRIMMING COMPANY.

U. S. Circuit Court, District of New Jersey.

Decided February 6, 1883.

15 Fed. Rep., p. 246.

1. Evidence in support of a defense to a charge of infringement of a design patent, on the ground of want of novelty, should be supplemented by specimens of the articles alleged to have been made before the time of the complainant's invention.

2. By the terms of Section 4,886, Rev. St., no article is patentable which has been in public use or on sale for more than two years prior to application for letters patent, or unless the same is proved to have been abandoned.
3. Section 4,929, Rev. St., provides for patents on any new and original designs, and by Section 4,933, Rev. St., all regulations and provisions that are applicable to the obtaining or protecting of patents for the inventions of useful articles are made applicable to design patents.
4. Merely improving the conceptions of another by change in form proportion, or degree, is not such an invention as will sustain a patent.

Philip W. Cross, for complainant.
Joseph C. Clayton and A. Q. Keasby, for defendants.

NIXON, J. This is a suit in equity for the infringement of three several letters patent issued to the complainant, the first, dated January 18, 1870, and numbered 99,032, for "improvement in the covering of harness trimmings;" the second, a design patent, dated June 13, 1871, and numbered 5,006, entitled "design for harness trimmings;" and the third, dated August 24, 1875, and numbered 168,040, for "improvement in harness mountings." The defendant company have filed their answer, setting up that the patents of the complainant are void for want of novelty, and non-infringement. The complainants' patents have reference to improvements in the covering of harness trimmings. The first was granted on the eighteenth of January, 1870. Up to that time, harness mountings were ordinarily covered with leather, with a single seam in the centre, which left a ridge more exposed to wear than the balance of the covering. The wear upon the covering made the trimming less durable than other parts of the harness, breaking the thread, whereby the seam opened and the whole covering was spoiled. The design of the patentee was to avoid this difficulty, by having two seams, one at or near each side, leaving the centre smooth and even, so that one part could not wear out sooner than any other. Although he states in his specifications that the covering might be made of any material, whether elastic or non-elastic, expressly in-

cluding rubber, and that it might be applied to any and every kind of harness trimmings, I think it is probable that the patentee, when the letters patent were applied for, had in his mind only such coverings as needed to be stitched with threads. He wanted to get the seams in a place where they would be less exposed to wear. The breaking of the thread of the seams, caused by such exposure, was the evil in the then existing state of the art which he proposed to remedy.

Such an obvious improvement at once claimed the public attention. It was not only more useful, by rendering the leather-covered harness more durable, but it was more attractive to the eye than the trimmings finished in the old way. Hard rubber was already in use for covering harness mountings, and in order to meet the popular demand for this alleged new improvement in style as well as durability, the defendant corporation, having the control of the hard-rubber coating patents, used that material for covering their harness trimmings; substituting, however, two imitation stitch seams of the patent. Not quite sure, I imagine, that such a use of the form of his invention would be regarded as an infringement, and desirous of more completely covering the whole ground, the complainant filed an application for a design patent, which was issued to him June 13, 1871, and is the second patent on which this suit is brought. In the specifications it is said to relate to a new design for covering harness trimmings, consisting in the formation of a groove or imitation seam near each edge of each covering. In his evidence the complainant states (page 26, Deft. Rec.), that he secured this patent "to prevent others, making harness trimmings with plastic material, from imitating my (his) patent."

The controversy, at the hearing, chiefly turned upon the question of the validity of these two patents. The learned counsel of the defendants maintained:

(1.) That Letters Patent No. 99,032 were void for want of novelty; (2) that if not void they were not capable of receiving any construction which would make the defendant's infringers; (3) that it appeared from the complainant's own testimony in the cause that the invention claimed in the design patent, No. 5,006, had been abandoned to

the public by his manufacturing and selling harness trimmings, covering the design, more than two years before the patent was applied for.

1. Are Letters Patent No. 99,032 void for want of novelty? The patentee states that he has invented a new mode of covering harness trimmings, whereby the rapid wear and destruction thereof are obviated. The new mode consists in abandoning the single seam in the centre of the article to be covered, and adopting two seams at or near each edge, which leaves the centre smooth and even. The defendants say there is nothing novel in this, and bring forward a number of witnesses to testify their knowledge of such a mode of covering long before the date of the complainant's alleged invention. The testimony is sought to be illustrated by a number of exhibits. Defendant's Exhibits Nos. 7 and 39 were particularly relied on as showing an anticipation Exhibit No. 7 was the ordinary hames, having the draft eye covered with leather, with double seams; one seam on each edge. No. 39 was called the union or roller fly-hook, also covered with leather, and having the double seam. It seems to have been conceded on the argument that if articles represented by these exhibits were manufactured and put upon the market two years before the date of the complainant's invention, they clearly anticipated everything claimed by him.

It will be observed that it came out in the proofs that these exhibits were not in existence before the date of the complainant's invention, but had been made since for the purpose of illustrating what the witness said they had manufactured as early as 1859, and continued to manufacture as late as 1874. Why was this? Why were not some of the older articles found and exhibited? Not because they were not made in large numbers. Oscar Weiner says, page 3 of the Defendant's Record:

"From about the year 1859 down to about the years 1873–4, our firm was largely engaged in making hames covered with leather, and draft-eyes covered with leather, in the way shown in this exhibit (No. 7), with the double seams, one seam on each edge. We made and sold them during all these years to all the leading dealers in the country, and are selling them very largely to-day."

He further says (page 61): "In 1864 or '5 we made trimmings covering the principle of stitching on each side, consisting of fly-hooks (defendant's Exhibit No. 39), and we covered some terrets."

Simon Weiner, of the firm of Weiner & Co., being shown Exhibit No. 7, states that they began to cover draft-eyes in hames with double seams, finished like the exhibit, in 1862 and have continued to cover them in that style up to the present time; that in 1864 and 1865 they began to cover terrets and fly-hooks with the two seams as a part of their regular business, and sold the goods to whoever wanted them.

Such testimony seems hardly consistent with two facts:

(1.) That not a single article was produced in the case which was proved to have been made before the time of the complainant's invention; (2) that these gentlemen were sued in this court in the year 1873 or 1874 by the complainant for the infringement of these patents, and before a hearing the paid to the complainant $1,300 in cash, and took a license from him for authority to do what they now swear they have been for so many years in the habit of doing.

If the testimony left the case here I should not hesitate to overrule the defense that the complainant's patent lacked the quality of novelty. But the complainant himself went upon the witness stand, and in his cross-examination testified as follows (Defendant's Record, page 31):

"Cross-question 99. When did you first know of the leather-covered hames, like defendant's Exhibit No. 7, as shown at the draft-eye thereon? Answer, (examining articles), Not until I made them first. This is an imitation of my way of covering the draft-eye on a leather-covered hame. Cross-question 100. Now, answer my question. When did you first see that? Answer. Not till I first made them. Cross-question 101. When was that? Answer. That was in 1865—in the spring. Cross-question 102. Was any considerable number of them made and sold? Answer. Yes, sir. Cross-question 106. Where were you working when you first made and sold them in 1865? Answer. I was in business for myself."

It should be added that subsequently in his cross-

examination the witness insisted that the draft-eye on Exhibit 7 had but one edge and one seam, and stated that such a finish of harness trimmings was not regarded as an infringement of his patent. But the Court cannot agree with him in this. It regards such a manufacture as a clear anticipation of the complainant's patent, and his admission that he put upon the market a considerable number of such a manufacture as early as the spring of 1865, is fatal to its validity. It is not invention to transfer such workmanship from the draft-eye of the hames to the terrets and rings of the harness.

2. The second of the complainant's patents is for a design. The authority for such patents is found in section 4,929 of the Revised Statutes, which provides that they may be issued to any person who invents any new and original design.

(1.) For a manufacture, bust, statue, alto relievo, or bas relief; (2) for the printing of woolen, silk, cotton, or other fabrics; (3) for any new and original impression, ornament, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; (4) or any new, original, and useful shape or configuration of any article of manufacture—the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication.

Patents for designs were first authorized by the third section of the act of August 29, 1842 (5 St. at Large, 543), and have been retained, in substantially the same terms, in the several revisions of the Patent Laws since that date. They differ from patents for inventions or discoveries in this respect, that they have reference to appearance rather than utility. Their object is to encourage the arts of decoration more than the invention of useful products. A picture or design that merely pleases the eye is a proper subject for such a patent, without regard to the question of utility, which is always an essential ingredient in an invention or discovery patent. But, notwithstanding these differences, all regulations and provisions that are applicable to the obtaining or protecting of patents of the latter kind are, by Section 4,933, made applicable also to design patents.

There is, therefore, no foundation for the argument of of the learned counsel for the complainant, that design patents are not avoided from being in public use or on sale for more than two years prior to the application for a patent. The limitation applies to them, and an inventor is not permitted to exhibit his skill and taste in decorative art by the publication of elegant designs through a course of years, and then debar the public from any further use by obtaining Letters Patent for the same. The complainant admits that, as early as 1865, he made and sold articles of manufacture which reveal to the eye the identity of design that characterizes the patent, and hence, the patent is void for want of novelty.

3. The object of the third patent of the complainant (No. 167,040), is to protect the edges of the coverings of harness trimmings. The application for the patent was filed May 8, 1875. The patentee states, in his specifications, that in terrets and other covered harness mountings, as then in use, the edges of the coverings were much exposed, and were liable to be worn and defaced. The reins were also liable to be cut and rapidly worn out by rubbing against the sharp edges of the metallic parts, forming the inside of the terrets or other mountings. These defects were to be remedied by covering them on the under side with metal castings, having their edges raised up, or turned up and projecting, so as to form a groove on each side of the mounting for the reception of the covering.

I have examined the specifications and claims of this patent with great care, and if they embrace any new and useful invention, that is not fairly indicated and shown in the first and third claims of the prior patent (No. 122,163), issued to William Fawcett, on the twenty-sixth of December, 1871, I have failed to discover it.

Fawcett's patent was also for an improvement in the mode of covering harness mountings. His first claim was for harness mountings, covered with leather or hard rubber upon the outer side, leaving the inner side uncovered to receive the plating; and the third claim was for the shoulder or recess formed upon the outer surface of harness mountings, to adapt them to receive a cover upon their outer sides. This is the foundation on which the com-

plainant has builded, and while he has undoubtedly made an improvement, it does not seem to be such an improvement as involves invention. It is merely carrying forward the original conception, which Fawcett patented—a new and more extended application of it—involving change only in form, proportion, or degree. The Supreme Court, in Smith *v.* Nichols, 21 Wall. 112, said that this was not such invention as would sustain a patent. Following that decision, I am constrained to hold that this patent is also void.

The bill of complaint must be dismissed, with costs.

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CROCKER *v.* CUTTER TOWER COMPANY.

U. S. Circuit Court, District of Massachusets.

Decided December 23, 1886.

29 Fed. Rep. 456.

1. Patent No. 16,312, dated October 6. 1885, for a design for easels, the design consisting of the upright standards of the easel crossed near their upper ends, and representing the stem and flowers of the cat-tail plant.
2. The evidence established that easels made of the *natural* cat-tails, crossing each other near their upper ends, had been before known: Held, that the patent, if possible to sustain it at all as containing anything patentable in view of the state of the art as shown must be limited to the specific mode of crossing the standards described in this patent.
3. In defendant's design the standards are not crossed, but held together by a band: Held, that while there was such a resemblance between the two as to constitute infringement if the patentee had been the first to design an easel made of cat-tails crossing each other, the necessary limitation of the claim required the conclusion that there was no infringement, since the plaintiff was not the first to use the main feature of the design, and defendant's design did not embody the patentee's specific mode of applying it.

C. H. Drew and W. B. Durant, for complainant.
C. C. Morgan and O. M. Shaw, for defendant.

COLT, J. This suit is brought upon letters patent No. 16,312, dated October 6, 1885, granted to the complainant for a design for easels. The leading feature of the design consists in the upright standards of the easel, crossed near their upper ends, and representing the stems and flowers of the cat-tail plant or flag. The claim is as follows:

"The design for an easel herein shown and described, the same consisting of the upright standards of an easel, crossing each other near their upper ends, and representing the stem and flowers of the cat-tail plant or flag."

Easels made of natural cat-tails crossing each other near their upper ends, are old. In view of this, the Crocker design must be limited to the mode of crossing the standards described in the patent. In defendant's design the standards are not crossed, but they are held together near the top by a band, from which point, by bending, they are spread out so as to present a fan-like appearance. If Crocker had been the first to design an easel made of cat-tails crossing each other, it might properly be held that the defendants design infringed, from the general resemblance between the two. In view, however, of what was old, we have grave doubts whether the claim of the patent constitutes any invention; but, assuming the patentability of the design, we are clear that it must be limited to the mode of crossing the standards found in the specification and drawing, and, the defendant not using any form of crossing the standards, there can be no infringement, and the bill must be dismissed.

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FOSTER *v.* CROSSIN *et al.* (Two Cases.)

U. S. Circuit Court, District of Rhode Island.

Decided April 6, 1885.

23 Fed. Rep. 400.

1. A preliminary injunction may be granted in a clear case of infringement, notwithstanding the patent is recent and its validity has not been judicially decided.
2. Design patents No. 15,049 and 15,050, for designs for jewelry pins, limited to the distinctive features of the design, not shown

by the affidavits to be lacking in novelty; and, as so construed, preliminary injunction granted.

W. B. Vincent, for compluinant.
J. M. Brennan and W. R. Pierce, for respondents.

CARPENTER, J. These bills pray an injunction to restrain the respondents from infringing letters patent, granted to the complainant, June 10, 1884, for designs for jewelry pins, and numbered 15,049 and 15,050, respectively. The complainant now moves for a preliminary injunction. The respondents, in the first place, object that the patents are recent, and have not been found by any judicial decree to be valid; and they contend that in such case the court will not look further, but will hold that the complainant must fail for want of a judicial decision establishing the patents. or such a lapse of time—accompanied with the general ac, quiescence of the public—as may raise an equivalent presumption in faver of his right to recover on final hearing-

There are cases in which the judges have guided their discretion by this rule. Some of them are collected in Bump on Patents, p. 289, Sec. 4,921. The following cases to the same effect are cited by the respondents: White *v.* S. Harris & Sons Manuf'g. Co. 5 Ban. & A. 571; S. C. 3 Fed. Rep. 161; Warner *v.* Bassett, 19 Blatchf. 145; S. C. 7 Fed. Rep. 468; Jones *v.* Hodges,[1] Holmes 37; Fales *v.* Wentworth, Id. 96; Jones *v.* Fields, 12 Blatchf. 494; Cross *v.* Livermore, 9 Fep. Rep. 607; Bradley & Hubbard Manuf'g. Co. *v.* Charles Parker Co., 17 Fed. Rep. 240. In all these cases it is to be noted, however, that there were other grounds for denying the motion besides that on which the respondents here rely; and I think very few cases will be found in which an injunction has been refused solely on the ground here urged.

Undoubtedly, the production of the patent alone can in no case raise a presumption in favor of the patentee sufficient to justify the order of a preliminary injunction; and it is, perhaps, usually true that the most satisfactory basis for finding such a presumption will be in a judicial decision or in long uninterrupted use. But I am not prepared to say that the presumption can arise in no other

way. It is true that a rule will be found laid down in many cases in terms which, taken by themselves, are broad enough to support the contention of the respondent; but it is also true that in many, if not most, of these cases the rule is stated more broadly than is necessary to the decision. I do not think the present current of decision tends to the establishment of a pointed rule such as is here claimed by the respondents. New York Grape Sugar Co. *v.* American Grape Sugar Co., 20 Blatchf. 386, S. C. 10 Fed. Rep. 835; Steam-gauge & Lantern Co. *v.* Miller, 8 Fed. Rep. 314.

I proceed, therefore, to consider whether the complainant has, on this motion, shown such a case as raises a clear presumption that he will be entitled to a decree on final hearing. Infringement is sufficiently proved, and, indeed, is not denied; but the respondents strenuously contend that the patents are void for want of patentable novelty. The distinctive feature of the design is fully stated in the claims of the patents. The claim No. 15,049 is as follows:

"The design for a jewelry pin herein shown and described, the same consisting of a plate having the shape of a spoon, with the outline edge of the plate turned backward at a nearly uniform distance from its front, and the surface of the handle of the spoon showing an embossed or engraved ornamentation."

The claim of No. 15,050 is the same, with the substitution of the word "table-fork" for the word "spoon." The main feature of the design is described in the words, "with the outline edge of the plate turned backward at a nearly uniform distance from its front." It is suggested that this clause of the claim relates to the method of manufacture, rather than to the design of the finished product, and therefore cannot be sustained in a design patent; but I think the reading of the whole claim shows the true meaning to be that the design claimed consists, not in the method of construction, but in the peculiar rounded and finished form of the edge, like that of a table-spoon, which peculiar form necessarily results from the turning down of the edge of the plate, and is most clearly described by reference to the process of manufacture which produces it. The question, then, is whether this design is new and sufficiently dis-

tinctive to be patentable. The respondents read the affidavits of several persons, who testify that they have seen for sale in the market, at various times from July, 1880, down to the present time, jewelry pins made in the form of spoons and forks. Three examples of such pins are produced in evidence. One of them is distinctly identified as a "specimen" of those sold by the affiant in the year 1881. The others are very imperfectly, if at all, identified as having been actually sold or made for sale, but they are stated by the witnesses to be similar to those which they have seen on sale. All these pins show embossed or engraved ornamentation, but they are all so made that there is a distinctly perceptible angle between the front and the edge of the spoon or fork which forms the pin.

Although the testimony by which these exhibits are verified is not of the most satisfactory kind, nevertheless, if the exhibits were exactly similar to the pins described in the patent, I should be unwilling to order an injunction. It is, therefore, necessary for the complainant to maintain the proposition that the rounded and smoothly-finished edge constitutes such a distinctive feature of the design as will support the patents.

Much light, as it seems to me, is thrown on this question by the affidavits read by the complainant. Seven witnesses, who have been engaged in the jewelry business in New York and Providence for different spaces of time, from fifteen to twenty-eight years, testify that so far as they know, the pins made by the complainant according to his design, were the first pins of that description known to the jewelry trade; that they were recognised by the trade as an original design; that the peculiar shape given to the edge by turning back the plate is distinctive and easily observed; that pins made with this shape are readily distinguished from those made like the exhibits produced by the respondents; and that the pins made by the complainant under his patents are in large demand, and have been, as affiants are informed, extensively copied by other persons. There are, indeed, affidavits produced by respondents in which witnesses, who are in the jewelry trade and are apparently equally well able to judge of the matter, give their opinion that there is no substantial difference in design

between the pins made by complainant and those which have formerly been sold. It seems to me, however, to be plain that the distinctive feature invented by the complainant, slight though it be, has been sufficient to create a large demand for the article in question, where there was before, to say the best of it, but a small demand. In view of the affidavits produced by the complainant, I can hardly believe that pins of the fork and spoon design have been generally sold in the jewelry trade before they were introduced by the complainant. Design, of course, relates solely to the appearance of the article to the ordinary purchaser; and, when the question is whether a difference of design be substantial and valuable, surely there can be no test better than the practical test which is furnished by observing the effect of the two designs on the appreciating observation of the purchasing public. I conclude that in this case the design is sufficiently distinctive to support the patents.

Some evidence has been introduced on both sides of the question whether the complainant be the first inventor of the turned-over edge as applied to jewelry pins. On this point I do not think it necessary to say anything, except that I am clearly satisfied that the complainant is the first inventor.

Let a decree be entered, enjoining the respondents as prayed.

DREYFUS *v.* SCHNEIDER, *et al.*

U. S. Circuit Court, Southern District New York.

Decided November 10, 1885.

25 Fed. Rep. 481.

1. The burden of proof is on the defendant to satisfy the court beyond a reasonable doubt, that the defense of prior knowledge and use has been established. Evidence held insufficient.
2. To constitute an infringement of a design patent it is sufficient if the alleged infringing article bears such a resemblance to that of the patent as to deceive the ordinary observer.

3. If the evidence connecting the defendants with the sale or use of the infringing article is not convincing, *per se*, it may be deemed sufficient to put the defendants to proof, after such evidence, to support the denial of infringement; and for want of such proof the issue should be found against the defendant.

R. B. McMaster, for complainant
William H. O'Dwyer, for defendants.

COXE, J. The complainant is the inventor of a new and original design for a pendant, for which design letters patent No. 14,356 were issued October 23, 1883. The pendant consists of a ring made of chenille, or other analogous fabric, suspended from a tuft, and a ball suspended in like manner in the centre of the ring; the thickness of the ring increasing from the bottom of the tuft to a point diametrically opposite. The defenses are want of novelty and non-infringement.

It is argued in the complainant's brief that a portion of the testimony relating to prior use and knowledge is inadmissible under the pleadings; the defendants having failed in the Answer to comply with the provisions of Section 4920, Rev. Stat., in omitting to state the names and residences of the persons alleged to have invented or to have had prior knowledge of the patented design. The answer is not among the papers submitted, and therefore it is impossible to rule intelligently upon this objection; but a ruling is rendered unnecessary, as I am convinced that the testimony is not of that clear and convincing character required to overthrow the presumption of validity arising from the patent itself. The burden is upon the defendants to satisfy the court beyond a reasonable doubt that the defense of prior knowledge and use has been established. Coffin *v.* Ogden, 18, Wall. 120; Howe *v.* Underwood, 1 Fisher, 160; Shirley *v.* Sanderson, 8 Fed. Rep. 905; Green *v.* French, 11 Fed. Rep. 591; Walk. Pat. Sect. 76. Tested by this rule the testimony of the defendants is wholly inadequate. It is too general, vague, and indefinite. Every fact and circumstance which might tend to raise a doubt as to the validity of the patent, and which is sufficiently explicit to admit of contradiction, is fully explained and answered by the complainant's evidence in rebuttal.

Bearing in mind the rule with reference to design patents, that it is enough if the resemblance is such as to deceive the ordinary observer (Gorham Co. *v.* White, 14 Wall. 511), there can be no question that the pendants, marked "Exhibit A," are infringements of complainant's patent. The difficulty upon this branch of the case is with the proof by which it is sought to connect the defendants with the infringing pendants. Though this evidence is not of the most convincing character, it was unquestionably sufficient to put the defendants upon their proof, and as they failed to deny the infringement after testimony was adduced which pointed to them with great directness as the wrong doers, it is clearly the duty of the court to find against them on this issue.

There should be a decree for the complainant.

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LEHNBEUTER *et al. v.* HOLTHAUS, *et al.*

Supreme Court of the United States.

Decided March 6, 1882.

105 U. S. Reports, 94.

An immaterial variation of the design, such as a slight inclination backward, hardly perceptible to the eye, of the glass constituting the front of the elevated parts of a show-case, does not relieve from the charge of infringement.

It is immaterial to the patentability of a design whether it is more graceful or more beautiful than older designs. It is sufficient if it is new and useful. The patent is *prima facie* evidence of both novelty and utility, and neither of these presumptions has been rebutted by the evidence.

Appeal from the Circuit Court of the United States for the Eastern District of Missouri.

Mr. R. H. Parkinson, for appellants.

No counsel appearing for appellees.

This was an appeal by the plaintiffs below, who filed a bill which charged infringement by defendants of Design

Patent No. 8814, for show-cases, granted to the complainants jointly, and dated November 30, 1875. The answer denied that the complainants were the first inventors of the design patented, denied its utility, and denied infringement. Upon final hearing the Circuit Court dismissed the bill because "said letters patent were not good and valid in law."

The record contained the following stipulations in respect to the evidence. "That the following exhibits may be produced by either party at the hearing upon an appeal in the Supreme Court and used in evidence as a portion of the transcript herein, viz: 'Defendant's Exhibit, Wiegal Catalogue,' and 'Defendants' Exhibit, Maw's Price Current;' also, 'Design Patents Nos. 8,287, 8,813, and 8,814; also, 'Complainants' Exhibit Holthaus Circular;' that it shall be taken as admitted, for the purpose of this case, that said exhibits, 'Wiegel Catalogue' and Maw's Price Current,' were issued prior to January, 1874; that the Circular marked 'Complainants' Exhibit, 'Holthaus Circular,' is a copy of circulars issued by the defendants in the month of July, 1877, and subsequently thereto; that the cuts therein correctly represent show-cases made and sold by the defendants in St. Louis within said Eastern District of Missouri during and after January, 1877, and before the commencement of this suit, and still made and sold by them; also, that the circular marked 'Complainants' Exhibit, Claes & Co., Circular,' is a copy of a publication issued and circulated by complainants in the month of September, 1875, and subsequently thereto; also, that the model marked on bottom, 'Complainant's Exhibit, Model No. 1,' under the hand of the same notary, correctly represents show-cases made and sold by defendant in said St. Louis, during the month of January, 1877, and before the commencement of these suits."

The only witness in the case was Charles K. Pickles, who testified for the complainants that he made the original drawings from which the plates were made of the cuts, 33, 34, and 36 of the Holthaus' circular; that he made the drawings for Holthaus, the defendant, who gave him cuts from Claes & Co.'s circular, from which to make the plates or prints, and that there were slight changes suggested by

Holthaus, which the witness followed in making the drawings.

The Wiegel Catalogue, Maw's Price Current, the Holthaus' Circular and the design patents, numbered respectively 8,287, 8,813, and 8,814 with their drawings, the first granted to Joseph Lehnbeuter, and the other two to Lehnbeuter and Claes, the complainants, were put in evidence. The one last named was that on which this suit was brought.

Mr. Justice Woods delivered the opinion of the court.

A comparison of the drawing which is appended to Patent No. 8,814, with cut No. 34 of the Holthaus' Circular, which, it is admitted, represent show cases manufactured and sold by the defendants during and since January, 1877, makes it clear that the latter is a servile copy of the former, excepting a slight inclination backward, hardly perceptible to the naked eye, of the glass constituting the front of the elevated portions of the case. We think, therefore, that the infringement is clearly established.

The attempt to prove that the complainants were not the first inventors of the design covered by their letters patent, has entirely failed. The only evidence offered on this branch of the defense are the publications designated as "Maw's Price Current" and the "Wiegel Catalogue." The first of these bears date in 1869, and the latter in 1872. After a careful search through both we have been unable to find any design for a show-case which remotely resembles that described in the complainants' patent. The design patented by the complainants differs essentially from any other which has been called to our attention. It is not covered by the other patents which are set out in the record. Whether it is more graceful or beautiful than older designs is not for us to decide. It is sufficient if it is new and useful. The patent is *prima facie* evidence of both novelty and utility, and neither of these presumptions has been rebutted by the evidence. On the contrary they are strengthened. No anticipation of the design is shown, although the attempt has been made to prove anticipation. The fact that it has been infringed by defendants is sufficient to establish its utility, at least as against them. (Swayne, Justice, in Whitney *v.* Mowry, 4 Fish. 207.)

Our conclusion is that the complainants have a valid patent, which the defendants have infringed. The decree of the Circuit Court dismissing their bill must, therefore, be reversed, and the cause remanded for further proceedings in conformity with this opinion.

MEERS *v.* KELLY.

Circuit Court, Southern District, New York.

Decided May 16, 1887.

31 Fed. Rep. page 153.

1. Suit on design patent, No. 14,961, dated April 15, 1884, to plaintiff, for a photographic album leaf, shown and described as an exterior plain border or frame, apparently elevated, inclosing a border or frame with a roughened or pebbled surface, and within this, pockets apparently raised for the purpose of holding the pictures; thus making three mats or frames.
2. Evidence of the state of the art described that album leaves with pebbled surfaces surrounding the openings through which the pictures are seen were old; and smooth borders surrounding pebbled pockets, and pockets with ornamented edges, were also old.
3. The defendant sold photograph albums with two borders surrounding the pockets,—one border pebbled, the other smooth,—not raised, but even with the surface of the sheet.
4. Held that if limited to the specific design shown, the patent was valid; but if construed to include, generally, a plain border inclosing a pebbled border, which inclosed a pocket, it was wanting in patentable novelty; and as defendant did not use the former construction, there was no infringement, and the bill must be dismissed.

J. Milton Stearns, Jr., for plaintiff.
Andrew J. Todd, for defendant.

SHIPMAN, J. This is a bill in equity to restrain the defendant from the alleged infringement of Design Patent No. 14,961, issued April 15, 1884, to Stephen Meers, for

a photographic album leaf. Letters Patent No. 293,054 were issued February 5, 1884, to the same patentee, for an improvement in photographic albums. The improvement consisted in part in dispensing with a large portion of the pasteboard which is ordinarily used inside the leaves of photographic albums, and in part in embossing the edges of the openings in the leaves, and thereby making raised pockets for receiving the pictures. The rim of pasteboard upon the edges of the leaf is also raised or elevated above the adjoining surface of the leaf. The specification of the design patent says that the "leaf is ornamented by a frame, A, the surface of which is roughened or pebbled, and which incloses the pocket or pockets, B. The roughened frame, A, is inclosed in a frame, C. This roughened frame imparts to the leaf an ornamental appearance." The claims are as follows:

"(1) The design for a photographic album leaf, consisting of the roughened frame, A, inclosing the pocket or pockets, B, as shown and described.

"(2) The design for a photographic album leaf consisting of the exterior frame, C, the roughened frame, A, inside the frame, C, and the pocket or pockets, B, inside of the roughened frame, A, as shown and described."

The frame, A, is a border of grained or roughened surface surrounding, for a certain distance, the pocket or place to hold pictures, and the frame, C, is a smooth border between A and the edges of the leaf. These borders have the effect of mats or frames for the picture. The drawings of the patent represent the pocket as apparently raised above the surrounding surface, and the border, C, as raised above the frame, A.

The defendant sells albums having leaves ornamented with borders, A and C, surrounding a pocket, not raised, but even with the surface of the sheet. The pasteboard in his leaves extends nearly to the pocket, so that the border, C, is upon a level with A.

At the date of the invention, photographic album leaves with pebbled surfaces surrounding the openings or spaces in the leaves through which the pictures are seen, were old. A smooth border surrounding a pebbled pocket, and a pocket with ornamental edges were also old. In view of

the state of the art at the date of the application for a patent, there was nothing indicative of invention in surrounding an ornamented or unornamented opening or pocket with a pebbled border which did not extend to the edges of the sheet. If the patent is construed to include a plain border inclosing a pebbled border, which incloses a pocket, then it does not contain patentable novelty, because pebbled surfaces surrounding the openings in album leaves were old at the date of the improvement, and there was nothing patentable in limiting the area of the pebbled surface. If the patent is limited to the design which the patentee made, and which is shown in the drawings, and which consists of an exterior plain, apparently elevated, border inclosing a pebbled border, which inclosed a pocket apparently raised, thus making, apparently, three mats or frames for the picture, it is a good design patent. Such a design has a pleasing effect, which is peculiar to itself, seems to be novel, and has the necessary element of invention.

There is no infringement, and the bill is dismissed.

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ECLIPSE MANF. CO. *v.* ADKINS *et al.*

U. S. Circuit Court, Northern District of Illinois.

Decided October 15, 1888.

36 Fed. Rep. 554.

1. A demurrer to a bill for want of novelty in the alleged invention will not be sustained, unless the court, from his own knowledge, has no doubt that the device is well known and in common use, and matter of common knowledge.
2. The court not being able to say from common knowledge that there is no novelty in the design for a radiator described in Letters Patent No. 17,270, granted April 19, 1887, to Leon H. Prentice, consisting of a plan for ornamenting the surface of the radiator pipes by embossed or depressed figures on the upper parts, leaving the lower parts plain, thus forming two rectangular parallelograms, one above the other, a demurrer to a bill to enjoin the infringement of such a patent should be overruled.

3. If it was novel with the patentee to ornament the surface of radiator pipes by dividing the space by a horizontal line, and adding any kind of ornament to one of the spaces, the claim would not be void, because the patent did not describe or show any specific ornament for such space.

Dyrenforth & Dyrenforth, for complainant.
E. S. Bottum, for defendants.

BLODGETT, J. This is a bill in equity asking for an injunction and accounting by reason of the alleged infringement of Letters Patent No. 17,270, granted April 19, 1887, to Leon H. Prentice, for a "design for a radiator." In his specification the patentee described the subject-matter of his patent as follows:

"The leading feature of my design consists in the upright or vertical pipes of the radiator, having a comparatively plain or even surface for a portion of their length from the bottom up, and with an ornamented surface consisting, preferably, of embossed or depressed ornamentation at the top or upper part, the plain portion constituting the lower or base portion of the radiator, and the figured or ornamented portion constituting the top or crown of the same; the plain and figured portions offsetting each other and presenting a contrasting appearance between the upper and lower parts of the radiator. These portions of the surface give the radiator a pleasing appearance. * * * The invention consists in the radiator composed of a series of vertical pipes or loops of uniform height, having the crown or top portion of the pipes or loops ornamented or figured a uniform distance from the top downward, the portion below being comparatively plain. In this manner the ornamented and plain portions of the aggregate surface of the radiator constitute two rectangular parallelograms, one above the other. A similar effect would be produced by transposing the plain and figured portions."

And the claim is:

"The design for a radiator herein shown, consisting of a series of upright pipes or loops of uniform height, having the upper and lower portions of their aggregate surface distinguished from each other by ornamentation, so as to present rectangular figures, A, B, in contrast."

Defendant demurs to the bill on the ground that the design described and set forth in the patent was not new and patentable at the time of the alleged invention thereof by the patentee, but that, on the contrary, the same was, from the common and general knowledge of the public, old and well known at the time of the alleged invention thereof by the patentee; of all which the court will take judicial notice. That the design is not such as requires the exercise of inventive genius and effort. It was also urged, *ore tenus*, that the patent is void because the specifications do not describe the kind of figures that are to be used for the ornamentation of the radiator, but it is simply and baldly for the idea of ornamenting the upper or lower portion of a radiator with figures of any kind, whether embossed or painted thereon. The patent law of the United States (Section 4,929, Rev. Stat.) provides that—

"Any person who, by his own industry, genius, efforts and expense, has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, patent, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, * * * * may obtain a patent therefor."

In West *v.* Rae, 33 Fed. Rep. 45, this court sustained a demurrer to a bill charging infringement of a patent on a device for protecting woolen blankets from insects by encasing them in paper bags, on the ground that within the common knowledge it was old to wrap or incase woolens in paper to protect them from dust or insects. At the time I announced the decision in that case, I stated that its effect might be to encourage counsel to demur to bills for infringement of patents in cases where they, from their special knowledge of the art, might be of opinion that the device covered by the patent was old. And my anticipations in that respect have been fully realized, as that decision has already produced in this court quite a bountiful crop

of demurrers in this class of cases. But the court must meet each case as it arises, and in sustaining demurrers like this, keep strictly within the field of common knowledge. The practical difficulty and danger is in defining where special knowledge leaves off and common knowledge begins. The judge must always be careful to distinguish between his own special knowledge, and what he considers to be the knowledge of others, in the field or sphere where the device in question is used. But when the judge before whom rights are claimed by virtue of a patent can say from his own observation and experience that the patented device is in principle and mode of operation only an old and well-known device in common use, he may act upon such knowledge. The case must, however, be so plain as to leave no room for doubt, otherwise injustice may be done, and the right granted by the patent defeated, without a hearing upon the proofs. The judge must, upon all such questions, vigilantly guard against acting upon expert or special knowledge of his own instead of keeping strictly within the field of general or popular knowledge. While I do not intend to lay down a rule, I am free to say that I should not feel justified in holding a patent void for want of novelty on common knowledge, unless I could cite instances of common use which would at once, on the suggestion being made, strike persons of usual intelligence as a complete answer to the claim of such patent.

The patent now under consideration is for a design by which the surface of a radiator is to be divided by a horizontal line into two rectangular spaces, and one of them—that is, either the upper or lower of these spaces—ornamented with figures, which may be produced by embossing or depressing upon the surface, or perhaps by painting. This certainly strikes me at first impression as a very close, if not doubtful, patent. I cannot, however, say from my own knowledge, or from any familiarity with radiators in common use, that it is not new. I may say that, so far as my own observation goes, I have never seen radiators ornamented in the manner shown in this patent, or by figures of any kind, either embossed, depressed, or painted thereon. Hence I am unable to say that this design is not wholly new and original with this patentee. As to the point that

this patent is void because it does not describe the kind of figures, I can only say that I, at present, am of opinion that if this patentee was the first to invent or produce an ornamented radiator, that is, the first to design a radiator with an upper or lower rectangular space ornamented by figures of any kind upon it, then he may be entitled to a patent for such design. It may not have required a very high order of genius or inventive talent to have conceived and produced such a design, but if it was new, if it originated with him, then I cannot, on demurrer, say his patent is invalid. I have nothing at present before me from which I can say that it did not require study, thought, and inventive talent to produce this design. The case can be far more satisfactorily and safely for the rights of all parties, disposed of upon proof as to the state of the art. The demurrer is therefore overruled.

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SPARKMAN, *et al.*, *v.* HIGGINS, *et al.*

U. S. Circuit Court, Southern District of New York.

Decided October Term, 1846.

1 Blatch., C. C. Rep. 205.

1. A caveat or application, though informal, if followed up with reasonable diligence, will afford ample foundation for a subsequent patent properly claiming the invention.
2. Suggestions made by a patentee to a workman, which leave nothing for the latter to do but carry them into effect to produce the design patented, will not avoid the patent.
3. Abandonment is not made out by proof that a patentee stipulated for the sale of his goods, before applying for his patent; the delivery not taking place till after application filed.
4. A declaration of any kind, by an inventor, which may fairly indicate an intention to claim the thing afterwards patented, rebuts presumption of abandonment arising from public sale before patent.
5. Erroneous or insufficient information from the Commissioner of Patents, obtained on inquiry, by an infringer, is no excuse for infringement of patentee's rights.

Daniel Lord, for the plaintiffs.
Seth P. Staples, for defendants.

BETTS, J. The plaintiffs have an injunction granted on their bill of complaint. The defendants move to discharge it on affidavits, and unless their proofs overcome the equity of the bill, and the evidence supporting it, the motion must be denied. They may make out a different case at the final hearing; but this motion must depend on what is now presented to the court.

The study of the courts has recently been, and especially since the patent acts of 1835 and 1839, to carry out the protection of the law to inventors, so as to secure to them the full benefit of their inventions. An inventor is bound to notify the public of his claim, by a caveat or application filed at the Patent Office, designating his discovery, and what he means to secure to himself. This is a matter often of nicety, and men of great experience encounter difficulties in preparing their papers. Correspondence ensues between the officers at Washington and the patentee, which consumes time. But if the claim thus put forward, although originally informal be followed up with reasonable diligence, and if, eventually, the patent is granted, it prevents any right being acquired by strangers interfering in the meantime. Here the first application, the claim to the invention, was made on the 13th day of February. It was again made on the 23d of March, and the papers were retained by the Patent Office until the 22d of June. They were then sent to New York, and returned with other and correct papers on the 14th of July, and the patent in suit was granted on the 24th of July. It is not for the court now to examine critically the correctness or even sufficiency of the application; as it was made to all appearance in good faith and was an attempt to make known and secure the claim.

It is next contended that Berry was the inventor, and not the plaintiffs, which position, if established, would be a good ground to dissolve the injunction. The defendants lay before the court the declarations of Berry, in connection with his working without any draft, design or model before him, which the defendants insist proves him to be the

inventor. But, on the other hand, Mr. Kelsey details very minutely the suggestions he made, his superintendence, his suggesting alterations in a design got up, his disapproving that, and the adoption of his views in the design now patented. And Mr. Berry gives his own account of the matter, and explains the declarations attributed to him, as referring to his working without a copy before him, and to the design being an original and not a copy. He does not intimate that he did not receive suggestions, alterations and directions from Mr. Kelsey, which were carried out in this design. To constitute an inventor, it is not necessary that he should have the manual skill and dexterity to make the drafts. If the ideas are furnished by him, for producing the result aimed at, he is entitled to avail himself of the mechanical skill of others to carry out practically his contrivance. Here the devising of the pattern, in this sense, appears to have been done by the plaintiffs.

Again, it is contended that the plaintiffs have abandoned their claim, or so dealt with it as to give it to the public. This, if made out, would also entitle the defendants to succeed. They first rely on the sale to Smith, who gave an order for goods on seeing the pattern, in January, which the plaintiffs agreed to execute. But an inventor may do this. He may stipulate for a sale of his invention before it is completed, without vitiating his claim; and these goods were not delivered until after the application of the 13th of February was filed in the Patent Office.

It is urged also, that Rice and Sampson purchased goods of the pattern in question at Baltimore, in April, and applied at Washington to know if it was patented, and were informed that it was not. That was true. But they do not say that they inquired if a patent had been applied for, and whether an application was pending. There was then an application there, with a specimen of the drawing of the design. If the commissioner or the officers had even overlooked it, that would not have defeated the plaintiffs' right. They had, in good faith, made their claim, and were at the time following it up, and eventually matured it. The sale did not defeat the right to the design.

It also appears that when the goods were shown in January, they were shown as the patent goods, or the

registered patterns of the plaintiffs. Now, although registered patents or patterns is not a term of law, yet it may well have indicated a pattern as claimed to be of their design, and one for which they were preparing to take out a patent.

The defendants have not made out a case to dissolve the injunction, and the motion must be denied, with costs.

STREAT *v.* WHITE, *et al.*

U. S. Circuit Court, Southern District of New York.

Decided July 2, 1888.

35 Fed. Rep. 426.

1. Letters Patent No. 16,375, dated November 10, 1885, to George Streat, claimed a design for printing textile fabrics, the leading feature of which was stripes of a solid block of color parallel to and alternating with stripes which are crossed at right angles by alternate dark and light lines, blended into each other by shading, and which was intended to be, and was, an imitation in printed cloths, of the woven fabric commonly called "seersucker."

2. It appearing that though the patentee conceived the idea of the imitation, but which had previously been attempted by others, the actual invention of successfully producing the imitation was by blending together the cross lines by shading, and which was alone novel, and as this was entirely the work of the engraver to whom the patentee committed the work, held the invention was made by the latter and not by the patentee.

3. Had the patentee conceived the idea of the blending together of the cross lines by shading, though he did not actually do the work, the case would be different.

Samuel R. Betts, for plaintiff.
Reuben L. Roberts, for defendant.

SHIPMAN, J. This is a bill in equity to restrain the defendants from the infringement of Design Patent No. 16,379, dated November 10, 1885, to George Streat, for

a design for textile fabrics, specially to be employed in printing calicoes and similar fabrics. The leading feature of the design consisted in a stripe of a solid block of color, or in the form of dots or pin-points applied closely together, "parallel to and alternating with a stripe which is crossed at right angles by alternate light and dark lines, which are blended into each other by shading." The general color or tint of the stripes is immaterial. The claim is as follows:

"The design for textile fabrics herein shown and described, the same consisting of the stripes, a a, parallel to and alternating with the stripes, b b, the latter being crossed at right angles by alternate light and dark lines, which are blended into each other by shading, substantially as described."

This was intended to be, and was, an imitation in printed cloths of a well-known and popular woven fabric called "seersucker." which presents a smooth stripe parallel and alternating with a ridged or crinkled stripe. The object of the alternate dark and light cross lines in the stripes, b b, was to represent the crinkled effect of the corresponding woven stripe in the seersucker. The idea of imitating, in printed cloths, the woven seersucker, was not a new one at the date of the alleged invention. It had frequently been attempted. Alternate light and dark cross-bars, at right angles with the stripes, to imitate the crinkled appearance of the ridged stripe, had been used; but I assume that the blending into each other of these lines by shading was novel. The design quickly attracted the fancy and favor of the public, and became very popular. The point in the case which I deem of most importance and of most danger to the patent is in regard to the fact of invention by Streat. He conceived the idea of imitating a seersucker fabric, and of having one stripe crossed at right angles by cross-bars, in which there was no novelty, and then submitted the project of an imitation to Mr. Gilmore, the manager of a factory for printing cotton goods, with the request that he cause it to be produced, which was done by the designer and engraver in Gilmore's factory. The patentee now desires to represent, in general and somewhat vague terms, that he conceived the idea of the blending together of the

cross lines by shading, and desired Gilmore to have the idea carried out. If that had been the fact, he would have created a design which contained "a new impression or effect, produced by an arrangement or configuration of lines, which introduces new elements of color or form" (Packing Co. *v.* Rubber Co., 24 Blatch. 345; 30 Fed. Rep. 785), and unless such imitation is within the engraver's customary art, I should not have deterred from conceding to him a position as inventor by the fact that he was imitating an old woven fabric. Other persons had imitated it with varying success, but the patent shows a new combination of lines by which it was successfully reproduced. The difficulty in this case is to know what the patentee created; but his correspondence with Gilmore before the design had been made or sketched by the engraver, is very significant upon this subject, and shows to my mind that he invented nothing except the idea of an imitation of a seersucker, and that the conception of the method by which the result was to be attained was entirely the work of the designer. The first communication of Streat to Gilmore was in a conversation on July 28, 1885. On July 29th he wrote Gilmore as follows:

"I herewith inclose a tintype which I had taken to-day from the sample of the seersucker which I retained after giving you the other half. I think it shows up the crinkle in the cloth plainly, and have no doubt your designer can imitate it accurately, which, if he succeeds, will, I think, lead to a good business in the goods. I think we should start right by having a good imitation in effect. Please let me hear from you as soon as possible in regard to this matter, as the goods will be wanted just as soon as we can get them out."

On July 30th he wrote Gilmore again, as follows:

"In regard to the printed seersuckers I am enthusiastic. If the engraving is well done as an imitation of the woven, I am satisfied we can sell a large quantity, as we will give good goods and at a popular price. I inclose you small sample of the dog's head, horse, horseshoe, as showing the class of work we want; *i. e.*, fineness. Cant you send me a sketch (before engraving) showing your designer's idea or conception of how the imitation should be? Just as

soon as we can get an idea how it will look, will forward gray goods at once, as the trade are now ready to give orders. Please let me hear from you by return mail, if you can, as to how the matter is progressing," etc.

These two letters show that Gilmore and the designer were furnished with a sample of a seersucker, and with a photographic copy of the sample, and were told to imitate it, and that the way in which the imitation was to be effected was left with the designer, who was solely responsible for a successful result, and to whom the task of finding an idea or conception of the method of imitating the crinkle was solely committed. The case does not contain the facts which generally come before courts upon the subject of joint or sole invention. It is not that of an inventor and a workman who puts into form the inventor's new idea. The idea of Streat was old. Had it been new, the facts would be different. The invention consisted in the new and successful way by which the old idea was made effective. Streat was the originator of nothing novel, except indirectly. He asked the designer to furnish an accurate imitation of the seersucker, and, if invention was necessary, to invent an imitation, and his request was complied with. The bill is dismissed.

CHAPTER V.

Of infringement, and identity of designs.

SECTION 1. Prior to the decision of the Supreme Court, in 1872, in Gorham Manufacturing Company *v.* White,[1] the decisions of the various Circuit Courts were not harmonious as to the character of the thing protected by a design patent, and the test of identity of design. It had previously been adjudged in the case in the court below,[2] that it was not the appearance, but the means by which the appearance was produced, that was intended to be protected by the patent, but the Supreme Court refused to accept that view; and, as it had previously intimated in an opinion rendered during December Term, 1869,[3] held, without qualification, that it was the resultant form or appearance, no matter by what agency produced, that constituted the thing for which the patent was granted. Hence a comparison of appearances must be the means of determining identity or dissimilarity.

SECT. 2. The general rule for the determination of the question of infringement of design patents was enunciated by the Supreme Court, in Gorham *v.* White, to be similarity of general appearance to the eye of average observers. But this doctrine was announced in a case on a patent for outline and surface ornamentation only, and in which no evidence of the previous state of the art was adduced. It was in exact accord however with the ruling of the Circuit Court in the first design patent case reported in the books, Root *v.* Ball,[4] decided in 1846, which was founded on a design patent for surface ornamentation, and in which there was some attempt to defeat, or at least to limit, the general claim of the patent by evidence tending to show

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[1] Gorham Co. *v.* White, 14 Wall., 511.
[2] Gorham Co. *v.* White, 7 Blatch, C. C. Rep.
[3] Clark *v.* Bousfield, 10 Wall., 133.
[4] Root *v.* Ball, 4 McLean, 177.

that the general features of the design, or part of it, were not novel with the patentee.

SECT. 3. The same test of identity, in determining the issue of infringement, was afterwards applied on circuit, in two cases, which were founded on design patents solely for shape or configuration. Kraus *v.* Fitzpatrick[1] involved a patent for a novel form of corset, and Tomkinson *v* Willets,[2] a new form of vegetable dish. In both cases there were variations between the patented shape and those with which they were compared, but the courts, respectively, held these to be material or not, dependent upon their effect upon the resultant appearance of the shape or configuration of the design as a whole.

SECT. 4. The ordinary observer or intending purchaser, to be deceived, or to whose judgment a comparison of designs is to be submitted, is not a person wholly unfamiliar with the uses and purposes of the article bearing the design, but purchasers or observers understanding the purposes for which the articles in question were purchased or intended to be used.[3]

SECT. 5. Design patents differ from functional or mechanical patents in that they are not addressed to persons skilled in the art, as the latter are. Hence, comparisons of designs, for the purpose of proving identity between them, as evidence under the issue of infringement and novelty, are not to be made by skilled experts; but such identity or dissimilarity is to be determined by the comparative effect of the two designs upon the eye of an ordinary observer, giving such attention as a purchaser of the article bearing the design usually gives, and if the two are alike to such a witness, if the resemblance is such as to deceive an observer of that character, and sufficient to induce him to purchase one supposing it to be the other, the patented design is infringed by such other. For identity of appearance or sameness of effect upon the eye, is the main test of substantial identity of design, and while differences in the lines and configuration, or the modes by which they are produced, may properly be considered in reaching the

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[1] 34 Fed. Rep. 39.

[2] 23 Fed. Rep. 895.

[3] Dryfoos *v.* Friedman, 18 Fed. Rep. 825.

conclusion, the controlling consideration is the resultant effect.[1]

SECT. 6. Hence it is that minor variations in the details of the ornamentation or configuration, a greater or less number of parts, or slight changes in the arrangement thereof, if insufficient to change the effect upon the eye, will not destroy the substantial identity. Expert testimony is therefore not to be adduced in the determination of such a question, although it might and perhaps would be perfectly proper to introduce such evidence to point out differences in the lines, configuration, and modes by which the appearance is effected, together with the effect of such differences on the finished design.[2]

SECT. 7. Proof of infringement must consist mainly, if not entirely, in the production and comparison of the alleged infringing article with an article embodying the patented design and duly proven to correctly represent the design shown, described, and claimed in the specification and drawings of the patent in suit. Such was the sole evidence offered in Jennings *v.* Kibbe,[3] in which Judge Blatchford sustained the patent and decreed an infringement; and in the opinion, after stating the rule determining identity as laid down in Gorham *v.* White,[4] added that in view of the simple character of the design in question and of the absence of counter-testimony on the part of the defence, he was of opinion that the absence of testimony as to identity did not make it improper for the court, in that case at least, to compare the defendant's manufacture with the patents as to design, and determine the question on such comparison, although it was not intended to imply that such practice could be extended to any other patent than one for design, or that it ought to be extended to all patents for designs.

SECT. 8. In the leading English case of McCrea *v.* Holdsworth, cited and approved in Gorham *v.* White, the controlling, if not the sole evidence upon which the case turned on the issue of infringement, was the ocular demon-

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[1] Gorham *v.* White, 14 Wall. 511.
[2] Gorham *v.* White, 14 Wall., 511.
[3] 10 Fed. Rep., 669.
[4] 14 Wall. 511.

stration by an exhibition of articles bearing the designs, to the Chancellor's own observation, and a comparison by him of the two designs in question, putting him in the position of an ordinary observer, and this was practically so also in Gorham *v.* White, Dobson *v.* Dornan, Lehnbeuter *v.* Holthaus, and is apparent in all or nearly all the Circuit Court decisions in design cases in which the issue of infringement was not admitted or not too plain as not to be open for consideration.

SECT. 9. By this it is not meant to say that a judge would be justified in deciding the issue of infringement solely upon his own comparison of the infringing article with that of the patent, without consideration of evidence offered in the cause by both parties of a similarity and dissimilarity respectively, of the two designs; but from the nature of the subject matter it must be apparent on casual reflection that a judge would not be justified in deciding the issue of infringement on what might be the weight of the oral evidence adduced in the case (and such must be in the nature of *opinions* only), if such decision would be repugnant to his own personal views of the ocular evidence as disclosed by comparison of the articles bearing the designs in question.

SECT. 10. In doubtful cases of infringement of a patented design by one which differs from it by variations, either in detail or outline, or in the presence or absence of a greater or less number of parts, the most unerring test of the materiality of such differences is to inquire whether the design as a whole is so like that patented that the mind is not directed in the first instance to dissimilarity, but to similarity. In other words, has it to be examined very carefully to find any distinction or difference? If that is the real position of the matter, *prima facie* it is an infringement. But such presumptions may, however, of course, be overcome by a more critical examination of the distinguishing characteristics in each which cause the resemblance, followed by intrinsic evidence that such features form no part of the claims, either because of their nature, *i. e.*, such as general similarity of subject, or of material, or of ground color, or the like, or because of the language of the claims; or by extrinsic evidence of their prior existence.

SECT. 11. Proper decision of questions of infringement, however, depends not alone upon a mere comparison of the alleged infringing design with the design shown, described and claimed in the patent. As with functional patents, the claims are to be limited by construction, if need be, in view of what shall be disclosed in any evidence introduced showing the state of the art at the time of the making of the patented invention in question. Patents are issued upon *ex parte* applications, and though the claim may be broad enough to include the alleged infringing design, yet the state of the art must be read into the specification, in limitation of the claim, if it be broader in its terms than is warranted by what shall appear by evidence *aliunde* constitutes the boundary lines of the actual invention.[1]

SECT. 12. And, therefore, if the alleged infringing design presents to the eye a general similarity in appearance to that of the patent, it is not to be declared an infringement if such similarity is due solely to what is old in both designs; for manifestly to give by construction a generic effect to a general claim for the design shown in the patent, would deprive the public and subsequent patentees from using that which was common, and not novel with the patentee, and prevent others from employing such old and well known materials to build up thereon their own special and different superstructures, though in each case the resultant picture will necessarily bear a general resemblance to that of the patent, due to both using the same foundation plan, or other old materials common to both. Hence there is no good reason why, under such circumstances, a claim in a design patent should not be construed to be a narrow (in contradistinction to a broad) claim, in view of what is non-patentable or old in the pattern or design patented, as in the case of a functional patent, and so be decisive of the question of infringement; because confined to a design not only resembling it in general appearance, but having those features which distinguish its origin as of the patentee's pencil.

SECT. 13. The test of identity, as applied to the issue of infringement, as it is stated in Gorham Co. *v.* White, will

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[1] Meers *v.* Kelley, 31 Fed. Rep., 153: Foster *v.* Crossin, 23 Fed. Rep., 400; Northrup *v.* Adams, 12 O. G., 430; Crocker *v.* Cutter Tower Co., 29 Fed. Rep., 456; Simpson *v.* Davis, 12 Fed. Rep., 144.

certainly admit of qualification under the several circumstances of some very possible cases; for instance, the distinguishing characteristics of the patented design may some of them be shown to lack novelty, and although as a whole, the infringing design may present a similar appearance to that of the patent, yet if the specification of the patent is so drawn, with claims which limit it to these specific distinguishing characteristics or features, it must be apparent that the court cannot disregard the claims even though there is an apparent or perhaps an admitted copying by the defendant of the design shown in the patent. The rule in Burns *v.* Myer,[1] and kindred cases on functional patents, to the effect that the claims are the essential parts which the public are to look to and scrutinize to ascertain their rights, is just as applicable to the claims of a design patent as to the other kind of patents, and was so applied by Judge Wheeler in a recent case,[2] decided June 6, 1884. That case was on a patent for design for watch-cases, and while it was apparent that the defendant had copied the plaintiff's design as exhibited in a watch-case produced in evidence, to such an extent that the court had no hesitation in saying that it came within the test of identity laid down by the courts as the true rule to determine infringement, the learned judge was equally positive in saying that the claims of the patent were not sufficiently descriptive to cover the design shown in the exhibit, and dismissed the bill accordingly.

SECT. 14. Design patents for surface ornamentation, or for configuration confined to outline, both being such as can be fully represented in a photograph or other flat illustration, have, by force of custom in the Patent Office, been prepared without any descriptive specification other than by a general reference to the drawing or photograph, and concluding without any specific claim other than a single general claim to the design *as shown*. Although the Supreme Court in Dobson *v.* Dornan,[3] held by a majority opinion that such a specification was sufficient within the language of the statute. it was careful to add that in such

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[1] 100 U. S. Rep's, 671.

[2] Untermyer *v.* Jeannot, 20 Fed. Rep. 503. Dryfoos *v.* Friedman, 18 Fed. Rep. 825.

[3] 118 U. S. 10.

a case a general claim of that character will cover only the design as a whole, and not any part of it as a part, and is to be tested as a whole to novelty and infringement. How exactly the court meant that this rule should be applied, is not altogether clear, at least it is not easy of application, in view of the rule for determination of infringement adopted by the courts in cases on such patents. For instance, although the claim should be construed as a claim for the whole, evidence of prior knowledge and use of any one or more of the parts, or even all of the parts, could not negative novelty of the design as a whole unless perhaps such one or more of the parts shown to be old constituted the distinctive features of the whole design, so that solely by reason thereof the infringing design compared with it should appear to be the same design as a whole to the eyes of ordinary observers.

SECT. 15. This interpretation of the true principle for the determination of the question of infringement of such patents, in view of evidence of that character, has authority to support it, in an opinion by Judge Benedict in Simpson *v.* Davis,[1] which was a suit on a patent for a newel post. Although the patent contained seven claims and was for the form of the post as well as separately for its surface ornamentation, the case turned upon the seventh claim only, which was for the form of the post and its ornamentation as a unit, and was, therefore, so far as the actual point decided was concerned, the same as though the patent contained only the single seventh claim. The evidence of prior use went so far as to defeat all of the single claims for the surface ornamentation and also for the distinctive features of the configuration of the post less its cap; but the court held that such evidence was not sufficient to defeat the novelty of the plaintiff's newel post, both in its outline and surface ornamentation *as a whole*, although several of the distinctive parts or features of these, as parts, were old, and hence the seventh claim of the patent, which claimed the design as a unit, was a good claim, and as the defendant made use of it as such, and copied it accordingly, he was guilty of infringement.

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[1] 12 Fed. Rep. 144.

SECT. 16. Such combination of old ornaments and outlines must, however, in their unitary condition, present a substantially new appearance, and be substantially a novel and distinctive design as such unit. Perry *v.* Starrett,[1] which was a suit on a design patent for a stove, furnishes an illustration of this rule. In counter illustration of this principle, the case of Western Electric Co. *v.* Odell[2] furnishes an example. That suit was founded on a design patent for the face or dial of an annunciator, and although it was disposed of on demurrer, in view of matters of common knowledge instead of evidence of the state of the art (which difference is not material on the question under consideration), the court found that the several parts of the design were old, or substantially anticipated by what was well known before, and that their arrangement together in the plaintiff's design, with the slight modifications found therein, did not present a distinctive and substantially novel appearance; and declined to sustain the patent accordingly.

SECT. 17. Great possibility of error exists in forming a conclusion as to identity of designs by a comparison of the alleged infringing article with another said to embody the design of the patent, without great care being taken that the similarity or dissimilarity of the two articles should depend upon the part or parts thereof which form the subject matter of the patent in question, and not upon the irrelevant or unpatented parts.[3] A case decided by Judge Wheeler[4] furnishes an illustration. The patent was for a fringed lace fabric, and the article exhibited to the court as illustrating the plaintiff's design was a nubia (an article of ladies' dress), having the patented fringe attached to it. The defendants also made and sold similar nubias with fringed lace fabric attached, but the fringed lace was different in one or more particulars from that of the patent. The court refused to decree an infringement, remarking that the patent was not for a design for a nubia but for a fringed lace fabric; that the novelty of the patented design appertained to the fringe and not to the rest of the

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[1] O. G. Vol. 14, p. 599. See also Wood *v.* Dolby, 7 Fed. Rep. 475.
[2] 18 Fed. Rep. 321.
[3] Dryfoos *v.* Friedman, 18 Fed. Rep. 825.
[4] Jennings *v.* Kible, 24 Fed. Rep. 697.

fabric, by the terms of the patent, and that the similarity of the whole arose from the body of the nubia rather than from the fringe, and as fringed fabrics, the designs were easily distinguishable. The same case, in which another patent was also involved, illustrates the counter proposition, in which the defendant did not copy the whole design of the patent, but took its principal parts and substituted different things for other parts. The court finding that the principal parts of the infringing design were the same as the principal parts of the patented design, stated that the minor and other parts mentioned, which were different, were the equivalent of the corresponding parts of the patented design, and that there was an infringement on the ground that the taking of the principal parts was a taking of the substance of the invention. This is the only reported design case in which the court in express language recognized the doctrine of equivalents.

SECT. 18. As identity of design is to be determined by effect on the eye of the ordinary observer, such determination must be not alone whether a person would be deceived in mistaking an article bearing the alleged infringing design for a similar article bearing that of the patent, because, as respects both outline and surface ornamentation, color and material may afford such distinguishing marks that no person, not a blind man, would be deceived in mistaking one article for the other. Remarking upon this subject, Judge Wheeler, in Perry *v.* Starrett,[1] answering the suggestion of the defence in that case, to the effect that the articles bearing the design were easily distinguishable from that of the patent, that they each bore their own respective trade-marks as well as their own trade-names, so that it was impossible that one article could be mistaken for the other, said that while all this might be true if the names or trade-marks would always be observed, they were not; and even though they always should be, the right to have the products bearing the design alone distinguished thereby from others, is not what was granted by the patent, which was the exclusive right to make, vend, and use that design upon stoves during the term of the grant.

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[1] 14 O. G., 599.

SECT. 19. This qualification of the general rule stated will be more readily apparent in considering the case of a patent for form or configuration, such as a bust, statue, bas-relief, or composition in alto or basso-relievo. If the patentee impressed his design upon any articles of the character of any of these named, but of a material different from a similar article made by an infringer, there could be no question that the public could easily distinguish between them. For instance, glass from china, clay from marble, gold from silver, and so on, or in the case of a patent for surface ornamentation, such as a design for a rug, carpet, or a printed textile fabric, or a wall paper, differences in the material of the fabric, differences in the color of the lines of the design itself, and, more particularly, differences in the ground color woven into or printed upon the fabric, would so distinguish the articles bearing the two designs from each other that no person of ordinary intelligence would be deceived in mistaking one for the other, yet the design or article in the one case may be an absolute facsimile of the design of the other, and constitute an undeniable infringement both in law and in fact.

The following selected cases illustrate the subject matter of the preceding chapter.

THE GORHAM MANUFACTURING COMPANY *v.* GEORGE C. WHITE.

U. S. Circuit Court, Southern District New York.

Decided September 7, 1870.

7 Blatchf. C. C. Rep. 513.

1. Design patent issued to John Gorham *et al.*, dated July 16, 1861, described the form or configuration as well as the surface ornamentation, of a spoon or fork handle, and claimed "the design herein specified for the handles of spoons or forks, as set forth and represented." Held not to have been infringed by spoons and forks made in accordance with patents to defendant, the designs shown and described in which were found to be substantially like those patented as respects the form or configuration, but not as respects the surface ornamentation. The

designs being found to consist of a combination of form and ornamentation, and there being no substantial identity as a whole.

2. The determination of the question of substantial identity depends upon a comparison of the means used to produce the designs compared, and if the means differ, though the result is similar, there is no infringement.

3. A patent for a design, like a patent for improvement in machinery, must be for the means of producing a certain result or appearance, and not for the result or appearance itself.

4. The evidence of persons skilled in the business of designs in the particular trade in question, comparing them side by side, is proper in determining whether two designs are alike or dissimilar. There must be a comparison of the features which make up the two designs. And the same rule is applicable to determine novelty as is applied on the question of infringement.

Charles M. Kellar and Charles F. Blake, for plaintiffs.
George Gifford, for defendant.

BLATCHFORD, J. This suit is founded on letters patent granted to John Gorham, Gorham Thurber, and Lewis Dexter, Jr., July 16, 1861, for a design "for the handles of table spoons and forks." The completed spoon or fork consists of a bowl or fork, a stem, and an enlarged end, the stem being interposed between the enlarged end and the bowl or fork. The stem and the enlarged end constitute the handle.

The stem is gradually but slightly increased in width from about the middle of its length towards each end, the swell being more sudden where it joins the bowl or fork. At the other extremity of the stem, where the enlarged end of the handle commences, a rounded shoulder spreads out on each side. The enlarged end then gradually spreads out on each side in concave lines. These lines afterwards gradually become convex to the widest part of the enlarged end.

From this point they run back and inwards, and they finally unite to form a nearly semi-circular end.

Along each end of the stem and of the enlarged end of

the handle, there is a small rounded moulding, and just within this a second moulding, and at the rounded shoulders, these mouldings, which look like wires, are united by two rosettes, having somewhat the appearance produced by twisting together the ends of wires to unite them. At the end of the enlarged end of the handle, the two sets of mouldings from each side are twined into a rosette, the two rosettes coming in contact in the middle of the width of the handle, and a small rounded tip making the central finish.

Between the two inner mouldings the surface is swelled, such swell being gradually flattened from the stem towards the widest part of the enlarged end of the handle.

The patent claims "the design herein specified for the handles of spoons and forks, as set forth and represented."

The bill alleges that the defendant has infringed the patent by selling spoons and other articles embodying the invention covered by the patent. The infringement is denied. Some of the articles sold by the defendant have been constructed, in design, in accordance with letters patent granted to Le Roy S. White, January 15, 1867, for a design for the handles of spoons and forks, and the rest of them have been constructed, in design, in accordance with letters patent granted to the said White, March 31, 1868, for a design for the handles of spoons and forks.

In the patent of 1867, to White, the handle is made with a comparatively long and narrow stem or shank, and with low rounded shoulders upon its side edges, at the points where the handles begins to expand or broaden, and terminates with a small rounded projection at the extreme end. Along the edges of the front and rear side of the handle is formed a single line, following the contour of the handle, and extending down upon the head of the fork or spoon in the form of a rounded angle, such angle extending further down on the rear than on the front side of the head. Along the sides of the broader part of the handle is formed a second line, terminating at each end with an inward curve and a bead.

In the space between the end curves of such second lines and the outer line, where the latter follows the outline of the rounded projection on the end of the handle, a shield is formed, having a central longitudinal rib or raised line.

There is, also, on each side of the enlarged end of the handle, a short curved line, starting from the end curve of the before-mentioned second line, and uniting with such line at the broadest part of the handle.

In the patent of 1868, to White, the stem or shank portion of the handle is made with two rounded formations along its side edges, constituting a raised border, which follows the contour of the whole handle. The stem or shank portion forms its junction with the upper or expanded portion of the handle by a swell on either side, of convex shape. These swells gradually merge in concave lines, which give a narrowed configuration to the expanded portion of the handle above the swells. Further up, the boundaries are continued by convex lines, which present a wider form, and the spread-out portion finally terminates in a rounded or arched projection at the extreme end. Along either side of the broader portion of the handle, within the before-mentioned raised border, is a second line, following, for the most part, the contour of the border, but terminating at each end with an inward curve and a bead. In the space between the upper-end curves of the before-mentioned second lines and the raised border, where it follows the outline of the projection on the end of the handle, a shield is formed, having a central longitudinal rib or raised line. There are, also, short curved lines, joining the end curves of the before-mentioned second lines with the broadest part of the handle.

The question to be determined is, whether the designs of the White patents are or are not substantially the same as the design of the plaintiffs' patent. Each design may properly be considered as composed of two elements; the outline which the handle presents to the eye when its broader face is looked at, and the ornamentation on such face.

If the plaintiffs' design be compared with the White design of 1867, a general resemblance is found between such outlines in the two designs. In other words, if the ornamentation on the handle in the plaintiffs' design formed no part of such design, and such design were confined to the form of the outline before mentioned, it would be difficult to say that the plaintiffs' design and the White design of 1867 were not substantially identical. But the moment the

ornamentation on the faces of the two handles come to be considered. striking differences appear between the plaintiff's design and the White design.

In the former, the outer thread is broken at the end of the handle, at the shoulders, and at the junction of the handle with the bowl; while, in the latter, such thread is continuous around the entire handle, from the junction of the stem with the bowl or fork, back to the same point, it having there the form of a Gothic arch.

In the former, the outer thread is, at the shoulders, turned inward, to form rosettes, which present the appearance of two parts twisted in together; while, in the latter, the outer thread is continuous. In the former, there is, on the stem of the handle, on each side, extending from the shoulder to the bowl or fork, an inner thread, parallel with and inside of the outer thread; while, in the latter, there is no such inner thread. In the former, the inner threads on the enlarged end of the handle turn outwards from each other towards the end of the handle, so as to form diverging scrolls; while, in the latter, such inner threads, as they approach the end of the handle, turn inwards and form re-entering scrolls. In the former, the scrolls of the inner threads form, at the end of the handle, a part of the outline boundary of the handle; while, in the latter, such scrolls are entirely inside of such outline boundary. In the former, the end of the handle is formed by a lip, inserted between the two diverging scrolls, into which the inner threads are formed; while, in the latter, the continuous outer thread forms such extreme end. In the latter, a figure in the form of a shield, is inserted between the scrolls, into which the inner threads are formed and the outer thread; while, in the former, no such figure is found, and no place exists where it could be inserted. In the latter, there is, on each side, a third and short thread, extending from the said scroll to the widest part of the handle; while no such thread is found in the former. In the former, the inner thread on the enlarged end of the handle, abuts, at the shoulder next the stem, against the scroll or rosette, into which the outer thread is there formed, and looks as if it were a continuation of the outer thread on the stem, passed under the said scroll; while, in the latter, the inner

thread on the enlarged end of the handle is, at the shoulder, turned into a scroll or rosette, and has no appearance of being a continuation of the outer thread on the stem. In the former, the inner threads on the stem unite in a swell or bass near the bowl or fork; while no such swell or bass is found in the latter. It is also to be noted, that, in the former, the outline at the end of the enlarged end of the handle has the form of a portion of a trifoil, while, in the latter, it has the form of a Gothic arch; and that, in the former, the surface of the enlarged end between the threads is swelled between the shoulders, and such swell is gradually flattened towards the widest part of the handle, so that the swell at such part is substantially different in appearance from the swell at the shoulders; while, in the latter, the swell is substantially the same from the shoulders to the broadest part of the enlarged end.

The differences thus observed between the plaintiffs' design and the White design of 1867, exist also, between the plaintiffs' design and the White design of 1868. In addition, in the plaintiffs' design, the contour of the enlarged end of the handle spreads outward progressively from the shoulders until the widest part of the handle is reached; while, in the White design of 1868, the sides of the enlarged end tend inward for a distance after leaving the shoulders, and then spread outward to the widest part.

From the comparison thus instituted, it appears that the plaintiffs' design and the White design of 1867, are, in what has been called outline, very much alike, while they differ from each other in a marked manner, in what has been called ornamentation; that the plaintiffs' design and the White design of 1868 differ from each other in a marked manner, both in outline and in ornamentation; and that the two White designs differ from each other, in outline in a marked manner, while they scarcely differ at all from each other in ornamentation.

There can be no doubt, on the proofs, that the plaintiffs' design is a very meritorious and salable one. The entire strength of their case, on the question of infringement, is put on the claimed ground that the resemblance between their design and each of the two designs of White is such as to mislead ordinary purchasers and casual observers,

and to induce them to mistake the one design for the other. It is urged that the merit of a design appeals solely to the eye, and that, if the eye of an ordinary observer cannot distinguish between two designs, they must, in law, be regarded as substantially alike. In the present case it is claimed that the eye of the ordinary observer is and will be deceived when looking at the handle of the plaintiffs' design and a handle of either of the designs of White, because, in addition to the resemblance in contour, the handles have all of them a threaded pattern around the edges, and small knobbed ornamentations at the shoulders, and small knobbed ornamentations near the end, and a pointed projection at the end, and that the general effect on the eye of the ordinary observer is not and will not be modified by the differences which have been pointed out.

It is impossible to assent to the view that the test, in regard to a patent for a design, is the eye of an ordinary observer. The first question that would arise, if such a test were to be admitted, would be, as to what is meant by "an ordinary observer," and how he is to exercise his observation. One of the witnesses for the plaintiffs testifies that the plaintiffs' design and the White design of 1867 are sufficiently alike to mislead ordinary purchasers as to their identity, but not on a second examination, and that, if an ordinary purchaser did not have before him a sample of the plaintiff's design, he would be apt to consider the White design of 1867 to be the same pattern as the plaintiffs' design.

Another of the witnesses for the plaintiff states that he does not think that an ordinary observer would notice any difference between the two designs on a casual observation. The expert examined for the plaintiffs testifies, that in saying that the White designs are substantially identical with the plaintiffs' design, he means such an identity as would deceive him when going, as a purchaser, to ask for one spoon, and being shown another; and that, when he saw articles of the plaintiffs' design and of the White design of 1867 separately, he took them to be of the same design, until he laid them side by side and compared them minutely.

The same principles which govern in determining the question of infringement in respect to a patent for an invention connected with the operation of machinery, must govern in determining the question of infringement in respect to a patent for a design. A design for a configuration of an article of manufacture is embraced within the statute as a patentable design, as well as for an ornament to be placed on an article of manufacture.

The object of the former may solely be increased utility, while the object of the latter may solely be increased gratification to a cultivated taste, addressed through the eye. It would be as reasonable to say that equal utility should be the test of infringement in the first case, as to say that equal appreciation by the eye should be the test of infringement in the latter case. There must be a uniform test, and that test can only be, as in the case of a patent in respect to machinery, substantial identity, not in view of the observation of a person whose observation is worthless because it is casual, heedless, and unintelligent, and who sees one of the articles in question at one time and place, and the other of such articles at another time and place, but in view of the observation of a person versed in the business of designs in the particular trade in question—of a person engaged in the manufacture or sale of articles containing such design—of a person accustomed to compare such designs, one with another, and who sees and examines the articles containing them side by side.

The question is not whether one design will be mistaken for another by a person who examines the two so carelessly as to be sure to be deceived, but whether the two designs can be said to be substantially the same, when examined intelligently, side by side. There must be such a comparison of the features which make up the two designs. As against an existing patented design, a patent for another design cannot be withheld because, to a casual observer, the general appearance of the latter design is so like that of the earlier one as to lead him, without proper attention, to mistake the one for the other. The same test must be applied on the question of infringement.

Applying these principles to the evidence in this case, and comparing the designs of White with the plaintiffs'

design, it is satisfactorily shown, by the clear weight of testimony, that the designs of White are not substantially the same as the plaintiffs' design. The strength of the testimony of the witnesses on the part of the plaintiffs themselves, leads to this conclusion. The substance of the evidence of the most intelligent of them, persons in the trade, is merely to the effect that the White designs are not substantially the same as the plaintiffs' design, but were intended to appear to be the same to an ordinary purchaser, and will so appear to him, but that a person in the trade will not be deceived by the resemblance into purchasing an article of the one design for an article of the other.

A patent for a design, like a patent for improvement in machinery, must be for the means of producing a certain result or appearance itself. The plaintiff's patent is for the described means of producing a certain appearance in the completed handle. Even if the same appearance is produced by another design, if the means used in such other design to produce the appearance are substantially different from the means used in the prior patented design to produce such appearance, the later design is not an infringement of the patented one. It is quite clear, on a consideration of the points of difference before enumerated between the plaintiffs' design and the designs of White, that each of the latter is substantially different from the former in the means it employs to produce the appearance it presents.

Such is the undoubted weight of the evidence, and such is the judgment of the court.

The bill must be dismissed with costs.

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THE GORHAM MANUFACTURING COMPANY, *Appellant*, *v.* GEORGE C. WHITE.

Supreme Court of the United States.

Decided December Term, 1871.

14 Wallace, 511.

1. The acts of Congress, which authorize the grant of patents for designs, contemplate not so much utility as appearance, and that, not an abstract impression or picture. The thing invented

or produced for which a design patent is given is that which imparts a peculiar or distinctive appearance to the manufacture or article to which it is applied or to which it gives form.

2. It is the appearance itself, and not the mode by which it is produced, that constitutes mainly. if not entirely, the contribution to the public, which the law deems worthy of recompense; and this appearance may be the result of peculiarity of configuration, or, of ornament alone, or of both conjointly, but, in whatever way produced, it is the new product which the patent law regards.

3. The acts of Congress embrace only designs applied or to be applied, and refer to finished products of invention, and not to the processes or agencies by which they are developed.

4. Identity of appearance, or sameness of effect upon the eye, is the main test of substantial identity of design. And while differences in the lines, the configuration, or the modes by which they are produced, may properly be considered in reaching a conclusion, the controlling consideration is the resultant effect.

5. Minor variations in the details of the ornamentation or configuration, a greater or less number of parts, or slight changes in the arrangement thereof, if insufficient to change the effect upon the eye, will not destroy the substantial identity.

6. It is not essential to identity of design that the appearance should be the same to the eye of an expert. If, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same; if the resemblance is such as to deceive such an observer, and sufficient to induce him to purchase one, supposing it to be the other, the one first patented is infringed by the other.

Mr. C. M. Kellar and Mr. C. F. Blake, for the Appellants.

Mr. G. Gifford and Mr. W. C. Witter for the Appellees.

Mr. Justice STRONG delivered the opinion of the court.

The complainants are the owners of a patent granted on the 16th day of July, 1861, to John Gorham, Gorham Thurber, and Lewis Dexter, Jr., for a new design for the handles of table spoons and forks, and their bill charges

that the patent has been infringed by the defendant. The validity of the patent is not denied, nor is it controverted that the defendant has sold spoons and forks which had upon them designs bearing some resemblance to the designs described in the complainants' patent.

But it is contended that none of the designs on these articles thus sold, are substantially the same as the design covered by the patent, and that they are all independent of anything secured to Gorham, Thurber and Dexter, the patentees.

The sole question, therefore, is one of fact. Has there been an infringement? Are the designs used by the defendant substantially the same as that owned by the complainants? To answer these questions correctly, it is indispensable to understand what constitutes identity of design, and what amounts to infringement.

The acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance, and that not an abstract impression or picture, but an aspect given to those objects mentioned in the acts.

It is a new and original design for a manufacture, whether of metal or other material; a new and original design for a bust, statue, bas-relief, or composition in alto or basso relievo; a new or original impression or ornament to be placed on any article of manufacture; a new and original design for the printing of woolen, silk, cotton or other fabrics; a new and useful pattern, print or picture, to be either worked into or on any article of manufacture; or a new and original shape or configuration of any article of manufacture. It is one or all of these that the law has in view; and the thing invented or produced, for which a patent is given, is that which gives a peculiar or distinctive appearance to the manufacture or article to which it may be applied or to which it gives form. The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. It therefore proposes to secure, for a limited time, to the ingenious producer of those appear-

ances, the advantages flowing from them. Manifestly, the mode in which those appearances are produced, has very little, if anything, to do with giving increased salableness to the article. It is the appearance itself which attracts the attention and calls out favor or dislike. It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense.

The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly; but, in whatever way produced, it is the new thing or product which the patent law regards. To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities.

As the acts of Congress embrace only designs applied or to be applied, they must refer to finished products of invention rather than to the process of finishing them or to the agencies by which they are developed. A patent for a product is a distinct thing from a patent for the elements entering into it, or for the ingredients of which it is composed, or for the combination that causes it. We do not say that in determining whether two designs are substantially the same, differences in the lines, the configuration, or the modes by which the aspects they exhibit, are not to be considered; but we think the controlling consideration is the resultant effect. Such was the opinion of Lord Chancellor Hatherly in McCrea *v.* Holdsworth, 6 Ch. Ap. Cases, Law Reports, 418. That was a suit to restrain an infringement of a design for ornamenting a woven fabric. The defence was a denial that the design used by the defendants was the same as that to which the plaintiff was entitled.

The ornament on both was, in part, a star, but on one it was turned in an opposite direction from that in the other; yet the effect of the ornament was the same to the eye.

The Lord Chancellor held that the important inquiry was, whether there was any difference in the effect of the designs, not whether there were differences in the details of ornament. "If," said he, "The designs are used in exactly the same manner, and have the same effect, or nearly the same effect, then, of course, the shifting or turning

round of a star, as in this particular case, cannot be allowed to protect the defendants from the consequences of the piracy."

This seems most reasonable, for, as we have said, it is the effect upon the eye which adds to articles of trade or commerce. So in Holdsworth *v.* McCrea, 2 App. Cas., House of Lords, 388, Lord Westbury said: "Now, in the case of those things, in 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 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."

This was said in a case where there was nothing but a drawing of the design.

We are now prepared to inquire what is the true test of identity of design. Plainly, it must be sameness of appearance; and mere difference of lines in the drawing or sketch, a greater or smaller number of lines or slight variances in configuration, if insufficient to change the effect upon the eye, will not destroy the substantial identity. An engraving which has many lines may present to the eye the same picture, and to the mind the same idea or conception as another with much fewer lines. The design, however, would be the same. So a pattern for a carpet or a print may be made up of wreaths of flowers arranged in a particular manner. Another carpet may have similar wreaths arranged in a like manner, so that none but very acute observers could detect a difference; yet in the wreaths upon one there may be fewer flowers, and the wreaths may be placed at wider distances from each other; surely in such a case the designs are alike.

The same conception was in the mind of the designer, and to that conception he gave expression.

If, then, identity of appearance, or, as expressed in McCrea *v.* Holdsworth, sameness of effect upon the eye, is the main test of substantial identity of design, the only remaining question upon this part of the case, is whether it is essential that the appearance should be the same to the eye of an expert. The court below was of opinion

that the test of a patent for a design is not the eye of an ordinary observer. The learned judge thought there could be no infringement unless there was "substantial identity in view of the observation of a person versed in designs in the particular trade in question; of a person engaged in the manufacture or sale of articles containing such designs; of a person accustomed to compare such designs, one with another, and who sees and examines the articles containing them them side by side." There must he thought, be a comparison of the features which make up the two designs. With this we cannot concur. Such a test would destroy all the protection which the Act of Congress intended to give.

There never could be piracy of a patented design, for human ingenuity has never yet produced a design, in all its details, exactly like another, so like that an expert could not distinguish them.

No counterfeit bank note is so identical in appearance with the true that an experienced artist cannot discern a difference. It is said an engraver distinguishes impressions made by the same plate. Experts, therefore, are not the persons to be deceived.

Much less than that which would be substantial identity in their eyes would be undistinguishable in the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed, that degree of observation which men of ordinary intelligence give. It is persons of the latter class who are the principal purchasers of the articles to which designs have given novel appearances; and if they are misled and induced to purchase what is not the article they supposed it to be; if, for example, they are led to purchase forks or spoons, deceived by an apparent resemblance into the belief that they bear the "Cottage" design, and, therefore, are the production of the holders of the Gorham, Thurber & Dexter patent, when, in fact, they are not, the patentees are injured, and that advantage of a market which the patent was granted to secure is destroyed.

The purpose of the law must be effected, if possible, but plainly it cannot be, if, while the general appearance of the design is preserved, minor differences of detail in the

manner in which the appearance is produced, observable by experts, but not noticed by ordinary observers, by those who buy and use, are sufficient to relieve an imitating design from condemnation as an infringement.

We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same—if the resemblance is such as to deceive such observer, inducing him to purchase one supposing it to be the other—the first one patented is infringed by the other.

Applying this rule to the facts of the present case, there is very little difficulty in coming to a satisfactory conclusion. The Gorham, Thurber & Dexter design, and the two designs sold by the defendant, which were patented to Le Roy S. White, one in 1867 and the other in 1868, are alike the result of peculiarities of outline or configuration and of ornamentation. These make up whatever is distinctive in appearance, and of these the outline or configuration is most impressive to the eye. Comparing the figure or outline of the plaintiff's design with that of the White design of 1867, it is apparent there is no substantial difference. This is in the main conceded. Even the minor differences are so minute as to escape observation, unless observation is stimulated by a suspicion that there may be diversity. And there are the same resemblances between the plaintiffs' design and the White design of 1868, and, with a single addition, the minor differences are the same. That additional one consists in this. At the upper part of the handle, immediately above the point where the broader part widens from the stem with a rounded shoulder, while the external lines of both designs are first concave and then gradually become convex, the degree of concave is greater in the White design. How much effect this variance has must be determined by the evidence. In all the designs the ornament in the part a rounded moulding or bead along the edge, with scrolls at the shoulders and near the top. There are, however, some distinctions in this ornament which are observable when attention is called to them. In the plaintiffs' the bead is interrupted at the shoulders and at the top by the scrolls while in both the designs of White it is continued entirely around the scrolls. In the plain

tiffs' the scrolls turn inward at the shoulders and outward at the tip. In the White design they turn inward both at the shoulders and at the upper end; but there is the same number of scrolls in all the designs, and they are similarly located, all having the appearance of rosettes. In all the external bead is formed by a depressed line running near the edge of the handle; but in the plaintiffs' there is an inner line, making a second very thin bead, nearly parallel to the external bead common to them all. In the White designs this inner line is wanting on the stem of the handle, though not on the broad part; but, as the single line is wider, it presents much the same appearance as it would present if divided into two.

There are other small differences which it is needless to specify. What we have mentioned are the most prominent. No doubt to the eye of an expert they are all real. Still, though variances in the ornament are discoverable, the question remains, is the effect of the whole design substantially the same? Is the adornment in the White design used instrumentally to produce an appearance, a distinct device, or does it work the same result in the same way, and is it, therefore, a colorable evasion of the prior patent, amounting, at most to a mere equivalent? In regard to this we have little doubt, in view of the evidence. Both the White designs, we think, are proved to be infringements of the Gorham, Thurbur & Dexter patent. A large number of witnesses familiar with designs, and most of them engaged in the trade, testify that, in their opinion, there is no substantial difference in the three designs, and that ordinary purchasers would be likely to mistake the White design for the "Cottage," viz: that of the plaintiffs. This opinion is repeated in many forms of expression, as that they are the same pattern; that the essential features are the same; that seven out of ten customers who buy silver ware would consider them the same; that manufacturers, as well as customers, would consider them the same; that the trade generally would so consider them; that, though there are differences they would not be noticed without a critical examination; that they are one and the same pattern, &c. This is the testimony of men who at their work substantially all differences in the appearance on in the other would

most readily appreciate it. Some think the White designs were intended to imitate the other, and they all agree that they are so nearly identical that ordinary purchasers of silver ware would mistake one for the other. On the other hand, a large number of witnesses have testified on behalf of the defendant that the designs are substantially unlike; but when they attempt to define the dissimilarity, they specify only the minor differences in the ornamentation, of which we have heretofore spoken. Not one of them denies that the appearance of the designs is substantially the same, or asserts that the effect upon the eye of an observer is different, or that ordinary purchasers, or even persons in trade, would not be led by their similarity to mistake one for another. Their idea of what constitutes identity of design seems to be that it is the possibility of being struck from the same die, which, of course, cannot be if there exists the slightest variation in a single line. They give little importance to configuration, and none to general aspect. Such evidence is not an answer to the complaints' case. It leaves undisputed the facts that, whatever differences there may be between the plaintiffs' design and those of the defendant, in details of ornament, they are still the same in general appearance and effect; so much alike that, in the market and with purchasers, they would pass for the same thing; so much alike that even persons in the trade would be in danger of being deceived.

Unless, therefore, the patent is to receive such a construction that the Act of Congress will afford no protection to a designer against imitations of his invention, we must hold that the sale by the defendant of spoons and forks bearing the designs patented to Le Roy S. White, in 1867 and 1868, is an infringement of the complainants' rights.

Decree reversed, and the cause remitted, with instructions to enter a decree in accordance with this opinion.

Justices Miller, Field, and Bradley dissented.

THEBERATH *v.* THE RUBBER AND CELLULOID HARNESS TRIMMING COMPANY.

U. S. Circuit Court, District of New Jersey.

Decided July 14, 1880.

3 Fed. Rep. 151.

1. Bill sustained which charged infringement by defendant conjointly of two functional patents and a design patent in the manufacture and sale of harness trimmings embodying the three several inventions.
2. The patent described ornamentation on a leather covered surface with thread stitches. The defendant used a vulcanized rubber surface with imitation stitches. Held to be an infringement, the effect on the eye being the same in both cases.

NIXON, D. J. This case has been heard on bill, plea, replication, and proofs. The bill alleges that the complainant is the original and first inventor of three several patents, to wit: one for the "improvement in the covering of harness trimmings," dated January 18, 1870, and numbered 99,032; one for a "new and useful design for harness trimmings," dated June 13, 1871, and numbered 5,006; and one for "improvement in harness mountings," dated August 24, 1875, and numbered 167,040; and charges that the defendant corporation has made, used, and vended to others to be used, a large number and quantity of an article of harness trimmings which infringe the three several patents. The plea denies that the three alleged inventions are, in point of fact, connected together in use or operation, and conjointly embodied in any of the harness trimmings and other articles manufactured, used, or sold by the defendant, on which denial the complainant has taken issue by replying. The complainant's replication is an admission by him of the sufficiency of the plea as a defense, if the facts which it alleges are established by the evidence. Myers *v.* Dorr, 13 Blatchf. 22-26; Story's Eq. Pl. Sect. 667. The issue, then, is as to the truth of the allegations of the plea, that no one article manufactured and sold

by the defendant infringes the three patents on which the suit is founded. The patents occupy very narrow ground. They refer to new methods of covering harness trimmings, and to new designs in the formation of rings and terrets. The testimony is brief, but I think its weight is with the complainant. Both Kuhn and Davy seem to be intelligent witnesses, and give satisfactory reasons why certain articles which are acknowledged to be the product of the defendant's manufactory, infringe the complainant's patents.

The l. . named witness, taking Exhibit E, which is a bolt hook and two terrets, made and sold by the defendant corporation, said that they infringed the three claims of the three patents "in having a raised or oval centre, with a depressed seam or groove on each edge, and a turned up, solid metallic edge, are of precisely the same design, and undoubtedly were made to imitate goods manufactured under the complainant's several patents." This testimony is confirmed by the eyesight. The articles made and sold by the defendant appear, on inspection, to be the same as those made and sold by the complainant under his patents, except in the one case they are covered with vulcanized rubber, and the other with leather. The only contradiction to it is the evidence of Mr. Albright, the president of the defendant company, and his denial of the infringement seems to be based upon the idea that the patents of the complainant cannot be infringed without the use of leather, needles, and stitches. The defendant adopts the methods and designs of the patents, but covers the article with rubber rather than leather; and this is done in the face of the statement of the patentee in his specifications "that the covering may be made of any material, whether elastic or non-elastic, and may be applied to any and every kind of harness trimmings in precisely the same manner rubber may be used for such trimmings."

Under the proofs there must be judgment on the plea in favor of complainant, with costs.

MILLER *et al v.* SMITH *et al.*

U. S. Circuit Court, District of Rhode Island.

Decided October 7, 1880.

5 Fed. Rep. 359.

1. Design patents are authorized by Sec. 4929, Rev. Stat., and all the regulations and provisions of existing laws relating to general patents, not inconsistent therewith, relate to patents for designs.
2. The production of the letters patent in evidence is *prima facie* proof that the patentee named therein is the original and first inventor of the design which it purports to cover, and that the same is patentable; which is sufficient to entitle the complainant to a decree, unless it is overcome by competent proof of greater weight.
3. Proof of want of novelty should never be allowed to prevail against the *prima facies* of a patent, where it is unsatisfactory and insufficient in probative force to outweigh such presumption of novelty, while, however, it is the duty of the court to give it effect when duly and sufficiently proved.
4. Mere delay in applying for a patent will not forfeit the right to the same, or present any bar to a subsequent application, unless the design in question had been in public use or on sale for more than two years prior to the application for a patent in suit.
5. Design letters patent were granted to the plaintiffs for an initial letter sleeve button, and contained a claim for the various letters of the alphabet, of a rustic pattern, ornamented by leaves, as shown and described in the drawings and specification. Held, not void for indefiniteness, because embracing more than one letter of the alphabet.
6. While it is true that the test of infringement in respect to a design patent is the same as in respect to a patent for an art, machine, etc., it is not essential to the identity of a design that it should be the same to the eye of an expert. Substantial similarity in the eye of an observing purchaser sufficient to cause him to mistake one of two designs for the other, is all that is necessary.
7. Applying this rule, the court decreed an infringement, founded

not only upon proof by the witnesses of their comparison, but largely by a comparison by the court itself, of the exhibits representing the designs in question.

B. F. Lee, for complainants.
Livingston Scott, for defendants.

CLIFFORD, C. J. Patents for designs, as well as for machines, are authorized by Act of Congress, the provision being to the effect that any person who, by his own industry, genius, efforts, and expense, has invented and produced any such new, useful, and original improvement, may obtain protection for his exclusive right, the same as in cases of other inventions or discoveries. Rev. Stat., Sec. 4929. Letters patent for such an invention were granted to the complainants, and they allege in the bill of complaint that the improvement is new, and a useful and original invention, and that the respondents have infringed their exclusive right to make, use, and vend the same to others for use. Service was made, the respondents appeared, and in the allegations of the answer were set up three principal defences, as follows: (1) That the complainants are not the original and first inventors of the alleged improvement; (2) that the charge that the respondents have infringed the patent is untrue; (3) that the alleged improvement was in public use, and on sale in the United States more than two years before their application for a patent.

They also allege to the effect that it had been patented or described in some printed publication prior to the supposed invention or discovery; which defence will be considered in connection with the first, that the complainants are not the original and first inventors of the supposed improvement.

Designs, it is admitted, are the proper subject of a patent, and the record in this case shows that the patent is for an alleged new and useful design for jewelry of the various kinds specified in the description given in the specification. It consists of the letters of the alphabet, shown by photographic illustrations, which are of a rustic pattern, ornamented by leaves, the claim being for sleeve buttons and other jewelry, composed of the letters of the alphabet, and having the described ornamentation of letters substantially

as given in the description, and shown in the photographic illustration accompanying the application for a patent. Persons seeking redress for the infringement of such a patent must, as in the case of a machine patent, allege and prove that they are the original and first inventors of the improvement, and that the respondents have infringed the same. Beyond doubt they take that burden in the first place; but, as in the case of patents for other inventions, the letters patent, when introduced in evidence, afford a *prima facie* presumption that the first allegation is true, which is sufficient to entitle the complainants to a decree, unless it is overcome by competent proof of greater weight. Rustic letters are employed, by which is meant, as the complainants allege, letters in which the necessary lines of the same represent the branches or trunks of trees unstripped of the bark, the ornamentation consisting of several separate leaves placed at intervals upon the lines of each letter, the lines exhibiting the appearance of the bark of a branch or trunk of a tree, which design is used for ornamenting buttons, studs, lockets, and other articles of jewelry. Photographs of the improvement were taken directly from gold sleeve buttons having leaves upon letters in actual relief, as given in the descriptive portion of the specification. Sufficient appears to show that the complainants were jewelers, and that for a series of years they had been endeavoring to produce an initial letter sleeve button which would be more ornamental and better suited for ladies' wear. Proofs were introduced showing many such experiments, and giving a history of the efforts to that end, and an account of the time and expenses incurred for its accomplishment, all of which resulted finally in producing the patented design. Experienced witnesses testify that they know of no other design relating to this class of goods which has been as successful as the subject of the patent in controversy; and the court is convinced that the invention is highly acceptable to the public, and profitable to the patentee.

Want of novelty is set up in every form of pleading, not only in the form that the complainants are not the original and first inventors of the improvement, but that many persons had prior knowledge of the thing patented, and that the same was previously described and shown in

certain specified printed publications. Attempt will not be made to examine the proofs in detail offered by the respondents in support of this defence, as it would serve no useful purpose, and would extend the opinion beyond all reasonable length. Regulations and provisions applicable to the obtaining or protection of patents for inventions or discoveries not inconsistent with the existing patent act, apply to patents for designs, without modification or variation. 16 Stat. at Large, 213; Rev. Stat. Sec., 4933. Expert witnesses were examined by the respondents to prove that the patent is invalid, and they introduced a great number of patents and printed publications for the same purpose. Of the witnesses one consists of an expert in penmanship, and the other is an expert in engraving and lithographing. They concur in the opinion that it requires no skill to produce the patented design of the complainants, to which the first witness added that it required nothing more than the ordinary skill of the draftsman in view of the exhibits produced in evidence and referred to in the record. Prior patents and printed publications compose the body of the exhibits, and the complainants' witnesses show to the satisfaction of the court that they are utterly insufficient to overcome the *prima facie* presumption of the patent when considered in connection with the patented articles manufactured by the complainants. Explanations as to the history of the invention were given by one of the complainants, and they also called an expert witness, who gives a full statement of the respondents' exhibits, and shows that none of them are of a character to supersede the patented invention. He points out the difference between figures in actual relief, such as are the subject of the patent in question, and figures where the effect is produced upon the eye merely by linear representation or artificial shading, as shown in several examples given in his testimony. Superadded to that, he shows the practical importance of the difference between a design of rustic letters ornamented with leaves placed solely upon the necessary lines of the letters, and a rustic letter having branches and sprays of the leaves springing from and around the same, as shown in some of the respondents' exhibits. Exhibits introduced by a party without needful explanation do not

deserve, and will not receive, much consideration. All such introduced by the respondents as were properly explained by their experts, were clearly shown by the testimony of the expert called by the complainants to be insufficient to maintain the defence of want of novelty. His statements to that effect are unqualified, and his explanations are persuasive and convincing that the statements are true and reliable. None of the exhibits explained show a rustic letter in relief ornamented with leaves in relief only upon the main lines of the letter. Nothing of the exact kind is shown in these exhibits, nor is there anything which can be regarded as proof that the thing patented was known to others before the invention patented was made by the patentees. Many attempts are made to prove that fact, but the proofs all fall short of meeting the requirement. When the defence of want of novelty is made, it is the duty of the tribunal, whether court or jury, to give it effect; but such proof or testimony should be weighed with care, and never be allowed to prevail where it is unsatisfactory, nor unless its probative force is sufficient to outweigh the *prima facie* presumption arising from the introduction of the patent. Wood *v.* Rolling-Mill, 4 Fisher, 550, 560; Parham *v.* Sewing Machine Co., Id. 468, 482; Hawes *v.* Antisdel, 8 O. G. 852.

Inventors may, if they can, keep their inventions secret, and if they do, it is a mistake to suppose that any delay to apply for a patent will forfeit their right to the same, or present any bar to a subsequent application. Nor does any different rule prevail in the case of a design patent. Delay less than for the period of two years constitutes no defense in any case; but the respondents may allege and prove that the invention in question had been in public use or on sale for more than two years prior to the application of the party for a patent, and if they allege and prove that defence they are entitled to prevail in the suit. Due allegation in that regard is made in this case, but the record contains no proof to support it, and it must be overruled. From all which it follows that the patent is a good and valid patent, and that the complainants, if they have proved the alleged infringement, are entitled to a decree in their favor for the profits made by the respondents

in the violation of their exclusive right to make, use, and vend the improvement secured by the letters patent. Prior to the alleged infringement, the complainants allege that they were in the exercise of the full and exclusive enjoyment of the franchise granted by the patent; and they charge that the respondents, having full knowledge of the premises, and of their exclusive right, have, without license, manufactured, used, and sold, and still continue to manufacture, use, and sell various articles of jewelry of the design invented by the complainants, and secured to them by their letters patent. Responsive to that charge, the respondents deny the same, and aver that the same is not true; and they also insist that the claim is bad, because it embraces more than one letter of the alphabet, which proposition is so obviously without merit that it is not deemed necessary to enter into any discussion of the topic. Perry *v.* Starrett, 14 O. G. 599; Simonds on Design Patents, 79. Speaking in the general sense, it is doubtless true that the test of infringement, in respect to the claims of a design patent, is the same as in respect to a patent for an art, machine, manufacture or composition of matter; but it is not essential to the identity of the design that it should be the same to the eye of an expert. If, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same; if the resemblance is such as to deceive such an observer, and sufficient to induce him to purchase one, supposing it to be the other, the one first patented is infringed by the other. Gorham Manufacturing Co. *v.* White, 14 Wall. 511, 528. Apply that rule to the case before the court, and it is so obvious that the charge of infringement is sustained by the proof and by the comparison of the opposing exhibits, that it is scarcely necessary to give the matter any further examination. Both the testimony of the complainants' expert, and the comparison of the exhibits made by the court, are decisive that the manufacture by the respondents is, in the sense of the patent law, substantially the same as that of the complainants, which show that the complainants are entitled to an account.

Decree for complainants.

KNOWLES, D. J., concurred.

JENNINGS *et al. v.* KIBBE *et al.*

U. S. Circuit Court, S. D. of New York.

Decided February 20, 1882.

10 Fed. Rep. 669.

1. The true test of identity of design is sameness of appearance—in other words, sameness of effect upon the eye of an ordinary observer, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give.
2. Following the precedent established by Gorham *v.* White, in which the court compared the design of the patent with the designs of the defendants' article, and arrived at the conclusion from such comparison that the designs of the defendants were in their effect as a whole, notwithstanding variances, substantially the same as the design of the patents, and were infringements; although in addition to this ocular evidence there was testimony of witnesses on both sides of the question, the weight of which the court thought also proved the infringement.
3. Held, in a suit upon a design patent for a fringed lace fabric, that in view of the proper test of identity as above set forth, and of the simple character of the designs involved, and also of the absence of counter testimony, it was not improper for the court, in the absence of affirmative parol testimony as to identity, to compare the defendant's article with the patent, as to design, and determine the question of identity from such comparison only; though it is not intended to imply that this practice can be extended to any other patent than one for a design, or that it ought to be extended to all patents for designs.

A. V. Briesen, for plaintiff.

J. R. Bennett, for defendants.

BLATCHFORD, C. J. This suit is brought on the letters patent for designs. One is No. 10,388, granted to Abraham G. Jennings, for fourteen years, on January 1, 1878, for a "design for lace purling." The other is No. 10,448, granted to Warner P. Jennings, for seven years, on February 12, 1878, for a "design for a fringed lace fabric." The specification of No. 10,388, says:

"Figure 1 represents a photographic illustration of my new lace purling. Figure 2 is a photographic illustration of the same design made of coarser thread. This invention relates to a new design for a lace fabric, and consists in providing the pillars thereof with more or less irregular, laterally projecting loops, thereby imparting to the entire fabric a puckered, wavy, purl-like appearance, which is indicated in the photograph. The loops on the pillars are placed close together to increase the effect."

The claim is this: "The design for a lace purling, the pillars whereof are provided with irregular, laterally-projecting loops, substantially as shown."

The specification of No. 10,488, says: "The accompanying photograph illustrates a face view of my new design. This invention relates to a new looped fringe applied in series to lace fabrics. A represents the lace fabric of usual kind. BB are disconnected fringes applied thereto. Each fringe, B, is formed with loops at both sides of a central stem or rib along its entire extent, as shown, thus producing a peculiar, full, and yet loose, effect. The fringes are arranged in series of rows, and suspended from the lace fabrics."

The claim is this: "The design for a lace fabric provided with disconnected, doubly-looped fringes, B, leaving loops at both sides of a central stem or rib, substantially as shown."

The answer denies infringement, and sets up various defences to both patents. In taking proofs for final hearing, the counsel for the defendants being present, the plaintiffs put in evidence the two patents and assignments to the plaintiffs, and a "nubia." The counsel for the defendants admitted, on the record of proofs, that the said nubia was purchased from the defendant firm prior to the commencement of this suit. The plaintiffs then rested their case. The defendants took no testimony. The plaintiffs bring the case now to a final hearing on the foregoing evidence, without introducing any witness to show the identity of design between what is found in said nubia and in the plaintiff's patents. The defendants contend that it is not sufficient for the plaintiffs to show merely the sale of the nubia by the defendants, and to leave the court to inspect

the nubia and compare it with the patents, but that the plaintiffs must produce a witness to testify to identity of design.

In Gorham Co. *v.* White, 14 Wall. 511, the Supreme Court considered directly the question of identity in regard to a patent for a design. It held that the true test of identity of a design is sameness of appearance—in other words, sameness of effect upon the eye; that it is not necessary that the appearance should be the same to the eye of an expert, and that the test is the eye of an ordinary observer, the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give. The court compared, in that case, the design of the patent with the designs on the defendants' article, and arrived at the conclusion, from such comparison, that the designs of the defendants were, in their effect as a whole, notwithstanding variances, substantially the same as the design of the patent, and infringements. In addition to this there was the testimony of witnesses on both sides on the question, and the court was of opinion, also, that the testimony proved the infringements.

In view of the proper test of identity, as above given, and of the simple character of the designs in the present case, and of the absence of any testimony on the part of the defendants, I am of opinion that the absence of testimony as to identity does not make it improper for the court in this case to compare the defendants' nubia with the patents, as to design, and determine the question of identity from such comparison. It is not intended to imply that the practice can be extended to any other patent than one for a design, or that it ought to be extended to all patents for designs.

On such comparison it is found that the defendants' nubia infringes both of the patents, and a decree in the usual form in favor of the plaintiffs, with costs, will be entered.

JENNINGS *et al. v.* KIBBE *et al.*
SAME *v.* DOLAN *et al.*

Circuit Court, S. D., New York. Decided January 10, 1885.

24 Fed. Rep. 697.

1. Patent No. 10,448, for design for fringed lace fabric. The novelty of the design for the lace fabric in question consists in having a fringe made of a series of stems connected to the fabric and not to each other, "with loops at both sides of a central stem or rib along its entire extent." Held, not infringed by nubias having somewhat similar fringes, but in which the similarity of the whole arises from the body of the nubias and not from the fringe; because the defendants fringe compared separately with that of the patent is easily distinguishable.
2. Same—Lace Purling—Patent No. 218,032—Anticipation. Evidence of want of novelty to be sufficient to defeat a patent, must be convincing beyond a reasonable doubt; otherwise the patent must be held valid.

Antonio Knauth and A. V. Briesen, for plaintiff.
John R Bennett, for defendant.

WHEELER, J. These suits are brought upon design letters patent No. 10,448, dated February 12, 1878, and granted to Warren P. Jennings for a design for a fringed lace fabric, and letters patent No. 218,032, dated July 29, 1879, and granted to Abraham G. Jennings and Warren P. Jennings for an improvement in lace purling. The design patent had before been adjudged to be valid in this court between the same parties to one of these cases, but upon different infringing articles. Jennings *v.* Kibbe, 20 Blatchf. C. C. 353; S. C. 10 Fed. Rep. 669. The design is for a lace fabric having a fringe made of a series of stems connected to the fabric and not to each other, "with loops at both sides of a central stem or rib along its entire extent," the infringing articles are nubias having such fringes of stems; but the stems have two central ribs, with loops projecting alternately at the sides, and not on both sides along its entire extent. There are so many of these things that the differences are necessarily small, and small differ-

ences make different designs. The patent is not for a design for a nubia, but of a fringed lace fabric, and the novelty of the patented design appertains to the fringe, and not to the rest of the fabric, by the terms of the patent. Nubias with this fringe might appear to be the same as those with the patented fringe, if the fringe should not be observed as such; but observation of that would discover the difference readily. The similarity would arise from the body of the nubias, rather than from the fringe, and as fringed fabrics the designs as to the fringes appear to be different. This patent is not, therefore, infringed by this article.

The novelty of the invention described in the other patent is denied. The anticipation relied upon is a sample in a book of samples of the defendant Dolan, purporting to contain samples of books made and sold before that invention. No article of that manufacture is shown besides the sample, and that is shown to have been put in the book since the invention and since controversy about it. The evidence of the defendants tends to show that the same one was taken out and replaced. The appearance of the book indicates that a sample of different color and size had been in that place. The force of the evidence depends upon the identity of that sample. So much doubt is thrown about it upon the whole proof as to bring it below the degree of certainty requisite to defeat a patent. After repeated examinations serious doubts remain about the production of that article as claimed. The proof should overcome these doubts in order to invalidate the patent, and as it does not, the patent stands as valid.

The infringement seems to be clear, unless the patent is limited to the particular mode of reticulation described. The pillars of the fabric appear to be precisely like those of the patent. The reticulation appears to be in all respects the equivalent of that of the patent. The pillars are really the principal things, and the substance of the invention appears to be taken.

Let there be a decree for the orators accordingly for an injunction and account in each case, without costs, except on the accounting.

WOOD *v.* DOLBY *et al.*

U. S. Circuit Court, Southern District of New York.

Decided April 28, 1881.

7 Fed. Rep. 475.

1. Section 4929, Rev. Stat., provides that a patent may be granted for a *new and original* design; Held, in a suit on design patent No. 11,409, granted for a *new and improved* design (the patent mentioning no prior design), that the term *improved* should be construed to mean a new and distinctive design, and improved as compared with others used; and, in connection with the term new, that it was original with the patentee.

2. The design in question, was for an ornamentation for a finger ring, consisting of the representation of a bird upon a branch or twig, with a leaf above the bird, a panel at the base of the twig of white and gold colors, and a diamond upon the leaf and panel. The evidence showed several pre-existing bird designs; Held, that the design was yet new and original, since none of the alleged anticipations were like it in appearance, either in outline or detail.

3. As the similarity of the defendants design to that of the patent is such that the differences between them (consisting not only of variations from, but additions to, the latter) are not appreciable by observing their artistic effect, such differences in detail become immaterial, and the designs must be considered as substantially identical.

4. The patent is for the appearance which the design adds to the article, making it desirable according to its attractiveness to those observing and wanting it, and it is the right to the exclusive use of this which is secured by it to the patentee.

William Kemble Hall, for plaintiff.
Worth Osgood, for defendants.

WHEELER, D. J. This suit is brought for an alleged infringement of Design Patent No. 11,409, issued to the orator for jewelry settings, expressed in the specification to be for a new and improved design for jewelry settings, consisting of a representation of a bird upon a branch or twig, with a leaf above the bird, and a panel at the base of the twig, in white and gold colors, with a diamond upon

the leaf and two diamonds upon the panel. The defences are that the patent for a new and improved design is not within the statute, Section 4929, which only provides for patents for new and original designs; that this design was known and used by others before the invention or production of it by the plaintiff; and that the defendants do not infringe.

Perhaps, as has been argued for the defendant, the statute was intended to protect such designs only as would be original and distinctive of themselves, and not those which would be mere improvements upon others; but, if so, the word "improved" in this patent is not understood as representing that this design is a mere improvement upon another, especially as no other is mentioned, but is considered to mean that this design is of itself new and distinctive, and improved as compared with others, and in connection with the new, to represent that it was original with the orator. The evidence shows several pre-existing bird designs, and the testimony of several witnesses is that this is only a bird design for such settings, and that therefore it is not new or original. But none of those shown are like this in appearance, either in outline or detail. Upon all the evidence in respect to them, it is not shown at all satisfactorily that settings of this design were either known or used before the the orator produced this.

The defendants have sold rings having a setting of the same outline as that represented in the orator's patent, representing a bird upon a branch or twig, with a leaf above the bird, and a panel, or a larger part of the branch in the shape of a panel, and two leaves, at the base of the twig, in white or silver and gold colors, and a diamond upon the leaf above. There are two other leaves upon the bird in the defendants' setting, The wings of the bird are in a different position from those of the bird in the plaintiff's setting, and the upper leaf is turned differently; but the two leaves below the bird in the defendants' setting are in white or silver color, and somewhat resemble the diamonds upon that part of the plaintiff's; and altogether more is required than to observe and consider the artistic effect of each to

bring these differences to notice. Looked at as ornaments desirable for their beauty or appropriateness, according to the taste of the wearer, these differences in the details become immaterial. The patent is for the appearance which the design will add to articles of jewelry, making them desirable according to its attractiveness to those who may observe and want them; and it is the right to the exclusive use of this which is secured by it to the orator. Gorham Co. *v.* White, 14 Wall. 371. The defendants have not left the orator to his rights, but have infringed upon them by making use of a design which presents substantially the same appearance to that class of persons. For this they must be held liable.

Let a decree be entered for an injunction and an account according to the prayer of the bill, with costs.

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MARGOT *v.* SCHNETZER *et al.*

U. S. Circuit Court, District of Massachusetts.

Decided February 5, 1883.

24 O. G. p. 101.

Validity of Design Patent No. 12,775, granted February 21, 1882, to Eugene F. Margot, for a design for a watch case, being questioned for want of novelty, by affidavits produced on the hearing, an injunction *nisi* only granted.

Mr. James E. Maynadier, for the complainant.
Messrs. Avery & Hobbs, for the defendant.

LOWELL, J. This is a motion for a preliminary injunction. The suit is upon Patent No. 12,775, dated February 21, 1882, for a design for watch-cases. The defendants copied the plaintiff's design before it was patented, and without knowing that a patent was to be applied for, and they are ready to stop infringing. The damages must be small, and I should wish to end the case here if that were possible; but a serious doubt is raised as to the novelty of the design, by the affidavit of one Smith, and by the admissions of the plaintiff in his affidavit in reply to Smith, so that I think an injunction *nisi* is all that I ought to grant. Injunction *nisi*.

WERNER *v.* REINHARDT, *et al.*

U. S. Circuit Court, S. D. New York.

Decided September 29, 1881.

10 Fed. Rep. 676.

1. A design patent claim for trimming, produced by embossing on fluting machinery, is a claim for the resultant appearance produced thereby.
2. The claim covers the leading and distinguishing features of the design; and these being found in the trimming made by defendant, the charge of infringement is made out.

Arthur V. Briesen, for orator.
Jacob L. Hanes, for defendants.

WHEELER, D. J. This suit is brought for relief agaist infringement of design letters patent No. 11,186, granted to the orator on application made March 19, 1879, for a design for trimming, produced by embossing on fluting machinery, dated May 6, 1879. The orator makes and sells trimming according to his patented design, as he claims it to be, and the defendants admit having made the same thing; but they set up in defence that the patent does not cover that design; that the orator was not the original and first producer of the design which it does cover; and that so much of the design as they have made use of had been in public use and on sale, with the consent and allowance of the orator, for more than two years prior to his application for the patent.

The impression created at the hearing was that the defendants had not, in view of all the evidence on both sides, sustained either of the last two defences by the requisite measure of proof. A careful review of all the evidence confirms that impression. The specification and drawings of the patent, taken all together, show a row of embossed, smooth, oblong and half-cylindrical projections between and parallel with two rows of ordinary fluting, which are the prominent and original features of the design, and are what the orator's trimming, made under the patent, show. This

design is what he invented. It proved attractive, and his patent conferred upon him the exclusive right to impress that appearance upon trimmings. The defendants appear to have infringed upon that right.

Therefore, there must be a decree for an injunction and an account, according to the prayer of the bill, with costs.

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DRYFOOS *et al. v.* FRIEDMAN *et al.*

U. S. Circuit Court, S. D. New York.

Decided January 4, 1884.

18 Fed. Rep. 825.

1. Design Letters Patent No. 4,802, dated April 11, 1871, and granted to William H. Walton for a design for printed material for gored skirts, consisting of printing a series of gore-shaped patterns, made to match around the lower edge in a skirt, the narrow end opposite the broad end of another, on a piece of woven fabric, so as to fill the width of the fabric, leaving blank spaces for seams, with dotted lines in the blank spaces by which to divide the fabric into parts, leaving each a pattern of proper shape to be sewed together into a full skirt, are not infringed by the gore-shaped patterns printed according to the patent, but already divided, ready to be sewed together into skirts, or by cutting skirt fabrics printed with gore-shaped patterns, the wide ends of which are placed alternately opposite the narrow ends, filling the width of the fabric, but without blank spaces for seams or lines or marks by which to divide them other than the outlines of the patterns.
2. The differences in designs necessary to take away their identity in law are such appearances as would attract the attention of an ordinary observer, giving such attention as a purchaser of the articles in question, for the purposes for which they were intended and purchased, would usually give.
3. There may be an infringement of a patented design without taking the whole of it, but in such cases the part taken must be a part covered by the patent.

Edmund Wetmore, for orators.
Roderick Robertson, for defendants.

WHEELER, J. The orators' own design Letters Patent, No. 4,802, dated April 11, 1871, and granted to William H. Walton for a design for printed material for gored skirts, consisting of printing a series of gore-shaped patterns, made to match around the lower edge in a skirt, the narrow end of one opposite the broad end of another, on a piece of woven fabric, so as to fill the width of the fabric, leaving blank spaces for seams, with dotted lines in the blank spaces by which to divide the fabric into parts having each a pattern of proper shape to be sewed together into a full skirt. The claim is for the "shape or configuration of a series of patterns for gored skirts printed upon a piece" of fabric, as shown and described. This suit is brought for relief against infringement. The answer does not deny the validity of the patent, but denies infringement by the defendants or either of them. The proof shows that the defendant, Abraham I. Friedman, sold a lot of gore-shaped patterns printed according to the patent, but already divided, ready to be sewed together into skirts, to a person sent to purchase them for the orators, and that he has cut up skirt fabrics printed with gore-shaped patterns, the wide ends of which were placed alternately opposite the narrow ends, as specified in the patent, filling the width of the fabric, but without blank spaces for seams or lines or marks by which to divide them, other than the outlines of the patterns. There is no proof whatever that the defendant, Daniel F. Friedman, has in any way done anything himself that is claimed to be an infringement, or that he has been in any way connected with Abraham I. Friedman in what he has done that is claimed to be an infringement. The invention would seem to have been better adapted to a patent for a manufacture than to one for a design. Clark *v.* Bousfield, 10 Wall, 133. But as a design patent was asked for and granted, and is not attacked, it must stand good for what it will probably cover. The sale procured by and to another for the orators, would not of itself probably be an unlawful infringement of which they could justly complain; yet, when made in the usual course of business, as of goods kept for sale, it might be evidence of sales of similar goods to others. Still, as the patent is not for the design of the patterns separately or united in a skirt at all, but only for the design of the series of patterns

as printed on the piece of fabric, it is not easy to see how the sale of the patterns divided could be an infringement of that patent. The design patented would not be there in that sale, and might not have been present in any use by that seller. When the piece of fabric was separated, and the patented design gone, there would not seem to be any infringement by a subsequent user or seller of the parts who was innocent before. But the cutting up of the fabric would undoubtedly be an unlawful use, if the fabric cut up was an infringement. The only evidence that Abraham I. Friedman cut up such fabric comes from his own cross-examination as a witness for the orators. In testifying to what he so used, he states that it is the same as used by him in 1868. If this is taken to be true, as the rest is, the patent, about which nothing prior to its grant is shown, could properly cover nothing but the improvement upon this, which would be merely the blank spaces for seams and the lines in these spaces by which to divide the patterns. As this defendant does not use these spaces nor lines, in this view, he would not infringe. Further, the prior printing of patterns upon woven fabrics for cutting apart and making up is well shown by other evidence. The patent could properly cover the improvements upon such, if this defendant's testimony as to what he had done before should be laid aside. As this patent, as before mentioned, does not cover the patterns, the improvements would consist in the design of the arrangement of them on the fabric, advantageously to be divided, for the fabric was not intended for use whole, but only by cutting the patterns apart. The spaces for seams, and lines in them to divide by, were prominent and important. The appearance of the pieces of fabric with and without these spaces and lines might be so nearly the same that the difference would not attract the attention of a disinterested observer, but it would at once be noticeable to ordinary purchasers or users of such material. The differences in designs necessary to take away their identity in law are understood to be such appearances as would attract the attention of an ordinary observer, giving such attention as a purchaser usually gives. Gorham Co. *v.* White, 14 Wall. 511. This, of course, means purchasers of the articles in question for the purposes for which they

were intended and are purchased. A purchaser of these fabrics would, ordinarily, be a person intending to cut them up and make them into skirts or sell them to others to make into skirts. A purchaser of ordinary observation, with that intention, would notice at once these prominent facilities for accomplishing those purposes. To such a person the design patented and that used by the defendant would be quite different. As argued for the orator, there doubtless might be an infringement of a patented design without taking the whole of it, but in such cases the part taken must be a part covered by the patent. Richardson *v.* Miller, 12 O. G. 3; Wood *v.* Dolby, 7 Fed. Rep. 475. The orators do not appear to have shown that the defendants or either of them infringe.

Let there be a decree that the defendants do not infringe and that the bill for that cause be dismissed, with costs.

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TOMKINSON *v.* WILLETS MANUFACTURING CO.

U. S. Circuit Court, S. D. of New York.

Decided March 7, 1884.

23 Fed. Rep. 895.

1. In a previous suit in another district (not reported), between the same parties on the same design patent, but in respect to a different infringing article, there was a final decree in the usual form, entered by consent, without defence: Held, that all questions on the second suit, except infringement, were *res judicata*, and not open for reconsideration.
2. Suit was on a design patent for a vegetable dish, which covered configuration only. Held proper to apply the rule of Gorham *v.* White, 14 Wall., to determine identity.
3. It is not necessary that a design patent should be copied in every particular to constitute an infringement. It is sufficient if the resemblance is such that an ordinary purchaser would be deceived, although the infringer has deviated slightly in details, or has either added or omitted something which an expert could discover, and this whether it be a patent for configuration or for surface ornamentation.

Frank V. Briesen, for complainant.
Philo Chase, for defendant.

Cox, J. This is an equity action for infringement, founded upon design patent No 13259, granted to John Slater, assignor to Gildea and Walker, September 12, 1882, for a design for a vegetable dish. The patent is now owned by the complainant. The invention relates to a new shape or configuration for a vegetable dish or other similar household article of china. The claims are as follows:

(1) The design for a rectangular vegetable dish, having upper straight section c, central curved section d, and lower straight section e, substantially as shown. (2) The design for a rectangular vegetable dish, having straight top and a section, d, curved first outward and then inward, in such a manner that the base of the dish is smaller than its top, substantially as shown. (3) The design for a vegetable dish, having parallel sides, a, a′, and parallel sides, b, b′, and composed of the sections, c, d, e, substantially as shown.

It will be observed that as to the handles, ornamentation, size and color of the dish, nothing is said in the claims. They are for the shape only.

In June, 1883, prior to this suit, the complainant commenced an action in the United States Circuit Court, district of New Jersey, against the defendant for an infringement of this patent. The complaint was in all respects similar to the one in the present suit. The defendant appeared by its president and consented to a decree and an injunction as prayed for. On or about the twenty-first of July, 1883, a final decree was entered, by which it was determined that the complainant is the sole owner of the letters patent in suit, and that they are good and valid in law. That decree was pleaded and proved in this action; it is valid and binding upon the rights of the parties, and, as to all the questions determined, by it, is *res judicata*. Unfortunately, perhaps, for the defendant, the court is not now permitted to consider the defenses, which, by the defendant's own action, are thus eliminated from the case. The question of infringement is alone open to investigation.

In approaching this subject, the rule with reference to design patents should be kept steadily in view. It is by no

means necessary that the patented thing should be copied in every particular. If the infringing design has the same general appearance, if the variations are slight, if to the eye of an ordinary person the two are substantially similar, it is enough. It is of no consequence that persons skilled in the art are able to detect differences. Those who have devoted time and study to the subject, who have spent their lives in dealing in articles similar to those in controversy, may see at a glance features which are wholly unimportant, and unobserved by those whose pursuits are in other directions, and who are attracted only by general appearances. If the resemblance is such that a purchaser would be deceived, it will not aid the infringer to show that he has deviated slightly from a straight line in one place and from a curved line in another, or that he has added or omitted something which an expert can discover. Gorham Co. *v.* White, 14 Wall, 511; Lehnbeuter *v.* Holthaus, 105 U. S. 94; Wood *v.* Dolby, 19 Blatchf. 214; S. C. 7 Fed. Rep. 476; Sim. Pat. 218; Walk. Pat., Sec. 375. Tested by this rule, I am constrained to say that the defendant infringes.

The principal difference pointed out between the two dishes in controversy is that in the upper vertical section of defendant's dish the sides are not exactly parallel, but bulge outwardly, departing from a straight line something less than half an inch. It is thought, however, that this divergence is not sufficiently marked to arrest the attention of the average observer. Bearing in mind that the patent deals with shape alone, the same conclusion must be reached with reference to the other differences suggested by the defendant's witnesses.

There should be a decree for the complainant.

CHAPTER VI.

Of remedies for infringement. Injunction. Profits and Damages.

SECTION 1. It has not been usual practice in patent causes to set out at length in the bill of complaint, or other initial pleading, any description of the invention for which the patent sued on was granted, nor to annex such as an exhibit to the pleading, nor to do more than make general profert of it. Unless one or the other of these courses be adopted, the pleading will be held defective on demurrer.[1] And whichever of these be adopted, the court will on demurrer to the sufficiency in law of the cause of action thus disclosed, consider and pass upon the patentability of the invention as appearing upon the face of the patent.[2]

SECT. 2. A bill in equity for injunction and account is not open to the objection of multifariousness merely because it charges infringement of two patents, one for a design and the other for mechanism, if it avers a conjoint use of both inventions in a single article made, used, or sold by the defendant. And this, though the two grants are of a different nature, authorized by different statutes, and for different terms, and tested as to novelty and infringement by wholly different principles. Ample precedent, however, is found for the practice.[3] Though if one of the patents be defeated, or be found not to have been infringed, the bill being sustained as to the other, no costs up to interlocutory decree should be allowed to the complainant.[4]

SECT. 3. As designs differ from mechanical inventions in being generally subjects of evanescent fancy rather than of lasting utility, and as the terms for which such patents

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[1] Post *v.* Richards Hardware Company, 25 Fed. Rep. 905.

[2] Post *v.* Richards Hardware Company, 26 Fed. Rep. 618. See also Eclipse Manufacturing Co. *v.* Adkins, 36 Fed. Rep. 554, and Western Electric Company *v.* Odell, 18 Fed. Rep. 321.

[3] Theberath *v.* Rubber, &c. Co. 3 Fed. Rep. 151; Wilson Packing Company *vs.* Clapp, 13 O. G. 368; Adams &c. Co. *v.* St Louis &c. Co. 12 O. G. 940.

[4] Jennings *v.* Kibbe, 24 Fed. Rep. 697.

are issued are shorter than for those of the other class of inventions, the general requirement that the validity of the patent should have been acquiesced in by the public or been judicially sustained, before granting a preliminary injunction, in a clear case of infringement, should be very much relaxed in such cases, to prevent injustice. Indeed, in one or more reported design cases, preliminary injunctions or restraining orders have been granted, where the patent was of very recent issue, and had not been previously litigated, and even where the novelty of the invention was questioned;[1] and such should also be the rule even where the fact of infringement, as respects identity of design, is, though sufficiently clear after careful comparison, at least debateable in the first instance; because the best and only positive evidence under that issue, must be produced at the original or preliminary hearing, viz., the articles bearing the designs in question.[2]

SECT. 4. There are but five reported cases on design patents, involving the question of the measure of profits and damages; three of these were decided on circuit,[3] and two in the Supreme Court.[4] Both of the latter, and one of the former, which was reversed in one of said Supreme Court decisions, were founded on patents for surface ornamentation exclusively. Of the other two cases mentioned, the one that was decided prior to the Supreme Court decisions referred to, was founded on claims for a design which consisted of both shape or configuration and surface ornamentation; while the other, decided afterwards and very recently, was founded on claims for form or configuration exclusively. The proper measure of damages may therefore be considered to be tolerably well settled, as respects both subject matters of design patents, certainly conclusively as to patents for surface ornamentation.

SECT. 5. Referring to these cases in the order of the dates of their decision, it was held in the first of these cases decided on circuit, viz., Bigelow Carpet Co. *v.* Dobson,

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[1] Foster *v.* Crossin, 23 Fed. Rep. 400; and Margot *v.* Schnetzer, 24 O. G. 101. And see Miller *v.* Smith, 5 Fed. Rep. 359; and Lehnbeuter *v.* Holthaus, 105 U. S. 94.

[2] See Jennings *v.* Kibbe, 10 Fed. Rep. 669; and Wood *v.* Dolby, 7 Fed. Rep. 475.

[3] Bigelow Carpet Co. *v.* Dobson, 10 Fed. Rep. 385; Simpson *v*, Davis, 22 Fed. Rep, 444; Tomkinson *v.* Willets, 34 Fed. Rep. 536.

[4] Dobson *v.* Bigelow and Hartford Carpet Cos., 114 U. S. 439; Dobson *v.* Dornan, 118 U. S. 10.

decided January 27, 1882, that the patentee's *damages* were to be estimated upon and measured by the *profit* it was shown that he would have realized upon a like quantity of the infringing carpets bearing the patented design, had he made and sold the same. There were other questions involved in the decision, but the case turned upon the point stated.

In the second case, decided on circuit, viz., Simpson *v.* Davis, decided April 2, 1884, in which the claim infringed was for a design for a newel post, consisting both of the form and the surface ornamentation thereof, the court measured the defendants *profits to be accounted for* on the basis that having ascertained the cost price, the selling price, and the average manufacturers' profit, held that the remainder of the price realized from the sale of the newels of the plaintiffs' design, after deducting the cost of making the newels, and a fair profit for their manufacture, must be presumed to represent the profit realized by the defendant from his adoption of the plaintiffs' design.

In the third case, decided on circuit, viz., Tomkinson *v.* Willets, decided March 26, 1888 (after the rule of profits and damages had been settled in the carpet cases decided in the Supreme Court). the court refused to allow manufacturer's profits actually or presumably derived from the sale of the square-shaped dishes of the peculiar form or configuration patented, holding that the burden was on the patentee to separate from the whole profit the part or proportion fairly attributable to the design, and that inability to do so, whether from the nature of the subject matter or otherwise, would not justify an allowance not based upon such evidence.

SECT 6. The first of the cases decided by the Supreme Court[1] did not establish any new measure of profits and damages, for infringement of design patents; but merely applied the rule previously laid down by the court in a series of decisions on functional patents, as to what are to be regarded as "profits to be accounted for by the defendant," and what as "actual damages." Courts of equity were first authorized by the law of July 8, 1870, since incorporated into Section 4921, Rev. Stat., to award damages to a complainant in a bill for infringement of a patent,

[1] Dobson *v.* Hartford & Bigelow Carpet Cos. 114 U. S. 439.

in addition to the profits made and received by the defendant from the infringement; and this was defined by the Supreme Court in Root *v.* Railway Co.[1] to mean that while damages may be allowed in addition to the profits accounted for, yet as the former are limited by the statute to actual damages, it is manifest that the recovery of damages and profits is not intended to be double, but that when necessary the damages are to supplement that loss of the complainant which the profits found to have been received are insufficient to compensate.

SECT. 7. Profits are the actual gains made and received by the defendant from the unlicensed use of the patented invention; while the complainant's damages are the actual[2] losses which he sustained in not being permitted to enjoy the exclusive rights conferred by the patent, by reason of defendant's unlawful interference with his enjoyment of such rights. By force of the statute these provisions of the general law are applicable to designs.[3] In applying these principles in suits for infringement of patents in general, the Supreme Court has had occasion in a long line of decisions to define what are to be regarded as "profits to be accounted for by the defendant" and what as "actual damages," and no rule has been sanctioned which will allow in the case of a patent for an ornamental design to be painted, woven, cast, or otherwise placed on or worked into any article of manufacture which possesses intrinsic value apart from the design, the entire profit from the manufacture and sale of the finished article, as either profits or damages, including all the profits from the manufacture of the article itself, thus regarding all the profits as due to the design impressed thereon.[4]

SECT. 8. Illustrations of the range of subjects to which this rule is applicable are found in designs for carpets, oil cloths, wall paper, window shades, curtains, fringe fabrics, watch cases, stove ornaments, and all other designs consisting of surface ornamentation to be printed, painted, cast, or otherwise placed on or worked into any article of manu-

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[1] 105 U. S. Reps. 189–212.

[2] See 4919 Rev. Stat.; Seymour *v.* McCormick, 16 How. 480; Root *v.* Railway, 105 U. S. 189, 212.

[3] See 4933 Rev. Stat.; Dobson *v.* Carpet Co. 114 U. S. 439, 443.

[4] Dobson *v.* Hartford Carpet Co. 114 U. S. 439; Dobson *v.* Dornan, 118 U. S. 10.

facture which has an inherent value apart from the design or pattern placed upon, and which forms a part of it. The true rule of damages in such cases, as declared by the Supreme Court,[1] is that to entitle the plaintiff to recover anything beyond nominal damages the evidence offered must separate or apportion the defendant's profits and the patentees damages between the patented feature and the unpatented features, of the whole article, and such evidence must be reliable and tangible, and not conjectural or speculative. There is, however, an exception to the rule, furnished by the previous decision in Manufacturing Company *v.* Cowing,[2] to the effect that if, by equally reliable and satisfactory evidence, it can be shown that the entire value of the completed article, as a marketable article, can be properly and legally attributed to the patented feature, that the patentee should in such case be entitled to the whole profit.

SECT. 9. The reason for the rule stated is quite apparent, as pointed out by the appellate court in its decision. As the design is merely the surface ornamentation, to be placed upon an article of manufacture, there is a legal presumption that the article itself must, to obtain a market, possess intrinsic merits of quality and structure which give value, to some extent at least, to the completed whole; and to attribute in law the entire profit to the design, which at most appeals only to the taste, is often a matter of evanescent caprice, and rarely adds to the market value of the article upon which it is impressed, would be an illogical deduction, as well in fact as in law, of cause from effect; besides being a violation of the statutory rule permitting only actual profits and damages to be accounted for and assessed. Additional reason for the rule is to be found in the fact that as a completed article may be at the same time the subject matter as well of a mechanical patent as of a design patent, the whole profit may as well, on principle, be attributed to the mechanical features as to the ornamental design.

SECT. 10. The rule stated for the ascertainment of profits and damages for infringement of design patents, was enun-

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[1] Dobson *v.* Hartford Carpet Co. 114 U. S. 439, 445.

[2] Manufacturing Co. *v.* Cowing, 105 U. S. 253.

ciated by the Supreme Court in a case[1] which arose upon a patent for a carpet design: that is, for a design for surface ornamentation, and which is the class of designs included in the second descriptive clause of Section 4929 of the Revised Statutes, which from its laanguage, as compared with the first and third descriptive clauses of the section, would clearly seem to include only such designs as consisted of surface ornamentation exclusively, and applicable to *known* articles of manufacture, which possess intrinsic merits of quality and structure apart from the particular or any other design which may be impressed upon them or with which they may be so ornamented. The first clause of said Section 4929 would in like manner seem to apply also to surface ornamenitation only, but applicable to *original* articles of manufacture, mainly articles of virtu, and in which the design itself is the chief feature, the material upon which it is impressed having no intrinsic merits of quality or structure; such as a bust, statue, alto-relievo, or bas-relief; the original clay, metal, or marble not being a "manufacture," and the design itself being the artistic manufacture impressed upon the original, natural, and rough material, which has little or no intrinsic value, is not marketable as a complete article apart from the design, and the latter having the effect of completely changing its whole character, quality, structure, merit, and value. While the third descriptive clause of said Section 4929 would, by the same reasoning and by force of its language, clearly apply exclusively to designs of shape, form, or configuration, of which the material or thing to which the design is applied must be a *known* article of manufacture, having intrinsic utility, and therefore necessarily intrinsic value, and be a technical "manufacture."

SECT. 11. In a leading early case on the measure of damages for infringement of mechanical patents—Seymour *v.* McCormick[1]—the Supreme Court, speaking by Mr. Justice GRIER, said, "it must be apparent to the most superficial observer of the immense variety of patents issued every day, that there cannot, in the nature of things, be any one rule of damages which will equally apply to all cases. The

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[1] Dobson *v.* Hartford Carpet Co., 114 U. S. 439. Approved in Dobson *v.* Dornan, 118 U. S. 10.

[1] 16 How. 480

mode of ascertaining damages must necessarily depend on the peculiar nature of the monopoly granted." The force of these remarks, in connection with the variety and wholly different character of articles to which the design law is applicable, as pointed out in the preceding sections, will be readily appreciated. The Supreme Court, speaking by Mr. Justice Blatchford, in the first of the carpet cases,[1] made use of the remark, that "a design or "pattern in ornamentation or *shape* appeals only to the taste "through the eye, and is often a matter of evanescent "caprice. The article which embodies it is not necessarily "or generally any more serviceable or durable than an ar- "ticle for the same use having a different design or pattern. "Approval of the particular design or pattern may very "well be one motive for purchasing the article containing "it, but the article must have intrinsic merits of quality and "structure to obtain a purchaser, aside from the pattern or "design." While this sentence includes the word "shape." meaning form or configuration, its whole tenor would seem to exclude from its meaning those articles included in the first clause of Section 4929, Rev. Stat., in which the design itself is the manufacture, and the original rough material on which it is impressed is of little or no intrinsic value; and to include only the subjects comprised within the second and third clauses of the section, viz: designs both of surface ornamentation and configuration, or either, and applied to known articles of manufacture possessing intrinsic value and merits of quality and structure, apart from the design, and not affected as a marketable article by the fact of the application to it of any particular design.

SECT. 12. In the second of the carpet cases,[2] the court said, "the value imparted to the carpet by the design" is the real profit realized by the defendant and lost to the plaintiff by the infringement; but remarked in the first of these cases,[3] that it is equally true that the plaintiff may be entitled to the entire profit on the article as well as the design, if he can show that the entire value of the whole as a marketable article is properly and legally attributable

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[1] 1 Dobson v. Hartford Carpet Co., 114 U. S. 439, 445.
[2] Dobson v. Dornan, 118 U.S. 10, 17.
[3] Dobson v. Hartford Carpet Co., 114 U. S. 439, 445.

to the design. This would be an exception to the rule, not likened so much to Mnfg. Co. *v.* Cowing,[1] which became an exception because of the locality of the sales as well as of the peculiar subject matter applicable to such locality, but because solely of the subject matter, for instance, a bust, statue, &c., or a carpet of particular pattern where the evidence showed a special and particularized demand for the carpet of that pattern, if made by the patentee, and the sales of which he lost directly by the infringement. Mnfg. Co. *v.* Cowing was founded in part, if not mainly, on the rule previously stated in Mowry *v.* Whitney,[2] that the plaintiff is entitled to recover the money value of the advantage which the defendant derived from using the complainant's invention over what he would have had in using other processes then open to the public, and adequate to enable him to obtain an equally beneficial result. "It does not necessarily follow from this," the court remarked, in Mnfg Co. *v.* Cowing, after quoting the above rule from Mowry *v.* Whitney, "that where the patent is for one of the constituent parts, and not for the whole of the machine, the profits are to be confined to what can be made by the manufacture and sale of the patented part separately. * * * If the improvement is required to adapt the machine to particular use, and there is no other way open to the public of supplying the demand for that use, then it is clear the infringer has, by his infringement, secured the advantage of a market he would not otherwise have had, and that the fruits of this advantage are the entire profits he has made in that market." Such may be the case frequently under the peculiar and possible circumstances previously above mentioned, in case of a particularized and special demand for a known and intrinsically valuable article bearing a particular design; or in case where the design was in itself the manufacture from original rough material possessing in itself no intrinsic value or merit of quality or structure, and having no salability for such purposes until impressed with the design, and this whether the latter be of ornamentation or of configuration.

SECT. 13. It will readily be seen therefore that a class of

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[1] 105 U. S. 253.

[2] 14 Wall. 260.

cases may arise, under the design patent statute, in which the rule of damages applied in Dobson *v.* Carpet Co., is not at all applicable, namely, that class included within the first descriptive clause of Section 4929 Rev. Stat., which comprises any new and original design for a bust, statue, alto relievo or bas relief, and the like, in which the design is impressed, not upon any article of manufacture, either known or original, but is the article itself, the material to which it gives form being comparatively of little or no intrinsic value, and undergoing an entire change both in character, utility, and value in the process. In such case it could not be open to doubt that the proper measure of damages would be the entire profit on the manufacture and sale of the article in question.

SECT. 14. In considering the practical application of the rule of damages proper to be applied in cases falling within the second and third descriptive clauses of the design statute, not only as respects designs consisting solely of surface ornamentation, or of shape or configuration, or of both together in one unitary design, these finding expression in the ornamentation of known articles of manufacture of intrinsic value *per se*, and possessing merits of quality and structure apart from the particular design or any design, it must be apparent to the most superficial thinker that rarely will it be possible to separate from the whole profit on the completed article, that portion thereof due to the design, from that remaining portion due to the article itself; because it is not alone the market value but the salability of the original article that is changed by the impression thereon of the design, and as to the latter it is a matter of taste, of evanescent caprice in the purchaser, and has no value in the abstract, nor until it is applied to the appropriate article for which it was created. It is not intended hereby to question the correctness of the rule of damages as applied by the appellate court in the carpet cases; on the contrary, it is the only sound rule that meets the exigencies of the subject; but to point out the difficulty of its application to certain classes of designs included within the statute authorizing the grant of patents for such productions.

SECT. 15. To meet this difficulty, which in some cases and under some circumstances would be absolutely insur-

mountable and leave the injured party without any compensatory remedy, the Congress, after the announcement of the decision in the last of the carpet cases, enacted a statute[1] which provides that for infringement of any design patent by any manufacturer of an article to which the design or any colorable imitation thereof has been applied by him, for the purpose of sale, without the license of the patentee; or by the sale by any person of such an article with knowledge, or after notice, that the said design had been so used without the consent of the owner of the patent, either or both of such persons so offending shall be liable at the suit of the patentee, to his own use, to pay a penalty of two hundred and fifty dollars, which recovery shall not be a bar to an action at law or in equity for the actual damages suffered, or for profits derived from the same act infringement, in excess of such penal sum; and also preserving, of course, the usual remedy by injunction to prevent further infringement.

SECT. 16. This legislation is in line with the English statutes on the subject, the first of which, enacted in 1839, imposed a penalty of from five to twenty pounds sterling at the discretion of the court; and this remedy was supplementary to that provided by previous laws, viz: by injunction in equity and by an action on the case for damages; and in this connection it is interesting to note that in a committee report to Parliament, in 1839, on the subject of amending the laws respecting protection for copyright in designs, it is stated that the records of the courts contained but one case in the previous fifty years brought at law for the recovery of damages for such infringement. The existing law in England, after which our own is modeled, was enacted August 25, 1883,[2] and is contained at large in a

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[1] Act of Feb. 4, 1887, 24 Stat. at Large, 387. See statute in full, foot-note to page 6 of this volume.

[2] 46 and 47 Vict. c. 57, Sect. 58. It shall not be lawful for any person without the license or written consent of the registered proprietor, to apply such design or any fraudulent or obvious imitations thereof in the class or classes of goods in which such design is registered, for purposes of sale, to any article of manufacture or to any substance, artificial or natural, or partly artificial and partly natural; and, it shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing the same has been so applied without the consent of the registered proprietor. Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any court of

foot note, it being so similar thereto that decisions under it may become useful precedents, or at least guides, in the interpretation of our own, as the English decision on identity of designs[1] afforded an outline for, and was followed in our own leading case—Gorham *v.* White—on that branch of the subject.

SECT. 17. Practice under this statute, thus very recently enacted by Congress, has not yet been established, but it would seem plain that the arbitrary amount named is in the nature of a penalty and not to be awarded as *damages* in cases where from want or failure of proof of actual damages, nominal damages could only otherwise have been awarded. And it would also seem free from doubt that in case the plaintiff should offer such proof of actual damages or profits as would warrant a verdict of a jury or a finding of a master, for a sum exceeding two hundred and fifty dollars, that the penalty could not be added or given also in addition thereto, and hence that the statute would have no operation in such a case. And finally, that the act is only aimed against the manufacturer, and against the dealer with guilty knowledge; and in either case that the penalty is not to be inflicted for each infringing article made or sold, but only for each continuous act of infringement, although clearly the penalty may be recovered against both manufacturer and dealer for the same infringement, or rather for the unlawful manufacture and sale of the same or identical article bearing the patented design.

SECT. 18. With respect to costs on an accounting before a master, it is but simple justice that if the plaintiff recover no more than nominal damages, or no more than the penalty provided by the act of February 4, 1887, the costs of the reference should be ordered to be paid by the plaintiff and not by the defendant. Such, at least, is the fair inference to be drawn from the decisions and decretal orders of the Supreme Court in the carpet cases herein before referred

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competent jurisdiction. Sect. 59. Notwithstanding the remedy given by this act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or any fraudulent or obvious imitation thereof, for the purpose of sale, to any article of manufacture or substance, or for the publication, sale or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor has not given his consent to such application.

[1] McCrea *v.* Holdsworth, L. R. 6 Ch. 416.

to.[1] And this whether such nominal damages be awarded by the master's report, or by the court on exceptions thereto, or by the appellate court on appeal.

The following selected cases illustrate the subject matter of the preceding chapter.

POST *et al. v.* RICHARDS HARDWARE CO.

U. S. Circuit Court, District of Connecticut.

Decided December 8, 1885.

25 Fed. Rep. 905.

The bill contained an averment that the patentee invented "a new and original design for a curtain and loop," and that letters patent, of a specified date and number, were granted thereon. No other description of the invention was given, nor any reference made to the patent for a further description. Held on demurrer that the invention was not sufficiently described in the bill.

It is essential to the sufficiency of a bill in equity for an injunction against the infringement of letters patent for an invention that the pleading should contain such a description of the invention as patented, as will apprise the court of its nature and character, and the particulars in which the improvement consists.

This may be done by a full and accurate description in the pleader's own language, care being taken not to depart from the legal effect of the language of the patent; or by employing the language of the specification, or by a reference to and profert of the patent. The last named course is the usual and most convenient one.

William Edgar Simonds, for plaintiff.
Frank L. Hungerford, for defendant.

SHIPMAN, J. This is a demurrer to a bill in equity for an injunction against the alleged infringement of a design

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[1] Dobson *v.* Hartford Carpet Co., 114 U. S. 439; Dobson *v.* Dornan, 118 U. S. 10.

patent. The bill alleges that the inventor invented "a new and original design for a curtain and loop," and that letters patent therefor, of a specified number and date, were granted and delivered to the inventor. The usual averments are made in regard to the execution of the letters patent. No other description of the invention is given, and no reference is made to the patent for a further description. The ground of the demurrer is that the bill "does not set out the nature, character, or description of the pretended patented design referred to in said bill, nor the letters patent alleged to have been obtained therefor, nor make any profert of the same."

It is necessary that a bill in equity for an injunction against the infringement of letters patent for an invention should contain such a description of the invention as patented, as will apprise the court of its nature and character, and the particulars in which the improvement consists. This may be done by a full and accurate description in the pleader's own language, care being taken not to depart from the legal effect of the language of the patent, or by employing the language of the specification, or by a reference to and profert of the patent. The last-named course is the usual and most convenient one. The bare averment that the design was "a design for a curtain and loop" is not sufficient.

The demurrer is allowed, with leave to amend.

SIMPSON *v.* DAVIS.

U. S. Circuit Court, Eastern District of New York.

Decided April 2, 1884.

22 Fed. Rep. 444.

1. Defendant having been adjudged by the interlocutory decree to have infringed the plaintiff's patent for design for newel posts, the master found that he had sold 101 newels, which embodied the patented design, at $7 each; that they cost $5 each to make, and that a fair manufacturer's profit on each was ten per cent. Held that the profit to be accounted for on such newels, was the whole profit as thus ascertained, or $151.50.

2. Proof that defendant sold other newels of a design not patented at the same price, did not dispel the presumption that the amount realized by him above the cost of manufacture and the manufacturer's profit, was the profit realized by him from the adoption of the patented design.

3. Held further, that under Section 4,919 of the Revised Statutes, as construed by the Supreme Court in Birdsall *v.* Coolidge, 93 U. S. 64, in cases where the defendant's profits do not amount to as much as the plaintiff's damages, the court may add to the amount to supply the deficiency, and that in this case it must be decreed that the plaintiff do recover of defendant,, in addition to the $151.50, as much more, making the recovery $303, that sum being proved to be the plaintiff's damages.

Edwin H. Brown and Arthur Murphy, for plaintiff.
M. H. Clement, for defendant.

BENEDICT, J. This case comes before the court upon the Master's report of the plaintiff's damages and the defendant's profits, arising out of an infringement by the defendant of the plaintiff's patent for a design for newel posts. The first exception is well taken. The proof is that the defendant sold 101 newel posts of the design covered by the plaintiff's patent, instead of 119 as reported by the Master. The second exception is not well taken. The proof is that 101 newels made and sold by the defendant embodied the design secured to the plaintiffs by their patent. The third exception is not well taken. The proof shows that the defendant made 101 newel posts similar to the plaintiff's newel posts. The cost of making these posts is shown by a stipulation made between the parties to be $5 each. The testimony shows that ten per cent. is the fair manufacturer's profit on the construction of such an article. The defendant sold the newels so made by him for $7 each. His profit, therefore, for the use of the plaintiff's design is $151.50. It is contended by the defendants that the proofs show that at the time he was selling newels of the plaintiff's design he was also selling newels of other designs not patented, from which sales he realized as much as he did from the sales of the plaintiff's newels, and therefore it is said no profit accrued to the defendant from the use of the plaintiff's

design. But the remainder of the price realized from the sale of newels of the plaintiff's design, after deducting the cost of making the newels, and a fair profit for their manufacture, must be presumed to represent the profit realized by the defendant from his adoption of the plaintiff's design, in the construction of the newels sold by him. And this presumption is not dispelled by proving that the defendant realized the same profit from adopting, in the manufacture of other newels sold by him, a different and unpatented design. The fact that a certain profit is realized from the adoption of the design of A does not show that no profit is realized from the adoption of the design of B. The fourth exception raises the question whether the plaintiffs can, by virtue of Section 4,919, Rev. Stat., recover damages resulting from the defendant's infringement of their patent in addition to the profits realized by the defendant. Doubts appear to have existed in regard to the meaning of the provisicn in Section 4,919, but I understand the Supreme Court, in Birdsall *v.* Coolidge, 93 U. S. 64, to hold the effect of the statute to be this: that when it appears, in a case in equity, that the defendant's profits, derived from the use of the plaintiff's invention, do not amount to so much as the plaintiff's damages arising from the infringement, the court may add to the amount of the defendant's profits a sum sufficient to make the amount awarded by the decree equal to the plaintiff's damages. So the decision referred to is understood in Child *v.* Boston & Fair Haven Iron Works, 19 Fed Rep. 258.

Under this construction of the statute the plaintiffs, upon the proofs in this case, may have added to the defendant's profits the sum of $151.50, making the recovery $303, which is the amount of the plaintiff's damages as shown by the proofs.

HARTFORD CARPET CO. *v.* DOBSON. BIGELOW CARPET CO. *v.* SAME. (Two Cases.)

U. S. Circuit Court. E. D. of Pennsylvania.

Decided January 27, 1882.

10 Fed. Rep. 885.

1. Where the infringement is willful, respondents ought to be held to the most rigid accountability, and no intendment ought to be made in their favor, founded upon the alleged inconclusiveness of the complainant's proof of loss. Such proof ought to be interpreted most liberally in favor of the complainants, within the limit of an approximately accurate ascertainment of their damages.

2. In a suit on a patent for a design for a carpet, the plaintiff claiming damages, under an interlocutory decree containing a reference to a master to assess profits and damages, the evidence showed the cost and selling price of complainants' carpet, the quantity of the infringing carpet sold by respondents, and that there was a decline in complainants' sales; *held* that the amount of defendant's sales must, under the circumstances, be presumed to have displaced an equal quantity of complainants' carpets; and that the measure of damages is the whole profit on the carpet bearing the design, and is to be ascertained by the profit plaintiffs would have realized had they made and sold the same.

These were two cases brought by the Bigelow Carpet Company, for infringement of letters patent Nos. 10,870 and 10,778, for designs for carpets; and a third by the Hartford Carpet Company, for infringement of letters patent No. 11,074, for designs for carpets, all against the same defendants. Interlocutory decrees were entered, and the cases were referred to a master to ascertain and report the profits and damages. The plaintiff's waived the former, as it appeared that no *actual* profit had been realized by defendant; and damages were asked for. In each case complainants proved that during the first six months after the introduction of the design a specific quantity of their carpet was sold, and they also gave evidence of its cost

and their profit on it. The quantity of the infringing carpet subsequently sold by respondents was also shown. Complainants claimed that the effect of respondents putting upon the market carpets of the same design at a less price was to decrease the demand for the original carpet, and compel a change of design. They claimed damages based upon estimates made by their witnesses as to the probable amount of their sales of the original carpet if respondents had not infringed and no other cause had occurred to diminish the demand. They also claimed the expense of changing their designs, as estimated by their witnesses. The master reported that while the effect of the infringement was to decrease the complainants' sales, he was entirely unable to find from the evidence the amount of their damage, or even to approximate its sum, and he therefore awarded only nominal damages. The cases came before the court on complainants exceptions to this report, and they were argued together.

A. V. Briesen and Joseph C. Fraley, for complainants.
George E. Buckley, for respondents.

McKENNAN, C. J. These were all suits for infringement by the respondents of designs for carpets patented to the complainants. The infringing designs are exact counterparts of the patented ones, and carpets embodying them were put upon the market by the respondents some time after the dates of the patents and introduction of carpets containing the designs described in them by the complainants. No defence was made by the respondents, and they therefore occupy the attitude of wilful infringers.

Under these circumstances the respondents ought to be held to the most rigid accountability, and no intendment ought to be made in their favor founded upon the alleged inconclusiveness of the complainants' proof of loss. On the other hand, such proof ought to be considered and interpreted most liberally in favor of the complainants, within the limit of an approximately accurate ascertainment of their damages.

The master has not so dealt with the evidence presented to him, and has, therefore, fallen into error in his conclu-

sion. He has found nominal damages only in favor of the complainants, although they furnished proof by which the damages claimed by them might, to some extent at least, be legally measured.

In this category is the evidence of the number of pieces and yards of the complainants' carpets manufactured during the season of its first introduction upon the market, the cost per yard of their manufacture, and the prices at which they were sold in the market; the number of pieces and yards of infringing carpets made and sold by the respondents in the following season, and the very large decline in the complainants' sales during this period. It furnishes the means of accurate computation of the complainants' profits, and of the extent to which the market was occupied by the respondents. All that is left for presumption is that the infringing carpets displaced in the market the complainants' carpets, and hence that the profits which would have accrued to them upon the quantity of carpets put upon the market is the measure of their damages.

This presumption, as against a wrong doer, is not unreasonable, and it has the sanction of numerous decisions. Putnam *v.* Lomax, 9 Fed. Rep. 448; American Saw Company *v.* Emerson, 8 Fed. Rep. 806; McComb *v.* Brodie, 2 O. G. 117; Westlake *v.* Cartter, 4 O. G. 636.

Upon this basis there is no difficulty in stating an account against the respondents; and this is the only one upon which under the evidence, the complainants' damages can be computed. It is enough for us to say that the losses claimed for the entire decline in the complainants' sales, and on looms, are too remotely connected with the defendants' acts as their suppposed cause, and hence are too speculative in their character to entitle them to allowance.

It sufficiently appears that the respondents made and sold twenty pieces of fifty-five yards each, 1,100 yards in all, of carpets containing the design described in No. 30, of April term, 1879, and that the complainants' profit upon carpets of that design was sixty-seven cents per yard. They lost, therefore, this sum upon 1,100 yards, and their damages amount to $737, for which a final decree must be rendered in their favor.

In No. 34, April term, 1879, which is founded upon the

patent for what is popularly called the "Pagoda Pattern," the respondents made 20 pieces of 50 yards, in all 1,000 yards, the profit of complainants for like carpet being 75 cents per yard. The respondents have not disclosed what became of the carpets thus made by them, and they are, therefore, held accountable for them as if put upon the market. The complainants' damages in this case are, then, 75 cents upon 1,000 yards, equal to $750, for which a final decree will be entered in their favor.

In No. 35 of April term, 1879, the respondents made 53 pieces of Chinese Lantern pattern of 50 yards each, but sold only 35 pieces, the rest having been sealed up by the marshal.

The complainants' damages in this case are, therefore, 75 cents upon 1,750 yards, amounting to $1,312.50, for which a final decree will be entered in their favor.

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DOBSON *et al.* *v.* HARTFORD CARPET CO.
SAME *v.* BIGELOW CARPET CO.

Supreme Court of the United States.

Decided April 20, 1885.

114 U. S. Rep., 439.

1. In assessing damages for the infringement of a patent for a design for carpets, where no profits were found to have been made by the defendant, the circuit court allowed to the plaintiff as damages on the quantity of infringing carpets made and sold by the defendant, the profit which the plaintiff would have realized in making and selling carpets with the patented design. Held that such award of damages was improper, as it included the whole profit on the carpet as well as on the design, and that in the absence of evidence of the latter, only nominal damages should have been allowed.
2. The measure of damages for infringement of a design patent, is the value the design contributed to the finished article, and not the whole profit; unless it is shown by reliable and tangible evidence that the whole profit is to be legally attributed to the design.

3. The joinder of a claim for a pattern and separate claims for each of its parts in one patent, does not *per se* invalidate the patent, or any claim, at the objection of a defendant.

4. A claim of "the design for a carpet, substantially as shown," refers both to the description and the drawing, and is sufficient.

5. Objections to a patent that might otherwise be taken on appeal from a decree entered after defense and hearing, are concluded where the bill is taken as confessed.

6. Where the master reported no profits, and nominal damages, in a suit in equity for the infringement of a patent for a design, and, on exception by the plaintiff, the circuit court allowed a sum for damages, and this court reversed its decree, the plaintiff was allowed costs in the circuit court to and including the interlocutory decree, and the defendant was allowed his costs after such decree.

Appeal from the Circuit Court of the United States for the Eastern District of Pennsylvania.

Hector T. Fenton and R. P. White, for appellants.

Arthur V. Briesen, for appellees.

Mr. Justice BLATCHFORD delivered the opinion of the court.

These are three suits in equity brought in the Circuit Court of the United States for the Eastern District of Pennsylvania, against John Dobson and James Dobson, trading as John & James Dobson, and as the Falls of Schuylkill Carpet Mills." No. 1 is brought by the Hartford Carpet Company, for the infringement of Design Letters Patent No. 11,074, granted March 18, 1879, to the plaintiff, as assignee of Winthrop L. Jacobs, for three and one-half years, for a design for carpets. No. 2 is brought by the Bigelow Carpet Company, for the infringement of Design Letters Patent No. 10,778, granted August 13, 1878, to the plaintiff, as assignee of J. Hugh Christie, for three and one-half years, for a design for carpets. No. 3 is brought by the Bigelow Carpet Company, for the infringement of Design Letters Patent No. 10,870, granted October 15, 1878, to the plaintiff, as assignee of Charles

Magee, for three and one-half years, for a design for carpets.

No. 1 was commenced on the 26th of April, 1879, and Nos. 2 and 3 an the 7th of May, 1879. In No. 1 and No. 3 the defendants appeared by a solicitor, but did not plead, answer, or demur to the bill, and it was taken as confessed in each suit, on the eleventh day of July, 1879; and on the 2d of September, 1879, an interlocutory decree was entered in each suit, awarding a perpetual injunction, and an account of profits and damages. In No. 2 an answer was filed on the 3d of September, 1879, denying infringement, and setting up want of novelty. A replication was filed, and on the 5th of November, 1879, a preliminary injunction was granted. Testimony was taken, and on April 23, 1880, on final hearing, a decree was made for a perpetual injunction, and an account of profits and damages. Some testimony on the accounting in Nos. 1 and 3 was taken in November, 1879, but most of the evidence before the Master was taken in the three suits at the same time, in June, 1880.

In No. 1 the Master filed a report on January 18, 1881, setting forth that the plaintiff, before the Master, waived all claim for profits, and limited its claim to the damages it has suffered by the infringement; that the defendants had sold 20 pieces of 50 yards each of carpet containing the patented design; that the plaintiff claimed $13,400 damages, being 67 cents a yard, on 400 pieces of carpet of 50 yards each, as being the decrease of the plaintiff's sales, caused by the infringement, estimating the cost to the plaintiff of making and selling the carpet at $1.08 per yard, and his selling price at $1.75 per yard; and that the Master had rejected that claim as founded on inadmissible evidence, and a further claim of $3,000 damages, for expenses caused to the plaintiff by the infringement, in getting up other designs and changing its looms to other carpets. The report was for six cents damages. The plaintiff excepted to the report because it did not find profits to have been made by the defendants, and did not report more than nominal damages. The court sustained the exceptions, and decreed to the plaintiff $737, being for 20 pieces of infringing carpet made and sold by the

defendants, at 55 yards per piece, or 1,100 yards, at 67 cents per yard, as the plaintiff's profit per yard on carpet of the patented design. The final decree was for $737 and costs, and a perpetual injunction. The defendants have appealed.

In No. 2 the Master filed a report on January 18, 1881, setting forth that the plaintiff, before the Master, waived all claim for profits, and limited its claim to the damages it had suffered by the infringement; that no testimony had been taken showing the amount of the defendant's sale of the infringing carpet; that the plaintiff claimed $11,250 damages, being 75 cents a yard on 300 pieces of carpet of 50 yards each, as being the decrease of the plaintiff's sales, caused by the infringement, estimating the cost to the plaintiff of making and selling the carpet at $1.10 per yard, and his selling price at $1.85 per yard; and that the Master had rejected that claim as not sustained by the evidence, and also a further claim for expense caused to the plaintiff by the infringement in getting up another design, and in resetting its looms to manufacture the same. The report was for six cents damages. The plaintiff excepted to the report for not finding more than nominal damages. The court sustained the exceptions, and decreed to the plaintiff $750, being for 20 pieces of infringing carpet made by the defendant, at 50 yards per piece, or 1,000 yards, at 75 cents per yard, as the plaintiffs' profit per yard on carpet of the patented design. The final decree was for $750 and costs, and a perpetual injunction. The defendants have appealed.

In No. 3, the master filed a report on January 18, 1881, setting forth that the plaintiff, before the master, waived all claim for profits, and limited its claim to the damages it has incurred by the infringement; that the defendants had sold 31 pieces, amounting to 1,684¼ yards of carpet containing the patented design; that the plaintiff claimed $3,750 damages being 75 cents a yard on 5,000 yards of carpet, as being the decrease of the plaintiff's sales, caused by the infringement, estimating the plaintiff's profit on making and selling the carpet at 75 cents per yard; and that the master had rejected that claim as not sustained by the evidence, and also a further claim for the cost of getting up another

design to replace the one infringed. The report was for six cents damages. The plaintiff excepted to the report, because it did not find profits to have been made by the defendants, and did not report more than nominal damages. The court sustained the exceptions, and decreed to the plaintiff $1,312.50, being for 35 pieces of infringing carpet, made and sold by the defendants, at 50 cents per piece, or 1,750 yards, at 75 cents per yard, as the plaintiff's profit per yard on carpet of the patented design. The final decree was for $1,312.50 and costs, and a perpetual injunction. The defendants have appealed.

The circuit court proceeded on the ground, as stated in its decision. (10 Fed. Rep. 385,) that it was to be presumed that the defendants' carpets displaced in the market an equal quantity of the plaintiffs' carpets; and that the profits which the plaintiffs would have made on that quantity of carpets was the measure of their damages. It rejected the claims for losses for any greater decline in the plaintiff's sales, and on looms, as "too remotely connected with the defendants' acts as their supposed cause," and "too speculative in their character," to be allowed.

Leaving out of view all question as to the presumption that the plaintiffs would have made and sold, in addition to the carpets of the patented designs, which they did make and sell, the infringing carpets which the defendants made and sold, which are alleged to have been of poorer quality and cheaper in price, it is plain that the price per yard allowed as damages was the entire profit to the plaintiffs, per yard, in the manufacture and sale of carpets of the patented designs, and not merely the value which the designs contributed to the carpets. There was no evidence as to that value.

It is provided by Section 4,921 of the Revised Statutes, that, in a suit in equity for the infringement of a patent, the plaintiff may, on a decree in his favor, recover the damages he has sustained, in addition to the profits to be accounted for by the defendant, such damages to be assessed by the court, or under its direction, and with the same power to increase the damages, in the discretion of the court, as in the case of verdicts; and the damages intended are "the actual damages sustained," in the language of

Section 4,919. Root *v.* Railway Company, 105 U. S. 189, 212. By Section 4,933 all these provisions apply to patents for designs.

This court has, in a series of decisions, laid down rules as to what are to be regarded as "profits to be accounted for by the defendant," and what as "actual damages," in suits for the infringement of patents; and no rule has been sanctioned which will allow, in the case of a patent for a design for ornamental figures created in the weaving of a carpet, or imprinted on it, the entire profit from the manufacture and sale of the carpet, as profits or damages, including all the profits from carding, spinning, dyeing and weaving, thus regarding the entire profits as due to the figure or pattern, unless it is shown, by reliable evidence, that the entire profit is due to the figure or pattern. It is matter of common knowledge, that there is an infinite variety of patterns in carpets, and that, between two carpets, of equal cost to make, and equal merit as to durability of fabric and fastness of color, each with a pattern pleasing to the taste, one having a design free to be used, and the other a design protected by a patent, the latter may or may not command in the market a price larger than the former. If it does, then the increased price may fairly be attributed to the design; and there is a solid basis of evidence for profits or damages. But short of this, under the rules established by this court, there is no such basis. The same principle is applicable as in patents for inventions. The burden is upon the plaintiff, and if he fails to give the necessary evidence, but resorts instead to inference and conjecture and speculation, he must fail for want of proof. There is another suggestion of great force. The carpet with the infringing design may be made on an infringing loom, and various infringing processes of mechanisms for carding, spinning or dyeing may be used in making it, and, if the entire profit in making and selling it, is necessarily to be attributed to the pattern, so it may as well on principle be attributed to each of the other infringements, and a defendant might be called on to respond many times over for the same amount. There is but one safe rule; to require the actual damages or profits to be established by trustworthy legal proof.

It is not necessary to cite at length from the cases decided by this court on the subject. It is sufficient to refer to them, as follows:—Livingston *v.* Woodworth, 15 How. 546; Seymour *v.* McCormick, 16 How. 480; Mayor *v.* Ransom, 23 How. 487; Mowry *v.* Whitney, 14 Wall, 620; Philp *v.* Nock, 17 Wall 460; Littlefield *v.* Perry, 21 Wall 205; Birdsall *v.* Coolidge, 93 U. S. 64; Cawood Patent, 94 U. S. 695; Blake *v.* Robertson, Id. 728; Garretson *v.* Clark, 111 U. S. 120; S. C. 4 Sup. Ct. Rep. 291; Black *v.* Thorne, 111 U. S. 122; S. C. 4 Sup. Ct. Rep. 326. The true rule, which applies also to a patent for a design, was formulated thus, by this court, in Garretson *v.* Clark: "The patentee must, in every case, give evidence tending to separate or apportion the defendant's profits and the patentee's damages between the patented feature and the unpatented features, and such evidence must be reliable and tangible, and not conjectural or speculative; or he must show, by equally reliable and satisfactory evidence, that the profits and damages are to be calculated on the whole machine. for the reason that the entire value of the whole machine, as a marketable article, is properly and legally attributable to the patented feature." The case of Manufacturing Co. *v.* Cowing, 105 U. S. 253, was a case falling within the last clause of the rule thus stated, and was an exceptional case, as was stated by the chief justice, in the opinion. The general rule was recognized in that case, and the exception was made, in regard to the oil-well gas pump there involved, because there was only a limited and local demand for it, which could not be, and was not, supplied by any other pump.

The rule in question is even more applicable to a patent for a design than to one for mechanism. A design or pattern in ornamentation or shape appeals only to the taste through the eye, and is often a matter of evanescent caprice. The article which embodies it is not necessarily or generally any more serviceable or durable than an article for the same use having a different design or pattern. Approval of the particular design or pattern may very well be one motive for purchasing the article containing it, but the article must have intrinsic merits of quality and structure, to obtain a purchaser, aside from the pattern or design; and to attrib-

ute in law, the entire profit to the pattern, to the exclusion of the other merits, unless it is shown, by evidence, as a fact, that the profit ought to be so attributed, not only violates the statutory rules of "actual damages" and of "profits to be accounted for," but confounds all distinctions between cause and effect.

The decrees must, therefore, all of them, be reversed, as to the damages awarded.

As to No. 1, though the bill was taken as confessed, the defendants take the point that the patent is void on its face, because it has nineteen claims. It has a claim for an entire pattern, and then a separate claim for each of eighteen component parts making up the whole. The bill alleges infringement by the making and selling of the "invention," and of carpets containing the "invention." Even if the defendants can raise this point after a decree *pro confesso*, (see Thomson *v.* Wooster, 114 U. S. 104), the patent must be held valid, at least, for the purposes of this case.

In No. 2, the question of proof of making and selling by the defendants before suit brought is raised. But we think, on the pleadings and all the proof, including the defendants' letter, of April 13, 1880, the case is made out. The point is also taken, that this patent is void, because it has a claim for the entire pattern and three claims for each of three constituent parts of it. No such point is taken in the answer, which speaks of the patent as one for a single design. If the patent-office, in view of the question of fees, and for other reasons, grants a patent for an entire design, with a claim for that, and a claim for each one of various constituent members of it, as a separate design, we see no objection to it, leaving the novelty of the whole and of each part, and the validity of the patent, open to contestation. The mere joinder of such claims in one grant does not *per se* invalidate the patent or any particular claim, at the objection of a defendant.

In No. 3, objection is taken to the patent because it claims "the design for a carpet, substantially as shown." As the bill is the same in form as that in No. 1, and was taken *pro confesso*, the patent is valid, at least for the purposes of this case. Aside from this, we see no good objection to the form of the claim. It refers to the description

as well as to the drawing, in using the word "shown." The objection is also made, as to No. 3, that the patent is for an aggregation of old ornaments, and embodies no invention. This objection is concluded, for this case, by the language of the bill and the decree *pro confesso*.

The final decrees in all of the suits are reversed, and the cases are remanded to the circuit court, with directions to disallow the award of damages in each suit, and to award six cents damages in each, and to allow the defendants a recovery in each case for their costs after interlocutory decree, and to the plaintiff in each case a recovery for its costs to and including interlocutory decree.

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DOBSON *et al. v.* DORNAN *et al.*

Supreme Court of the United States.

Decided April 19, 1886.

118 U. S. Reports, 10.

1. Letters patent for a design for a carpet in which the specification is accompanied by a photographic illustration, and merely states that the nature of the design is fully represented in such illustration, and claims "the configuration of the design hereunto annexed, when applied to carpeting," sets forth a sufficient description and claim, and the patent is valid.

2. An interlocutory decree which awards a recovery for profits and damages for infringement of a patent for a design for carpet, but orders an account of the profits from the manufacture and sale of carpets bearing the design, is not open to the objection taken to the form of the decree that it awards more than the profit from the design.

3. On a question of infringement of a design patent, where the evidence is conflicting, but the court below had the aid of exhibits, this court cannot, in the absence of ocular inspection of such exhibits also, say that the court below erred in its conclusion.

4. The decision in Dobson *v.* Hartford and Bigelow Carpet Co's. (114 U. S. 439) as to the rule of damages in a suit for infringement of a patent for a design, confirmed.

5. The plaintiff must show what profits or damages are attributable to the use of the infringing design.

6. The defendant made no profits on the carpets bearing the infringing design. The Circuit Court allowed damages based on the profit the plaintiff would have realized on the sale of a like number of yards of carpet had he made and sold the same, without any evidence that the plaintiff would have sold the same, or that the design added anything to the price, or promoted the sale of the carpet. Held to be error.

7. On reversal, costs allowed to plaintiff to and including interlocutory decree, and to defendant costs after interlocutory decree.

Appeal from the Circuit Court of the United States for the Eastern District of Pennsylvania.

Hector T. Fenton, and Richard P. White, for appellants.
Ludovic C. Cleeman, for appellees.

Mr. Justice BLATCHFORD delivered the opinion of the Court.

This is a suit in equity brought in February, 1875, by the appellees, trading as Dornan, Maybin & Co., against the appellants, John Dobson & James Dobson, in the Circuit Court of the United States for the Eastern District of Pennsylvania, for the infringement of Letters Patent No. 6,822 for a design for a carpet granted to Charles A. Righter, August 19, 1873, for three and one-half years. The entire specification is as follows: "Be it known that I, Charles A. Righter, of the City of Philadelphia, County of Philadelphia, State of Pennsylvania, have invented and produced a new and original design for carpets, of which the following is a specification. The nature of my design is fully represented in the accompanying photographic illustration, to which reference is made. I claim as my invention the configuration of the design hereunto annexed, when applied to carpeting." The photographic illustration is a six inch square, containing a single figure or design. The only defense set up in the answer is non-infringement. Issue being joined, proofs were taken, and the case was heard, and in April, 1876, a decree was made finding that the patent was valid, and had been infringed, and awarding

to the plaintiffs costs, an account of profits and damages before a master, and a perpetual injunction.

The master made his report in April, 1882. He found that the defendants had made no profits, and stated thus the contending views of the parties as to the proper rule of damages: "The complainants asked to have awarded to them, as damages and compensation for the injury inflicted upon them, whatever profit the defendants may have made, and also whatever loss they, the complainants, had incurred, which could be measured by the profits that would have accrued to them if they had made the exclusive sales of the carpet, deducting in such case the amount of profits, if any, made by the defendants. The defendants, however, contended that all that the complainants were entitled to was not what they, the defendants had made or saved on the carpets, but only what they made or saved by reason of the use of the pattern, as compared with what they could have made without it, and therefore, unless they could sell the carpet bearing the design at a higher price than other carpets, whereby they made more or lost less, no profit resulted to them. They further contend that, unless it was shown by direct evidence that the complainants would have made the sales which the defendants did, had they not infringed, the fact could not be inferred." The Master found that the profit of the plaintiffs consisted in the exclusive use of the invention, and in the monopoly of manufacturing for others to use; that they sold their carpets at from 10 to 15 cents a yard more than the defendants did, and made a profit, in 1874, of $13\frac{3}{4}$ per cent., and in 1875 of $10\frac{3}{4}$ per cent., their average price per yard being more than one dollar; that the defendants might have made an equal profit if they had asked the same prices, and the benefit, gain, or advantage to them might be reasonably estimated as equivalent to the money profit they might have made; that it was to be presumed that the defendants' carpets displaced the plaintiffs' in the market; that it was proper to award to the plaintiffs an amount equal to the profits they could have made in 1874 and 1875, on the carpets made and sold by the defendants, if the plaintiffs themselves had made and sold them; that the defendants made and sold in 1874, 19,243$\frac{1}{2}$ yards, which would have yielded, at one

dollar a yard, $19,243.50, on which the profits of the plaintiffs, at 13¾ per cent., would have been $2,645.97; that the defendants made and sold, in 1875, 31,280½ yards, which would have yielded, at one dollar a yard, $31,280.50, on which the profits of the plaintiffs, at 10¾ per cent., would have been $3,362.65; and that, therefore, the plaintiffs had sustained $6,008.62 damages by the infringement of the patent.

The defendants excepted to the report, but the court confirmed it, and in October, 1882, rendered a decree for the plaintiffs for $6,128.79, from which the defendants have appealed.

It is assigned for error that the patent is void on its face for want of a sufficient description and claim. It was issued under the Act of July 8, 1870, C. 230 (16 St. 198). Sections 71, 72, and 76 of that act provided as follows:

"SECT. 71. Any person who, by his own industry, genius, efforts, and expense has invented or produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented, or described in any printed publication, may, upon payment of the duty required by law, and other due proceedings had, the same as in cases of inventions or discoveries, obtain a patent therefor.

SECT. 72. The Commissioner may dispense with models or of designs when the design can be sufficiently represented by drawings or photographs.

"SECT. 76. All the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries not inconsistent with the provisions of this act, shall apply to patents for designs."

It is contended that Section 26, of the Act of July 8, 1870, applies to the present case. That section provides that, before any person shall receive a patent for his inven-

tion or discovery, he shall file in the patent office a written description of it, and "particularly" point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. It is urged that Section 26 was not complied with in this case, and that the patent is void because it contains no description, and no proper claim. But we are of opinion that the description and claim are sufficient. The purport of the description is that what the photographic illustration represents as a whole is the invention. It is that which is claimed, when applied to carpeting. The design is a pattern to be worked into a carpet, and is within the statute. Claiming the "configuration of the design" is the same thing as claiming the design or the figure or the pattern. It is better represented by the photographic illustration than it could be by any description, and a description would probably not be intelligible without the illustration.

In Dobson *v.* Bigelow Carpet Co., 114 U. S. 439, 446, S. C. 5 Sup. Ct. Rep. 945, the claim of the design patent was "the design for a carpet, substantially as shown." Objection was taken to the form of the claim; but this court said it saw no good objection to the form and that the claim referred to the description as well as the drawing in using the word "shown." The drawing there was a photographic illustration of the body aad border of the carpet, described in the specification as representing a face view; but the description was merely that A was an irregular shield-like figure, surrounded by a border embellished by floral decoration; that B, B were two irregular figures of the same design, but having a different ground color from a, and arranged at opposite sides diagonally of each shield; c, c, were tassel-like ornaments, arranged beneath the several figures a; that d were bouquets, and there were other floral ornamentations; that the border contained an inner plain stripe, f, and an outer zigzag stripe, g, having inwardly projecting semi-circular ornaments, h; that between the stripes, f and g, were representations of shields resembling the shield a, and floral decorations extending over the stripe, f, as shown, and that the tassel-like ornaments, c, were also in the border. Unaided by the illustration, probably many different designs might have been

drawn to which the description would have applied, and the description furnished no aid whatever in identifying the design. So, in the present case, the design is sufficiently identified by the illustration without the aid of any description. In the language of Section 72, before cited, the design is sufficiently represented by the photograph.

Undoubtedly, the claim in this case covers the design as a whole, and not any part of it as a part, and it is to be tested to a whole as to novelty and infringement. The answer admits that Righter was the original and first inventor of the design for which the patent was granted, and does not question the novelty of the invention.

Exception is taken to the form of the interlocutory decreed, in that, while it awards a recovery for the profits and damages from the infringement of the design, it orders an account to be taken of the profits of the defendants from infringing upon the exclusive rights of the plaintiffs "by the manufacture, use, and sale of carpeting bearing said patented design," and of the additional damages suffered by the plaintiffs "by reason of said infringements." We do not think the decree is open to the objection made. It is not like the decree in Littlefield *v.* Perry, 21 Wall 205, 228. It directs an account of the profits from the infringement. The infringement could be committed only by making, using and selling carpets containing the patented design; but the profits and damages to be accounted for are described as only those from the infringement.

It is also contended that the weight of the evidence on the question of infringement was with the defendants. The court below found otherwise. It appears by the record that a piece of carpet (Exhibit No. 2.) was introduced in evidence as containing the patented design; and another piece of carpet (Exhibit No. 3,) as being the defendant's carpet alleged to infringe. Those Exhibits have not been produced on the hearing in this court, although the brief for the appellants states that the circuit court evidently decided the question of infringement with little aid other than ocular inspection of the samples. This court has not the benefit of any such aid. We find, however, in the record, testimony of a witness to the effect that, from his experience as a seller of carpets, he thinks it would be almost

impossible for any one, who had not seen the two carpets together, to tell them apart; and of another witness that, in his opinion, not one consumer in twenty-five would know the difference; and other testimony tending to the same result. While there is evidence contradictory of this, we cannot, in the absence of ocular inspection, take it upon ourselves to say that the circuit court erred in finding infringement.

The only remaining question is that of the amount of damages. The master and the circuit court proceeded on a view which had been adopted by that court in the three cases adjudged by it, the decrees in which were reversed by this court in Dobson *v.* Hartford Carpet Company, 114 U. S. 439; S. C. 5 Sup. Ct. Rep. 945. The present case was decided by the circuit court before such reversal. We are of opinion that the decision cited covers all the questions involved in the case at bar, and requires that the final decree in it should be reversed. In the cases in 114 U. S., the patents being for designs for carpets, it was found that no profits had been made by the defendant, but the circuit court allowed to the plaintiff, as damages, in respect to the yards of infringing carpet made and sold by the defendants, the sum per yard which was the profit of the plaintiff in making and selling carpets with the patented design, there being no evidence as to the value imparted to the carpet by the design. This court held that such award of damages was improper, and that only nominal damages should have been allowed. It is not necessary to recapitulate the views set forth in 114 U. S., which controlled that decision. The present case cannot be distinguished.

It is urged that the principle on which damages are to be computed in respect to a patent for a machine, or for an improvement in a machine, or for a process, is not applicable to a patent for a design, because in a patent for a design the result is patented, while in the other kind of patent the means are patented; that in the design patent there is no other way of effecting the result, while in the other there generally is; and that, therefore, in the design patent the entire profits or damages on the article containing the design are to be given, while in the other, only those be-

longing to the particular improvement patented are to be allowed. But we think all that is here urged is covered by what was said in the cases in 114 U. S. The plaintiff must show what profits or damages are attributable to the use of the infringing design.

In the present case the master found that the plaintiffs' profit on their carpets was a certain percentage, and assumed or presumed that the defendants' carpets, which were far inferior in quality as in market value, displaced those of the plaintiffs' to the extent of the sales by the defendants, and held that the entire profit which the plaintiffs would have received, at such percentage, from the sale of an equal quantity of their own carpets of the same pattern, was the proper measure of their damages. The defendants' carpets were so inferior in quality that they sold them at a much less price than the plaintiffs got for their carpets, and even at those prices the defendants made no profits. Under these circumstances there can be no presumption that the plaintiffs would have sold their better quality of carpets in place of the defendants' poorer quality if the latter had not existed, or that the pattern would have induced the purchasers from the defendants to give to the plaintiffs the higher price. On the contrary, the presumption is at least equal that the cheaper price, and not the pattern, sold the defendants' carpets. There was no satisfactory testimony that those who bought the cheap carpets from the defendants would have bought the higher priced ones from the plaintiffs, or that the design added anything to the defendants' price, or promoted their sale of the particular carpet, and none to show what part of the defendants' price was to be attributed to the design.

It does not evade the force of the principle governing the case that, in arriving at the percentage of profits made by the plaintiffs on their sales, the cost was made up by computing all the items which entered into the production of their carpets. The objection is to taking the whole of that profit as the measure of damages, on the assumption that the whole of it was due solely to the design, and on the further assumption that the plaintiffs would have sold of their higher grade of carpets a quantity equal to the cheaper lower grade carpets sold by the defendants.

The final decree of the circuit court is reversed, and the case is remanded to that court, with direction to disallow the award of damages, and to award six cents damages, and to allow to the defendants a recovery for their costs after interlocutory decree, and to the plaintiffs a recovery for their costs to and including the interlocutory decree.

FIELD, J. I concur in the reversal of the decree, but am of opinion that the patent was invalid, and that the bill should therefore be dismissed.

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TOMKINSON *v.* WILLETS MANUFACTURING CO.

U. S. Circuit Court, Southern District of New York.

Decided March 26, 1888.

34 Fed. Rep. 536.

In an action in equity for infringement of a design patent for the form or configuration of a peculiar, square-shaped vegetable dish, the measure of damages is not the gains derived by defendant from the manufacture and sale of the infringing dishes, but is only that part of the profits which is fairly attributable to plaintiff's design, viz.: that snm which defendants have derived from the adoption of plaintiff's peculiar variety of square-shaped dish, as compared with what he would have derived from the sale of other non-infringing, square-shaped dishes.

This case came on for hearing on defendant's exceptions to master's report, in a suit in equity brought at a previous term (Tomkinson *v.* Willets Manufacturing Company, 23 Fed. Rep. 895), for the infringement of a patent for a design for a vegetable dish, in which case a decree was passed for plaintiff, and the case referred to a master to assess the amount of profits and damages.

Frank V. Brieser, for complainant.
Philo Chase, for defendant.

LACOMBE, J. This is a suit in equity for infringement, founded upon Design Patent No. 13,295, granted to John

Slater, assignor to Gildea & Walker, September 12, 1882, for a design for a vegetable dish. Upon final hearing, before Judge Coxe, it appeared that in a precisely similar suit in the district of New Jersey between the same parties for infringement of this patent, the defendant appeared by its president, and consented to a decree, whereupon, before the commencement of the present suit, judgment was entered, sustaining the patent. Passing upon the effect of such adjudication, Judge Cox says:

That decree was pleaded and proved in this action. It is valid and binding upon the rights of the parties, and as to all the questions determined by it is *res judicata.* Unfortunately, perhaps, for the defendant, the court is not now permitted to consider the defenses which, by the defendant's own action, are thus eliminated from the case. The question of infringement is alone open to investigation. * * * I am constrained to say that the defendant infringes." Tomkinson *v.* Manufacturing Co., 23 Fed. Rep. 895.

It was referred to a Master to take account of the gains and profits, and assess the damages. The Master has duly reported that the complainant is entitled to recover "the gains and advantages derived by the defendant from the use, manufacture, and sale of the infringing dishes, in the sum of $1,853.29." The case now comes up on defendant's exceptions to the Master's report.

The report must be set aside. Even if a method of comparison such as was adopted by the master were conceded to be the proper way in which to accomplish the result sought for—and that question is not now passed upon—he has not selected a suitable standard of comparison. In order to ascertain the profit derived from the use of complainant's model, comparison should be made, not with goods of an entirely different model, but with goods of the most similar pattern, which defendant was free to use. What makes, or rather, what is supposed to make, the design patentable? The circumstance that it is an improvement upon the existing state of the art. The patent covers only the particular advance which the patentee has made; it gives the patentee no rights in what was common property before. It appears that

complainant's patent is for a particular model of square-shaped dish,—for the shape only, not for the decoration. Defendant sold a number of infringing square-shaped dishes, called "Doric." It also sold dishes of a totally different shape—an oval—called "Excelsior." It further appeared that defendant was free to use other square-shaped dishes, and did in fact make a non-infringing square-shaped dish, called the "Piedmont." The entire profit on the "Doric" dishes over cost of manufacture could no doubt be found, but to that entire sum the plaintiff is not entitled. Dobson *v.* Carpet Co., 114 U. S. 440, 5 Sup. Ct. Rep. 945. All he should recover is the amount of such profit which is fairly attributable to his design. Nor is that amount ascertained even by finding what profit the defendant secured by making and selling the infringing square dishes, instead of oval ones. The amount of that profit must be itself, sub-divided into the sums due respectively to the adoption of a square-shaped dish, generally, and to the appropriation of plaintiff's particular variety of square-shaped dish. To the latter sum he is entitled, but its amount is certainly not ascertained by comparing the sales and cost of the infringing dishes with the sales and cost of the oval dishes. *Non constat* but what defendant would have secured 90 per cent. of its "extra profits," as complainant calls them, by sales of such square dishes as it was free to use. If so, the plaintiff would be entitled only to the remaining 10 per cent. as profits resulting from pirating his peculiar square dish. It may be that complainant may find it difficult, if not impossible, to prove the amount of such profit, but that is a difficulty inherent in the particular kind of patent which he holds. One, who by some lucky chance secures a patent for "the mere shadow of a shade of an idea," should not be disappointed if the grant, even though uncontested, subsequently proves of no appreciable pecuniary value.

APPENDIX.

CONTAINING ALL THE REPORTED DECISIONS OF THE COMMISSIONER OF PATENTS, TO DEC. 31, 1888, RELATING TO APPLICATIONS FOR PATENTS FOR DESIGNS; ARRANGED CHRONOLOGICALLY.

TABLE OF DECISIONS

OF COMMISSIONER OF PATENTS, TO DECEMBER 31, 1888, RELATING TO APPLICATIONS FOR DESIGN PATENTS.

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BAILEY, *Ex parte.* **37 O. G., 781**..... 321

Design for Carpet Stretcher. Decided November 9, 1886.

Error in claiming design patent where application should have been for mechanical patent.

BARTHOLOMEW, *Ex parte.* **Com. Dec., 1869, 103**..... 229

Design for Rubber Eraser. Decided December 2, 1869.

Construing Act of March 2, 1861, *Sect.* 11. *Subject-matter of design patents. Unity of design; variations or modifications. Utility defined, and distinguished from utility of mechanical invention. Generic and specific claims. Artistic or æsthetic equivalents. Novel ornamentation, what changes constitute. Configuration, old form applied to new article.* [See decision on application for mechanical patent, Com. Dec., 1871, p. 298.]

BEATTIE, *Ex parte.* **Com. Dec., 1879, 142.**
s. c., 16 O. G., 266..... 299

Design for Spoon Handle. Decided May 3, 1879.

Two or more separate designs cannot be claimed in same patent. Where design is an entirety, claim for the entire design, as well as for sub-combinations of the parts, may be allowed.

BENNAGE *v.* PHILLIPPI *et al.* (Interference.)
Com. Dec., 1876, 135. s. c., 9 O. G., 1159..... 287

Design for Figure of Memorial Hall applied to certain defined articles. Decided June 5, 1876.

Patentability. Arbitrary selection of a known figure or picture applied to ornamentation of toys, etc. Degree of originality required to support design patent.

BROWER, *Ex parte.* **Com. Dec., 1873, 151**..... 277

Design for Inkstands. Decided October 25, 1873.

Division of application, unity of design. Novel form of inkstand and stopper cannot be claimed in same patent.

CARTY, *Ex parte.* **44 O. G., 570**..... 349

Design for Cuffs and Collars. Decided July 9, 1888.

Caveat; statute does not authorize for designs. Design consists of form, contour, or ornamentation, and no entirety thereof can exist in an incomplete condition.

COLLENDER, *Ex parte.* **Com. Dec., 1872, 217**..... 267

Design for Billiard Table. Decided October 2, 1872.

Prior design patent for ornamental configuration no bar to mechanical patent for the plan of construction of the article if it involves utility. [See decision on dissolution of interference, 3 O. G., 91.]

COLLENDER *v.* GRIFFITH. (Interference.)

3 O. G., 91. s. c., Com. Dec., 1873, 14..... 269

Design for Billiard Table. Decided January 30, 1873.

Interference properly declared between design patent and subsequent application of another for mechanical patent showing the design.

COLLENDER *v.* GRIFFITH. (Interference.)

3 O. G., 267. s. c., Com. Dec., 1873, 43..... 270

Design for Billiard Table. Decided March 11, 1873.

Interference between Griffith's design patent of October 6, 1871, *and Collender's subsequent application for mechanical patent. Collender had obtained a previous design patent on June* 6, 1871.

Interference properly declared between application for mechanical patent and a prior design patent, although applicant holds a prior patent for same. Burden of proof on applicant for mechanical patent, although his design patent first shows the invention.

CRANE, JASON, *Ex parte.* **Com. Dec., 1869, 7**..... 225

Design for Fur-set Box. Decided April 20, 1869.

Construing statute of August 29, 1842, *as to subject-matter of design patents. Comprehends utility as well as ornamentation.*

DIFFENDERFER, *Ex parte.* **Com. Dec., 1872, 154**..... 264

Design for Desk Standard. Decided July 8, 1872.

Obverse and reverse of the design should be shown. Function must not form part of claim. If function described, must be eliminated or patent refused.

DOOLITTLE, *Ex parte.* **2 O. G., 275.**

s. c., Com. Dec., 1872, 176. 265

Improvement in Button-hole Cutters. Decided July 31, 1872.

Where form produced functional utility, mechanical and not design patent is proper. Shape or form for æsthetic utility or ornamentation only can be secured by a design patent.

FAIRCHILD, *Ex parte.* **3 O. G., 232.**

s. c., Com. Dec., 1873, 45..... 273

Design for a Sign. Decided March 12, 1873.

Name sign with an imitation gold pen attached to it held patentable as a design. Ex parte *Parkinson, Com. Dec.,* 1871, *page* 251, *distinguished and approved. Description of mechanical construction and utility of purpose must be eliminated from specification.*

FENNO, *Ex parte.* **Com. Dec., 1871, 52..... 250**

Design for Damper for Stove-pipes. Decided February 27, 1871.

Comparison of Act of 1870 *with prior Act of* 1861. *Utility of new form or configuration proper subject of inquiry by Examiner, and necessary to be stated in specification. Functional utility as distinguished from ornamental or æsthetic utility; thought to be included in new Act* (1870).

GERARD, *Ex parte.* **43 O. G., 1235..... 333**

Design for a Plate or Dish. Decided May 22, 1888.

Employment of words "as shown and described" in design patents; effect of. Application cannot embrace more than one subject of invention. Form or configuration cannot be claimed in same patent with surface ornamentation unless, being parts of same article, both unite in producing common result. Design must be an entire, completed, and integral thing; cannot consist of aggregation of separate parts applicable to different uses or purposes. Doctrines of combinations and elements of combinations and genus and species not applicable to designs. Test of infringement is identity of appearance. Objections to non-segregability relate to merits and not to form of application, and appeals therefrom should be to Board of Examiners-in-Chief. A design may, under present statutes, be also the subject of a mechanical patent.

GERARD, *Ex parte.* **43 O. G., 1240..... 346**

Design for Plate or Dish. Decided May 22, 1888.

Relation of genus and species does not exist in designs. Question involved is merely that of identity. Design patent must be limited to a single invention, but may cover variations or modifications that include sufficient of the distinctive features to preserve the identity of the completed design.

HALEY, *Ex parte.* **44 O. G., 1399..... 351**

Design for Glass-ware. Decided July 16, 1888.

Application for three and one-half years patent, abandoned and second application filed for fourteen years patent, request that the fee paid for first be applied as part payment on second, refused.

HARRIS, *Ex parte.* **38 O. G., 104**..... 323

Design for Ornamenting Surface of Walls of Cars. Decided December 22, 1886.

Where design application is rejected by Examiner as not disclosing "proper subject-matter of a design patent," appeal should be to Board of Examiners-in-Chief.

KING, *Ex parte.* **Com. Dec., 1870, 109**..... 245

Design for a Trade-mark. Decided September 19, 1870.

Prior to Act of 1870, *designs intended for trade-marks were patented, not as trade-marks, but such use was only incidental to their patentability as designs. The Act of July* 8, 1870, *Sect.* 71, *which provides a mode of protecting trade-marks by registration, excludes all other modes.*

KOHLER, *Ex parte.* **4 O. G., 53.**
s. c., Com. Dec., 1873, 84..... 274

Design for Shutter Slats. Decided May 17, 1873.

Prior design patent will not bar subsequent mechanical patent for device shown in it, but prior mechanical patent showing design will bar subsequent application for design patent, unless specification of former contains an express reservation of right to claim design shown. Reason is that mechanical is greater than design; former includes the latter, but not the latter the former. Abandonment by implied dedication to public.

LEE & SHEPARD, *Ex parte.* **24 O. G., 1271**..... 309

Application for Registration of Trade-mark on Ornamental Book Cover, previously patented as a design. Decided September 8, 1883.

Design law construed. Previous existing design patent securing to a party exclusive right for a term, of the design shown, precludes Office from granting a trade-mark registration for same subject. [See W. & G. S. M. Co. *v.* Gibbons, 17 Fed. Rep., 623.]

MAYO, *Ex parte.* **Com. Dec., 1870, 14**..... 238

Design for a Transparent Shield. Decided February 23, 1870.

Act of March 2, 1861, *Sect.* 11, *construed. Application for design patent must contain election as to term patent shall issue for, and be accompanied by the fee appropriate for such term. Cannot be amended, after filing, as to term.*

NIEDRINGHAUS, *Ex parte.* **8 O. G., 279**..... 283

Design for Ornamenting Enamelled Iron-ware. Decided December 26, 1874.

Requisites of specification. Statute requires clearness, exactness, and particularly in description and claim. Design must be fixed and determined, and capable of specific description, either in words or by illustration.

NORTON, *Ex parte*, 22 O. G., 1205.
s. c., Com. Dec., 1882, 14..... 306

Design for Machine Frame. Decided June 16, 1882.

Utility in design law means attractiveness. Description of function should be omitted from a design specification.

OGLESBY, *Ex parte*. 3 O. G., 211.
s. c., Com. Dec., 1873, 35..... 272

Design for new form of Saw-tooth for Cotton-gins. Decided February 24, 1873.

New form which gives better appearance merely is subject of design patent, but if it changes or improves its functions, or affects results, it may be subject of mechanical patent.

PALMER, *Ex parte*. 21 O. G., 1111.
s. c., Com. Dec., 1882, 5..... 304

Design for Lamp. Decided November 30, 1881.

Previous mechanical patent showing design is not per se a bar to subsequent design patent. Former decisions to the contrary commented on and disapproved.

PATITZ, *Ex parte*. 25 O. G., 980.
s. c., Com. Dec., 1883, 101..... 316

Design for Sconce Frame. Decided November 19, 1883.

Unity of design. Where there is no necessary connection between designs exhibited in two articles, the fact that they are adapted to be associated together does not constitute a unity of design. Separate applications must be presented for them.

PARKER, *Ex parte*. 13 O. G., 323.
s. c., Com. Dec., 1878, 14..... 294

Design for a Card to be used as a Match Striker. Decided November 13, 1877.

The figure of a boy, together with certain words, on a sample-card, is the subject of design patent. Subject-matter of design patent. Distinguished from trade-marks, labels, and copyrights. Object of law to protect improved appearances adding to the salability and salable value of the article.

PARKINSON, *Ex parte*. Com. Dec., 1871, 251..... 257

Design for Claw-hammer. Decided September 25, 1871.

Æsthetic utility and not functional usefulness is what is contemplated by the design law of July 8, 1870. Ex parte Bartholomew, Com. Dec., 1869, page 103, commented on and disapproved in part. Nor is mere change of form enough; the result must be substantially new, must involve creative genius, and produce a new ornamental effect.

POPE, *Ex parte.* **25 O. G., 290.**
s. c., Com. Dec., 1883, 74 308

Design for Seat-risers. Decided June 30, 1883.

Claim must be restricted to the entire design and distinctive, segregable, integral parts thereof. Claims for portions capable of being attached to different forms, to make up an entire whole, are inadmissible.

PRESSPRICH, *Ex parte.* **11 O. G., 195** 294

Design for Instrument for Regulating Pressure of Gas. Decided February 1, 1877.

Decision of Primary Examiner, that application does not present subject-matter for design patent, goes to the merits, and is appealable to the Examiners-in-Chief.

PROUDFIT, *Ex parte.* **10 O. G., 585** 292

Design for Bill-heads. Decided September 28, 1876.

Rejection, on ground of non-patentability as a design, is not interlocutory, but goes to the merits, and hence is appealable to the Examiners-in-Chief.

ROGERS *et al., Ex parte.* **13 O. G., 596.**
s. c., Com. Dec., 1878, 62 298

Design for Casket Screw. Decided April 2, 1878.

Unity of design. Claims for whole and for each subordinate segregable feature, allowable.

SCHULZE-BERGE, *Ex parte.* **42 O. G., 293** 324

Improvement in Corrugated Glass. Decided January 5, 1888.

Rejection by Examiner on ground that matter is patentable by mechanical, and not by design patent, goes to the merits, and is appealable to the Examiners-in-Chief. Utility not used in same sense in design law as for mechanical inventions; defined and distinguished.

SEAMAN, *Ex parte.* **4 O. G., 691** 279

Design for Lamp-chimney Cleaner. Decided January 5, 1874.

"Useful" shape in design statute relates to utility of ornamental form and appearance, rather than to operative function.

SELLERS, *Ex parte.* **Com. Dec., 1870, 58** 242

Design for Rolled Hollow Hexagonal Column. Decided June 8, 1870.

Pending application for mechanical patent cannot be changed by amendment into an application for a design patent. Reasons stated. Patent to alien. Design patent has to do with form or configuration, not with materials or mode of construction.

SHEPPARD, *Ex parte.* **Com. Dec., 1870, 22..... 241**

Design for Stove Ornaments. Decided March 8, 1870.

Nothing in design law forbids two or more claims or clauses of claim in same patent. Previous practice of the Office on the subject reviewed.

SHOENINGER, *Ex parte.* **15 O. G., 384.**
s. c., Com. Dec., 1878, 128..... 301

Design for Sled. Decided November 20, 1878.

The Revised Statutes authorize design patents for new and useful forms, irrespective of whether they are or are not ornamental. "Useful" was first used in the Act of 1870. *Previous Acts compared with Act of* 1870, *as to scope of patentable subject-matter. Previous Commissioners decisions under the several Acts reviewed and compared.*

SOLOMON, Exec'r, *Ex parte.* **Com. Dec., 1869, 49..... 227**

Design for Inkstand. Decided August 17, 1869.

The Acts of 1842 *and* 1861 *are not confined to ornamental forms, but extend to those intended to promote convenience or utility.*

SPERRY, *Ex parte.* **Com. Dec., 1870, 139..... 248**

Design for Knife-handle. Decided October 28, 1870.

Extensions allowed under Act of 1870 *of patents issued prior to March* 2, 1861, *but none as to patents granted between those dates.*

STETSON, *Ex parte.* **36 O. G., 343..... 317**

Design for Dial for Time-piece. Decided May 26, 1884.

Numerals as part of design. Arrangement thereof not patentable, but form may be.

STUART & BRIDGE, *Ex parte.* **Com. Dec., 1870, 15..... 239**

Design for Cooking Stove. Decided February 23, 1870.

Mechanical patent cannot be reissued in divisions, one for the mechanical features and the other for the design. Reasons stated. Previous mechanical patent is a complete bar to grant of subsequent design patent. Under Act of 1861, *there must be no use or knowledge by others prior to application; different in this respect from mechanical invention which may be known for not exceeding two years.*

TRAITEL, *Ex parte.* **25 O. G., 783.**
s. c., Com. Dec., 1883, 92..... 311

Design for Finger Rings. Decided November 12, 1883.

A design consists merely of delineation of form or figure. Material and color form no part of it that is patentable.

TYLER, *Ex parte.* **Com. Dec., 1871, 106..... 253**

Design for Clock Case. Decided April 27, 1871.

Form or ornamentation, but not material, alone affect the question of novelty and patentability.

WEINBERG, *Ex parte.* **Com. Dec., 1871, 244..... 255**

Design for Muffs. Decided September 6, 1871.

Design patents not intended for protection of trade-marks. Must be inventive genius involved to support design patent. Mere substitution of colors not patentable, nor any blending or arrangement of colors, unless producing a new æsthetical effect.

WHYTE, *Ex parte.* **Com. Dec., 1871, 304..... 260**

Design for Ornamental Prints for Fabrics. Decided November 28, 1871.

Design intended for trade-mark not patentable under Act of 1870. *Suggested that specification should specify the article or class of goods to which design is to be applied.*

Ex parte JASON CRANE

Decided April 20, 1869.

Com. Dec., 1869, page 7.

In the matter of the application of Jason Crane for a patent for a Design for a Fur-set Box.

The construction heretofore given by the Office to the design statute since its passage in 1842, that it relates solely to designs of an artistic character as contradistinguished to those of convenience or utility, is too narrow, as the objects and intent of the law fairly and properly embrace those relating to utility merely, as well as ornament.

Foote, Commissioner:

The applicant designed a paper box, with compartments conveniently arranged for holding each of the articles composing a set of ladies' furs. It is neat in appearance, as well as convenient in use, and has commanded a preference in the market over other boxes for that purpose.

It was at first claimed that the new arrangement of the compartments was the proper subject of a general patent. This was denied by the office on the ground that, although skill and good taste had been displayed in designing the article, it did not come up to what might properly be termed a "new invention." A more limited patent is now asked for the design, and the question is presented whether the case comes within the statute relating to design patents.

The construction which has been given to that act by the office ever since its passage in 1842, is that it relates to designs for ornament merely; something of an artistic character as contradistinguished to those of convenience or utility. It was upon this view of the statute that the application was rejected by the examiner in charge, and, on appeal, by the board of examiners-in-chief. No judicial construction has yet been given to this part of the act.

Considerable reflection upon the subject has satisfied me that the objects and intent of the statute extend beyond the limit assigned to it by the office.

It provides, among other things, that any citizen "who by his industry, genius, efforts, and expense may have invented or produced any new and original design for a manufacture," or * * * "any new and orginal shape or configuration of any article of manufacture," may obtain a patent therefor. It does not say "ornamental" design, or "artistic" shape or configuration, and I am unable to perceive any good reasons why designs for utility are not fairly and properly embraced within the statute, as well as those relating to ornamentation merely.

The line of distinction between what is useful and what is merely ornamental is, in some cases, very definite. By some it is said that any form or design that is most useful is also most pleasing. It would be impossible, in the view of such persons, to make any improvement in utility that did not at the same time add to the ornamental and artistic.

I can perceive no necessity for the distinction. There is a large class of improvements in manufactured articles that are not regarded as inventions, or as coming within the scope of general patent laws. They add to the market value and saleability of such articles, and often result from the exercise of much labor, genius, and expense. They promote the best interests of the country, as well as the creations of inventive talent. It seems to me to have been the intent of Congress to extend to all such cases a limited protection and encouragement. Whenever there shall be produced by the exercise of industry, genius, efforts, and expense any new and original design, form, configuration, or arrangement of a manufactured article, it comes within the provisions and objects of the act creating design patents, whatever be its nature, and whether made for ornament merely, or intended to promote convenience and utility.

The construction given to the statute by the board of appeals seems to me to be erroneous, and I accordingly overrule their decision.

Ex parte B. L. SOLOMON, EXECUTOR OF MYER PHINEAS.

Decided August 17, 1869.

Com. Dec., 1869, page 49.

In the matter of the application of Burnet L. Solomon, executor of the last will and testament of Myer Phineas, deceased, for the extension of a patent for a Design for an Inkstand, granted to the said Myer Phineas, August 19, 1862.

1. While the doctrine of the Office formerly, was that a design patent contemplated artistic excellence only, it is now held to be proper to grant such a patent for an article whether made for ornament merely, or intended to promote convenience or utility.

2. Both the value of the artistic excellence, as well as that of the functional usefulness of the article, taken into consideration, on application for extension in this case.

Hodges, Acting Commissioner:

The petitioner has shown his compliance with all the requirements of the office, with perhaps a single exception. It may be questioned whether he has made out that his testator's invention is of sufficient value and importance to the public to entitle him to an extension.

He has filed a number of affidavits, which fully establish the merit of the inkstand his testator devised and manufactured, and satisfy us that, if the article itself was the thing patented, it deserves to be further protected. It does not follow, however, that the mere design is equally meritorious.

The doctrine of the office has been, for a long time, that a patent for a design like the one before us could only be issued for articles possessed of artistic excellence, and that nothing else could be monopolized under such a patent. The advantages obtained in consequence of its mechanical construction were not supposed to enter into consideration. It was the "configuration" and not the construction which was held to be embraced in the grant.

Now, the affidavits filed by the petitioner all take into

account, in estimating the utility and value of his intestate's invention, the mechanical advantages of the article as constructed. They instance the ink being protected from the air; its being supplied automatically to the fountain; the cup for holding a sponge; and other peculiarities of a like nature. Some of the most important of these qualities are as old as the ancient fountain inkstand, and have long been public property; and none of them could be considered, according to the former practice, as constituting any part of the invention, or as enhancing its value.

It is true that the affidavits also speak of the merit of the design as a design merely, and include that in the estimates. But there is no attempt to discriminate the respective merits, so that it can be seen what valuation was set upon the artistic excellence of the design, as distinguished from its other advantages. If the Commissioner were to inquire whether that artistic excellence alone is so great as to justify the extension prayed for, he would have no data upon which he could proceed. He could only say that its value is so much when taken together with its usual functions—not what it is worth in itself.

But it is now held that "any new and original design, form, configuration, or arrangement of a manufactured article" comes within the scope of the Act of 1842 (and, of course, within that of 1861, Sect. 11), "whether made for ornament merely, or intended to promote convenience or utility." Under the circumstances, it must be assumed that this is the present doctrine of the office. It has a vital bearing upon the case before us, and gives a new significance and effect to the affidavits which have been filed. The patent under consideration covers, under this rule, not only the beauty of the inkstand in point of form, but also all those advantages in point of utility and convenience, which result from its configuration, by which, in this connection, must be intended its construction. Some of these are old, it is true, but the combination of the whole is new. All the peculiarities enumerated by the affiants unite to give value to the article, and are proper elements to be taken into account in estimating it; and the opinions they give of its value become a just and proper basis upon which the Commissioner can form his own conclusion. They are so

full and explicit as to remove all doubt upon this point, in this view of the law.

The question of value is the only serious one in the case. No other objection seems to exist against granting the prayer of the petitioner, and his testator's patent is, therefore, extended.

—o—

Ex parte WILLIAM N. BARTHOLOMEW, ASSIGNOR TO J. BECKENDORFER.

Decided December 2, 1869.

Com. Dec., 1869, page 103.

In the matter of the application of William N. Bartholomew, assignor to J. Beckendorfer, for letters patent for a Design for Rubber Eraser.

1. The Office has heretofore correctly construed the Act of 1861, as well as the previous Statute of 1842, to include designs consisting of form or configuration which, whether involving artistic excellence or not, involve increase of utility; and this even where the sole utility of the new device arises from its novel shape or configuration.

2. There is no apparent reason, under the law, why designs may not be generic, why what are called "broad claims" may not be made to them, and why the doctrine of artistic or æsthetic equivalents may not be applied to them.

3. A design may be so generic in its character as to admit of many variations, which should embody its substantial characteristics and be entirely consistent with a substantial identity of form.

4. As the form is alone the thing patented, it is immaterial by what process that form is attained. The composition of matter or the mode of construction, must be protected by a patent of a different kind.

5. An old form may be so applied to a distinct article of manufacture as to make it technically a new article, and constitute the subject of a valid design patent.

Fisher, Commissioner:

Letters patent for designs have increased in importance within the last few years. Formerly, but few were granted; now, many are issued. To this day they have made so little figure in litigation that but three reported cases are known, in which design patents have come into controversy. With their increase, questions have arisen concerning their scope and character, which have given rise to dispute and to inquiry as to the correctness of the current practice of the office in this branch of invention. While, on the one hand, it is insisted that the practice has always been uniform, and is therefore now fixed and definite, on the other it is asserted that there has never been, and is not now, any well defined or uniform practice either in the granting or refusal of design patents.

The Act of 1836 made no provision for the patenting of designs. The earliest legislation upon this subject is found in the Act of August 29, 1842, section 3; and the only legislation upon the subject is found in this section and in section 11 of the Act of March 2, 1861.

The definition of the subject-matter, or, in other words, of a "design," is the same in both acts. It is as follows:

"That any citizen, etc., who by his, her, or their own industry, genius, efforts and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, and original designs for a bust, statue, bas-relief, or composition in alto or basso-relievo, or any new and original impression being formed in marble or other material, or any new and useful pattern, print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others," &c.

This definition embraces five particulars:

1. A new and original design for a manufacture.

2. An original design for a bust, statue, &c.

3. A new and original impression or ornament to be placed on any article of manufacture.

4. A new and useful pattern, print, or picture, to be

worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture.

5. A new and original shape or configuration of any article of manufacture.

The first three of these classes would seem to refer to ornament only; the fourth, to ornament combined with utility, as in the case of trade-marks; and the fifth, to new shapes or forms of manufactured articles, which, for some reasons, were preferable to those previously adopted.

The disputed questions which have thus far arisen under these definitions, are: (1) What variations may be claimed or covered by the patent, consistently with unity of design? (2) Is a new shape of an article of manufacture, whereby utility is secured, a subject of protection under this act? and (3) Is mechanical function of any kind covered by it?

As to the first of these questions, it seems to have been assumed that the design spoken of in all parts of the sections referred, to covered a fixed, unchangeable figure; that the protection of the letters patent did not extend to any variation, however slight, but that such variation constituted a new design, might be covered by a new patent, and might safely be used without infringement of the first. This, it is said, is the correct theory of the law, and has been the uniform adjudication of the office.

Neither of these statements is absolutely correct. The law by no means defines a design with such strictness. The language is, "new and original design for a manufacture," "new and original impression or ornament," "new and original shape or configuration." It would seem to be too plain for argument that the new design, or impression, or shape, might be so generic in its character as to admit of many variations, which should embody its substantial characteristics and be entirely consistent with a substantial identity of form. Thus, if the invention were of a design for an ornamental button, the face of which was grooved with radial rays, it would seem that the first designer of such a button might properly describe a button of five rays, and, having stated that a greater number of rays might be used, might claim a design consisting generally of radial rays, or of "five or more" rays, and that it could not be necessary for him to take out a patent for

each additional ray that could be cut upon his button. So, if the design were the ornamentation of long combs by a chain of pearls, it would seem that a claim for such a design might be maintained against one who arranged the pearls either in curved or straight lines, or who used half pearls only; and that such modifications, if they had occurred to the designer, might properly have been enumerated in his specification as possible and equivalent variations. In short, I can see no reason, under the law, why designs may not be generic, why what are called "broad claims" may not be made to them, and why the doctrine of artistic or æsthetic equivalents may not be applied to them.

This has been recognized to a greater or less extent in the adjudication of the courts and in the practice of the office. One of the reported cases is that of Booth *v.* Garelly, 1 Blatchf. 247. The design is described as consisting of "radially formed ornaments on the face of the moulds or blocks of which the button is formed, combined with the mode of winding the covering on the same, substantially as set forth, whether the covering be of one or more colors." The specification, in "substantially" setting forth the design, contained this language: "It will be obvious from the foregoing that the figures can be changed at pleasure, by giving the desired form to the face of the mould, by depressions and elevations which radiate from a point, whether in the center of the mould or eccentric thereto." In the consideration of the case by the court, no objection was made to this statement or claim. In the case of Root *v.* Ball, 4 McLean, 180, the learned judge instructed the jury that "if they should find that the defendant had infringed the plaintiff's patent by using substantially the same device, as ornamental, on the same part of the stove, they would, of course, find the defendant guilty. To infringe a patent right, it is not necessary that the thing patented should be adopted in every particular; but if, as in the present case, the design and figures were substantially adopted by the defendants, they have infringed the plaintiff's right. If they adopt the same principle, the defendants are guilty."

"The principle of a machine is that combination of mechanical powers which produces a certain result. And,

in a case like the present, where ornaments are used for a stove, it is an infringement to adopt the design so as to produce substantially the same appearance."

It has been the constant practice to grant patents for designs for fonts of type, for sets of silver plate, for a series of printers' flourishes, and the like. This class of cases has always passed without objection. Two other cases which have arisen within the office deserve notice. The first was for a series of miniature shoulder-straps, with emblems denoting rank, provided with a pin, to be worn under an officer's coat, upon his vest, or as a lady's breastpin. The drawing shows eight of these pins with emblems of rank, varying from that of second lieutenant to major-general; and the specification, describing the brooch for a second lieutenant, goes on to say: "I propose to introduce on some of them the different ornaments showing the respective ranks of the army from a major-generalship to a second lieutenancy. See figures 2, 3, 4, 5, 6, 7, 8."

The second case was that of an application for a monogram visiting card, on which the name was to be inscribed or printed in the form of a monogram. The applicant filed a drawing, showing a card upon which was a monogram of his own name. In his specification he gives certain rules for forming such monograms, and then says: "It is manifest that the form of the letters, as well as the letters themselves, can be changed as required by circumstances or the taste of the individual for whom the monogram is designed; and that the general form and outline of the monogram may be varied, and, indeed, must vary to be adapted to the particular name it is required to represent." The claim was for "a monogram visiting card, or visiting card upon which the name is inscribed or printed in the form of a monogram, substantially as herein specified." This application was rejected by the examiner and board of examiners-in-chief, but was allowed by the Commissioner upon appeal.

It is true that, before and since this patent was issued, many patents have been refused, for what I have called generic designs. One man, having designed a tack-head ornamented with radial lines, was compelled to take out one patent for his tack with six radial lines, and another for the

same tack with eight. There are other instances of like character, but they only serve to show that the practice of the office has not been uniform, and that the true practice is still to be adopted and followed.

I have no hesitation in saying, in view of the premises, that a valid patent may be granted for a new genus or class of ornaments, as well as for specific ornaments, though I do not doubt that, under the statute, every species, variety, and individual having distinct characteristics, under such a genus, might also be patented, the patent being subordinate and tributary to that which covered the class.

From the nature of this subject matter, there must always be more latitude in the issue of patents for trifling changes of form or outline, since it is only necessary that such changes should constitute a new design to entitle them to a patent of this class.

The second question relates to the element of utility in patents for designs.

Upon this point, it is said by my predecessor, in Jason Crane, *ex parte*, Commissioner's decisions, May, 1869, p. 1, "that the construction which has been given to the Act of 1842 by the office, ever since its passage, is that it relates to designs for ornament merely; something of an artistic character as contradistinguished to those of convenience or utility."

The board of examiners-in-chief, in the present case, say: "The practice of the office has been uniform from the beginning, and has always excluded cases like the present from the benefit of the laws relating to designs." And again, "The general understanding has always been that the Acts of 1842 and 1861 were intended to cover articles making pretensions to artistic excellence, exclusively."

In thus denying that a new "shape or configuration" of an article, whereby utility or convenience is promoted, is the proper subject of a patent, under the acts referred to, the office would seem to have involved itself in the absurdity that if a design is useless it may be patented, whereas if it be useful it is entitled to no protection.

Fortunately, no such "uniform practice" has existed, and the office is relieved from so grievous an imputation. The practice seems to have been taken for granted by the

appellate tribunals; and so far from being as stated, is, as nearly as possible, the reverse of it.

Articles have been, and are being constantly, patented as designs which possess no element of the artistic or ornamental, but are valuable solely because, by a new shape or configuration, they possess more utility than the prior forms of like articles.

Of this character are designs for axe-heads, for reflectors, for lamp shades, for the soles of boots and shoes, which have been heretofore patented as designs; and to this class might be added with great propriety that class of so-called "mechanical" patents granted for mere changes of form, such as plowshares, fan blowers, propeller blades, and others of like character.

When, therefore, my learned predecessor in Crane's case added to this number a box so designed as to hold, with convenience, a set of furs, he did but confirm, and not alter, the practice of the office, so far as it can be gleaned from the patented cases.

I am of opinion that the class of cases named in the act arising from "new shape or configuration," includes within it all those new changes of form which involve increase of utility. This I take to be the spirit of the decision in Wooster *v.* Crane, 2 Fisher, 583. The design was of a reel in the shape of a rhombus. The learned judge says: "In this case the reel itself, as an article of manufacture, is conceded to be old and not the subject of a patent. The shape applied to it by the complainant is also an old, well-known mathematical figure. Now, although it does not appear that any person ever before applied this particular shape to this particular article, I cannot think that the act quoted above was intended to secure to the complainant an exclusive right to use this well-known figure in the manufacture of reels. The act, although it does not require utility in order to secure the benefit of its provisions, does require that the shape produced shall be the result of industry, effort, genius, or expense, and must also, I think, be held to require that the shape or configuration sought to be secured shall at least be new and original as applied to articles of manufacture. But here the shape is a common one in many articles of manufacture, and its application to

a reel cannot fairly be said to be the result of industry, genius, effort, and expense. No advantage whatever is pretended to be derived from the adoption of the torm selected by the complainant, except the incidental one of using it as a trade-mark. Its selection can hardly be said to be the result of effort even; it was simply an arbitrary, chance selection of one of many well-known shapes, all equally well adapted to the purpose. To hold that such an application of a common form can be secured by letters patent, would be giving the Act of 1861 a construction broader than I am willing to give it."

It would seem from this language that if there had been "advantage," *i. e.*, utility, in the adoption of the form of the rhombus it would have found more favor in the eyes of the court.

This subject has been well discussed in the opinion of Commissioner Foote, in Crane, *ex parte*. I concur in that opinion; except as to the recital of the former practice of the office, which a careful examination has shown to be erroneous.

The third question may be readily disposed of. Modes of operation or construction, principles of action, combination to secure novelty or utility of movement, or compositions of matter, can hardly be said to be "shapes, configurations, or designs," but where the sole utility of the new device arises from its new shape or configuration, I think it may fairly be included among the subjects which the act of 1842 was designed to protect.

The present case may, in view of the foregoing considerations, be disposed of without difficulty. Letters patent are asked by applicant for a new design for a rubber eraser, which consists in giving to the eraser a cylindrical body, with ends beveled to an edge. The claim is for the "cylindrical rubber eraser, provided with a wrapper or case, as herein shown and described." In the body of the specification, the applicant describes the mode of making the eraser, and he also enumerates its advantages over erasers of the ordinary forms. The examiner does not object to the application because of the utility of the eraser. although the board of examiners-in-chief seem to base their decision upon that point alone, but he pronounces the form already

old in its application to artists' stumps, and he insists that the mode of composition or construction can form no element of the claim for a design patent.

In the latter statement he is undoubtedly right. These patents are granted solely for new shapes or forms, and the form being new it is immaterial by what process that form is attained. The composition of matter or the mode of construction is neither "design," "shape," nor "configuration," and must be protected, if at all, under a patent of another kind.

I cannot say that the presence of such matter in the specification would be objectionable, if descriptive merely, but it could in no way be allowed to enter into or modify the claim.

As to the first ground of rejection, I think the examiner is in error. This purports to be a new form or shape of a distinct article of manufacture, to wit: rubber erasers. If it be new, as thus applied, it is immaterial whether pencils, or stumps or penhandles, or anything else, may or may not have been made cylindrical. If they are not substantially the same articles of manufacture as erasers, the old form applied to this new article is unquestionably entitled to protection.

The applicant has not defined his invention with entire accuracy. He should strike from his claim the words "provided with a wrapper or case," as these relate to construction, and not configuration; and he should insert the words, "having the ends beveled to an edge," in lieu of the phrase erased, or he should adopt the usual form of claims for designs, viz.: "The design for a rubber eraser as shown and described."

As the claim stands, it ought not to be allowed, and the decision must be affirmed; but the applicant will be allowed to amend as suggested.

Ex parte ISRAEL C. MAYO.

Decided February 23, 1870.

Com. Dec., 1870, p. 14.

In the matter of the application of Israel C. Mayo, for letters patent for a Design for a Transparent Shield.

Application for design patent, under Act of 1861, must contain an election as to the term of patent desired. No amendment in this respect is permissible under the statute.

Fisher, Commissioner:

The applicant makes application for a patent for a design. He pays ten dollars into the treasury, and adds to his petition the following proviso: Should the commissioner be willing to allow a patent on this application, the undersigned wishes to pay into the treasury the further sum of twenty dollars, and have such patent granted for fourteen years, instead of three and a half years."

Section 11 of the Act of March 2, 1861, provides that upon application for a patent for a design, "the commissioner, on due proceedings had, may grant a patent therefore, as in the case now of application for a patent, for the term of three and one-half years, or for the term of seven years, or for the term of fourteen years, as the said applicant may elect in his application; provided, that the fee to be paid in such application shall be for the term of three years and six months, ten dollars; for seven years, fifteen dollars; and for fourteen years, thirty dollars."

This language contemplates an election to be made by the applicant, at the time of his application, of the term for which he desires his patent to issue, and the payment of a fee corresponding to that election. It does not contemplate the contingency of an application for one term and the payment of one fee, and a subsequent election, at the time of issue, of another term and the payment of another fee. The words are "elect in his application." The choice is to be made there, and not elsewhere or otherwise, and being made must be final.

I can see that the practice proposed might be desirable, and might result in the granting of design patents for a longer period, and the receipt of a larger revenue; but I have no power to alter the plain language of the statute, or to extend the time of election beyond the time of making the application, for any purpose.

In the present case the applicant has paid a fee of ten dollars. His patent, if granted, can issue only for three and a half years.

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Ex parte STUART & BRIDGE,

Decided February 23, 1870.

Com. Dec. 1870, p. 15.

In the matter of the application of David Stuart and Lewis Bridge for letters patent for a Design for a Cooking Stove.

1. Previous mechanical patent describing the design granted either to the inventor or to others, will bar a subsequent design patent therefor, as under the Statute of 1861, it must not be known or used prior to application for patent, and no provision is made for a permissible use or sale prior thereto as in case of other inventions.

2. The Act of 1836 allowing reissues, do not authorize reissues in divisions, one of which shall be for the design shown in the mechanical patent surrendered. Reasons stated.

Fisher, Commissioner:

The applicants, on November 3, 1868, patented the arrangement of ovens and flue in a cook stove having a peculiar external conformation. On February 5, 1870, they filed an application for a design substantially identical with that shown in their patent of 1868.

Upon this state of facts the examiner asks: 1. Should the application be rejected on the patent? 2. If so, can the patentees reissue in two divisions, one of which shall be for the design? 3. If so, what fees are required?

Section 11 of the Act of March 2, 1861, provides that the new design, &c., shall not be "known or used by others

before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor," &c.

It will be observed that no provision is made, for use or sale of the invention prior to the application, as in the case of other inventions; and the reason of the distinction is found in the fact that as designs relate to form and shape only, no time is required for experiment before the application. At all events, the language of the statute is plain. The design must not have been known or used by others prior to the application of the inventor. It is obvious that if the design be described in a prior patent, granted either to himself or others, it is known to others within the meaning of the law. The present application must therefore be rejected upon the former patent.

The second question is, whether the original patent can be surrendered and reissued in two divisions, one of which shall be for the design.

Patents for designs may be granted for three and one-half, seven, or fourteen years, at the election of the applicant, made at the time of application. Patents for other inventions are granted for seventeen years.

The patent granted to applicants in November, 1868, was of the latter kind, and was granted for seventeen years.

It is provided by Section 13 of the Act of 1836 that upon applications for reissue "it shall be lawful for the commissioner, &c., to cause a new patent to be issued to the said inventor for the same invention, for the residue of the period, then unexpired, for which the original patent was granted."

This language is explicit, and it is obvious that under this section any reissue of this patent, or any division of such reissue, must be granted "for the residue of the period then unexpired for which the original patent was granted;" that is, for the residue of seventeen years. But no patent for a design can be granted for seventeen years, or for the residue of an unexpired period of seventeen years; and this fact seems decisive of the question.

The result is that an invention of a design, if shown in a patent for a mechanical invention, is lost, and cannot be included in a subsequent application and patent for a design.

Ex parte ISAAC A. SHEPPARD.

Decided March 8, 1870.

Com. Dec. 1870, p. 22.

In the matter of the application of Isaac A. Sheppard for letters patent for a Design for a Stove Ornament.

There is nothing in the design statute forbidding two or more claims in same patent. If the design contains features which are new, singly and in combination, they may be so claimed, both upon reason and precedent.

Fisher, Commissioner:

This case is referred to me by the primary examiner upon the following statement:

"In this application for patent for design of Isaac A. Sheppard, filed February 24, 1870, are found two claims: one for the central figure (which constitutes the gist of the case), when cast on and forming a part of a stove plate, and the other for the central figure and surrounding ornaments.

"In dealing with this case, the examiner finds that it has not been the usual practice of the office to allow more than one claim in an application for a patent for a design. The reasons generally given to sustain this course of action are that a design is a complete and individual device or ornament, and as such must be exact and perfect in every form, line, or configuration, the slightest deviation from what is represented operating to make a new design.

"The law evidently makes no such inflexible rule of official practice. In the Bartholomew case, Commissioner's Decisions, 1869, p. 111, it is observed that a certain reasonable and proper latitude is given in judging what does and what does not breathe the spirit of the invention in any given case, and that mere colorable variation is to receive no more countenance or favor in an application for a patent for a design than it would in an application for a mechanical device.

"But while the examiner is impressed with these views, he is unwilling in his first decisions, in applications of the

present character, to overrule, so far as falls within his jurisdiction, the generally settled custom and rule of the office in the above particular. He desires, therefore, to refer the whole matter to the personal consideration of the commissioner, as a question of office practice for his decision or direction.

"L. DEANE, *Examiner.*"

I agree with the examiner that there is no provision in, or fair construction of, the act relating to letters patent for designs, which forbids the union of two or more claims or clauses of claim in a single patent. I am at a loss to know upon what ground such a construction can be asserted or maintained. If the design contains features which are new, singly and in combination, no reason is known to me why they may not be so claimed.

But the practice of the office has not been so uniformly adverse to the granting of double claims as seems to have been supposed. On the contrary, letters patent for designs containing more than one claim were granted in the years 1855, 1857, 1858, 1859, 1860, and 1862, and doubtless in the succeeding years, if time had permitted a further examination. Among these, special reference is made to the patent granted to Appollos Richmond, in 1859, which contains one claim for the configuration of a stove plate, and another for the ornament upon the same plate; and to the patent granted to Isaac B. Woodruff, in 1862, for a design for a clock-case, which contains one claim for the configuration of the whole case, and another for a gilt frame forming a subordinate part of the same whole.

These cases fully justify the claims presented in the present application, which may, therefore, be allowed, both upon reason and precedent.

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Ex parte GEORGE H. SELLERS,

Decided June 8, 1870.

Com. Dec. 1870, p. 58.

In the matter of the application of George H. Sellers for letters patent for Improvement in Rolled Hollow Hexagonal Column.

1. An application for mechanical patent cannot be changed, by amendment, into one for a design patent. It is not a matter of classification, nor within the discretion of the Commissioner.

2. Whether an invention is within either class defined by the several statutes, is matter of legal determination, and an error is fatal.

3. Novel configuration is independent of materials or mode of construction. If shape is old as applied to the article, its production by a novel process, or with novel material, will not constitute patentable design novelty.

Fisher, Commissioner:

Applicant filed in September, 1868, an application for a patent for "a new and useful improvement in a rolled hollow hexagonal column." He claimed, in terms, "a hollow column of uniform thickness, hexagonal in both its interior and exterior, and rolled out from a solid or welded pile or billet of iron or steel, with a hexagonal opening through it, substantially as described and represented."

Becoming satisfied that he could not succeed in obtaining a patent for his supposed invention in this shape, he now proposes to change his application into one for a patent for a design. He asks to be allowed to deposit a further fee of $15, making $30 in all. He avers that it was by inadvertence and mistake that the fee of $30 was not paid originally, and the application made in terms for a patent for a design, under Section 11 of the Act of March 2, 1861. He presents an amended specification in which the invention is described as a "new and original shape or confiuration of steel or wrought-iron rolled pipes, tubes, or hollow shafts or pillars," and is claimed in the following terms: "as a new and original shape or configuration of tubes, pipes, hollow shafts or hollow pillars or posts of steel, or of wrought or malleable iron, a machine-rolled tube or pipe or hollow shaft or hollow post, of uniform and symmetrical hexagonal perimeter, area, and cross section, in every part of its length, and having no projections upon its surface or beyond its angles."

In support of his prayer he urges that the question whether his patent be for an invention of a design is merely one of classification, which is within the discretion

of the commissioner, and he insists that this is a case in which that discretion ought to be exercised in his favor.

Prior to the Act of August 29, 1842, there was no law which permitted the granting of letters patent for "shapes," "configurations," "designs," "ornaments," patterns," and the like, which did not involve some mechanical principle or amount to a new machine or manufacture within the meaning of the patent law.

By that act and the Act of March 12, 1861, these subjects were made patentable, not by enlarging the scope of the existing patent laws by the addition of new subjects of invention, but by independent legislation, providing for a new class of patents, granted to a different class of persons, for a different class of subjects, for different periods of time, and upon the payment of different fees.

It is not a matter of discretion with the commissioner whether the subject of an application be a machine, or a design for a manufacture; a manufacture, or a new and original shape or configuration of an article of manufacture; a composition of matter, or a composition in alto or basso-relievo, an art, or a pattern, print or picture. It is a matter of law in which a mistake is fatal. These subjects of invention or contrivance are in truth as distinct from each other as either is from a copyright.

The applicant treats this matter as if it were simply a matter of mistake as to the term for which he should have applied for letters patent; but in truth the error, if error there were, was in the character of the application itself. He applied for a patent for a new product, paying the fee for an examination, and praying for a patent for seventeen years. He described not a design for a manufacture, but a manufacture. He claimed not a new shape, but a new thing. I know of no discretion or authority vested in the commissioner to turn this application into an application for a design, nor any process by which it can be accomplished short of a new application. A single illustration will make this sufficiently obvious. An alien may apply for letters patent for an invention, but not for a design, unless he has resided in this country for more than one year, and made oath of his intention to become a citizen. It would be impossible therefore to turn the application of the alien for

an invention into an application for a design, however clearly the subject-matter might place it in the latter class of subjects.

I regard the eleventh section of the Act of 1861 as distinct from the remainder of the law as if it formed the subject of a separate statute, and the codifiers of the patent laws evidently so regarded it, for they collected all the matter relating to design patents in a separate chapter.

There is another objection which is fatal to this application. A new shape or configuration is independent of materials or modes of manufacture. If the shape be old as applied to the thing, it cannot avail that the thing is produced by a new process or wrought in a different material. If cast hexagonal columns are old, no patent can be granted for wrought columns of a hexagonal shape. It is immaterial, so far as the design is concerned, whether the column be cast, hammered or rolled, or whether it be of cast iron, malleable iron, or steel. (See W. N. Bartholomew, *ex parte*, Commissioner's Decisions, 1879, p. 103.)

The applicant now claims hollow shafts, &c., "of wrought or malleable iron," "machine-rolled tube or pipe," of a hexagonal form, &c. This is evidently intended to avoid the references already given, of those which may be given to cast iron hexagonal pipes or columns; or to those which form a hexagon when united, although not rolled in a single piece. These incidents have nothing to do with the design, the claim for which stands only upon novelty of form, and cannot be strengthened by their introduction.

The motion of applicant is overruled.

Ex parte WILLIAM KING.

Decided September 19, 1870.

Com. Dec., 1870, p. 109.

In the matter of the application of William King for letters patent for a Design for a Trade-mark.

Pictorial designs intended for trade-marks cannot be patented under the design statute of July 8, 1870, Sec. 71; because Section 77 of that act, which provides a mode of protecting trade-

marks, excludes, by implication, all other modes. The statute relates to external ornamention of manufactured articles, and to specific articles to which the same is to be applied.

Fisher, Commissioner:

Applicant tenders $30, and asks for a patent for fourteen years for a "design for a trade-mark." He says: "The distinctive features of my design consist of my portrait placed in the center, lengthwise, and surmounted by the British coat-of-arms, about which is arranged in a semi-circular form the words, 'King's Sauce Royal.' Upon the left of my portrait is a shield or tablet containing the words, 'Shake well the bottle before using, and upon the opposite side a similar tablet containing the words, 'None genuine without my portrait and signature, W. King,' said signature being a fac-simile of my hand-writing. Although the above-named tablets are used, they are not considered as essential to the design, and may be omitted if desired.

"Having thus fully set forth the nature and merits of my invention, what I claim as new is, the hereinbefore described design, substantially as shown."

Prior to the Act of July 8, 1870, no protection was afforded by statute for trade-marks *eo nomine*. They were left to the protection of the common law; except where the design was of such character as to fall properly within the subjects patentable as designs. In such case they have been patented, usually with the addition of the words, "for a trade-mark." These words were, however, merely descriptive, and carried with them no guarantee as to the use of the trade-mark. In other words, if goods had been sold with such a design affixed, the only penalty that could have been recovered, under the statute, would have been for the infringement of the design, as an ornament, and no recovery could have been had of the damage resulting to the injury to the trade of the manufacturer, by a violation of his trade-mark in the sale of the articles to which it was attached.

It was to remedy this evil, and to give promptly, by statute, that protection to trade-marks which the common law tardily afforded, that Congress passed so much of the

act of July 8, 1870, as relates to this subject. By the provisions of that act, a trade-mark, whether old or new, may be registered in the Patent Office by its owner, and by the payment of $25 protection is afforded for thirty years. As this protection is more ample, and covers more than double the time for less money, it is difficult to see why applicant, or any one else, should now seek a design patent for a trade-mark. The folly of the application does not however relieve me from the necessity of deciding upon its legality.

The only clause of the designs act under which trade-marks can possibly fall is that which enumerates "any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture." This manifestly refers to the external ornamentation of manufactured articles, and it requires, first, a specific article of manufacture to be ornamented; and, second, an impression, ornament, pattern, print, or picture to be placed upon it. It was only by a forced construction of this clause that designs, which were to be used only as trade-marks, or selling labels, could be included within it.

But the subject is relieved of all difficulty by Section 77 of the late statute. It is there enacted that any person, corporation, &c., "who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark, for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following provisions." This provision, by prescribing the statutory mode of obtaining protection for a trade-mark, excludes all other modes not expressly provided for, and operates as a construction of Section 71, in excluding trade-marks from the list of subjects intended to be protected as designs.

In accordance with this opinion, the present application, and all others which are intended to cover trade-marks, or "designs for trade-marks," must be presented under the provisions of Sections 77–84 of the Act of July 8, 1870, and not otherwise.

Ex parte EGBERT W. SPERRY.

Decided October 28, 1870.

Com. Dec., 1870, page 139.

In the matter of the application of Egbert W. Sperry, for the extension of letters patent, Nos. 2641 and 2642, for designs for a Knife, Fork, or Spoon Handle, granted April 30, 1867.

Extensions of patents are only granted by virtue of express authority conferred by statute. The Act of March 2, 1861, authorizing such, was repealed by the Act of July 8, 1870, except as to patents granted before the date of the prior act. The fact that the petition for extension was pending at the time of the passage of the Act of July 8, 1870, does not bring the case within the proviso of the repealing clause of that act so as to preserve the right to an extension.

Duncan, Acting Commissioner:

The patents which it is now sought to extend are for designs, and were granted April 30, 1867, for the term of three and one-half years. The petitions for the extensions were filed respectively June 3, and May 31, 1870.

The remonstrants object to the grant of the extensions on the ground, *inter alia*, that under the existing law the commissioner has no power to entertain the applications.

The commissioner's sole authority for extending patents is derived from positive legislative enactment, and in the exercise of this power he is bound to restrict his action to the exact limits established by the statute. The only parts of the new law relating in terms to this subject are the sections (63 and 67 inclusive) which provide for the extension of patents for inventions or discoveries, and section 74, which enacts that "patentees of designs issued prior to March 2, 1861, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries issued prior to the second day of March, 1861."

The patents now offered for extension, being patents for designs issued since the second day of March, 1861, do

not come under either of these provisions, and consequently the commissioner has no power in the premises, unless, by reason of the fact that the applications were filed prior to the passage of the present law, applicant thereby acquired rights which are preserved to him by the repealing section of the law.

The Patent Act of 1861 (section 11) gave the commissioner power to extend design patents. The repealing section of the Act of July 8, 1870, contains the proviso that the repeal of the existing laws relating to patents "shall not affect, impair, or take away any right existing under any of said laws." The rights here referred to would seem to be such rights only as may form the basis of a suit at law or in equity, the further language of the proviso being as follows: "But all actions and causes of action, both in law and in equity, which have arisen under any of said laws, may be commenced and prosecuted, and if already commenced, may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed." Manifestly the rights here contemplated can have no relation to the right of an applicant for an extension to have his case examined and acted upon by the Commissioner of Patents. This right, as existing in cases pending at the time of the passage of the new law, does not appear to have been preserved by the proviso quoted.

Neither has applicant any rights preserved to him by the second proviso of the repealing section of the new law, which is in these words, viz: "That all applications for patents pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage thereof." While this proviso may fairly be construed to cover applications for extensions, as well as for original patents and for reissues, yet manifestly it cannot include any class of cases over which, if filed subsequently to the passage of the act, the commissioner could not assume jurisdiction. The present cases fall within this last category, and cannot, therefore, be subject to the operation of the proviso.

There would seem, therefore, to be no power vested in the commissioner to grant the extensions asked for, even if

applicant had furnished satisfactory evidence upon the various questions involved in every extension, and in which the burden of proof is thrown upon the party making the application. In point of fact no ascertained value of the inventions is shown, and applicant has utterly failed to show that the lack of remuneration has been without neglect or fault on his part.

The extension must be refused.

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Ex parte E. RAY FENNO.

Decided February 27, 1871.

Com. Dec., 1871, page 52.

In the matter of the application of E. Ray Fenno for letters patent for a Design for Damper for Stove-pipes.

Design specification for new form or configuration, while it may describe mechanical construction, must be confined to shape or form in the claiming clause.

The Statute of July, 1870, is different from that of March, 1861, in that the latter required only that the design be "new and original," while the former uses the terms "new, useful and original;" and this is sufficiently comprehensive to include any useful shape for an article of manufacture, even though no ornamental effect be produced thereby.

Duncan, Acting Commissioner:

Applicant's damper consists of two plates, the one being a slide which works over an orifice in the other, opening and closing it at pleasure, the main plate at the same time being made capable of partial rotation on an axis. The opening in the principal plate is bounded on the one side by the arc of a circle, and on the other by an irregular curve. The patent granted to E. Munson, February 16, 1864, shows a damper having precisely the same mechanical construction, the only difference being in the shape of the opening, which in Munson's damper is rectangular.

Fenno, the present applicant, came before the office in 1867, asking for a patent for his adjustable damper re-

garded as a mechanical device. He was rejected upon the patent of Munson. He carried his application through the various appeals allowed by law, and the correctness of the examiner's decision was finally affirmed by the highest appellate tribunal. Mr. Justice Fisher, in rendering his decision upon the appeal, uses the following language: "In this case there is not the least appreciable difference between the damper of applicant and that of Munson, to which reference was made in the office. They are identical in principle, so completely that the wonder is that the case should have been carried beyond the first rejection by the primary examiner."

Fenno now comes forward with this new application, in which he asks for a patent on his alleged "new and original design" for a stove-pipe damper. The examiner declines to pass upon the question of novelty, raising the preliminary objections, (1) that mere shape is but a fractional part of the end desired to be covered by the case;" and (2) that the claim for a patent is inadmissible, inasmuch as the device is to perform its function inside a stove-pipe, where, from the nature of things, mere beauty of form or ornamental configuration can play no part.

The first objection raises a question as to the good faith of the party in making his application in the present form. A careful reading of the specification shows that the objection is not entirely without foundation. The nature of the invention is set forth in the opening of the specification in the following language: "The invention consists in making the damper in two parts, one part being stationary, and the other part being made to slide thereon, as hereinafter more fully described;" and then follows the elaborate description of the mechanical construction and the mechanical functions of the various parts of the damper. Following this description, the claim for "the design for damper as shown," is, to say the least, ambiguous, and the inference would seem justified, that applicant is now endeavoring to obtain covertly what he failed to accomplish by direct method upon the former application.

As the specification is now drawn, the examiner's first objection must be regarded as well taken.

But it is manifest that the specification is susceptible of

amendment, so as that the mechanical construction of the damper shall be distinctly disclaimed, and the claim be confined to the special form of the opening in the main plate; and the question then recurs whether, if so amended, the claim would be of a patentable character, and the novelty of its subject-matter should be inquired into by the examiner.

Among the various things which may form the subject of design patents under the amended law is, "any new, useful and original shape or configuration of any article of manufacture," which has not been known or used by others, or patented or described in any printed publication, prior to the invention or production thereof by the applicant.

There is here no limitation as to the use to which the article, wrought into the particular shape designed for it, is to be subjected; and no suggestion that mere beauty of form or ornamental configuration are the ends sought. In fact, the language quoted expressly implies that utility may be the sole object had in view, in the invention or selection of the particular form to be impressed upon the manufacture; and I am of the opinion that under the present statute, if a new, and at the same time useful shape be devised for a particular article of manufacture, even though no ornamental effect be produced thereby, the inventor of the same is entitled to protection for it under the design section of the patent law.

It should, however, be borne in mind by the examiner, in the further consideration of the present case, that, as regards designs for articles of manufacture, the present law is different from that which it supersedes. Formerly it was only required that the design be new and original; now it must be new, useful, and original. If, therefore, Fenno should so amend his specification as to relieve it of the first objection urged, it would still be incumbent upon him to show that some useful result is produced by changing the form of the opening as shown in Munson's patent to that shown in the pending application. As the specification now stands, no utility of the one form over the other is alleged; and it is propounded as a fair subject for examination whether any in fact exists.

The case is remanded to the examiner for the considera-

tion of such amendments as the applicant may desire to present, and of such arguments on the question of utility as the nature of the case will admit of.

—o—

Ex parte WALTER L. TYLER.

Decided April 27, 1871.

Com. Dec. 1871, 106.

In the matter of the application of Walter L. Tyler for letters patent for a Design for a Clock Case.

The specification may describe mode of construction and materials, if not relied on to support patentability, but merely "to the end that the shape, the ornamental effect or design, may be more apparent.

If mode of construction secures an appearance—a presentation to the eye—substantially different from anything then known, the former may be described, and the latter claimed, in a design patent.

Leggett, Commissioner:

The applicant described his design, which he claims as new and original, as follows, viz:

The case is of a circular form, and is provided with the usual round metallic sash, A. B C are the several laminæ of dark and light colored wood. The sides of the case are flaring, so that the several laminæ may be seen when the case is viewed directly from the front. The edges of each of the laminæ are slightly rounded, thus corrugating the flaring sides, as shown in the drawing.

Fig. 2. The whole formed and combined as shown and described, to produce a new design for a clock case. I claim as my invention the design for a clock case substantially as shown and described.

The examiner rejected this application by reference to Jerome patent of June 16, 1863, and the rejected application of Green, filed October 19, 1867.

The board of examiners-in-chief affirm the decision of the examiner, and add that "the applicant evidently relies upon the difference in construction, to substantiate his claim

to a patent. This ground is believed to be utterly untenable. Shape, configuration, ornamental design, may be protected by a design patent; but the material used, or mode of construction employed, cannot in any way affect the question of novelty or patentability."

The doctrine in reference to design patents, as set forth by the board, is undoubtedly correct, but whether it applies against the applicant depends entirely upon whether "he relies upon difference in construction to substantiate his claim to a patent."

I confess that I cannot see, in the applicant's specification and claim, as quoted above, any evidence of reliance upon "difference in construction." It is true he briefly described the process of construction, but only to the end that the shape, the ornamental effect or design, may be more apparent. His mode of construction secures an appearance, a presentation to the eye, substantially different from that of either of the references. Jerome's patent shows a circular clock case, which, if viewed from the front, shows two stripes of wood and two of brass; but if viewed from the sides, only one of brass and one of wood, and has the appearance of the ordinary clock case, having a wood body and brass sash, and is not ornamented by alternate stripes at all.

Green's rejected application was for an oval picture frame, constructed of alternate rings of different colored woods, the outer ring having the greater projection. This would also show alternate stripes of different colors when viewed directly in front, but if viewed from the side or edge, only a single wood of a single color is presented to the eye.

The application shows a design of a clock case which presents to the eye several alternate stripes of different colors, and so arranged as to exhibit these stripes from whatever direction the case may be viewed.

The three cases exhibit a slight resemblance in ornamentation when viewed from directly in front, but the design described by applicant is radically different from either of the others when viewed from any other direction.

The decision of the board of examiners-in-chief is therefore reversed.

Ex parte PHILIP WEINBERG.

Decided September 6, 1871.

Com. Dec. 1871, 244.

In the matter of the application of Philip Weinberg for Design Patent on Muffs.

The statute (of 1870) does not contemplate the grant of a design patent to serve merely the purpose of a trade-mark.

The word "produced" in that law does not qualify the associated word "invented," so as to authorize the grant of a design patent for anything not involving an exercise of inventive genius. The word "invention" had become so intimately associated with improvements in functional constructions, that the word "produced" was used in the statute in connection with the word "invention," merely to relieve it of its functional signification.

Read in connection with the words "genius" and "original," found in the statute, the word "produced" carries a higher signification, meaning "created," and implying the exercise of a higher faculty that is indicated by "invented" alone.

In mechanism, an exercise of constructive genius may, perhaps, be sufficient to support a patent, but a design patent presupposes an exercise of creative genius, an original thought, a new idea begotten and embodied.

While it is not now held that a design patent cannot be based on colors, a mere substitution of one color for another possesses no element of originalty, and indicates no exercise of genius sufficient to support a design patent; nor can any blending or arrangement of colors, unless a new æsthetical effect is produced, and an original idea indicated.

Leggett, Commissioner:

This case comes from the primary examiner on the following question:

Can color, parti-colors (innumable), their indefinite shades and contrasts or measurements, form the proper subject for a design patent, and how far, if at all?

It is clear that the law never was intended to give a

man a design patent to serve merely the purpose of a trade-mark.

A prerequisite for a patent of any kind is an exercise of inventive genius. This is no less true of design than of functional patents. It is true the section of the law relating to design patents says, "that if any person by his own industry, genius, efforts, and expense has invented or produced any new and original design," &c.; and many seem to suppose that by the introduction of the word "produced," it was intended to grant design patents without evidence of the exercise of inventive genius, and hence patents are continually sought, and sometimes granted, for the most trivial changes in form or color. The word "produced" was never intended to give any such latitude, nor was it intended in any way to let down the standard for grant of patents. The word "invent" had become so intimately associated with improvements in functional constructions and combinations, that the word "produced" was used in connection with the word "invention," merely to relieve it of this functional signification. When read in connection with the words "genius" and "original," as found in the statute quoted, the word "produced" is evidently used with a much higher signification than merely made or constructed; it means created. "Invented or produced," as used in this section of the law, means the exercise of a higher faculty than would have been indicated by "invented" alone.

In mechanism an exercise of constructive genius may, perhaps, be sufficient to obtain a patent, but a design patent presupposes an exercise of creative genius. Original thought is demanded, a new idea must be begotten and embodied.

A mere substitution of one color for another possesses no element of originality, and indicates no exercise of genius, and cannot, therefore, become the subject of a patent; neither can any blending or arrangement of colors, unless a new æsthetical effect is produced—an original idea indicated.

I am not prepared to say that no design patent could be based on colors, but, with the foregoing explanations, my views are, I think, sufficiently indicated for the case under consideration, and other similar cases.

Ex parte PETER C. PARKINSON.

Decided September 25, 1871.

Com. Dec., 1871, 251.

In the matter of the application of Peter C. Parkinson for a Design Patent for a Claw-hammer.

Function can form no part of a design patent. "Useful" in connection with mechanical inventions relates to functional quality; while the same word in connection with designs, means "adaptation to producing pleasant emotions."

The Statute of 1870 does not authorize the grant of a design patent for every possible change of form that might be given to a machine or article of manufacture.

Slight and unimportant changes in form or color, requiring neither inventive or creative genius, and producing no new or æsthetic effect, are not patentable as designs. The changes must constitute an *original* as distinguished from a merely *new* design.

The decision in *Ex parte* Bartholomew, C. D., 1871, p. 298, commented on, and disapproved as too broad.

Leggett, Commissioner:

The applicant seeks to obtain a design patent upon what he calls a "claw-hammer." This hammer is nothing more or less than an iron bar fitted in substantially the ordinary manner and form for drawing spikes. The foot of this hammer or spike-bar has the ordinary slot for catching the head of the spike, and the foot is of a goose-neck shape, and of sufficient length to draw the spike entirely from its fastening. The same is substantially true of a large majority of the tack-hammers and nail-hammers in common use. The applicant's device may differ somewhat in form from ordinary claw-hammers, but not essentially or materially.

The examiner refuses to consider the application under the head of designs, and says: ("Function can form no part of a design patent.") From this decision the applicant appeals under Rule 44.

The law has provided for granting patents to the inventors

or discoverers of new and useful arts, machines, manufactures, and compositions of matter, and also of any improvements thereof.

This class of inventions has to do with functional qualities of matter and things. The term "useful," in connection with machine patents, relates to the office the thing patented fills in producing a desired effect; or, if the thing patented is the result or effect, that is, the article produced, then "useful" relates to its adaptation to serve some practical purpose in supplying some physical or tangible want.

But the law authorizing design patents was intended to provide for an entirely different class of inventions, inventions in the field of esthetics, taste, beauty, ornament.

The question an examiner asks himself while investigating a device for a design patent is not "What will it do?" but "How does it look?" "What new effect does it produce upon the eye?" The term "useful" in relation to designs means adaptation to producing pleasant emotions.

The section of the law which enumerates the subjects of design patents reads as follows:

Any person who, by his own industry, genius, efforts, and expense, has invented or produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, &c.

The Legislature never intended by this section (Act of July 8, 1870, Sect. 2) to let down the standard for patents. It was never contemplated to grant a design patent for every possible change of form that might be given to a machine or article of manufacture. By "article of manufacture," as used in this section, the legislature evidently meant only ornamental articles, articles used simply for decoration.

The inventor in this line must not merely change the form or the color, but he must produce a new esthetic effect. He must, by the exercise of industry and genius, invent or produce, not only a new, but an original design. He must

do a little more than invent—he must produce, that is, create. Creative genius is demanded in giving existence to a new and original design.

The idea of stretching the section in question to cover slight changes in the form of crow-bars, spades, plows, scrapers, &c., is simply ridiculous, and tends to bring the whole system into disrepute.

If a man wants a trade-mark let him adopt one and have it registered; but before he can have the monopoly of a patent, he must have produced something substantially new.

The practice of the office in granting design patents has been not only liberal but lax. To real inventors the office should be liberal and generous, and all doubts should be solved in their favor. But the man who comes to the office with a machine or article of manufacture and seeks a design patent simply for some slight and unimportant change of form or color, requiring neither inventive nor creative genius, and producing no new or esthetic effect, deserves but little favor or consideration. In general, such men are impostors, and desire a design patent merely to obtain the right to put the word "patented" upon their manufacture, and thereby deceive the public and wrong real inventors, for they well know that not one person in ten thousand will ever learn the fact that the patent only covers the design.

The interests of real inventors, and a proper regard for the public good, demand that design patents be limited exclusively to the field herein suggested, and it is clear to my mind that a proper construction of the law fully warrants such limitation.

My learned predecessor's administration was an epoch in the history of the Patent Office. He established many boundaries and land marks that before had been very uncertain and indefinite, and instituted many reforms in the office practice that have rendered it far more simple and certain. It is after much hesitation that I differ from any of his recorded opinions, yet in the celebrated Bartholomew case, decided December 2, 1869, it is clear to my mind that he opened the door to design patents far too widely.

The action of the primary examiner is fully sustained.

Ex parte WILLIAM WHYTE.

Decided November 28, 1871.

Com. Dec., 1871, page 304.

In the matter of the application of William Whyte for letters patent for a Design for Ornamental Print for Fabrics.

The design for an article of manufacture, contemplated by the statute, must be permanently affixed to the article, or so wrought into the texture as to become in effect a part of it.

Surface designs intended to subserve merely a temporary purpose, such as to distinguish an article by its presence upon it, until sold, are not within the statute. Such are in effect trade-marks only, which are excluded, by implication at least, from the provisions of the act.

The specification not mentioning any article to which the design is applicable or to be applied, and upon the intrinsic evidence furnished by the design itself, it must be held that it is really intended for a trade-mark.

Suggestion in *Ex parte* King (C. D., 1870, p. 109) that a design patent to be valid should particularly specify the article to be ornamented or to which is applicable, approved.

Duncan, Acting Commissioner:

The design shown in this application consists of a shield or escutcheon, within which is a representation of a scroll and of the lower part of the human leg, the two crossing each other nearly at right angles. This is entitled by the applicant an "ornamental print for fabrics," and is described in the specification as a "new and original impression or print to be printed or painted upon paper or other fabrics or woven or otherwise worked into the same."

The examiner declines to entertain the case and inquire into the novelty of the design, assigning as the reason that the design is really intended for a trade-mark, and that the applicant accordingly must obtain protection, if at all, by registering it as a trade-mark and not by patenting it as a design. It is from this decision that the present appeal is

taken, and applicant's prayer is for an order upon the examiner directing him to proceed with the case.

In *ex parte* William King, Commissioner's Decisions, September 19, 1870, it was held that designs for trade-marks are excluded from the category of subjects made patentable by what is known as the design section of the patent act. One reason for this ruling was that as the statute in later sections provided a special means of obtaining protection for trade-marks, such provision must be interpreted as excluding all other modes not as specifically enacted, and therefore, as excepting trade-marks from the operation of that clause which enumerates, in general terms only, as subjects for design patents, "any new and useful impression, ornament, pattern, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture." The rule then laid down still governs the office practice; so that the only question at issue in this appeal is as to the real object of the design to which it relates.

There can be but little doubt that, in the enumeration of subjects for design patents as contained in the clause of the statute above quoted, regard was had to the external ornamentation of articles of manufacture; and that to this end it was the intent of the law that the various designs should be so affixed to the manufactured articles, or so wrought into their texture as to become in effect a part of them. They were not intended to subserve merely a temporary purpose—such, for instance, as to distinguish the article by their presence upon it until it should have passed into the hands of the consumer; rather, they were to be incorporated into its very structure, and to abide with it after it had reached the consumer, and until obliterated by the natural and gradual deterioration resulting from use.

Applying this test, how are we to regard the present case? Is the design one that the applicant intends to use for the purpose of ornamentation? Does he propose to himself so to incorporate it into the structure of the articles to which he applies it that it will become a permanent part thereof? To be sure, he speaks of it as something "to be printed or painted upon paper or other fabrics, or woven or otherwise worked into the same;" but there is no suggestion that the

fabrics upon which it is thus to be printed or painted, or into which it is thus to be woven or otherwise wrought, are themselves to be worked up into definite articles of manufacture, and are not to be used simply for temporary attachment to other manufactures for the purpose of indicating their ownership or origin. In the absence of any positive declaration to the contrary it must be assumed that the latter is the real intention of the applicant, for it is difficult, if not impossible, to conceive of any article of manufacture the value of which would be the least enhanced in the estimation of the public by the permanent attachment to it of the design in question. There is too little of the beautiful or even the grotesque in it to warrant the expectation of such a result. If placed upon a surface of plate, or used for other kindred purposes, it might give a special value in the eyes of the owner to the articles upon which it is thus impressed; but this would be a matter affecting the public indirectly only, and more frequently, perhaps, than otherwise would actually depreciate the articles in the public estimation. In the absence from the specification of all mention of the articles, if any, upon which it is proposed to place the design as an ornamentation, and to which it would be adapted for such a purpose, and upon the intrinsic evidence of the design itself, it must be held that it is really intended as a trade-mark.

This view is strengthened by reference to the history of the case. As first filed, the drawing had the word "trade-mark" imprinted upon the scroll within the shield, and the oath of invention first filed spoke of the design as being for a trade-mark. Since the first action of the examiner raising an issue as to the character of the application, the word "trade-mark" has been erased from the drawing and an amended oath has been filed which corresponds in phraseology with the specification.

The suggestion of the applicant's attorney, that from the filing of the present application it must be presumed that applicant does not seek to protect his design as a trade-mark; since, if this were his object, he would not have proceeded under the design section of the law, but under that branch of it which related to trade-marks, by which for a smaller fee he would have obtained a longer term of

protection, is without force. It is more likely that applicant chose the present form of application, thinking that by securing the exclusive use of the design he could apply it at pleasure to all classes of goods; and that, being protected in that exclusive use, he would thus, in the lapse of time, become possessed of a veritable trade-mark for as many different classes of goods as he might himself have manufactured, or might have procured to be manufactured by others, while under the trade-mark sections of the law a single fee would have secured registration for the design as a trade-mark in its application to a single class of goods only.

If this result would follow, there is all the more reason why special care should be exercised to prevent a loss in this direction to the revenues of the Government by an adroit evasion of the spirit of the law. It may be, however, that applicant mistakes as to the extent of his rights under a design patent. It is true that under the old law, there being at the time no statute specifically relating to trade-marks, parties were permitted to take out patents for designs for trade-marks, and this without naming any particular class of goods upon which such design was to be thus used; but in *ex parte* W. King, above referred to, the commissioner characterizes that construction of the design law which tolerated this practice as a forced interpretation, and plainly intimates the opinion that a design patent to be valid must particularly specify the special article to be ornamented by the pattern, print, picture, &c., upon which the patent is granted. If this view be correct, the grant of such a patent would create no right to the exclusive use of the design upon other articles than a particular one specified.

It is not recalled that there has been any adjudication of the courts upon the validity of a design patent which contains no specification of the class of goods to which the design is applicable; but the doubt thrown upon the question by the above-named decision of the Commissioner of Patents may well be pondered by all who would surrender the particular measure of protection afforded by the trade-mark law, thinking that by so doing they can, under the design law, obtain larger rights at a smaller cost.

The decision of the examiner in the premises is affirmed.

Ex parte J. D. DIFFENDERFER.

Decided July 8, 1872.

Com. Dec., 1872, 154.

Appeal from the principal examiner in the matter of the application of John D. Diffenderfer for letters patent for a Design for Desk-standard.

1. In an application for a design patent both the obverse and reverse of the design may be shown, but the views should correspond, that is, illustrate like portions of the device claimed.
2. A patent for a design cannot be granted where the function of a device forms an element of the claim. When the claim is for a "design substantially as shown and described," and the description contains references to the purpose and use of certain devices: Held, that function is thereby carried into the claim, which therefore should not be allowed.

Thacher, Acting Commissioner:

In taking this appeal, applicant says: "The question for decision is, can applicant show and describe the inner as well as the outer side of his standard?" I have no hesitation in giving an affirmative answer to this question. Every applicant for a design patent has an undoubted right to show both the obverse and reverse of the ornamental work which he has devised. But the two faces should correspond; if one be shown entire the other should be also. In this case, while the obverse of the standard is fully illustrated the reverse is only partially shown. The drawings should be amended to correct this error: Fig. 2 should be made to correspond with Fig. 1, so as to represent the reverse of the entire standard.

I find, upon examination, that this is not the only question in the case. In his first letter of rejection the examiner states his objection to the grant of a patent as follows:

The application above named embraces much more than can be admitted in a design. The exterior form or configuration is all that can be allowed. The other parts, relating to function, must be erased from the specification and drawing.

Subsequently to this action applicant amended his specification and drawing so as to overcome, as he supposed, the objection of the examiner. This, it seems, he failed to accomplish, for on the 1st instant, the examiner rejected the case a second time, restating his position, as follows:

The same objection exists to the specification as amended as to the original; and nearly the same form of a school-desk can be found in this room, which was placed there on the third day of January, 1870.

It becomes necessary, then, to examine the description and claim in this case, to determine whether the function of the standard forms any part of the invention claimed. Applicant claims—

The design for a desk-standard, substantially as herein shown and described.

Turning to the description I find that in describing the inner side, or reverse of the standard, certain flanges and projections are described and referred to by letter, the purpose of which, as stated by applicant, is to form supports for the bottom, end-pieces, and shelves of the desk. This language obviously carries the function of the parts mentioned into the claim for the design, for said claim refers directly back to the description for its interpretation. This class of claims in application for design patents has already been criticised by the commissioner, and the field to be occupied by such patents clearly defined in the appeal case of Peter C. Parkinson, C. D., 1871, p. 251.

The present case, in my opinion, comes clearly within the ruling in the decision referred to above, and in accordance therewith the applicant should be required to erase from his description all reference to the function of the standard, or any portion thereof, described.

—o—

Ex parte T. B. DOOLITTLE.

Decided July 31, 1872.

Com. Dec. 1872, 176.

Appeal from the Primary Examiner in the matter of the application of T. B. Doolittle for letters patent for Improvement in Button-hole Cutters.

When utility is cited as the purpose of a "peculiar shape," the invention cannot, under such description, be the subject of a design patent.

Useful purpose is the characterization of a machine patent, so called; ornamentation, that of a design patent.

Thacher, Acting Commissioner:

The fifth claim was rejected by the examiner on the ground that the invention was "a proper subject of a design patent; but not for a mechanical patent."

This objection was not noticed by the examiners-in-chief when considering this application on appeal, probably because they very properly regarded it as a question appealable directly to the Commissioner. Such an appeal is now taken by the applicant.

The claim in question is for "the peculiar shape of the end of the shield, so that all danger of grasping it at a dangerous locality will be avoided, as hereinbefore explained." If the shape here referred to was for the purpose of ornamentation, the objection of the examiner would be valid; but in the claim utility is suggested as the object of the peculiar form of the end of the shield.

Upon referring to the description the useful purpose subserved by this form is found to be still more distinctly set forth.

Inasmuch, therefore, as the peculiar shape of the end of the shield is not mere fanciful ornamentation, but was devised to serve a useful purpose, to wit: to form a safe handle for the instrument, it constitutes proper subject-matter for a claim in a machine patent.

Perhaps, however, the claim should be amended so as more carefully to define the invention to which it relates, and the examiner is advised to require such amendment before allowing the subject.

The claim is, of course, open to any objection the examiner may raise if he finds, upon examination, that the invention is wanting in novelty.

The decision of the examiner is overruled.

Ex parte H. W. COLLENDER.

Decided October 2, 1872.

Com. Dec. 1872, 217.

A patent for design and one for structure cannot both be granted for the same subject matter. A single device, however, may embrace subject matter for both classes of patents; that for one being a particular configuration or ornamentation, and that for the other, the structure of the device, involving its mechanical uses and adaptation.

Thacher, Acting Commissioner:

Applicant claims "a billiard table formed with bevelled side rails, or with the sides of its body bevelled under."

The object of beveling the sides of the frame under the table is alleged to be so to change the form of the frame as to make room for the leg of a player when it becomes necessary for him to "hug" the table closely, and bend forward in order to strike the cue-ball at the greatest distance without using the bridge, which it is desirable to avoid. This is the theory advanced; but the fact is, this construction will not enable the player to strike his cue-ball at any greater distance from the cushion than the old one would. On the contrary, the rule of the game being, as I am informed, that only one foot must necessarily be kept upon the floor while making a shot, a player cannot reach so far with his leg under the table as he can when it is not under the table. The common practice, which is in accordance with the rules of the game, is in making a long shot without the bridge, to rest the weight on one foot or on the ball of the foot, beyond or outside the space covered by the table-top, and lean forward against the cushion-rail. The distance reached depends upon how tall the player is, and how long his arms are, and not in the least upon this particular construction of the table-frame beneath the top. The truth of this may be verified by observation of a game between experts, and by reference to the rules of the game. So this basis of the utility of these beveled sides vanishes at once. They do not possess the practical utility alleged.

Nevertheless I do not doubt that they do possess a peculiar practical utility, not in connection, as alleged, with the long shots in which the bridge is ordinarily used, so that they operate to dispense with its use, but rather in connection with ordinary shots, or shots where the cue-ball rests at only a moderate distance from the cushion, and it is desirable to have the weight of the body supported by the foot advanced rather than by the bridge-hand. The beveled construction of the frame will allow the foot to be advanced and the body supported steadily to make shots just so much further from the cushion, in this advantageous position, than can be made on the old tables, as there is space gained by the beveling. This is an improvement, therefore, which will be valued by billiard players, as is evident from the fact that beveled tables are now fast superseding the old square-framed tables, and billiard-saloon proprietors are compelled by the public preference to supply them.

The only question, therefore, as to the patentability of this improvement upon a proper specification, is raised by the fact that applicant has already taken out a design patent showing and covering, as a design, the identical form of table now presented. Its effect, however, is merely to secure to him the particular configuration shown. Claiming to be the inventor of the useful plan of construction embodying broadly the beveled frame as well as of the configuration adopted, he now seeks protection for said beveled frame without regard to configuration.

The case of Bartholomew (Com. Dec., 1871, p. 298) is precisely in point. In that case a design patent was granted for a particular conformation of a rubber eraser, possessing the æsthetic utility and novelty required for a design patent, and afterwards a patent was granted covering the plan of construction, which possessed the elements to support the grant of a mechanical patent. At the same time the rule was not violated that a mechanical patent and a design patent should not be granted for the same subject matter. The subject matter was essentially different, although found in the same device. The same difference exists in the case under consideration. The definite ornamental configuration presented is already secured by patent, and now the plan of construction, which may be of varied

design, and which relates exclusively to utility, except when applied in connection with some particular embodiment of form, which it is made to assume for æsthetic effect as well as for utility, is proper, because different, subject-matter for patent.

The decision of the board is reversed, and the application is remanded to the examiner, who will require the specification to be amended in accordance with the above suggestions, when an interference may be necessary before ordering a patent to issue.

COLLENDER *v.* GRIFFITH.

Decided January 30, 1873.

(Com. Dec., 1873, page 14.)

If an application is filed for a mechanical patent for a construction, and if a design for which a patent has been granted can be produced only by that construction, an interference should be declared between the application and the patent.

Thacher, Acting Commissioner:

This is an appeal from a decision of the examiner dissolving the interference. The main reason for the dissolution is that an interference is improper between an application for a mechanical patent and a patent for a design.

This is urged on the ground that the interests are not and cannot be identical, inasmuch as the patentee of the design cannot reissue and obtain a claim for the construction, even if successful in the suit. Although this argument appears plausible, it is really unsound and should not prevail. An interference does not necessarily result in the grant of a patent to one of the parties for the subject-matter involved. It frequently happens that the prior inventor is adjudged, for various reasons, not to be entitled to a patent. The question in this case is not whether Griffith is entitled to a patent, but whether Collender shall have the patent for which he prays. Now, it is admitted that Griffith, in applying his design, must use the construction claimed by Collender, and therefore the grant to

the latter of the patent sought would subordinate a design patent of earlier date. Under these circumstances it is perfectly evident that it would be improper to issue a patent to Collender until he proves himself the prior inventor. An interference, therefore, was necessary, and in this instance properly declared.

The decision of the examiner dissolving the interference is overruled.

COLLENDER *v.* GRIFFITH.

Decided March 11, 1873.

Com. Dec., 1873, page 43.

An interference should be declared between an application for a mechanical patent and a design patent which shows the alleged invention, although the applicant holds a prior design patent showing the same.

If the designs embraced in the two patents are so dissimilar as not to be in conflict, it is unnecessary to include the earlier patent in the interference.

The burden of proof is on the applicant for the mechanical patent, notwithstanding his design patent first shows the invention; but he may have the benefit of it by introducing it in evidence.

Leggett, Commissioner:

This is a motion to dissolve the interference. The case is somewhat anomalous. Collender obtained a patent for a design for an ornamental billiard-table frame, June 6, 1871. On October 6, 1871, a design patent was granted to Griffith, also for an ornamental billiard-table frame. The two designs, as such, are distinctly dissimilar. There was no interference between them as designs, and they were properly patented. January 16, 1872, Collender filed his present application for a patent, claiming to be the inventor of a beveled frame for billiard-tables, which is alleged to be a material practical improvement upon the square vertical-sided frame in common use. The beveled frame was shown in his design patent and in that of Griffith. Having in itself, however, a practical, useful

function, without regard to any particular ornamental configuration or design, it was held—following the practice adopted in the Bartholomew case (Commissioner's Decisions, 1871, p. 298)—to be proper subject-matter for a mechanical patent. An interference became necessary to determine which of the parties, Colleuder or Griffith, was the inventor of the beveled frame. In it Collender's design patent was not embraced, and the question now is whether or not it should have been. The invention now claimed can never be secured to Collender or his representatives by reissue of that design patent. This is true also as to Griffith's design patent. The question is which of the parties is entitled to a mechanical patent upon separate application therefor, or, more immediately, whether or not Collender is upon his application. It is his application that raises this issue, and not his design patent. To be sure, he is alleged to be the inventor of both the design and the mechanical construction he shows, which are substantially identical in both his cases. But inasmuch as he cannot secure protection for the latter in his design patent by reissue, it is not necessary to place that patent in interference with his own application. That would be allowed without an interference were it not that another inventor shows the subject-matter claimed. Neither is it necessary to place it in interference with Griffith's design patent, because the two designs, as such, do not interfere. The case is not altered by assuming that Collender's design patent may be in the hands of assignees whose interests might be affected. They could never have an interference either with Griffith's design or Collender's mechanical patent, should he obtain one. Questions which might arise between them and Collender, growing out of the grant to him of the patent he now seeks, would be of a different nature and come before another tribunal. If Griffiths should be awarded priority, he may file a new application and obtain a patent without obstruction from Collender's design patent. The fact that the burden of proof is upon Collender in this instance arises, under the rules, from the record, and I see no reason why the rules should be modified in his favor. He can put in his design patent as evidence, and thus avail himself of it. But there is no reason why it should be

embraced in this interference, and therefore there is none for relieving him of the burden of proof which he sustains upon the records in the cases which are actually and necessarily in interference.

The examiner's decision is sustained.

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Ex parte T. B. OGLESBY.

Decided February 24, 1873.

Com. Dec., 1873, page 35.

1. When an alteration in any article is calculated to give it a better appearance merely, it can be protected only by a design patent.
2. If the alteration is intended to change its functions or improve its operation, or effect a new result, it may be the subject of a mechanical patent.

Leggett, Commissioner:

Applicant claims a peculiarly-shaped saw-tooth for cotton gins, on account of the construction or form of which several important advantages are alleged to be gained, referring both to the cost of making the tooth and to its use in ginning. No question is made by the examiner as to the novelty or utility of the tooth, but he maintains that as it exhibits merely a change of form, it is therefore proper subject-matter for a design patent only. This position is not tenable in this case. Admitting that there is no more than a change of form in the tooth itself, it is necessary to go further and inquire what is the object and what are the results of the change of form. If the shape of the tooth has been altered for the purpose of improving its appearance merely, without changing its function or increasing its practical efficiency, then the modification is calculated to produce the novelty and utility requisite to warrant the grant of a design patent. But if the shape of the tooth has been altered for the purpose of improving its operation, and actually does, as alleged, greatly increase its efficiency, then there is clearly presented subject-matter for a mechanical patent. When the common screw was simply provided

with a pointed instead of a blunt threaded end, there was only a change of its form and seemingly a very slight and obvious one. Yet the object of the change, and the advantage resulting from it, rendered it an important and patentable mechanical invention. This case is analogous, and the examiner's decision must therefore be overruled.

Ex parte L. W. FAIRCHILD.

Decided March 12, 1873.

Com. Dec., 1873, page 45.

1. A name-sign, with an imitation gold pen attached to it, constitutes a proper subject for a design patent.
2. The case of Parkinson, *ex parte*, Commissioner's Decisions, 1871, page 251, distinguished from this and approved.
3. All descriptions of the mechanical construction of the article represented in a design for which a patent is asked should be eliminated from the specification, as well as all reference to the utility of its purpose.

Thacher, Acting Commissioner:

Applicant attaches an imitation gold pen to a name-sign, and asks a patent for the whole as a new design. The examiner holds that this is not proper subject-matter for a design patent, and from this decision an appeal is taken.

The decision of the commissioner in Parkinson, *ex parte*, 1871, is cited as authority for the opinion of the examiner. In that case the article was a tool for mechanical purposes, and the peculiar form, for which a design patent was asked, was intended solely for purposes of utility. In the present case the completed article has no mechanical function whatever, and the design represented is a matter of taste. It is not, therefore, in my opinion, open to the criticisms so justly made in the Parkinson case.

As the subject-matter of this application is a matter of taste, and, to some extent, ornament, designed to attract the eye, I think there can be no doubt of the propriety of granting a patent for the design as requested.

The decision of the examiner to this extent is overruled; but, of course, without pronouncing upon the question of novelty, which is not brought up by this appeal.

The specification, however, requires careful revision. All description of the mechanical construction of the article should be eliminated, as well as all reference to its purpose as a matter of utility. All matter of this description is improper in a design patent. The examiner will, therefore, require suitable amendments in the case before further action.

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Ex parte ALOIS KOHLER.

Decided May 17, 1873.

Com. Dec. 1873, p. 84.

1. A patent will not be granted for a design which is shown in the drawings annexed to a patent already issued for a machine, although the machine or design may either of them be capable of use without the other.

2. Although the grantee of the machine patent is the applicant for the design patent, he should be denied in such a case.

3. If the patentee of a machine disclose in his specification his intention of obtaining a patent for the design shown in his drawings, it seems that he might then obtain such a patent.

4. The cases of *ex parte* Bartholomew, Com. Dec., 1871, p. 298, and *ex parte* Collender, 2 Off. Gaz. 360, commented on.

Leggett, Commissioner:

A patent was granted the applicant May 7, 1872, the drawing of which exhibited the design now claimed. That patent covered the construction of the opposite edges of a blind slat, whereby a peculiar hinge connection was formed. This construction was entirely concealed from view when the slats were united to form blinds. It was intended to perform a practical useful function, and was wholly independent of the exterior conformation of the slat shown, or of any other particular exterior design. It could be used as well with one design exhibited by the surface of the slat

as another, and this fact was set forth in the specification of the patent in the following words: "A represents the slats made with any suitable molding, form, or design upon their broad faces. This is all of the specification of the patent that refers to the design. The patent does not protect it, of course, and cannot be reissued so as to protect it, because it is not subject matter which a mechanical patent will protect. It is proper subject matter for a design patent, and the construction of the hinge connection is entirely distinct subject matter, and was properly patented as a mechanical device.

In view of this state of facts, the examiner and the board of examiners-in-chief have refused the application, the examiner holding that the patent of May 7, 1872, is a bar to the patent now sought, but the applicant continues his appeal, holding that, following the precedents set in the Bartholomew case (Com. Dec., 1871, p. 298) and the Collender case (Off. Gaz., Vol. 2, p. 360), he is entitled to a patent.

In each of the cases cited, the patent for the design was first obtained, and the mechanical patent subsequently applied for and allowed. In the present case the mechanical patent was first allowed, fully showing the design, and the design patent is now sought—sought upon drawings which are exact duplicates of those upon which the mechanical patent was granted. The cases are radically different. A design patent relates only to configuration and arrangement for æsthetic effect. The mechanical patent is for practically useful mechanism. The design may be shown and described in the case pending without developing the mechanism upon which the patent was granted, but the mechanism could not have been described in accordance with the requirement of law without showing some design. Hence the design patent might have been first granted and afterwards the mechanical, but not *vice versa*, for the mechanical is the greater, and must include the right to use the design shown, unless it was previously patented, but the design is the less, and does not necessarily include the mechanism. It will be remembered that in this case the special mechanism and special design have no necessary connection, as either can be used without the other. But when the ap-

plicant applied for his mechanical patent he was obliged to show his invention in some form in his drawings and model. He chose to adopt the identical form which he now seeks to cover by a design patent. If a valid patent, could be given him, he could then say to the assignee of his former patent that said assignee shall not use the mechanical invention in the manner and form set forth and fully described in that patent. The law certainly never contemplated the granting of patents that might thus come in conflict with each other. If the precedents quoted go that far, which I deny, then it is high time they were reversed.

If the applicant, at the time he applied for his mechanical patent had at the same time applied for his design patent, and had put a clause in the specification of the mechanical application stating that the design shown was a subject of a pending application for design patent, I should not question his right to both patents, for then the purchaser of the mechanical patent would buy with notice; but having fully shown his design in the mechanical patent without notice of intention to claim it, he has barred himself from setting up any subsequent claim to it, and has dedicated it to at least any person who now does, or may hereafter, own the mechanical patent. It might be said that both of these patents will belong to the inventor, hence will not come in conflict; but as they may, by future contingencies, either with or without the patentee's consent, fall into different hands and become antagonized, the office must be guided by the same principles as if the existing patent had already been assigned. The cases relied upon as precedents have gone to the utmost verge of propriety, if not a little beyond. The intent has been to correct mistakes, the applicants having taken patents for designs when they should have taken mechanical patents.

The decision of the board is affirmed, and the patent denied.

Ex parte BLOOMFIELD BROWER.

Decided October 28, 1873.

Com. Dec., 1873, page 151.

1. A square inkstand, with its angles chamfered, and a square-headed movable stopper with its angles similarly chamfered, held not to constitute a patentable design for a single article of manufacture.

2. The ordinary use of an article, for the form of which a design patent is sought, is a controlling consideration in determining whether or not it presents proper subject matter for a design patent.

3. As the ordinary use of an inkstand and stopper requires their separation, they do not present such a fixed unit as to constitute them a single design.

4. The relative position of connected parts to constitute a design ought to be uniform and fixed, because, as a rule, a design is essentially unitary and unvarying in character. It cannot embrace alternates or equivalents of form, but is arbitrary and unchangeable.

Thacher, Acting Commissioner:

Applicant claims a "design for a glass inkstand and stopper of glass, made square, with equally chamfered edges, substantially in the manner above described."

The edges or angles of a square inkstand are all chamfered, and the chamfers are all of equal width. A square stopper head is provided, having its edges or angles all similarly chamfered. The photographic illustration filed exhibits the square chamfered stopper in the chamfered inkstand in such a position that the sides of the squares are parallel with each other.

The examiner holds that the bottle and the stopper are separate articles, and exhibit separate and independent designs. On the other hand, it is maintained in behalf of the applicant, in substance, that while this is true in one sense, the two have an intimate relation respecting the harmony of their individual forms to produce an æsthetic

effect when they are brought together for use or display, and are presented to the eye as a unit. He alleges that he has made the stopper head of the form of the inkstand in conformity with a law of fitness or correspondence relating to forms to be connected or conjoined, from which what is pleasing to the eye, and what we naturally term beautiful, result. There is apparently some force in this reasoning; but it should be remembered that the ordinary use of an article for which a design is presented, is a controlling consideration in determining whether or not the design is proper subject matter for patent as such.

The object of an inkstand and stopper is to preserve the ink for use; but whenever it is being used they must be separated. The stopper must be removed, and that destroys the design alleged to be constituted by the two. There is not, therefore, such a fixed unity of design, considering the ordinary use of an inkstand and its stopper, as to constitute the two separable and often separated parts a single design.

Another consideration of importance, is that the relative positions of the two parts, when connected, ought to be uniform and fixed, in order to constitute a design which is, as a general rule, a thing essentially unitary and unvarying in character. A design cannot embrace in its scope alternates or equivalents of form. It is arbitrary and unchangeable, either by the separation or the rearrangement of its features. In this case it is obvious that there is nothing in the construction presented to preserve the alleged design shown, even when the stopper is in place, for it may be turned out of parallelism with the square of the stand, whereby the æsthetic effect described will be violated and the original design destroyed. It would then be like a capital misplaced on the shaft of a column.

It is not denied by the applicant that a design for an inkstand and a stopper-head, respectively, might be patented. The exterior of the stand and the stopper, being individually ornamental and novel in form, would each present subject matter for patent. The two permanently united, or so constructed as always to occupy the same relative positions to each other, might also, no doubt, present subject matter for patent were such a union consistent with

their ordinary use; but neither of these conditions is found in this case. I therefore concur with the examiner that a division of this application is necessary. The inkstand and stopper, as presented, do not constitute a single unitary design for an article of manufacture.

The examiner's decision is affirmed.

—o—

Ex parte CHARLES A. SEAMAN.

Decided January 5, 1874.

4 O. G., 691.

1. The form of the body or swab of a lamp-chimney cleaner held not to be subject matter for a design patent, because the form was adopted for practical use and not for ornament, and, in the body of a lamp-chimney cleaner, was without utility as an ornament.
2. The words "useful" shape in the statute relating to designs refer to the utility of ornamental form and appearance rather than to that of operative mechanical function.
3. By design for "an article of manufacture," as the subject of patent, is to be understood ornamental forms of articles employed merely for decoration.
4. When "an article of manufacture is presented for patent in order to determine to which statutory class of patents it should be referred for protection, it should be asked, Is its form, without reference to the function of the article, intended to be ornamental? and is the article itself a thing which may, for any practical purpose, have a merely ornamental configuration, and therefore have, in that sense, sufficient utility to warrant the grant of a patent?
5. The law is based upon the universal truth that the influence of the beautiful is beneficial to mankind, and there is no reason for excluding "the decorative arts" from recognition under the statute wherever there is room for real decoration.

Leggett, Commissioner:

The applicant makes a lamp-chimney cleaner with a "pear-shaped" body, and seeks a design patent covering

this form of the article. The examiner holds that this is not proper subject matter for a design patent.

Under the old law, which provided that he who invented "any new and original shape or configuration of any article of manufacture," should have a design patent therefor, Commissioner Foote held—

"It (the statute) does not say 'ornamental' design, or 'artistic' shape or configuration, and I am unable to perceive any good reason why designs for utility are not fairly and properly embraced within the statute, as well as those relating to ornamentation merely. The line of distinction between what is useful and what is merely ornamental, is, in some cases, very indefinite." (Commissioner's Decisions for 1869, p. 7.)

Commissioner Fisher expressly concurred in this opinion, and added—

"I am of opinion that the class of cases named in the act as arising from 'new shape or configuration,' includes within it all those new changes of form which involve increase of utility." (Ib. p. 105.)

The Act of July 8, 1870, adds the word "useful," and provides that "any new, useful, and original shape or configuration of any article of manufacture" may be patented as a design. Under this act, Acting Commissioner Duncan held (Commissioners Decisions for 1871, p. 53)—

"There is here no limitation as to the use to which the article wrought into the particular shape designed for it, is to be subjected; and no suggestion that mere beauty of form or ornamental configuration are the ends sought. In fact, the language quoted expressly implies that utility may be the sole object had in view in the invention or selection of the particular form to be impressed upon the manufacture; and I am of opinion that, under the present statute, if a new, and at the same time, useful, shape be devised for a particular article of the manufacture, even though no ornamental effect be produced thereby, the inventor of the same is entitled to protection for it under the design section of the patent law."

Upon mature deliberation, and in view of the different statutes and the decisions under them, I came to a different conclusion as to the purpose and scope of the law author-

izing the grant of patents for designs, and as to the meaning of the language of the statute, construed with reference to what I conceived to be the object of the law and the ground it covered as a supplement to the statutes authorizing the grant of patents for mechanical inventions. This conclusion I announced in the case of P. C. Parkinson (Commissioner's Decisions for 1871, p. 251). It was to the effect that the law authorizing design patents was intended to provide for a distinct class of inventions, "inventions in the field of æsthetics—taste, beauty, ornament;" that the words "useful," shape, in the statute relating to designs, refer to the utility of ornamental form and appearance rather than to that of operative mechanical function; and that by a design for an "article of manufacture" as the subject of a patent is to be understood ornamental forms of articles employed merely for decoration, the articles themselves, irrespective of mere ornamental form, frequently having mechanical utility. At last, in 1872, a case reached the Supreme Court of the United States, under the present statute, and the object of the law, at least, was definitely and authoritatively settled. The subject before the court was a certain ornamentation on the handles of table-forks and spoons. The court said:

"The Acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance, and that not an abstract impression or picture, but an aspect given to those objects mentioned in the acts."

* * * The thing invented or produced for which a patent is given is that which gives a peculiar or distinctive appearance to the manufacture or article to which it may be applied or to which it gives form. The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. It therefore proposes to secure, for a limited time, to the ingenious producer of these appearances the advantages flowing from them. Manifestly, the mode in which these appearances are produced has very little, if anything, to do with giving in-

creased salableness to the article. It is the appearance itself which attracts the attention and calls out favor or dislike. It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense. The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly, but, in whatever way produced, it is the new thing or product which the patent law regards. To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities. * * *

Identity of appearance, or, as expressed in McCrea *v.* Holdsworth, sameness of effect upon the eye is the main test of substantial identity of design. (The Gorham Manufacturing Company *v.* White, Official Gazette, vol. 2, p. 592.)

If the object of the law is to encourage "the decorative arts," and if "the appearance is the new thing or product which the patent law regards," then it must of necessity be exclusively ornamental appearance or conformation that is the subject matter of design patents. The active useful mechanical features or functions of devices, whether due to form or combination, are amply secured to inventors by the law authorizing what, for want of a better designation, have been termed mechanical patents. The only questions, then, when an "article of manufacture" is presented for patent, and there is a doubt as to which statutory class of patents it should be referred for protection, are: Is its form, without reference to the function of the article, intended to be ornamental, and is the article itself a thing which may, for any practical purpose, have a merely ornamental configuration, and therefore have, in that sense, sufficient utility to warrant the grant of a patent?

The body of a chimney-lamp cleaner is a mere swab, not intended for display, but for a very dirty use; and when not in use it is usually kept as far out of sight as possible. It is sought by the public, not for its beauty of contour, but because its form is adapted to fit and clean the interior of lamp-chimneys. This appears to have been the view of the applicant originally, when, as the examiner reports, he applied for a mechanical patent for this identical device. His application having been rejected upon references, he

apparently sought his remedy in an application for a design. The law is based upon the universal truth that the influence of the beautiful is beneficial to mankind, and there is no reason for excluding "the decorative arts" from recognition under the statute wherever there is room for real decoration. But the province of ornamentation is a high one, and the law should not be so applied as to degrade it. "The beauty of an ornament is one great test of its utility." (Magic Ruffle Co. *v.* Douglas, 2 Fish. p. 336.) There can hardly be sufficient utility in the way of ornamentation in the form of a swab for cleaning lamp-chimneys to justify the grant of a design patent.

I concur with the examiner that the merit of the form of this device relates wholly to its mechanical function, and not to ornamentation, and that the application does not embody proper subject matter for a design patent.

Appeal of FRED. G. & WM. F. NIEDRINGHAUS.

Supreme Court, District of Columbia.

Decided December 26, 1874.

8. O. G., 279.

In the matter of the application of Frederick G. and William F. Niedringhaus for a patent for a "Design for Ornament for Enameled Iron-ware," filed June 3, 1874. Appeal from the decision of the Commissioner of Patents.

1. A beautiful appearance does not of itself entitle an applicant to a design patent. The design must also be new and original, and the result of invention and genius.
2. Mere exhibition of skill on the part of workers in enamel in giving beautiful forms and colors to their productions, when they are the common efforts of persons ordinarily skilled in the art, is not the invention which is protected by the law.
3. The use of an old design is clearly excluded from patent by the statute, and mere change or "double use" cannot receive its protection.
4. The same degree of originality is required both in design and functional patents—that is, the claim must not comprehend what is already in existence.

5. A design consisting in a mere mottled appearance to be given to enameled iron-ware is not patentable.

MR. JUSTICE MACARTHUR delivered the opinion of the court:

This is an appeal from the decision of the Commissioner of Patents refusing a design patent in enameled ironware to Frederick G. Niedringhaus and William F. Niedringhaus. The statute in regard to design patents reads as follows:

"Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may upon the payment of the fee prescribed, and other due proceedings had, the same as in cases of inventions and discoveries, obtain a patent therefor." Section 4929 U. S. Rev. Stat.

In their specification, the applicants claim to have invented and produced a new and original design or ornament or pattern, to be printed, painted, or otherwise placed on, or worked into the various articles of enameled iron-ware which they make and sell. A photograph is annexed to illustrate the outline. They also say that, "the article itself, however, when completed, presents to the eye, a beautifully-mottled appearance, resembling granite in color, which the illustration fails to exhibit. It is this peculiar mottled appearance which constitutes the chief merit of our design, and it is on this we place most importance."

The primary examiner, the examiners-in-chief, and the commissioner have all concurred in refusing the application for the patent. The commissioner, in his decision, says:

"I concur in the opinion of the examiners-in-chief, so far as want of patentability in the general subject matter em-

braced by the application is concerned. The so-called design is effected by printing, painting, or in any other way placing upon ironware a peculiarly mixed color. The enameling of ironware in various colors is an art well known. If applicant has achieved anything new, it is to be found in the mixing of colors, by which he produces a mottled appearance having the effect of granite coloring. If he has in this way obtained a new paint, it may or may not be patentable; but the application of such a paint in an ordinary way does not constitute the subject matter of a design patent, even under the most liberal construction of the statute."

The court are unanimously of the opinion that the decision of the commissioner ought to be affirmed. The art of enameling has been practiced for many centuries, and the different kinds of enamel have been produced in every variety of shade and color. The materials used for the purpose of coloring, and the process by which they are fused, have been known so long that to change them requires only the taste and skill of one engaged in the business. The appellants, of course, do not mean to claim any exclusive title to what is so well known. But their specification certainly seems to suggest that the change of color "resembling granite," imparts great value to their invention. They say, "the mottled appearance, which constitutes the chief merit of our design, and it is on this we place the most importance." The specimen of enameled ironware exhibited by counsel on the argument was of a color resembling granite, and was marked by spots of different shades darker than granite. The enamel and coloring substances are manifestly liquified by intense heat, such as enamelers use, until they are completely fused, and they are laid upon the ironware in this condition. The spots are then formed at random, in larger and smaller patches, without regard to regularity or design of any kind. No two of the articles are alike, except to color and general appearance. It is undoubtedly ornamental to the article, and has a pleasing effect on the eye. This is equally true of the hundreds of objects upon which this art is employed. Ornamental work in great variety, and paintings that never lose their freshness, are executed in enamel. Indeed, the

primary object of this art is to impart greater luster and beauty to every article of luxury or utility to which it is applied. A beautiful appearance is not in itself patentable. The design must be new and original, and the work of invention and genius. The ingenuity and taste of workers in enamel are quite wonderful to all but those employed in it; but no one would imagine that these exhibitions of skill in giving beautiful forms or colors to their productions was the kind of invention to be protected by the law. They are the common efforts of persons ordinarily skilled in the art. The appellants contend in their brief that it matters not if the design has been previously used, if now combined with an "object" with which it has not been hitherto combined, and if, as a result of such association, a new and distinctive aspect is given to such object, the law is complied with, and refer to former decisions by the Commissioner of Patents as cases in point. We cannot concur in this view. The thing provided for in the law is in express language, "any new and original design for a manufacture;" "any new and original design for printing;" "any new and original impression;" "any new, useful, and original shape;" "the same not having been known or used by others before his invention or production thereof." The use of an old design upon an old object is clearly excluded by the statute, and mere changes or "double use" cannot receive its protection. Besides, it is now well understood that the same degree of originality is required in both design and functional patents. That is, the claim must not be for a copy or imitation of what is already in existence. If, for instance, the applicants should manufacture their ironware with the figure of a statue of the Three Graces, it might improve the appearance of the article, but would scarcely entitle them to the benefits of a patent. To manufacture it with enamel is a change of the same kind, for the same thing has been performed on metals from time immemorial. To give the enamel any particular color is a matter of ordinary skill and taste. The coloring substances have always been fused with the enamel in the heat of the furnace. We can, therefore, observe nothing in the present specification to which the term invention can be applied. I am aware that the Supreme Court of the United States,

in Gorham Company *v.* White, 14 Wall, 524, have said in regard to design patents, that "they contemplate not so much utility as appearance, and that not an abstract impression but an aspect given to those objects mentioned in the arts." That was an action brought for the infringement of a design patent for the handles of table-spoons and forks. The design consisted in the configuration of the spoon and the ornamentation of the handle. The outline and all the details of the design were new, and invariable in each spoon alike. No question was discussed as to the originality of the patent, for it had never been known before, and the court decided that the article manufactured and sold by the defendant did not differ substantially from plaintiff's, and that it was therefore an infringement. But the whole tenor of the decision is to the effect that the appearance or aspect of the object must be of a design that is new and original. Indeed, no other view is admissible, for such is the express requirement of the law.

The decision of the Commissioner is affirmed.

BENNAGE *v.* PHILLIPPI *et al.*—*Interference.*

Decided June 5, 1876.

9 O. G., 1159.

1. In an interference proceeding, the question of novelty should be first disposed of, and when that question is raised it controls the matter of jurisdiction of the Commissioner of Patents in adjudicating upon the rights of the parties.
2. In an application for a design patent, the arbitrary selection of the form of a now well-known and celebrated building to be applied to toys, inkstands, paper weights, etc., does not evince the slightest exercise of invention, industry, genius, or expense.
3. An alleged design, consisting of a mere imitation of an existing form or configuration, which any artisan has the right to apply to any object his fancy may dictate, is not properly the subject of a patent.
4. If neither the article produced, nor the appearance of it, is original, there is no evidence of what the law contemplates as originality, genius, or invention.

5. The same degree of originality is required in both design and functional patents—that is, the claim must not be for a copy or imitation of what is already in existence.

Doolittle, Assistant Commissioner:

This is an appeal from the Examiner of interferences refusing to dissolve the interferences between the applications.

All the applicants claim, as a new design, the figure of the Memorial Hall at the Centennial Exposition, in imitation of which they have shaped articles of manufacture. Phillippi works the design into a "metallic casting for toy banks, inkstands," &c. Stewart makes a paper-weight of that form, and Bennage an inkstand.

The motion to dissolve is based upon the ground that the design is intended in each case for different articles of manufacture, and that the law gives protection to any design that may be placed for the first time upon a particular article of manufacture, notwithstanding the fact that the same design may have been used upon other articles of manufacture; that the article in each case was not for an analogous purpose, and that, therefore, the further objection of double use of the design does not apply.

As the question of patentability, when raised in an interference case, controls the matter of jurisdiction of the Commissioner in adjudicating the rights of the parties, it becomes necessary that that question should be first disposed of. It is impossible to determine whether this interference should continue without first considering the grounds on which it was declared.

The Primary Examiner originally rejected each of these cases for the reasons that no one of them contained patentable subject-matter; that the proposed design was not original with any of the applicants; that its adoption in these articles was not the result of invention, and therefore not entitled to the protection of the patent laws. Upon appeal this decision was reversed by the Board of Examiners-in-Chief.

Section 4929 provides that—

"Any person who, by his own industry, genius, efforts and expense has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-

relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture to be printed, painted, cast, or otherwise placed on, or worked into, any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor."

Section 4933 provides that—

"All the regulations and provisions which apply to obtaining or protecting patents for inventions or discoveries, not inconsistent with the provisions of this title, shall apply to patents for designs."

The articles in question are probably included within the phrase, "any new, useful, and original shape or configuration of any article of manufacture."

Comparatively few adjudications of design patents have been had by the United States courts in which a construction of the law has been given. The first decision which I have been able to find setting forth the purpose of the design patent act is that of Wooster *v.* Crane, (2 Fish. 583). In that case the patent had been granted the complainant for a design and configuration of a reel in the shape of a rhombus. The statute relied on by complainant was the Act of March 2, 1861, Section 11, which, in its provisions as to patentability, is substantially the same as the present law. The court there held:

"In this case the reel itself, as an article of manufacture, is conceded to be old and not the subject of a patent. The shape applied to it by the complainant is also an old and well-known mathematical figure. Now, although it does not appear that any person ever before applied this particular shape to this particular article, I cannot think that the act quoted above was intended to secure to the complainant an exclusive right to use this well-known figure in the manufacture of reels. The act, although it does not require utility in order to secure the benefit of its provisions, does require that the shape produced shall be the result

of industry, effort, genius, or expense, and must also, I think, be held to require that the shape or configuration sought to be secured shall at least be new and original as applied to articles of manufacture. But here the shape is a common one in many articles of manufacture, and its application to a reel cannot fairly be said to be the result of industry, genius, effort, and expense. * * * * No advantage whatever is pretended to be derived from the adoption of the form selected by the complainant, except the incidental one of using it as a trade-mark. Its selection can hardly be said to be the result of effort even; it was simply an arbitrary chance selection of one of many well-known shapes, all equally well adapted for the purpose. To hold that such an application of a common form can be secured by letters patent, would be giving the Act of 1861 a construction broader than I am willing to give it."

I have quoted this decision thus fully for the reason that by substituting therein the present design for the one there mentioned, the reasoning and conclusions would be precisely the same; and also, because the doctrine in that case has never been reversed or departed from by the courts.

The arbitrary chance selection of the form of a now well-known and celebrated building, to be applied to toys, ink-stands, paper-weights," &c., does not, in my opinion, evince the slightest exercise of invention, industry, effort, genius, or expense. It is a mere imitation which any artisan has the right to apply to any object his fancy may dictate. And as the objects of fancy are innumerable, so the number of patents for this design might also be innumerable if the government were foolish enough to grant them.

It is true that the Supreme Court, in the Gorham Manufacturing Company case (14 Wall. 511) speak of the value of manufactured articles being enhanced by giving them new and beautiful appearances, and that the object of the law was to protect the producers of such appearances in the right to use them, but at the same time they distinctly allude to such appearances as having been "invented or produced," and add that the law "proposes to secure for a limited time to the ingenious producer of those appearances the advantages flowing from them."

They describe these original designs as the "finished

products of invention." The mere abstract idea or impression is not patentable, but becomes so when it has been or is to be applied to some particular article. If neither the article nor the appearance given it is original, wherein consists the originality, genius, or invention of the "finished product?" It is not like a patentable combination in mechanics, where two or more old elements may be combined to produce a new result, but the element here called the appearance, must, in all cases, be a new and original one.

Say the Supreme Court of this District, in the late case of Niedringhaus (8 Official Gazette, 279):

The appellants contend in their brief that "it matters not if the design has been previously used, if now combined with an object with which it has not been hitherto combined; and if, as a result of such association, a new and distinctive aspect is given to such object, the law is complied with," and refers to former decisions by the Commissioner of Patents as cases in point. We cannot concur in this view. The thing provided for in the law is in express language,—"any new and original design for the manufacture;" "any new and original design for printing;" "any new and original impression;" "any new, useful, and original shape;" "the same not having been known or used by others before his invention or production thereof." The use of an old design upon an old subject is clearly excluded by the statute, and mere changes or "double use" cannot receive its protection.

Besides, it is now well understood that the same degree of originality, is required in both design and functional patents. That is, the claim must not be for a copy or imitation of what is already in existence.

And in alluding to the Gorham case, they add:

I am aware that the Supreme Court of the United States in Gorham Co. *v.* White (14 Wall. 524), have said in regard to design patents, that "they contemplate not so much utility as appearance, and that not an abstract impression, but an aspect given to those objects mentioned in the acts."

That was an action brought for the infringement of a design patent for the handles of tablespoons and forks. The design consisted in the configuration of the spoon and the ornamentation of the handle. The outline and all the

details of the design were new, and invariable in each spoon alike. No question was discussed as to the originality of the patent, for it had never been known before, and the court decided that the article manufactured and sold by the defendant did not differ substantially from plaintiff's, and that it was therefore an infringement. But the whole tenor of the decision is to the effect that the appearance or aspect of the object must be of a design that is new and original. Indeed, no other view is admissible, for such is the express requirement of the law.

The Acts of Congress "were plainly intended," as the United States Supreme Court said, "to give encouragement to the decorative arts," but the authority for their enactment is the same provision of the Constitution that authorizes the grant of patents generally, and which provides for securing, for limited times to inventors, the exclusive right to their discoveries.

This provision has never been regarded by Congress or the courts as offering protection to servile imitators either in mechanics or the fine arts, but to encourage and protect the products of inventive genius.

This interference is, therefore, not only dissolved, but the applications will stand rejected.

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Ex parte D. L. PROUDFIT.

Decided September 28, 1876.

10 O. G., 585.

1. The rejection of an application on the ground that it does not present the proper subject-matter for a design patent goes to the merits of the case, and may be appealed to the board.
2. The board have appellate jurisdiction whenever a statutory bar is interposed and the patentability of the subject is denied.
3. Only such matters as affect office practice and are interlocutory in their nature are appealable direct to the Commissioner.
4. All the reasons for rejecting an application should be given at once.

Duell, Commissioner:

The examiner has refused to consider this case, upon the ground that it does not "present proper subject-matter for a design patent," in view of certain decisions of the Commissioner.

The attorney, recognizing the former practice of the office in this particular, inquires whether his proper course is to appeal to the board or to the Commissioner in person.

Heretofore, matters of this kind have uniformly been disposed of by the Commissioner on interlocutory appeal, but such proceeding, I am convinced, was erroneous.

The Supreme Court, in Commissioner of Patents *v.* Whitely (4 Wallace, 522), decided that an application must be received before it can be acted upon, and that if the Commissioner actually refuse to receive an application a mandamus would lie to compel him, but that a mandamus would not lie where there was a remedy by appeal, as in the case of a refusal to allow the application after it had been received.

The statute provides that whenever an application is twice rejected, an appeal may be taken to the Board of Examiners-in-Chief, from them to the Commissioner, and thence to the Supreme Court of the district.

This has reference to all matters which go to the merits of the invention, and applies whenever a statutory bar is interposed and the patentability of the subject denied.

Only such matters as affect office practice and are interlocutory in their nature are appealable direct to the Commissioner in his executive or ministerial capacity.

In the case under consideration the objection clearly affects the merits, and involves the question of its patentability under the statute. The appeal should, therefore, be addressed to the board.

The examiner is directed to present all his objections to the application, so that a second appeal will not be necessary should his decision on this question be overruled.

Ex parte OTTO PRESSPRICH.

Decided February 1, 1877.

11 O. G., 195.

The rejection of an application upon the ground that it does not constitute the proper subject-matter for a design-patent, has reference to the merits, and is appealable to the board.

Doolittle, Acting Commissioner:

The examiner denies that the matter included in this application is the proper subject for a design patent, and, upon his suggestion, applicant takes this appeal.

The practice in this matter was changed in the case of D. L. Proudfit (10 Official Gazette, 585), where it was determined that the rejection of an application, on the ground that it does not present the proper subject-matter for a design patent, has reference to the merits of the case, and is subject to revision by the Board of Examiners-in-Chief upon appeal.

The case does not, therefore, come under the provisions of Rule 44, with reference to preliminary or intermediate questions, and the appeal is accordingly dismissed.

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Ex parte PARKER.

Decided November 13, 1877.

13 O. G., 323.

Appeal from the decision of the Examiner of Trade-marks in the matter of the application of Thomas E. Parker, filed August 8, 1877, for Registration of a Label.

1. **Registrable prints or labels and trade-marks are recognized by the terms of the law, and the decisions of the courts, as applicable only to some kind of merchandise.**

2. **Labels give the names of manufacturers, place of manufacture, nature or quality of goods, directions for use, &c. Trade-marks are arbitrary symbols, which serve to distinguish the**

manufactured goods from those of a similar character made by other persons. Both are affixed in some manner to the goods they designate, and are not an essential constituent of the merchandise itself.

3. Hence, the figure of a boy, together with certain words, printed in minute squares upon a sampler-card, is the subject of a design patent. It is not to be attached as a distinguishing label or symbol to certain merchandise, but is the article itself.

Doolittle, Acting Commissioner:

Applicant described his label as consisting of the figure of a boy, and the words "Scratch my back," surrounded by a border of parallel lines, as shown, the figure and the words being formed of numerous squares, printed and arranged as represented. This label is for use on cards, or sheets of abrasive paper or cloth, and as a pattern for sampler-work, to be wrought on the squares, in order to so finish the label when desirable. The cards thus labeled are intended for use in firing friction-matches.

I am informed that it is quite common to work designs of precisely this character upon the back of abrasive paper or cloth, but the question of novelty is not the one at issue, but rather that of identity. Is it a label, trade-mark, or should it be copyrighted?

As held in the Simpson case (10 Official Gazette, 333), one definition given by Webster of a label is about what the office regards as being the proper matter to be registered as such. "A narrow slip of silk, paper, parchment, &c., affixed to anything denoting its contents, ownership, and the like, as the label of a bottle or a package." So far as this definition includes fanciful and arbitrary matter, which may be used for the sole and independent purpose of a trade-mark, to denote origin or ownership, it is not applicable to matters registered as labels.

Registrable labels or prints and trade-marks are recognized by the terms of the law and the decisions of the courts as applicable only to some kind of merchandise; labels, as giving the names of the manufacturers, place of manufacture, nature or quality of goods, directions for their use, and the like; and a trade-mark as some arbitrary

symbol to distinguish the same from those goods of a similar character made by other persons.

The trade-mark statute requires applicants to specify "the class of merchandise and the particular class of goods comprised in such class" to which the mark has been, or is intended to be, appropriated.

The section of the copyright law relating to labels provides that no prints or labels to be used for "any other articles of manufacture" than pictorial illustrations of works connected with the fine arts shall be entered under the copyright law, but may be registered in the Patent Office.

And the penal Act of August 14, 1876, embracing within its terms both trade-marks and labels, applies to the fraudulent affixing of them to goods or packages containing the same.

The courts have always sustained trade-marks and labels on precisely the same principles, and they uniformly discuss these matters as having been fixed, in some way, to goods, as merchandise, and not as constituting the merchandise itself.

This was remarked by the learned judge in the case of Moorman *v.* Hoge (2 Sawyer, 78), in passing upon an alleged trade-mark. He stated that he had examined with care a large number of cases involving infringement of trade-marks, including all the recent cases which he had been able to find bearing upon the question, and that he had found no case in which the use of an article or package containing it had been enjoined, unless there was some symbol, word, letter, or form impressed or affixed to the article, and which, considered separately from the article or package, was used as the trade-mark.

This view of the law was also approved by the United States Circuit Court for the Southern District of New York, in the case of Harrington *v.* Libby (12 Official Gazette, 188).

In the present instance, then, the matter sought to be registered is not a label, print, or a trade-mark affixed to goods or merchandise, to denote ownership, or the character of the goods, and the like, but is the article itself—a fanciful pattern wrought or to be wrought into or upon the

article—forming part of the article and giving to it a certain value, by way of a new appearance, like a new pattern worked upon a slipper.

Neither is it designed to be published as a work of fine art, and therefore is not the subject of copyright.

We are now led to consider whether the design act applies to the case.

The law relating to designs provides for the granting of patents to those who, among other things, have invented and produced "any new and original impression, ornament, pattern, print, or picture to be printed, painted, cast, or otherwise placed on, or worked into, any article of manufacture."

The Supreme Court have held that the object of this act was to extend the protection of a patent to the ingenious producer of new and original appearances given to manufactured articles, whereby their salable value was enhanced, and the demand for them enlarged.

They add that this appearance may be the result of the peculiarity of configuration or of ornament alone, or of both conjointly. Gorham Manufacturing Company *v.* White, 14 Wall., 511.

In view, then, of the fact that the matter in question is ornamental in character, and is to be incorporated into the structure of the article, to be a permanent part thereof, I am of opinion that it comes within the terms and meaning of the design act. See case of White, Com. Dec., 1871, p. 304.

The subjects to be protected under the design, copyright, label, and trade-mark acts are often so nearly the same in character that it is difficult always to say to which class they belong, especially in the absence of definitions in the statutes, but these provisions differ in some respects so widely that the executive departments must give them some positive interpretation to insure an orderly administration of public business.

The decision of the Examiner of Trade-marks is affirmed.

Ex parte ROGERS *et al.*

Decided April 2, 1878.

13 O. G., 596.

1. An application for a design patent in analogy to an application for a mechanical patent need not be divided if the separate subordinate designs to which claim is made form, when united, one principal and complete design.
2. Nor is there objection to making claim to each subordinate feature, provided it is of a distinct and separable part of the whole design.

Spear, Commissioner:

This appeal is taken from the ruling of the examiner requiring a division of the application. The application is for a patent for a design consisting of a screw-head formed to represent a crown surmounted by a cross, together with a base of peculiar shape and configuration, to which the screw-head is fitted.

Two claims are made: one for the design of the screw-head, and the other for a design of the base plate. It is represented that although the two are especially fitted for each other, and form when in place one complete design, yet that the screw-head may be used with an entirely different shape of base, and the base may be used with an entirely different shape of screw-head.

The examiner, following the decision of the acting commissioner in *ex parte* Brower, Com. Dec., 1873, p. 151, required a division of the application, holding that the subject matter was such as to be properly in two distinct applications. The decision quoted may possibly go to that extent, but I cannot agree with it, and think that it would be unnecessary hardship to require the applicant to make two separate applications and take out two separate patents, both parts forming, when united, one complete design, while, as has been stated, they are separable, and can be used without the other with good effect.

If each design is patentable at all, I do not see why they might not be claimed as parts of one whole.

The law relating to design patents provides "that any person who, by his own industry, genius, efforts, and expense, has invented or produced any new or original design, &c., * * * may, upon payment of the fee required by law and other due proceedings had, the same as in cases of invention or discoveries, obtain a patent therefor."

The law plainly indicates what seems in itself reasonable, that the same principle should be applied in the issue of design patents, so far as they may be applicable, as those which govern in the issue of patents on what are called mechanical subjects.

I cannot conceive of any reason for refusing to allow particular claims for the particular elements of a design any more than for refusing to grant claims for subordinate elements and combinations in a machine, provided the parts are distinct and separable, and at the same time go to make up with beneficial effect the whole design.

The decision of the examiner is reversed.

———o———

Ex parte BEATTIE.

Decided May 3, 1879.

16 O. G., 266.

More than one separate and independent design cannot be claimed in the same application; but, where the design is an entirety, a claim for the entire design, as well as claims for sub-combinations of the parts, is allowable.

Applicant claims—

1. The design herein described for the handle of a spoon or analogous implement, consisting of the general configuration of a spear-head or dart, having a blunted point and obtuse angles upon the sides.

2. The handle made in the form of a spear-head with obtuse angled sides and a blunted point, and having an enlargement at c, between the same and the shank, as shown and described.

Doolittle, Acting Commissioner:

The examiner's objections to these claims, in matter of form, are twofold:

First.—That the claims do not embrace the ornamentation.

Second.—That they present two independent designs, and not a unitary device.

As to the first objection, the claims and descriptions are made as to mere configuration, without regard to ornamentation, and this, under the law, is permissible. Applicant might have claimed the ornamentation without regard to the configuration.

As to the unity of the design, all the parts are included in the second claim, and this properly should be the first claim. The first claim is for a sub-combination of the features, omitting the enlargement, c.

Care should be taken that an application for a design patent does not embrace claims for more than one separate and independent design. In such case the application should be divided, as in other classes of inventions. But where one claim is made which covers the entire device, there is no reason why the practice in other classes of also making claims for combinations of the separate features should not be here permitted. (Sheppard, *ex parte*, Com. Dec., 1870, 22.) Otherwise an infringer might use with impunity almost the entire design. In the present case for instance, if the design could only be claimed in one form, with the enlargement, c, near the shank of the handle as an unvarying part thereof, another would not invade applicant's right, as claimed, by omitting this enlargement and using the rest of the design, which is, by all odds, the most conspicuous and important part thereof.

If an applicant is the inventor of a design as an entirety, as well as of each of its parts or several of its parts in combination, his claims should be commensurate to his rights.

The decision of the examiner is reversed.

Ex parte SHOENINGER.

Decided November 20, 1879.

15 O. G., 384.

Under Section 4929 of the Revised Statutes a design patent may be granted for any shape or configuration of an article of manufacture which is new and useful, whether it is or is not at the same time ornamental.

Paine, Commissioner:

The question is, whether, under Section 4929 of the Revised Statutes, a patent may be granted for a "shape or configuration of any article of manufacture," which shape or configuration is useful, whether it is or is not also ornamental. It is not to be denied that the record of the office on this question is somewhat ragged. The decisive words of the section (Rev. St., 4929) are these: "Any new, useful, and original shape or configuration of any article of manufacture." The corresponding clauses of the Acts of 1842 and 1861 took the following form: "Any new and original shape or configuration of any article of manufacture."

The word "useful" was first employed in the Act of 1870, and constitutes the only point of difference between that act and the Acts of 1842 and 1861, so far as the clause in question is concerned.

On the 20th of April, 1869, the Commissioner said, in Crane's case (1869, C. D., 7) that since the passage of the Act of 1842 it had been construed in the Office as exclusively applicable to designs for ornament; but he concluded that this construction was erroneous, and stated his opinion of the effect of the Act of 1842, in the following words:

"Whenever there shall be produced by the exercise of industry, genius, effort, and expense, any new and original design, form, configuration, or arrangement of a manufactured article, it comes within the provisions and objects of the act creating design patents, whatever be its nature, and whether made for ornament merely or intended to promote convenience and utility."

On the 2d of December, 1869, a succeeding Commissioner, in Bartholomew's case (1869, C. D., 103), expressed the same opinion as to the effect of the Acts of 1842 and 1861, but questioned the accuracy of this statement respecting the previous construction of those acts in the office. He said:

"Fortunately no such uniform practice has existed, and the office is relieved from so grievous an imputation. The practice seems to have been taken for granted by the appellate tribunals, and, so far from being as stated, is, as nearly as possible, the reverse of it. Articles have been and are being constantly patented as designs, which possess no element of the artistic or ornamental, but are valuable solely because, by a new shape or configuration, they possess more utility than the prior forms of like articles. Of this character are designs for ax-heads, for reflectors, for lamp-shades, for the soles of boots and shoes, which have been heretofore patented as designs; and to this class might be added, with great propriety, that class of so-called mechanical patents granted for mere changes of forms, such as plow-shares, fan-blowers, propeller blades, and others of like character. * * * I am of opinion that the class of cases named in the act as arising from new shape or configuration includes within it all those new changes of form which involve increase of utility."

In Fenno's case, decided February 27, 1871, after the enactment of the law of 1870, the Acting Commissioner said:

"I am of the opinion that, under the present statute, if a new and, at the same time, useful shape be devised for a particular article of manufacture, even though no ornamental effect be produced thereby, the inventor of the same is entitled to protection for it under the design section of the patent law." (1871, C. D., 52.)

But, on the 25th of September, 1871, a third Commissioner, in Parkinson's case (1871, C. D., 251), questioned the doctrine of Bartholomew's case. He decided that usefulness, in the sense of the Act of 1870, consisted in adaptation to the production of pleasant emotions; in other words, that the term "useful" means pleasing, in the clause authorizing the issue of a patent for "any new, useful,

and original shape or configuration of any article of manufacture."

My attention has been called to no judicial authority beyond a dictum in Gorham Manufacturing Company *v.* White (14 Wall., 511), decided under the Act of 1861, in the following words:

"The acts of Congress which authorize the grant of patents for designs were plainly intended to give encouragement to the decorative arts. They contemplate not so much utility as appearance, and that not an abstract impression or picture, but an aspect given to those objects mentioned in the acts."

If, using language in a very broad, not to say fanciful, sense, we may predicate utility of mere beauty, it is nevertheless, certain that in the language of legislation, as well as of common life, the words useful and ornamental are not so employed; and that such an extraordinary meaning as that adopted in Parkinson's case cannot fairly be imputed to the word useful in the statute seems to be very clear. In my opinion, the provision as it stood in the Acts of 1842 and 1861 covered designs which were ornamental, although they were at the same time useful; and the provision as it stands in the Act of 1870 covers designs which are useful, whether they are or not ornamental. The weight of authority seems to be in favor of this view of the law.

The examiner's objection in this case is not that the design is for a shape or configuration wholly useful, but that it is not for a shape or configuration wholly ornamental. He thinks the presence of utility as one of the qualities of the design renders it unpatentable, notwithstanding the simultaneous presence of beauty as another quality.

But I think that if the design is new and original, and also useful, it is patentable under the law, whether it be or not ornamental or beautiful.

The examiner will conform his action in the case to the foregoing opinion.

The decision of the primary examiner is affirmed.

Ex parte PALMER.

Decided November 30, 1881.

21 O. G., 1111.

A previous mechanical patent is of itself no bar to the grant of a patent to the patentee therein for a design shown in such patent. Former decisions commented on and disapproved.

Marble, Commissioner:

This application comes before me upon a question of law, submitted by the examiner of designs, as follows:

"Can an application for a design patent be properly rejected upon a mechanical patent to the same party showing the same design?"

It appears that this question has been already considered by three different Commissioners; but the applicants in this case and in another, in which the same point has arisen, urge that in view of a recent decision of Mr. Justice Blatchford in Collender *v.* Griffith (18 O. G., 241), the former practice of the office is improper, and should be discontinued.

The decision by Commissioner Fisher in *ex parte* Stuart and Bridge (Com. Dec., 1870, 15), was made under the Act of 1861, which contained a different provision in reference to prior knowledge and use from the Act of 1870, and hence has no weight in the present case.

The decision in *ex parte* Kohler (Com. Dec., 1873, 84) was based upon the ground that if a design patent should be granted, any subsequent assignee of the mechanical patent could not use the form in which the inventor originally embodied his invention, and that he must consequently be considered to have "dedicated it to at least any person who now does or may hereafter own the mechanical patent." To bar the grant of a patent upon the ground of abandonment, such abandonment must be to the public, and not simply to the assigns of the inventor, and hence it seems that the position taken by the commissioner in this case is not tenable.

In *ex parte* Towne & Taylor (19 Com. Mss. Dec., 6) which also presented the same question, the Commissioner

allowed a design patent upon the ground that the parties in the patent and application were not the same, the design being shown in a previous mechanical patent to Taylor, but being, in fact, the joint invention of Taylor and Towne. He, however, approved the decision in Kohler's case, though basing his approval upon the ground that the previous mechanical patent was a publication.

As the statute requires, in order to defeat the grant of a patent, that a publication shall be made before the invention or production of the subject matter thereof, it does not appear how the previous mechanical patent can have such effect. If the design was invented by the patentee at all it must have been invented before the filing of the application for the mechanical patent in which it is shown, and hence a publication, to be a bar, must have been made before the invention of the mechanism embodying the design.

The point which arises here is not exactly the same as that in Collender *v.* Griffith, above referred to, the design patent in that case having been first granted, and the question at issue was whether it was a bar to a subsequent mechanical patent, but the principles laid down by the court are equally applicable to the present case. The court says:

"The claim of the design patent is to shape. The claim of the reissued mechanical patent is a claim to a mechanical combination. The shape of the structure may be the same as the shape in the design patent, but the subject matter of the two claims is not the same. The shape covered by the claim of the design patent may be attained without following the mechanical combination claimed in the reissued mechanical patent."

There seems to be no doubt that the court by this language meant to declare the subject matter of design and mechanical patents to be entirely different. Nothing else could have been intended, for in the one case ornament is the basis, and in the other mechanical function. It therefore follows that whichever kind of patent is first obtained by an inventor it will not be a bar to the grant to him of a patent of the other kind.

It has long been held by the office that where the applicant is the same, a previous design patent is no bar to the

grant of a mechanical patent (*ex parte* Bartholomew, Com. Dec., 1871, 298, and Collender, Com. Dec., 1872, 217), and I am also of the opinion that of itself a previous mechanical patent is no bar to the grant of a patent to the patentee therein for a design shown in such patent.

The view herein taken accords with that of the court in Burton *v.* Greenville (18 O. G., 411), where this precise question arose, but which they did not think it necessary to decide. They say:

"A question is made by the defendants whether an inventor is not to be presumed to abandon his design when he exhibits it in the drawings of a mechanical patent. I do not see why this consequence should follow until the design has been in use for two years."

———o———

Ex parte NORTON.

Decided June 16, 1882.

22 O. G., 1205.

1. The term "useful" in the patent law is used in contradistinction to "mischievous." A design, if not mischievous, is useful if it is attractive, and the utility consists in such a shape or configuration of a given article that persons needing it will purchase it because of such shape or configuration in preference to other articles for the same purpose, but different in shape or configuration.
2. Matter descriptive of the mechanical functions of a device should be omitted from a design application.

Marble, Commissioner:

Applicant claims as a new article of manufacture—

"The T-shaped shingle machine frame, consisting of the parts a and b, the part b being the jointer-casing and supporting the saw-arbor, substantially as set forth and illustrated."

Two of the examiners-in-chief unite in holding that the decision of the primary examiner should be affirmed, but on different grounds.

The statute provides that design patents, among other things, may be granted for "any new, useful, and original shape or configuration of any article of manufacture." It is not denied that what is claimed here is an article of manufacture, and that it is new, but its utility seems to be questioned. An examination of the representation of the article shows that for its functional or mechanical use it is useful, being strong and compact, and in such shape as to recommend it to those engaged in the business for which it is intended. Such being the case, the question arises as to whether it is useful as a design for a shingle-machine frame. "'Useful,' in the patent law, is in contradistinction to 'mischievous.' The invention should be of some benefit." (Cox *v.* Briggs, 2 Fish., 174.) A design, if not "mischievous,' is useful if it attracts persons to it or to articles made like it. It may not be of great artistic excellence, but if it be attractive it is useful.

So, I think, in articles of manufacture like the one under consideration, if the applicant has by his industry, genius, and efforts made a design of an article of manufacture—viz., the frame of a shingle-machine—which, because of its design and not because of its mechanical structure (by which I mean its strength and durability), commends itself to persons desiring to purchase such articles, it is useful, and the applicant should be protected in its manufacture and sale. It is not necessary that it should be ornamental, although it may be, to entitle the applicant to a patent therefor. The utility in an article of this kind consists in having a shape or configuration of such a character that persons needing it will purchase it because of its shape or configuration in preference to other articles for the same purpose but different in shape or configuration. Applicant, however, must strike out of his application everything descriptive of the mechanical functions of the device.

The decision of the Board of Examiners-in-Chief is overruled, and the patent will be allowed.

Ex parte POPE.

Decided June 30, 1883.

25 O. G., 290.

1. A claim for other than the entire design, or a distinctive integral part thereof, not allowable.
2. In an application for a design patent, a claim merely for a portion of the design, capable of being attached or connected with different forms to make up an entire whole, is inadmissible. The claims must be restricted to the entire design and distinctive, segregable, integral parts thereof.

Marble, Commissioner:

Appeal is taken from the decision of examiners-in-chief affirming the decision of the examiner rejecting the following claim, viz.:

"The upper portion of a seat-riser ornamented with segments or arches, a, a, a, (the centre arch terminating in knob-like portions, c, c,), the bifurcations at o, and the hook-like parts, b, b."

A claim for the entire design has been allowed. Applicant now desires to have a claim for the upper portion of the design, because, as he alleges, the lower portion thereof may be varied, and thereby the invention rendered of little or no value. The examiner and the examiners-in-chief unite in holding that the claim is not for a definite, segregable, distinctive part of a design, but only for a part of an entire whole, and hence is not allowable. Applicant cites certain patents in which segregable portions of an entire design were allowed to be covered by separate claims, and urges that because such claims were allowed this claim should be, although the matter described is not segregable as presented from the entire design. He also calls attention to the fact that distinct parts and distinct combinations in machines are permitted to be covered by distinct claims.

I think applicant fails to draw the line where it is drawn in the decisions referred to, either in granting the patents mentioned or in deciding what may be covered by claims. An invention is an entirety, and when a patent is issued covering an invention, if properly issued, it covers the

entire invention. If it be a machine, the invention may be made up of many parts and many combinations, each of which in itself is integral, and under the practice claims for such parts or combinations are allowable.

The claim here presented is not for an integral part of a design, nor is it for an entirety; but it is rather for a portion of a design which is capable of being attached or united with different forms to make up an entire whole. It is because the portion sought to be covered by this claim is susceptible of such attachment or arrangement that applicant desires a separate claim therefor. I think his desire to have it covered by such claim arises from a misapprehension of the law. It is not every colorable change which may be made in a design, which renders it patentable. On the contrary, designs which in general appearance are the same are held to be the same designs, although in some particulars they may be varied, either intentionally or otherwise. (See Gorham Mfg. Co. *v.* White, Simonds on Design Patents, pages 30 to 50.) If, therefore, a design should be manufactured by some other person or company having the upper portion of the seat-riser the same as the one here presented and claimed, with the lower portion of some other form of construction, it would clearly be an infringement of this design, the part which would attract the eye and give general appearance to the structure being the upper rather than the lower part.

I find no error in the decision of the examiners-in-chief, and therefore affirm the same.

Ex parte LEE & SHEPARD.

Decided September 8, 1883.

24 O. G., 1271.

Matter patented as a design cannot be registered as a trade-mark.

The office, after having adjudicated certain subject-matter patentable as a design, and granted a patent therefor, thereby giving the patentee the exclusive right to use the same for the term of years mentioned therein, cannot register as a trade-mark substantially the same design, and give to another and different party the right to use it as a trade-mark.

Marble, Commissioner:

Applicants' appeal from the decision of the Examiner of Trade-marks refusing registration of "an ornamental book-cover, having projecting beyond the edges thereof silk or other fringe." The examiner refused registration for two reasons: first, because the book-cover described is anticipated by Design Patent No. 13,040, to G. Bourck, dated July 18, 1882; and, second, because the book-cover is not a trade-mark. The book-cover here claimed is in all essential particulars the same as the card-cover patented as a design to Bourck. Bourck has the right under said patent to use his design not only as a cover for cards, but for books as well. There can be no question that the subject-matter covered by Bourck's design patent was patentable as such.

While it is true that a design may be used as a trade-mark, and that which is properly the subject for a design patent may also be the proper subject for a trade-mark, still the office, after having adjudicated certain subject-matter patentable as a design, and granted a patent therefor, thereby giving the patentee the exclusive right to use the same for the term of years mentioned therein, cannot register as a trade-mark substantially the same design, and give to another and different party the right to use it as a trade-mark. Conflict in the rights of parties would at once arise. One would claim that he had the right to sell his production under his trade-mark, and the other under his design patent. The office should not knowingly bring about such a controversy.

Bourck filed his application long before Lee & Shepard's application was filed, and took his patent in the regular course of proceedings. The office will do nothing to cast a shadow upon his title to the invention covered by his patent.

As the decision of the examiner must be affirmed on the first point, it is unnecessary to consider the second. The decision is affirmed.

Ex parte TRAITEL.

Decided November 12, 1883.

25 O. G., 783.

1. A design is merely a delineation of form or figure, either plane or solid—a shape or configuration. The character of the material, or the colors in which a design finds expression, form no part of it, and are of no possible importance in describing the design itself.

2. There is no design which is not capable of delineation and description on paper, one or both, such delineation being the primary means; but where the forms are known forms, as in the case of geometrical figures, language may be employed as an auxiliary to describe them.

3. A grouping together of certain materials in an article of manufacture, so as to produce an ornate effect, may be patented as an article of manufacture, in which case the applicant may properly mention the mechanical structure, character, and qualities of materials, colors, &c.; but if he wants to patent a design, he must confine himself to a delineation of the form, shape, or configuration the manufactured article is to assume. He must not prepare his specification under one classification, as a predicate for asking a patent under another separate and distinct class.

4. If the examiner decided erroneously in a former case, it will hardly be urged that such decision under the rule *stare decisis* would bind the appellate tribunal.

Butterworth, Commissioner:

This case comes up on appeal from the decision of the primary examiner.

The appellant makes application for a patent for a novel design for finger-ring settings. The examiner held the specification to be defective, on the ground that the materials, color, and mode of manufacturing the article for which the design is intended are improperly referred to and described therein; that, instead of describing a design for an article of manufacture, the applicant in fact describes

an article of manufacture and the materials and mode of constructing it.

The specification is in the following language, viz:

"My invention relates to a novel design for finger-ring settings, and consists in a stone formed with a depression in which is mounted a metallic ornament, said depression being greater in extent than its contained ornament, so as to be distinctly visible, as will be hereafter more fully described.

"Previous to my present invention, finger-ring settings have been made with stones, in the faces of which have been engraved initial letters, monograms, or other things; and settings have also been made in which the stones thus engraved or cut have been provided with metallic letters, monograms, or other things which were set within the engraved or cut portions of the stones, so as to wholly fill the same and present a substantially smooth and unbroken exterior surface.

"I have illustrated my invention in the accompanying drawings, in which I have shown at figure 1 a top view, at figure 2 a side view, and at figure 3 a cross-section taken at the line xx of figure 2.

"In the several views the same part will be found designated by the same letter of reference.

"A is the shank or band of the ring, and B the metallic base or bearing for the stone ornament C, which latter is provided with a depressed or sunken portion, c, within which is mounted or arranged a metallic letter, b, preferably of gold. The depression c in the stone C, I make of greater area than is necessary to encompass the metal letter b, so as to be clearly visible, and show in relief its contained ornament.

"I have shown my invention embodied in a stone rectangular in contour and curved in form, but do not consider the same as limited to a stone of any particular shape or color; and, although I have shown the depression in the stone elliptical in outline, this may be changed without departing from the spirit of my invention; and of course, instead of the metallic letter T shown, any other metallic letter or monogram or device may be used.

"The ends of the shank of the ring are shown, orna-

mented with a series of curved notches, n, and perforations, m; but this ornamentation may be used or not with a setting containing my invention, at the pleasure of the manufacturer.

"What I claim as my invention, and desire to secure by design letters patent is—

"1. A finger-ring having substantially the configuration and ornamentation shown and described.

"2. A finger-ring setting of stone, formed with a depression, c, in which is arranged a metallic ornament, substantially as shown and described.

"3. A finger-ring setting consisting of a curved stone having a depression, c, elliptical in outline, in which is arranged a metallic ornament, substantially as shown and described."

The points raised on this appeal may be determined by correctly answering the following questions:

First. Does the specification describe a single specific design?

Second. Is the design described in appropriate terms?

Third. What is a design as contemplated by the statute?

SECTION 4899. "Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new or original design for a manufacture, bust statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, patent (pattern), print, or picture to be printed, painted, cast or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor."

A design is merely a delineation of form or figure, either plane or solid—a shape or configuration. The construction of an article in accordance with that delineation is the materialization of the conception of design. The conception of a building of some particular shape, form, or con-

figuration, and which is delineated on paper or described in language, is a design. The various shapes and figures which appear in colors on the surface of prints and carpets are the expression of so many different designs.

The material out of which the building is constructed, whether of stone, brick, wood, or glass, forms no part of the design. The character of the material, whether velvet, cloth, cotton, or wool, upon which the designs find expression, form no part of the design. The colors in which they find expression are of no possible importance in describing the design itself. A combination of red and blue and green may be beautiful, and the effect very desirable, but it forms no part of the design, but is the medium through which a design, which relates solely to form and configuration, finds expression or materializes. Then, since a design as used in the statute relates solely to form and configuration, how should it be described?

There is no design which is not capable of delineation and description on paper, one or both, such delineation being the primary means. Where the forms are known forms, as in the case of geometrical figures, language may be employed as an auxiliary to describe them. And it follows as a corollary to the foregoing that the applicant's design, if he has one, is capable of being described or delineated on paper without reference to the materials used, or the colors employed, or the mode of their utilization in the construction of the article for which the design is intended.

Does the specification describe a single specific design? The applicant has delineated upon paper what is called a design; but in the specification he does not confine himself to any particular shape, form, or configuration. What he does in fact claim, is any form of ring or ring-setting that may be the product of his method of construction. Has he used apt and proper language to describe a or any design? Clearly he has not. He has proceeded to describe, with much particularity a manufactured article, has given the materials employed, including color preferable. The form and configuration, which alone relate to, describe, and constitute a design, being, if not hidden altogether, at least very obscure.

The appellant says, in effect, that he is unable to convey the idea of what he regards as his design without mentioning the materials, the color, and mechanical structure. If this is true, the difficulty arises, not because it is impossible to describe or delineate a design without reference to the materials, color, and mechanical structure, but from the fact that what he seeks to describe is not merely a design —a form or configuration for an improvement for a ring-setting, but the means of producing a pleasing effect resulting from the qualities, color, and texture of the materials used.

It is urged that the very idea, end, and purpose of the inventor may be to so group together certain materials in an article of manufacture as to produce an ornate effect—to produce, in other words, "a thing of beauty," the beauty resulting largely, if not altogether, from the character or quality of the materials used and the arrangement of them in the manufacture. And I am asked, may there not be a design in that? Undoubtedly there may, and the inventor may have a patent for the article of manufacture, in which case the applicant may properly mention in the specification the mechanical structure, mode of constructing, and character and quality of materials, colors, &c., as the appellant in the case at bar does. Or, if he desires simply to patent a design—that is, the form, configuration, which the manufactured article is to assume when it materializes—he will confine himself to a delineation of that form, shape, or configuration; but he must not prepare his specification under one classification as a predicate for asking a patent under another separate and distinct class. The object of the rule, which reflects the intent of the statute, is to prevent this, and it is in obedience to that rule that the examiner declared the specification in the application under consideration incompetent. He was right in his action. The line which marks the boundary between the classification of subjects which the statute makes patentable should be carefully and sharply drawn to avoid confusion; otherwise it may frequently occur that, instead of protecting and encouraging the genius of invention, a mere monopoly is created and fostered.

My attention is called to the fact that the examiner who

objects to the specification in this case has heretofore and recently passed, without objection, specifications with reference to the same subject-matter, and which are almost identical in manner and form with those under consideration. It is enough to say that, if the appellant is correct, the action of the examiner was erroneous; and it will not be urged that the decision of the primary examiner, under the operation of the rule *stare decisis*, would bind the appellate tribunal.

The decision of the examiner is approved.

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Ex parte PATITZ.

Decided November 19, 1883.

25 O. G., 980.

1. Rule 41 makes no distinction as to applications, and a design is equally within its terms as a mechanical application.
2. Where there is no necessary connection between the designs exhibited in two articles, the fact that they are adapted to be associated does not constitute a unity of design, and the two must be presented in separate applications.

Butterworth, Commissioner:

The application presents two distinct articles of manufacture having uses as separate and distinct as those pertaining to a watch and the chain to which it is to be attached; and to each of these articles he gives a pleasing appearance by means of certain ornamentation. He has manufactured a mirror-frame, not a new thing, but made presumably according to a new design, and also a sconce embracing a certain design. The sconce may be attached to the mirror-frame, and provision is made therefor; and it is suggested that the "design" may be varied and changed to suit the taste by disassociation of the particular mirror-frame from the sconce, and *vice versa*.

There is no necessary connection between the design for the mirror-frame and the sconce, and their union in the manner contemplated in this application does not constitute a unity of design. Nor is there, in fact, a unity of struc-

ture. The grouping together of the two articles produce an ornate effect; but it is the result of mere aggregation or association of the sconce and mirror-frame; hence, the two can no more be included in the same application than if they were not adapted to be associated.

It can hardly be doubted if an application for a mechanical patent had been filed describing a peculiar formation of mirror-frame and a peculiar construction of sconce, and containing separate claims to these constructions, that a division would have been required, notwithstanding the sconce might be detachably secured to the mirror-frame. At all events, previous decisions would give a negative answer, and Rule 41 accords with them. This rule makes no distinction as to applications, and a design is equally within its terms as a mechanical application. The same considerations apply to the two classes of applications in regard to this question of joinder of invention. To permit the two claims now presented to be embraced in one application will confuse and cripple the classification established for the proper and orderly administration of the business of the office. This decision is in the line of precedent. (See *Ex parte* Brower, C. D., 1873, p. 151.)

The decision of the examiner is affirmed.

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Ex parte STETSON.

Decided May 26, 1884.

36 O. G., 343.

1. The ornamentation of a clock-dial is a legitimate subject for a design patent under Section 4929 Revised Statutes, but the ornamentation must be distinctly separable from and irrespective of particular time-indicating figures and characters and their particular arrangement upon the dial. This latter feature, being solely of functional value, is not the subject of the design section, but of Section 4886 Revised Statutes.
2. A design cannot consist of any mere arrangement of particular letters or numerals, but it may consist of the shape or configuration of a particular letter or numeral—never in their combination to make up a function in an organized apparatus.

Examiner's Statement: "Consideration of the above entitled application having been refused by the Examiner of Designs on the ground that the same fails to offer, as described, shown. and claimed, proper subject-matter for a valid patent under Section 4929 Revised Statutes, the same being instead, as set up, for an improved clock-dial, and, therefore, falling within the terms of Section 4886 Revised Statutes, applicant notes an appeal under Rule 140.

"It has been held (*ex parte* Proudfit, 10 O. G., 585, and *ex parte* Pressprich, 11 O. G., 195) that an objection upon the grounds above indicated is not properly appealable under Rule 140, but that such objection goes to the merits, and is only appealable under Rule 128. The question involved, however, being in substance the same as that presented in *ex parte* Traitel (25 O. G., 783), the examiner sends the appeal forward for such consideration as the Commissioner may determine it deserves.

"Perhaps the simplest statement of the examiner's objection to the consideration of the application under the act relating to design patents, and one which at the same time demonstrates the fallacy of applicant's belief that he has produced 'a new and original design,' would be formulated in the following question: Are the particular numerals set forth in this case of the essence of the invention? If they are, and in the organization shown, then it is to say that applicant's invention is not a design under the act, for a design cannot consist of any mere arrangement of particular letters or numerals, as shown, described, and claimed in this case. A design may, however, consist of the shape or configuration of a particular letter or numeral—never in their combination to make up a function in an organized apparatus; but when, as in tickets, passes, coupons, blanks, notes, checks, calendars, etc., a certain function of novel and useful kind of character is obtained by the definite and specific combination—*i. e.*, 'arrangement' of the ordinary letters of the Roman alphabet or the numerals of the Arabic system of notation—then a new article is 'invented or discovered" for which the patent act in Section 4886 Revised Statutes, affords ample protection; and the classification of this Office shows many valuable patents issued upon this subject-matter. If, moreover, applicant should allege

himself to be the inventor and producer of a new font of printing type which should be adapted to produce the representation of an individual type of hybrid letter or numeral such as shown upon his clock-dial, he would clearly be within the pale of the act relating to designs, for he would then have produced a (possibly) new 'impression.' In that event he would be entitled to make use of his representation wherever and whenever he might find it desirable; but to seek to cover by a design patent an arrangement or combination of particular letters and numerals which confessedly is without value, except in the particular arrangement shown, is to attempt to invade the sphere of Section 4886 Revised Statutes, and would, if successful, be the means of securing to applicant an invalid patent. (Pratt *et al. v.* Rosenfeld *et al.*, 21 O. G., 866.) It is as if an application should be made for a design patent for a bank-check in which the entire novelty or essence of the design alleged should be described and shown as consisting in the fact that the letters and numerals represented thereon were printed in a particular type—possibly in a type or impression never before known or produced. Is it, then, to be contended that, granting such impression to be a new impression, the bank-check so printed is a 'new and original design?' Or, further, would the fact that the said check was printed in a particular type or impression make that check a 'design' in the statutory sense of the word or in the classification of this office? Manifestly not. Because the type or impression is the proper and legitimate subject of a design patent, can it, therefore, be lucidly maintained that a specific functional arrangement or combination thereof in any symbols, sentences, or emblems in or upon a particular article not itself the subject of a design patent renders that article a proper subject for a valid patent of that character? If the contrary to this proposition were true, then, indeed, it is not easy to discover where the true line of demarcation is to be drawn between these two sections of the Revised Statutes herein referred to.

"If called upon to examine the application as presented, the first requirement of the examiner, under the rules and practice of the Office, would necessarily be that applicant

should eliminate from the drawing all letters and numerals, and from his specification all description thereof and reference thereto, such being inadmissible in any 'new and original design.' And this for the reason that the same indicates on the one hand, either function which is unlawful in a design patent, or, on the other hand, objectionable matter of the nature of surplusage, as being either of trade-mark character or as lacking in the statutory 'genius, industry, efforts, and expense' required for the production of a design.

"The touchstone, then, whereby to determine whether applicant has produced a new design is: Is the design new, irrespective of the particular letters and numerals shown and described? If the answer is in the affirmative, the examiner admits his error. Had he believed an affirmative answer would have been admitted by the applicant, he would have assumed jurisdiction of the case, and required applicant to remove the objectionable features and make claim to the design that should remain; but what design would be shown with the particular, functional, time-indicating features of the dial eliminated. Applicant, however, alleges that a clock-face is a legitimate subject for an ornamental design. The statement is not denied, for its ornamentation falls directly within the provisions of Section 4929 Revised Statutes; but this ornamentation is, and from its nature must be, always clearly separable from and irrespective of the particular time-iudicating figures and characters and their arrangement—*i. e.*, their combination, *inter esse*—upon the dial. In applicant's case there is absolutely no ornamentation, but, as described, shown, and claimed, the letters and figures, in their combination and arrangement, are the very essence and gist of the alleged invention. And this is not patentable as a design, however valuable the invention may be *per se*.

"It would appear, however, in view of the well-known twenty-four hour dial shown in the Prince Pierre Soltykoff collection, in Paris, giving all the functional features of applicant's invention, and known to be several centuries old, that applicant has carefully prepared his case relating solely to one class of applications as a predicate for asking a patent under another class, a practice condemned as

tending to confuse and mislead both the public and the Office in *ex parte* Traitel, *supra*."

Butterworth, Commissioner:

The decision of the examiner is approved. His action is sustained by the reasons submitted and the authorities cited by him.

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Ex parte BAILEY.

Decided November 9, 1886.

37 O. G., 781.

1. When an application for a design patent is received which is a clear, palpable, and manifest error, and for the subject-matter of which applicant is entitled to, if anything, a mechanical patent, the case should be withheld by the application clerk, and applicant advised.

2. When, however, such error is not plain, palpable, and manifest, and the case goes to a division for examination, the preliminary fee cannot be refunded to applicant or applied upon a new application.

Montgomery, Commissioner:

On the 3d of May last this application was received, in which applicant asked for a patent for a design for the term of three years and six months. The application was accompanied by a fee of ten dollars. On the 4th of May the drawing was discovered to be informal. The case was therefore sent to the draftsman's division for the correction of the drawing, and on the 4th of June a new drawing was prepared by the office, for which applicant was charged three dollars. Ou the 1st of July the application was reached for examination, and applicant informed by office letter that it was "manifest from the drawing and description that the subject-matter is for a mechanical improvement, and not for a design." On the first of November, instant, applicant transmitted to the office his petition for a mechanical patent, together "with five dollars to com-

plete preliminary fee," and asked that his new application be received and filed and considered in the usual way without further payment.

I think it very plain that applicant's request cannot be granted.

In the case of *ex parte* Sellers (1870 C. D., 58), Mr. Commissioner Fisher held that a fee of fifteen dollars, which had been forwarded to the office with an application for mechanical patent, could not thereafter, when applicant discovered that he was not entitled to a mechanical patent but was entitled to a design patent, be applied in part payment of the fees required for such design patent. The reasoning of that case seems to apply to the case under consideration. Suppose, for instance, that the examiner had, as he had the undoubted right to do, and as applicant had the undoubted right to insist upon, passed upon the application for design patent as he received it. Applicant would have been rejected, and would have been entitled to appeal. Upon such appeal the examiner had been affirmed. Would applicant claim under these circumstances that his original and first fee should be applied upon a fee which should thereafter accompany a new application?

I have no doubt that where an application is received which is palpably and manifestly a mistake, it would be the duty of the application clerk to withhold the same and notify applicant thereof. It must, however, be a very plain case—such a one as admits of no question—or such applicant might properly charge the application clerk with impertinent voluntary advice. It can hardly be presumed, however, that such manifest and palpable mistakes will occur except in rare cases. When, however, such error is not plain, palpable, and manifest, and the case goes to a division for examination, I see no reason why the accompanying fee should be refunded, and no practical ground upon which such refunding can be asked for or based.

Ex parte HARRIS.

Decided December 22, 1886.

38 O. G., 104.

An application for patent upon "a design for ornamenting the surface of the walls of railway cars," &c., which, in the opinion of the examiner, contains nothing which can "constitute proper subject-matter for a design patent" should be by such examiner rejected. From such rejection an appeal will lie to the Board of Examiners-in-Chief, as in ordinary cases of the rejection of claims.

Montgomery, Commissioner:

Applicant asks for a patent upon a design for ornamenting the surface of the walls of railway cars, &c. His design consists of colors in combination upon a dark ground to produce on walls a frosted effect. July 27, 1886, applicant was informed by office letter that a consideration of his case was refused for the reason that, in the opinion of the examiner, the thing proposed could "in no sense constitute proper subject-matter for a design patent." Since this action on the part of the examiner, the same has been substantially repeated several times, the last time on the sixteenth of last month. On the following day applicant filed a petition, in which he asks, in substance, the Commissioner to "instruct" the examiner that the design which he presented did "constitute proper subject-matter for a design patent," and therefore an examination of the state of the art should be made. The situation seems to be as follows: The primary examiner refuses to either pass or reject this application, for the reason that, in his opinion, the thing proposed to be patented can "in no sense constitute proper subject-matter for a design patent." This statement, properly interpreted, simply means that, in the opinion of the examiner, applicant presents nothing patentable. He does not find fault with the form in which the thing proposed is presented. He requires no correction of the specification or claim. He simply says, "the thing which you bring here is not patentable." This objection

is in no sense a formal one, but one which goes to the very life of the application itself. If the examiner is correct in his opinion that applicant presents nothing which "constitutes proper subject-matter for a design patent," very clearly consideration of the case should not be refused, but the application should be considered and rejected. It need hardly be said that if the examiner is right there can be no occasion to examine the state of the art.

The statute, Section 4929, provides in express terms that —"Every applicant for a patent * * * any of the claims of which have been twice rejected * * * may appeal * * * to the Board of Examiners-in-Chief."

Section 4933 declares that—"All the regulations and provisions which apply to obtaining * * * patents for inventions * * * shall apply to patents for designs."

The case will go back to the primary examiner. If he shall remain of the opinion that the thing which applicant proposes to patent does not "constitute proper subject-matter for a design patent," he will reject for that reason. From such rejection applicant has the absolute right of appeal, not to the Commissioner direct, but to the Board of Examiners-in-Chief, thence to the Commissioner, and lastly, to the Supreme Court of the District of Columbia.

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Ex parte SCHULZE-BERGE.

Decided January 5, 1888.

42 O. G., 293.

1. Objections by the examiner that the alleged invention shown in an application for a mechanical patent should be made the subject of a design application, held to be a rejection of the application, the appeal from which must go to the examiners-in-chief.

2. The word "useful," employed by Congress in legislation upon the subject of mechanical and design applications, defined and distinguished, and held when applied to designs, to relate to matters of decoration and æsthetic art which reach the senses through the eye, and so used in an entirely different sense from that in which it is applied to the subject of mechanical inven-

tion, where the usefulness contemplated by the statute relates to the employment of dynamic force, its modification or operation.

3. An inventor of a mechanical invention is entitled to give to it such enhancement by way of ornamentation and decoration as it is capable of receiving, and this without in any way modifying or detracting from his right to a patent.

4. Such inventor may also receive a design patent for the configuration, ornamentation, or decoration which the mechanical invention is capable of receiving.

Hall, Commissioner:

This is an application for patent for an improvement in corrugated or ondoyant glass, the function of which is to permit the passage of light, and yet obscure vision.

On the 11th of July, 1887, applicant was informed as follows by office letter:

"This application cannot be considered in the class of mechanical inventions. The application should be for a design patent."

On the 7th of October, 1887, applicant answered as follows:

"We request a reconsideration of the last action in this case, for the reason that applicant does not claim a design for plate-glass, but has made an improvement in corrugated or ondoyant glass, the function of which is to permit the passage of light and yet obscure vision. This applicant's invention does more perfectly than the former devices, in that while it more perfectly obstructs vision it obstructs the passage of light to a much less extent."

On the 13th of October, 1887, the office replied in the following language:

"The argument filed in this case, October 8th, has been considered, and applicant is advised that the office still entertains the views expressed in the official action of July 11, 1887. The fact that applicant's design serves a useful purpose does not change its classification as a subject of invention. This case comes under the clause of Section 4,929 Revised Statutes, which says that "any new, useful, and original shape or configuration of any article of manu-

facture' is the subject of a design patent. The official action of July 11, 1887, is reiterated."

Thereupon the applicant appeals to the commissioner, and prays that the action of the examiner may be reversed, and that he may be directed to entertain the application and act upon the merits thereof, for the reasons, first, that the invention involves the functions of or result produced by the article claimed as a new article of manufacture; second, that the action of the examiner is contrary to the views held by the office, &c.

In view of the decisions in *ex parte* Proudfit (10 O. G., 585), *ex parte* Presspich (11 O. G., 195), and *ex parte* Bailey (Com. Dec. 1886, 39), I am of opinion that the action of the examiner in this case must be held to be a rejection of the application, and that the appeal must go to the examiners-in-chief. It is true the examiner has simply advised applicant that the invention described and shown in his application must be covered by a design patent, and not by a mechanical patent; but the applicant asks for the latter kind of patent, and the office has no right or power to insist upon his filing an application for a design patent or any other patent than that which he wishes. This application is pending in the office and must be disposed of. I know of no way of disposing of it except by allowing or rejecting it; and when the examiner has twice advised applicant, after a discussion of the merits of the question, that he must pursue another course, and file an application for a design patent, he in fact refuses to allow the present application, for the reason that it is not for an invention upon which a patent, as now asked, can be based. But in view of the fact that the case must go back to the examiner for further consideration, and will be within his jurisdiction until applicant sees proper to take an appeal to the Examiners-in-chief, I feel justified in offering some suggestions to the examiner.

I have examined very carefully the answer of the examiner to this petition and the authorities cited by him, and I am disposed to think that the invention shown and described in this case, if new, contains patentable merit as claimed by the applicant. Up to 1842 there was no provision of law authorizing the issue of design patents. The

field of art in which invention could proceed, and for which patents might issue, was limited to the four classes specified, viz: "any new and useful art, machine, manufacture, or composition of matter;" but in that year Congress saw proper to recognize and establish another and different field of art. It is difficult to define this new field other than by the language Congress has employed:

"Any new and original design for a manufacture, whether of metal or of other material or materials, or any new and original design for the printing of woolen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas-relief, or composition in alto- or basso-relievo, or any new and original impression or ornament to be placed on any article of manufacture, the same being formed of marble or other material, or any new and useful pattern, or print, or picture to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed, on any article of manufacture, or any new and original shape or configuration of any article of manufacture, not known or used by others before his or their invention or production thereof," &c.

It will be noticed in this extract from the statute that the only instance in which the word "useful" is employed is with reference to "pattern, or print, or picture, to be either worked into or worked on," &c., any article of manufacture, &c. The statute has since been modified until we find in Section 4929 of the Revised Statutes that the only employment of the word "useful" is in this clause: "Or any new, useful, and original shape or configuration of any article of manufacture."

Under the former statute there seems to have been some contrariety of opinion as to the dividing line between inventions which might be the subject of "design patents," and attention has been called to the decisions in *ex parte* Crane (C. D., 1869, 7); *ex parte* Bartholomew (C. D., 1869, 103); *ex parte* Fenno (C. D., 1871, 52), and Wooster *v.* Crane (2 Fisher, 583). In some instances the Commissioner has been of opinion that the word "useful" justified the issue of a mechanical patent for any form, shape, or configuration, provided the thing whose shape or form was involved possessed usefulness or utility in a mechanical sense. In my judgment, the decisions which have pursued

this line of reasoning have given too great importance to the word "useful," employed in this connection. I cannot avoid the conclusion, from an examination of later authorities, that the subject of design patents was intended by Congress to relate to matters of decoration, of esthetic art, which reach the senses through the eye.

There can be no doubt that an invention to be the subject of a mechanical patent must possess utility or usefulness; but it is a usefulness which relates to mechanics, the modification or control of physical forces. On the other hand, the subject of a design patent may also be useful in an entirely different sense or direction, and I think the word "useful" in the statute, Section 4929, Revised Statutes, is employed in a different sense. The subject of invention, so far as form, or shape, or configuration is concerned, must be useful in the sense that it tends to promote pleasure, refinement, comfort, depending upon the sense of the beautiful; it must be useful in the sense that it must not be mischievous, obscene, or tending to produce evil or wicked reflections. Invention in this field of art relates to the intangible, and its power consists in its ability to awaken pleasant and agreeable sensations, conceptions, and thoughts, and the usefulness involved is that which brings about these results.

The decisions above alluded to, have dwelt upon the technical meaning of the word "useful," overlooking the fact that Congress, by its legislation upon the subject of mechanical and design patents, had clearly marked out two separate and distinct fields of invention, which were purposely made separate and distinct from each other, and that, while the word "useful" is employed in the statute relating to each, it was not intended to apply to the same kind of usefulness in each.

As already suggested, the usefulness contemplated by the statute for mechanical patents was such as related to the employment of dynamic force, its modification or operation. The usefulness indicated in the statute with reference to designs was in the other direction and intended to be limited to that kind of usefulness.

Says Leggett, Commissioner, in *ex parte* Parkinson (C. D., 1871, 251):

"The law has provided for granting patents to the inventors or discoverers of new and useful arts, machines, manufactures, and compositions of matter, and also of any improvements thereof.

"This class of inventions has to do with functional qualities of matter and things. The term 'useful,' in connection with machine patents, relates to the office the thing patented fills in producing a desired effect; or, if the thing patented is the result or effect, that is, the article produced, then 'useful' relates to its adaptation to serve some practical purpose in supplying some physical or tangible want.

"But the law authorizing design patents was intended to provide for an entirely different class of inventions, inventions in the field of esthetics, taste, beauty, ornament.

"The question an examiner asks himself while investigating a device for a design patent is not 'What will it do?' but 'How does it look?' 'What new effect does it produce upon the eye?' The term 'useful' in relation to designs means adaptation to producing pleasant emotions.

* * * * * * * * *

"The Legislature never intended by this section (4929) to let down the standard for patents. It was never contemplated to grant a design patent for every possible change of form that might be given to a machine or article of manufacture. By 'article of manufacture,' as used in this section, the Legislature evidently meant only ornamental articles, articles used simply for decoration."

In the case of Thomas S. Cox *v.* Jacob W. Griggs *et al.* (2 Fisher, 174), Judge Drummond held:

"You must be satisfied that the invention is a useful one, and of this slight evidence only is necessary. 'Useful,' in the patent law, is in contradistinction to 'mischievous.' The invention should be of some benefit."

(See also Wooster *v.* Crane, Id., 583; Gorham Manufacturing Company *v.* White, 14 Wall., 511).

In *ex parte* Norton (C. D., 1882, 14) Commissioner Marble held:

"'Useful,' in the patent law, is in contradistinction to 'mischievous.' The invention should be of some benefit. (Cox *v.* Griggs, 2 Fisher, 174.) A design, if not 'mis-

chievous,' is useful if it attracts persons to it or to articles made like it. It may not be of great artistic excellence; but if it be attractive it is useful. * * * It is not necessary that it should be ornamental, although it may be, to entitle the applicant to a patent therefor. The utility in an article of this kind consists in having a shape or configuration of such a character that persons needing it will purchase it because of its shape or configuration in preference to other articles for the same purpose but different in shape or configuration."

In Theberath *v.* Rubber Co. (C. D., 1883, 205), Circuit Court of New Jersey, Judge Nixon uses the following language in speaking of design patents:

"They differ from patents for inventions or discoveries in this respect, that they have reference to appearance rather than to utility. Their object is to encourage the arts of decoration more than the invention of useful products. A picture or design that merely pleases the eye is a proper subject for such a patent without regard to the question of utility, which is always an essential ingredient in an invention or discovery patent."

Applying these decisions to the present case, the applicant claims that he has invented a plate glass which is useful, because while it admits a great quantity of light it practically excludes vision. It is true that this function of the glass depends upon the peculiar manner in which applicant gives form and shape to one of its surfaces, which he claims may be made irregularly and without any design whatever, or it may be made in forms which would be pleasing to the eye, such as designs of figures; but when so made such configuration is a mere incident to the purpose for which the plate glass is constructed. It must be conceded that such a plate glass would have no attraction and no practical utility as a mere design or picture, and no person would purchase it for that alone. The great and predominant utility of the plate glass is that it may be used in the construction of houses in windows and doors, so as to admit light into the rooms and apartments of the building without enabling vision from either side.

In the examiner's discussion of the distinction between mechanical and design patents, he says:

"The one is that which the letter of the statute seems to suggest, viz.: on the line of configuaration pure and simple —that is to say, where the invention is for an article of manufacture, and consists in shape or configuration, it should be protected by a design patent, and no other. This is the line clearly suggested by Commissioner Fisher, and possesses the merit of clearness and simplicity, besides that of strictly following the letter of the statute.

"Another line is that of function. That is, where the subject-matter of the invention is an article of manufacture and the invention consists of shape or configuration, the classification may depend upon the use for which the article is designed. If its function is mechanical—that is, if its function is to transmit or modify mechanical force—then it should be a mechanical patent. The articles suggested by Commissioner Fisher in the Bartholomew case as properly belonging to the classification of designs would come under this category—'plow-shares, fan-blowers, propeller-blades, and others of like character.' On the other hand, if the function of the article is to gratify the eye or to serve some useful purpose and promote convenience in a way not connected with the transmission, generation or modification of a mechanical power, then it should be protected by a design patent."

I am not able to agree that a propeller-blade, the form of which is devised by an inventor for use in propelling a vessel and to transmit vast power by reason of that form, should be covered by a design patent; its function is mechanical, and its object is to transmit or modify mechanical force, and that being true, it should be covered by a mechanical patent; and so of the other illustrations cited by the examiner.

In the case now before me the whole object or purpose of the invention is to modify and transmit mechanical force —that is, the force called "light." The rays of light are dispersed or scattered in such a way that, while the light is admitted, by reason of this dispersion vision is prevented. Light is a force, and it flows in at the window much as a current of water flows over a dam; it produces results, and its modification in hundreds of particulars is desirable. The invention now under consideration is made with a

view to accomplishing such modifications, and it modifies or transmits that force as much as a wheel or other device operating in a current of water would modify or change such current, and is therefore as much the subject of a mechanical patent as the other. Having made this invention, the inventor is next entitled to give to it such enhancement by way of ornamentation and decoration as it is capable of receiving, and this without in any way modifying or detracting from his right to patent. As already suggested, if the invention admit of it, the inventor may arrange the irregular surfaces of the glass in figures and designs pleasing to the eye. This every inventor may do with all the varieties of invention conceivable, and I know of no reason why an inventor of a mechanical invention may not in many instances also have a patent for a design for such configuration, ornamentation, or decoration made upon the same. Of course the two are different inventions —one relating to the transmission or modification of mechanical force, and the other to the ornamentation that is pleasing to the eye.

A mechanical patent has been held to be no bar to the grant of a patent to the same patentee for a design shown therein. (*Ex parte* Palmer, C. D., 1882, 5; Collender *v.* Griffith *et al.*, 18 O. G., 241; *ex parte* Bartholomew, C. D., 1871, 298.)

It is sometimes exceedingly difficult to separate the form and configuration of a body from its function. This seems to have been the difficulty in cases hereinbefore cited, where reference has been had to propeller-blades, plow-shares, and other like instrumentalities. Take, for instance, a lens for converging or diverging light, which depends entirely upon its configuration, no one would pretend, if it were new, that it would not be the proper subject of a mechanical patent, and for the sole reason that it modifies the force called "light" in its transmission through it. So, too, of a goose-necked valve or trap used in plumbing; the function depends upon its form; and yet no one would contend, I apprehend, that, if new, it should not be the subject of a mechanical patent. So, I think, we may go through the entire list of subjects where the invention and form depend upon each other, and the true distinction will always

remain, that when the function of the invention for the accomplishment of some physical result depends upon its form, it cannot be deprived of its mechanical patentability by reason of form or configuration.

I have made these suggestions because I deem the subject of considerable importance, and in order that the examiner may, if he sees proper, give them consideration, before the case proceeds further. It is to be understood that they are not at all conclusive upon him, and he is at liberty to permit the case to remain just as it is—rejected—so that the applicant, if he chooses, may take an appeal upon the merits to the examiners-in-chief; but, it being evident that the examiner has not understood that he has rejected the case upon its merits, I deem it proper to go into the question to some extent in order that the examiner may feel at liberty to reconsider his decision, and be justified in taking such further action as to him seems right and proper.

The present appeal is dismissed, and the case is remanded to the primary examiner for such action as the applicant or the examiner may see proper to direct.

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Ex parte GERARD.

Decided May 22, 1888.

43 O. G., 1235.

1. It is well understood that, while the courts, when construing the validity, scope, and extent of the claims in patents, will regard the words "as shown and described" as ever present, and when absent will not construe patents to embrace more than is shown and described, it is the policy of the office while it has control over applications to insist that the form and phraseology adopted and employed by applicants should not be misleading nor unintelligible to the common people who seek to deal with patent property. It has therefore been customary to require that the words "as shown and described" shall be employed in the claims of design patents, in order that the patents may be limited to the subject-matter shown and described. The introduction of such words operates as a guide-post to inform all

persons that the patent is limited to the precise invention shown and described, and that there is no hidden mystery nor secret trap, by which those who attempt to enter the same field of invention, or to use other articles, may be arrested in their efforts or mulcted in damages.

2. A design application will not be permitted to embrace more than one subject of invention. The same principles in this particular which control in mechanical applications must obtain in design applications. A distinct and separate invention relating to the form or configuration cannot be lawfully included in a patent embracing a distinct and separate invention as to surface ornamentation—as, for instance, an alto-relievo cannot be joined with an ornamentation or picture to be worked into a woolen fabric; but when the shape and the ornamentation are parts of the same article of manufacture, so that both unite in producing the same result, then they are not distinct and separate within the purview of the rule.

3. Under the statute the design must be a finished and completed thing—must be one entire and integral thing. It cannot consist of several integral different designs aggregated, so as to protect the several individual parts, nor so that these parts may be separately applied to other and different articles or parts of articles of manufacture.

4. The doctrines of combination and elements of combinations and of genus and species obtaining in mechanical inventions cannot be applied to designs. In a mechanical combination, when one element is withdrawn, that combination ceases; but in a design a subordinate and unimportant feature may be withdrawn, and yet the design as a whole remain, and to simulate the predominant features would infringe the whole.

5. The test of infringement is the "identity of appearence, determined by the eye of the ordinary observer." (Gorham Co. *v.* White.) As the subject of identity of the design is addressed to the eye of the ordinary observer—the public—so the questions of the extent and character of claims in patents for distinctive and segregable parts, must be determined largely by the skill and judgment of the experts of the Office.

6. Objections to claims for non-segregable parts relate to the merits rather than to form, and upon rejection the appeal should go to the examiners-in-chief.

7. A new and original design under the statutes may also be the subject of a mechanical patent. (*Ex parte* Schulze-Berge, 42 O. G., 293.)

Hull, Commissioner:

Applicant appeals in this case from the action of the examiner in the three following particulars:

First. In requiring applicant to incorporate into his specification a brief statement of the leading features of his design.

Second. In requiring applicant to state his respective claims separately and singly as to each subject of the claims, instead of incorporating a preamble introductory to all the claims, "in a design for a plate or dish," &c., and then adding the statement of what is claimed in such design. The examiner also required that the applicant should add to his claims the usual words, "as shown," &c.

Third. The rejection of claims 3, 5, 6, 7, and 8, in that they were not for distinctive and segregable matter as required by *ex parte* Pope (26 O. G., 290).

Applicant in his appeal requests the commissioner to instruct the examiner by what principles he should be guided in rejecting claims because of non-distinctiveness and non-segregability, in view of the frequency of the citation of *ex parte* Pope, and also to determine whether a rejection on this ground should be regarded as relating to the merits which gives an applicant the right of appeal to the examiners-in-chief, or whether it should be regarded as an objection relating to form, which would be appealable to the commissioner.

The design for which applicant seeks a patent is a dish of certain form and shape, the upper surface of which bears certain ornamentation. The dish is made with a central circular depression or bowl, while the rim is rectangular with defined corners. The corners are ornamented with a peculiar design, while the bowl and panels possess their own respective designs or ornamentation.

The claims are as follows:

In a design for a plate or dish, the following defined novel and segregable features, substantially as hereinbefore

described, and as shown in the accompanying photographs, namely:

1. The design for the shape of the dish, consisting of a rectangular outline with the corners formed by straight lines, a a, forming obtuse angles with the sides, and the circular arc, b, interposed between the lines, a a.

2. The design for the shape of the dish, consisting of the depressed center of circular outline, and the rim with square outline, with its corners formed by lines, a a, at obtuse angles with the sides, and intervening circular arc, b.

3. The design for the corner of the dish, consisting of circular arc, b, and straight lines, a a, forming the edge outline of the dish, with a surface ornamentation consisting of a circular figure, A, entering said arc, b, and a concentric border, B, extending to and interrupted by said lines, a a.

4. The design for the surface ornamentation of the corner of the dish, consisting of a circular figure, A, composed of a conventionalized flower with radial petals, and the concentric border, B, characterized by the circular row of pointed figures, e e, radiating from the common center.

5. The design for the rim of the dish, consisting of the corner ornamentations, A B, and the intervening panels, C C, filled with ornamentation consisting of diagonally-arranged figures, as shown.

6. The ornamentation for the panels, C C, on the rim of the dish, consisting of diagonal bends, h, i, j, k, and l.

7. The ornamentation for the depressed center of the dish consisting of the figures, D D.

8. The ornamentation for the depressed center of the dish, consisting of the annular border, G.

9. The ornamentation for the depressed center of the dish, consisting of the radial figures, D D, the annular border, G, interrupted by said figures and appearing to pass beneath them, and the central rosettes, E.

The examiner allowed claims 1, 2, 4, and 9, but rejected claims 3, 5, 6, 7, and 8, the ground of his decision being that these latter claims did not embrace parts or features which were distinctive and segregable from the entire design.

It appears from the official action of the examiner and his statement in reply to the appeal that he has waived and

abandoned the formal objections as to the "distinctive features" of the design and the introduction of the preamble to the claims, and only insists upon the use of the customary words, "as shown and described," &c. As to the latter subject, I concur with the views expressed by the examiner. It is well understood that, so far as the validity, scope, and extent of a patent are concerned, these words are immaterial. The courts regard them as ever present, for the patent can extend no further and can embrace no more than is shown and described; but the Office has control over the form and phraseology of the patents issued by it to the extent of rendering them easily intelligible to the common people, so that they cannot be the means of deluding or misleading those who seek to deal either with patent property or the articles of manufacture made under such exclusive privileges. The introduction of those words operates as a guide-post to point the fact which many, but by no means all, persons know, that a patent is limited to the very subject matter "shown and described" and its equivalents, and that there is no hidden mystery nor secret trap by which those who attempt to enter the field of invention in the same class of arts or to use other articles of manufacture may be arrested in their efforts or mulcted in damages. It has always been customary to use those words in claims of design patents. It is the policy of the Office to require them to be used, and the action of the examiner in requiring them in this case must be affirmed.

As to the rejected claims, an examination of the statutes relating to design patents shows that the subject matter, "a new and original design," relates to an article of manufacture. A new and useful article of manufacture may also be the subject of a mechanical patent (*ex parte* Schulze-Berge, 42 O. G., 293), depending upon its construction or mode of construction; but it may possess a new and original form, or surface ornamentation, or both. Shape must relate to the outward form or contour, while the surface ornamentation relates to illustrations and delineations that are printed or impressed upon or woven into it.

So far as applicable, the statutes and rules pertaining to mechanical patents relate also to designs. Letters patent issued on one application will not be permitted to embrace

more than one subject of invention in designs. The same principles in this particular which control in mechanical patents must obtain in this. The statute provides (R. S., Sec. 4929) that:

"Any person who, by his own industry, genius, efforts, and expense has invented or produced any new and original design for a manufacture, bust, statue, alto-relievo or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture to be printed, painted, cast, or otherwise placed on, or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention, or production thereof, or patented or described in any printed publication may * * * obtain a patent therefor."

The peculiar disjunctive character of this section relative to the two classes of invention, shape and ornamentation, when considered in conjunction with the statutes, decisions of the courts, and rules of practice of the Patent Office applicable to mechanical patents, is conclusive that a distinct and separate invention as to form or configuration cannot be lawfully and properly embraced in the same patent with a distinct and separate invention as to surface onamentation. An alto-relievo cannot be joined with an ornamentation or picture to be worked into a woolen fabric, in the same patent; but when the shape and the ornamentation are parts of the same article of manufacture, so that both unite in producing the same result, viz., the usefulness of beauty in the same article, then they are not distinct and separate within the purview of the rule. Such an instance can scarcely be held to be an exception to the rule. As already stated, the invention which is the subject of the design patent cannot exist separate and apart from the article of manufacture. An article of manufacture may wear the garment of form and also that of surface ornamentation; but both features combine to constitute a single garment, and the article remains the same article of manufacture. Its usefulness is one and integral. The design of form may have been conceived and applied first; but

when that of surface ornamentation came into existence and was applied the two in their application blended and united in a new creation, which was one and indivisible. In such a case a patent for the design consisting of shape and surface ornamentation possibly might not protect the shape alone; but this question is not before me, and I only suggest, but do not express, any opinion upon it. I conclude simply that the designs of form and those of surface ornamentation, when applied to the same article of manufacture, constitute the proper subjects for single letters patent.

What elements or features of design are covered and protected by a design patent? In the language of the statute, the thing to be patented must be new and original, and it must have been invented and produced. It must necessarily be a finished and completed thing. Whether it consists of form or surface delineations, or both, the design must be one entire and integral thing. It cannot consist of several integral different designs aggregated, so as to protect the several parts individually and separately, nor so that these parts may be separately applied to other and different articles or parts of articles of manufacture made or hereafter to be made. The doctrines of combinations and elements of combinations and of genus and species, which obtain in mechanical inventions cannot be applied to designs. Shape and contour and surface delineations may have predominant features—may be divisible, in a certain sense, into parts; but these parts do not co-ordinate and co-act as elements in mechanical combinations do. In the latter when an element is withdrawn that combination ceases. In a design some of the subordinate and unimportant features may be withdrawn and yet the design as a whole remain, and to simulate the predominant features would infringe the whole, upon well-known principles to be stated hereinafter.

Curves or outlines, areas or surfaces, and solids, all having forms and contours, may be classified, depending upon their co-ordinates or relations of curve and angle. The curves of conic sections, the sphere, cube, and paraboloid, &c., may be classified mathematically; but they are incapable of differentiation into varieties and species. As matters of

beauty and ornamentation addressing themselves to the eye, they are always the same. The moment either loses its quality of cube or sphere, so as to become a variety of cube or sphere, it ceases to exist and becomes something else. If it be cubical or spherical, though not a perfect cube or sphere, it does not change to a species or variety, but retains a resemblance which will still classify and arrange it as one or the other. Genus possesses constant qualities which are common to all included varieties or species. The variations or modifications upon which the species depend relate to features of structure other than mere similitude of form and shape. Every bust could be classified under genus and species if complexion, eyes, nose, mouth, and hair—common features of the races of men—were to be considered; but the design of a bust does not depend upon the representation of these features as such. The bust of Henry Clay would not be patentable as such, for that would prevent other artists from making busts of the same individual. So, also, of portraits to be impressed upon or woven into fabrics. That which is patentable is the ideal characteristic pertaining to the design which the artist has created and not borrowed or copied. There is in this respect but one characteristic which is common to mechanical and design patents, and that is equivalency. With reference to mechanical inventions, an equivalent is defined to be:

"A thing that performs the same function, and performs that function in substantially the same manner as the thing of which it is alleged to be the equivalent." (Mason *v.* Graham, 23 Wall., 275; Potter *v.* Stewart, 18 Blatchf., 563.)

But designs are addressed to the eye, and their usefulness relates to the enjoyment of the beautiful which their consideration and contemplation awaken. The protection afforded by the patent law for such inventions necessarily depends upon identity, which embraces the idea of equivalency in the law of patents. The reproduction and simulation by others of the invented design are forbidden.

The Supreme Court of the United States in Gorham Manufacturing Company *v.* White (14 Wall., 511) has clearly stated and limited the force and meaning of a patent for a new and original design. That case was appealed

from the Circuit Court for the Southern District of New York. The court below held views approved by the Supreme Court as to the identity of design, but instructed that this identity was to be determined by the eye of the expert and not that of the ordinary observer. The judgment proceeded upon this idea that a design was a subject of art and skill, and its qualities and characteristics must be determined by experts skilled in such arts. As to the standard of distinction in the matter of identity, or the means and manner of defining the subject of a design patent, the Supreme Court differed from the Circuit Court. The opinion is a leading one upon this subject:

[Here follows opinion in Gorham *v.* White, 14 Wall.]

From these observations of the court it is clear that "identity of appearance, determined by the eye of the ordinary observer," is the test of piracy or infringement, and defines the protection which a patent affords to the inventor. This identity does not descend to the mere lines and dots, the various and infinite details of the design, but depends rather upon the predominant and characteristic features, the *tout ensemble*. Even with changes, variations, or omissions of these, if the indicated design contains the dominating features, or as a whole so simulates the original design covered by patent, that "there is identity of appearance," or, as expressed in McCrea *v.* Holdsworth, "sameness of effect upon the eye," then it is guilty of infringement:

"If in the eyes of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same—if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other."

This is the protection afforded, and while an applicant may embrace claims covering distinctive and segregable parts of his design, as recognised in *ex parte* Pope, this will not increase or enlarge the extent of his protection. He does not thereby secure a patent for more than one design, and that one is the whole completed and finished design, made up of the distinctive and segregable parts, combined with the non-distinctive and non-segregable.

I am aware of what was said by Mr. Justice McLEAN as to combination of parts in Root *v.* Ball & Davis (4 McLean, 177, 1846), and by Commissioner Fisher, *ex parte* Bartholomew (C. D., 1869, 103), as to generic claims and variations. (See, also, *ex parte* Sheppard, C. D., 1870, 22). But Gorham Company *v.* White is later and higher authority, and certainly is conclusive as to what may be patented as a design.

In *ex parte* Bartholomew Commissioner Fisher says:

"Thus, if the invention were of a design for an ornamental button, the face of which was grooved with radial rays, it would seem that the first designer of such a button might properly describe a button of five rays, and, having stated that a greater number of rays might be used, might claim a design consisting generally, of radial rays, or of 'five or more' rays, and that it could not be necessary for him to take out a patent for each additional ray that could be cut upon this button. So if the design were the ornamentation of long combs by a chain of pearls it would seem that a claim for such a design might be maintained against one who arranged the pearls either in curved or straight lines, or who used half pearls only, and that such modifications, if they had occurred to the designer, might properly have been enumerated in his specification as possible and equivalent variations. In short, I can see no reason under the law why designs may not be generic, why what are called 'broad claims' may not be made to them, and why the doctrine of artistic or æsthetic equivalents may not be applied to them."

But it is evident that whatever form the claim for the button or the comb assumed, the patent would protect whatever simulated its identity to the eye of the ordinary observer. In the case of the button this would be true whether there were more or less than five rays. There may be variations and immaterial departures from the specific details set forth in the patent which will be perfectly protected by it. The claim may be made "broadly," so as to cover them; but it cannot state them so broadly or generically as to cover a design not yet conceived, and which, as a work of art, would be so different from that exhibited in the patent that the eye of the ordinary observer would re-

gard it as new and different. To permit such claims would enable the patentee to forestall the future, and to usurp the ownership of unconceived and uncreated subjects of shape and ornamentation.

What, then, is the purpose of claims for distinctive and segregable parts? Evidently to enable the applicant for himself, and the Patent Office for the public, to point out those predominant and controlling features in a design, the use of which alone would be regarded as preserving the identity of a design, even when other parts are omitted. Unquestionably whatever features or parts of a design which, if used by another, would constitute an infringement may be used by and protected to the patentee, and that is the limit and extent of the variation which the law will sanction or permit. The whole subject resolves itself back into a question of identity—sameness to the eye of an ordinary (unskilled) observer. The common observer is not familiar with the genus and species of design (if such distinctions can have any existence), and his liability to be misled or deceived in matters of resemblance and identity does not depend upon them. While, therefore, there is some little analogy between claims for distinctive and segregable parts in design patents and claims for elements and co-acting parts in mechanical patents, they are not founded upon the same principles.

An applicant may seek to patent a design for a stove in which is included the form or shape of the stove with the surface ornamentation for its sides and top. In such case he cannot secure a claim for the design as to ornamentation as applied to the sides and top of any stove, regardless of its form and configuration. If he wishes to secure a design for a side or panel of a (any) stove, he must take out a separate patent for that. In the case supposed his patent will cover the ornamentation, with such variations thereof as will preserve its identity upon the form or shape of the stove—with such variations thereof as will preserve its identity to the eye of the ordinary observer of both. He cannot in the same patent secure claims for distinct and separate parts independent of the whole design. (*Ex parte* Neil, MS. Dec., Vol. 24, 236; *ex parte* Hill, MS. Dec., Vol. 28, 124.)

Undoubtedly in cases like the present, where the design consists of a combination of shape and ornamentation, claims covering greater variation may be allowed, based upon distinctive and segregable parts, than where shape alone or ornamentation alone is the subject of the design. Thus the shape of the dish in the case under consideration, with some slightly distinctive features of ornamentation, might more easily deceive or mislead the eye of the ordinary observer than such distinctive feature of the ornamentation applied to a dish of wholly different shape and contour. As the subject of identity or sameness of design is addressed to the judgment of the eye of the ordinary observer, so the questions of the extent and character of claims in patents for distinctive and segregable parts must be determined largely by the skill and judgment of the experts of the Office. Whenever the claim is to such distinctive and predominant parts as, when used and applied to an article of manufacture, would induce the ordinary observer to accept them as the whole design, the claim should be allowed; but when the segregation goes so far that the identity of the whole design ceases, and the ordinary observer would not be likely to recognize the sameness or resemblance between the segregated parts and the whole design, they should not be allowed. The ordinary observer —the public—is not learned in patent law nor the nice distinctions in matters of claims. The public is not required to be skilled in matters of art. In dealing with designs, patented or unpatented, ordinary observers judge of the design as a whole, and are not called upon to dissect and analyze it with accuracy. To permit claims for parts that belong to details which possess no distinct and visible resemblance to, and create in the mind no impression of, the whole design, would be to set traps for the unskilled and unwary. This is against public interest, and will not be tolerated.

Claims for distinctive and segregable parts of a design indicate the skilled judgment of the Office as to what parts and features of the design, if segregated from the whole and applied to an article of manufacture, would accord with the eye of the ordinary observer, and preserve the identity of the original and entire design. Evidently such claims

should be carefully scrutinized; otherwise the applicant may in the same patent cover a multiplicity of designs. The courts would probably not interfere to defeat such patents nor to limit them to the one original design, but, regarding each distinct design as an original, would rest the validity of the patent upon the discretion vested in the Commissioner as to such matters.

In the present case there is no claim presented for the design of the form of the dish and its ornamentation as a whole, unless the preamble and nine paragraphs can be regarded as one claim. I do not see how claims can be allowed for distinctive and segregable parts of a design when there is no claim for the whole design. If patented, is the completed design to be free, and its distinctive parts subject to patent? Or is the entire and finished design to be protected because the eye of the ordinary observer is required to recognize its identity with some of the segregated parts? Evidently, if variation in designs is to be recognized by allowing claims for distinctive parts, they must be formulated with reference to the whole design. The interests of the public require this.

In the case under consideration, claim 1 is for the rectangular rim of the dish with reference to the central bowl or any ornamentation whatever. Claim 2 is for the shape of the bowl with circular outline and the rim, without reference to the ornamentation. These two claims together would cover simply the shape of the dish, "as shown and described," but without such words or the implication of the law would embrace the rim with any kind of a central part, and the bowl with any kind of a rim, and the whole shape without any ornamentation. In effect, as was stated in *ex parte* Hill, the claims would cover two designs, in which case applicant should be required to take out two patents. Claim 3 covers the corners of the dish with their surface ornamentation. Claim 4 is for the surface ornamentation of the corners. Claim 5 is for the ornamentation of the corners and panels, composing the entire rim of the dish. Claim 6 covers the ornamentation of the panels of the rim. Claims 8 and 9 relate alone to the ornamentation, but these claims for ornamentation do not appear to be limited to a dish of the form and shape shown, and, as

already stated, this is essential where a design consisting of both form and surface ornamentation is to be embraced in a single patent.

The examiner calls attention to the fact that under *ex parte* Harris (38 O. G., 104) objections to claims for non-segregable parts relate to the merits rather than to form, and an appeal from such rejection should go to the examiners-in-chief. I concur in this view and follow that decision, but as the present appeal is taken as to matters of form as well as merits, I have felt justified in giving more consideration to the case than I otherwise would. The decision is affirmed as to the requirement that the words "as shown and described" be used in the claims, and the case is remanded to the primary examiner, to take such further action on the claims as he may see proper, in view of the principles expressed herein. If applicant desires to appeal from such action, his appeal from rejection of claims covering distinct and segregable parts must be taken to the examiners-in-chief.

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Ex parte GERARD.

Decided May 22, 1888.

43 O. G., 1240.

1. The relation of genus and species does not exist in designs. The question involved in designs is one of identity.

2. A patent for a design must be limited to a single invention; but such patent may cover any variation or modification, provided the distinct and predominant features so far remain as to preserve the identity of the original completed design.

Hall, Commissioner:

In this case applicant seeks to patent designs consisting of both shape and surface ornamentation. Six dishes are shown in the drawings, all differing in shape or contour. Each dish is ornamented with its own surface ornamentation; but the entire surface ornamentation of each dish is unlike that of any of the other five. In the shape of each

is some slight feature, such as a notch or indentation at a corner, and in the surface ornamentation of each is also found some features which are common to all. These features the applicant chooses to call distinct and segregable parts of his design, and upon them attempts to found a genus of design and its subordinate species. There is, and in the nature of the case can be, no entire and complete design—no one single design. Consequently, there is no claim for a single design as a whole, with other claims for distinct and segregable parts; but an attempt is made to apply the principles of generic and specific claims, which obtain in applications for mechanical patents.

Applicant devises certain rather unimportant forms relating to shape, and certain surface ornamentation; then exercising his skill and ingenuity in producing dishes of various shapes, he introduces his specific features of surface ornamentation. He claims, broadly, his specific features, and also incorporates claims for as many various and different forms of dishes, with their varied and different ornamentation as his imagination can produce. He has presented nineteen claims, one of which covers the shape of the dish, and the remaining eighteen cover the surface ornamentation of eighteen different dishes.

Claim 19 is as follows:

"The design for the shape of a plate or similar dish, consisting of straight sides, rounded ends, indentations a, a, at the approximate junction of the sides and ends, and radial ribs f, f, extending from said indentations across the rim."

With this broad claim for the shape or form applicant presents, as just stated, eighteen claims for as many different designs, based upon the fact that they possess some one or more features of form common to the parent design, or in common with each other.

On July 22, 1887, the examiner advised applicant as follows:

"The statute of designs (Section 4929, R. S.) provides for a new and original shape for an article of manufacture, or a new and original ornamentation thereof. A new and original shape may also have a new and original ornamentation; but a generic claim must be made for applicant's

invention in accordance with the doctrine in *ex parte* R. N. Eagle (C. D., 1870, 137).

"A claim may also be made for one of the species belonging to applicant's invention, but not for all the species which may exist under the generic invention."

"On renewed consideration of the application above entitled, it appears that there is no generic claim covering applicant's invention as disclosed, while there are many claims for various species and fragments thereof, contrary to the practice as above indicated. The objections noted in previous office letter are therefore withdrawn, and will not be insisted on at the present time, being dominated by the above-noted objection."

This action, as I understand, was not a rejection nor an objection to any specific claim, but was simply a declaration that the examiner could not proceed to a consideration of the case until applicant had presented a claim for one entire completed design. He required a generic claim to be made. This action being repeated, the applicant appeals to the Commissioner.

In another appeal by this applicant I have had occasion to discuss the nature and character of claims for distinctive and segregable parts, and my remarks in that case are equally applicable to this. I think the examiner was correct in requiring applicant to submit a claim for the one entire completed design invented by him, for from that alone can it be determined what is and what is not distinct and segregable. As explained in *ex parte* Gerard, above referred to, this depends upon identity as determined by the eye of an ordinary observer. Without the original entire design it is impossible to make comparison or define the segregable parts. The examiner was unfortunate, I am disposed to think, in acting upon this supposed analogy of mechanical patents, and requiring a generic claim for applicant's invention in accordance with the doctrine in *ex parte* Eagle (C. D., 1870, 137).

The relation of genus and species, in my opinion, does not exist in designs. As explained in the other case of applicant, the question is one of identity. A patent for a design must be limited to a single invention; but such patent will cover any variation or modification, provided

the distinct and predominant features so far remain as to preserve the identity of the original and completed design.

The decision of the examiner was correct, and is affirmed; but the case is remanded, and the examiner is at liberty to modify his statement of the requirement, or take such other action as he may see proper, in accordance with this decision.

———o———

Ex parte CARTY.

Decided July 9, 1888.

44 O. G., 570.

In the matter of the request of Martin Carty for the return of the fee paid on the 30th of March, 1888, for filing Caveat for Design for Ladies Collars and Cuffs.

1. Section 4902 of the Revised Statutes, providing for the filing of caveats for any new invention or discovery, does not apply to the subject of designs, nor is there any statute authorizing the filing of caveats for this class of inventions.
2. A design invention covers the form, contour, or ornamentation, and such design cannot exist in an incomplete condition. A patent when issued covers all the dominant and controlling features, all the distinct and segregable parts. Petition granted and fee ordered to be returned to applicant.

Hall, Commissioner:

Martin Carty presented to the office on the 30th of March, 1888, a caveat for a design for ladies' collars and cuffs, paid the filing fee of ten dollars, and requested that his caveat should be filed in the confidential archives of the office, in accordance with the rules and the statute. The examiner declined to file the caveat, or instrument called a "caveat," for the reason that in his opinion, the subject of design patent, as provided by statute, was not comprehended in Section 4,902 of the Revised Statutes, which provides for the filing of caveats in the Patent Office. That section is as follows:

"Any citizen of the United States who makes any new invention or discovery, and desires further time to mature

the same may, on payment of the fees required by law, file in the Patent Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his rights until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the Commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post-office in Washington, with the usual time required for transmitting it to the caveator added thereto; which time shall be indorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen."

After receiving notice of the action of the examiner the caveator, being in doubt as to the correctness of the decision, and desiring to file the caveat, if it could be done, and if not to have the filing fee returned to him, raised the question before the Commissioner by a petition setting forth the facts and requesting the return of such filing fee. In answer to this petition the examiner has renewed his statement that Section 4902 does not apply to design patents, and that there is no law authorizing the filing of caveats for such class of inventions. Briefly stated, his proposition is that before a design can have an existence for any purpose whatever, it must be invented and completed, and that a design which is incomplete can have no recognition under any of the statutes relating to the subject.

As is well understood, the subjects of design patents are form or contour and surface ornamentation, and it is physically impossible for any entity of that character to exist in an incomplete condition. There can be no circle when a

segment of it is absent. There can be no continuous line when it is broken. I concur fully in what the examiner has said upon this subject. At first I was disposed to think, in view of the decision announced in *ex parte* Gerard (43 O. G., 1235), that it would be proper to file a caveat for the predominant and controlling features of a design, enabling the caveator within the period provided by law to fill out the details and subordinate parts, in much the same manner as a caveator of a mechanical device would be enabled to describe generally his invention in the caveat and reserve the period allowed by law within which to complete and put it in practical operation, or reduce it to practice. But I am satisfied upon reflection that this is not the correct view, because if the design has reached such a state of completion that it may be said to be perfect in its distinct and segregable parts, it is in a condition to be patented, and there is no necessity for a caveat, and the caveat could serve no useful purpose.

As was stated in the case of Gerard, above cited, a patent which covers a completed design covers all the distinct and segregable parts with the mere minor details omitted, so that it may be conceded that the immaterial and subordinate details of designs are not regarded as a part of the patent; that so long as the dominant and controlling features, called the "distinct and segregable parts," occupying their proper place and relation to each other exist, the patent relates to and covers them, and, as just stated, when the design has reached this state of perfection, it may be said to be complete and capable of becoming the subject of a patent.

I therefore sustain the petition of the applicant for the return of the filing fee, and direct that it be returned to him.

Ex parte HALEY.

Decided July 16, 1888.

44 O. G., 1399.

An applicant who has filed an application for a design patent for the term of three and one-half years, which has received examina-

tion on the merits, will not be permitted to have the government fee paid on filing such application applied as part payment on a second application filed for the full term of fourteen years for the same subject-matter.

Hall, Commissioner:

Applicant petitions to be allowed to file a new application for a design for a term of fourteen years upon the payment of $20, the deficiency being made up by applying $10, previously paid on an application for the term of three and a half years. Applicant alleges that he made a mistake in filing the first application for three and a half years instead of for the full term.

The records of the Office show that on April 4, 1888, applicant filed a completed application for a design patent for glassware for the term of three and a half years. Accompanying this application was the necessary fee of $10. This application was duly forwarded to the examiner on April 6, 1888, and was examined by him as a complete application. On April 9 applicant was informed of the state of the art and of certain informalities, upon the correction of which the application, so far as then advised, would be in condition for allowance. Thereupon applicant, instead of correcting the informalities in his application, on May 3, 1888, filed a petition, asking that the period named by him, without which statement his application would not have been open to the consideration of the examiner, might be extended from three and one-half years to fourteen years. Such petition was not within the jurisdiction of the primary examiner, but was addressed to the Commissioner in person. On May 22, 1888, the assistant Commissioner denied this petition, but without prejudice to the right of the petitioner to renew it. (MS. Dec., vol. 37, p. 91.) Thereafter applicant prepared a new application for a patent for his design, and requested that the patent should run for the full term of fourteen years. This application was presented to the Office, accompanied by a request that the sum of $20 tendered therewith might be accepted and that the remainder of the fee required—viz., $10—be made good by applying the $10 paid, as applicant claims by mistake, on the first application.

It is evident that this second application has not been received by the Office as a completed application, because the full fee has not yet been paid. The present request, like the former one, is addressed to the Commissioner in person. As the case now stands the only question presented is whether the $10 paid on filing the first application was paid through mistake; if so, whether it ought to be returned to applicant or placed to his credit to be applied with the $20 to make up the full fee required for his second application.

I have examined the statements of applicant, and am not able to see that they show any evidence that a mistake was committed. Applicant simply says that he was not aware at the time he filed his first application that the law authorized design patents to be issued for different terms, but supposed there was a single uniform period for all such patents. This is only ignorance of the law, and not a mistake. Had applicant consulted an attorney concerning the preparation of his application, or had he made any inquiry whatever, he could have obtained all necessary information. If applicant should show that he made inquiry and obtained incorrect information, upon which he had acted, then he would present a showing of something in the nature of a mistake. Acting upon such information as he possessed, and without making any inquiry, applicant sent his application to the Office in such form as justified the action of the Office in making the usual examination. He has no right after having been advised of the state of the art, and being in no danger of losing the fee by an adverse decision, to use his ignorance or want of information under the circumstances as a plea for changing the term of his application from three and one-half years to the full term of fourteen years.

There are other reasons why it is against the policy of the Office to grant such requests unless the party who petitions discloses the fact that an actual mistake has been made, such as courts of equity recognize.

The petition is denied, and it will be necessary for the applicant before he can receive action upon his second application to pay the fee required by the statute.

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