THE LAW

OF

DESIGN PATENTS

CONTAINING

ALL REPORTED DECISIONS OF THE U. S. COURTS AND THE PATENT OFFICE, IN DESIGN CASES, TO A. D. 1874.

WITH DIGESTS AND TREATISE.

BY

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PREFACE.

THOSE members of the profession who have had occasion to give any considerable attention to design-patent matters, must have experienced difficulty in ascertaining just how much and what has been done toward settling the status of these patents. The decisions in the Patent Office have been conflicting, and the court cases are not altogether harmonious.

Fortunately, the Supreme Court has had occasion, of late, to pass somewhat fully upon a design-patent cause, and it seems an opportune time to collect the cases, digest them, and present them, with deductive comments, to the profession, in a single volume.

The syllabus of each case has been written anew, generally with greater fulness than in the original reports, and using, when practicable, the exact language of the judges.

The field covered is not a large one, but is rapidly growing in importance. An effort has been made to render the work thorough, accurate, and reliable, and thereby discharge, in some small measure, the debt that each member is proud to acknowledge that he owes to the profession at large.

WM. EDGAR SIMONDS.

Hartford, 1874.

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PART I.

A COLLECTION OF ALL THE REPORTED CASES

BEARING UPON LETTERS PATENT FOR DESIGNS,

DECIDED IN THE UNITED STATES COURTS,

TO JANUARY 1, 1874.

CASES.

DAVID ROOT *v.* BALL & DAVIS.

[4 McLean, 177. July Term, 1846.]

In an action on a design patent, a plea that the invention was in use or on sale before the application for the patent, is demurrable, unless the plea aver an abandonment, or that such use or sale was for more than two years before the application; for—under section 7 of the act of March 3, 1839—such use or sale must have preceded the application more than two years, in order to invalidate the patent.

"The same (design) patent may include a patent for a combination, and an invention of some of the parts of which the combination consists."

Where a law is in force inflicting a penalty for selling patented articles unstamped with the date of the patent, the selling of such articles unstamped, which were made before the date of the patent, has no bearing on the plaintiff's right to recover.

It is not necessary, in order to constitute infringement, "that the thing patented should be adopted in every particular; but if, as in the pesent case, the design and figures were substantially adopted by the defendants, they have infringed the plaintiff's right."

"It is an infringement to adopt the design so as to produce substantially the same appearance."

Fox, for the plaintiff.

Hart, for the defendants.

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 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 November, 1844, and thence 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 to 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 1st, 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 patent for

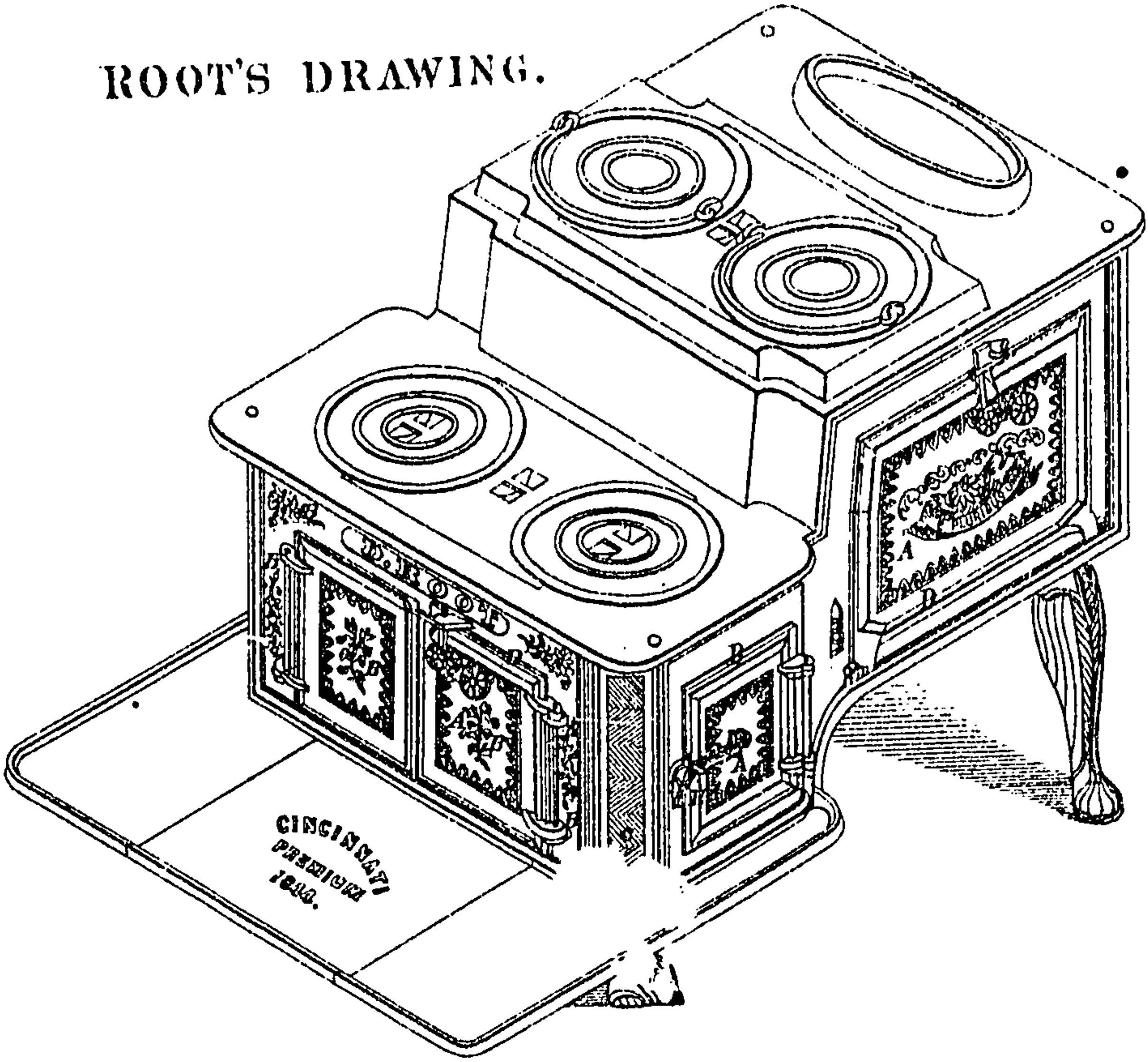
a combination, and an invention of some of the parts of which the combination consists. A patent for a combination is not infringed by the use of any part less than the whole of the combination (Moody v. Fiske, 2 Mason, 112).

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 stated 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 ornamental on the same parts of the stove, they would of course find the defendant guilty, 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.

ROOT'S DRAWING.



COPY *of the Specification of the Letters Patent in Issue in Root v. Ball* et al.

DAVID ROOT, Cincinnati, Ohio.—LETTERS PATENT, No. 36, dated 9th September, 1845.—DESIGN FOR STOVES.

To all Whom it may Concern:

Be it known that I, David Root, of Cincinnati, in the county of Hamilton and State of Ohio, have invented or produced a new design of doors and feet to stoves, as respects the ornamental work; together with the general design and combination of the several ornamental parts of the stove, and I do hereby declare that the accompanying drawings represent the same, viz.:

A, panneled doors with a gothic-pointed raffle leaf in panel; center of panel enriched with a vine leaf springing from a cluster of tied raffle leaves.

B, the front, containing a sunk transverse panel over the doors (containing the name D. Root), with semi-circular terminations, with the same vine leaf springing from clusters of tied raffled leaves on each side of the panel.

C, squares diagonally reeded in the corners and around the panel on the back of the stove.

D, the moulding round the doors, consisting of a flat ogee and fillet.

E, carving on feet and latches, consisting of a leaf in the center and top of the leg; also, a half leaf on each side of the center of the leg, and fluting on each side and toe-shaped reeds at the bottom, and one of the latches having a rosette on the falling end, and triangular grooves across the center; the other latch having a triangular groove around the edge and triangular fillet on the center. These latches are marked 1 and 2.

What I claim as original, or as my own invention, is the "General Design and Combination of the several Ornamental parts of the Stove; also, the Design of the Doors and Feet to the Stoves," but do not claim to be the inventor of the different parts of the stove, except as above set forth.

DAVID ROOT.

Witnesses:

E. SINGER,
JAS. S. SINGER.

JAMES D. SPARKMAN AND MELVILLE KELSEY *v.* HIGGINS & CO. AND C. & E. HARVEY.

[1 Blatch. 205. October Term, 1846.]

A motion to dissolve a provisional injunction will not be granted unless the affidavits offered in support of the motion overcome the equity of the bill and the evidence supporting it.

"The study of the courts has recently been, and especially since the patent acts of 1836 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."

"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 mean time."

On motion to dissolve provisional injunction, "it is not for the court * to examine critically the correctness or even sufficiency of the application, * made, to all appearance, in good faith, and * an attempt to make known and secure the claim."

"To constitute an inventor of a design, it is not necessary 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."

An inventor may stipulate for the sale of articles embodying his invention before his application for patent, without affecting his right to a patent.

Such sale does not constitute abandonment.

The failure of the commissioner of patents to inform a questioner that an application for patent is pending, whereby the questioner is led to make and sell goods embodying the invention, does not affect applicant's right.

Showing articles for sale as "patent goods," or as "registered patterns," will indicate that the taking of a patent thereon is intended.

Before BETTS, *J., South. Dist. N. Y.*

THIS was a motion before Judge Betts, sitting in the Circuit Court, to dissolve an injunction. The plaintiffs were the

patentees, under the act of August 29th, 1842 (5 U. S. Stat. at Large, 543), of a patent, issued July 24th, 1846, for a design for floor oil-cloth, called The Gothic Pavement pattern. The bill alleged an infringement by the defendants Higgins & Co., by selling, and by the defendants, the Harveys, by making oil-cloths of the patented pattern. An injunction was granted on the bill, and this motion to dissolve it was made on affidavits.

The defendants showed, that in January, 1846, one Smith, of Baltimore, saw a sample of the pattern at the plaintiffs' store in New York, and was informed that it was on sale, but not ready for delivery; that he ordered a quantity, which was sent to him on the 16th of March, and was immediately sold at Baltimore; that Higgins & Co. procured from Baltimore enough to show the pattern, and the Harveys, on seeing it, immediately prepared blocks for printing it, which were ready about the 23d of May, when they proceeded to print. They also showed that Rice & Sampson, of Hallowell, Maine, saw the pattern at Baltimore, in May, went to the Patent Office at Washington, and were then informed that it was not patented, procured the pattern, took it to their works in Maine, made the blocks for printing it, and proceeded to print from them, prior to the date of the patent. The defendants also set up, that the design was the invention of one Berry, a workman in the plaintiff's employ, and made oath that when they got the pattern they did not know it was patented or that the invention was claimed by the plaintiffs.

The case on the part of the plaintiffs was this: Kelsey was a practical manufacturer and designer of patterns. Sparkman was familiar with the styles of the trade. They would discuss together the subject of patterns, and inform Berry of their wishes, and criticise and suggest, while the patterns were being designed. Berry had been instructed by Kelsey in the art of getting up patterns.

In the summer of 1845, Kelsey proposed to Berry to get up a pattern of the kind afterwards patented. Berry did so, but the plaintiffs, on seeing it, disapproved of it, and suggested alterations and improvements.

These were adopted by Berry in a new pattern, which was substituted for the first one, and was the one patented. In January, 1846, a sample was printed and sent to the plaintiffs' store to be exhibited for the sale of goods by orders. Higgins & Co. saw it there, and were told by Kelsey that it was some of their patent goods.

Soon afterwards Smith saw it, and was told by Kelsey it was some of their registered patterns, a term to denote goods of designs patented or intended to be. Smith ordered a quantity, to be delivered as soon as possible. On the 20th of February the plaintiffs' application for a patent for the design was received at the Patent Office. But the papers, being informal, were amended and sworn to anew, and the application was renewed on the 23d of March. On the 22d of June the papers were again returned as informal, and were then corrected and filed again on the 14th of July. The patent was then issued.

Seth P. Staples, for the defendants.

Daniel Lord, for the plaintiffs.

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 1836 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 mean time. 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.

DON ALONZO BOOTH *v.* JULIUS GROSS GARELLY AND OTHERS. IN EQUITY.

[1 Blatchford, 247. October Term, 1847.]

NELSON, J., N. Y.

A design patent was granted under the act of August 29, 1842, for "a new and ornamental design for figured silk buttons." The specification describes the configuration of the mold or block forming the foundation of the button, and the mode of securing the thread with which the mold is wound, but does not describe the process of winding the thread. The claim is for "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."

Held, that the process of winding is not claimed, but that "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."

Inferentially, the claim in a design patent may cover a genus or class of ornaments.

Abandonment is a question of fact.

The 7th section of the act of March 3, 1839, allowing two years' public use and sale of an invention prior to application for patent, held applicable to design patents granted under the act of August 29, 1842.

Quære, whether the sale of an article bearing a design is a sale of the design.

Provisional injunction refused where the novelty of the patented design was attacked, and it was admitted that the patentee had, before his application for the patent, sold large quantities of articles bearing the patented design marked as imported from abroad.

THIS was a motion for a provisional injunction to restrain the defendants from infringing the plaintiff's patent. The case is sufficiently stated in the opinion of the court.

Samuel Sherwood, for the plaintiff.

Abijah Mann, Jr., for the 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: 1st. The configuration of the mold or block, having radial indentations thereon, forming the foundation of the button; 2d. 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, § 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.

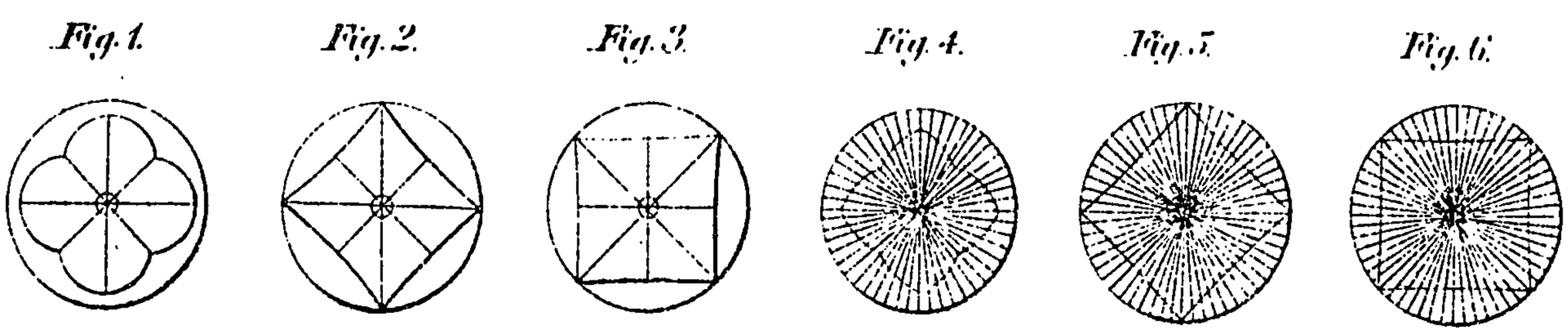
If the button be regarded simply as a product of the in-

vention, 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 defendants.

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

BOOTH'S DRAWING





COPY *of the Specification of the Letters Patent in Issue in Booth v. Garelly* et al.

DON A. BOOTH, NEW YORK, N. Y.—LETTERS PATENT FOR DESIGN FOR FIGURED-SILK BUTTONS, No. 139.—Dated 24th July, 1847.

To all to Whom these Presents shall Come:

Be it known that I, Don A. Booth, of the city, county and State of New York, have invented a new and ornamental design for figured-silk buttons, and that the following is a full, clear and exact description thereof, reference being had to the accompanying drawings making part of this specification.

This design for an ornamental button is composed of two distinct elements or characters which are to be used in combination to insure the beauty of the article. These consist, first, in the configuration of the mold or block, having radial indentations thereon, which forms the basis of the button; and, second, in winding said block with silk in the manner hereafter described; the beauty and effect of this design being due to these two features which, together, form the design, and without which it cannot be produced.

In the accompanying drawings, figures 1, 2 and 3 represent wooden molds cut with different figures, all of which radiate from the center, so that in winding on the silk the threads shall cross each other in the center, represented in figures 4, 5 and 6.

After the threads of silk have been wound on the mold, where they cross each other in the center, they are secured by a thread which passes through a hole in the center of the mold, as shown in figures 1, 2 and 3, to prevent the figuring threads from slipping from their appropriate places.

In addition to this mode of figuring, the silk or radially wound covering can be varied in its colors to any extent of shade desired without affecting the general character of the design. 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 mold, so long as these figures are formed in the face of the mold by depressions and elevations which radiate from a point, whether on the center of the mold or eccentric thereto.

What I claim in the above-described design as my invention, and desire to secure by letters patent, is the radially formed ornaments on the face of the molds 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.

D. A. BOOTH.

Witnesses:

JOHN V. GRIFFIN,
WILLIAM TROTTER.

EMMA C. WOOSTER *v.* JASON CRANE *et al.* IN EQUITY.

[2 Fisher's Patent Cases, 583.]

BENEDICT, J., South. Dist. N. Y., Oct. 7, 1865.

"The act (of March 2, 1861) 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 (and) expense, and must * * * 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."

Where the patented shape was "a common one in many articles of manufacture," "an arbitrary, chance selection of one of many well known shapes all equally well adapted to the purpose," from the selection of which no advantage was derived except the incidental use as a trade-mark—the patent held invalid.

(Before BENEDICT, J., Southern District of New York, October, 1865.)

THIS was a bill in equity, filed to restrain defendants from infringing upon letters patent for a "design for a reel," granted under the act of March 2, 1861, to complainant, and dated October 20, 1863.

The facts sufficiently appear in the opinion of the court.

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 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 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 or 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 desise 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 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, 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 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.

WOOSTER'S DRAWING.

Fig. 1.

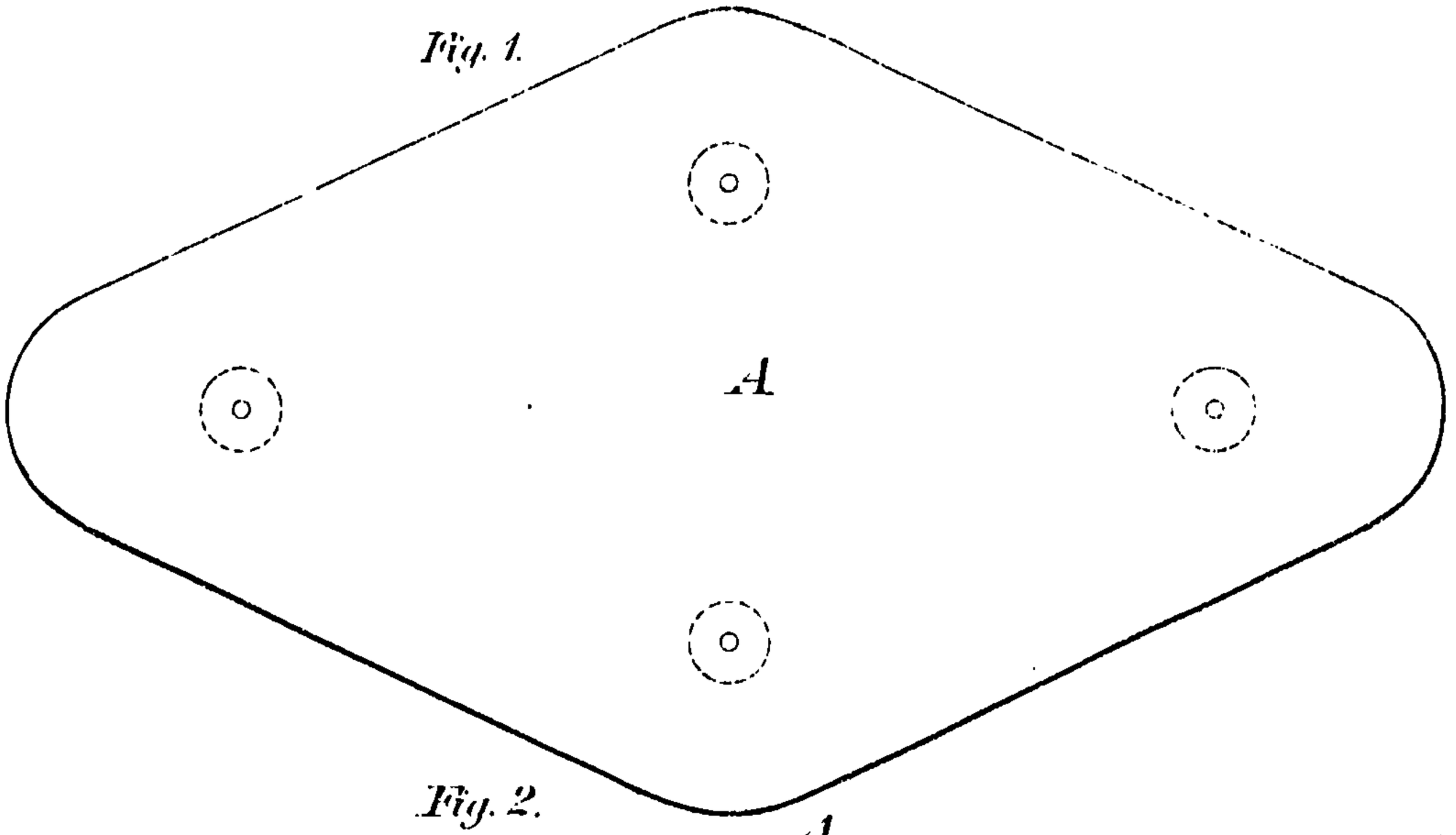
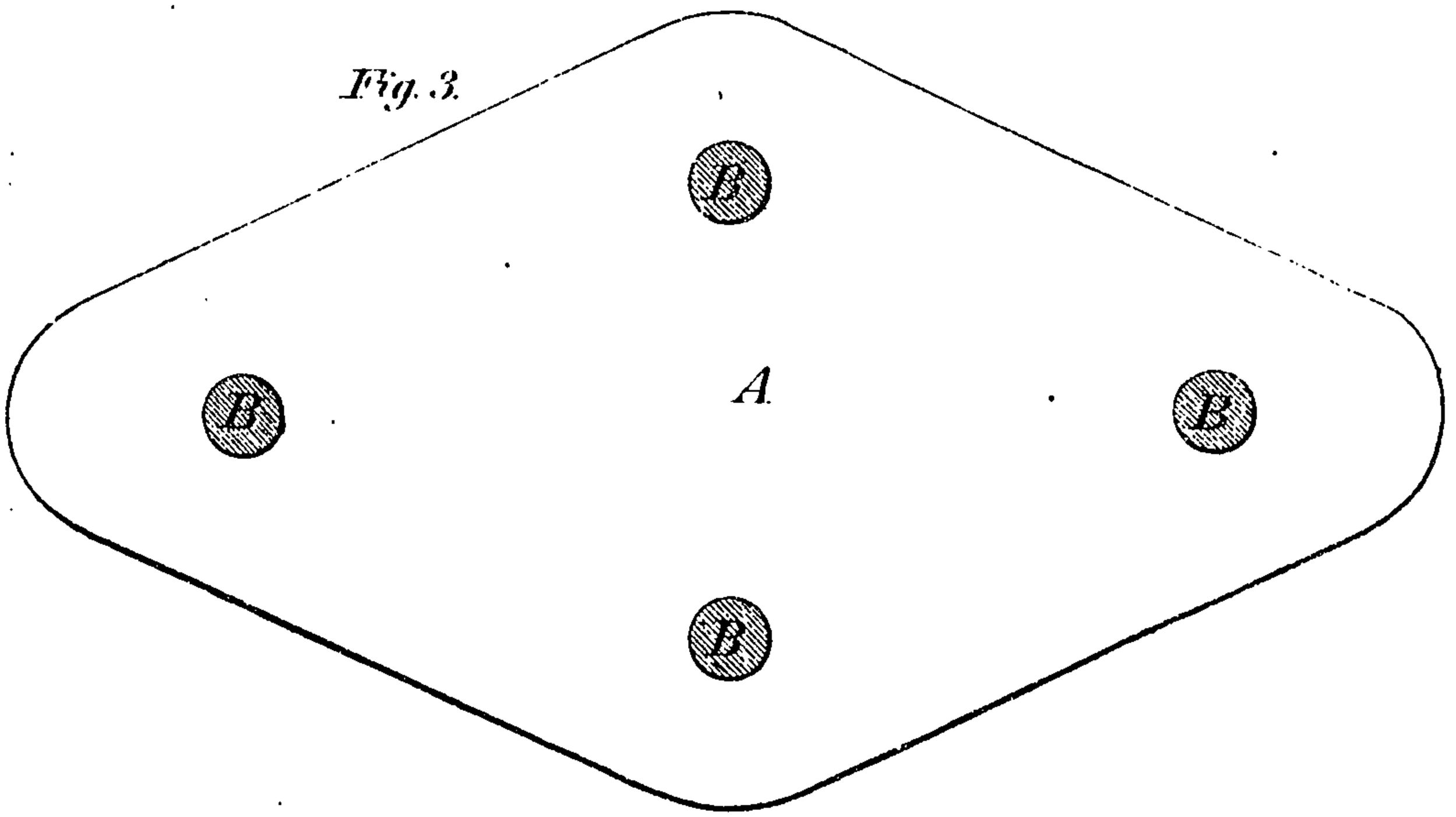


Fig. 2.

Fig. 3.



Copy *of the Specification of the Letters Patent in Issue in Wooster v. Crane* et al.

EMMA C. WOOSTER, of New York.—LETTERS PATENT, No. 1834, dated October 20, 1863.—DESIGN FOR A REEL.

To all Whom it may Concern :

Be it known that I, Emma C. Wooster, of the city, county and State of New York, have invented a new design for a reel for containing ruffles, ladies' dress trimmings and other goods; and I do hereby declare that the following is a full, clear and exact description of the same, reference being had to the accompanying drawings forming part of this specification, in which

Figure 1 is an end view of the reel.

Figure 2 is a side view of the same.

Figure 3 is a section of the same in a plane parallel with figure 1.

Similar letters of reference indicate corresponding parts in the several figures.

The configuration of the reel is that of a rhombus with the angles rounded off—its heads, *A A*, being composed of disks of that form, and the rods, *B B*, which connect them, being arranged near the rounded corners.

What I claim as my invention, and desire to secure by letters patent is;

The design and configuration of the reel herein described and represented in the accompanying drawings.

EMMA C. WOOSTER.

Witnesses :

THOS. J. DOUGLASS,
GEO. W. REED.

CLARK *v.* BOUSFIELD.

[10 Wallace, U. S. Sup. Ct. 133.]

In a patent for an "Improvement in Machines for Graining Pails," one claim, among others, was made for "arranging the elastic material aforesaid, whether curved or rectangular in form, in a series of distinct staves or designs, substantially, &c.," Held—That this is not a claim for a design.

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 4th, 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 2d, 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*, &c.; or any new and original impression or ornament, to be placed on any article of manufacture, &c.; 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, &c., 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, &c.

With both acts in force, R. & A. Cross obtained, December 27th, 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 imitation 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 grove 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 impressed 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 eleven of the act of March 2d, 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 mechanism 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. Carey, 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, &c., 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 in 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 below 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 re-

ducing 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.

CROSS'S DRAWING.

Fig. 2.

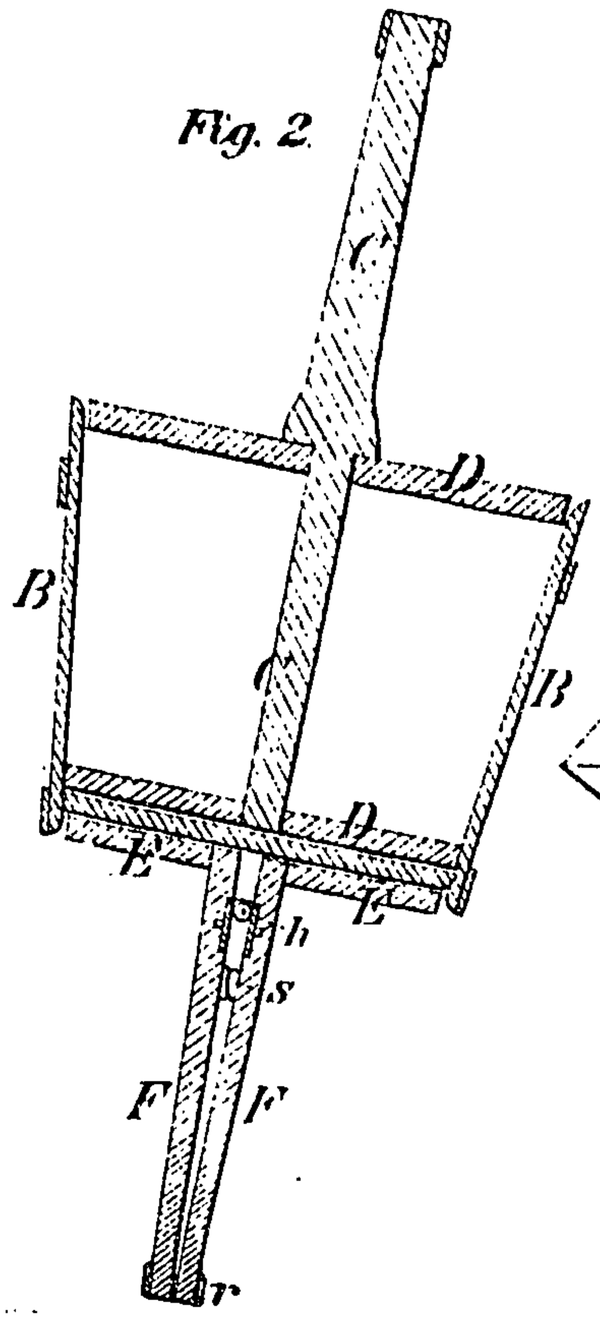
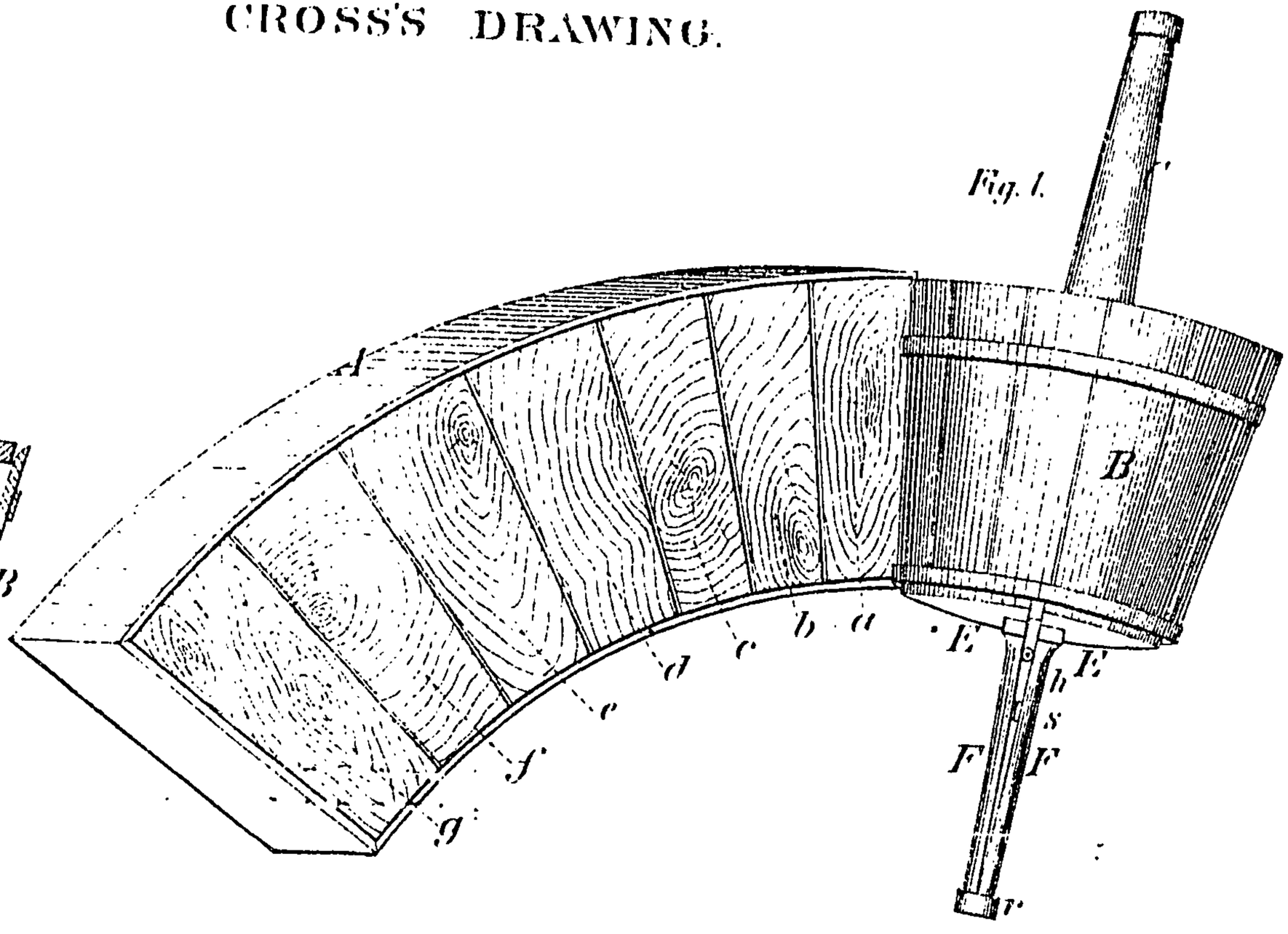


Fig. 1.



Copy *of the Specification of the Letters Patent in Issue in Clark v. Bousfield.*

J. R. & A. J. Cross, of Chicago, Illinois.—Letters Patent, No. 45,500, dated December 17, 1864.—Apparatus for Graining Pails.

SPECIFICATION.

To all Whom it may Concern:

Be it known that we, J. R. Cross and A. J. Cross, of Chicago, in the county of Cook, and State of Illinois, have invented a new and useful Improvement in Machines for Graining Pails and other analogous uses; and, we do hereby declare that the following is a full, clear and exact description thereof, reference being had to the accompanying drawings and the letters and figures marked thereon, forming part of this specification.

In the said drawings, which are hereunto attached,

Figure 1 represents a perspective view of our invention, and

Figure 2 is a central sectional view of the pail or other vessel to be grained, with the devices thereunto attached.

The nature of our invention consists in constructing the 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 designs, so that by moving the pail over the same, the various designs will be stamped upon the pail, thus producing a pail whose staves are painted in imitation of different kinds of wood.

To enable those skilled in the art to fully understand how to construct and use our invention, we will proceed to describe the same with particularity, reference being made to the aforesaid drawings.

A represents the box or bed into which the elastic material impressed with the required designs to be grained upon the pails, is placed or framed, and may be constructed of wood or iron, or any other material suitable for the purpose.

The elastic bed upon which the desired impression is made, presents a plane surface, whose area is included between the arcs of two concentric circles described upon radii whose difference in length is equal to the height of the pail or other vessel to be grained, the length of the exterior arc being equal to the circumference of the top or larger end of the pail, and the length of the interior arc being equal to the circumference of the bottom or smaller end thereof, and the corresponding ends of the said two arcs being joined by two straight lines.

The curvatures of said arcs must be adapted to the different sizes of pails to be grained, and also to the different inclinations of their sides from the vertical, so that when the pail is adjusted properly upon said

bed, and rolled upon and over it, the upper or larger end shall follow the outer curve, and the lower or smaller end shall follow the interior or smaller curve, with exactness and precision.

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 as shown in figure 1, by the letters, *a*, *b*, *c*, *d*, *e*, *f*, *g*, so that the pail or vessel grained thereon or thereby, shall present the appearance of being constructed of different kinds or species of woods, as rosewood, oak, walnut and others.

The elastic bed may be constructed of any suitable impressible material, as rubber or leather, but I consider the best material for the purpose to be a compound of glue and molasses, which is used for printers' rollers.

The bed may also be constructed of separate pieces or blocks, as shown, 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 same material may also be employed to imitate marbles, and other ornamental stones.

It may be used for graining other wares, as for japanning and other similar purposes, and also for graining broom handles.

It may be observed, however, that when the articles to be grained have upright or parallel sides, the bed may be of rectangular form instead of the form shown.

C, *D*, *E* and *F*, represent the handles and other devices for affixing or attaching said handles, *C* and *F*, to the pails to facilitate the operation of graining.

D, *D* are two circular plates fitting closely into the pail as shown, which are rigidly attached to the handle, *C*, and when introduced as shown into the pail, hold the same firmly.

E, *E* represent a circular plate divided in two parts, to each of which is rigidly attached the handles, *F*, *F*, as shown.

The said handles, *F*, *F*, are connected by a hinge at *k*, and between them is arranged a spring, *s*, to throw said handles apart when not confined by the ring, *r*, upon the ends of the same.

Having described the construction and nature of our invention, we will now describe the mode of operation and application of the same.

The ring, *r*, being removed from the end of the handle, *F*, *F*, the opposite ends thereof approach each other, being forced together by the operation of the spring, *s*, and hinge, *k*, and thus the two parts of the plate, *E*, *E*, are drawn together diminishing its size so that it can readily introduce within the chine of the bottom of the pail, when by pressing the ends of *F*, *F*, together and replacing the ring, *r*, the plate, *E*, *E*, is expanded and adjusted within said chine, so as firmly to fasten the

handle, *F*, so the pail. The handle, *C*, is then readily inserted and adjusted within the pail, when the operator grasps the handles, *C*, *F*, and adjusts the pail upon the elastic bed as shown, the paint or coloring matter having been previously applied thereto by means of a roller, or in any other suitable and convenient manner. The pail is then readily rolled across the bed, and is, by this simple operation, grained in the most beautiful manner in staves, in imitation of various woods or marbles, as before described, when the handles are detached and applied to another pail and the operation repeated.

Instead of rolling the pail over the said bed, the pail may be suspended upon the handles or their removable equivalents, and the elastic bed itself moved beneath the pail in a suitably arranged groove or truck producing the same result. Or the application may be made in any other convenient and practical manner.

Having described the nature, construction and operation of our machine for graining pails and other analogous uses, we will now specify what we claim as new therein and desire to secure by letters patent.

First. We claim constructing the bed of 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.

Third. We claim the arrangement of the expansible plate, *E*, *E*, and the handle, *F*, *F*, provided with the hinge, *k*, and spring, *s*, as and for the purposes described.

Fourth. In combination with the last foregoing, we claim the employment of the handle, *G*, and plates, *D*, *D*, as and for the purposes shown and described.

J. R. CROSS,
A. J. CROSS.

Witnesses:
L. L. COBURN,
W. E. MARRS.

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

[7 Blatch. 513. South. Dist. N. Y. BLATCHFORD, J., Sept. 1870.]

The letters patent to John Gorham, Gorham Thurber, and Lewis Dexter, Jr., dated July 16th, 1861, for a "design for the handles of table spoons and forks," are not infringed by articles made in accordance with the letters patent to Le Roy S. White, dated January 15th, 1867, for a "design for spoon handles, fork handles," &c., or by articles made in accordance with the letters patent to Le Roy S. White, dated March 31st, 1868, for a "design for spoon, fork, and other handles."

The several designs treated by the court in analyzing and comparing them as composed, each—in general terms—of a combination of two elements, to wit: 1st, the outline of the handle; and 2d, the ornamentation on the handle.

The outlines of two of the handles being found to be substantially the same, but the ornamentation thereon being held to be somewhat different, the two designs were held not to be substantially identical.

The eye of an ordinary or casual observer is not a proper test as to the substantial identity of designs on different articles.

"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," and "the object * * * may solely be increased utility."

The only test of the substantial identity of designs on different articles "is 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 designs—of a person accustomed to compare such designs one with another, and who sees and examines the articles containing them side by side."

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

"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."

BLATCHFORD, J. This suit is founded on letters patent granted to John Gorham, Gorham Thurber, and Lewis Dexter, Jr., July 16th, 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 semicircular 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 15th, 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 31st, 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 handle 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 ornamentations on the faces of the two handles come to be considered, striking differences appear between the plaintiffs' 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 comparisons 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 a 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 plaintiffs' 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 plaintiffs 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 a design 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 gratifi-

cation 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 designs—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, and not for the result or appearance itself. The plaintiffs' patent is for their 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.

Charles M. Keller and *Charles F. Blake*, for the plaintiffs.

George Gifford, for the defendant.

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

[U. S. Supreme Court, December Term, 1871.]

The letters patent to John Gorham, Gorham Thurber, and Lewis Dexter, Jr., dated July 16, 1861, for "a design for the handles of table spoons and forks," *are* infringed by articles made in accordance with the letters patent to Le Roy S. White, dated January 15, 1867, for a "design for spoon handles, fork handles, &c.;" and by articles made in accordance with the letters patent to Le Roy S. White, dated March 31, 1868. for a "design for spoon, fork and other handles."

"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 as 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."

"It is the appearance itself, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense."

"To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities."

"The controlling consideration is the resultant effect."

"The true test of identity of design * * 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."

"Experts, * are not the persons to be deceived." "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, inducing him to purchase one, supposing it to be the other, the first one patented is infringed by the other."

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 design 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 appearances, 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 Cha. 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 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 value 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 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, and 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, and 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 plaintiffs' 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

concavity is greater in the White design. How much effect this variance has must be determined by the evidence. In all the designs the ornament is, in part, a rounded molding or bead along the edge, with scrolls at the shoulders and near top. There are, however, some diversities in this ornament, which are discoverable when attention is called to them. In the plaintiffs', the bead is interrupted at the shoulders and at the tip by the scrolls, while in both the designs of White it is continued unbroken around the scrolls. In the plaintiffs', 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, Thurber, and 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., &c. This is the testimony of men who, if there were a substantial difference in the appearance or in the effect, 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 complainants' 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.

The decree of the Circuit Court is reversed, and the cause is remitted, with instructions to enter a decree in accordance with this opinion.

Justices Miller, Field, and Bradley dissent in this case.

Copy of the Specification of the Letters Patent in Issue in The Gorham Manufacturing Company v. George C. White:

JOHN GORHAM, GORHAM THURBER, and LEWIS DEXTER, Jr., of Providence, R. I.—LETTERS PATENT FOR A DESIGN No. 74, dated July 10, 1861.—HANDLES FOR TABLE SPOONS AND FORKS.

SPECIFICATION.

To all Whom it may Concern:

Be it known, that we, John Gorham, Gorham Thurber, and Lewis Dexter, Jr., of Providence, in the State of Rhode Island, have invented or produced a new and original design for the handles of table spoons and forks; and we do hereby declare that the following is a full, clear, and exact description thereof, reference being had to the accompanying drawings making part of this specification, in which—

Fig. 1 is a plan of the upper surface; and

Fig. 2, a like view of the under surface.

Figs. 3 and 4 are cross sections, taken at the narrowest and at the widest parts of the handle.

In figures 1 and 2 of the accompanying drawings *a* represents the stem of the handle either of a spoon or fork, and *b* the enlarged end thereof. The stem is gradually but slightly increased in width from about the middle of its length towards each end, the swell being more sudden at *c*, where it joins the bowl or fork. At the rear extremity of the stem, where the enlarged part *b* commences, it spreads out on each side with a rounded shoulder *d d*, and then gradually spreads out in concave lines as at *e e*, these lines gradually becoming convex to the widest part, where they run back and inwards, as at *f f*, finally uniting to form a nearly semicircular end. Along each edge there is a small rounded moulding *g g*, and just within this a row of beads *h h*, and at the shoulders *d d* the mouldings *g g*, that look like wires, are united by two rosettes, having somewhat the appearance produced by twisting together the ends of wires to unite them; and at the rear end the mouldings from each side are turned into a rosette, the two rosettes, as at *i i*, coming in contact with a small rounded tip *j* making the central finish. Between the rows of beads the surface is swelled, as at *k*, figure 4, this swell being gradually flattened towards the widest part of the handle.

What we claim as new, and desire to secure by letters patent, is the design herein specified for the handles of spoons and forks, as set forth and represented.

JOHN GORHAM,
GORHAM THURBER,
LEWIS DEXTER, JR.

Witnesses:

ALBERT M. HEWITT,
HENRY MARTIN.

GORHAM, THURBER & DEXTER'S DRAWING.

Fig. 1.

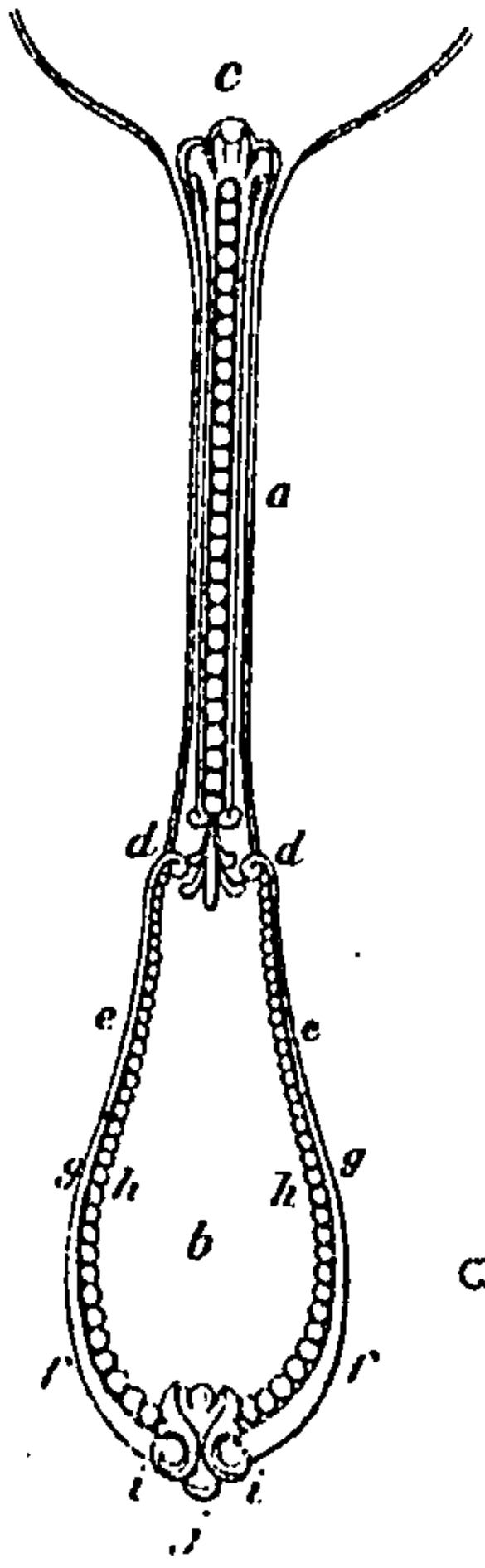


Fig. 3.



Fig. 4.

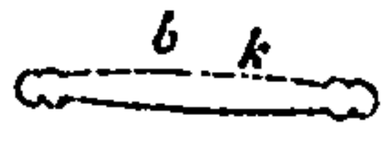
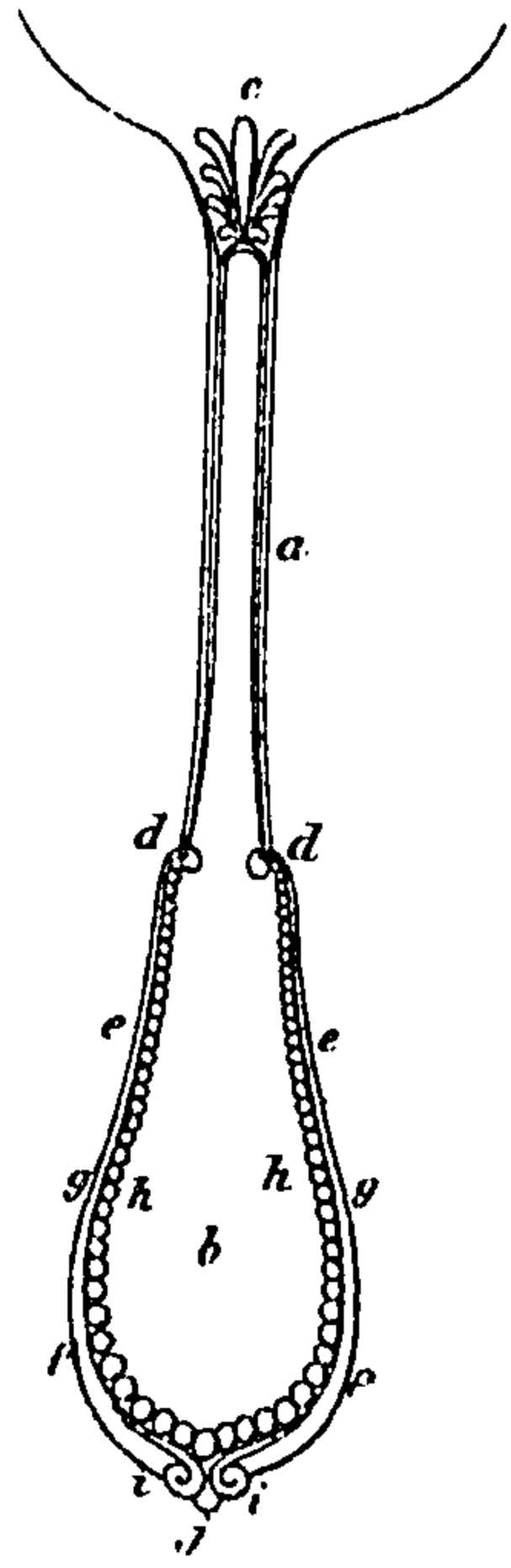
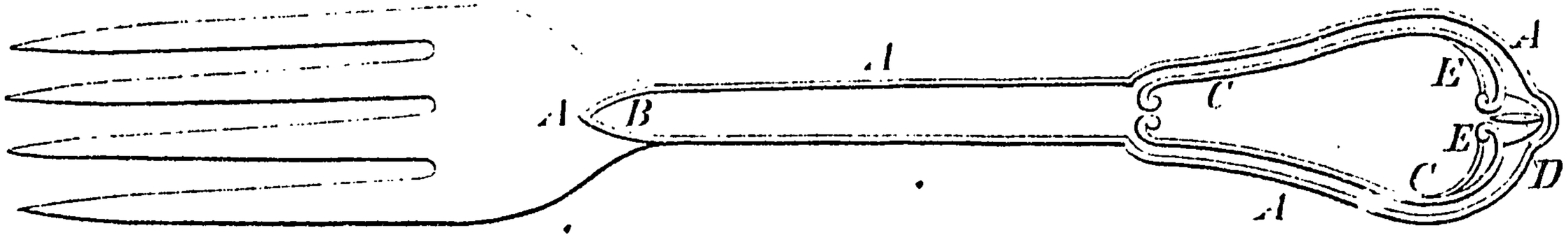


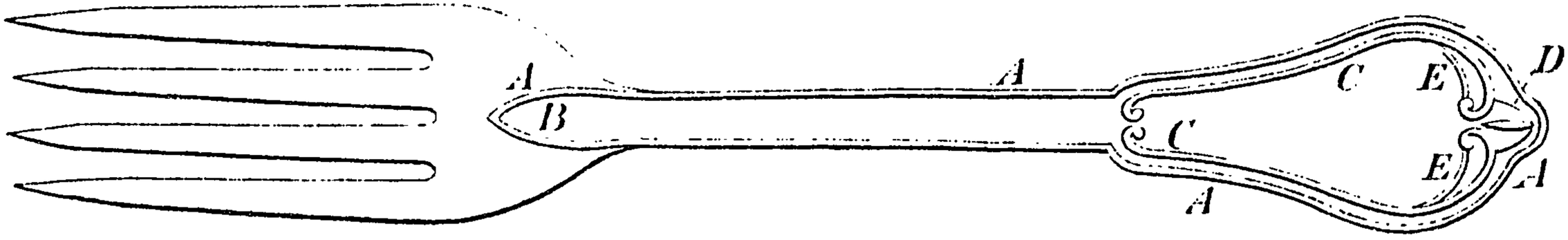
Fig. 2.



WHITE'S DRAWING

PAT. No. 2551.





LE ROY S. WHITE, of Waterbury, Connecticut.—DESIGN No. 2,551, dated January 15, 1867.—DESIGN FOR THE HANDLE OF A FORK OR SPOON.

SPECIFICATION.

To all Whom it may Concern:

Be it known that I, L. S. White, of Waterbury, in the county of New Haven, and State of Connecticut, have invented a new and improved design for spoon handles, fork handles, &c.; and I do hereby declare that the following is a full, clear, and exact description thereof, reference being had to the accompanying drawings, forming part of this specification, in which—

Figure 1 is a front view, and

Figure 2 is a rear view of the same.

Similar letters of reference indicate like parts.

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 said handle begins to expand or broaden, and terminates with a small rounded projection at the extreme end. Along the edges of the front and rear sides of the handle is formed a single line A, following the contour of the handle, and extending down upon the end of the fork or spoon in the form of a rounded angle B; this angle extending further down upon the rear than upon the front side of said head. Along the sides of the broader part of the handle is formed a second line C, terminating at each end with an inward curve and bead, as shown in figs. 1 and 2. In the space between the end curves of the lines C and the line A, where it follows the outline of the rounded projection upon the end of the handle, is formed a shield D, having a central longitudinal rib or raised line, as shown. E are short, curved lines, starting from the end curves of the lines C, and uniting with said lines at the broadest part of the handle, as shown in figs. 1 and 2.

I claim as new, and desire to secure by letters patent—

The design for fork handles, spoon handles, &c., herein shown and described.

LE ROY S. WHITE.

Witnesses:

DAVID B. HAMILTON,

CHARLES A. HAMILTON.

LE ROY S. WHITE, of Waterbury, Connecticut.—DESIGN No. 2,092, dated March 31, 1868.—DESIGN FOR A SPOON OR FORK HANDLE.

SPECIFICATION.

To all Whom it may Concern:

Be it known that I, Le Roy S. White, of Waterbury, in the county of New Haven, and State of Connecticut, have invented a new and improved design for spoon, fork, and other handles, of which the following is a full, clear, and exact description, reference being had to the accompanying drawing, forming part of this specification, and which represents a front view of a spoon or other handle, or same in part fashioned to embrace my new design.

The stem or shank portion, A, of the handle may be of any suitable length, and is made with two rounded formations along its side edges, constituting a raised border *a*, that follows the contour of the whole handle, and is the same front and rear of the latter as are the several ornamental configurations on or of the handle. The stem or shank portion, A, forms its junction with the upper or expanded portion of the handle by a swell *b*, on either side, of convex shape, that gradually merge or meet concave lines or boundaries *c*, which give a narrowed configuration to the expanded portion of the handle above the swells *b*, and afterwards, or further up, where the boundaries are continued by convex lines *d*, a wider form, such spread-out portion finally terminating in a rounded or arched projection *e*, at the top or extreme end. Along either side of the broader portion B of the handle, within the line or border *a*, is a second line *f*, following, for the most part, the contour of the border, but terminating at each end with an inward curve and bead, as shown in the drawing. In the space between the upper end curves of the lines *f* and border *a*, where it follows the outline of the projection *e*, upon the end of the handle, is formed a shield *g*, having a central longitudinal rib or raised line, as shown. There are also short curved lines *h*, joining the end curves of the lines *f* with the broadest part of the handle, as represented in the drawing.

What is here claimed, and desired to be secured by letters patent, is—

The design for fork, spoon, or other handles, as herein shown and described.

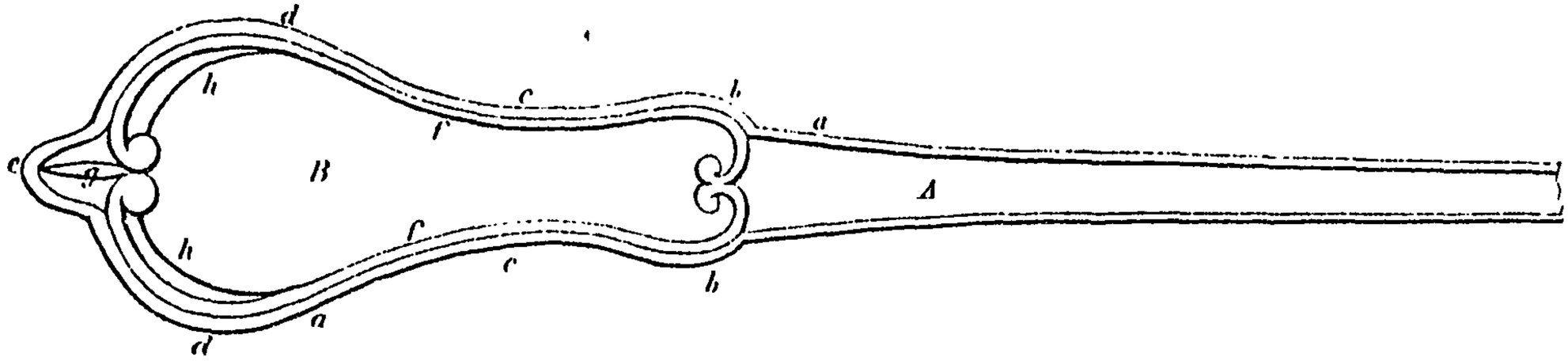
LE ROY S. WHITE.

Witnesses:

C. A. HAMILTON,
GEO. E. BERRY.

WHITE'S DRAWING

PAT. No. 2992.



HUGH W. COLLENDER v. WM. H. GRIFFITH.
THE SAME v. THE SAME.

[U. S. Circuit Ct., South. Dist. N. Y., 1873.]

The defendant will not be permitted on the hearing to read depositions showing prior knowledge and use of the thing patented by persons whose names are not given in his answer.

It being shown that tables with the sides beveled inward from the top have been known before, a patent is void which claims the design of a billiard table thus constructed, in order that the player may advance his foot further under it.

It is a mere question of judgment, not invention, how far the bevel shall be carried, and a patent for the design of a billiard table is not rendered valid because a much deeper bevel is shown in it than has been used in other tables.

If a patent for a design includes as a part thereof the ornamentation shown in it, it is no infringement to use the principal figure without the ornamentation.

A person who publishes by way of advertisement an engraving of an article he has on sale, cannot by copyrighting it prevent others who have an equal right to sell the article from using a similar engraving in advertising it.

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 the complainant's alleged invention. This is so clearly established that the argument in behalf of the complainant 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.

Copy of the Specification of the Letters Patent in issue, in Hugh W. Collender v. Wm. H. Griffith.

HUGH W. COLLENDER, of New York, N. Y.—DESIGN No. 4,073, dated June 6, 1871.—DESIGN FOR A BILLIARD TABLE.

To all Whom it may Concern:

Be it known that I, Hugh W. Collender, of New York city, county of New York and State of New York, have invented certain new and useful improvements in the shape and design of billiard tables; and do hereby declare that the following is a full and exact description thereof, reference being had to the accompanying drawing making part of this application.

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 thirty or forty 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

COLLENDER'S DRAWING.

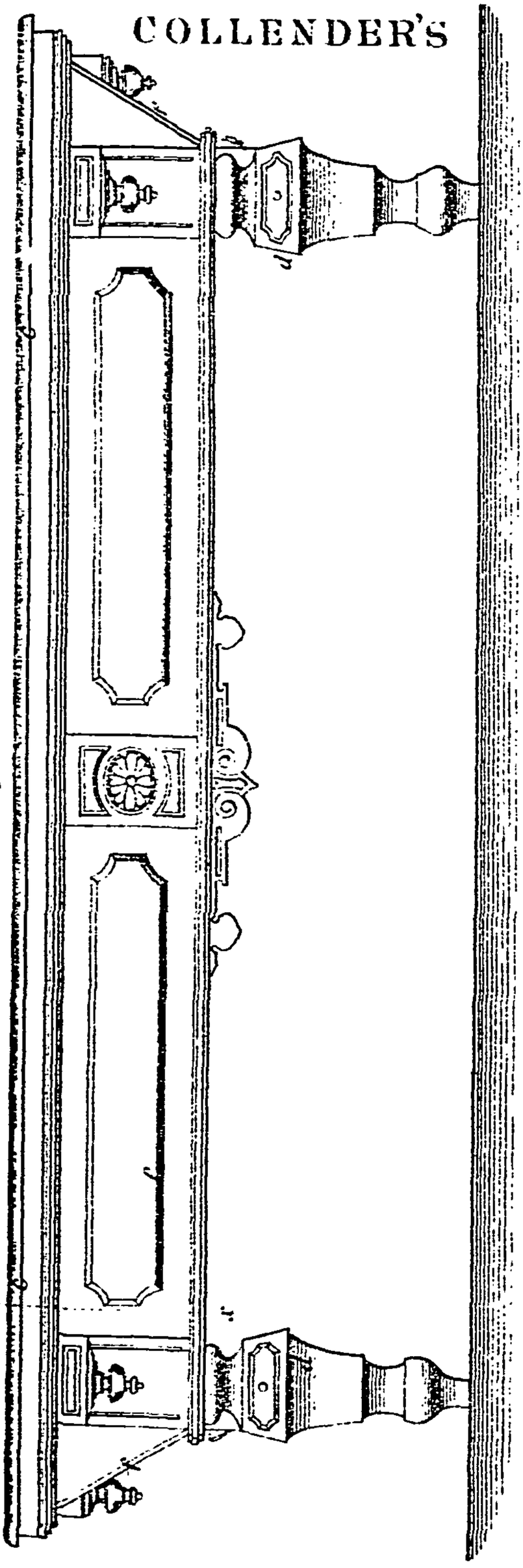


Fig. 1.

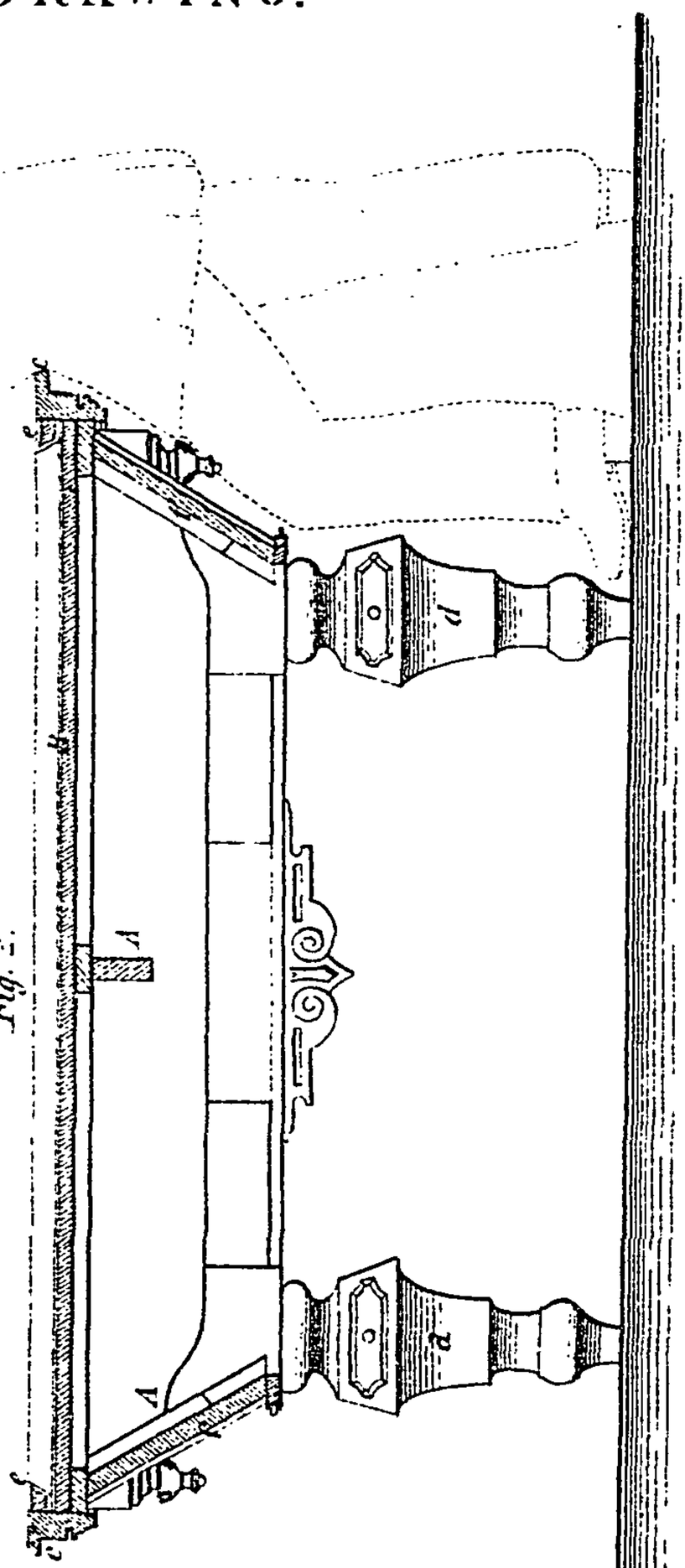


Fig. 2.

is no more than in the manufacture of the vertical sided tables now generally made.

The inclined or flared sides *f* may be ornamented, paneled, &c., to any desired extent.

By reference to the figure drawn at fig. 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 table as now made, have to be played with the bridge.

Having clearly shown and described the characteristic features of my new design for billiard tables,

What I claim, and desire to secure by letters patent, is—

The design for billiard tables, as herein shown and described.

In testimony whereof I have hereunto set my hand and seal this 11th day of February, 1871.

HUGH W. COLLENDER. [L. S.]

Witnesses:

HENRY N. BROWN,

W. M. ERNST.

PART II.

A COLLECTION OF ALL THE REPORTED CASES,

BEARING UPON LETTERS PATENT FOR DESIGNS,

DECIDED IN THE U. S. PATENT OFFICE,

TO JANUARY 1, 1874.

CASES.

JASON CRANE, *Ex parte.*

Appeal from Examiners-in-chief. April 20, 1869.

[Commissioners' Decisions, 1869, page 7.]

In the matter of the application of JASON CRANE, *for a patent for a design for a* FUR SET BOX.

Letters patent allowed for the design of an article on the ground of the *utility* of the article.

"The construction which has been given to that act (the act of August 29, 1842), 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."

"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."

"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."

"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."

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 com-

manded 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 as 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 original 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 indefinite. 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 new inventions, or as coming within the scope of general patent laws. They add to the market value and salability 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, 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.

The construction given to the statute by the board of appeals seems to me to be erroneous, and I accordingly overrule their decision.

B. L. SOLOMON, *Ex'r* OF MYER PHINEAS.

Extension. August 17, 1869.

[Commissioners' Decisions, 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.

It does not follow that because an article embodying or bearing a design is meritorious, the design itself is equally so.

"The doctrine of the office has been for a long time, that a patent for a design * * * could only be issued for articles possessed of artistic excellence."

"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, sec. 11), 'whether made for ornament merely, or intended to promote convenience or utility.'"

The *utility* of an article bearing a patented design, taken into account in considering the propriety of extending the patent for the design.

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, sec. 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 con-

sideration 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 resulted 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.

WM. N. BARTHOLOMEW, ASSIGNOR TO J. BECKENDORFER, *Ex parte*, APPEAL FROM EXAMINER-IN-CHIEF.

December 2, 1869.

[Commissioner's Decisions, 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.

"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."

"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."

"The practice of the office has not been uniform" as to granting or denying generic claims in design patents.

"A valid patent may be granted for a new genus or class of ornaments, as well as for specific ornaments, though, * * * , 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."

It has been the practice of the office to grant design patents for *useful* forms as well as for those of *artistic excellence.*

"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."

"Modes of operation or construction, principles of action, combinations to secure novelty or utility of movement, or compositions of matter can hardly be said to be 'shapes, configurations or designs.'"

"Where the sole utility of the new device arises from its new shape or configuration * * it may fairly be included among the subjects which the act of 1842 was designed to protect."

"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."

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 this 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, &c., 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 reason, 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 Blatch. 247. The design is described as consisting of "radially formed ornaments on the face of the molds 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 mold, by depressions and elevations which radiate from a point, whether in the center of the mold 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 begin-

ning, 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, [illegible] 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 as 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 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 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 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, that 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, combinations

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, "hav- the ends beveled to an edge," in lieu of the phrase erased, or he should adopt the usual form of claim 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.

ISRAEL C. MAYO, *Ex parte.*

Motion. February 23, 1870.

[Commissioner's Decisions, 1870, page 14.]

In the matter of the application of ISRAEL C. MAYO *for letters patent for a* DESIGN FOR A TRANSPARENT SHIELD.

An applicant for a design patent must make his election *at the time of making application*, of the term—three and one-half, seven, or fourteen years—for which he desires his patent to issue, and, at the same time, pay the prescribed fee for the so elected term.

FISHER, Commissioner. The applicant makes application for a patent for a design. He pays $10 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 $20, 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 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 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.

STUART & BRIDGE, *Ex parte*.

Motion. February 23, 1870.

[Commissioner's Decisions, 1870, page 15.]

In the matter of the application of DAVID STUART *and* LEWIS BRIDGE *for letters patent for a* DESIGN FOR A COOKING STOVE.

"No provision is made for use or sale of the invention"—in the matter of design patents—"prior to the application, as in the case of other inventions."

"The design must not have been known or used by others prior to the application of the inventor."

"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."

"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."

A patent, other than a design patent, cannot be reissued and changed, either as a whole, or by a division into a patent for a design.

FISHER, Commissioner. The applicants on November 3d, 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 2d, 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, and 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.

ISAAC A. SHEPPARD, *Ex parte.*

Motion. March 8, 1870.

[Commissioner's Decisions, 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 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.

"There has been no uniform practice to the contrary, by the Patent Office, in the granting of design patents.

"If the design contains features which are new, singly and in combination, no reason is known * * why they may not be so claimed."

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 Decision, 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.

GEORGE H. SELLERS.

Motion. June 8, 1870.

[Commissioner's Decisions, 1870, page 58.]

In the matter of the application of GEORGE H. SELLERS *for letters patent for* IMPROVEMENT IN ROLLED HOLLOW HEXAGONAL COLUMNS.

"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."

"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 copyright."

There is "no discretion or authority vested in the commissioner to turn this application"—an application for a mechanical patent—"into an application for a design, nor any process by which it can be accomplished short of a new 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 an hexagonal shape."

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 configuration 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 or 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 2, 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 an 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 regard 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, 1869, 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, or 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.

WILLIAM KING.

Motion. September 10, 1870.

[Commissioner's Decisions, 1870, p. 109.]

In the matter of the application of WILLIAM KING *for letters patent for a* DESIGN FOR A TRADE MARK.

The provisions of section 77 of the act of July 8, 1870, "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."

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 semicircular 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 table containing the words, 'None genuine without my portrait and signature, W. King,' said signature being a *fac simile* of my handwriting. 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 a 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.

EGBERT W. SPERRY.

Extension. October 28, 1870.

[Commissioner's Decisions, 1870, page 139.]

In the matter of the application of EGBERT W. SPERRY *for the extension of letters patent Nos.* 2,641 *and* 2,642, *for* DESIGNS FOR A KNIFE, FORK, OR SPOON HANDLE, *granted April* 30, 1867.

Since the passage of the act of July 8, 1870, the commissioner has no power to extend patents for designs issued since March 2, 1861.

The fact that the application for the extension of such a patent was filed before the passage of the act of July 8, 1870, does not preserve the right to such 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 to 67 inclusive) which provide for the extension of patents for inventions as 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 2d day of March, 1861."

The patents now offered for extension, being patents for designs issued since the 2d 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 the 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 extension 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.

E. RAY FENNO.

Appeal from Primary Examiner. February 27, 1871.

[Commissioner's Decisions, 1871, page 52.]

In the matter of the application of E. RAY FENNO *for letters patent for a* DESIGN FOR DAMPER FOR STOVE PIPES.

Mechanical construction is not claimable in a design patent.

In the statute relating to design patents, there is "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."

"The language"—of the statute—"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."

"The present law"—the act of July 8, 1870—"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."

Applicant sought a design patent for a stove-pipe damper, which was like a prior damper, except in the shape of a certain orifice. *Held*, that if applicant could show superior utility in his form of orifice, that would entitle him to a patent.

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 regarded 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 of 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 an 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 consideration 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.

WALTER L. TYLER.

Appeal from Examiners-in-Chief. April 27, 1871.

[Commissioner's Decisions, 1871, page 100.]

In the matter of the application of WALTER L. TYLER *for letters patent for a* DESIGN FOR A CLOCK-CASE.

"The material used, or mode of construction employed, cannot in any way affect the question of novelty or patentability" in relation to design patents.

A design for a circular clock-case, having flaring or sloping sides, composed of rounded rings, or laminæ, of different colored woods, so that the various stripes of color are seen from whatever direction the case is viewed, is not anticipated by a circular clock-case, of common form, 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.

Nor by an oval picture frame of alternate rings of different colored woods, the outer rings having the greater projection, showing, when viewed in front, alternate stripes of different colors, but, if viewed from the side, only a single wood of a single color.

LEGGETT, Commissioner. The applicant describes 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's 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 describes 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 rings 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.

PHILIP WEINBERG.

Appeal from Primary Examiner. September 6, 1871.

[Commissioner's Decisions, 1871, page 244.]

In the Matter of the application of PHILIP WEINBERG *for* DESIGN PATENT ON MUFFS.

"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."

"The word 'produced,' as used in the statute referring to design patents, was not intended to permit the grant of design patents, 'without evidence of the exercise of inventive genius, * * * nor was it intended in any way to let down the standard for grant of patents.'"

"'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 esthetical effect is produced—an original idea indicated."

LEGGETT, Commissioner. This case comes from the primary examiner on the following question:

Can color, parti-colors (indefinable), 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 construction 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 esthetical 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 explanation, my views are, I think, sufficiently indicated for the case under consideration and other similar cases.

PETER C. PARKINSON.

Appeal from Primary Examiner. September 25th, 1871.

[Commissioner's Decisions, 1871, page 251.]

In the matter of the application of PETER C. PARKINSON *for a design patent for a* CLAW HAMMER.

"The law authorizing design patents, was intended to provide for an entirely different class of inventions" from those properly covered by machine or functional patents—"inventions in the field of æsthetics, taste, beauty, ornament."

"The term 'useful,' in relation to designs, means adaptation to producing pleasant emotions."

"By 'article of manufacture,' as used in this section," of the design patent law, "the Legislature evidently meant only ornamental articles, articles used simply for decoration."

"Creative genius is demanded in giving existence to a new and original design."

"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 æsthetic effect, deserves but little favor or consideration."

The case of Bartholomew (Com'r Dec. 1869, page 103), commented on and dissented from.

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 æsthetics, 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 in 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, 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 æsthetic 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 patent 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 æsthetic 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 bound-

aries and landmarks 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.

W. N. BARTHOLOMEW.

Appeal from Examiners-in-Chief. November 23, 1871.

[Commissioner's Decisions, 1871, page 298.]

In the matter of the application of WM. N. BARTHOLOMEW, *for letters patent for an* INDIA-RUBBER ERASER.

The previous grant of a design patent, covering only the *form* of an article, will not prevent the grant of a mechanical or functional patent covering the peculiar *construction* of such article.

DUNCAN, Acting Commissioner. The present applicant is also a patentee, under date of January 4, 1870. In the patent then granted him he describes a rubber eraser molded into an elongated cylindrical form, and enwrapped in a casing of paper, leather, or other suitable article, which is secured to it by a cement or other like means. In the application upon which that patent was allowed, there was originally claimed "the cylindrical rubber eraser provided with a wrapper or case, as shown and described," the claim itself being thus made to relate not merely to the form of the eraser, but also to the mode of its construction; but the commissioner, having the case before him in person on appeal, held that, inasmuch as the applicant was seeking a design patent, the mode of construction and the composition of matter could not be allowed to enter into, or in any way modify, the technical claim, but that this must be confined entirely to the shape or configuration. Accordingly, while the description setting forth the mode of construction was permitted to stand in the specification, the claim was limited to the "design for a rubber eraser, as shown and described." In other words, the thing then patented was simply the form or shape given to the eraser.

Bartholomew now comes to the office, and asks a patent on the mode of construction. As before, he forms the eraser by molding a vulcanizable rubber compound into a distinctively pencil-like form, which, after vulcanization, is tightly wrapped with a casing of paper, leather, or other equivalent

material, secured by means of glue or other suitable cement. This wrapper is to be cut away as the rubber wears down with use, and the ends of the eraser are to be cut and shaped as circumstances require. The object of the sheath or wrapper is, in part, to keep the rubber from becoming soiled by contact with the fingers and otherwise; the object of the glue, which becomes hard on drying, is, to give, in connection with the wrapper, a proper degree of stiffness for the required manipulation in using, and the design of the pencil-like form is the same as before, viz., convenience in handling and in carrying.

The claim is for "a rubber eraser composed of a stick or pencil of vulcanized-rubber erasive compound of distinctively pencil-like form, and a surrounding sheath of paper, leather, or equivalent material, the two being united by glue or other cement which, like glue, will harden on drying, substantially as herein shown and set forth."

The objections hitherto made in the office in the allowance of this claim are two-fold: First, it is said that the patent of January 4, 1870, is a bar to the patent now sought. The board, in their decision, assert that the design patent is limited by material and construction, and that under such circumstances the issue of another patent would be highly improper, since the practice of the invention under either patent would be an infringement of the other. In this position, however, it is believed the board are in error. This is not a case where a party whose invention has to do exclusively with form, and who has obtained a design patent upon it, subsequently seeks to secure a mechanical patent covering the same ground. Such a practice, if it ever obtained, cannot be too emphatically condemned. No man can have two valid patents at the same time upon the same invention, and covering the same ground.

In the present case, while it is true that in the specification of the patent the construction of the eraser is fully described, yet all reference thereto is carefully excluded from the claim. This, in fact, was the only condition under which, in conformity with the commissioner's decision in the premises, a design

patent could be granted. The commissioner, referring in his decision to the description of the mode of construction contained in the specification, used these words:

"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."

The original claim was changed to meet this view. It is plain, therefore, that the patent covers the *form* of the eraser only, independent of any and every kind of wrapper, as well as the mode in which such wrapper may be applied. It would have been better, doubtless, had all description of the mode of construction been omitted from the specification. It is all extraneous and irrelevant matter. Still its presence does not affect the scope of the claim or modify the patent; and, if a patent should be granted upon the pending application, it would not follow, as suggested, that the two patents would be infringements, each upon the other. The earlier patent, at least, relating to form alone, would be independent. The existence of that patent, then, cannot operate as a bar to the grant of another for the mode of construction, into which, at most, the form shown in the existing patent enters merely as one among several elements.

Again, it has been urged that the use of the leather or paper wrapper upon the pencil-shaped eraser, is an instance of mere double use, which, by a well-established rule, is not patentable. Applicant himself, in one of his arguments, admits that for years thin rectangular blocks of erasing compound, with the middle part incased, have been sold in the market; it is also admitted that artists' stubs, of elongated cylindrical shape, and formed of paper, cork, or leather, have been similarly wrapped or incased; and it further appears that a distinctively pencil-like form has been given not only to such stubs, but to rubber erasers also,—for which see applicant's design patent. From these premises it has been assumed that, in what is now presented for consideration, there is at best nothing more than the application of an old article to a new use.

In determining whether this be the correct view, inquiry must be made as to the function of the wrapper in its new use. If the application of an old wrapper to a well known form of eraser, is accomplished in the same way as its application to erasers of other forms, or to other articles having the same form, and is unaccompanied with any new results, it must be pronounced a mere double use. But in artists' stubs, and in the rectangular blocks of rubber, the wrapper is used chiefly, and, for aught that appears, solely, for the purpose of keeping the inclosed article from becoming soiled; but in the present instance it is claimed, and perhaps with reason, that the wrapper, in order to secure the most valuable results, must be made to perform a new function, viz., give greater rigidity to the structure than it would otherwise possess, and that the stiffness or supporting power can best be obtained by the use between the wrapper and the stick of rubber of glue or some other cement that hardens on drying. Now, this is a thing that was not to be anticipated as a necessary result of the change made in the form of the eraser.

The use of the wrapper secured by means of a cement, that on hardening will give additional stiffness, seems to bear a close analogy, so far as concerns the question of patentability, to the use of a knit fabric on the handles of whips, which formed the basis of the Woodbury patent, sustained by Judge Blatchford in Strong v. Noble. In that case it appeared that prior to the invention for which the patent was granted, tubular knit fabrics had been used for various purposes, that whips were old, and that it was no new idea to cover whip handles with some suitable material; and yet the court held that the application of a tubular knit fabric, as a covering for whip handles, was not a double use in any such sense as to invalidate the patent, assigning as the basis of the decision, that it could not be told necessarily, *a priori*, without experiments, that the advantages actually obtained would accompany the new application of the knit fabric.

This rule would seem to be equally applicable to the present case.

The decision of the board of examiners-in-chief is accordingly overruled.

WILLIAM WHYTE.

Appeal from Primary Examiner. November 28, 1871.

[Commissioner's Decisions, 1871, page 304.]

In the matter of the application of WM. WHYTE *for letters patent for a* DESIGN FOR AN ALLEGED ORNAMENTAL PRINT FOR FABRICS.

"There can be little doubt that, in the enumeration of subjects for design patents, as contained in * * * statute * * 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 a merely 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."

"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."

Query. Ought not a design patent to specify the particular article which is to embody or bear it? And does it protect as to any other article?

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 a reason that the design is really intended for a trade-mark, and that the applicant accordingly must obtain protection, if at all, by register-

ing 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 marked 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 service 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 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 relates 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, etc., 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 the 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

J. D. DIFFENDERFER.

Appeal. Decided July 8, 1872.

[Of. Gaz. U. S. Patent Office, vol. 2, page 57.]

Appeal from the principal examiner in the matter of the application of JOHN D. DIFFENDERFER *for letters patent for a* DESIGN FOR DESK STANDARD.

"Every applicant for a design patent has an undoubted right to show both the obverse and the 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 an application for a design patent on a desk standard, applicant described, in the specification, certain parts which performed mechanical functions, and then claimed "The design for a desk standard, substantially as herein shown and described."

Held, that "this language obviously carries the function of the parts mentioned into the claim," and that "applicant should be required to erase from his description all reference to the function of" such parts.

THATCHER, 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, re-stating 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 3d 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 applications 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.

T. B. DOOLITTLE.

Appeal. Decided July 31, 1872.

[Of. Gaz. U. S. Patent Office, vol. 2, page 275.]

Appeal from the primary examiner in the matter of the application of T. B. DOOLITTLE *for letters patent for improvement in* BUTTON-HOLE CUTTERS.

The peculiar shape of one part of an article being designed to serve a useful purpose, and not for ornamentation, it is proper subject-matter for a claim in a machine patent.

THATCHER, 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 examiner-in-chief, when considering this application on appeal, probably because they very properly regarded it as a question appealable directly to the commissioners. 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 patent.

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.

H. W. COLLENDER.

Appeal. Decided October 2, 1872.

[Of. Gaz. U. S. Patent Office, vol. 2, page 360.]

Appeal from the Board of Examiners-in-chief in the matter of the application of H. W. COLLENDER *for patent for* BILLIARD TABLE, *filed January* 6, 1870.

A mechanical and a design patent cannot both be granted for the same subject-matter.

But a single device may present subject-matter for both kinds of patents, one covering the plan of construction, and the other covering the design—the shape, form, or configuration—of the article.

THATCHER, Acting Commissioner. Applicant claims "a billiard table formed with beveled side rails, or with the sides of its body beveled 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 the configuration adopted, he now seeks protection for said beveled frame without regard to configuration.

The case of Bartholomew (C. D. 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.

Interference. Decided January 30, 1873.

[Of. Gaz. U. S. Patent Office, vol. 3, page 91.]

Appeal from the principal examiner in the matter of the interference between the application of H. W. COLLENDER, *for alleged improvement in* BILLIARD TABLES, *and the patent of* W. H. GRIFFITH, *for a* DESIGN FOR BILLIARD TABLES, *granted October* 24, 1871.

"An interference does not *necessarily* result in the grant of a patent to one of the parties for the subject-matter involved."

Where an applicant for a patent for a *design* must necessarily use the *construction* previously patented to another, in producing the design, an interference should be had between the application and the patent.

THATCHER, 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 should 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.

T. B. OGLESBY.

Appeal. Decided February 24, 1873.

[Of. Gaz. U. S. Patent Office, vol. 3, page 211.]

Appeal from the principal examiner in the matter of the application of THOMAS B. OGLESBY *for patent for* COTTON-GIN SAW.

"If the shape * * * has been altered for the purpose of improving its appearance merely, * * * then the modification is calculated to produce the novelty and utility requisite to warrant the grant of a design patent."

"If the shape * * * 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."

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 advantages resulting from it, rendered it an important and patentable mechanical invention. This case is analogous, and the examiner's decision must, therefore, be overruled.

COLLENDER *v.* GRIFFITH.

Interference. Decided March 11, 1873.

[Of. Gaz. U. S. Patent Office, vol. 3, page 267.]

Appeal from the decision of the primary examiner in the matter of the interference between the application of H. W. COLLENDER *and the design patent of* W. H. GRIFFITH, *granted October* 24, 1871, *for improvement in* BILLIARD TABLES.

An interference may properly be declared between an application by A. for a mechanical patent, and a prior design patent to B., which shows but does not claim the feature claimed in the application for the mechanical patent.

Although A. has a prior design patent, which is also prior to the design patent of B., and shows the feature claimed by A. in his application for a mechanical patent, such design patent to A. need not be put into the interference.

In the interference, the burden of proof is on A. notwithstanding his design patent. A. may have the benefit of his prior design patent by putting 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 believed 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, Collender 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 Griffith 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 burdens of proof which he sustains upon the records in the cases which are actually and necessarily in interference.

The examiner's decision is sustained.

L. W. FAIRCHILD.

Appeal. Decided March 12, 1873.

[Of. Gaz. U. S. Patent Office, vol. 3, page 323.]

Appeal from the principal examiner in the matter of the application of L. W. FAIRCHILD, *for letters patent for a* DESIGN FOR A SIGN.

A name-sign, with an imitation gold pen attached to it, held to be a proper subject for a design patent.

A distinction made between such subject and the tool for which a patent was asked in Parkinson, *ex parte*, Com'r Dec. 1871, page 251.

"All description of the mechanical construction of the article should be eliminated" from the specification, "as well as all reference to its purpose as a matter of utility."

THATCHER, 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.

ALOIS KOHLER.

Appeal. Decided May 17, 1873.

[Official Gazette, vol. 4, page 53.]

Appeal from the Board of Examiners-in-Chief, in the matter of the application of ALOIS KOHLER, *for patent for* DESIGN FOR ROLLING SHUTTER-SLATS.

Patent denied for a design shown in prior mechanical patent granted to present applicant.

"The design patent might have been first granted and afterward 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 seems that if notice of an intention to claim the design had been given in the application for the mechanical patent, a patent for the design might be granted afterward.

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 slat 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 (C. D., 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 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 afterward 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 applicant 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 the 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 patent denied.

BLOOMFIELD BROWER.

[Vol. 4, Pat. Of. Gaz. p. 450.]

Appeal from the decision of the Primary Examiner, in the matter of the application of BLOOMFIELD BROWER *for patent for* DESIGN FOR INKSTANDS.—Decided October 28, 1873.

An inkstand and a removable stopper, both square in their general shape but with all the angles similarly chamfered, do not, together, constitute a single design.

The ordinary use of an article, for which a design is presented is a controlling consideration in determining what separable parts may be included in one design.

"There is not, * 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."

The relative positions of the inkstand and stopper when together are not always the same, and a "design cannot embrace in its scope, alternates or equivalents of form."

The stand and the stopper, 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 * * present subject-matter for patent, were such a union consistent with their ordinary use."

THATCHER, 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, results. 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 its 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.

PART III.

DIGEST OF ALL THE REPORTED CASES,

UPON LETTERS PATENT FOR DESIGNS,

DECIDED IN THE UNITED STATES COURTS,

TO JANUARY, 1, 1874.

DIGEST.

[Explanation.—The figures following the stars thus (* p. 10) refer to the pages of this book; the other reference letters refer to pages of the original reports.]

ABANDONMENT.

"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." "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 rights being acquired by strangers interfering in the mean time."

Sparkman v. *Higgins*, 1 Blatch. 205, N. Y. 1846 (* p. 6).

An inventor may stipulate for the sale of articles embodying his invention before his application for patent, without affecting his right to a patent. Such sale does not constitute abandonment.

Ibid.

Showing articles for sale as "patent goods," or as "registered patterns," will indicate that the taking of a patent thereon is intended.

Ibid.

Abandonment is a question of fact.

Booth v. *Garelly et al.*, 1 Blatch. 247, N. Y. 1847 (* p. 11).

CLAIM.

"The same (design) patent may include a patent for a combination, and an invention of some of the parts of which the combination consists."

Root v. *Ball et al.*, 4 McLean, 177, Ohio, 1846 (*p. 1).

A design patent was granted under the act of Aug. 29, 1842, for "a new and ornamental design for figured silk but-

tons." The specification describes the configuration of the mold or block forming the foundation of the button, and the mode of securing the thread with which the mold is wound, but does not describe the process of winding the thread. The claim is for "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."

Held, that the process of winding is not claimed, but that "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."

Booth v. *Garelly et al.*, 1 Blatch. 247, N. Y. 1847 (* p. 11).

Inferentially, the claim in a design patent may cover a genus or class of ornaments.

Ibid.

In a patent for an "improvement in machines for graining pails," one claim, among others, was made for "arranging the elastic material aforesaid, whether curved or rectangular in form, in a series of distinct staves or designs, substantially, &c." *Held*, that this is not a claim for a design.

Clark v. *Bousfield*, 10 Wallace, Sup. Ct. 133 (* p. 20).

DATE OF PATENT.

Where a law is in force inflicting a penalty for selling patented articles unstamped with the date of the patent, the selling of such articles unstamped which were made before the date of the patent, has no bearing on the plaintiff's right to recover.

Root v. *Ball et al.*, 4 McLean, 177, Ohio, 1846 (* p. 1).

IDENTITY.—INFRINGEMENT.

It is not necessary, in order to constitute an infringement, "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."

Root v. *Ball et al.*, 4 McLean, 177, Ohio, 1846 (* p. 1).

"It is an infringement to adopt the design so as to produce substantially the same appearance."

Ibid.

The failure of the commissioner of patents to inform a questioner that an application for patent is pending, whereby the questioner is led to make and sell goods embodying the invention, does not affect applicant's right.

Sparkman v. *Higgins*, 1 Blatch. 205, N. Y. 1846 (* p. 6.)

Several designs for handles of spoons and forks treated by the court in analyzing and comparing them, as composed, each—in general terms—of a combination of two elements, to wit: 1st, the outline of the handle, and 2d, the ornamentation on the handle.

Gorham Mfg. Co. v. *White*, 7 Blatch. 513, N. Y. 1870 (* p. 30).

The outlines of two of the handles being found to be substantially the same, but the ornamentation thereon being held to be somewhat different, the two designs were held not to be substantially identical.

Ibid.

The eye of an ordinary or casual observer is not a proper test as to the substantial identity of designs on different articles.

Ibid.

"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."

Ibid.

The only test of the substantial identity of designs on different articles "is 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 designs; of a person accustomed to compare such designs one with another, and who sees and examines the articles containing them side by side.

Ibid.

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

Ibid.

"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."

Ibid.

"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."

Gorham Mfg. Co. v. *White*, U. S. Sup. Ct. 1871 (* p. 39).

"It is the appearance itself, * no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense."

Ibid.

"To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities."

Ibid.

"The controlling consideration is the resultant effect."

Ibid.

"The true test of identity of design * * 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."

Ibid.

"Experts * are not the persons to be deceived." "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, inducing him to purchase one, supposing it to be the other, the first one patented is infringed by the other."

Ibid.

If a patent for a design includes, as a part thereof, the ornamentation shown in it, it is no infringement to use the principal figure * without the ornamentation.

Collender v. *Griffith*, N. Y. 1873 (* p. 51).

INJUNCTION.

A motion to dissolve a provisional injunction will not be granted unless the affidavits offered in support of the

motion overcome the equity of the bill and the evidence supporting it.

Sparkman v. *Higgins*, 1 Blatch. 205, N. Y. 1846 (* p. 6).

On motion to dissolve provisional injunction, "it is not for the court * to examine critically the correctness or even sufficiency of the application, * made, to all appearance, in good faith, and * an attempt to make known and secure the claim."

Ibid.

Provisional injunction refused where the novelty of the patented design was attacked, and it was admitted that the patentee had, before his application for the patent, sold large quantities of articles bearing the patented design marked as imported from abroad.

Booth v. *Garelly*, 1 Blatch. 247, N. Y. 1847 (* p. 11).

INVENTOR.

"To constitute an inventor (of a design), it is not necessary 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."

Sparkman v. *Higgins*, 1 Blatch. 205, N. Y. 1846 (* p. 6).

NOVELTY.

Provisional injunction refused where the novelty of the patented design was attacked, and it was admitted that the patentee had, before his application for a patent, sold large quantities of articles bearing the patented design marked as imported from a foreign country.

Booth v. *Garelly*, 1 Blatch. 247, N. Y. 1847 (* p. 11).

"The act (of March 2, 1861) must * * be held to require that the shape sought to be secured shall at least be new and original as applied to articles of manufacture."

Wooster v. *Crane et al.*, 2 Fish. P. C. 583, N. Y. 1865 (* p. 16).

Where the patented shape was "a common one in many articles of manufacture,"—"an arbitrary, chance selection of one of many well known shapes all equally well adapted to the purpose,"—the patent was held invalid for want of novelty.

Ibid.

It being shown that tables with sides beveled inward from the top have been known before, a patent is void which claims the design for a billiard table thus constructed, in order that the player may advance his foot further under it.

Collender v. *Griffith*, N. Y. 1873 (* p. 51).

It is a mere question of judgment, not invention, how far the bevel shall be carried, and a patent for the design of a billiard table is not rendered valid because a much deeper bevel is shown in it than has been used in other tables.

Ibid.

PARTICULAR PATENTS.

Letters patent, No. 36, to David Root, for "Design for Stoves," dated Sept. 9, 1845, held valid.

Root v. *Ball et al.*, 4 McLean, 177, Ohio, 1846 (* p. 1).

Letters patent, No. 139, to Don Alonzo Booth, for "Design for Figured Silk Buttons," dated July 24, 1847, sent to a trial at law.

Booth v. *Garelly et al.*, 1 Blatch. 247, N. Y. 1847 (* p. 11).

Letters patent, No. 1,834, to Emma C. Wooster, for "Design for a Reel," dated Oct. 20, 1863, held invalid for want of novelty.

Wooster v. *Crane et al.*, 2 Fish. P. C. 583, N. Y. 1865 (* p. 16).

Letters patent, No. 45,590, to J. R. & A. J. Cross, for "Apparatus for Graining Pails," dated Dec. 27, 1864, claim in, held not to be a claim for a design.

Clark v. *Bousfield*, 10 Wallace Sup. C. 133 (* p. 20).

Letters patent, No. 1,439, to John Gorham, Gorham Thurber, and Lewis Dexter, Jr., for a "Design for the Handles of Table Spoons and Forks," dated July 16, 1861, held not to be infringed by articles made under letters patent, No. 2,551, to Le Roy S. White, for a "Design for the Handle of a Fork or Spoon," dated January 15, 1867, nor by articles made under letters patent, No. 2,992, to Le Roy S. White, for "Design for a Spoon or Fork-Handle," dated March 31, 1868.

Gorham Mfg. Co. v. *White*, 7 Blatch. 513, N. Y. 1870 (* p. 30).

Decision last given reversed *in toto*.

Gorham Mfg. Co. v. *White*, U. S. Sup. Ct. 1871 (* p. 39.)

Letters patent, No. 4,973, to Hugh W. Collender, for "Design for a Billiard Table," dated June 6, 1871, held invalid for want of novelty.

Collender v. *Griffith*, N. Y. 1873 (* p. 51).

PATENTABLE REQUISITES.

"The act (of March 2, 1861), 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 (and) expense, and must * * 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."

Wooster v. *Crane et al.*, 2 Fish. P. C. 583, N. Y. 1865 (* p. 16).

Where the patented shape was "a common one in many articles of manufacture,"—"an arbitrary, chance selection of one of many well-known shapes all equally well adapted to the purpose,"—from the selection of which no advantage was derived, except the incidental use as a trade-mark, the patent held invalid.

Ibid.

PRACTICE.

In an action on a design patent, a plea that the invention was in use or on sale before the application for the patent, is demurrable, unless the plea aver an abandonment, or that such use or sale was for more than two years before the application, for—under section 7 of the act of March 3, 1839,—such use or sale must have preceded the application more than two years in order to invalidate the patent.

Root v. *Ball et al.*, 4 McLean, 177, Ohio, 1846 (* p. 1).

"A motion to dissolve a provisional injunction will not be granted unless the affidavits offered in support of the motion overcome the equity of the bill and the evidence supporting it."

Sparkman v. *Higgins*, 1 Blatch. 205, N. Y. 1846 (* p. 6).

On motion to dissolve provisional injunction, "it is not for the court * to examine critically the correctness or even sufficiency of the application, * made, to all appearance, in good faith, and * an attempt to make known and secure the claim."

Ibid.

Provisional injunction refused where the novelty of the patented design was attacked, and it was admitted that the patentee had, before his application for the patent, sold large quantities of articles bearing the patented design marked as imported from abroad.

Booth v. *Garelly et al.*, 1 Blatch. 247, N. Y. 1847 (* p. 11).

Several designs treated by the court in analyzing and comparing them, as composed, each—in general terms—of a combination of two elements, to wit,—1st, the outline of the handle; and, 2d, the ornamentation on the handle.

Gorham Mfg. Co. v. *White*, 7 Blatch. 513, N. Y. 1870 (* p. 30).

"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."

Ibid.

"To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities."

Gorham Mfg. Co. v. *White*, Sup. Ct. 1871 (* p. 39).

"The controlling consideration is the resultant effect."

Ibid.

The defendant will not be permitted on the hearing to read depositions showing prior knowledge and use of the thing patented by persons whose names are not given in his answer.

Collender v. *Griffith*, N. Y. 1873 (* p. 51.)

PRIOR USE.

In an action on a design patent, a plea that the invention was in use or on sale before the application for the patent is demurrable, unless the plea aver an abandonment, or that such use or sale was for more than two years before the application, for, under section 7 of the act of March 3, 1869, such use or sale must have preceded the application more than two years in order to invalidate the patent.

Root v. *Ball et al.*, 4 McLean, 177; Ohio, 1846 (* p. 1).

An inventor may stipulate for the sale of articles embodying his invention, before his application for patent, without affecting his right to a patent.

Sparkman v. *Higgins*, 1 Blatch. 205 N. Y. 1866 (* p. 6).

The 7th section of the act of March 3, 1839, allowing two years' public use and sale of an invention prior to application for patent—held, applicable to design patents granted under the act of August 29, 1842.

Booth v. *Garelly et al.*, 1 Blatch. 247, N. Y. 1847 (* p. 11).

Query, whether the sale of an article bearing a design is a sale of the design.

Ibid.

Provisional injunction refused where the novelty of the patented design was attacked, and it was admitted that the patentee had, before his application for the patent, sold large quantities of articles bearing the patented design, marked as imported from abroad.

Ibid.

UTILITY.

"The act (of March 2, 1861), 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 (and) expense."

Wooster v. *Crane et al.*, 2 Fish. P. C. 583, N. Y. 1865 (* p. 16).

Where the patented shape was "a common one in many articles of manufacture"—"an arbitrary, chance selection of one of many well-known shapes, all equally well adapted to the purpose"—from the selection of which no advantage was derived except the incidental use as a trade-mark, the patent held invalid.

Ibid.

"A design for a configuration of an article of manufacture is embraced within the statute as a patentable design," and "the object * * * may solely be increased utility."

Gorham Mfg. Co. v. *White*, 7 Blatch. 513, N. Y. 1870 (* p. 30).

"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."

Gorham Mfg. Co. v. *White*, Sup. Ct. 1871 (* p. 39).

PART IV.

DIGEST OF ALL THE REPORTED CASES,

BEARING UPON LETTERS PATENT FOR DESIGNS,

DECIDED IN THE U. S. PATENT OFFICE,

TO JANUARY 1, 1874.

DIGEST.

[NOTE.—The letters C. D. refer to the Commissioners' Decisions. The stars (*) refer to pages in this book.]

APPLICATION.

An applicant for a design patent must make his election *at the time of making application*, of the term, three and one-half, seven, or fourteen years, for which he desires his patent to issue, and, at the same time, pay the prescribed fee for the so elected term.

Mayo, I. C., ex parte, C. D. Feb. 23, 1870, p. 14 (* p. 75), Fisher, C.

"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." "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 copyright."

Sellers, G. H., ex parte, C. D. June 8, 1870, p. 58 (* p. 81), Fisher, C.

There is "no discretion or authority vested in the commissioner to turn this application"—an application for a mechanical patent—"into an application for a design, nor any process by which it can be accomplished, short of a new application."

Ibid.

CLAIM.

"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."

Bartholomew, W. N., ex parte, C. D. Dec. 2, 1869, p. 103 (* p. 65), Fisher, C.

"The practice of the office has not been uniform" as to granting or denying generic claims in design patents.

Ibid.

"A valid patent may be granted for a new genus or class

of ornaments, as well as for specific ornaments, though * * * 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."

Ibid.

"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."

Sheppard, I. A., ex parte, C. D. March 8, 1870, p. 22, (* p. 79), Fisher, C.

There has been no uniform practice to the contrary, by the Patent Office, in the granting of design patents.

Ibid.

"If the design contains features which are new, singly and in combination, no reason is known * * * why they may not be so claimed."

Ibid.

Mechanical construction is not claimable in a design patent.

Fenno, E. R., ex parte, C. D. Feb. 27, 1871, p. 52 (* p. 91), Duncan, A. C.

In an application for a design patent on a desk standard, applicant described in the specification certain parts which performed mechanical functions, and then claimed "The design for a desk standard substantially as herein shown and described." Held, that "this language obviously carries the function of the parts mentioned into the claim," and that "applicant should be required to erase from his description all reference to the function of" such parts.

Diffenderfer, J. D., ex parte, July 8, 1872, 2 Of. Gaz. 57 (* p. 112), Thatcher, A. C.

EQUIVALENTS.

"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."

Bartholomew, W. N., ex parte, C. D. Dec. 2, 1869, p. 103 (* p. 65), Fisher, C.

EVIDENCE.

A. had a design patent upon a billiard table. B. had a

later design patent on billiard table, showing but not claiming the design shown in A.'s design patent. A., still later, made application for a mechanical patent on billiard tables, claiming a *construction* which necessarily included the use of the design shown in both the design patents. Held, that A.'s application for mechanical patent should be put into interference with B.'s design patent, and that A.'s design patent need not be put into the interference, and that the burden of proof is on A., notwithstanding his design patent. A. may have the benefit of his prior design patent by putting it in evidence.

Collender v. *Griffith*, 3 Of. Gaz. 267, March 11, 1873 (*p. 123), Leggett, C.

EXTENSION.

The utility of an article bearing a patented design taken into account in considering the propriety of extending the patent for the design.

Solomon, B. L., C. D. Aug. 17, 1869, p. 49 (* p. 62), Hodges, A. C.

Since the passage of the act of July 8, 1870, the commissioner has no power to extend patents for designs issued since March 2, 1861.

Sperry, E. W., C. D. Oct. 28, 1870, p. 139 (* p. 88), Duncan, A. C.

The fact that the application for the extension of such a patent was filed before the passage of the act of July 8, 1870, does not preserve the right to such extension.

Ibid.

FEES.

An applicant for a design patent must make his election, at the time of making application, of the term—three and one-half, seven, or fourteen years—for which he desires his patent to issue, and, at the same time, pay the prescribed fee for the so elected term.

Mayo, I. C., ex parte, C. D. Feb. 23, 1870, p. 14 (* p. 75), Fisher, C.

IDENTITY.

"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 em-

body its subsequent characteristics, and be entirely consistent with a substantial identity of form."

Bartholomew, W. N., ex parte, C. D. Dec. 2, 1869, p. 103 (* p. 65), Fisher, C.

"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."

Ibid.

"A valid patent may be granted for a new genus or class of ornaments, as well as for specific ornaments, though, * * * 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."

Ibid.

A design for a circular clock-case, having flaring or sloping sides, composed of rounded rings or laminæ of different colored woods, so that the various stripes of color are seen from whatever direction the case is viewed, is not anticipated by a circular clock case, of common form, 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.

Tyler, W. L., C. D. April 27, 1871, p. 106 (* p. 95), Leggett, C.

Nor by an oval picture-frame of alternate rings of different colored woods, the outer rings having the greater projection, showing, when viewed in front, alternate stripes of different colors, but, if viewed from the side, only a single wood of a single color.

Ibid.

INTERFERENCE.

"An interference does not *necessarily* result in the grant of a patent to one of the parties for the subject-matter involved."

Collender v. *Griffith*, Jan. 30, 1873, 3 Of. Gaz. 91 (* p. 119), Thatcher, A. C.

Where an applicant for a patent for a *design* must necessarily use the *construction* previously patented to another, in producing the design, an interference should be had between the application and the patent.

Ibid.

An interference may properly be declared between an application by A. for a mechanical patent, and a prior design patent to B., which shows but does not claim the feature claimed in the application for the mechanical patent.

Collender v. *Griffith*, Mch. 11, 1873, 3 Of. Gaz. 267 (* p. 123), Leggett, C.

Although A. has a prior design patent, which is also prior to the design patent of B. and shows the feature claimed by A. in his application for a mechanical patent, such design patent to A. need not be put into the interference.

Ibid.

In the interference, the burden of proof is on A., notwithstanding his design patent. A. may have the benefit of his prior design patent, by putting it in evidence.

Ibid.

NOVELTY.

"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 new material. If cast hexagonal columns are old, no patent can be granted for wrought columns of an hexagonal shape."

Sellers, G. H., C. D. June 8, 1870, p. 58 (* p. 81), Fisher, C.

Applicant sought a design patent for a stove pipe damper, which was like a prior damper, except in the shape of a certain orifice. Held, that if applicant could show superior utility in his form of orifice, that would entitle him to a patent.

Fenno, E. R., C. D. Feb. 27, 1871, p. 52 (* p. 91), Duncan, A. C.

"The material used or mode of construction employed cannot in any way affect the question of novelty or patentability," in relation to design patents.

Tyler, W. L., C. D. Ap. 27, 1871, p. 106 (* p. 95), Leggett, C.

A design for a circular clock case, having flaring or sloping sides composed of rounded rings or laminæ of different colored woods, so that the various stripes of color are seen from whatever direction the case is viewed, is not anticipated by a circular clock case of common form 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.

Ibid.

Nor by an oval picture frame of alternate rings of different colored goods, the outer rings having the greater projection, showing, when viewed in front, alternate stripes of different colors, but, if viewed from the side, only a single wood of a single color.

Ibid.

"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."

Weinberg, P., C. D. Sept. 6, 1871, p. 244 (* p. 97), Leggett, C.

The word "produced," as used in the statute relating to design patents, was not intended to permit the grant of design patents "without evidence of the exercise of inventive genius, * * * nor was it intended in any way to let down the standard for grant of patents."

Ibid.

"'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."

Ibid.

"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."

Ibid.

"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."

Ibid.

"Creative genius is demanded in giving existence to a new and original design."

Parkinson, P. C., C. D. Sept. 25, 1871, p. 251 (* p. 99), Leggett, C.

"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 æsthetic effect, deserves but little favor or consideration."

Ibid.

The previous grant of a design patent covering only the *form* of an article, will not prevent the grant of a mechanical or functional patent covering the peculiar *construction* of such article.

Bartholomew, W. N., C. D. Nov. 23, 1871, p. 298 (* p. 103), Duncan, A. C.

"If the shape * * * has been altered for the purpose of improving its appearance merely, * * * then the modification is calculated to produce the novelty and utility requisite to warrant the grant of a design patent."

Oglesby, T. B., 3 Of. Gaz. 211, Feb. 24, 1873 (* p. 121), Leggett, C.

Patent denied for a design shown in prior mechanical patent granted to present applicant.

Kohler, A., 4 Of. Gaz. 53, May 17, 1873 (* p. 128), Leggett, C.

"The design patent might have been first granted and afterward the mechanical, but not *vice versa*, for the mechanical is the greater, and must include the right to use the design shown, but the design is the less and does not necessarily include the mechanism."

Ibid.

It seems that if notice of an intention to claim the design had been given in the application for the mechanical patent, a patent for the design might be granted afterward.

Ibid.

PATENTABLE SUBJECT-MATTER.

Letters patent allowed for the design of an article on the ground of the *utility* of the article.

Crane, J., ex parte, C. D. Ap. 20, 1869, p. 7 (* p. 59), Foote, C.

"The construction which has been given to that act (the act of Aug. 29, 1842), 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."

Ibid.

"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."

Ibid.

"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."

Ibid.

"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."

Ibid.

"The doctrine of the office has been for a long time, that a patent for a design, * * * could only be issued for articles possessed of artistic excellence."

Solomon, B. L., C. D. Aug. 17, 1869, p. 49 (* p. 62), Hodges, A. C.

"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, sec. 11), 'whether made for ornament merely, or intended to promote convenience or utility.'"

Ibid.

"A valid patent may be granted for a new genus or class of ornaments as well as for specific ornaments, though * * * 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."

Bartholomew, W. N., ex parte, C. D. Dec. 2, 1869, p. 103 (* p. 65), Fisher, C.

"It has been the practice of the office to grant design patents for *useful* forms, as well as for those of *artistic excellence*."
Ibid.

"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."
Ibid.

"Modes of operation or construction, principles of action, combinations to secure novelty or utility of movement, or compositions of matter can hardly be said to be 'shapes, configurations, or designs.'"
Ibid.

"Where the sole utility of the new device arises from its new shape or configuration * * * it may fairly be included among the subjects which the act of 1842 was designed to protect."
Ibid.

"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."
Ibid.

"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." "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 copyright."
Sellers, G. H., C. D. June 8, 1870, p. 58 (*p. 81), Fisher, C.

"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 an hexagonal shape."
Ibid.

The provision of section 77 of the act of July 8, 1870, "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."

King, W., C. D. Sept. 19, 1870, p. 109 (* p. 85), Fisher, C.

Mechanical construction is not claimable in a design patent.

Fenno, E. R., C. D. Feb. 27, 1871, p. 52 (* p. 91), Duncan, A. C.

In the statute relating to design patents there is "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."

Ibid.

"The language"—of the statute—"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."

Ibid.

"The present law"—the act of July 8, 1870—"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."

Ibid.

Applicant sought a design patent for a stove-pipe damper which was like a prior damper except in the shape of a certain orifice. Held, that if applicant could show superior utility in his form of orifice, that would entitle him to a patent.

Ibid.

"The material used or mode of construction employed, cannot, in any way, affect the question of novelty or patentability," in relation to design patents.

Tyler, W. L., C. D. April 27, 1871, p. 106 (* p. 95), Leggett, C.

"The law never was intended to give a man a design patent to serve merely the purpose of a trade mark."

Weinberg, P., C. D. Sept. 6, 1871, p. 244 (* p. 97), Leggett, C.

"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."

Ibid.

The word "produced," as used in the statute referring to design patents, was not intended to permit the grant of design patents "without evidence of the exercise of inventive genius, * * * nor was it intended in any way to let down the standard for grant of patents."

Ibid.

"'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."

Ibid.

"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."

Ibid.

"The law authorizing design patents was intended to provide for an entirely different class of inventions" from those covered by machine or functional patents—"inventions in the field of æsthetics, taste, beauty, ornament."

Parkinson, P. C., C. D., Sept. 25, '71, p. 251 (* p. 99), Leggett, C.

"The term 'useful,' in relation to designs, means adaptation to producing pleasant emotions."

Ibid.

"By 'article of manufacture,' as used in this section" of the design patent law, "the Legislature evidently meant only ornamental articles, articles used simply for decoration."

Ibid.

"Creative genius is demanded in giving existence to a new and original design."

Ibid.

"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 æsthetic effect, deserves but little favor or consideration."

Ibid.

The case of Bartholomew, C. D. Dec. 1869, p. 103, commented on and dissented from.

Ibid.

"There can be little doubt that, in the enumeration of subjects for design patents as contained in the * * * statute, * * * 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."

Whyte, W., C. D. Nov. 28, 1871, p. 304 (* p. 107), Duncan, A. C.

"They were not intended to subserve a merely 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."

Ibid.

"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 trademark."

Ibid.

Query. Ought not a design patent to specify the particular article which is to embody or bear it? And does it protect as to any other article?

Ibid.

The peculiar shape of one part of an article being designed to serve a useful purpose, and not for ornamentation, it is proper subject-matter for a claim in a machine patent.

Doolittle, T. B., 2 Of. Gaz. 275, July 31, 1872 (* p. 114), Thatcher, A. C.

A mechanical and a design patent cannot both be granted for the same subject-matter.

Collender, H. W., 2 Of. Gaz. 360, Oct. 2, 1872 (* p. 116), Thatcher, A. C.

But a single device may present subject-matter for both kinds of patents, one covering the plan of construction and the other the design—the shape, form, or configuration—of the article.

Ibid.

"If the shape * * * has been altered for the purpose of improving its appearance merely, * * * then the modification is calculated to produce the novelty and utility requisite to warrant the grant of a design patent."

Oglesby, T. B., 3 Of. Gaz. 211, Feb. 24, 1873 (* p. 121), Leggett, C.

"If the shape * * * 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."

Ibid.

A name-sign with an imitation gold pen attached to it, held to be a proper subject for a design patent.

Fairchild, L. W., 3 Of. Gaz. 323, March 12, 1873 (* p. 126), Thatcher, A. C.

A distinction made between such subject and the tool for which a patent was asked in Parkinson, *ex parte*, C. D. 1871, p. 281.

Ibid.

PRACTICE.

"The construction which has been given to that act (the act of Aug. 29, 1842) 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."

Crane, J., C. D. Ap. 20, 1869, p. 7 (* p. 59), Foote, C.

"The doctrine of the office has been for a long time, that a patent for a design * * * could only be issued for articles possessed of artistic excellence."

Solomon, B. L., C. D. Aug. 17, 1869, p. 49 (* p. 62), Hodges, A. C.

"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, sec. 11), whether made for ornament merely or intended to promote convenience or utility."

Ibid.

"The practice of the office has not been uniform" as to granting or denying generic claims in design patents.

Bartholomew, W. N., C. D. Dec. 2, 1869, p. 103 (* p. 65), Fisher, C.

It has been the practice of the office to grant design patents for *useful* forms as well as for those of *artistic excellence.*

Ibid.

A patent other than a design patent can not be reissued and changed, either as a whole, or by a division into a patent for a design.

Stuart & Bridge, C. D. Feb. 23, 1870, p. 15 (* p. 77), Fisher, C.

"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."

Sheppard, I. A., C. D. March 8, 1870, p. 22 (* p. 79) Fisher, C.

There has been no uniform practice to the contrary by the Patent Office in the granting of design patents.

Ibid.

"If the design contains features which are new, singly, and in combination, no reason is known * * * why they may not be so claimed."

Ibid.

"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." "It is a matter of law in which a mistake is fatal."

Sellers, G. H., C. D. June 8, 1870, p. 58 (* p. 81), Fisher, C.

There is "no discretion or authority vested in the commissioner to turn this application"—for a mechanical patent—"into an application for a design, nor any process by which it can be accomplished, short of a new application."

Ibid.

"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 trademark."

Whyte, W., C. D. Nov. 28, 1871, p. 304 (* p. 107), Duncan, A. C.

Query. Ought not a design patent to specify the particular article which is to embody or bear it?

Ibid.

"Every applicant for a design patent has an undoubted right to show both the obverse and the reverse of the ornamental work which he has devised."

Diffenderfer, J. D., 2 Of. Gaz. 57, July 8, 1872 (* p. 112), Thatcher, A. C.

"But the two faces should correspond; if one be shown entire the other should be also."

Ibid.

In an application for a design patent on a desk standard, applicant described, in the specification, certain parts which performed mechanical functions, and then claimed "The design for a desk standard substantially as herein shown and described." Held, that "this language obviously carries the function of the parts mentioned into the claim," and that "applicant should be required to erase from his description all reference to the function of" such parts.

Ibid.

"An interference does not *necessarily* result in the grant of a patent to one of the parties for the subject-matter involved."

Collender v. *Griffith*, 3 Of. Gaz. 91, January 30, 1873 (* p. 119), Thatcher, A. C.

Where an applicant for a patent for a *design* must necessarily use the *construction* previously patented to another in producing the design, an interference should be had between the application and the patent.

Ibid.

An interference may properly be declared between an application by A. for a mechanical patent and a prior design patent to B., which shows but does not claim the feature claimed in the application for the mechanical patent.

Collender v. *Griffith*, 3 Of. Gaz. 267, March 11, 1873 (* p. 123), Leggett, C.

Although A. has a prior design patent which is also prior to the design patent of B., and shows the feature claimed by A. in his application for a mechanical patent, such design patent to A. need not be put into the interference.

Ibid.

In the interference, the burden of proof is on A., notwithstanding his design patent. A. may have the benefit of his prior design patent by putting it in evidence.

Ibid.

"All description of the mechanical construction of the article should be eliminated" — from the specification — "as well as all reference to its purpose as a matter of utility."

Fairchild, L. W., 3 Of. Gaz. 323, March 12, 1873 (* p. 126), Thatcher, A. C.

Patent denied for a design shown in a prior mechanical patent to present applicant. "The design patent might have been first granted and afterward the mechanical, but not *vice versa*."

Kohler, A., 4 Of. Gaz. 53, May 17, 1873 (* p. 128), Leggett, C.

It seems that if notice of an intention to claim the design had been given in the application for the mechanical patent, a patent for the design might be granted afterward.

Ibid.

An inkstand and a removable stopper, both square in their general shape, but with all the angles similarly chamfered, do not, together, constitute a single design.

Brower, B., 4 Of. Gaz. 450, Oct. 28, 1873 (* p. 131).

The ordinary use of an article, for which a design is presented, is a controlling consideration in determining what separable parts may be included in one design.

Ibid.

"There is not, * 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."

Ibid.

The relative positions of the inkstand and stopper when together are not always the same, and a "design cannot embrace in its scope alternates or equivalents of form."

Ibid.

The stand and the stopper each present subject-matter for patent.

Ibid.

"The two, permanently united, or so constructed as always to occupy the same relative positions to each other, might also, * * present subject-matter for patent, were such a union consistent with their ordinary use."

Ibid.

PRIOR USE.

"No provision is made for use or sale of the invention" —in the matter of design patents—"prior to the application, as in the case of other inventions."

Stuart & Bridge, C. D. February 23, 1870, p. 15 (*p. 77), Fisher, C.

"The design must not have been known or used by others prior to the application of the inventor."

Ibid.

"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." 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."

Ibid.

The previous grant of a design patent covering only the *form* of an article, will not prevent the grant of a mechanical or functional patent covering the peculiar *construction* of such article.

Bartholomew, W. N., C. D. November 23, 1871, p. 298 (* p. 103), Duncan, A. C.

Patent denied for a design shown in a prior mechanical patent granted to present applicant.

Kohler, A., 4 Of. Gaz. 53, May 17, 1873 (p. 128), Leggett, C.

"The design patent might have been first granted and afterward 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."

Ibid.

It seems that if notice of an intention to claim the design had been given in the application for the mechanical patent, a patent for the design might be granted afterward.

Ibid.

REISSUE.

A patent other than a design patent cannot be reissued and changed, either as a whole, or by a division, into a patent for a design.

Stuart & Bridge, C. D. February 23, 1870, p. 15 (* p. 77), Fisher, C.

TERM.

An applicant for a design patent must make his election, *at the time of making application*, of the term- three and one-half, seven, or fourteen years—for which he desires his patent to issue, and, at the same time pay the prescribed fee for the so elected term.

Mayo, I. C., C. D. Feb. 23, 1870, p. 14 (* p. 75), Fisher, C.

UTILITY.

Letters patent allowed for the design of an article on the ground of the *utility* of the article.

Crane, J., C. D. April 20, 1869, p. 7 (*p. 59), Foote, C.

"The construction which has been given to that act (the act of Aug. 29, 1842) 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."

Ibid.

"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."

Ibid.

"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."

Ibid.

"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."

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Ibid.

The *utility* of an article bearing a patented design taken into account in considering the propriety of extending the patent for the design.

Ibid.

It has been the practice of the office to grant design patents for *useful* forms, as well as for those of *artistic excellence.*

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"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."

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improving its appearance merely, * * * then the modification is calculated to produce the novelty and utility requisite to warrant the grant of a design patent."

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If the shape * * * 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."

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A distinction made between such subject and the tool for which a patent was asked in Parkinson, *ex parte*, C. D. 1871, p. 251.

Ibid.

"All description of the mechanical construction of the article should be eliminated"—from the specification—"as well as all reference to its purpose as a matter of utility."

Ibid.

PART V.

COMMENTS ON THE LAW

RELATING TO

LETTERS PATENT FOR DESIGNS.

COMMENTS ON THE LAW.

CHAPTER I.

HISTORY AND ANALYSIS OF THE STATUTES RELATING TO LETTERS PATENT FOR DESIGNS.

THE first statute authorizing the grant of letters patent for designs, was the act approved August 29th, 1842, 5th volume of the Statutes at Large, chapter 263, page 543, section 3, reading as follows:

"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 "or" inclosed in brackets is plainly superfluous.

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 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."

The foregoing statute was superseded by the act approved March 2d, 1861, volume 12 of the Statutes at Large, chapter 37, page 130, section 11, reading 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 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, [or] a manufacture, whether of metal or other material or materials, [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, 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 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 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: *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." *

The act of March 2d, 1861, was superseded by the act approved July 8th, 1870, volume 16 of the Statutes at Large, chapter 230, page 198, sections 11, &c., the law now in force, reading as follows:

"SECTION 11. *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 fabric; 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 invention or discoveries, obtain a patent therefor.

"SECTION 72. *And be it further enacted*, That the commissioner may dispense with models of designs when the design 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 de-

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* The first "or" inclosed in brackets should probably read "for." The "and" inclosed in brackets should probably read "any." The last "or" in brackets is clearly superfluous.

signs 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.

"SECTION 111. *And be it further enacted*, That the acts and parts of acts set forth in the schedule of acts cited, hereto annexed, are hereby repealed without reviving any acts or parts of acts repealed by any of said acts, or by any clause or provisions thereof: *Provided however*, That the repeal hereby enacted shall not affect, impair, or take away any right existing under any of said laws; but all actions and causes of action, both in law and 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, excepting the remedial provisions of this act shall be applicable to all suits and proceedings hereafter commenced: *And provided also*, 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: *And provided further*, That all offenses which are defined and punishable under any of said acts, and all penalties and forfeitures created thereby, and incurred before this act takes effect, may be prosecuted, sued for, and recovered, and such offenses punished according to the provisions of said acts, which are continued in force for that purpose."

Schedule of statutes cited and repealed, as printed in the Statutes at Large, including such portions only of the appropriation bills referred to as are applicable to the Patent Office.

* * * * * * * * * *

August 29, 1842, chapter 203, volume 5, page 543.

* * * * * * * * * *

March 2, 1861, chapter 88, volume 12, page 246.

Analysis of the Act of August 29, 1842.

WHO MAY TAKE.—Citizens and aliens resident one year in the United States, and having taken the oath of intention to become citizens.

REQUISITE QUALITIES.—The design must be the result of applicant's own industry, genius, efforts and expense.

SUBJECT-MATTER.—Any new and original design for a manufacture of metal or other material.

Any new and original design for the printing of woolen, silk, cotton, or other fabrics.

Any new and original design for a bust, statue, bas-relief, or composition in alto or basso relievo.

Any new and original impression } to be placed on any article of
" " ornament } manufacture, the same being formed in marble or other material.

Any new and useful pattern }
" " print } to be either worked into or worked on, or printed or painted,
" " picture } or cast, or otherwise fixed on, any article of manufacture.

Any new and original shape of any article of manufacture.

Any new and original configuration of any article of manufacture.

AS TO NOVELTY.—The design must not have been known or used by others before applicant's invention or production thereof, and prior to his application.

FEE.—One-half the sum required of the particular applicant for a functional patent.

TERM.—Seven years. No provision for extension.

Analysis of the Act of March 2, 1861.

WHO MAY TAKE.—Citizens and aliens resident one year in the United States, and having taken the oath of intention to become citizens.

REQUISITE QUALITIES.—The design must be the result of applicant's own industry, genius, efforts and expense.

SUBJECT-MATTER.—Any new and original design for a manufacture of metal or other material.

An original design for a bust, statue, bas-relief, or composition in alto or basso relievo.

Any new and original impression, " " ornament } to be placed on any article of manufacture formed in marble or other material.

Any new and useful pattern, " " print, " " picture } to be either worked into or worked on, or printed or painted, or cast, or otherwise fixed on, any article of manufacture.

Any new and original shape of any article of manufacture.

Any new and original configuration of any article of manufacture.

AS TO NOVELTY.—The design must not have been known or used by others before applicant's invention or production thereof, and prior to his application.

FEE.—	$10 00	$15 00	$30 00
TERM.—	3½ years.	7 years.	14 years.

EXTENSION.—Design patents granted under this act to be extensible for seven years upon the same terms as other patents.

Analysis of the Act of July 8, 1870.

WHO MAY TAKE.—Any person.

REQUISITE QUALITIES.—The design must be the result of applicant's own industry, genius, efforts and expense.

SUBJECT-MATTER.—Any new and original design for a manufacture.

Any new and original design for a 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
" " picture
} to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture.

Any new, useful and original shape
" " " configuration
} of any article of manufacture.

AS TO NOVELTY.—The design must not have been known or used by others before applicant's invention or production thereof, or patented or described in any printed publication.

FEE.— $10 00 $15 00 $30 00

TERM.—3½ years. 7 years. 14 years.

EXTENSION.—No provision for, of future patents. Design patents granted prior to March 2, 1861, made extensible upon the same terms as other patents.

The act of March 2, 1861, differs from the act of August 29, 1842, in not specifying as patentable subject-matter, "any new and original design for the printing of woolen, silk, cotton or other fabrics," but as the same subject-matter is plainly included under the head of "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," this difference is more apparent than real. The act of 1861, further differs from the act of 1842, as to the government fee, and the duration of the patent. Under the act of 1842, the duration of the patent was made absolute at seven years, while the fee was fixed at one-half the fee required for other

patents, so that a change in the fee for other patents would entail a similar change in the fee for design patents. The act of 1861 established a sliding scale, both as to duration and fees; design patents were made grantable, at the election of the applicant, for the term of three years and six months, upon a fee of ten dollars, for seven years upon a fee of fifteen dollars, or for fourteen years upon a fee of thirty dollars.

A still further difference was made between the acts of 1842 and 1861, as to extensibility; in the act of 1842 no provision was made for extension, while in the act of 1861 future design patents were made extensible upon the same terms, and under the same restrictions as other patents.

The act of July 8, 1870, differs from the act of 1861, and also from the act of 1842, in allowing "any person" to take a design patent, while the two former acts only permitted them to be taken by "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."

The act of 1870 specifies as patentable subject-matter, though in more concise phraseology, everything specified in the act of 1842, restoring the matter relating to "the printing of woolen, silk, cotton or other fabrics," which had been omitted in the act of 1861.

The qualifications constituting patentable novelty, differ in the act of 1870, from both the preceeding acts; in the former two it was required that the design must have been "not known or used by others before his (applicant's), her, or their invention or production thereof, and prior to the time of his, her, or their

application for a patent therefor," while the requirement in the act of 1870, is that the design must be not "known or used by others before his (applicant's) invention or production thereof, or patented or described in any printed publication," the requirement in this regard being assimilated, in the statute of 1870, to the requirements as to other kinds of patents.

As to fees and duration, the act of 1870 is identical with the act of 1861, and differs the same as that statute from the act of 1842.

The act of 1870 differs from the act of 1861, and—as to future patents—agrees with the Act of 1842, as to extensibility; patents under the act of 1861 were extensible, design patents granted under the act of 1870 are not. This latest act, however, expressly makes design patents granted under the act of 1842 extensible, while they were not so before. An adjudication of the Patent Office holds, that the act of 1870 takes away the extensibility of patents granted under the act of 1861; an attempt will be made, further on, to show that this position is unsound.

CHAPTER II.

PATENTABLE SUBJECT-MATTER.

It is but a mild statement of a notorious fact to say that, until within a recent period, the Patent Office has not recognized design patents as occupying a field peculiarly and distinctively their own, with well defined limits. Design patents have been issued for articles on the ground of the utility of their shapes as well as for artistic forms, figures and shapes, and in some cases for purely mechanical arrangements. It has been a common device when a mechanical or functional patent could not be procured upon an article, to take a design patent upon it for the purpose of enabling the inventor or owner to mark it as "patented," and this without regard to whether the article embodied proper subject-matter for a design patent or not.

Why this should have been permitted when the purpose and spirit of the law is very plain from its text, and when the law existing before the passage of the first design patent act afforded ample protection to all inventions to which the design patent act is not peculiarly applicable, is not readily explainable, except on the hypothesis of the existence of an amiable desire on the part of the commissioners to allow some kind of a patent to every applicant. One excellent method to be followed in ascertaining the true construction of a statute law is to consider the law

or laws relating to the same or kindred subjects which existed before the passage of the act sought to be construed, and to find from such consideration what was the want left unsatisfied by the old law, the nature of this want affording a key to the mind of the legislator who originated the statute under discussion.

Following this method of inquiry and construction with reference to the design patent act of August 29th, 1842, it will be found that there existed at the time of the passage of this act copyright laws affording protection to books, maps, charts, cuts, engravings, prints, and musical compositions; and that there were also patent laws affording protection to new and useful arts, machines, manufactures, and compositions of matter, and improvements thereon, including, in general terms, processes, machines, compounds, and articles of manufacture designed to serve some useful purpose.

Outside of these two classes of intellectual productions, there was a third class to which no protection had been given, comprising such things as statues and other productions of the sculptor's art valuable for æsthetic purposes only; beautiful forms and appearances given to articles useful in themselves, as vases, clocks, and silver plate; patterns, figures, or pictures to be woven into, or printed or impressed upon textile fabrics, as carpets, shawls and dress goods; patterns for printing upon wall paper; and generally all those things intended to give an ornamental or pleasing appearance to articles, the chief purpose of which is a useful one.

Statues and other productions of the sculptor's art, intended solely to gratify a taste for the ideal and the beautiful, cannot, perhaps, be classed logically in every

respect with the other things named, whose chief purpose is a useful one—in the common and homely acceptation of that word—but they can be logically classed together in that it requires the same faculty, power or talent to produce the one as the other. It requires the exercise of the same power or faculty, in kind, to produce a beautiful vase as to model a beautiful statue.

We find, then, in the objects named in the law, a large, congruous, and important class of intellectual productions to which no protection was given by the then existing laws; and it may therefrom be inferred that it was exclusively this class of cases not covered by the former laws that the design patent act was intended to protect.

It will be observed that, with the exception of busts, statues, bas-reliefs and compositions in alto or basso relievo, all the things named in the law as constituting patentable subject-matter are things designed to give an ornamental or pleasing appearance to articles useful in themselves, and irrespective of their artistic excellence, and it is not unreasonable to assume that it was this application of æsthetic ideas or principles to the adornment of useful articles, moving in the minds of the legislators who drafted the laws of 1842 and 1861, that induced them to insert the word "useful" into the text when they named as patentable subject-matter "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;" and in the mind of the legislator who drafted the law of 1870, when he named as patentable subject-matter "any

new, useful, and original shape or configuration of any article of manufacture." All inventions or discoveries having utility as their basis, were fully protected by laws other than those relating to designs, and it is not reasonable to suppose that the originators of the design patent acts intended to offer another method of protection to things already protected. It would then seem tolerably plain that the legislators who originated the design patent acts had in mind, in making use of the word "useful," designs for ornament applied to articles capable of serving a useful purpose, and in this sense an ornamental pattern, print, picture, shape, or configuration may be properly termed "useful" in the common acceptation of that word.

Commissioner Leggett, in the case of Parkinson, C. D., 1871, 251, says that "the term 'useful,' in relation to designs, means adaptation to producing pleasant emotions." While this explanation is highly ingenious, and may be the right one, it certainly gives to the word a meaning which is not common; to many it will appear more reasonable that the draftsman of the law meant an ornamental pattern, print, picture, shape, or configuration applied to a useful article.

The question as to whether ornamentation forms the sole and exclusive basis of patentable design, has been the subject of conflicting decisions, both in the courts and the Patent Office, and a resume of these decisions may not be uninstructive.

In the case of Wooster v. Crane *et al.*, 2 Fish. P. C., 585, N. Y. 1865, the judge spoke of the patented shape as "a common one, in many articles of manufacture,"—"an arbitrary, chance selection of one of many well known shapes all equally well adapted

to the purpose,"—from the selection of which no advantage was derived, except the incidental use as a trade mark, thereby saying, inferentially, that if some other advantage had been derived from the selection of the patented shape, it might have had some bearing on the validity of the patent, and intimating that the utility of the patented shape could be taken into consideration.

In the matter of the application of Jason Crane, for a design patent upon a fur set box, C. D., April 20, 1869, p. 7, Commissioner Foote decided squarely that utility may form the basis for the grant of a design patent. He says "The construction which has been given to that act (the act of Aug. 29, 1842) 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." He proceeds, "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." "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." "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."

Acting Commissioner Hodges, in the case of B. L. Solomon, C. D., Aug. 17, 1869, p. 49, quotes the

words of the case last cited, and follows it as an authority; the utility of an article bearing a patented design was taken into account in considering the propriety of extending the patent for the design.

Commissioner Fisher, in the case of W. N. Bartholomew, C. D., Dec. 2, 1869, p. 103, states that it has been the practice of the office to grant design patents for *useful* forms, as well as for those of *artistic excellence*, 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," and that "where the sole utility of the new device arises from its new shape or configuration, * * it may fairly be included among the subjects which the act of 1842 was designed to protect."

In the case of the Gorham Mfg. Co. v. White, 7 Blatch. 513, N. Y. 1870, the learned judge says, "a design for a configuration of an article of manufacture is embraced within the statute as a patentable design," and "the object * * * may solely be increased utility."

In the case of E. R. Fenno, C. D., February 27, 1871, p. 52, Acting Commissioner Duncan says that in the statute relating to design patents there is "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, and that 'the language'—of the statute—'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.'"

At this time, the judges of the Circuit Courts, and

two commissioners of patents, had held that utility might form the basis of a design patent, and the doctrine seemed pretty well settled by construction, but at this juncture the case of the Gorham Mfg. Co. v. White came before the U. S. Supreme Court on appeal, and 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," thus completely reversing the decision of the court below, and finally determining that the utility of a thing has no bearing upon its patentability under the design patent act.

In the case of P. C. Parkinson, C. D., September 25, 1871, p. 251, Commissioner of Patents Leggett fully coincides with the decision of the Supreme Court. He says, "the law authorizing design patents was intended to provide for an entirely different class of inventions"—from those properly covered by machine or functional patents—"inventions in the field of æsthetics, taste, beauty, ornament;" and that "by 'article of manufacture,' as used in this section"—of the design patent law—"the legislature evidently meant only ornamental articles, articles used simply for decoration."

This construction of the law was followed by Acting Commissioner Duncan, in the case of W. Whyte, C. D., November 28, 1871, p. 304; by Acting Commissioner Thatcher, in the case of T. B. Doolittle, 2 Of. Gaz. 275, July 31, 1872; by Commissioner Leggett, in the case of T. B. Oglesby, 3 Of. Gaz. 211, February 24, 1873; and by Acting Commissioner Thatcher, in the case of L. W. Fairchild, 3 Of. Gaz. 323, March 12,

1873, comprising all the cases to date, so that it may now be taken as settled and determined that only those things which are intended to give an ornamental or pleasing appearance to the objects specified in the design patent act, are patentable as designs; and that the utility of a thing has no bearing on the patentability of any design it bears or embodies.

MATERIALS AND MODE OF CONSTRUCTION.—In the case of W. N. Bartholomew, C. D., December 2, 1869, p. 103, Commissioner Fisher decides that "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;" and in the case of G. H. Sellers, C. D., June 8, 1870, p. 58, he decides that "a new shape or configuration is independent of materials or modes of manufacture. If the shape be old as applied to the thing, it can not avail that the thing is produced by a new process or wrought in a different material."

Commissioner Leggett decides the same in the case of W. L. Tyler, C. D., April 27, 1871, p. 106. The U. S. Supreme Court, in the case of the Gorham Mfg. Co. v. White, says, "it is the appearance itself, * no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense," and this is, beyond question, the true doctrine.

TRADE MARKS.—In the case of Wm. King, C. D., September 19, 1870, p. 109, Commissioner Fisher decides

that the provisions of section 77 of the act of July 8, 1870, "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."

Commissioner Leggett, in the case of P. Weinberg, C. D., September 6, 1871, p. 244, decides that "the law never was intended to give a man a design patent to serve merely the purpose of a trade mark," and in the case of W. Whyte, C. D., November 28, 1871, p. 304, that designs "were not intended to subserve a merely 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."

The construction of the law presented in these decisions is in entire accord with the decision of the Supreme Court in the case of the Gorham Mfg. Co. v. White, which says that the design patent acts "were plainly intended to give encouragement to the decorative arts," that "they contemplate not so much utility as appearance, and that not as an abstract impression or picture, but an aspect given to those objects mentioned in the acts," thus saying that the design must be a permanent part of the article bearing it, and not intended to serve a *useful* purpose, as is the purpose of a trade mark, but solely to give the article an ornamental and pleasing appearance.

CHAPTER III.

QUALITIES OF PATENTABLE DESIGNS.

THE act of July 8, 1870, reads "That any person who, by his own industry, genius, efforts, and expense, has invented or produced any new and original design," &c., "may obtain a patent therefor;" and the requirements in this regard are the same in the acts of 1842 and 1861, thus requiring that any design, in order to be patentable, must be the result of industry, genius, efforts, and expense. With regard to the meaning of "industry," "efforts," and "expense" in this connection, no question is likely to arise; but with regard to the meaning, here, of the word "genius" a question has arisen already, or is, at least, suggested by the reported cases. In the former practice of the Patent Office, little or no regard was paid to the meaning and requirements of the word in this connection.

It seems to have been taken for granted that the use of the word "produce" in the text indicated that a very low or inferior kind of originality is all that is required to support a design patent. Although the language of the learned judge in the case of Wooster v. Crane, 2 Fish. P. C., 583, is not decisive upon this point, he not being called upon by the circumstances of the case to make it so, it yet seems to recognize a low degree of originality as sufficient to support a design patent. He said: "The act (of March 2, 1861), 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 (and) expense, and must * * * 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," thereby intimating that if the shape had been new simply as applied to a manufacture, though old otherwise, that would have been sufficient to support the patent. This was long the adopted and recognized doctrine and practice of the Patent Office, but in the case of P. Weinberg, C. D., Sept. 6, 1871, p. 244, Commissioner Leggett took advanced ground in the exactly opposite direction. He said, "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." That the word "produced" as used in the statute relating to design patents was not intended to permit the grant of design patents "without evidence of the exercise of inventive genius, * * * nor was it intended in any way to let down the standard for grant of patents." "'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." In the case of P. C. Parkinson, C. D., Sept. 25, 1871, p. 251, he says, "creative genius is demanded in giving existence to a new and original design."

It seems to the present writer that the reason for introducing the words "produced" and "genius" into

the wording of the act can be made clear by a very simple experiment. Omit the words "or produced," and the act reads "That any person who, by his own industry, genius, efforts, and expense, has invented * * any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief," &c. It is at once apparent that it is not customary or correct to speak of a bust, statue, alto or bas-relief, or of some of the other things specified, as inventions or as things "invented." So that the use of "produced" or its synonym becomes necessary in this connection. Now, leaving in the words "or produced," omit the word "genius," and it will be percieved that the wording would cover and protect a low order of originality, much lower than is required by the law relating to functional patents, and as the draftsman of the design patent act wrote with the functional patent act before him as a guide, so far as it might be, there is no reason to suppose that he intended to alter, in the least, the standard of originality required; but it is reasonable to assume that he introduced the word "produced" in order to correctly designate the originating of busts, statues, &c., and that he introduced the word "genius" to indicate that the same degree of originality would be required to support a design patent as to support a functional patent, it being plain that the exercise of genius is required to support the latter.

The former practice of the Patent Office was, that a much lower order of originality would support a design than a functional patent, and the decision in Wooster v. Crane seems to hold to the same view, while the quoted decisions of Commissioner Leggett take the ground that design patents require a higher

order of originality than functional patents. If the explanation herein put forth is every way reasonable, neither of these views is correct, but the same degree of originality is required in both design and functional patents.

DOUBLE USE.—It was the former practice of the Patent Office, and a practice seemingly sustained by the case of Wooster v. Crane, to grant design patents for old shapes which were only new as applied to articles of manufacture, as if, for instance, a person had taken a statue of a shepherd boy, and applied it to the purposes of a drop light, having the gas issue from a pipe held in the hand of the boy. This would be known under the functional patent act as simply a double use, the mere application of an old device to a new purpose, and clearly unpatentable because it involves the exercise of no genius, but is simply ordinary mechanical adaptation. If such a new application of an existing thing does not involve genius enough to support a functional patent, neither does it involve genius enough to support a design patent. No good reason can be seen, why the doctrine of double use is not as applicable to design as to functional patents. A patentable design must, in itself, be new, not merely a new application of an old shape; mere taste and judgment in the selection of existing forms can hardly be held to be an exercise of genius.

THE TEST OF GENIUS.—As no tribunal has pointed out what is to be taken as evidence of the exercise of genius in the production of a design, it will profit but little to speculate upon a matter which is so evidently difficult of reduction to exact rules, but there are some principles relating to functional patents

which may possibly be analogous here. Utility is the chief end of a functional invention, but the cases are very clear that any degree of utility, however slight, will—other questions aside—support a functional patent. The Supreme Court decides in the case of the Gorham Mfg. Co. v. White, that "pleasing appearance" is the chief end of patentable designs, so that utility in functional patents seems to stand in the same place as appearance in design patents. It would seem, therefore, that if a design is—1st. Substantially unlike any previous design; 2d. Not absolutely frivolous in its character; and 3d. Gives pleasing appearance in any degree, that sufficient evidence of the exercise of genius is shown to support a patent for it.

CHAPTER IV.

THE CLAIM.

THE common formula for a claim in a design patent is "I claim as my invention: The design for * * * substantially as shown and described," the claim being to the thing as a whole without any specific reference to the features composing the design, and the design patents are very few in number which contain as a claim more than the above formula. It is believed that this practice has arisen from the belief that this is the only proper claim to be made in a design patent.

In the application of Isaac A. Sheppard for letters patent for a design for a stove ornament, Com. Dec. 1870, p. 22, the question was raised whether features of a design can be claimed singly and as combined into a whole, in the same patent. Commissioner Fisher said: "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 claims in the same patent." "There has been no uniform practice to the contrary by the Patent Office." "If the design contains features which are new, singly and in combination, no reason is known * * why they may not be so claimed."

It so happens that this very question was decided in the very first design patent cause that came before a court. In the case of Root v. Ball, 4 McLean, 177

(1846), the learned judge held that "the same (design) patent may include a patent for a combination, and an invention of some of the parts of which the combination consists."

As it is common, and always has been, to grant two or more clauses of claim, in functional patents, upon precisely the same kind of wording in the law, it is not readily seen how such a question could ever have been raised. Where a design contains features which are separate and distinct from the other features, there seems to be no good reason why a claim may not be made to each of such features. Suppose a design for the ornamentation of the surface of a circular plate to consist of three features, radial rays at the centre, a wreath of flowers outside of this, and ornamental serrations at the periphery. It would seem absurd to compel the producer to take a patent for the design as a whole, thus permitting any one so disposed to use any two of these three features with impunity.

In the case of the Gorham Mfg. Co. v. White, the decision of the Supreme Court contains some paragraphs which seem, at the first glance, to militate against the allowance of more than one clause of claim. The learned judges say: "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 which causes it."

Upon examining the decision of the court below it will be seen that this language has no relation whatever to the question of whether a design patent may have one or more claims, but is used solely for the purpose of negativing the idea advanced by the judge below to the effect that a patent for a design is in effect a patent for the agencies used to cause an appearance and not for the appearance itself.

It will thus be seen that the courts and the Patent Office are both committed to the doctrine of allowing claims to specific features of a design, both singly and in combination.

Broad Claims.—In the case of W. N. Bartholomew, Com. Dec. 1869, p. 10, Commissioner Fisher said: "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." "A valid patent may be granted for a new genus or class of ornaments as well as for specific ornaments." In the case of the Gorham Mfg. Co. v. White, the Supreme Court defined two designs to be identical, when an ordinary observer, giving ordinary observation, would be likely to mistake one for the other. This definition gives a generic effect to some claims, whether generic in terms or not; for instance, if a patent were taken for a button with five radial rays, this would clearly cover a design having a greater or less number of rays, unless the disparity was made extraordinary in some way, for an ordinary observer giving ordinary attention to a button would not be apt to notice whether the number of rays was more or less. It is clear, from this decision of the

Supreme Court, that a claim cannot be legally so generic in its terms as to cover a design which an ordinary observer, giving ordinary attention, would not be likely to mistake for the design shown in the patent. As the law gives a claim, by construction, to all the generic effect it can have, it would seem not advisable to attempt the general introduction of generic claims into design patents.

CHAPTER V.

IDENTITY AND INFRINGEMENT.

In the first reported patent cause, the case of Root v. Ball, 4 McLean, 177 (1846), the learned judge had occasion to decide what constitutes patentable identity of designs, and what constitutes infringement of a patented design. He said that it is not necessary, in order to constitute infringement, "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." "It is an infringement to adopt the design so as to produce substantially the same appearance."

At the trial of the case of the Gorham Mfg. Co. v. White, in the Circuit Court, the learned judge took entirely different ground. He treated the several designs, for handles of spoons and forks, in analyzing and comparing them, as composed, each—in general terms—of a combination of two elements, to wit: 1st. The outline of the handle, and 2d. the ornamentation on the handle. He finding the outlines of two of the handles to be substantially the same, but the ornamentation different, in minor particulars, held the two designs not to be substantially identical. He held that the eye of an ordinary or casual observer is not a proper test as to the substantial identity of designs

upon different articles, that "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," that the only test of the substantial identity of designs on different articles "is 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 designs —of a person accustomed to compare such designs one with another, and who sees and examines the articles containing them side by side," that "a patent for a design, like a patent for an improvement in machinery, must be for the means of producing a certain result or appearance, and not for the result or appearance itself," and that, "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."

When this same case came before the Supreme Court on appeal, the court took the same ground as was taken in the case of Root v. Ball, and reversed the ruling of the judge below upon every point of law laid down. The court said, "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." "It is the appearance itself, * no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public

which the law deems worthy of recompense." "To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities." "The controlling consideration is the resultant effect." "The true test of identity of design * * 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." "Experts * are not the persons to be deceived." "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, inducing him to purchase one, supposing it to be the other—the first one patented is infringed by the other."

This discussion of this question by the highest tribunal in the land is so full as to leave nothing to be said; there is, however, a minor matter connected with this subject which deserves some consideration.

TRIBUTARY OR IMPROVED DESIGNS.—It is well known that it is customary to grant patents for functional devices which are mere improvements upon existing devices, such patents being often tributary to other and prior patents.

In the case of W. N. Bartholomew, Com. Dec. 1869, p. 103, Commissioner Fisher seemingly takes the ground that the same thing can be done in design patents. He says, "a valid patent may be granted for a new genus or class of ornaments as well as for specific ornaments, though * * * 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."

It is readily apparent that an existing design might be so improved upon as to add greatly to its beauty, and yet the so improved design not be substantially unlike the original, as the alteration of a single line sometimes makes all the difference between an æsthetic fault and perfect symmetry, but in view of the decision of the Supreme Court in the case of the Gorham Mfg. Co. v. White, it is tolerably clear that unless the improvement were carried so far as to make the improved design substantially unlike the original, it would not be patentable.

There is a reason for this in the law. The act relating to functional patents (sec. 24) reads: "That any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, *or any new and useful improvement thereon*, &c., may obtain a patent therefor," thereby expressly allowing patents for improvements on existing devices, while the design patent act only allows a patent for "any new and original design," saying nothing about "improvements thereon," so that both the text of the law and the construction of the court point to the conclusion that a design patent can not be allowed for a design which is tributary to another, or a mere improvement thereon, and not in substance unlike it.

CHAPTER VI.

PRIOR USE.

In the case of Stuart & Bridge, Com. Dec. 1870, p. 15, Commissioner Fisher said, with reference to design patents, that "no provision is made for use or sale of the invention prior to the application, as in the case of other inventions." "The design must not have been known or used by others prior to the application of the inventor." "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. 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."

In the case of Alois Kohler, 4 Of. Gaz. 53, Commissioner Leggett denied a patent for a design shown in a prior mechanical patent granted to the same applicant. His reason does not appear to be the same as given by Commissioner Fisher just cited; he says "the design patent might have been first granted, and afterward the mechanical, but not *vice versa*, for the mechanical is the greater and must include the right to use the design shown, * * * but the design is the less and does not necessarily include the mechanism."

Although the remark is not exactly pertinent to the subject under consideration, it may be said, just here, that the language of Commissioner Leggett, just quoted,

reads rather curiously by the side of his language, in the case of P. Weinberg, Com. Dec. 1871, p. 244, where he says "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."

It so happens that two different courts have had occasion to decide whether design patents are entitled to two years' public use prior to application, as are other patents, and both courts have held that they are. In the case of Root v. Ball, 4 McLean, 177, which was an action upon a design patent, the court held that a plea that the design was in use or on sale before the application for the patent is demurrable, unless the plea aver an abandonment, or that such use or sale was for more than two years before the application for—under section 7 of the act of March 3, 1839—such use or sale must have preceded the application more than two years in order to invalidate the patent. And in Booth v. Garelly, 1 Blatch. 247, the court held the 7th section of the act of March 3, 1839, allowing two years' public use prior to the application, applicable to design patents. The act of 1839, just referred to, was passed three years prior to the first act, creating design patents, and refers directly to the act permitting the grant of functional patents. If the act of 1839 was applicable to the act of 1842, the equivalent sections of the acts since passed are certainly applicable each to the other, and design patents must be held entitled to two years prior use, the same as other patents.

Apropos of these constructions by courts, it may be remarked that they plainly foreshadow what the

action of a court will be, if the question as to whether a design patent can be reissued, or whether a disclaimer can be made thereto, is ever brought before it; and these constructions point to the conclusion that every provision of the general patent act of 1870, not inconsistent with the sections distinctively applicable to designs, is applicable to design patents.

CHAPTER VII.

EXTENSION.

THE first act authorizing design patents, approved August 29, 1842, made no provision for their extension beyond their original terms. The act of March 2, 1861, made design patents thereafter granted extensible upon the same terms and under the same conditions as other patents.

The act of July 8, 1870, made design patents granted prior to March 2, 1861, extensible the same as other patents; it made no provision for the extension of any patents whatever thereafter granted; it repealed both the former acts, but contained a saving clause with reference to rights existing under former acts which, so far as it relates to the extensibility of design patents issued between March 2, 1861, and July 8, 1870, has received a construction by the Patent Office, in the case of E. W. Sperry, C. D. 1870, p. 139. The acting commissioner decides squarely that since the passage of the act of July 8, 1870, the commissioner has no power to extend patents for designs issued since March 2, 1861, and that the fact that an application for such an extension was filed before the passage of the act of 1870 makes no difference in this regard.

He says: "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 to 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 2d day of March, 1861.'

"The patents now offered for extension, being patents for designs issued since the 2d 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."

There is room for serious doubt as to the correctness of this decision. The acting commissioner seems to have entirely overlooked the fundamental nature of a patent, and not to have applied the ordinary and received rules of construction to the saving clause in the repealing section of the act of 1870.

The sections of the law of 1870, referred to by the acting commissioner, "63 to 67 inclusive," and "section 74," have no direct application to the subject under discussion, for the former do not refer to design patents at all, and the latter refers expressly to design patents issued prior to March 2, 1861.

The parts of the law which have direct application to the subject are the latter part of section 11 of the act approved March 2, 1861, which provides "that the patentees of designs under this act shall be entitled to the extension of their respective patents, &c.," and section 111 of the act of July 8, 1870, which reads as follows:

"SECTION 111. *And be it further enacted*, That the acts and parts of acts set forth in the schedule of acts cited, hereto annexed, are hereby repealed, without reviving any acts or parts of acts repealed by any of said acts, or by any clause or provision therein: Provided, however, That the repeal hereby enacted SHALL NOT AFFECT, IMPAIR, OR TAKE AWAY ANY RIGHT EXISTING UNDER ANY OF SAID LAWS; 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, &c.

Schedule, &c.

* * * * * * * * *

Act of March 2, 1861."

Attention is called to the words made purposely prominent by being put in small capitals. It will be observed that, although, among others, the act of March 2, 1861, is repealed, yet that any right existing under it is preserved. The right to the extension of a design patent, granted under that act, is one of the rights so preserved, and it is not probable that a person unfamiliar with the artificial methods of legal

reasoning sometimes emp!.,ed in such matters would think of asserting to the contrary.

The then acting commissioner concludes, however, that because this saving clause is connected by the word "but" to the words "all actions and causes of action, both in law and in equity, &c.," that, therefore, this saving relates to "such rights only as may form the basis of a suit at law or in equity." With reference to this, it may be observed that the saving clause is separated from "but" and its following words by a semicolon, a slight circumstance perhaps, but showing that there is no intimate connection intended between the saving clause and but with its followers. It may be further observed, that when the word "but" is used as a connective in legal language, it does not necessarily nor, it is believed, ordinarily have the same meaning and significance that it has when used as a connective in other kinds of composition, so that it does not follow, from the use of the connective "but" here, that the words following it are to be taken as modifying and limiting the words preceding it. Still further, the right to bring suit under a repealed law is just the right that the draftsman of a new law would not leave to be derived from the general words preceding the semicolon, but he would naturally go on in the same connection to elaborate upon this particular right, just as is done in this case, and what more natural than the use of the semicolon and the word "but" between the general clause and the elaboration of a single point under it. Again, this saving clause is in the nature of a remedial statute, and hence should be construed liberally, and it would seem to need but little liberality of construction to make this saving clause include the right of extension.

There is an argument which would seem to be decisive of the whole question. The right to the protection of letters patent is not a natural right that is pertaining to man in a state of nature, but it is a civil right pertaining to man under the protection of a civil government, and the law of March 2, 1861, is clearly a law in the nature of a contract between the government and the inventor.

The consideration moving from the inventor is the production of the design and the compliance with certain requisites of the law, such as paying a fee and preparing and presenting the proper papers. The consideration moving from the government is the grant of an exclusive right to make, use, and vend the design for a specified time, with the right, under conditions, to a specified extension of such time. The government says to the man, "If you will make an invention, pay a certain fee, and prepare and present certain papers, then the government will, in return, grant you an exclusive right with reference to such invention, and, under conditions, will extend such time for a specified term," thus making the right to the extension an essential and integral part of the contract and of the consideration moving from the government.

"When a law is in the nature of a contract, and when rights have vested under it, a repeal of the law cannot divest those rights; a party to a contract cannot pronounce its own deed invalid, though that party be a sovereign state." These are the words of a distinguished jurist, and cannot be gainsaid. The right to extension vested in every patentee of a design, under the act of March 2, 1861, as soon as his patent issued, and he cannot be divested of that right, even though

a subsequent act assume to do so in explicit terms, which is by no means the case here.

It is not an answer to this argument to say that "this theory may be correct, but the government *has repealed* the law, there is no power competent to coerce the government, the commissioner must obey the law, and your wrong is one without remedy," for the acting commissioner in deciding this case did not follow a plain and straightforward statement of law that left him no choice of action, but he arrived at his conclusion by means of a technical and highly artificial course of reasoning, when it was his duty, if the matter was involved in any doubt, to resolve that doubt in the way and manner that would leave the government in the attitude of an honest party, fulfilling its contract. This people and this government recognize right and justice as rules of action for guidance and governance, and it was the duty of the acting commissioner, who wielded the powers of government in this instance, to leave the government in the attitude of performing its contract.

It is believed that another argument bearing upon this matter is found in section 74 of the act of July 8, 1870, where Congress, in terms, makes design patents granted prior to March 2, 1861, extensible when they had not been so before.

Why was extensibility given to these early design patents, when they had it not before, except to put them on an equal footing with those granted since March 2d, 1861? Why take away extensibility from these later patents, which was theirs of right, and give it to the prior patents as a gratuity? Why rob Peter, not to pay Paul, but to make him a gift of the theft? If extensibility is a good thing, why take it

away from the later patents? If a bad thing, why give it to the prior ones? To attempt to explain section 74, except on the ground that it was intended to put the earlier design patents upon the same footing as the later ones, seems to involve an absurdity.

It would seem tolerably clear that Congress had no right to take away extensibility from design patents granted between March 2, 1861, and July 8, 1870; that they did not intend to do so, and that a fair construction of the law will not sustain a refusal to extend one of these patents.

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