

THE LAW
OF
PATENTS FOR DESIGNS

CONTAINING

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

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PREFACE.

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

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

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

U. T. F.

PHILADELPHIA, June, 1889.

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THE LAW OF PATENTS FOR DESIGNS.

CHAPTER I.

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

SECTION 1. Although the Congress of the United States as early as April 10, 1790,¹ did, by Act of that date, provide for carrying into effect the provisions of Article 1, Sect. 8, of the Constitution, authorizing the grant for limited periods to authors and inventors, of the exclusive right to their respective writings and discoveries, the general classification therein of subjects of invention so entitled to be protected thereby, excluded, by implication at least, any new and original design for ornamentation to be placed upon, or any new and original configuration of, any article of manufacture; and it was not until 1842² that Congress enacted a law specifically including these inventions or pro-

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

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

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

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

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

SECT. 3. The Act of August 29, 1842, was repealed and supplied by the Act of March 2, 1861². The Act of 1842

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

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

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

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

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

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

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

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

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

SECT. 5. These statutes were repealed and entirely superseded by the consolidated Patent Act of July 8, 1870.¹ Sections 71 to 76 inclusive, only, of that act apply to design patents. This law abolishes all discrimination between citizen and alien applicants, and also in lieu of the words "not known, etc., prior to application for a patent therefor," found in the Acts of 1842 and 1861, substituted the words "patented or described in any printed publication." The

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

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

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

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

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

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

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

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

SECT. 6. The laws relating to design patents, in force on the 22d of June, 1874, formed Sections 4929 to 4934 of the Revised Statutes³ of the United States, adopted and approved by Congress by law of that date. These sections are a reprint in substance, and almost in phraseology, of

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

² *Ex parte Sperry*, Com. Dec. 1870, page 139.

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

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

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

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

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

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

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

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

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

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

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

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

CHAPTER II.

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

SECTION 1. The power of Congress, under the Constitution, to enact laws to protect by patent the exclusive right, for limited periods, to the use of novel designs, can only be by virtue of Cl. 8, sec. 8, Art. 1 of that instrument authorizing grants by general or special laws, or by both, to authors and inventors, of the exclusive right, for limited periods, to their respective writings and discoveries. Hence it was said by an able and learned judge in a very early case¹ founded on a design patent, that to support the grant, the patentee must have been an *inventor*, and he must have made an *invention*; that is to say, the design sought to be protected must be more than a mere fanciful sketch or form, or more than a mere aggregation of forms, figures, letters, or ornaments; in brief, it must be a new and original design, involving ingenuity.

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

¹ Northrup v. Adams, 2 B. & A. 567. See also Wooster v. Crane, 5 Blatch, 292, and Simpson v. Davis, 12 Fed. Rep. 144.

figuration or for ornament, the name of the author or *proprietor*, and the class of goods to which the design is applicable or intended to be applied, is all that is necessary to obtain protection¹; and no requirement is there made that the design shall necessarily involve invention, or be more than a mere aggregation of words, figures, lines, or ornaments, provided that the whole be novel in the sense of being distinguishable from what is already in use in the same class.

SECT. 3. Much difference of opinion has existed as to whether or not design patents were confined to ornamentation only, as defined in the Acts of 1842 and 1861, and as these statutes were construed by the Supreme Court in *Gorham Co. v. White*; since, in the subsequent Act of July, 1870, and the Revised Statutes, the word *useful* appears for the first time in conjunction with the words *new and original* in including form or configuration of an article as patentable subject-matter under the design section. Diametrically opposite opinions on this point are to be found in the earlier decisions of the Patent Office, but better opinion at this time seems to be that *useful*, in the statute, means ornamental utility, and not functional utility. Since the Act of 1870, the Circuit Court for the District of New Jersey, in a well considered case² decided in 1883, held that design patents differ from patents for inventions or discoveries in that they have reference to appearance rather than utility; that their object is to encourage the arts of decoration rather than the invention of useful products; and that a picture or design which merely pleases the eye is a proper subject for such a patent, without regard to the question of utility.

SECT. 4. The Supreme Court in an opinion by Mr. Justice Nelson³ construed the Act of 1861, as respects patentable subject matter under that act, to the effect that the claim must be for an original design, or impression, or ornament, or picture, or pattern, and the like, wholly irrespective of the means of producing it; and was called upon in that case to distinguish between the patentability under the

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

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

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

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

SECT. 5. In construing the Act of 1861, Judge Benedict held¹ that while the act as respects form or configuration of an article does not require functional utility in the thing sought to be protected, it does require that the shape produced shall be the result of industry, effort, genius, or expense, and must also be held to require that the shape or configuration sought to be secured shall also be new and original as applied to articles of manufacture. The case arose upon a patent for a design for a reel for containing or holding ruffles, dress-trimmings or other goods, consisting of two parallel disks of pasteboard connected by four bits of wood, the pasteboard being cut in the shape of a rhombus with the angles rounded; and the claim was for the form of the reel. A reel as an article of manufacture being old, and the rhombus form being that of a well-known mathematical figure, the court held that it did not involve patentable novelty under this act to originally apply an arbitrarily selected old form to a well-known article of manufacture.

SECT. 6. In a suit on a patent issued under the Act of 1842, Judge Nelson held² that the invention claimed was a "design for a manufacture," of an ornamental button. The design was described in the patent as consisting of two distinct characters, to be used in combination, in order

¹ *Wooster v. Crane*, 2 Fisher, P. C. 583.

² *Booth v. Garrelly*, 1 Blatch., C. C. Rep. 217.

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

SECT. 7. As illustrative of what does *not* present patentable subject matter under the design patent statute, it was held in 1880¹ that a card for pearl buttons, covered with tin foil, arranged in bands, to hold pearl buttons in rows of three or four, was not such an invention, for the reason among others that the so-called design did not apply to the article itself, but the card was merely for presenting the article—the buttons—in a more convenient, or perhaps more pleasing form, to an intending purchaser; and holding without qualification, that merely changing the mode of keeping and presenting an article for sale, without changing its form or appearance, and that did not affect the article itself, would not support a design patent.

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

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

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

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

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

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

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

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

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

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

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

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

anything like satisfactory results. No doubt it was well applied in that case. The court held that identity was to be determined, not by a critical comparison of the design patented with that which preceded or followed it, but by the effect on the eye of an ordinary observer; and that expert comparative testimony was to be rejected, together with immaterial differences in details not affecting the resultant appearance of the whole; adding, however, that the court did not mean to say that in determining whether two designs were substantially alike, differences in the lines, the configuration, or the modes by which the aspects they exhibit, are not to be considered; but deciding that resultant effect is the controlling consideration. The opinion in this case reversed the decision of the court below¹ on every ground on which the judgment was founded, but the decree of reversal was non-concurred in by three of the Justices who sat at the hearing of the appeal.

SECT. 11. It is important to note that neither in the case of *Gorham Co. v. White*, nor in the case of *Holdsworth v. McCrea*,² a leading English case cited and approved therein, was any defense made on the ground of want of patentable novelty, or any evidence of the state of the art introduced. As in construing functional patent claims, such evidence is of the first importance, no good reasons exist why it is not equally applicable in design patent cases. It can scarcely be controverted that a new and original and patentable design may be specifically different as a whole or in any of its several and, perhaps, segregable parts, yet generically like a prior design, in an artistic, if not in a legal, sense; although the Patent Office authorities held in a very well considered recent decision,³ that under the definition of identity of design, by the Supreme Court in *Gorham Co. v. White*, such would not be patentably different. An earlier ruling of the Patent Office in an elaborate opinion,⁴ held to the contrary; while a learned text writer⁵ on the subject, considering that opinion in

¹ *Gorham Co. v. White*, 7 Blatch. 513.

² *Holdsworth v. McCrea*, 2 App. Cas. II. of L. 333.

³ *Ex-parte Gerard*, 43 O. G. 1235 and 1240 (2 cases).

⁴ *Ex-parte Bartholomew*, Com. Dec., 1870, page 103.

⁵ *Simonds on Design Patents*, page 139.

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

SECT. 12. The most common subject of designs is surface ornamentation; and it has been much discussed as to whether mere arrangements of colors might constitute a patentable design. In an early Patent Office decision¹ it is said that a *mere* substitution of one color for another possesses no element of originality, and indicates no exercise of genius, and cannot, therefore, become the subject of a patent, neither can any blending or arrangement of colors, unless a new æsthetical effect is produced, or original idea indicated. Both branches of the ruling are seemingly correct. The same decision, however, contains the admission that, subject to the qualification mentioned, it is not intended to rule that no design patent could, under any circumstances, be based on colors only. A case arose in New York, decided in 1887, in which the court said that the patent was an attempt to secure to the patentee a monopoly of all ornamentation upon rubber mats by which variations of light and shade are produced by a series of ridges and depressions, without regard to any particular arrangement or characteristics of the lines, except that they are to be parallel. That as it was not new to produce contrasts and variations in light and shade by depressions or elevations in various materials, as wood, plaster, corduroy cloth, etc., it was not patentable novelty to transfer the same to rubber mats, and held the patent void because the claims did not extend to, or cover anything which "embodies a new impression or effect produced by an arrangement or configuration of lines which introduces new elements of color or form."

SECT. 13. The same doctrine, applicable to employer and workman, that holds in case of functional patents, has been applied to designs, in an early case decided in New York in 1846,² wherein it was ruled that to constitute an inventor (of a design), it is not necessary that he should have the manual skill and dexterity to make the drafts. If the

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

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

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

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

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

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

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

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

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

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

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

SECT. 17. Other illustrations of non-patentability are found in cases involving what, in suits on functional patents, would be called analogous uses or mere double uses. The adaptation of old devices or forms to new purposes, however convenient, useful, or beautiful they may be in their new role, is not invention.² An apt illustration of this is found in gas drop-lights or newel-post lights, where a gas-jet is passed through any well-known bronze figure, and so adapting to a useful purpose that which was before purely ornamental, which, while it may exhibit good taste and judgment, lacks the element of invention and involves merely judicious selection of existing forms.

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

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

¹ *Osborn v. Judd*, 38 O. G., 1132.

² *Northrup v. Adams*, 12 O. G. 430.

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

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

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

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

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

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

³ *Ex parte Patitz*, 25 O. G. 980.

⁴ *Ex parte Gerard*, 43 O. G. 1243.

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

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

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

¹ Simpson v. Davis, 12 Fed. Rep. 144.

² Gorham Co. v. White, 14 Wall. 511.

³ Wood v. Dolby, 7 Fed. Rep., 475.

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

SECT. 24. It is seen therefore that the same test of identity, applied to determine the issue of infringement, as laid down by the Supreme Court in *Gorham Co. v. White*, is to be applied to determine the issue of patentable novelty, where the court is called upon to consider that question in view of evidence of the state of the art, or more properly of prior designs of the same genus, class or character. Yet, cases may arise in which it seems extremely difficult to apply the rule inflexibly, in view of the fact that the Supreme Court has recently ruled¹ that a design patent claim is good which simply claims the thing shown without pointing out and distinctly claiming, or even describing, the particular part or parts or arrangement of parts, distinguishing its originality from what preceded it in the same class of ornamental designs.

SECT. 25. The same test of identity, is applicable to form or configuration, as well as to surface ornamentation, and was so applied in a case² where the patent covered in three separate claims the external form as an entirety, the ornamentation, and finally the appearance resulting from both the elements of form and ornamentation. The subject matter of the patent was a stove, and evidence of the state

¹ *Dobson v. Dornan*, 118 U. S., 10.

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

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

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

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

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

Decided October 7, 1865.

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

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

Thomas P. How, for complainant.

S. F. Freeman, for defendants.

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

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

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

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

Section 11 of this Act is as follows:

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

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

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

shape applied to it by the complainant is also an old, well-known mathematical figure. Now, although it does not appear that any person ever before applied this particular shape to this particular article, I cannot think that the act quoted above was intended to secure to the complainant an exclusive right to use this well-known figure in the manufacture of reels. The act, although it does not require utility in order to secure the benefit of its provisions, does require that the shape produced shall be the result of industry, effort, genius, or expense, and must also, I think, be held to require that the shape or configuration sought to be secured, shall at least be new and original as applied to articles of manufacture. But here the shape is a common one in many articles of manufacture, and its application to a reel cannot fairly be said to be the result of industry, genius, efforts, and expense. No advantage whatever is pretended to be derived from the adoption of the form selected by the complainant, except the incidental one of using it as a trade-mark. Its selection can hardly be said to be the result of effort even; it was simply an 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.



CLARK *v.* BOUSFIELD.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

This language is both concise and correct ; and, tested

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

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

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

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

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

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

Mr. Justice NELSON delivered the opinion of the court.

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

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

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

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

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

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

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

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

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

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

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

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

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

*Mr. Hunt, for complainant.**Messrs. J. W. McGrath and Geo. H. Lothrop, for defendant.*

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

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

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

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

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

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

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

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

It results that the bill must be dismissed with costs.

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

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

Decided September Term, 1877.

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

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

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

Coburn and Thacher, for plaintiff.

S. S. Boyd, for defendant.

Motion for preliminary injunction.

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

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

The claim in the patent is for—

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

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

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

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

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

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

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

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

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

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

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

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

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

The second element is for a design patent.

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

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

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

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

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

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

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

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

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



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

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

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

1. The main and principal features of the art of preserving fruits, vegetables and meats, in hermetically sealed cans or packages being old, whether a patent for each particular article of canned goods "as a new article of commerce" can be sustained as a new invention, *Quære*.
2. Courts should not be hasty or inconsiderate in granting injunctions at the instance of the holders of such patents against other manufactures of similar goods. Preliminary injunction accordingly dissolved, leave to make motion to such effect based on suitable affidavits being granted at the time of the injunction.

3. Doubted whether a frusto-pyramidal shaped packing-can with rounded corners for containing preserved meat, and which facilitates its removal in solid mass, is as a form or configuration a patentable design, because lacking in novelty for analagous purposes.
4. The defendant having neither made nor sold goods in the similitude of complainants' goods within the district where suit was brought, the preliminary injunction was dissolved; ordinarily such process cannot run beyond the district from whence it issues.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

The injunction is dissolved.



PRATT AND ANOTHER *v.* ROSENFELD AND ANOTHER.

Circuit Court, Southern District New York.

Decided June 14, 1880.

2 Fed. Rep., p. 335.

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

George C. Lay, Jr., for plaintiffs.

Edmund Wetmore, for defendants.

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

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

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

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

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

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

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

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

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

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SIMPSON *v.* DAVIS.

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

12 Fed. Rep., p. 144.

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

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

Edwin H. Brown, for plaintiff.

N. H. Clement, for defendant.

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

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

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

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

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

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

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

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

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



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

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

18 Fed. Rep., p. 321.

1. Letters patent issued on the 15th of February, 1876, to Charles W. Lewis, for a design for the dial of an annunciator, held invalid for want of novelty.
2. It is now tolerably well settled that design patents stand on as high a plane as utility patents, and require as high a degree of exercise of the inventive or originative faculty. In patentable designs a person cannot be permitted to select an existing form, and simply put it to a new use, any more than he can be permitted to take a patent for a mere double use of a machine; but the selection and adaptation of an existing form may amount to patentable design, as the adaptation of an existing mechanical device may amount to patentable invention.

Geo. P. Barton, for complainant.

James L. High, for defendant.

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

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

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

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

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

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

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

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

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

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

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

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

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

POST AND OTHERS v. T. C. RICHARDS HARD-
WARE CO.

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

26 Fed. Rep., p. 618.

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

William Edgar Simonds, for plaintiffs.

Frank L. Hungerford, for defendant.

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

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

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

The specification described the patented design as follows:

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

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

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

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

The demurrer is allowed.



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

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

34 Fed. Rep., p. 39.

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

Robert H. Duncan, for orators.

Lawrence E. Sexton, for defendants.

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

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

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



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

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

Decided November 20, 1886.

38 O. G., p. 1132.

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

Mr. Joshua Pusey, for the complainant.

Messrs. Briesen & Steele, for the defendants.

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

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

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

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



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

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

30 Fed. Rep., p. 785.

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

A. von Briesen, for complainant.

W. H. L. Lee, for defendant.

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

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

The claims are as follows:

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

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

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

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

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

The demurrer is sustained.

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

CHAPTER III.

Of the Letters Patent, and of the application therefor.

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

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

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

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

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

¹ *Ex parte Mayo*, Com. Dec., 1870, p. 14.

² *Ex parte Haley*, 44 O. G. 1399.

³ *Ex parte Sellers*, Com. Dec., 1870, p. 58.

⁴ *Ex parte Bailey*, 37 O. G. 781.

⁵ *Cone v. Morgan Envelope Co.*, 4 B. & A. 107.

⁶ *Ex parte Carty*, 44 O. G. 570.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

⁵ *Ex parte Neidringhaus*, 8 O. G. 279; *Untermeyer v. Jeannot*, 20 Fed. Rep. 503.

⁶ Sect. 4888, Rev. Stat.

⁷ 11 Wallace, 516, 540.

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

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

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

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

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

¹ *Dobson v. Dornan*, 118 U. S. 10.

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

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

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

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

² *Miller v. Smith*, 5 Fed. Rep. 359.

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

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

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

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

UNTERMEYER v. JEANNOT AND OTHERS.

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

20 Fed. Rep., p. 503.

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

Rowland Cox, for complainant.

Birdseye, Cloyd & Bayless, for defendants.

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

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

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

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

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



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

Circuit Court U. S., District of Massachusetts.

Decided January, 1879.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

NOTE.—See also the following Patent Office decisions, contained in the appendix at end of this volume, governing the practice in that department, in applications for Design Patents. *Ex parte* Beattie, 16 O. G. 266; *ex parte* Brower, C. D. 1873, p. 151; *ex parte* Carty, 44 O. G. 570; *Collender vs. Griffiths*, 3 O. G. 91 and 287; *ex parte* Diffenderfer, C. D. 1872, p. 151; *ex parte* Fairchild, 3 O. G., 232; *ex parte* Gerard, 43 O. G. 1235 and 1240; *ex parte* Kohler, 4 O. G. 53; *ex parte* Mayo, C. D. 1870, p. 14; *ex parte* Neldringhaus, 8 O. G. 279; *ex parte* Palmer, 21 O. G. 1111; *ex parte* Patitz, 25 O. G. 980; *ex parte* Pope, 25 O. G. 290; *ex parte* Rogers, 13 O. G. 596; *ex parte* Sheppard, C. D. 1870, p. 22; *ex parte* Stuart & Bridge, C. D. 1870, p. 15; *ex parte* Sperry, C. D. 1870, p. 139; *ex parte* Whyte, C. D. 1871, p. 304.

CHAPTER IV.

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

SECTION 1. It was held in the first reported design patent case,¹ decided in 1846, that without an averment of abandonment, a plea that the thing patented had been publicly used before the application, without averring also that such use has been for more than two years, was demurrable; and that the general patent act of March 3, 1839, permitting such use for not more than two years prior to application for patent, was applicable to designs. And the same view was incidentally expressed in a later case decided in 1847.² As both these cases arose on patents issued under the act of 1842, it may be doubted if the ruling was correct, as that statute, as well as the act of 1861, only authorized such a patent when the invention was "not known or used by others before his invention or production thereof, and prior to his application for a patent therefor." The subsequent rulings of the Patent Office were certainly not in accord therewith.³ The present law (Act of July, 1870, and Sec. 4,929, Rev. Stat.) omits this qualifying language; hence the general law, which permits of a public use for not more than two years prior to application for patent, is now applicable to designs.

SECT. 2. In a case decided in 1880⁴ founded on two design patents, both issued under the provisions of the Revised Statutes, the Court was of opinion that there was no presumption of abandonment by reason of the patentee exhibiting his design in a previous mechanical patent; and that abandonment, in fact, did not follow from such act until after two years public use.⁵ No doubt abandonment

¹ *Root v. Ball*, 4 McLean, 177.

² *Booth v. Garrelly*, 1 Blatch. 247.

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

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

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

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

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

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

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

¹ *Booth v. Garrelly*, 1 Blatch. 247.

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

³ *Meers v. Kelley*, 31 Fed. Rep. 153.

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

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

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

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

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

¹ *Collender v. Griffith*, [See page 88 of this book.]

² *Jennings v. Kibbe*, 24 Fed. Rep. 697.

³ *Foster v. Crossin*, 23 Fed. Rep. 400.

⁴ *Simpson v. Davis*, 12 Fed. Rep. 141.

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

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

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

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

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

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

⁴ *Perry v. Starrett*, 14 O. G. 599.

⁵ *id.*

⁶ 91 U. S. Rep. 37.

⁷ 107 U. S. Rep. 349.

⁸ 36 Fed. Rep. 554.

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

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

¹ 26 Fed. Rep. 618.

² 1 Blatch. 295.

³ 35 Fed. Rep. 426.

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

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

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

DAVID ROOT *v.* BALL & DAVIS.

Decided July Term, 1846.

4 McLean, C. C. Rep. 177.

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

¹ *Lehnbeuter v. Holthaus*, 105 U. S. 94.

² *Ibid.*

³ *Ibid.*

⁴ *Dreyfus v. Schneider*, 29 Fed. 491.

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

3. It is no defence that the patentee, before issue of patent, sold some of the patented articles without stamping thereon notice of his application.
4. To constitute infringement, it is not necessary to copy the thing patented, in every particular. It is sufficient if the defendant's design produces substantially the same appearance.

Fox, for the plaintiff.

Hart for the defendant.

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

The defendants pleaded :

1. The general issue.
2. Because, before the date of the patent, on the 6th of January, 1844, stoves constructed upon the plan of the stove patented by the plaintiff, with the same general design and combination of the ornamental parts, were publicly made and sold by the defendants at the district, etc.
3. Because, before the date of the application for the said letters patent, on the 1st of November, 1844, and hence on till the date of said application, stoves constructed on the plan of the stoves patented by the plaintiff, with the same general design and combination of the ornamental parts, were publicly for sale by the plaintiff himself at the district, etc.
4. Because, before the date of issuing the patent, on the 1st of January, 1845, and thence on the date of the same, stoves constructed upon the plan of the stove patented by the plaintiff, with the same general plan and combination of the ornamental parts, were publicly for sale by the plaintiff himself at Cincinnati, etc.
5. Because, at the date of application for said letters, on November 1, 1844, and thence till the date of said application, stoves constructed upon the plan of the stove

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

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

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

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

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

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

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

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

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

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

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

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

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

find the defendant 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.



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

Decided October Term, 1847.

1 Blatch. C. C. Rep. 247.

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

Samuel Sherwood, for plaintiff.

Abijah Mann, Jr., for defendants.

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

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

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

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

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

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

If the button be regarded simply as a product of the

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

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



BURTON *v.* THE TOWN OF GREENVILLE.

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

Decided July 21, 1880.

3 Fed. Rep. 642.

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

George E. Betton, for complainant.

Stearns & Butler, for defendant.

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

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

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

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

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

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

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

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

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

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

Bill dismissed with costs.



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

SAME v. SAME.

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

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

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

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

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

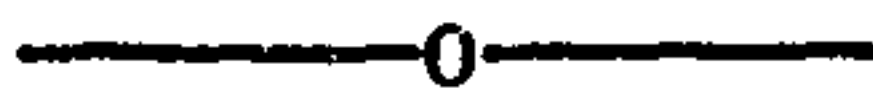
The principal, if not the sole, feature claimed is, the form of beveled sides and ends. Tables and designs for tables having such beveled sides and ends, both straight or in the form technically called "ogee" are shown to be old and in public use long before complainant's alleged invention. This is so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

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

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

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

The bill of complaint must be dismissed with costs.



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

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

Decided May 4, 1880.

2 Fed. Rep. 206.

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

George Harding and H. D. Donnelly, for plaintiff.

Dickerson & Beaman, for defendant.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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



PERRY *et al.* v. STARRETT.

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

Decided October 17, 1878.

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

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

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

2. To constitute a new design that would be patentable as such, it must be so different from all others existing before as to appear to be such to ordinary observers.
3. The patent granted to John S. Perry and others, May 26, 1874, for a design for stoves, held under this rule to be valid; the first claim being interpreted to cover the element of external form as an entirety, without regard to that of the individual parts; the second, the element of ornamentation; and the fifth, the appearance resulting from the combination of the two elements of form and ornamentation.
4. Held that these claims were infringed by the unlicensed sale of a stove "having both form and ornamentation so like those to which said claims relate, that whether regard be had to such form or to such ornamentation separately, or to the combined effect of the two, the stoves so sold are calculated, by reason of such resemblance, to deprive the complainants of a part of that market to which, under their patent, they are exclusively entitled."
5. The Hecla, adjudged to be in appearance substantially like the patented design (the Argand), the general effect, both of form and ornamentation being the same, notwithstanding minor differences which require study and fixing them in mind to enable a person to tell one from the other when they are not side by side.
6. Infringement of a design patent may exist, notwithstanding that the alleged infringing article is made to carry a distinguishing name or distinguishing marks of other character.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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



**THEBERATH v. RUBBER & CELLULOID HAR-
NESS TRIMMING COMPANY.**

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

Decided February 6, 1883.

15 Fed. Rep., p. 246.

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

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

Philip W. Cross, for complainant.

Joseph C. Clayton and A. Q. Keasby, for defendants.

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

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

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

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

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

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

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

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

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

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

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

Such testimony seems hardly consistent with two facts:

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

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

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

It should be added that subsequently in his cross-

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

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

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

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

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

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

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

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

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

The bill of complaint must be dismissed, with costs.



CROCKER *v.* CUTTER TOWER COMPANY.

U. S. Circuit Court, District of Massachusetts.

Decided December 23, 1886.

29 Fed. Rep. 456.

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

C. H. Drew and W. B. Durant, for complainant.

C. C. Morgan and O. M. Shaw, for defendant.

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

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

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



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

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

Decided April 6, 1885.

23 Fed. Rep. 400.

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

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

W. B. Vincent, for complainant.

J. M. Brennan and W. R. Pierce, for respondents.

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

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

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

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

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

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

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

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

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

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

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

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

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



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

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

Decided November 10, 1885.

25 Fed. Rep. 481.

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

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

R. B. McMaster, for complainant

William H. O'Dwyer, for defendants.

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

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

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

There should be a decree for the complainant.



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

Supreme Court of the United States.

Decided March 6, 1882.

105 U. S. Reports, 94.

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

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

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

Mr. R. H. Parkinson, for appellants.

No counsel appearing for appellees.

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

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

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

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

Holthaus, which the witness followed in making the drawings.

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

Mr. Justice Woods delivered the opinion of the court.

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

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

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

MEERS *v.* KELLY.

Circuit Court, Southern District, New York.

Decided May 16, 1887.

31 Fed. Rep. page 153.

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

J. Milton Stearns, Jr., for plaintiff.

Andrew J. Todd, for defendant.

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

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

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

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

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

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

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

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

There is no infringement, and the bill is dismissed.



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

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

Decided October 15, 1888.

36 Fed. Rep. 554.

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

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

Dyrenforth & Dyrenforth, for complainant.

E. S. Bottum, for defendants.

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

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

And the claim is:

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

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

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

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

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

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

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



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

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

Decided October Term, 1846.

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

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

Daniel Lord, for the plaintiffs.

Seth P. Staples, for defendants.

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

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

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

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

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

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

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

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

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



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

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

Decided July 2, 1888.

35 Fed. Rep. 426.

1. Letters Patent No. 16,375, dated November 10, 1885, to George Streat, claimed a design for printing textile fabrics, the leading feature of which was stripes of a solid block of color parallel to and alternating with stripes which are crossed at right angles by alternate dark and light lines, blended into each other by shading, and which was intended to be, and was, an imitation in printed cloths, of the woven fabric commonly called "seersucker."
2. It appearing that though the patentee conceived the idea of the imitation, but which had previously been attempted by others, the actual invention of successfully producing the imitation was by blending together the cross lines by shading, and which was alone novel, and as this was entirely the work of the engraver to whom the patentee committed the work, held the invention was made by the latter and not by the patentee.
3. Had the patentee conceived the idea of the blending together of the cross lines by shading, though he did not actually do the work, the case would be different.

Samuel R. Betts, for plaintiff.

Reuben L. Roberts, for defendant.

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

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

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

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

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

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

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

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

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

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

CHAPTER V.

Of infringement, and identity of designs.

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

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

¹ *Gorham Co. v. White*, 14 Wall., 511.

² *Gorham Co. v. White*, 7 Blatch, C. C. Rep.

³ *Clark v. Bousfield*, 10 Wall., 183.

⁴ *Root v. Ball*, 4 McLean, 177.

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

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

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

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

¹ 34 Fed. Rep. 39.

² 23 Fed. Rep. 895.

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

conclusion, the controlling consideration is the resultant effect.¹

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

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

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

¹ *Gorham v. White*, 14 Wall. 511.

² *Gorham v. White*, 14 Wall., 511.

³ 10 Fed. Rep., 669.

⁴ 14 Wall. 511.

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

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

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

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

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

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

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

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

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

¹ 100 U. S. Rep's, 671.

² *Untermeyer v. Jeannot*, 20 Fed. Rep. 503. *Dryfoos v. Friedman*, 18 Fed. Rep. 825.

³ 118 U. S. 10.

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

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

¹ 12 Fed. Rep. 144.

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

SECT. 17. Great possibility of error exists in forming a conclusion as to identity of designs by a comparison of the alleged infringing article with another said to embody the design of the patent, without great care being taken that the similarity or dissimilarity of the two articles should depend upon the part or parts thereof which form the subject matter of the patent in question, and not upon the irrelevant or unpatented parts.³ A case decided by Judge Wheeler⁴ furnishes an illustration. The patent was for a fringed lace fabric, and the article exhibited to the court as illustrating the plaintiff's design was a nubia (an article of ladies' dress), having the patented fringe attached to it. The defendants also made and sold similar nubias with fringed lace fabric attached, but the fringed lace was different in one or more particulars from that of the patent. The court refused to decree an infringement, remarking that the patent was not for a design for a nubia but for a fringed lace fabric; that the novelty of the patented design appertained to the fringe and not to the rest of the

¹ O. G. Vol. 14, p. 599. See also *Wood v. Dolby*, 7 Fed. Rep. 475.

² 18 Fed. Rep. 321.

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

⁴ *Jennings v. Kibbe*, 24 Fed. Rep. 697.

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

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

¹ 14 O. G., 599.

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

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

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

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

Decided September 7, 1870.

7 Blatchf. C. C. Rep. 513.

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

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

2. The determination of the question of substantial identity depends upon a comparison of the means used to produce the designs compared, and if the means differ, though the result is similar, there is no infringement.
3. A patent for a design, like a patent for improvement in machinery, must be for the means of producing a certain result or appearance, and not for the result or appearance itself.
4. The evidence of persons skilled in the business of designs in the particular trade in question, comparing them side by side, is proper in determining whether two designs are alike or dissimilar. There must be a comparison of the features which make up the two designs. And the same rule is applicable to determine novelty as is applied on the question of infringement.

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

The bill must be dismissed with costs.



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

Supreme Court of the United States.

Decided December Term, 1871.

14 Wallace, 511.

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

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

2. It is the appearance itself, and not the mode by which it is produced, that constitutes mainly, if not entirely, the contribution to the public, which the law deems worthy of recompense; and this appearance may be the result of peculiarity of configuration, or, of ornament alone, or of both conjointly, but, in whatever way produced, it is the new product which the patent law regards.
3. The acts of Congress embrace only designs applied or to be applied, and refer to finished products of invention, and not to the processes or agencies by which they are developed.
4. Identity of appearance, or sameness of effect upon the eye, is the main test of substantial identity of design. And while differences in the lines, the configuration, or the modes by which they are produced, may properly be considered in reaching a conclusion, the controlling consideration is the resultant effect.
5. Minor variations in the details of the ornamentation or configuration, a greater or less number of parts, or slight changes in the arrangement thereof, if insufficient to change the effect upon the eye, will not destroy the substantial identity.
6. It is not essential to identity of design that the appearance should be the same to the eye of an expert. If, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same; if the resemblance is such as to deceive such an observer, and sufficient to induce him to purchase one, supposing it to be the other, the one first patented is infringed by the other.

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

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

Mr. Justice STRONG delivered the opinion of the court.

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

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

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

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

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

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

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

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

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

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

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

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

This seems most reasonable, for, as we have said, it is the effect upon the eye which adds to articles of trade or commerce. So in *Holdsworth v. McCrea*, 2 App. Cas., House of Lords, 388, Lord Westbury said: “Now, in the case of those things, in which the merit of the invention lies in the drawing, or in forms that can be copied, the appeal is to the eye, and the eye alone is the judge of the identity of the two things. Whether, therefore, there be piracy or not, is referred to an unerring judge—namely, the eye, which takes the one figure and the other figure, and ascertains whether they are or are not the same.”

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

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

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

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

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

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

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

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

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

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

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

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

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

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

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

Justices Miller, Field, and Bradley dissented.

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

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

Decided July 14, 1880.

3 Fed. Rep. 151.

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

NIXON, D. J. This case has been heard on bill, plea, replication, and proofs. The bill alleges that the complainant is the original and first inventor of three several patents, to wit: one for the "improvement in the covering of harness trimmings," dated January 18, 1870, and numbered 99,032; one for a "new and useful design for harness trimmings," dated June 13, 1871, and numbered 5,006; and one for "improvement in harness mountings," dated August 24, 1875, and numbered 167,040; and charges that the defendant corporation has made, used, and vended to others to be used, a large number and quantity of an article of harness trimmings which infringe the three several patents. The plea denies that the three alleged inventions are, in point of fact, connected together in use or operation, and conjointly embodied in any of the harness trimmings and other articles manufactured, used, or sold by the defendant, on which denial the complainant has taken issue by replying. The complainant's replication is an admission by him of the sufficiency of the plea as a defense, if the facts which it alleges are established by the evidence. *Myers v. Dorr*, 13 Blatch. 22-26; Story's Eq. Pl. Sect. 607. The issue, then, is as to the truth of the allegations of the plea, that no one article manufactured and sold

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

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

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

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

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

Decided October 7, 1880.

5 Fed. Rep. 359.

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

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

B. F. Lee, for complainants.

Livingston Scott, for defendants.

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

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

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

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

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

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

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

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

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

Decree for complainants.

KNOWLES, D. J., concurred.

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

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

Decided February 20, 1882.

10 Fed. Rep. 669.

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

*A. V. Briesen, for plaintiff.**J. R. Bennett, for defendants.*

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

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

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

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

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

The answer denies infringement, and sets up various defences to both patents. In taking proofs for final hearing, the counsel for the defendants being present, the plaintiffs put in evidence the two patents and assignments to the plaintiffs, and a “nubia.” The counsel for the defendants admitted, on the record of proofs, that the said nubia was purchased from the defendant firm prior to the commencement of this suit. The plaintiffs then rested their case. The defendants took no testimony. The plaintiffs bring the case now to a final hearing on the foregoing evidence, without introducing any witness to show the identity of design between what is found in said nubia and in the plaintiff’s patents. The defendants contend that it is not sufficient for the plaintiffs to show merely the sale of the nubia by the defendants, and to leave the court to inspect

the nubia and compare it with the patents, but that the plaintiffs must produce a witness to testify to identity of design.

In *Gorham Co. v. White*, 14 Wall. 511, the Supreme Court considered directly the question of identity in regard to a patent for a design. It held that the true test of identity of a design is sameness of appearance—in other words, sameness of effect upon the eye; that it is not necessary that the appearance should be the same to the eye of an expert, and that the test is the eye of an ordinary observer, the eyes of men generally, of observers of ordinary acuteness, bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give. The court compared, in that case, the design of the patent with the designs on the defendants' article, and arrived at the conclusion, from such comparison, that the designs of the defendants were, in their effect as a whole, notwithstanding variances, substantially the same as the design of the patent, and infringements. In addition to this there was the testimony of witnesses on both sides on the question, and the court was of opinion, also, that the testimony proved the infringements.

In view of the proper test of identity, as above given, and of the simple character of the designs in the present case, and of the absence of any testimony on the part of the defendants, I am of opinion that the absence of testimony as to identity does not make it improper for the court in this case to compare the defendants' nubia with the patents, as to design, and determine the question of identity from such comparison. It is not intended to imply that the practice can be extended to any other patent than one for a design, or that it ought to be extended to all patents for designs.

On such comparison it is found that the defendants' nubia infringes both of the patents, and a decree in the usual form in favor of the plaintiffs, with costs, will be entered.

JENNINGS *et al.* v. KIBBE *et al.*
 SAME v. DOLAN *et al.*

Circuit Court, S. D., New York. Decided January 10, 1885.

24 Fed. Rep. 697.

1. Patent No. 10,448, for design for fringed lace fabric. The novelty of the design for the lace fabric in question consists in having a fringe made of a series of stems connected to the fabric and not to each other, "with loops at both sides of a central stem or rib along its entire extent." Held, not infringed by nubias having somewhat similar fringes, but in which the similarity of the whole arises from the body of the nubias and not from the fringe; because the defendants fringe compared separately with that of the patent is easily distinguishable.
2. Same—Lace Purling—Patent No. 218,032—Anticipation. Evidence of want of novelty to be sufficient to defeat a patent, must be convincing beyond a reasonable doubt; otherwise the patent must be held valid.

Antonio Knauth and A. V. Briesen, for plaintiff.

John R. Bennett, for defendant.

WHEELER, J. These suits are brought upon design letters patent No. 10,448, dated February 12, 1878, and granted to Warren P. Jennings for a design for a fringed lace fabric, and letters patent No. 218,032, dated July 29, 1879, and granted to Abraham G. Jennings and Warren P. Jennings for an improvement in lace purling. The design patent had before been adjudged to be valid in this court between the same parties to one of these cases, but upon different infringing articles. *Jennings v. Kibbe*, 20 Blatchf. C. C. 353; S. C. 10 Fed. Rep. 669. The design is for a lace fabric having a fringe made of a series of stems connected to the fabric and not to each other, "with loops at both sides of a central stem or rib along its entire extent," the infringing articles are nubias having such fringes of stems; but the stems have two central ribs, with loops projecting alternately at the sides, and not on both sides along its entire extent. There are so many of these things that the differences are necessarily small, and small differ-

ences make different designs. The patent is not for a design for a nubia, but of a fringed lace fabric, and the novelty of the patented design appertains to the fringe, and not to the rest of the fabric, by the terms of the patent. Nubias with this fringe might appear to be the same as those with the patented fringe, if the fringe should not be observed as such; but observation of that would discover the difference readily. The similarity would arise from the body of the nubias, rather than from the fringe, and as fringed fabrics the designs as to the fringes appear to be different. This patent is not, therefore, infringed by this article.

The novelty of the invention described in the other patent is denied. The anticipation relied upon is a sample in a book of samples of the defendant Dolan, purporting to contain samples of books made and sold before that invention. No article of that manufacture is shown besides the sample, and that is shown to have been put in the book since the invention and since controversy about it. The evidence of the defendants tends to show that the same one was taken out and replaced. The appearance of the book indicates that a sample of different color and size had been in that place. The force of the evidence depends upon the identity of that sample. So much doubt is thrown about it upon the whole proof as to bring it below the degree of certainty requisite to defeat a patent. After repeated examinations serious doubts remain about the production of that article as claimed. The proof should overcome these doubts in order to invalidate the patent, and as it does not, the patent stands as valid.

The infringement seems to be clear, unless the patent is limited to the particular mode of reticulation described. The pillars of the fabric appear to be precisely like those of the patent. The reticulation appears to be in all respects the equivalent of that of the patent. The pillars are really the principal things, and the substance of the invention appears to be taken.

Let there be a decree for the orators accordingly for an injunction and account in each case, without costs, except on the accounting.

WOOD *v.* DOLBY *et al.*

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

Decided April 28, 1881.

7 Fed. Rep. 475.

1. Section 4929, Rev. Stat., provides that a patent may be granted for a *new and original* design; Held, in a suit on design patent No. 11,409, granted for a *new and improved* design (the patent mentioning no prior design), that the term *improved* should be construed to mean a new and distinctive design, and improved as compared with others used; and, in connection with the term new, that it was original with the patentee.
2. The design in question, was for an ornamentation for a finger ring, consisting of the representation of a bird upon a branch or twig, with a leaf above the bird, a panel at the base of the twig of white and gold colors, and a diamond upon the leaf and panel. The evidence showed several pre-existing bird designs; Held, that the design was yet new and original, since none of the alleged anticipations were like it in appearance, either in outline or detail.
3. As the similarity of the defendants design to that of the patent is such that the differences between them (consisting not only of variations from, but additions to, the latter) are not appreciable by observing their artistic effect, such differences in detail become immaterial, and the designs must be considered as substantially identical.
4. The patent is for the appearance which the design adds to the article, making it desirable according to its attractiveness to those observing and wanting it, and it is the right to the exclusive use of this which is secured by it to the patentee.

William Kemble Hall, for plaintiff.

Worth Osgood, for defendants.

WHEELER, D. J. This suit is brought for an alleged infringement of Design Patent No. 11,409, issued to the orator for jewelry settings, expressed in the specification to be for a new and improved design for jewelry settings, consisting of a representation of a bird upon a branch or twig, with a leaf above the bird, and a panel at the base of the twig, in white and gold colors, with a diamond upon

the leaf and two diamonds upon the panel. The defences are that the patent for a new and improved design is not within the statute, Section 4929, which only provides for patents for new and original designs; that this design was known and used by others before the invention or production of it by the plaintiff; and that the defendants do not infringe.

Perhaps, as has been argued for the defendant, the statute was intended to protect such designs only as would be original and distinctive of themselves, and not those which would be mere improvements upon others; but, if so, the word "improved" in this patent is not understood as representing that this design is a mere improvement upon another, especially as no other is mentioned, but is considered to mean that this design is of itself new and distinctive, and improved as compared with others, and in connection with the new, to represent that it was original with the orator. The evidence shows several pre-existing bird designs, and the testimony of several witnesses is that this is only a bird design for such settings, and that therefore it is not new or original. But none of those shown are like this in appearance, either in outline or detail. Upon all the evidence in respect to them, it is not shown at all satisfactorily that settings of this design were either known or used before the the orator produced this.

The defendants have sold rings having a setting of the same outline as that represented in the orator's patent, representing a bird upon a branch or twig, with a leaf above the bird, and a panel, or a larger part of the branch in the shape of a panel, and two leaves, at the base of the twig, in white or silver and gold colors, and a diamond upon the leaf above. There are two other leaves upon the bird in the defendants' setting, The wings of the bird are in a different position from those of the bird in the plaintiff's setting, and the upper leaf is turned differently; but the two leaves below the bird in the defendants' setting are in white or silver color, and somewhat resemble the diamonds upon that part of the plaintiff's; and altogether more is required than to observe and consider the artistic effect of each to

bring these differences to notice. Looked at as ornaments desirable for their beauty or appropriateness, according to the taste of the wearer, these differences in the details become immaterial. The patent is for the appearance which the design will add to articles of jewelry, making them desirable according to its attractiveness to those who may observe and want them; and it is the right to the exclusive use of this which is secured by it to the orator. *Gorham Co. v. White*, 14 Wall. 371. The defendants have not left the orator to his rights, but have infringed upon them by making use of a design which presents substantially the same appearance to that class of persons. For this they must be held liable.

Let a decree be entered for an injunction and an account according to the prayer of the bill, with costs.



MARGOT *v.* SCHNETZER *et al.*

U. S. Circuit Court, District of Massachusetts.

Decided February 5, 1883.

24 O. G. p. 101.

Validity of Design Patent No. 12,775, granted February 21, 1882, to Eugene F. Margot, for a design for a watch case, being questioned for want of novelty, by affidavits produced on the hearing, an injunction *nisi* only granted.

Mr. James E. Maynardier, for the complainant.

Messrs. Avery & Hobbs, for the defendant.

LOWELL, J. This is a motion for a preliminary injunction. The suit is upon Patent No. 12,775, dated February 21, 1882, for a design for watch-cases. The defendants copied the plaintiff's design before it was patented, and without knowing that a patent was to be applied for, and they are ready to stop infringing. The damages must be small, and I should wish to end the case here if that were possible; but a serious doubt is raised as to the novelty of the design, by the affidavit of one Smith, and by the admissions of the plaintiff in his affidavit in reply to Smith, so that I think an injunction *nisi* is all that I ought to grant. Injunction *nisi*.

WERNER v. REINHARDT, *et al.*

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

Decided September 29, 1881.

10 Fed. Rep. 676.

1. A design patent claim for trimming, produced by embossing on fluting machinery, is a claim for the resultant appearance produced thereby.
2. The claim covers the leading and distinguishing features of the design; and these being found in the trimming made by defendant, the charge of infringement is made out.

Arthur V. Briesen, for orator.

Jacob L. Hanes, for defendants.

WHEELER, D. J. This suit is brought for relief against infringement of design letters patent No. 11,186, granted to the orator on application made March 19, 1879, for a design for trimming, produced by embossing on fluting machinery, dated May 6, 1879. The orator makes and sells trimming according to his patented design, as he claims it to be, and the defendants admit having made the same thing; but they set up in defence that the patent does not cover that design; that the orator was not the original and first producer of the design which it does cover; and that so much of the design as they have made use of had been in public use and on sale, with the consent and allowance of the orator, for more than two years prior to his application for the patent.

The impression created at the hearing was that the defendants had not, in view of all the evidence on both sides, sustained either of the last two defences by the requisite measure of proof. A careful review of all the evidence confirms that impression. The specification and drawings of the patent, taken all together, show a row of embossed, smooth, oblong and half-cylindrical projections between and parallel with two rows of ordinary fluting, which are the prominent and original features of the design, and are what the orator's trimming, made under the patent, show. This

design is what he invented. It proved attractive, and his patent conferred upon him the exclusive right to impress that appearance upon trimmings. The defendants appear to have infringed upon that right.

Therefore, there must be a decree for an injunction and an account, according to the prayer of the bill, with costs.

DRYFOOS *et al.* v. FRIEDMAN *et al.*

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

Decided January 4, 1884.

18 Fed. Rep. 825.

1. Desigr. Letters Patent No. 4,802, dated April 11, 1871, and granted to William H. Walton for a design for printed material for gored skirts, consisting of printing a series of gore-shaped patterns, made to match around the lower edge in a skirt, the narrow end opposite the broad end of another, on a piece of woven fabric, so as to fill the width of the fabric, leaving blank spaces for seams, with dotted lines in the blank spaces by which to divide the fabric into parts, leaving each a pattern of proper shape to be sewed together into a full skirt, are not infringed by the gore-shaped patterns printed according to the patent, but already divided, ready to be sewed together into skirts, or by cutting skirt fabrics printed with gore-shaped patterns, the wide ends of which are placed alternately opposite the narrow ends, filling the width of the fabric, but without blank spaces for seams or lines or marks by which to divide them other than the outlines of the patterns.
2. The differences in designs necessary to take away their identity in law are such appearances as would attract the attention of an ordinary observer, giving such attention as a purchaser of the articles in question, for the purposes for which they were intended and purchased, would usually give.
3. There may be an infringement of a patented design without taking the whole of it, but in such cases the part taken must be a part covered by the patent.

Edmund Wetmore, for orators.

Roderick Robertson, for defendants.