

WHEELER, J. The orators' own design Letters Patent, No. 4,802, dated April 11, 1871, and granted to William H. Walton for a design for printed material for gored skirts, consisting of printing a series of gore-shaped patterns, made to match around the lower edge in a skirt, the narrow end of one opposite the broad end of another, on a piece of woven fabric, so as to fill the width of the fabric, leaving blank spaces for seams, with dotted lines in the blank spaces by which to divide the fabric into parts having each a pattern of proper shape to be sewed together into a full skirt. The claim is for the "shape or configuration of a series of patterns for gored skirts printed upon a piece" of fabric, as shown and described. This suit is brought for relief against infringement. The answer does not deny the validity of the patent, but denies infringement by the defendants or either of them. The proof shows that the defendant, Abraham I. Friedman, sold a lot of gore-shaped patterns printed according to the patent, but already divided, ready to be sewed together into skirts, to a person sent to purchase them for the orators, and that he has cut up skirt fabrics printed with gore-shaped patterns, the wide ends of which were placed alternately opposite the narrow ends, as specified in the patent, filling the width of the fabric, but without blank spaces for seams or lines or marks by which to divide them, other than the outlines of the patterns. There is no proof whatever that the defendant, Daniel F. Friedman, has in any way done anything himself that is claimed to be an infringement, or that he has been in any way connected with Abraham I. Friedman in what he has done that is claimed to be an infringement. The invention would seem to have been better adapted to a patent for a manufacture than to one for a design. *Clark v. Bousfield*, 10 Wall, 133. But as a design patent was asked for and granted, and is not attacked, it must stand good for what it will probably cover. The sale procured by and to another for the orators, would not of itself probably be an unlawful infringement of which they could justly complain; yet, when made in the usual course of business, as of goods kept for sale, it might be evidence of sales of similar goods to others. Still, as the patent is not for the design of the patterns separately or united in a skirt at all, but only for the design of the series of patterns

as printed on the piece of fabric, it is not easy to see how the sale of the patterns divided could be an infringement of that patent. The design patented would not be there in that sale, and might not have been present in any use by that seller. When the piece of fabric was separated, and the patented design gone, there would not seem to be any infringement by a subsequent user or seller of the parts who was innocent before. But the cutting up of the fabric would undoubtedly be an unlawful use, if the fabric cut up was an infringement. The only evidence that Abraham I. Friedman cut up such fabric comes from his own cross-examination as a witness for the orators. In testifying to what he so used, he states that it is the same as used by him in 1868. If this is taken to be true, as the rest is, the patent, about which nothing prior to its grant is shown, could properly cover nothing but the improvement upon this, which would be merely the blank spaces for seams and the lines in these spaces by which to divide the patterns. As this defendant does not use these spaces nor lines, in this view, he would not infringe. Further, the prior printing of patterns upon woven fabrics for cutting apart and making up is well shown by other evidence. The patent could properly cover the improvements upon such, if this defendant's testimony as to what he had done before should be laid aside. As this patent, as before mentioned, does not cover the patterns, the improvements would consist in the design of the arrangement of them on the fabric, advantageously to be divided, for the fabric was not intended for use whole, but only by cutting the patterns apart. The spaces for seams, and lines in them to divide by, were prominent and important. The appearance of the pieces of fabric with and without these spaces and lines might be so nearly the same that the difference would not attract the attention of a disinterested observer, but it would at once be noticeable to ordinary purchasers or users of such material. The differences in designs necessary to take away their identity in law are understood to be such appearances as would attract the attention of an ordinary observer, giving such attention as a purchaser usually gives. *Gorham Co. v. White*, 14 Wall. 511. This, of course, means purchasers of the articles in question for the purposes for which they

were intended and are purchased. A purchaser of these fabrics would, ordinarily, be a person intending to cut them up and make them into skirts or sell them to others to make into skirts. A purchaser of ordinary observation, with that intention, would notice at once these prominent facilities for accomplishing those purposes. To such a person the design patented and that used by the defendant would be quite different. As argued for the orator, there doubtless might be an infringement of a patented design without taking the whole of it, but in such cases the part taken must be a part covered by the patent. *Richardson v. Miller*, 12 O. G. 3; *Wood v. Dolby*, 7 Fed. Rep. 475. The orators do not appear to have shown that the defendants or either of them infringe.

Let there be a decree that the defendants do not infringe and that the bill for that cause be dismissed, with costs.



## TOMKINSON *v.* WILLETS MANUFACTURING CO.

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

Decided March 7, 1884.

23 Fed. Rep. 895.

1. In a previous suit in another district (not reported), between the same parties on the same design patent, but in respect to a different infringing article, there was a final decree in the usual form, entered by consent, without defence: Held, that all questions on the second suit, except infringement, were *res judicata*, and not open for reconsideration.
2. Suit was on a design patent for a vegetable dish, which covered configuration only. Held proper to apply the rule of *Gorham v. White*, 14 Wall., to determine identity.
3. It is not necessary that a design patent should be copied in every particular to constitute an infringement. It is sufficient if the resemblance is such that an ordinary purchaser would be deceived, although the infringer has deviated slightly in details, or has either added or omitted something which an expert could discover, and this whether it be a patent for configuration or for surface ornamentation.

*Frank V. Briesen, for complainant.*

*Philo Chase, for defendant.*

Cox, J. This is an equity action for infringement, founded upon design patent No 13259, granted to John Slater, assignor to Gildea and Walker, September 12, 1882, for a design for a vegetable dish. The patent is now owned by the complainant. The invention relates to a new shape or configuration for a vegetable dish or other similar household article of china. The claims are as follows:

(1) The design for a rectangular vegetable dish, having upper straight section c, central curved section d, and lower straight section e, substantially as shown. (2) The design for a rectangular vegetable dish, having straight top and a section, d, curved first outward and then inward, in such a manner that the base of the dish is smaller than its top, substantially as shown. (3) The design for a vegetable dish, having parallel sides, a, a', and parallel sides, b, b', and composed of the sections, c, d, e, substantially as shown.

It will be observed that as to the handles, ornamentation, size and color of the dish, nothing is said in the claims. They are for the shape only.

In June, 1883, prior to this suit, the complainant commenced an action in the United States Circuit Court, district of New Jersey, against the defendant for an infringement of this patent. The complaint was in all respects similar to the one in the present suit. The defendant appeared by its president and consented to a decree and an injunction as prayed for. On or about the twenty-first of July, 1883, a final decree was entered, by which it was determined that the complainant is the sole owner of the letters patent in suit, and that they are good and valid in law. That decree was pleaded and proved in this action; it is valid and binding upon the rights of the parties, and, as to all the questions determined, by it, is *res judicata*. Unfortunately, perhaps, for the defendant, the court is not now permitted to consider the defenses, which, by the defendant's own action, are thus eliminated from the case. The question of infringement is alone open to investigation.

In approaching this subject, the rule with reference to design patents should be kept steadily in view. It is by no

means necessary that the patented thing should be copied in every particular. If the infringing design has the same general appearance, if the variations are slight, if to the eye of an ordinary person the two are substantially similar, it is enough. It is of no consequence that persons skilled in the art are able to detect differences. Those who have devoted time and study to the subject, who have spent their lives in dealing in articles similar to those in controversy, may see at a glance features which are wholly unimportant, and unobserved by those whose pursuits are in other directions, and who are attracted only by general appearances. If the resemblance is such that a purchaser would be deceived, it will not aid the infringer to show that he has deviated slightly from a straight line in one place and from a curved line in another, or that he has added or omitted something which an expert can discover. *Gorham Co. v. White*, 14 Wall, 511; *Lehnbeuter v. Holt-haus*, 105 U. S. 94; *Wood v. Dolby*, 19 Blatchf. 214; S. C. 7 Fed. Rep. 476; *Sim. Pat.* 218; *Walk. Pat.*, Sec. 375. Tested by this rule, I am constrained to say that the defendant infringes.

The principal difference pointed out between the two dishes in controversy is that in the upper vertical section of defendant's dish the sides are not exactly parallel, but bulge outwardly, departing from a straight line something less than half an inch. It is thought, however, that this divergence is not sufficiently marked to arrest the attention of the average observer. Bearing in mind that the patent deals with shape alone, the same conclusion must be reached with reference to the other differences suggested by the defendant's witnesses.

There should be a decree for the complainant.

## CHAPTER VI.

*Of remedies for infringement. Injunction. Profits and Damages.*

SECTION 1. It has not been usual practice in patent causes to set out at length in the bill of complaint, or other initial pleading, any description of the invention for which the patent sued on was granted, nor to annex such as an exhibit to the pleading, nor to do more than make general profert of it. Unless one or the other of these courses be adopted, the pleading will be held defective on demurrer.<sup>1</sup> And whichever of these be adopted, the court will on demurrer to the sufficiency in law of the cause of action thus disclosed, consider and pass upon the patentability of the invention as appearing upon the face of the patent.<sup>2</sup>

SECT. 2. A bill in equity for injunction and account is not open to the objection of multifariousness merely because it charges infringement of two patents, one for a design and the other for mechanism, if it avers a conjoint use of both inventions in a single article made, used, or sold by the defendant. And this, though the two grants are of a different nature, authorized by different statutes, and for different terms, and tested as to novelty and infringement by wholly different principles. Ample precedent, however, is found for the practice.<sup>3</sup> Though if one of the patents be defeated, or be found not to have been infringed, the bill being sustained as to the other, no costs up to interlocutory decree should be allowed to the complainant.<sup>4</sup>

SECT. 3. As designs differ from mechanical inventions in being generally subjects of evanescent fancy rather than of lasting utility, and as the terms for which such patents

<sup>1</sup> Post v. Richards Hardware Company, 25 Fed. Rep. 905.

<sup>2</sup> Post v. Richards Hardware Company, 26 Fed. Rep. 618. See also Eclipse Manufacturing Co. v. Adkins, 36 Fed. Rep. 554, and Western Electric Company v. Odell, 18 Fed. Rep. 321.

<sup>3</sup> Theberath v. Rubber, &c. Co. 3 Fed. Rep. 151; Wilson Packing Company vs. Clapp, 13 O. G. 368; Adams &c. Co. v. St Louis &c. Co. 12 O. G. 940.

<sup>4</sup> Jennings v. Kibbe, 24 Fed. Rep. 697.

are issued are shorter than for those of the other class of inventions, the general requirement that the validity of the patent should have been acquiesced in by the public or been judicially sustained, before granting a preliminary injunction, in a clear case of infringement, should be very much relaxed in such cases, to prevent injustice. Indeed, in one or more reported design cases, preliminary injunctions or restraining orders have been granted, where the patent was of very recent issue, and had not been previously litigated, and even where the novelty of the invention was questioned;<sup>1</sup> and such should also be the rule even where the fact of infringement, as respects identity of design, is, though sufficiently clear after careful comparison, at least debatable in the first instance; because the best and only positive evidence under that issue, must be produced at the original or preliminary hearing, viz., the articles bearing the designs in question.<sup>2</sup>

SECT. 4. There are but five reported cases on design patents, involving the question of the measure of profits and damages; three of these were decided on circuit,<sup>3</sup> and two in the Supreme Court.<sup>4</sup> Both of the latter, and one of the former, which was reversed in one of said Supreme Court decisions, were founded on patents for surface ornamentation exclusively. Of the other two cases mentioned, the one that was decided prior to the Supreme Court decisions referred to, was founded on claims for a design which consisted of both shape or configuration and surface ornamentation; while the other, decided afterwards and very recently, was founded on claims for form or configuration exclusively. The proper measure of damages may therefore be considered to be tolerably well settled, as respects both subject matters of design patents, certainly conclusively as to patents for surface ornamentation.

SECT. 5. Referring to these cases in the order of the dates of their decision, it was held in the first of these cases decided on circuit, viz., *Bigelow Carpet Co. v. Dobson*,

---

<sup>1</sup> *Foster v. Crossin*, 28 Fed. Rep. 400; and *Margot v. Schnetzer*, 24 O. G. 101. And see *Miller v. Smith*, 5 Fed. Rep. 359; and *Lehnbeuter v. Holthaus*, 105 U. S. 94.

<sup>2</sup> See *Jennings v. Kibbe*, 10 Fed. Rep. 669; and *Wood v. Dolby*, 7 Fed. Rep. 475.

<sup>3</sup> *Bigelow Carpet Co. v. Dobson*, 10 Fed. Rep. 385; *Simpson v. Davis*, 22 Fed. Rep. 444; *Tomkinson v. Willets*, 34 Fed. Rep. 536.

<sup>4</sup> *Dobson v. Bigelow and Hartford Carpet Cos.*, 114 U. S. 439; *Dobson v. Dornan*, 118 U. S. 10.

decided January 27, 1882, that the patentee's *damages* were to be estimated upon and measured by the *profit* it was shown that he would have realized upon a like quantity of the infringing carpets bearing the patented design, had he made and sold the same. There were other questions involved in the decision, but the case turned upon the point stated.

In the second case, decided on circuit, viz., *Simpson v. Davis*, decided April 2, 1884, in which the claim infringed was for a design for a newel post, consisting both of the form and the surface ornamentation thereof, the court measured the defendants *profits to be accounted for* on the basis that having ascertained the cost price, the selling price, and the average manufacturers' profit, held that the remainder of the price realized from the sale of the newels of the plaintiffs' design, after deducting the cost of making the newels, and a fair profit for their manufacture, must be presumed to represent the profit realized by the defendant from his adoption of the plaintiffs' design.

In the third case, decided on circuit, viz., *Tomkinson v. Willets*, decided March 26, 1888 (after the rule of profits and damages had been settled in the carpet cases decided in the Supreme Court). the court refused to allow manufacturer's profits actually or presumably derived from the sale of the square-shaped dishes of the peculiar form or configuration patented, holding that the burden was on the patentee to separate from the whole profit the part or proportion fairly attributable to the design, and that inability to do so, whether from the nature of the subject matter or otherwise, would not justify an allowance not based upon such evidence.

SECT 6. The first of the cases decided by the Supreme Court<sup>1</sup> did not establish any new measure of profits and damages, for infringement of design patents; but merely applied the rule previously laid down by the court in a series of decisions on functional patents, as to what are to be regarded as "profits to be accounted for by the defendant," and what as "actual damages." Courts of equity were first authorized by the law of July 8, 1870, since incorporated into Section 4921, Rev. Stat., to award damages to a complainant in a bill for infringement of a patent,

<sup>1</sup> *Dobson v. Hartford & Bigelow Carpet Cos.* 114 U. S. 439.



in addition to the profits made and received by the defendant from the infringement; and this was defined by the Supreme Court in *Root v. Railway Co.*<sup>1</sup> to mean that while damages may be allowed in addition to the profits accounted for, yet as the former are limited by the statute to actual damages, it is manifest that the recovery of damages and profits is not intended to be double, but that when necessary the damages are to supplement that loss of the complainant which the profits found to have been received are insufficient to compensate.

SECT. 7. Profits are the actual gains made and received by the defendant from the unlicensed use of the patented invention; while the complainant's damages are the actual<sup>2</sup> losses which he sustained in not being permitted to enjoy the exclusive rights conferred by the patent, by reason of defendant's unlawful interference with his enjoyment of such rights. By force of the statute these provisions of the general law are applicable to designs.<sup>3</sup> In applying these principles in suits for infringement of patents in general, the Supreme Court has had occasion in a long line of decisions to define what are to be regarded as "profits to be accounted for by the defendant" and what as "actual damages," and no rule has been sanctioned which will allow in the case of a patent for an ornamental design to be painted, woven, cast, or otherwise placed on or worked into any article of manufacture which possesses intrinsic value apart from the design, the entire profit from the manufacture and sale of the finished article, as either profits or damages, including all the profits from the manufacture of the article itself, thus regarding all the profits as due to the design impressed thereon.<sup>4</sup>

SECT. 8. Illustrations of the range of subjects to which this rule is applicable are found in designs for carpets, oil cloths, wall paper, window shades, curtains, fringe fabrics, watch cases, stove ornaments, and all other designs consisting of surface ornamentation to be printed, painted, cast, or otherwise placed on or worked into any article of manu-

---

<sup>1</sup> 105 U. S. Repts. 189-212.

<sup>2</sup> See 4919 Rev. Stat.; *Seymour v. McCormick*, 16 How. 480; *Root v. Railway*, 105 U. S. 189, 212.

<sup>3</sup> See 4938 Rev. Stat.; *Dobson v. Carpet Co.* 114 U. S. 432, 443.

<sup>4</sup> *Dobson v. Hartford Carpet Co.* 114 U. S. 439; *Dobson v. Dornan*, 118 U. S. 10.

facture which has an inherent value apart from the design or pattern placed upon, and which forms a part of it. The true rule of damages in such cases, as declared by the Supreme Court,<sup>1</sup> is that to entitle the plaintiff to recover anything beyond nominal damages the evidence offered must separate or apportion the defendant's profits and the patentee's damages between the patented feature and the unpatented features, of the whole article, and such evidence must be reliable and tangible, and not conjectural or speculative. There is, however, an exception to the rule, furnished by the previous decision in *Manufacturing Company v. Cowing*,<sup>2</sup> to the effect that if, by equally reliable and satisfactory evidence, it can be shown that the entire value of the completed article, as a marketable article, can be properly and legally attributed to the patented feature, that the patentee should in such case be entitled to the whole profit.

SECT. 9. The reason for the rule stated is quite apparent, as pointed out by the appellate court in its decision. As the design is merely the surface ornamentation, to be placed upon an article of manufacture, there is a legal presumption that the article itself must, to obtain a market, possess intrinsic merits of quality and structure which give value, to some extent at least, to the completed whole; and to attribute in law the entire profit to the design, which at most appeals only to the taste, is often a matter of evanescent caprice, and rarely adds to the market value of the article upon which it is impressed, would be an illogical deduction, as well in fact as in law, of cause from effect; besides being a violation of the statutory rule permitting only actual profits and damages to be accounted for and assessed. Additional reason for the rule is to be found in the fact that as a completed article may be at the same time the subject matter as well of a mechanical patent as of a design patent, the whole profit may as well, on principle, be attributed to the mechanical features as to the ornamental design.

SECT. 10. The rule stated for the ascertainment of profits and damages for infringement of design patents, was enun-

---

<sup>1</sup> *Dobson v. Hartford Carpet Co.* 114 U. S. 439, 445.

<sup>2</sup> *Manufacturing Co. v. Cowing*, 105 U. S. 253.

ciated by the Supreme Court in a case<sup>1</sup> which arose upon a patent for a carpet design: that is, for a design for surface ornamentation, and which is the class of designs included in the second descriptive clause of Section 4929 of the Revised Statutes, which from its language, as compared with the first and third descriptive clauses of the section, would clearly seem to include only such designs as consisted of surface ornamentation exclusively, and applicable to *known* articles of manufacture, which possess intrinsic merits of quality and structure apart from the particular or any other design which may be impressed upon them or with which they may be so ornamented. The first clause of said Section 4929 would in like manner seem to apply also to surface ornamentation only, but applicable to *original* articles of manufacture, mainly articles of virtue, and in which the design itself is the chief feature, the material upon which it is impressed having no intrinsic merits of quality or structure; such as a bust, statue, alto-relievo, or bas-relief; the original clay, metal, or marble not being a "manufacture," and the design itself being the artistic manufacture impressed upon the original, natural, and rough material, which has little or no intrinsic value, is not marketable as a complete article apart from the design, and the latter having the effect of completely changing its whole character, quality, structure, merit, and value. While the third descriptive clause of said Section 4929 would, by the same reasoning and by force of its language, clearly apply exclusively to designs of shape, form, or configuration, of which the material or thing to which the design is applied must be a *known* article of manufacture, having intrinsic utility, and therefore necessarily intrinsic value, and be a technical "manufacture."

SECT. 11. In a leading early case on the measure of damages for infringement of mechanical patents—*Seymour v. McCormick*<sup>1</sup>—the Supreme Court, speaking by Mr. Justice GRIER, said, "it must be apparent to the most superficial observer of the immense variety of patents issued every day, that there cannot, in the nature of things, be any one rule of damages which will equally apply to all cases. The

<sup>1</sup> *Dobson v. Hartford Carpet Co.*, 114 U. S. 439. Approved in *Dobson v. Dornan*, 118 U. S. 10.

<sup>2</sup> 16 How. 480

mode of ascertaining damages must necessarily depend on the peculiar nature of the monopoly granted." The force of these remarks, in connection with the variety and wholly different character of articles to which the design law is applicable, as pointed out in the preceding sections, will be readily appreciated. The Supreme Court, speaking by Mr. Justice Blatchford, in the first of the carpet cases,<sup>1</sup> made use of the remark, that "a design or "pattern in ornamentation or *shape* appeals only to the taste "through the eye, and is often a matter of evanescent "caprice. The article which embodies it is not necessarily "or generally any more serviceable or durable than an ar- "ticle for the same use having a different design or pattern. "Approval of the particular design or pattern may very "well be one motive for purchasing the article containing "it, but the article must have intrinsic merits of quality and "structure to obtain a purchaser, aside from the pattern or "design." While this sentence includes the word "shape," meaning form or configuration, its whole tenor would seem to exclude from its meaning those articles included in the first clause of Section 4929, Rev. Stat., in which the design itself is the manufacture, and the original rough material on which it is impressed is of little or no intrinsic value; and to include only the subjects comprised within the second and third clauses of the section, viz: designs both of surface ornamentation and configuration, or either, and applied to known articles of manufacture possessing intrinsic value and merits of quality and structure, apart from the design, and not affected as a marketable article by the fact of the application to it of any particular design.

SECT. 12. In the second of the carpet cases,<sup>2</sup> the court said, "the value imparted to the carpet by the design" is the real profit realized by the defendant and lost to the plaintiff by the infringement; but remarked in the first of these cases,<sup>3</sup> that it is equally true that the plaintiff may be entitled to the entire profit on the article as well as the design, if he can show that the entire value of the whole as a marketable article is properly and legally attributable

---

<sup>1</sup> 1 Dobson v. Hartford Carpet Co., 114 U. S. 439, 445.

<sup>2</sup> Dobson v. Dornan, 118 U. S. 10, 17.

<sup>3</sup> Dobson v. Hartford Carpet Co., 114 U. S. 439, 445.

to the design. This would be an exception to the rule, not likened so much to *Mnfg. Co. v. Cowing*,<sup>1</sup> which became an exception because of the locality of the sales as well as of the peculiar subject matter applicable to such locality, but because solely of the subject matter, for instance, a bust, statue, &c., or a carpet of particular pattern where the evidence showed a special and particularized demand for the carpet of that pattern, if made by the patentee, and the sales of which he lost directly by the infringement. *Mnfg. Co. v. Cowing* was founded in part, if not mainly, on the rule previously stated in *Mowry v. Whitney*,<sup>2</sup> that the plaintiff is entitled to recover the money value of the advantage which the defendant derived from using the complainant's invention over what he would have had in using other processes then open to the public, and adequate to enable him to obtain an equally beneficial result. "It does not necessarily follow from this," the court remarked, in *Mnfg. Co. v. Cowing*, after quoting the above rule from *Mowry v. Whitney*, "that where the patent is for one of the constituent parts, and not for the whole of the machine, the profits are to be confined to what can be made by the manufacture and sale of the patented part separately. \* \* \* If the improvement is required to adapt the machine to particular use, and there is no other way open to the public of supplying the demand for that use, then it is clear the infringer has, by his infringement, secured the advantage of a market he would not otherwise have had, and that the fruits of this advantage are the entire profits he has made in that market." Such may be the case frequently under the peculiar and possible circumstances previously above mentioned, in case of a particularized and special demand for a known and intrinsically valuable article bearing a particular design; or in case where the design was in itself the manufacture from original rough material possessing in itself no intrinsic value or merit of quality or structure, and having no salability for such purposes until impressed with the design, and this whether the latter be of ornamentation or of configuration.

SECT. 13. It will readily be seen therefore that a class of

<sup>1</sup> 105 U. S. 253.

<sup>2</sup> 14 Wall. 269.

cases may arise, under the design patent statute, in which the rule of damages applied in *Dobson v. Carpet Co.*, is not at all applicable, namely, that class included within the first descriptive clause of Section 4929 Rev. Stat., which comprises any new and original design for a bust, statue, alto relieve or bas relief, and the like, in which the design is impressed, not upon any article of manufacture, either known or original, but is the article itself, the material to which it gives form being comparatively of little or no intrinsic value, and undergoing an entire change both in character, utility, and value in the process. In such case it could not be open to doubt that the proper measure of damages would be the entire profit on the manufacture and sale of the article in question.

SECT. 14. In considering the practical application of the rule of damages proper to be applied in cases falling within the second and third descriptive clauses of the design statute, not only as respects designs consisting solely of surface ornamentation, or of shape or configuration, or of both together in one unitary design, these finding expression in the ornamentation of known articles of manufacture of intrinsic value *per se*, and possessing merits of quality and structure apart from the particular design or any design, it must be apparent to the most superficial thinker that rarely will it be possible to separate from the whole profit on the completed article, that portion thereof due to the design, from that remaining portion due to the article itself; because it is not alone the market value but the salability of the original article that is changed by the impression thereon of the design, and as to the latter it is a matter of taste, of evanescent caprice in the purchaser, and has no value in the abstract, nor until it is applied to the appropriate article for which it was created. It is not intended hereby to question the correctness of the rule of damages as applied by the appellate court in the carpet cases; on the contrary, it is the only sound rule that meets the exigencies of the subject; but to point out the difficulty of its application to certain classes of designs included within the statute authorizing the grant of patents for such productions.

SECT. 15. To meet this difficulty, which in some cases and under some circumstances would be absolutely insur-

mountable and leave the injured party without any compensatory remedy, the Congress, after the announcement of the decision in the last of the carpet cases, enacted a statute<sup>1</sup> which provides that for infringement of any design patent by any manufacturer of an article to which the design or any colorable imitation thereof has been applied by him, for the purpose of sale, without the license of the patentee; or by the sale by any person of such an article with knowledge, or after notice, that the said design had been so used without the consent of the owner of the patent, either or both of such persons so offending shall be liable at the suit of the patentee, to his own use, to pay a penalty of two hundred and fifty dollars, which recovery shall not be a bar to an action at law or in equity for the actual damages suffered, or for profits derived from the same act infringement, in excess of such penal sum; and also preserving, of course, the usual remedy by injunction to prevent further infringement.

SECT. 16. This legislation is in line with the English statutes on the subject, the first of which, enacted in 1839, imposed a penalty of from five to twenty pounds sterling at the discretion of the court; and this remedy was supplementary to that provided by previous laws, viz: by injunction in equity and by an action on the case for damages; and in this connection it is interesting to note that in a committee report to Parliament, in 1839, on the subject of amending the laws respecting protection for copyright in designs, it is stated that the records of the courts contained but one case in the previous fifty years brought at law for the recovery of damages for such infringement. The existing law in England, after which our own is modeled, was enacted August 25, 1883,<sup>2</sup> and is contained at large in a

---

<sup>1</sup> Act of Feb. 4, 1887, 24 Stat. at Large, 387. See statute in full, foot-note to page 6 of this volume.

<sup>2</sup> 46 and 47 Vict. c. 57, Sect. 58. It shall not be lawful for any person without the license or written consent of the registered proprietor, to apply such design or any fraudulent or obvious imitations thereof in the class or classes of goods in which such design is registered, for purposes of sale, to any article of manufacture or to any substance, artificial or natural, or partly artificial and partly natural; and, it shall not be lawful for any person to publish or expose for sale any article of manufacture or any substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, knowing the same has been so applied without the consent of the registered proprietor. Any person who acts in contravention of this section shall be liable for every offence to forfeit a sum not exceeding fifty pounds to the registered proprietor of the design, who may recover such sum as a simple contract debt by action in any court of

foot note, it being so similar thereto that decisions under it may become useful precedents, or at least guides, in the interpretation of our own, as the English decision on identity of designs<sup>1</sup> afforded an outline for, and was followed in our own leading case—*Gorham v. White*—on that branch of the subject.

SECT. 17. Practice under this statute, thus very recently enacted by Congress, has not yet been established, but it would seem plain that the arbitrary amount named is in the nature of a penalty and not to be awarded as *damages* in cases where from want or failure of proof of actual damages, nominal damages could only otherwise have been awarded. And it would also seem free from doubt that in case the plaintiff should offer such proof of actual damages or profits as would warrant a verdict of a jury or a finding of a master, for a sum exceeding two hundred and fifty dollars, that the penalty could not be added or given also in addition thereto, and hence that the statute would have no operation in such a case. And finally, that the act is only aimed against the manufacturer, and against the dealer with guilty knowledge; and in either case that the penalty is not to be inflicted for each infringing article made or sold, but only for each continuous act of infringement, although clearly the penalty may be recovered against both manufacturer and dealer for the same infringement, or rather for the unlawful manufacture and sale of the same or identical article bearing the patented design.

SECT. 18. With respect to costs on an accounting before a master, it is but simple justice that if the plaintiff recover no more than nominal damages, or no more than the penalty provided by the act of February 4, 1887, the costs of the reference should be ordered to be paid by the plaintiff and not by the defendant. Such, at least, is the fair inference to be drawn from the decisions and decretal orders of the Supreme Court in the carpet cases herein before referred

---

competent jurisdiction. Sect. 59. Notwithstanding the remedy given by this act for the recovery of such penalty as aforesaid, the registered proprietor of any design may (if he elects to do so) bring an action for the recovery of any damages arising from the application of any such design, or any fraudulent or obvious imitation thereof, for the purpose of sale, to any article of manufacture or substance, or for the publication, sale or exposure for sale by any person of any article or substance to which such design or any fraudulent or obvious imitation thereof shall have been so applied, such person knowing that the proprietor has not given his consent to such application.

<sup>1</sup> *McCrea v. Holdsworth*, L. R. 6 Ch. 418.



to.<sup>1</sup> And this whether such nominal damages be awarded by the master's report, or by the court on exceptions thereto, or by the appellate court on appeal.

---

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

---

POST *et al.* v. RICHARDS HARDWARE CO.

U. S. Circuit Court, District of Connecticut.

Decided December 8, 1885.

25 Fed. Rep. 905.

The bill contained an averment that the patentee invented "a new and original design for a curtain and loop," and that letters patent, of a specified date and number, were granted thereon. No other description of the invention was given, nor any reference made to the patent for a further description. Held on demurrer that the invention was not sufficiently described in the bill.

It is essential to the sufficiency of a bill in equity for an injunction against the infringement of letters patent for an invention that the pleading should contain such a description of the invention as patented, as will apprise the court of its nature and character, and the particulars in which the improvement consists.

This may be done by a full and accurate description in the pleader's own language, care being taken not to depart from the legal effect of the language of the patent; or by employing the language of the specification, or by a reference to and proferment of the patent. The last named course is the usual and most convenient one.

*William Edgar Simonds, for plaintiff.*

*Frank L. Hungerford, for defendant.*

SHIPMAN, J. This is a demurrer to a bill in equity for an injunction against the alleged infringement of a design

---

<sup>1</sup> Dobson v. Hartford Carpet Co., 114 U. S. 439; Dobson v. Dornan, 118 U. S. 10.

patent. The bill alleges that the inventor invented "a new and original design for a curtain and loop," and that letters patent therefor, of a specified number and date, were granted and delivered to the inventor. The usual averments are made in regard to the execution of the letters patent. No other description of the invention is given, and no reference is made to the patent for a further description. The ground of the demurrer is that the bill "does not set out the nature, character, or description of the pretended patented design referred to in said bill, nor the letters patent alleged to have been obtained therefor, nor make any profert of the same."

It is necessary that a bill in equity for an injunction against the infringement of letters patent for an invention should contain such a description of the invention as patented, as will apprise the court of its nature and character, and the particulars in which the improvement consists. This may be done by a full and accurate description in the pleader's own language, care being taken not to depart from the legal effect of the language of the patent, or by employing the language of the specification, or by a reference to and profert of the patent. The last-named course is the usual and most convenient one. The bare averment that the design was "a design for a curtain and loop" is not sufficient.

The demurrer is allowed, with leave to amend.

—o—

### SIMPSON *v.* DAVIS.

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

Decided April 2, 1884.

22 Fed. Rep. 444.

1. Defendant having been adjudged by the interlocutory decree to have infringed the plaintiff's patent for design for newel posts, the master found that he had sold 101 newels, which embodied the patented design, at \$7 each; that they cost \$5 each to make, and that a fair manufacturer's profit on each was ten per cent. Held that the profit to be accounted for on such newels, was the whole profit as thus ascertained, or \$151.50.

2. Proof that defendant sold other newels of a design not patented at the same price, did not dispel the presumption that the amount realized by him above the cost of manufacture and the manufacturer's profit, was the profit realized by him from the adoption of the patented design.
3. Held further, that under Section 4,919 of the Revised Statutes, as construed by the Supreme Court in *Birdsall v. Coolidge*, 93 U. S. 64, in cases where the defendant's profits do not amount to as much as the plaintiff's damages, the court may add to the amount to supply the deficiency, and that in this case it must be decreed that the plaintiff do recover of defendant, in addition to the \$151.50, as much more, making the recovery \$303, that sum being proved to be the plaintiff's damages.

*Edwin H. Brown and Arthur Murphy, for plaintiff.*

*M. H. Clement, for defendant.*

BENEDICT, J. This case comes before the court upon the Master's report of the plaintiff's damages and the defendant's profits, arising out of an infringement by the defendant of the plaintiff's patent for a design for newel posts. The first exception is well taken. The proof is that the defendant sold 101 newel posts of the design covered by the plaintiff's patent, instead of 119 as reported by the Master. The second exception is not well taken. The proof is that 101 newels made and sold by the defendant embodied the design secured to the plaintiffs by their patent. The third exception is not well taken. The proof shows that the defendant made 101 newel posts similar to the plaintiff's newel posts. The cost of making these posts is shown by a stipulation made between the parties to be \$5 each. The testimony shows that ten per cent. is the fair manufacturer's profit on the construction of such an article. The defendant sold the newels so made by him for \$7 each. His profit, therefore, for the use of the plaintiff's design is \$151.50. It is contended by the defendants that the proofs show that at the time he was selling newels of the plaintiff's design he was also selling newels of other designs not patented, from which sales he realized as much as he did from the sales of the plaintiff's newels, and therefore it is said no profit accrued to the defendant from the use of the plaintiff's

design. But the remainder of the price realized from the sale of newels of the plaintiff's design, after deducting the cost of making the newels, and a fair profit for their manufacture, must be presumed to represent the profit realized by the defendant from his adoption of the plaintiff's design, in the construction of the newels sold by him. And this presumption is not dispelled by proving that the defendant realized the same profit from adopting, in the manufacture of other newels sold by him, a different and unpatented design. The fact that a certain profit is realized from the adoption of the design of A does not show that no profit is realized from the adoption of the design of B. The fourth exception raises the question whether the plaintiffs can, by virtue of Section 4,919, Rev. Stat., recover damages resulting from the defendant's infringement of their patent in addition to the profits realized by the defendant. Doubts appear to have existed in regard to the meaning of the provision in Section 4,919, but I understand the Supreme Court, in *Birdsall v. Coolidge*, 93 U. S. 64, to hold the effect of the statute to be this: that when it appears, in a case in equity, that the defendant's profits, derived from the use of the plaintiff's invention, do not amount to so much as the plaintiff's damages arising from the infringement, the court may add to the amount of the defendant's profits a sum sufficient to make the amount awarded by the decree equal to the plaintiff's damages. So the decision referred to is understood in *Child v. Boston & Fair Haven Iron Works*, 19 Fed Rep. 258.

Under this construction of the statute the plaintiffs, upon the proofs in this case, may have added to the defendant's profits the sum of \$151.50, making the recovery \$303, which is the amount of the plaintiff's damages as shown by the proofs.

HARTFORD CARPET CO. *v.* DOBSON.  
 BIGELOW CARPET CO. *v.* SAME. (Two Cases.)

U. S. Circuit Court. E. D. of Pennsylvania.

Decided January 27, 1882.

10 Fed. Rep. 385.

1. Where the infringement is willful, respondents ought to be held to the most rigid accountability, and no intendment ought to be made in their favor, founded upon the alleged inconclusiveness of the complainant's proof of loss. Such proof ought to be interpreted most liberally in favor of the complainants, within the limit of an approximately accurate ascertainment of their damages.
2. In a suit on a patent for a design for a carpet, the plaintiff claiming damages, under an interlocutory decree containing a reference to a master to assess profits and damages, the evidence showed the cost and selling price of complainants' carpet, the quantity of the infringing carpet sold by respondents, and that there was a decline in complainants' sales; *held* that the amount of defendant's sales must, under the circumstances, be presumed to have displaced an equal quantity of complainants' carpets; and that the measure of damages is the whole profit on the carpet bearing the design, and is to be ascertained by the profit plaintiffs would have realized had they made and sold the same.

These were two cases brought by the Bigelow Carpet Company, for infringement of letters patent Nos. 10,870 and 10,778, for designs for carpets; and a third by the Hartford Carpet Company, for infringement of letters patent No. 11,074, for designs for carpets, all against the same defendants. Interlocutory decrees were entered, and the cases were referred to a master to ascertain and report the profits and damages. The plaintiff's waived the former, as it appeared that no *actual* profit had been realized by defendant; and damages were asked for. In each case complainants proved that during the first six months after the introduction of the design a specific quantity of their carpet was sold, and they also gave evidence of its cost

and their profit on it. The quantity of the infringing carpet subsequently sold by respondents was also shown. Complainants claimed that the effect of respondents putting upon the market carpets of the same design at a less price was to decrease the demand for the original carpet, and compel a change of design. They claimed damages based upon estimates made by their witnesses as to the probable amount of their sales of the original carpet if respondents had not infringed and no other cause had occurred to diminish the demand. They also claimed the expense of changing their designs, as estimated by their witnesses. The master reported that while the effect of the infringement was to decrease the complainants' sales, he was entirely unable to find from the evidence the amount of their damage, or even to approximate its sum, and he therefore awarded only nominal damages. The cases came before the court on complainants exceptions to this report, and they were argued together.

*A. V. Briesen and Joseph C. Fraley, for complainants.  
George E. Buckley, for respondents.*

McKENNAN, C. J. These were all suits for infringement by the respondents of designs for carpets patented to the complainants. The infringing designs are exact counterparts of the patented ones, and carpets embodying them were put upon the market by the respondents some time after the dates of the patents and introduction of carpets containing the designs described in them by the complainants. No defence was made by the respondents, and they therefore occupy the attitude of wilful infringers.

Under these circumstances the respondents ought to be held to the most rigid accountability, and no intendment ought to be made in their favor founded upon the alleged inconclusiveness of the complainants' proof of loss. On the other hand, such proof ought to be considered and interpreted most liberally in favor of the complainants, within the limit of an approximately accurate ascertainment of their damages.

The master has not so dealt with the evidence presented to him, and has, therefore, fallen into error in his conclu-

sion. He has found nominal damages only in favor of the complainants, although they furnished proof by which the damages claimed by them might, to some extent at least, be legally measured.

In this category is the evidence of the number of pieces and yards of the complainants' carpets manufactured during the season of its first introduction upon the market, the cost per yard of their manufacture, and the prices at which they were sold in the market; the number of pieces and yards of infringing carpets made and sold by the respondents in the following season, and the very large decline in the complainants' sales during this period. It furnishes the means of accurate computation of the complainants' profits, and of the extent to which the market was occupied by the respondents. All that is left for presumption is that the infringing carpets displaced in the market the complainants' carpets, and hence that the profits which would have accrued to them upon the quantity of carpets put upon the market is the measure of their damages.

This presumption, as against a wrong doer, is not unreasonable, and it has the sanction of numerous decisions. *Putnam v. Lomax*, 9 Fed. Rep. 448; *American Saw Company v. Emerson*, 8 Fed. Rep. 806; *McComb v. Brodie*, 2 O. G. 117; *Westlake v. Cartter*, 4 O. G. 636.

Upon this basis there is no difficulty in stating an account against the respondents; and this is the only one upon which under the evidence, the complainants' damages can be computed. It is enough for us to say that the losses claimed for the entire decline in the complainants' sales, and on looms, are too remotely connected with the defendants' acts as their supposed cause, and hence are too speculative in their character to entitle them to allowance.

It sufficiently appears that the respondents made and sold twenty pieces of fifty-five yards each, 1,100 yards in all, of carpets containing the design described in No. 30, of April term, 1879, and that the complainants' profit upon carpets of that design was sixty-seven cents per yard. They lost, therefore, this sum upon 1,100 yards, and their damages amount to \$737, for which a final decree must be rendered in their favor.

In No. 34, April term, 1879, which is founded upon the

patent for what is popularly called the "Pagoda Pattern," the respondents made 20 pieces of 50 yards, in all 1,000 yards, the profit of complainants for like carpet being 75 cents per yard. The respondents have not disclosed what became of the carpets thus made by them, and they are, therefore, held accountable for them as if put upon the market. The complainants' damages in this case are, then, 75 cents upon 1,000 yards, equal to \$750, for which a final decree will be entered in their favor.

In No. 35 of April term, 1879, the respondents made 53 pieces of Chinese Lantern pattern of 50 yards each, but sold only 35 pieces, the rest having been sealed up by the marshal.

The complainants' damages in this case are, therefore, 75 cents upon 1,750 yards, amounting to \$1,312.50, for which a final decree will be entered in their favor.



DOBSON *et al.* v. HARTFORD CARPET CO.  
SAME v. BIGELOW CARPET CO.

Supreme Court of the United States.

Decided April 20, 1885.

114 U. S. Rep., 439.

1. In assessing damages for the infringement of a patent for a design for carpets, where no profits were found to have been made by the defendant, the circuit court allowed to the plaintiff as damages on the quantity of infringing carpets made and sold by the defendant, the profit which the plaintiff would have realized in making and selling carpets with the patented design. Held that such award of damages was improper, as it included the whole profit on the carpet as well as on the design, and that in the absence of evidence of the latter, only nominal damages should have been allowed.
2. The measure of damages for infringement of a design patent, is the value the design contributed to the finished article, and not the whole profit; unless it is shown by reliable and tangible evidence that the whole profit is to be legally attributed to the design.



3. The joinder of a claim for a pattern and separate claims for each of its parts in one patent, does not *per se* invalidate the patent, or any claim, at the objection of a defendant.
4. A claim of "the design for a carpet, substantially as shown," refers both to the description and the drawing, and is sufficient.
5. Objections to a patent that might otherwise be taken on appeal from a decree entered after defense and hearing, are concluded where the bill is taken as confessed.
6. Where the master reported no profits, and nominal damages, in a suit in equity for the infringement of a patent for a design, and, on exception by the plaintiff, the circuit court allowed a sum for damages, and this court reversed its decree, the plaintiff was allowed costs in the circuit court to and including the interlocutory decree, and the defendant was allowed his costs after such decree.

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

*Hector T. Fenton and R. P. White, for appellants.*  
*Arthur V. Briesen, for appellees.*

Mr. Justice BLATCHFORD delivered the opinion of the court.

These are three suits in equity brought in the Circuit Court of the United States for the Eastern District of Pennsylvania, against John Dobson and James Dobson, trading as John & James Dobson, and as the Falls of Schuylkill Carpet Mills." No. 1 is brought by the Hartford Carpet Company, for the infringement of Design Letters Patent No. 11,074, granted March 18, 1879, to the plaintiff, as assignee of Winthrop L. Jacobs, for three and one-half years, for a design for carpets. No. 2 is brought by the Bigelow Carpet Company, for the infringement of Design Letters Patent No. 10,778, granted August 13, 1878, to the plaintiff, as assignee of J. Hugh Christie, for three and one-half years, for a design for carpets. No. 3 is brought by the Bigelow Carpet Company, for the infringement of Design Letters Patent No. 10,870, granted October 15, 1878, to the plaintiff, as assignee of Charles

Magee, for three and one-half years, for a design for carpets.

No. 1 was commenced on the 26th of April, 1879, and Nos. 2 and 3 on the 7th of May, 1879. In No. 1 and No. 3 the defendants appeared by a solicitor, but did not plead, answer, or demur to the bill, and it was taken as confessed in each suit, on the eleventh day of July, 1879; and on the 2d of September, 1879, an interlocutory decree was entered in each suit, awarding a perpetual injunction, and an account of profits and damages. In No. 2 an answer was filed on the 3d of September, 1879, denying infringement, and setting up want of novelty. A replication was filed, and on the 5th of November, 1879, a preliminary injunction was granted. Testimony was taken, and on April 23, 1880, on final hearing, a decree was made for a perpetual injunction, and an account of profits and damages. Some testimony on the accounting in Nos. 1 and 3 was taken in November, 1879, but most of the evidence before the Master was taken in the three suits at the same time, in June, 1880.

In No. 1 the Master filed a report on January 18, 1881, setting forth that the plaintiff, before the Master, waived all claim for profits, and limited its claim to the damages it has suffered by the infringement; that the defendants had sold 20 pieces of 50 yards each of carpet containing the patented design; that the plaintiff claimed \$13,400 damages, being 67 cents a yard, on 400 pieces of carpet of 50 yards each, as being the decrease of the plaintiff's sales, caused by the infringement, estimating the cost to the plaintiff of making and selling the carpet at \$1.08 per yard, and his selling price at \$1.75 per yard; and that the Master had rejected that claim as founded on inadmissible evidence, and a further claim of \$3,000 damages, for expenses caused to the plaintiff by the infringement, in getting up other designs and changing its looms to other carpets. The report was for six cents damages. The plaintiff excepted to the report because it did not find profits to have been made by the defendants, and did not report more than nominal damages. The court sustained the exceptions, and decreed to the plaintiff \$737, being for 20 pieces of infringing carpet made and sold by the

defendants, at 55 yards per piece, or 1,100 yards, at 67 cents per yard, as the plaintiff's profit per yard on carpet of the patented design. The final decree was for \$737 and costs, and a perpetual injunction. The defendants have appealed.

In No. 2 the Master filed a report on January 18, 1881, setting forth that the plaintiff, before the Master, waived all claim for profits, and limited its claim to the damages it had suffered by the infringement; that no testimony had been taken showing the amount of the defendant's sale of the infringing carpet; that the plaintiff claimed \$11,250 damages, being 75 cents a yard on 300 pieces of carpet of 50 yards each, as being the decrease of the plaintiff's sales, caused by the infringement, estimating the cost to the plaintiff of making and selling the carpet at \$1.10 per yard, and his selling price at \$1.85 per yard; and that the Master had rejected that claim as not sustained by the evidence, and also a further claim for expense caused to the plaintiff by the infringement in getting up another design, and in resetting its looms to manufacture the same. The report was for six cents damages. The plaintiff excepted to the report for not finding more than nominal damages. The court sustained the exceptions, and decreed to the plaintiff \$750, being for 20 pieces of infringing carpet made by the defendant, at 50 yards per piece, or 1,000 yards, at 75 cents per yard, as the plaintiffs' profit per yard on carpet of the patented design. The final decree was for \$750 and costs, and a perpetual injunction. The defendants have appealed.

In No. 3, the master filed a report on January 18, 1881, setting forth that the plaintiff, before the master, waived all claim for profits, and limited its claim to the damages it has incurred by the infringement; that the defendants had sold 31 pieces, amounting to 1,684 $\frac{1}{4}$  yards of carpet containing the patented design; that the plaintiff claimed \$3,750 damages being 75 cents a yard on 5,000 yards of carpet, as being the decrease of the plaintiff's sales, caused by the infringement, estimating the plaintiff's profit on making and selling the carpet at 75 cents per yard; and that the master had rejected that claim as not sustained by the evidence, and also a further claim for the cost of getting up another

design to replace the one infringed. The report was for six cents damages. The plaintiff excepted to the report, because it did not find profits to have been made by the defendants, and did not report more than nominal damages. The court sustained the exceptions, and decreed to the plaintiff \$1,312.50, being for 35 pieces of infringing carpet, made and sold by the defendants, at 50 cents per piece, or 1,750 yards, at 75 cents per yard, as the plaintiff's profit per yard on carpet of the patented design. The final decree was for \$1,312.50 and costs, and a perpetual injunction. The defendants have appealed.

The circuit court proceeded on the ground, as stated in its decision. (10 Fed. Rep. 385,) that it was to be presumed that the defendants' carpets displaced in the market an equal quantity of the plaintiffs' carpets; and that the profits which the plaintiffs would have made on that quantity of carpets was the measure of their damages. It rejected the claims for losses for any greater decline in the plaintiff's sales, and on looms, as "too remotely connected with the defendants' acts as their supposed cause," and "too speculative in their character," to be allowed.

Leaving out of view all question as to the presumption that the plaintiffs would have made and sold, in addition to the carpets of the patented designs, which they did make and sell, the infringing carpets which the defendants made and sold, which are alleged to have been of poorer quality and cheaper in price, it is plain that the price per yard allowed as damages was the entire profit to the plaintiffs, per yard, in the manufacture and sale of carpets of the patented designs, and not merely the value which the designs contributed to the carpets. There was no evidence as to that value.

It is provided by Section 4,921 of the Revised Statutes, that, in a suit in equity for the infringement of a patent, the plaintiff may, on a decree in his favor, recover the damages he has sustained, in addition to the profits to be accounted for by the defendant, such damages to be assessed by the court, or under its direction, and with the same power to increase the damages, in the discretion of the court, as in the case of verdicts; and the damages intended are "the actual damages sustained," in the language of

Section 4,919. *Root v. Railway Company*, 105 U. S. 189, 212. By Section 4,933 all these provisions apply to patents for designs.

This court has, in a series of decisions, laid down rules as to what are to be regarded as "profits to be accounted for by the defendant," and what as "actual damages," in suits for the infringement of patents; and no rule has been sanctioned which will allow, in the case of a patent for a design for ornamental figures created in the weaving of a carpet, or imprinted on it, the entire profit from the manufacture and sale of the carpet, as profits or damages, including all the profits from carding, spinning, dyeing and weaving, thus regarding the entire profits as due to the figure or pattern, unless it is shown, by reliable evidence, that the entire profit is due to the figure or pattern. It is matter of common knowledge, that there is an infinite variety of patterns in carpets, and that, between two carpets, of equal cost to make, and equal merit as to durability of fabric and fastness of color, each with a pattern pleasing to the taste, one having a design free to be used, and the other a design protected by a patent, the latter may or may not command in the market a price larger than the former. If it does, then the increased price may fairly be attributed to the design; and there is a solid basis of evidence for profits or damages. But short of this, under the rules established by this court, there is no such basis. The same principle is applicable as in patents for inventions. The burden is upon the plaintiff, and if he fails to give the necessary evidence, but resorts instead to inference and conjecture and speculation, he must fail for want of proof. There is another suggestion of great force. The carpet with the infringing design may be made on an infringing loom, and various infringing processes of mechanisms for carding, spinning or dyeing may be used in making it, and, if the entire profit in making and selling it, is necessarily to be attributed to the pattern, so it may as well on principle be attributed to each of the other infringements, and a defendant might be called on to respond many times over for the same amount. There is but one safe rule; to require the actual damages or profits to be established by trustworthy legal proof.

It is not necessary to cite at length from the cases decided by this court on the subject. It is sufficient to refer to them, as follows:—*Livingston v. Woodworth*, 15 How. 546; *Seymour v. McCormick*, 16 How. 480; *Mayor v. Ransom*, 23 How. 487; *Mowry v. Whitney*, 14 Wall, 620; *Philp v. Nock*, 17 Wall 460; *Littlefield v. Perry*, 21 Wall 205; *Birdsall v. Coolidge*, 93 U. S. 64; *Cawood Patent*, 94 U. S. 695; *Blake v. Robertson*, Id. 728; *Garretson v. Clark*, 111 U. S. 120; S. C. 4 Sup. Ct. Rep. 291; *Black v. Thorne*, 111 U. S. 122; S. C. 4 Sup. Ct. Rep. 326. The true rule, which applies also to a patent for a design, was formulated thus, by this court, in *Garretson v. Clark*: “The patentee must, in every case, give evidence tending to separate or apportion the defendant’s profits and the patentee’s damages between the patented feature and the unpatented features, and such evidence must be reliable and tangible, and not conjectural or speculative; or he must show, by equally reliable and satisfactory evidence, that the profits and damages are to be calculated on the whole machine. for the reason that the entire value of the whole machine, as a marketable article, is properly and legally attributable to the patented feature.” The case of *Manufacturing Co. v. Cowing*, 105 U. S. 253, was a case falling within the last clause of the rule thus stated, and was an exceptional case, as was stated by the chief justice, in the opinion. The general rule was recognized in that case, and the exception was made, in regard to the oil-well gas pump there involved, because there was only a limited and local demand for it, which could not be, and was not, supplied by any other pump.

The rule in question is even more applicable to a patent for a design than to one for mechanism. A design or pattern in ornamentation or shape appeals only to the taste through the eye, and is often a matter of evanescent caprice. The article which embodies it is not necessarily or generally any more serviceable or durable than an article for the same use having a different design or pattern. Approval of the particular design or pattern may very well be one motive for purchasing the article containing it, but the article must have intrinsic merits of quality and structure, to obtain a purchaser, aside from the pattern or design; and to attrib-

ute in law, the entire profit to the pattern, to the exclusion of the other merits, unless it is shown, by evidence, as a fact, that the profit ought to be so attributed, not only violates the statutory rules of "actual damages" and of "profits to be accounted for," but confounds all distinctions between cause and effect.

The decrees must, therefore, all of them, be reversed, as to the damages awarded.

As to No. 1, though the bill was taken as confessed, the defendants take the point that the patent is void on its face, because it has nineteen claims. It has a claim for an entire pattern, and then a separate claim for each of eighteen component parts making up the whole. The bill alleges infringement by the making and selling of the "invention," and of carpets containing the "invention." Even if the defendants can raise this point after a decree *pro confesso*, (see *Thomson v. Wooster*, 114 U. S. 104), the patent must be held valid, at least, for the purposes of this case.

In No. 2, the question of proof of making and selling by the defendants before suit brought is raised. But we think, on the pleadings and all the proof, including the defendants' letter, of April 13, 1880, the case is made out. The point is also taken, that this patent is void, because it has a claim for the entire pattern and three claims for each of three constituent parts of it. No such point is taken in the answer, which speaks of the patent as one for a single design. If the patent-office, in view of the question of fees, and for other reasons, grants a patent for an entire design, with a claim for that, and a claim for each one of various constituent members of it, as a separate design, we see no objection to it, leaving the novelty of the whole and of each part, and the validity of the patent, open to contestation. The mere joinder of such claims in one grant does not *per se* invalidate the patent or any particular claim, at the objection of a defendant.

In No. 3, objection is taken to the patent because it claims "the design for a carpet, substantially as shown." As the bill is the same in form as that in No. 1, and was taken *pro confesso*, the patent is valid, at least for the purposes of this case. Aside from this, we see no good objection to the form of the claim. It refers to the description

as well as to the drawing, in using the word "shown." The objection is also made, as to No. 3, that the patent is for an aggregation of old ornaments, and embodies no invention. This objection is concluded, for this case, by the language of the bill and the decree *pro confesso*.

The final decrees in all of the suits are reversed, and the cases are remanded to the circuit court, with directions to disallow the award of damages in each suit, and to award six cents damages in each, and to allow the defendants a recovery in each case for their costs after interlocutory decree, and to the plaintiff in each case a recovery for its costs to and including interlocutory decree.



DOBSON *et al.* v. DORNAN *et al.*

Supreme Court of the United States.

Decided April 19, 1886.

118 U. S. Reports, 10.

1. Letters patent for a design for a carpet in which the specification is accompanied by a photographic illustration, and merely states that the nature of the design is fully represented in such illustration, and claims "the configuration of the design hereunto annexed, when applied to carpeting," sets forth a sufficient description and claim, and the patent is valid.
2. An interlocutory decree which awards a recovery for profits and damages for infringement of a patent for a design for carpet, but orders an account of the profits from the manufacture and sale of carpets bearing the design, is not open to the objection taken to the form of the decree that it awards more than the profit from the design.
3. On a question of infringement of a design patent, where the evidence is conflicting, but the court below had the aid of exhibits, this court cannot, in the absence of ocular inspection of such exhibits also, say that the court below erred in its conclusion.
4. The decision in *Dobson v. Hartford and Bigelow Carpet Co's.* (114 U. S. 439) as to the rule of damages in a suit for infringement of a patent for a design, confirmed.



5. The plaintiff must show what profits or damages are attributable to the use of the infringing design.
6. The defendant made no profits on the carpets bearing the infringing design. The Circuit Court allowed damages based on the profit the plaintiff would have realized on the sale of a like number of yards of carpet had he made and sold the same, without any evidence that the plaintiff would have sold the same, or that the design added anything to the price, or promoted the sale of the carpet. Held to be error.
7. On reversal, costs allowed to plaintiff to and including interlocutory decree, and to defendant costs after interlocutory decree.

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

*Hector T. Fenton, and Richard P. White, for appellants.*  
*Ludovic C. Cleeman, for appellees.*

Mr. Justice BLATCHFORD delivered the opinion of the Court.

This is a suit in equity brought in February, 1875, by the appellees, trading as Dornan, Maybin & Co., against the appellants, John Dobson & James Dobson, in the Circuit Court of the United States for the Eastern District of Pennsylvania, for the infringement of Letters Patent No. 6,822 for a design for a carpet granted to Charles A. Righter, August 19, 1873, for three and one-half years. The entire specification is as follows: "Be it known that I, Charles A. Righter, of the City of Philadelphia, County of Philadelphia, State of Pennsylvania, have invented and produced a new and original design for carpets, of which the following is a specification. The nature of my design is fully represented in the accompanying photographic illustration, to which reference is made. I claim as my invention the configuration of the design hereunto annexed, when applied to carpeting." The photographic illustration is a six inch square, containing a single figure or design. The only defense set up in the answer is non-infringement. Issue being joined, proofs were taken, and the case was heard, and in April, 1876, a decree was made finding that the patent was valid, and had been infringed, and awarding

to the plaintiffs costs, an account of profits and damages before a master, and a perpetual injunction.

The master made his report in April, 1882. He found that the defendants had made no profits, and stated thus the contending views of the parties as to the proper rule of damages: "The complainants asked to have awarded to them, as damages and compensation for the injury inflicted upon them, whatever profit the defendants may have made, and also whatever loss they, the complainants, had incurred, which could be measured by the profits that would have accrued to them if they had made the exclusive sales of the carpet, deducting in such case the amount of profits, if any, made by the defendants. The defendants, however, contended that all that the complainants were entitled to was not what they, the defendants had made or saved on the carpets, but only what they made or saved by reason of the use of the pattern, as compared with what they could have made without it, and therefore, unless they could sell the carpet bearing the design at a higher price than other carpets, whereby they made more or lost less, no profit resulted to them. They further contend that, unless it was shown by direct evidence that the complainants would have made the sales which the defendants did, had they not infringed, the fact could not be inferred." The Master found that the profit of the plaintiffs consisted in the exclusive use of the invention, and in the monopoly of manufacturing for others to use; that they sold their carpets at from 10 to 15 cents a yard more than the defendants did, and made a profit, in 1874, of  $13\frac{3}{4}$  per cent., and in 1875 of  $10\frac{3}{4}$  per cent., their average price per yard being more than one dollar; that the defendants might have made an equal profit if they had asked the same prices, and the benefit, gain, or advantage to them might be reasonably estimated as equivalent to the money profit they might have made; that it was to be presumed that the defendants' carpets displaced the plaintiffs' in the market; that it was proper to award to the plaintiffs an amount equal to the profits they could have made in 1874 and 1875, on the carpets made and sold by the defendants, if the plaintiffs themselves had made and sold them; that the defendants made and sold in 1874, 19,243 $\frac{1}{2}$  yards, which would have yielded, at one

dollar a yard, \$19,243.50, on which the profits of the plaintiffs, at  $13\frac{3}{4}$  per cent., would have been \$2,645.97; that the defendants made and sold, in 1875, 31,280 $\frac{1}{2}$  yards, which would have yielded, at one dollar a yard, \$31,280.50, on which the profits of the plaintiffs, at  $10\frac{3}{4}$  per cent., would have been \$3,362.65; and that, therefore, the plaintiffs had sustained \$6,008.62 damages by the infringement of the patent.

The defendants excepted to the report, but the court confirmed it, and in October, 1882, rendered a decree for the plaintiffs for \$6,128.79, from which the defendants have appealed.

It is assigned for error that the patent is void on its face for want of a sufficient description and claim. It was issued under the Act of July 8, 1870, C. 230 (16 St. 198). Sections 71, 72, and 76 of that act provided as follows:

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

SECT. 72. The Commissioner may dispense with models or of designs when the design can be sufficiently represented by drawings or photographs.

“SECT. 76. All the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries not inconsistent with the provisions of this act, shall apply to patents for designs.”

It is contended that Section 26, of the Act of July 8, 1870, applies to the present case. That section provides that, before any person shall receive a patent for his inven-

tion or discovery, he shall file in the patent office a written description of it, and "particularly" point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery. It is urged that Section 26 was not complied with in this case, and that the patent is void because it contains no description, and no proper claim. But we are of opinion that the description and claim are sufficient. The purport of the description is that what the photographic illustration represents as a whole is the invention. It is that which is claimed, when applied to carpeting. The design is a pattern to be worked into a carpet, and is within the statute. Claiming the "configuration of the design" is the same thing as claiming the design or the figure or the pattern. It is better represented by the photographic illustration than it could be by any description, and a description would probably not be intelligible without the illustration.

In *Dobson v. Bigelow Carpet Co.*, 114 U. S. 439, 446, S. C. 5 Sup. Ct. Rep. 945, the claim of the design patent was "the design for a carpet, substantially as shown." Objection was taken to the form of the claim; but this court said it saw no good objection to the form and that the claim referred to the description as well as the drawing in using the word "shown." The drawing there was a photographic illustration of the body and border of the carpet, described in the specification as representing a face view; but the description was merely that A was an irregular shield-like figure, surrounded by a border embellished by floral decoration; that B, B were two irregular figures of the same design, but having a different ground color from a, and arranged at opposite sides diagonally of each shield; c, c, were tassel-like ornaments, arranged beneath the several figures a; that d were bouquets, and there were other floral ornamentations; that the border contained an inner plain stripe, f, and an outer zigzag stripe, g, having inwardly projecting semi-circular ornaments, h; that between the stripes, f and g, were representations of shields resembling the shield a, and floral decorations extending over the stripe, f, as shown, and that the tassel-like ornaments, c, were also in the border. Unaided by the illustration, probably many different designs might have been

drawn to which the description would have applied, and the description furnished no aid whatever in identifying the design. So, in the present case, the design is sufficiently identified by the illustration without the aid of any description. In the language of Section 72, before cited, the design is sufficiently represented by the photograph.

Undoubtedly, the claim in this case covers the design as a whole, and not any part of it as a part, and it is to be tested to a whole as to novelty and infringement. The answer admits that Righter was the original and first inventor of the design for which the patent was granted, and does not question the novelty of the invention.

Exception is taken to the form of the interlocutory decree, in that, while it awards a recovery for the profits and damages from the infringement of the design, it orders an account to be taken of the profits of the defendants from infringing upon the exclusive rights of the plaintiffs "by the manufacture, use, and sale of carpeting bearing said patented design," and of the additional damages suffered by the plaintiffs "by reason of said infringements." We do not think the decree is open to the objection made. It is not like the decree in *Littlefield v. Perry*, 21 Wall 205, 228. It directs an account of the profits from the infringement. The infringement could be committed only by making, using and selling carpets containing the patented design; but the profits and damages to be accounted for are described as only those from the infringement.

It is also contended that the weight of the evidence on the question of infringement was with the defendants. The court below found otherwise. It appears by the record that a piece of carpet (Exhibit No. 2.) was introduced in evidence as containing the patented design; and another piece of carpet (Exhibit No. 3.) as being the defendant's carpet alleged to infringe. Those Exhibits have not been produced on the hearing in this court, although the brief for the appellants states that the circuit court evidently decided the question of infringement with little aid other than ocular inspection of the samples. This court has not the benefit of any such aid. We find, however, in the record, testimony of a witness to the effect that, from his experience as a seller of carpets, he thinks it would be almost

impossible for any one, who had not seen the two carpets together, to tell them apart; and of another witness that, in his opinion, not one consumer in twenty-five would know the difference; and other testimony tending to the same result. While there is evidence contradictory of this, we cannot, in the absence of ocular inspection, take it upon ourselves to say that the circuit court erred in finding infringement.

The only remaining question is that of the amount of damages. The master and the circuit court proceeded on a view which had been adopted by that court in the three cases adjudged by it, the decrees in which were reversed by this court in *Dobson v. Hartford Carpet Company*, 114 U. S. 439; S. C. 5 Sup. Ct. Rep. 945. The present case was decided by the circuit court before such reversal. We are of opinion that the decision cited covers all the questions involved in the case at bar, and requires that the final decree in it should be reversed. In the cases in 114 U. S., the patents being for designs for carpets, it was found that no profits had been made by the defendant, but the circuit court allowed to the plaintiff, as damages, in respect to the yards of infringing carpet made and sold by the defendants, the sum per yard which was the profit of the plaintiff in making and selling carpets with the patented design, there being no evidence as to the value imparted to the carpet by the design. This court held that such award of damages was improper, and that only nominal damages should have been allowed. It is not necessary to recapitulate the views set forth in 114 U. S., which controlled that decision. The present case cannot be distinguished.

It is urged that the principle on which damages are to be computed in respect to a patent for a machine, or for an improvement in a machine, or for a process, is not applicable to a patent for a design, because in a patent for a design the result is patented, while in the other kind of patent the means are patented; that in the design patent there is no other way of effecting the result, while in the other there generally is; and that, therefore, in the design patent the entire profits or damages on the article containing the design are to be given, while in the other, only those be-

longing to the particular improvement patented are to be allowed. But we think all that is here urged is covered by what was said in the cases in 114 U. S. The plaintiff must show what profits or damages are attributable to the use of the infringing design.

In the present case the master found that the plaintiffs' profit on their carpets was a certain percentage, and assumed or presumed that the defendants' carpets, which were far inferior in quality as in market value, displaced those of the plaintiffs' to the extent of the sales by the defendants, and held that the entire profit which the plaintiffs would have received, at such percentage, from the sale of an equal quantity of their own carpets of the same pattern, was the proper measure of their damages. The defendants' carpets were so inferior in quality that they sold them at a much less price than the plaintiffs got for their carpets, and even at those prices the defendants made no profits. Under these circumstances there can be no presumption that the plaintiffs would have sold their better quality of carpets in place of the defendants' poorer quality if the latter had not existed, or that the pattern would have induced the purchasers from the defendants to give to the plaintiffs the higher price. On the contrary, the presumption is at least equal that the cheaper price, and not the pattern, sold the defendants' carpets. There was no satisfactory testimony that those who bought the cheap carpets from the defendants would have bought the higher priced ones from the plaintiffs, or that the design added anything to the defendants' price, or promoted their sale of the particular carpet, and none to show what part of the defendants' price was to be attributed to the design.

It does not evade the force of the principle governing the case that, in arriving at the percentage of profits made by the plaintiffs on their sales, the cost was made up by computing all the items which entered into the production of their carpets. The objection is to taking the whole of that profit as the measure of damages, on the assumption that the whole of it was due solely to the design, and on the further assumption that the plaintiffs would have sold of their higher grade of carpets a quantity equal to the cheaper lower grade carpets sold by the defendants.

The final decree of the circuit court is reversed, and the case is remanded to that court, with direction to disallow the award of damages, and to award six cents damages, and to allow to the defendants a recovery for their costs after interlocutory decree, and to the plaintiffs a recovery for their costs to and including the interlocutory decree.

FIELD, J. I concur in the reversal of the decree, but am of opinion that the patent was invalid, and that the bill should therefore be dismissed.



### TOMKINSON *v.* WILLETS MANUFACTURING CO.

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

Decided March 26, 1888.

34 Fed. Rep. 536.

In an action in equity for infringement of a design patent for the form or configuration of a peculiar, square-shaped vegetable dish, the measure of damages is not the gains derived by defendant from the manufacture and sale of the infringing dishes, but is only that part of the profits which is fairly attributable to plaintiff's design, viz.: that sum which defendants have derived from the adoption of plaintiff's peculiar variety of square-shaped dish, as compared with what he would have derived from the sale of other non-infringing, square-shaped dishes.

This case came on for hearing on defendant's exceptions to master's report, in a suit in equity brought at a previous term (*Tomkinson v. Willets Manufacturing Company*, 23 Fed. Rep. 895), for the infringement of a patent for a design for a vegetable dish, in which case a decree was passed for plaintiff, and the case referred to a master to assess the amount of profits and damages.

*Frank V. Brieser, for complainant.*

*Philo Chase, for defendant.*

LACOMBE, J. This is a suit in equity for infringement, founded upon Design Patent No. 13,295, granted to John



Slater, assignor to Gildea & Walker, September 12, 1882, for a design for a vegetable dish. Upon final hearing, before Judge Coxe, it appeared that in a precisely similar suit in the district of New Jersey between the same parties for infringement of this patent, the defendant appeared by its president, and consented to a decree, whereupon, before the commencement of the present suit, judgment was entered, sustaining the patent. Passing upon the effect of such adjudication, Judge Cox says:

That decree was pleaded and proved in this action. It is valid and binding upon the rights of the parties, and as to all the questions determined by it is *res judicata*. Unfortunately, perhaps; for the defendant, the court is not now permitted to consider the defenses which, by the defendant's own action, are thus eliminated from the case. The question of infringement is alone open to investigation. \* \* \* I am constrained to say that the defendant infringes." *Tomkinson v. Manufacturing Co.*, 23 Fed. Rep. 895.

It was referred to a Master to take account of the gains and profits, and assess the damages. The Master has duly reported that the complainant is entitled to recover "the gains and advantages derived by the defendant from the use, manufacture, and sale of the infringing dishes, in the sum of \$1,853.29." The case now comes up on defendant's exceptions to the Master's report.

The report must be set aside. Even if a method of comparison such as was adopted by the master were conceded to be the proper way in which to accomplish the result sought for—and that question is not now passed upon—he has not selected a suitable standard of comparison. In order to ascertain the profit derived from the use of complainant's model, comparison should be made, not with goods of an entirely different model, but with goods of the most similar pattern, which defendant was free to use. What makes, or rather, what is supposed to make, the design patentable? The circumstance that it is an improvement upon the existing state of the art. The patent covers only the particular advance which the patentee has made; it gives the patentee no rights in what was common property before. It appears that

complainant's patent is for a particular model of square-shaped dish,—for the shape only, not for the decoration. Defendant sold a number of infringing square-shaped dishes, called "Doric." It also sold dishes of a totally different shape—an oval—called "Excelsior." It further appeared that defendant was free to use other square-shaped dishes, and did in fact make a non-infringing square-shaped dish, called the "Piedmont." The entire profit on the "Doric" dishes over cost of manufacture could no doubt be found, but to that entire sum the plaintiff is not entitled. *Dobson v. Carpet Co.*, 114 U. S. 440, 5 Sup. Ct. Rep. 945. All he should recover is the amount of such profit which is fairly attributable to his design. Nor is that amount ascertained even by finding what profit the defendant secured by making and selling the infringing square dishes, instead of oval ones. The amount of that profit must be itself, sub-divided into the sums due respectively to the adoption of a square-shaped dish, generally, and to the appropriation of plaintiff's particular variety of square-shaped dish. To the latter sum he is entitled, but its amount is certainly not ascertained by comparing the sales and cost of the infringing dishes with the sales and cost of the oval dishes. *Non constat* but what defendant would have secured 90 per cent. of its "extra profits," as complainant calls them, by sales of such square dishes as it was free to use. If so, the plaintiff would be entitled only to the remaining 10 per cent. as profits resulting from pirating his peculiar square dish. It may be that complainant may find it difficult, if not impossible, to prove the amount of such profit, but that is a difficulty inherent in the particular kind of patent which he holds. One, who by some lucky chance secures a patent for "the mere shadow of a shade of an idea," should not be disappointed if the grant, even though uncontested, subsequently proves of no appreciable pecuniary value.

# APPENDIX.

---

CONTAINING ALL THE REPORTED DECISIONS  
OF THE COMMISSIONER OF PATENTS, TO  
DEC. 31, 1888, RELATING TO APPLICA-  
TIONS FOR PATENTS FOR DESIGNS;  
ARRANGED CHRONOLOGICALLY.

# TABLE OF DECISIONS

## OF COMMISSIONER OF PATENTS, TO DECEMBER 31, 1888, RELATING TO APPLICATIONS FOR DESIGN PATENTS.

	PAGE
BAILEY, <i>Ex parte</i> . 37 O. G., 781.....	321
Design for Carpet Stretcher. Decided November 9, 1886.	
<i>Error in claiming design patent where application should have been for mechanical patent.</i>	
BARTHOLOMEW, <i>Ex parte</i> . Com. Dec., 1869, 103.....	229
Design for Rubber Eraser. Decided December 2, 1869.	
<i>Construing Act of March 2, 1861, Sect. 11. Subject-matter of design patents. Unity of design; variations or modifications. Utility defined, and distinguished from utility of mechanical invention. Generic and specific claims. Artistic or æsthetic equivalents. Novel ornamentation, what changes constitute. Configuration, old form applied to new article. [See decision on application for mechanical patent, Com. Dec., 1871, p. 298.]</i>	
BEATTIE, <i>Ex parte</i> . Com. Dec., 1879, 142. s. c., 16 O. G., 266.....	299
Design for Spoon Handle. Decided May 3, 1879.	
<i>Two or more separate designs cannot be claimed in same patent. Where design is an entirety, claim for the entire design, as well as for sub-combinations of the parts, may be allowed.</i>	
BENNAGE <i>v.</i> PHILLIPPI <i>et al.</i> (Interference.) Com. Dec., 1876, 135. s. c., 9 O. G., 1159.....	287
Design for Figure of Memorial Hall applied to certain defined articles. Decided June 5, 1876.	
<i>Patentability. Arbitrary selection of a known figure or picture applied to ornamentation of toys, etc. Degree of originality required to support design patent.</i>	
BROWER, <i>Ex parte</i> . Com. Dec., 1873, 151.....	277
Design for Inkstands. Decided October 25, 1873.	
<i>Division of application, unity of design. Novel form of inkstand and stopper cannot be claimed in same patent.</i>	

- CARTY, *Ex parte*. 44 O. G., 570..... 349**  
 Design for Cuffs and Collars. Decided July 9, 1888.  
*Caveat; statute does not authorize for designs. Design consists of form, contour, or ornamentation, and no entirety thereof can exist in an incomplete condition.*
- COLLENDER, *Ex parte*. Com. Dec., 1872, 217..... 267**  
 Design for Billiard Table. Decided October 2, 1872.  
*Prior design patent for ornamental configuration no bar to mechanical patent for the plan of construction of the article if it involves utility. [See decision on dissolution of interference, 3 O. G., 91.]*
- COLLENDER v. GRIFFITH. (Interference.)**  
**3 O. G., 91. s. c., Com. Dec., 1873, 14..... 269**  
 Design for Billiard Table. Decided January 30, 1873.  
*Interference properly declared between design patent and subsequent application of another for mechanical patent showing the design.*
- COLLENDER v. GRIFFITH. (Interference.)**  
**3 O. G., 267. s. c., Com. Dec., 1873, 43..... 270**  
 Design for Billiard Table. Decided March 11, 1873.  
*Interference between Griffith's design patent of October 6, 1871, and Collender's subsequent application for mechanical patent. Collender had obtained a previous design patent on June 6, 1871. Interference properly declared between application for mechanical patent and a prior design patent, although applicant holds a prior patent for same. Burden of proof on applicant for mechanical patent, although his design patent first shows the invention.*
- CRANE, JASON, *Ex parte*. Com. Dec., 1869, 7..... 225**  
 Design for Fur-set Box. Decided April 20, 1869.  
*Construing statute of August 29, 1842, as to subject-matter of design patents. Comprehends utility as well as ornamentation.*
- DIFFENDERFER, *Ex parte*. Com. Dec., 1872, 154..... 264**  
 Design for Desk Standard. Decided July 8, 1872.  
*Obverse and reverse of the design should be shown. Function must not form part of claim. If function described, must be eliminated or patent refused.*
- DOOLITTLE, *Ex parte*. 2 O. G., 275.**  
**s. c., Com. Dec., 1872, 176. .... 265**  
 Improvement in Button-hole Cutters. Decided July 31, 1872.  
*Where form produced functional utility, mechanical and not design patent is proper. Shape or form for æsthetic utility or ornamentation only can be secured by a design patent.*

- FAIRCHILD, Ex parte.** 3 O. G., 232.  
s. c., Com. Dec., 1873, 45..... 273

Design for a Sign. Decided March 12, 1873.

*Name sign with an imitation gold pen attached to it held patentable as a design. Ex parte Parkinson, Com. Dec., 1871, page 251, distinguished and approved. Description of mechanical construction and utility of purpose must be eliminated from specification.*

- FENNO, Ex parte.** Com. Dec., 1871, 52..... 250

Design for Damper for Stove-pipes. Decided February 27, 1871.

*Comparison of Act of 1870 with prior Act of 1861. Utility of new form or configuration proper subject of inquiry by Examiner, and necessary to be stated in specification. Functional utility as distinguished from ornamental or æsthetic utility; thought to be included in new Act (1870).*

- GERARD, Ex parte.** 43 O. G., 1235..... 333

Design for a Plate or Dish. Decided May 22, 1888.

*Employment of words "as shown and described" in design patents; effect of. Application cannot embrace more than one subject of invention. Form or configuration cannot be claimed in same patent with surface ornamentation unless, being parts of same article, both unite in producing common result. Design must be an entire, completed, and integral thing; cannot consist of aggregation of separate parts applicable to different uses or purposes. Doctrines of combinations and elements of combinations and genus and species not applicable to designs. Test of infringement is identity of appearance. Objections to non-segregability relate to merits and not to form of application, and appeals therefrom should be to Board of Examiners-in-Chief. A design may, under present statutes, be also the subject of a mechanical patent.*

- GERARD, Ex parte.** 43 O. G., 1240..... 346

Design for Plate or Dish. Decided May 22, 1888.

*Relation of genus and species does not exist in designs. Question involved is merely that of identity. Design patent must be limited to a single invention, but may cover variations or modifications that include sufficient of the distinctive features to preserve the identity of the completed design.*

- HALEY, Ex parte.** 44 O. G., 1399..... 351

Design for Glass-ware. Decided July 16, 1888.

*Application for three and one-half years patent, abandoned and second application filed for fourteen years patent, request that the fee paid for first be applied as part payment on second, refused.*

- HARRIS, *Ex parte*. 38 O. G., 104..... 323**  
 Design for Ornamenting Surface of Walls of Cars. Decided December 22, 1886.  
*Where design application is rejected by Examiner as not disclosing "proper subject-matter of a design patent," appeal should be to Board of Examiners-in-Chief.*
- KING, *Ex parte*. Com. Dec., 1870, 109..... 245**  
 Design for a Trade-mark. Decided September 19, 1870.  
*Prior to Act of 1870, designs intended for trade-marks were patented, not as trade-marks, but such use was only incidental to their patentability as designs. The Act of July 8, 1870, Sect. 71, which provides a mode of protecting trade-marks by registration, excludes all other modes.*
- KOHLER, *Ex parte*. 4 O. G., 58.  
 s. c., Com. Dec., 1873, 84..... 274 .**  
 Design for Shutter Slats. Decided May 17, 1873.  
*Prior design patent will not bar subsequent mechanical patent for device shown in it, but prior mechanical patent showing design will bar subsequent application for design patent, unless specification of former contains an express reservation of right to claim design shown. Reason is that mechanical is greater than design; former includes the latter, but not the latter the former. Abandonment by implied dedication to public.*
- LEE & SHEPARD, *Ex parte*. 24 O. G., 1271..... 309**  
 Application for Registration of Trade-mark on Ornamental Book Cover, previously patented as a design. Decided September 8, 1883.  
*Design law construed. Previous existing design patent securing to a party exclusive right for a term, of the design shown, precludes Office from granting a trade-mark registration for same subject. [See W. & G. S. M. Co. v. Gibbens, 17 Fed. Rep., 623.]*
- MAYO, *Ex parte*. Com. Dec., 1870, 14..... 238**  
 Design for a Transparent Shield. Decided February 23, 1870.  
*Act of March 2, 1861, Sect. 11, construed. Application for design patent must contain election as to term patent shall issue for, and be accompanied by the fee appropriate for such term. Cannot be amended, after filing, as to term.*
- NIEDRINGHAUS, *Ex parte*. 8 O. G., 279..... 283**  
 Design for Ornamenting Enamelled Iron-ware. Decided December 26, 1874.  
*Requisites of specification. Statute requires clearness, exactness, and particularly in description and claim. Design must be fixed and determined, and capable of specific description, either in words or by illustration.*

- NORTON, *Ex parte*, 22 O. G., 1205.**  
**s. c., Com. Dec., 1882, 14..... 306**  
 Design for Machine Frame. Decided June 16, 1882.  
*Utility in design law means attractiveness. Description of function should be omitted from a design specification.*
- OGLESBY, *Ex parte*. 3 O. G., 211.**  
**s. c., Com. Dec., 1873, 35..... 272**  
 Design for new form of Saw-tooth for Cotton-gins. Decided February 24, 1873.  
*New form which gives better appearance merely is subject of design patent, but if it changes or improves its functions, or affects results, it may be subject of mechanical patent.*
- PALMER, *Ex parte*. 21 O. G., 1111.**  
**s. c., Com. Dec., 1882, 5..... 304**  
 Design for Lamp. Decided November 30, 1881.  
*Previous mechanical patent showing design is not per se a bar to subsequent design patent. Former decisions to the contrary commented on and disapproved.*
- PATITZ, *Ex parte*. 25 O. G., 980.**  
**s. c., Com. Dec., 1883, 101..... 316**  
 Design for Sconce Frame. Decided November 19, 1883.  
*Unity of design. Where there is no necessary connection between designs exhibited in two articles, the fact that they are adapted to be associated together does not constitute a unity of design. Separate applications must be presented for them.*
- PARKER, *Ex parte*. 13 O. G., 323.**  
**s. c., Com. Dec., 1878, 14..... 294**  
 Design for a Card to be used as a Match Striker. Decided November 13, 1877.  
*The figure of a boy, together with certain words, on a sample-card, is the subject of design patent. Subject-matter of design patent. Distinguished from trade-marks, labels, and copyrights. Object of law to protect improved appearances adding to the salability and salable value of the article.*
- PARKINSON, *Ex parte*. Com. Dec., 1871, 251..... 257**  
 Design for Claw-hammer. Decided September 25, 1871.  
*Æsthetic utility and not functional usefulness is what is contemplated by the design law of July 8, 1870. Ex parte Bartholomew, Com. Dec., 1869, page 103, commented on and disapproved in part. Nor is mere change of form enough; the result must be substantially new, must involve creative genius, and produce a new ornamental effect.*



- POPE, *Ex parte*. 25 O. G., 290.**  
**s. c., Com. Dec., 1883, 74..... 308**  
 Design for Seat-risers. Decided June 30, 1883.  
*Claim must be restricted to the entire design and distinctive, segregable, integral parts thereof. Claims for portions capable of being attached to different forms, to make up an entire whole, are inadmissible.*
- PRESSPRICH, *Ex parte*. 11 O. G., 195..... 294**  
 Design for Instrument for Regulating Pressure of Gas. Decided February 1, 1877.  
*Decision of Primary Examiner, that application does not present subject-matter for design patent, goes to the merits, and is appealable to the Examiners-in-Chief.*
- PROUDFIT, *Ex parte*. 10 O. G., 585..... 292**  
 Design for Bill-heads. Decided September 28, 1876.  
*Rejection, on ground of non-patentability as a design, is not interlocutory, but goes to the merits, and hence is appealable to the Examiners-in-Chief.*
- ROGERS et al., *Ex parte*. 13 O. G., 596.**  
**s. c., Com. Dec., 1878, 62..... 298**  
 Design for Casket Screw. Decided April 2, 1878.  
*Unity of design. Claims for whole and for each subordinate segregable feature, allowable.*
- SCHULZE-BERGE, *Ex parte*. 42 O. G., 293..... 324**  
 Improvement in Corrugated Glass. Decided January 5, 1888.  
*Rejection by Examiner on ground that matter is patentable by mechanical, and not by design patent, goes to the merits, and is appealable to the Examiners-in-Chief. Utility not used in same sense in design law as for mechanical inventions; defined and distinguished.*
- SEAMAN, *Ex parte*. 4 O. G., 691..... 279**  
 Design for Lamp-chimney Cleaner. Decided January 5, 1874.  
*"Useful" shape in design statute relates to utility of ornamental form and appearance, rather than to operative function.*
- SELLERS, *Ex parte*. Com. Dec., 1870, 58..... 242**  
 Design for Rolled Hollow Hexagonal Column. Decided June 8, 1870.  
*Pending application for mechanical patent cannot be changed by amendment into an application for a design patent. Reasons stated. Patent to alien. Design patent has to do with form or configuration, not with materials or mode of construction.*

- SHEPPARD, *Ex parte*. Com. Dec., 1870, 22..... 241**  
 Design for Stove Ornaments. Decided March 8, 1870.  
*Nothing in design law forbids two or more claims or clauses of claim in same patent. Previous practice of the Office on the subject reviewed.*
- SHOENINGER, *Ex parte*. 15 O. G., 384.  
 s. c., Com. Dec., 1878, 128..... 301**  
 Design for Sled. Decided November 20, 1878.  
*The Revised Statutes authorize design patents for new and useful forms, irrespective of whether they are or are not ornamental. "Useful" was first used in the Act of 1870. Previous Acts compared with Act of 1870, as to scope of patentable subject-matter. Previous Commissioners decisions under the several Acts reviewed and compared.*
- SOLOMON, Exec'r, *Ex parte*. Com. Dec., 1869, 49..... 227**  
 Design for Inkstand. Decided August 17, 1869.  
*The Acts of 1842 and 1861 are not confined to ornamental forms, but extend to those intended to promote convenience or utility.*
- SPERRY, *Ex parte*. Com. Dec., 1870, 139..... 248**  
 Design for Knife-handle. Decided October 28, 1870.  
*Extensions allowed under Act of 1870 of patents issued prior to March 2, 1861, but none as to patents granted between those dates.*
- STETSON, *Ex parte*. 36 O. G., 343..... 317**  
 Design for Dial for Time-piece. Decided May 26, 1884.  
*Numerals as part of design. Arrangement thereof not patentable, but form may be.*
- STUART & BRIDGE, *Ex parte*. Com. Dec., 1870, 15..... 239**  
 Design for Cooking Stove. Decided February 23, 1870.  
*Mechanical patent cannot be reissued in divisions, one for the mechanical features and the other for the design. Reasons stated. Previous mechanical patent is a complete bar to grant of subsequent design patent. Under Act of 1861, there must be no use or knowledge by others prior to application; different in this respect from mechanical invention which may be known for not exceeding two years.*
- TRAITTEL, *Ex parte*. 25 O. G., 783.  
 s. c., Com. Dec., 1883, 92..... 311**  
 Design for Finger Rings. Decided November 12, 1883.  
*A design consists merely of delineation of form or figure. Material and color form no part of it that is patentable.*

- TYLER, *Ex parte*. Com. Dec., 1871, 106..... 253**  
 Design for Clock Case. Decided April 27, 1871.  
*Form or ornamentation, but not material, alone affect the question of novelty and patentability.*
- WEINBERG, *Ex parte*. Com. Dec., 1871, 244..... 255**  
 Design for Muffs. Decided September 6, 1871.  
*Design patents not intended for protection of trade-marks. Must be inventive genius involved to support design patent. Mere substitution of colors not patentable, nor any blending or arrangement of colors, unless producing a new aesthetical effect.*
- WHYTE, *Ex parte*. Com. Dec., 1871, 304..... 260**  
 Design for Ornamental Prints for Fabrics. Decided November 28, 1871.  
*Design intended for trade-mark not patentable under Act of 1870. Suggested that specification should specify the article or class of goods to which design is to be applied.*

*Ex parte* JASON CRANE

Decided April 20, 1869.

Com. Dec., 1869, page 7.

In the matter of the application of Jason Crane for a patent for a Design for a Fur-set Box.

The construction heretofore given by the Office to the design statute since its passage in 1842, that it relates solely to designs of an artistic character as contradistinguished to those of convenience or utility, is too narrow, as the objects and intent of the law fairly and properly embrace those relating to utility merely, as well as ornament.

*Foote, Commissioner:*

The applicant designed a paper box, with compartments conveniently arranged for holding each of the articles composing a set of ladies' furs. It is neat in appearance, as well as convenient in use, and has commanded a preference in the market over other boxes for that purpose.

It was at first claimed that the new arrangement of the compartments was the proper subject of a general patent. This was denied by the office on the ground that, although skill and good taste had been displayed in designing the article, it did not come up to what might properly be termed a "new invention." A more limited patent is now asked for the design, and the question is presented whether the case comes within the statute relating to design patents.

The construction which has been given to that act by the office ever since its passage in 1842, is that it relates to designs for ornament merely; something of an artistic character as contradistinguished to those of convenience or utility. It was upon this view of the statute that the application was rejected by the examiner in charge, and, on appeal, by the board of examiners-in-chief. No judicial construction has yet been given to this part of the act.

Considerable reflection upon the subject has satisfied me that the objects and intent of the statute extend beyond the limit assigned to it by the office.

It provides, among other things, that any citizen "who by his industry, genius, efforts, and expense may have invented or produced any new and original design for a manufacture," or \* \* \* "any new and original shape or configuration of any article of manufacture," may obtain a patent therefor. It does not say "ornamental" design, or "artistic" shape or configuration, and I am unable to perceive any good reasons why designs for utility are not fairly and properly embraced within the statute, as well as those relating to ornamentation merely.

The line of distinction between what is useful and what is merely ornamental is, in some cases, very definite. By some it is said that any form or design that is most useful is also most pleasing. It would be impossible, in the view of such persons, to make any improvement in utility that did not at the same time add to the ornamental and artistic.

I can perceive no necessity for the distinction. There is a large class of improvements in manufactured articles that are not regarded as inventions, or as coming within the scope of general patent laws. They add to the market value and saleability of such articles, and often result from the exercise of much labor, genius, and expense. They promote the best interests of the country, as well as the creations of inventive talent. It seems to me to have been the intent of Congress to extend to all such cases a limited protection and encouragement. Whenever there shall be produced by the exercise of industry, genius, efforts, and expense any new and original design, form, configuration, or arrangement of a manufactured article, it comes within the provisions and objects of the act creating design patents, whatever be its nature, and whether made for ornament merely, or intended to promote convenience and utility.

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

*Ex parte* B. L. SOLOMON, EXECUTOR OF MYER  
PHINEAS.

Decided August 17, 1869.

Com. Dec., 1869, page 49.

In the matter of the application of Burnet L. Solomon, executor of the last will and testament of Myer Phineas, deceased, for the extension of a patent for a Design for an Inkstand, granted to the said Myer Phineas, August 19, 1862.

1. While the doctrine of the Office formerly, was that a design patent contemplated artistic excellence only, it is now held to be proper to grant such a patent for an article whether made for ornament merely, or intended to promote convenience or utility.
2. Both the value of the artistic excellence, as well as that of the functional usefulness of the article, taken into consideration, on application for extension in this case.

*Hodges, Acting Commissioner:*

The petitioner has shown his compliance with all the requirements of the office, with perhaps a single exception. It may be questioned whether he has made out that his testator's invention is of sufficient value and importance to the public to entitle him to an extension.

He has filed a number of affidavits, which fully establish the merit of the inkstand his testator devised and manufactured, and satisfy us that, if the article itself was the thing patented, it deserves to be further protected. It does not follow, however, that the mere design is equally meritorious.

The doctrine of the office has been, for a long time, that a patent for a design like the one before us could only be issued for articles possessed of artistic excellence, and that nothing else could be monopolized under such a patent. The advantages obtained in consequence of its mechanical construction were not supposed to enter into consideration. It was the "configuration" and not the construction which was held to be embraced in the grant.

Now, the affidavits filed by the petitioner all take into

account, in estimating the utility and value of his intestate's invention, the mechanical advantages of the article as constructed. They instance the ink being protected from the air; its being supplied automatically to the fountain; the cup for holding a sponge; and other peculiarities of a like nature. Some of the most important of these qualities are as old as the ancient fountain inkstand, and have long been public property; and none of them could be considered, according to the former practice, as constituting any part of the invention, or as enhancing its value.

It is true that the affidavits also speak of the merit of the design as a design merely, and include that in the estimates. But there is no attempt to discriminate the respective merits, so that it can be seen what valuation was set upon the artistic excellence of the design, as distinguished from its other advantages. If the Commissioner were to inquire whether that artistic excellence alone is so great as to justify the extension prayed for, he would have no data upon which he could proceed. He could only say that its value is so much when taken together with its usual functions—not what it is worth in itself.

But it is now held that “any new and original design, form, configuration, or arrangement of a manufactured article” comes within the scope of the Act of 1842 (and, of course, within that of 1861, Sect. 11), “whether made for ornament merely, or intended to promote convenience or utility.” Under the circumstances, it must be assumed that this is the present doctrine of the office. It has a vital bearing upon the case before us, and gives a new significance and effect to the affidavits which have been filed. The patent under consideration covers, under this rule, not only the beauty of the inkstand in point of form, but also all those advantages in point of utility and convenience, which result from its configuration, by which, in this connection, must be intended its construction. Some of these are old, it is true, but the combination of the whole is new. All the peculiarities enumerated by the affiants unite to give value to the article, and are proper elements to be taken into account in estimating it; and the opinions they give of its value become a just and proper basis upon which the Commissioner can form his own conclusion. They are so

full and explicit as to remove all doubt upon this point, in this view of the law.

The question of value is the only serious one in the case. No other objection seems to exist against granting the prayer of the petitioner, and his testator's patent is, therefore, extended.



*Ex parte* WILLIAM N. BARTHOLOMEW,  
ASSIGNOR TO J. BECKENDORFER.

Decided December 2, 1869.

Com. Dec., 1869, page 103.

In the matter of the application of William N. Bartholomew, assignor to J. Beckendorfer, for letters patent for a Design for Rubber Eraser.

1. The Office has heretofore correctly construed the Act of 1861, as well as the previous Statute of 1842, to include designs consisting of form or configuration which, whether involving artistic excellence or not, involve increase of utility; and this even where the sole utility of the new device arises from its novel shape or configuration.
2. There is no apparent reason, under the law, why designs may not be generic, why what are called "broad claims" may not be made to them, and why the doctrine of artistic or æsthetic equivalents may not be applied to them.
3. A design may be so generic in its character as to admit of many variations, which should embody its substantial characteristics and be entirely consistent with a substantial identity of form.
4. As the form is alone the thing patented, it is immaterial by what process that form is attained. The composition of matter or the mode of construction, must be protected by a patent of a different kind.
5. An old form may be so applied to a distinct article of manufacture as to make it technically a new article, and constitute the subject of a valid design patent.



*Fisher, Commissioner :*

Letters patent for designs have increased in importance within the last few years. Formerly, but few were granted; now, many are issued. To this day they have made so little figure in litigation that but three reported cases are known, in which design patents have come into controversy. With their increase, questions have arisen concerning their scope and character, which have given rise to dispute and to inquiry as to the correctness of the current practice of the office in this branch of invention. While, on the one hand, it is insisted that the practice has always been uniform, and is therefore now fixed and definite, on the other it is asserted that there has never been, and is not now, any well defined or uniform practice either in the granting or refusal of design patents.

The Act of 1836 made no provision for the patenting of designs. The earliest legislation upon this subject is found in the Act of August 29, 1842, section 3; and the only legislation upon the subject is found in this section and in section 11 of the Act of March 2, 1861.

The definition of the subject-matter, or, in other words, of a "design," is the same in both acts. It is as follows:

"That any citizen, etc., who by his, her, or their own industry, genius, efforts and expense, may have invented or produced any new and original design for a manufacture, whether of metal or other material or materials, and original designs for a bust, statue, bas-relief, or composition in alto or basso-relievo, or any new and original impression being formed in marble or other material, or any new and useful pattern, print, or picture, to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture, or any new and original shape or configuration of any article of manufacture not known or used by others," &c.

This definition embraces five particulars:

1. A new and original design for a manufacture.
2. An original design for a bust, statue, &c.
3. A new and original impression or ornament to be placed on any article of manufacture.
4. A new and useful pattern, print, or picture, to be

worked into or worked on, or printed, or painted, or cast, or otherwise fixed on any article of manufacture.

5. A new and original shape or configuration of any article of manufacture.

The first three of these classes would seem to refer to ornament only; the fourth, to ornament combined with utility, as in the case of trade-marks; and the fifth, to new shapes or forms of manufactured articles, which, for some reasons, were preferable to those previously adopted.

The disputed questions which have thus far arisen under these definitions, are: (1) What variations may be claimed or covered by the patent, consistently with unity of design? (2) Is a new shape of an article of manufacture, whereby utility is secured, a subject of protection under this act? and (3) Is mechanical function of any kind covered by it?

As to the first of these questions, it seems to have been assumed that the design spoken of in all parts of the sections referred, to covered a fixed, unchangeable figure; that the protection of the letters patent did not extend to any variation, however slight, but that such variation constituted a new design, might be covered by a new patent, and might safely be used without infringement of the first. This, it is said, is the correct theory of the law, and has been the uniform adjudication of the office.

Neither of these statements is absolutely correct. The law by no means defines a design with such strictness. The language is, "new and original design for a manufacture," "new and original impression or ornament," "new and original shape or configuration." It would seem to be too plain for argument that the new design, or impression, or shape, might be so generic in its character as to admit of many variations, which should embody its substantial characteristics and be entirely consistent with a substantial identity of form. Thus, if the invention were of a design for an ornamental button, the face of which was grooved with radial rays, it would seem that the first designer of such a button might properly describe a button of five rays, and, having stated that a greater number of rays might be used, might claim a design consisting generally of radial rays, or of "five or more" rays, and that it could not be necessary for him to take out a patent for

each additional ray that could be cut upon his button. So, if the design were the ornamentation of long combs by a chain of pearls, it would seem that a claim for such a design might be maintained against one who arranged the pearls either in curved or straight lines, or who used half pearls only; and that such modifications, if they had occurred to the designer, might properly have been enumerated in his specification as possible and equivalent variations. In short, I can see no reason, under the law, why designs may not be generic, why what are called "broad claims" may not be made to them, and why the doctrine of artistic or æsthetic equivalents may not be applied to them.

This has been recognized to a greater or less extent in the adjudication of the courts and in the practice of the office. One of the reported cases is that of *Booth v. Garelly*, 1 Blatchf. 247. The design is described as consisting of "radially formed ornaments on the face of the moulds or blocks of which the button is formed, combined with the mode of winding the covering on the same, substantially as set forth, whether the covering be of one or more colors." The specification, in "substantially" setting forth the design, contained this language: "It will be obvious from the foregoing that the figures can be changed at pleasure, by giving the desired form to the face of the mould, by depressions and elevations which radiate from a point, whether in the center of the mould or eccentric thereto." In the consideration of the case by the court, no objection was made to this statement or claim. In the case of *Root v. Ball*, 4 McLean, 180, the learned judge instructed the jury that "if they should find that the defendant had infringed the plaintiff's patent by using substantially the same device, as ornamental, on the same part of the stove, they would, of course, find the defendant guilty. To infringe a patent right, it is not necessary that the thing patented should be adopted in every particular; but if, as in the present case, the design and figures were substantially adopted by the defendants, they have infringed the plaintiff's right. If they adopt the same principle, the defendants are guilty."

"The principle of a machine is that combination of mechanical powers which produces a certain result. And,

in a case like the present, where ornaments are used for a stove, it is an infringement to adopt the design so as to produce substantially the same appearance."

It has been the constant practice to grant patents for designs for fonts of type, for sets of silver plate, for a series of printers' flourishes, and the like. This class of cases has always passed without objection. Two other cases which have arisen within the office deserve notice. The first was for a series of miniature shoulder-straps, with emblems denoting rank, provided with a pin, to be worn under an officer's coat, upon his vest, or as a lady's breastpin. The drawing shows eight of these pins with emblems of rank, varying from that of second lieutenant to major-general; and the specification, describing the brooch for a second lieutenant, goes on to say: "I propose to introduce on some of them the different ornaments showing the respective ranks of the army from a major-generalship to a second lieutenancy. See figures 2, 3, 4, 5, 6, 7, 8."

The second case was that of an application for a monogram visiting card, on which the name was to be inscribed or printed in the form of a monogram. The applicant filed a drawing, showing a card upon which was a monogram of his own name. In his specification he gives certain rules for forming such monograms, and then says: "It is manifest that the form of the letters, as well as the letters themselves, can be changed as required by circumstances or the taste of the individual for whom the monogram is designed; and that the general form and outline of the monogram may be varied, and, indeed, must vary to be adapted to the particular name it is required to represent." The claim was for "a monogram visiting card, or visiting card upon which the name is inscribed or printed in the form of a monogram, substantially as herein specified." This application was rejected by the examiner and board of examiners-in-chief, but was allowed by the Commissioner upon appeal.

It is true that, before and since this patent was issued, many patents have been refused, for what I have called generic designs. One man, having designed a tack-head ornamented with radial lines, was compelled to take out one patent for his tack with six radial lines, and another for the

same tack with eight. There are other instances of like character, but they only serve to show that the practice of the office has not been uniform, and that the true practice is still to be adopted and followed.

I have no hesitation in saying, in view of the premises, that a valid patent may be granted for a new genus or class of ornaments, as well as for specific ornaments, though I do not doubt that, under the statute, every species, variety, and individual having distinct characteristics, under such a genus, might also be patented, the patent being subordinate and tributary to that which covered the class.

From the nature of this subject matter, there must always be more latitude in the issue of patents for trifling changes of form or outline, since it is only necessary that such changes should constitute a new design to entitle them to a patent of this class.

The second question relates to the element of utility in patents for designs.

Upon this point, it is said by my predecessor, in *Jason Crane, ex parte*, Commissioner's decisions, May, 1869, p. 1, "that the construction which has been given to the Act of 1842 by the office, ever since its passage, is that it relates to designs for ornament merely; something of an artistic character as contradistinguished to those of convenience or utility."

The board of examiners-in-chief, in the present case, say: "The practice of the office has been uniform from the beginning, and has always excluded cases like the present from the benefit of the laws relating to designs." And again, "The general understanding has always been that the Acts of 1842 and 1861 were intended to cover articles making pretensions to artistic excellence, exclusively."

In thus denying that a new "shape or configuration" of an article, whereby utility or convenience is promoted, is the proper subject of a patent, under the acts referred to, the office would seem to have involved itself in the absurdity that if a design is useless it may be patented, whereas if it be useful it is entitled to no protection.

Fortunately, no such "uniform practice" has existed, and the office is relieved from so grievous an imputation. The practice seems to have been taken for granted by the

appellate tribunals; and so far from being as stated, is, as nearly as possible, the reverse of it.

Articles have been, and are being constantly, patented as designs which possess no element of the artistic or ornamental, but are valuable solely because, by a new shape or configuration, they possess more utility than the prior forms of like articles.

Of this character are designs for axe-heads, for reflectors, for lamp shades, for the soles of boots and shoes, which have been heretofore patented as designs; and to this class might be added with great propriety that class of so-called "mechanical" patents granted for mere changes of form, such as plowshares, fan blowers, propeller blades, and others of like character.

When, therefore, my learned predecessor in Crane's case added to this number a box so designed as to hold, with convenience, a set of furs, he did but confirm, and not alter, the practice of the office, so far as it can be gleaned from the patented cases.

I am of opinion that the class of cases named in the act arising from "new shape or configuration," includes within it all those new changes of form which involve increase of utility. This I take to be the spirit of the decision in *Wooster v. Crane*, 2 Fisher, 583. The design was of a reel in the shape of a rhombus. The learned judge says: "In this case the reel itself, as an article of manufacture, is conceded to be old and not the subject of a patent. The shape applied to it by the complainant is also an old, well-known mathematical figure. Now, although it does not appear that any person ever before applied this particular shape to this particular article, I cannot think that the act quoted above was intended to secure to the complainant an exclusive right to use this well-known figure in the manufacture of reels. The act, although it does not require utility in order to secure the benefit of its provisions, does require that the shape produced shall be the result of industry, effort, genius, or expense, and must also, I think, be held to require that the shape or configuration sought to be secured shall at least be new and original as applied to articles of manufacture. But here the shape is a common one in many articles of manufacture, and its application to

a reel cannot fairly be said to be the result of industry, genius, effort, and expense. No advantage whatever is pretended to be derived from the adoption of the form selected by the complainant, except the incidental one of using it as a trade-mark. Its selection can hardly be said to be the result of effort even; it was simply an arbitrary, chance selection of one of many well-known shapes, all equally well adapted to the purpose. To hold that such an application of a common form can be secured by letters patent, would be giving the Act of 1861 a construction broader than I am willing to give it."

It would seem from this language that if there had been "advantage," *i. e.*, utility, in the adoption of the form of the rhombus it would have found more favor in the eyes of the court.

This subject has been well discussed in the opinion of Commissioner Foote, in *Crane, ex parte*. I concur in that opinion; except as to the recital of the former practice of the office, which a careful examination has shown to be erroneous.

The third question may be readily disposed of. Modes of operation or construction, principles of action, combination to secure novelty or utility of movement, or compositions of matter, can hardly be said to be "shapes, configurations, or designs," but where the sole utility of the new device arises from its new shape or configuration, I think it may fairly be included among the subjects which the act of 1842 was designed to protect.

The present case may, in view of the foregoing considerations, be disposed of without difficulty. Letters patent are asked by applicant for a new design for a rubber eraser, which consists in giving to the eraser a cylindrical body, with ends beveled to an edge. The claim is for the "cylindrical rubber eraser, provided with a wrapper or case, as herein shown and described." In the body of the specification, the applicant describes the mode of making the eraser, and he also enumerates its advantages over erasers of the ordinary forms. The examiner does not object to the application because of the utility of the eraser, although the board of examiners-in-chief seem to base their decision upon that point alone, but he pronounces the form already

old in its application to artists' stumps, and he insists that the mode of composition or construction can form no element of the claim for a design patent.

In the latter statement he is undoubtedly right. These patents are granted solely for new shapes or forms, and the form being new it is immaterial by what process that form is attained. The composition of matter or the mode of construction is neither "design," "shape," nor "configuration," and must be protected, if at all, under a patent of another kind.

I cannot say that the presence of such matter in the specification would be objectionable, if descriptive merely, but it could in no way be allowed to enter into or modify the claim.

As to the first ground of rejection, I think the examiner is in error. This purports to be a new form or shape of a distinct article of manufacture, to wit: rubber erasers. If it be new, as thus applied, it is immaterial whether pencils, or stumps or penhandles, or anything else, may or may not have been made cylindrical. If they are not substantially the same articles of manufacture as erasers, the old form applied to this new article is unquestionably entitled to protection.

The applicant has not defined his invention with entire accuracy. He should strike from his claim the words "provided with a wrapper or case," as these relate to construction, and not configuration; and he should insert the words, "having the ends beveled to an edge," in lieu of the phrase erased, or he should adopt the usual form of claims for designs, viz.: "The design for a rubber eraser as shown and described."

As the claim stands, it ought not to be allowed, and the decision must be affirmed; but the applicant will be allowed to amend as suggested.



*Ex parte* ISRAEL C. MAYO.

Decided February 23, 1870.

Com. Dec., 1870, p. 14.

In the matter of the application of Israel C. Mayo, for letters patent for a Design for a Transparent Shield.

Application for design patent, under Act of 1861, must contain an election as to the term of patent desired. No amendment in this respect is permissible under the statute.

*Fisher, Commissioner:*

The applicant makes application for a patent for a design. He pays ten dollars into the treasury, and adds to his petition the following proviso: Should the commissioner be willing to allow a patent on this application, the undersigned wishes to pay into the treasury the further sum of twenty dollars, and have such patent granted for fourteen years, instead of three and a half years."

Section 11 of the Act of March 2, 1861, provides that upon application for a patent for a design, "the commissioner, on due proceedings had, may grant a patent therefore, as in the case now of application for a patent, for the term of three and one-half years, or for the term of seven years, or for the term of fourteen years, as the said applicant may elect in his application; provided, that the fee to be paid in such application shall be for the term of three years and six months, ten dollars; for seven years, fifteen dollars; and for fourteen years, thirty dollars."

This language contemplates an election to be made by the applicant, at the time of his application, of the term for which he desires his patent to issue, and the payment of a fee corresponding to that election. It does not contemplate the contingency of an application for one term and the payment of one fee, and a subsequent election, at the time of issue, of another term and the payment of another fee. The words are "elect in his application." The choice is to be made there, and not elsewhere or otherwise, and being made must be final.

I can see that the practice proposed might be desirable, and might result in the granting of design patents for a longer period, and the receipt of a larger revenue; but I have no power to alter the plain language of the statute, or to extend the time of election beyond the time of making the application, for any purpose.

In the present case the applicant has paid a fee of ten dollars. His patent, if granted, can issue only for three and a half years.



*Ex parte* STUART & BRIDGE,

Decided February 23, 1870.

Com. Dec. 1870, p. 15.

In the matter of the application of David Stuart and Lewis Bridge for letters patent for a Design for a Cooking Stove.

1. Previous mechanical patent describing the design granted either to the inventor or to others, will bar a subsequent design patent therefor, as under the Statute of 1861, it must not be known or used prior to application for patent, and no provision is made for a permissible use or sale prior thereto as in case of other inventions.
2. The Act of 1836 allowing reissues, do not authorize reissues in divisions, one of which shall be for the design shown in the mechanical patent surrendered. Reasons stated.

*Fisher, Commissioner :*

The applicants, on November 3, 1868, patented the arrangement of ovens and flue in a cook stove having a peculiar external conformation. On February 5, 1870, they filed an application for a design substantially identical with that shown in their patent of 1868.

Upon this state of facts the examiner asks: 1. Should the application be rejected on the patent? 2. If so, can the patentees reissue in two divisions, one of which shall be for the design? 3. If so, what fees are required?

Section 11 of the Act of March 2, 1861, provides that the new design, &c., shall not be "known or used by others

before his, her, or their invention or production thereof, and prior to the time of his, her, or their application for a patent therefor," &c.

It will be observed that no provision is made, for use or sale of the invention prior to the application, as in the case of other inventions; and the reason of the distinction is found in the fact that as designs relate to form and shape only, no time is required for experiment before the application. At all events, the language of the statute is plain. The design must not have been known or used by others prior to the application of the inventor. It is obvious that if the design be described in a prior patent, granted either to himself or others, it is known to others within the meaning of the law. The present application must therefore be rejected upon the former patent.

The second question is, whether the original patent can be surrendered and reissued in two divisions, one of which shall be for the design.

Patents for designs may be granted for three and one-half, seven, or fourteen years, at the election of the applicant, made at the time of application. Patents for other inventions are granted for seventeen years.

The patent granted to applicants in November, 1868, was of the latter kind, and was granted for seventeen years.

It is provided by Section 13 of the Act of 1836 that upon applications for reissue "it shall be lawful for the commissioner, &c., to cause a new patent to be issued to the said inventor for the same invention, for the residue of the period, then unexpired, for which the original patent was granted."

This language is explicit, and it is obvious that under this section any reissue of this patent, or any division of such reissue, must be granted "for the residue of the period then unexpired for which the original patent was granted;" that is, for the residue of seventeen years. But no patent for a design can be granted for seventeen years, or for the residue of an unexpired period of seventeen years; and this fact seems decisive of the question.

The result is that an invention of a design, if shown in a patent for a mechanical invention, is lost, and cannot be included in a subsequent application and patent for a design.

*Ex parte* ISAAC A. SHEPPARD.

Decided March 8, 1870.

Com. Dec. 1870, p. 22.

In the matter of the application of Isaac A. Sheppard for letters patent for a Design for a Stove Ornament.

There is nothing in the design statute forbidding two or more claims in same patent. If the design contains features which are new, singly and in combination, they may be so claimed, both upon reason and precedent.

*Fisher, Commissioner:*

This case is referred to me by the primary examiner upon the following statement:

“In this application for patent for design of Isaac A. Sheppard, filed February 24, 1870, are found two claims: one for the central figure (which constitutes the gist of the case), when cast on and forming a part of a stove plate, and the other for the central figure and surrounding ornaments.

“In dealing with this case, the examiner finds that it has not been the usual practice of the office to allow more than one claim in an application for a patent for a design. The reasons generally given to sustain this course of action are that a design is a complete and individual device or ornament, and as such must be exact and perfect in every form, line, or configuration, the slightest deviation from what is represented operating to make a new design.

“The law evidently makes no such inflexible rule of official practice. In the Bartholomew case, Commissioner’s Decisions, 1869, p. 111, it is observed that a certain reasonable and proper latitude is given in judging what does and what does not breathe the spirit of the invention in any given case, and that mere colorable variation is to receive no more countenance or favor in an application for a patent for a design than it would in an application for a mechanical device.

“But while the examiner is impressed with these views, he is unwilling in his first decisions, in applications of the

present character, to overrule, so far as falls within his jurisdiction, the generally settled custom and rule of the office in the above particular. He desires, therefore, to refer the whole matter to the personal consideration of the commissioner, as a question of office practice for his decision or direction.

“L. DEANE, *Examiner.*”

I agree with the examiner that there is no provision in, or fair construction of, the act relating to letters patent for designs, which forbids the union of two or more claims or clauses of claim in a single patent. I am at a loss to know upon what ground such a construction can be asserted or maintained. If the design contains features which are new, singly and in combination, no reason is known to me why they may not be so claimed.

But the practice of the office has not been so uniformly adverse to the granting of double claims as seems to have been supposed. On the contrary, letters patent for designs containing more than one claim were granted in the years 1855, 1857, 1858, 1859, 1860, and 1862, and doubtless in the succeeding years, if time had permitted a further examination. Among these, special reference is made to the patent granted to Appollos Richmond, in 1859, which contains one claim for the configuration of a stove plate, and another for the ornament upon the same plate; and to the patent granted to Isaac B. Woodruff, in 1862, for a design for a clock-case, which contains one claim for the configuration of the whole case, and another for a gilt frame forming a subordinate part of the same whole.

These cases fully justify the claims presented in the present application, which may, therefore, be allowed, both upon reason and precedent.

—o—

*Ex parte* GEORGE H. SELLERS,

Decided June 8, 1870.

Com. Dec. 1870, p. 58.

In the matter of the application of George H. Sellers for letters patent for Improvement in Rolled Hollow Hexagonal Column.

1. An application for mechanical patent cannot be changed, by amendment, into one for a design patent. It is not a matter of classification, nor within the discretion of the Commissioner.
2. Whether an invention is within either class defined by the several statutes, is matter of legal determination, and an error is fatal.
3. Novel configuration is independent of materials or mode of construction. If shape is old as applied to the article, its production by a novel process, or with novel material, will not constitute patentable design novelty.

*Fisher, Commissioner:*

Applicant filed in September, 1868, an application for a patent for "a new and useful improvement in a rolled hollow hexagonal column." He claimed, in terms, "a hollow column of uniform thickness, hexagonal in both its interior and exterior, and rolled out from a solid or welded pile or billet of iron or steel, with a hexagonal opening through it, substantially as described and represented."

Becoming satisfied that he could not succeed in obtaining a patent for his supposed invention in this shape, he now proposes to change his application into one for a patent for a design. He asks to be allowed to deposit a further fee of \$15, making \$30 in all. He avers that it was by inadvertence and mistake that the fee of \$30 was not paid originally, and the application made in terms for a patent for a design, under Section 11 of the Act of March 2, 1861. He presents an amended specification in which the invention is described as a "new and original shape or configuration of steel or wrought-iron rolled pipes, tubes, or hollow shafts or pillars," and is claimed in the following terms: "as a new and original shape or configuration of tubes, pipes, hollow shafts or hollow pillars or posts of steel, or of wrought or malleable iron, a machine-rolled tube or pipe or hollow shaft or hollow post, of uniform and symmetrical hexagonal perimeter, area, and cross section, in every part of its length, and having no projections upon its surface or beyond its angles."

In support of his prayer he urges that the question whether his patent be for an invention of a design is merely one of classification, which is within the discretion

of the commissioner, and he insists that this is a case in which that discretion ought to be exercised in his favor.

Prior to the Act of August 29, 1842, there was no law which permitted the granting of letters patent for "shapes," "configurations," "designs," "ornaments," "patterns," and the like, which did not involve some mechanical principle or amount to a new machine or manufacture within the meaning of the patent law.

By that act and the Act of March 12, 1861, these subjects were made patentable, not by enlarging the scope of the existing patent laws by the addition of new subjects of invention, but by independent legislation, providing for a new class of patents, granted to a different class of persons, for a different class of subjects, for different periods of time, and upon the payment of different fees.

It is not a matter of discretion with the commissioner whether the subject of an application be a machine, or a design for a manufacture; a manufacture, or a new and original shape or configuration of an article of manufacture; a composition of matter, or a composition in alto or basso-relievo, an art, or a pattern, print or picture. It is a matter of law in which a mistake is fatal. These subjects of invention or contrivance are in truth as distinct from each other as either is from a copyright.

The applicant treats this matter as if it were simply a matter of mistake as to the term for which he should have applied for letters patent; but in truth the error, if error there were, was in the character of the application itself. He applied for a patent for a new product, paying the fee for an examination, and praying for a patent for seventeen years. He described not a design for a manufacture, but a manufacture. He claimed not a new shape, but a new thing. I know of no discretion or authority vested in the commissioner to turn this application into an application for a design, nor any process by which it can be accomplished short of a new application. A single illustration will make this sufficiently obvious. An alien may apply for letters patent for an invention, but not for a design, unless he has resided in this country for more than one year, and made oath of his intention to become a citizen. It would be impossible therefore to turn the application of the alien for

an invention into an application for a design, however clearly the subject-matter might place it in the latter class of subjects.

I regard the eleventh section of the Act of 1861 as distinct from the remainder of the law as if it formed the subject of a separate statute, and the codifiers of the patent laws evidently so regarded it, for they collected all the matter relating to design patents in a separate chapter.

There is another objection which is fatal to this application. A new shape or configuration is independent of materials or modes of manufacture. If the shape be old as applied to the thing, it cannot avail that the thing is produced by a new process or wrought in a different material. If cast hexagonal columns are old, no patent can be granted for wrought columns of a hexagonal shape. It is immaterial, so far as the design is concerned, whether the column be cast, hammered or rolled, or whether it be of cast iron, malleable iron, or steel. (See W. N. Bartholomew, *ex parte*, Commissioner's Decisions, 1879, p. 103.)

The applicant now claims hollow shafts, &c., "of wrought or malleable iron," "machine-rolled tube or pipe," of a hexagonal form, &c. This is evidently intended to avoid the references already given, of those which may be given to cast iron hexagonal pipes or columns; or to those which form a hexagon when united, although not rolled in a single piece. These incidents have nothing to do with the design, the claim for which stands only upon novelty of form, and cannot be strengthened by their introduction.

The motion of applicant is overruled.

—o—

*Ex parte* WILLIAM KING.

Decided September 19, 1870.

Com. Dec., 1870, p. 109.

In the matter of the application of William King for letters patent for a Design for a Trade-mark.

Pictorial designs intended for trade-marks cannot be patented under the design statute of July 8, 1870, Sec. 71; because Section 77 of that act, which provides a mode of protecting trade-



marks, excludes, by implication, all other modes. The statute relates to external ornamentation of manufactured articles, and to specific articles to which the same is to be applied.

*Fisher, Commissioner :*

Applicant tenders \$30, and asks for a patent for fourteen years for a "design for a trade-mark." He says: "The distinctive features of my design consist of my portrait placed in the center, lengthwise, and surmounted by the British coat-of-arms, about which is arranged in a semi-circular form the words, 'King's Sauce Royal.' Upon the left of my portrait is a shield or tablet containing the words, 'Shake well the bottle before using, and upon the opposite side a similar tablet containing the words, 'None genuine without my portrait and signature, W. King,' said signature being a fac-simile of my handwriting. Although the above-named tablets are used, they are not considered as essential to the design, and may be omitted if desired.

"Having thus fully set forth the nature and merits of my invention, what I claim as new is, the hereinbefore described design, substantially as shown."

Prior to the Act of July 8, 1870, no protection was afforded by statute for trade-marks *eo nomine*. They were left to the protection of the common law; except where the design was of such character as to fall properly within the subjects patentable as designs. In such case they have been patented, usually with the addition of the words, "for a trade-mark." These words were, however, merely descriptive, and carried with them no guarantee as to the use of the trade-mark. In other words, if goods had been sold with such a design affixed, the only penalty that could have been recovered, under the statute, would have been for the infringement of the design, as an ornament, and no recovery could have been had of the damage resulting to the injury to the trade of the manufacturer, by a violation of his trade-mark in the sale of the articles to which it was attached.

It was to remedy this evil, and to give promptly, by statute, that protection to trade-marks which the common law tardily afforded, that Congress passed so much of the

act of July 8, 1870, as relates to this subject. By the provisions of that act, a trade-mark, whether old or new, may be registered in the Patent Office by its owner, and by the payment of \$25 protection is afforded for thirty years. As this protection is more ample, and covers more than double the time for less money, it is difficult to see why applicant, or any one else, should now seek a design patent for a trade-mark. The folly of the application does not however relieve me from the necessity of deciding upon its legality.

The only clause of the designs act under which trade-marks can possibly fall is that which enumerates "any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture." This manifestly refers to the external ornamentation of manufactured articles, and it requires, first, a specific article of manufacture to be ornamented; and, second, an impression, ornament, pattern, print, or picture to be placed upon it. It was only by a forced construction of this clause that designs, which were to be used only as trade-marks, or selling labels, could be included within it.

But the subject is relieved of all difficulty by Section 77 of the late statute. It is there enacted that any person, corporation, &c., "who are entitled to the exclusive use of any lawful trade-mark, or who intend to adopt and use any trade-mark, for exclusive use within the United States, may obtain protection for such lawful trade-mark by complying with the following provisions." This provision, by prescribing the statutory mode of obtaining protection for a trade-mark, excludes all other modes not expressly provided for, and operates as a construction of Section 71, in excluding trade-marks from the list of subjects intended to be protected as designs.

In accordance with this opinion, the present application, and all others which are intended to cover trade-marks, or "designs for trade-marks," must be presented under the provisions of Sections 77-84 of the Act of July 8, 1870, and not otherwise.

*Ex parte* EGBERT W. SPERRY.

Decided October 28, 1870.

Com. Dec., 1870, page 139.

In the matter of the application of Egbert W. Sperry, for the extension of letters patent, Nos. 2641 and 2642, for designs for a Knife, Fork, or Spoon Handle, granted April 30, 1867.

Extensions of patents are only granted by virtue of express authority conferred by statute. The Act of March 2, 1861, authorizing such, was repealed by the Act of July 8, 1870, except as to patents granted before the date of the prior act. The fact that the petition for extension was pending at the time of the passage of the Act of July 8, 1870, does not bring the case within the proviso of the repealing clause of that act so as to preserve the right to an extension.

*Duncan, Acting Commissioner:*

The patents which it is now sought to extend are for designs, and were granted April 30, 1867, for the term of three and one-half years. The petitions for the extensions were filed respectively June 3, and May 31, 1870.

The remonstrants object to the grant of the extensions on the ground, *inter alia*, that under the existing law the commissioner has no power to entertain the applications.

The commissioner's sole authority for extending patents is derived from positive legislative enactment, and in the exercise of this power he is bound to restrict his action to the exact limits established by the statute. The only parts of the new law relating in terms to this subject are the sections (63 and 67 inclusive) which provide for the extension of patents for inventions or discoveries, and section 74, which enacts that "patentees of designs issued prior to March 2, 1861, shall be entitled to extension of their respective patents for the term of seven years, in the same manner and under the same restrictions as are provided for the extension of patents for inventions or discoveries issued prior to the second day of March, 1861."

The patents now offered for extension, being patents for designs issued since the second day of March, 1861, do

not come under either of these provisions, and consequently the commissioner has no power in the premises, unless, by reason of the fact that the applications were filed prior to the passage of the present law, applicant thereby acquired rights which are preserved to him by the repealing section of the law.

The Patent Act of 1861 (section 11) gave the commissioner power to extend design patents. The repealing section of the Act of July 8, 1870, contains the proviso that the repeal of the existing laws relating to patents "shall not affect, impair, or take away any right existing under any of said laws." The rights here referred to would seem to be such rights only as may form the basis of a suit at law or in equity, the further language of the proviso being as follows: "But all actions and causes of action, both in law and in equity, which have arisen under any of said laws, may be commenced and prosecuted, and if already commenced, may be prosecuted to final judgment and execution, in the same manner as though this act had not been passed." Manifestly the rights here contemplated can have no relation to the right of an applicant for an extension to have his case examined and acted upon by the Commissioner of Patents. This right, as existing in cases pending at the time of the passage of the new law, does not appear to have been preserved by the proviso quoted.

Neither has applicant any rights preserved to him by the second proviso of the repealing section of the new law, which is in these words, viz: "That all applications for patents pending at the time of the passage of this act, in cases where the duty has been paid, shall be proceeded with and acted on in the same manner as though filed after the passage thereof." While this proviso may fairly be construed to cover applications for extensions, as well as for original patents and for reissues, yet manifestly it cannot include any class of cases over which, if filed subsequently to the passage of the act, the commissioner could not assume jurisdiction. The present cases fall within this last category, and cannot, therefore, be subject to the operation of the proviso.

There would seem, therefore, to be no power vested in the commissioner to grant the extensions asked for, even if

applicant had furnished satisfactory evidence upon the various questions involved in every extension, and in which the burden of proof is thrown upon the party making the application. In point of fact no ascertained value of the inventions is shown, and applicant has utterly failed to show that the lack of remuneration has been without neglect or fault on his part.

The extension must be refused.

—o—

*Ex parte* E. RAY FENNO.

Decided February 27, 1871.

Com. Dec., 1871, page 52.

In the matter of the application of E. Ray Fenno for letters patent for a Design for Damper for Stove-pipes.

Design specification for new form or configuration, while it may describe mechanical construction, must be confined to shape or form in the claiming clause.

The Statute of July, 1870, is different from that of March, 1861, in that the latter required only that the design be "new and original," while the former uses the terms "new, useful and original;" and this is sufficiently comprehensive to include any useful shape for an article of manufacture, even though no ornamental effect be produced thereby.

*Duncan, Acting Commissioner:*

Applicant's damper consists of two plates, the one being a slide which works over an orifice in the other, opening and closing it at pleasure, the main plate at the same time being made capable of partial rotation on an axis. The opening in the principal plate is bounded on the one side by the arc of a circle, and on the other by an irregular curve. The patent granted to E. Munson, February 16, 1864, shows a damper having precisely the same mechanical construction, the only difference being in the shape of the opening, which in Munson's damper is rectangular.

Fenno, the present applicant, came before the office in 1867, asking for a patent for his adjustable damper re-

garded as a mechanical device. He was rejected upon the patent of Munson. He carried his application through the various appeals allowed by law, and the correctness of the examiner's decision was finally affirmed by the highest appellate tribunal. Mr. Justice Fisher, in rendering his decision upon the appeal, uses the following language: "In this case there is not the least appreciable difference between the damper of applicant and that of Munson, to which reference was made in the office. They are identical in principle, so completely that the wonder is that the case should have been carried beyond the first rejection by the primary examiner."

Fenno now comes forward with this new application, in which he asks for a patent on his alleged "new and original design" for a stove-pipe damper. The examiner declines to pass upon the question of novelty, raising the preliminary objections, (1) that mere shape is but a fractional part of the end desired to be covered by the case; and (2) that the claim for a patent is inadmissible, inasmuch as the device is to perform its function inside a stove-pipe, where, from the nature of things, mere beauty of form or ornamental configuration can play no part.

The first objection raises a question as to the good faith of the party in making his application in the present form. A careful reading of the specification shows that the objection is not entirely without foundation. The nature of the invention is set forth in the opening of the specification in the following language: "The invention consists in making the damper in two parts, one part being stationary, and the other part being made to slide thereon, as hereinafter more fully described;" and then follows the elaborate description of the mechanical construction and the mechanical functions of the various parts of the damper. Following this description, the claim for "the design for damper as shown," is, to say the least, ambiguous, and the inference would seem justified, that applicant is now endeavoring to obtain covertly what he failed to accomplish by direct method upon the former application.

As the specification is now drawn, the examiner's first objection must be regarded as well taken.

But it is manifest that the specification is susceptible of

amendment, so as that the mechanical construction of the damper shall be distinctly disclaimed, and the claim be confined to the special form of the opening in the main plate; and the question then recurs whether, if so amended, the claim would be of a patentable character, and the novelty of its subject-matter should be inquired into by the examiner.

Among the various things which may form the subject of design patents under the amended law is, "any new, useful and original shape or configuration of any article of manufacture," which has not been known or used by others, or patented or described in any printed publication, prior to the invention or production thereof by the applicant.

There is here no limitation as to the use to which the article, wrought into the particular shape designed for it, is to be subjected; and no suggestion that mere beauty of form or ornamental configuration are the ends sought. In fact, the language quoted expressly implies that utility may be the sole object had in view, in the invention or selection of the particular form to be impressed upon the manufacture; and I am of the opinion that under the present statute, if a new, and at the same time useful shape be devised for a particular article of manufacture, even though no ornamental effect be produced thereby, the inventor of the same is entitled to protection for it under the design section of the patent law.

It should, however, be borne in mind by the examiner, in the further consideration of the present case, that, as regards designs for articles of manufacture, the present law is different from that which it supersedes. Formerly it was only required that the design be new and original; now it must be new, useful, and original. If, therefore, Fenno should so amend his specification as to relieve it of the first objection urged, it would still be incumbent upon him to show that some useful result is produced by changing the form of the opening as shown in Munson's patent to that shown in the pending application. As the specification now stands, no utility of the one form over the other is alleged; and it is propounded as a fair subject for examination whether any in fact exists.

The case is remanded to the examiner for the considera-

tion of such amendments as the applicant may desire to present, and of such arguments on the question of utility as the nature of the case will admit of. -



*Ex parte* WALTER L. TYLER.

Decided April 27, 1871.

Com. Dec. 1871, 106.

In the matter of the application of Walter L. Tyler for letters patent for a Design for a Clock Case.

The specification may describe mode of construction and materials, if not relied on to support patentability, but merely “to the end that the shape, the ornamental effect or design, may be more apparent.

If mode of construction secures an appearance—a presentation to the eye—substantially different from anything then known, the former may be described, and the latter claimed, in a design patent.

*Leggett, Commissioner :*

The applicant described his design, which he claims as new and original, as follows, viz:

The case is of a circular form, and is provided with the usual round metallic sash, A. B C are the several laminæ of dark and light colored wood. The sides of the case are flaring, so that the several laminæ may be seen when the case is viewed directly from the front. The edges of each of the laminæ are slightly rounded, thus corrugating the flaring sides, as shown in the drawing.

Fig. 2. The whole formed and combined as shown and described, to produce a new design for a clock case. I claim as my invention the design for a clock case substantially as shown and described.

The examiner rejected this application by reference to Jerome patent of June 16, 1863, and the rejected application of Green, filed October 19, 1867.

The board of examiners-in-chief affirm the decision of the examiner, and add that “the applicant evidently relies upon the difference in construction, to substantiate his claim



to a patent. This ground is believed to be utterly untenable. Shape, configuration, ornamental design, may be protected by a design patent; but the material used, or mode of construction employed, cannot in any way affect the question of novelty or patentability."

The doctrine in reference to design patents, as set forth by the board, is undoubtedly correct, but whether it applies against the applicant depends entirely upon whether "he relies upon difference in construction to substantiate his claim to a patent."

I confess that I cannot see, in the applicant's specification and claim, as quoted above, any evidence of reliance upon "difference in construction." It is true he briefly described the process of construction, but only to the end that the shape, the ornamental effect or design, may be more apparent. His mode of construction secures an appearance, a presentation to the eye, substantially different from that of either of the references. Jerome's patent shows a circular clock case, which, if viewed from the front, shows two stripes of wood and two of brass; but if viewed from the sides, only one of brass and one of wood, and has the appearance of the ordinary clock case, having a wood body and brass sash, and is not ornamented by alternate stripes at all.

Green's rejected application was for an oval picture frame, constructed of alternate rings of different colored woods, the outer ring having the greater projection. This would also show alternate stripes of different colors when viewed directly in front, but if viewed from the side or edge, only a single wood of a single color is presented to the eye.

The application shows a design of a clock case which presents to the eye several alternate stripes of different colors, and so arranged as to exhibit these stripes from whatever direction the case may be viewed.

The three cases exhibit a slight resemblance in ornamentation when viewed from directly in front, but the design described by applicant is radically different from either of the others when viewed from any other direction.

The decision of the board of examiners-in-chief is therefore reversed.

*Ex parte* PHILIP WEINBERG.

Decided September 6, 1871.

Com. Dec. 1871, 244.

In the matter of the application of Philip Weinberg for Design Patent on Muffs.

The statute (of 1870) does not contemplate the grant of a design patent to serve merely the purpose of a trade-mark.

The word "produced" in that law does not qualify the associated word "invented," so as to authorize the grant of a design patent for anything not involving an exercise of inventive genius. The word "invention" had become so intimately associated with improvements in functional constructions, that the word "produced" was used in the statute in connection with the word "invention," merely to relieve it of its functional signification.

Read in connection with the words "genius" and "original," found in the statute, the word "produced" carries a higher signification, meaning "created," and implying the exercise of a higher faculty that is indicated by "invented" alone.

In mechanism, an exercise of constructive genius may, perhaps, be sufficient to support a patent, but a design patent presupposes an exercise of creative genius, an original thought, a new idea begotten and embodied.

While it is not now held that a design patent cannot be based on colors, a mere substitution of one color for another possesses no element of originality, and indicates no exercise of genius sufficient to support a design patent; nor can any blending or arrangement of colors, unless a new æsthetical effect is produced, and an original idea indicated.

*Leggett, Commissioner :*

This case comes from the primary examiner on the following question:

Can color, parti-colors (innumerable), their indefinite shades and contrasts or measurements, form the proper subject for a design patent, and how far, if at all?

It is clear that the law never was intended to give a

man a design patent to serve merely the purpose of a trade-mark.

A prerequisite for a patent of any kind is an exercise of inventive genius. This is no less true of design than of functional patents. It is true the section of the law relating to design patents says, "that if any person by his own industry, genius, efforts, and expense has invented or produced any new and original design," &c.; and many seem to suppose that by the introduction of the word "produced," it was intended to grant design patents without evidence of the exercise of inventive genius, and hence patents are continually sought, and sometimes granted, for the most trivial changes in form or color. The word "produced" was never intended to give any such latitude, nor was it intended in any way to let down the standard for grant of patents. The word "invent" had become so intimately associated with improvements in functional constructions and combinations, that the word "produced" was used in connection with the word "invention," merely to relieve it of this functional signification. When read in connection with the words "genius" and "original," as found in the statute quoted, the word "produced" is evidently used with a much higher signification than merely made or constructed; it means created. "Invented or produced," as used in this section of the law, means the exercise of a higher faculty than would have been indicated by "invented" alone.

In mechanism an exercise of constructive genius may, perhaps, be sufficient to obtain a patent, but a design patent presupposes an exercise of creative genius. Original thought is demanded, a new idea must be begotten and embodied.

A mere substitution of one color for another possesses no element of originality, and indicates no exercise of genius, and cannot, therefore, become the subject of a patent; neither can any blending or arrangement of colors, unless a new aesthetical effect is produced—an original idea indicated.

I am not prepared to say that no design patent could be based on colors, but, with the foregoing explanations, my views are, I think, sufficiently indicated for the case under consideration, and other similar cases.

*Ex parte* PETER C. PARKINSON.

Decided September 25, 1871.

Com. Dec., 1871, 251.

In the matter of the application of Peter C. Parkinson for a Design Patent for a Claw-hammer.

Function can form no part of a design patent. "Useful" in connection with mechanical inventions relates to functional quality; while the same word in connection with designs, means "adaptation to producing pleasant emotions."

The Statute of 1870 does not authorize the grant of a design patent for every possible change of form that might be given to a machine or article of manufacture.

Slight and unimportant changes in form or color, requiring neither inventive or creative genius, and producing no new or æsthetic effect, are not patentable as designs. The changes must constitute an *original* as distinguished from a merely *new* design.

The decision in *Ex parte* Bartholomew, C. D., 1871, p. 298, commented on, and disapproved as too broad.

*Leggett, Commissioner:*

The applicant seeks to obtain a design patent upon what he calls a "claw-hammer." This hammer is nothing more or less than an iron bar fitted in substantially the ordinary manner and form for drawing spikes. The foot of this hammer or spike-bar has the ordinary slot for catching the head of the spike, and the foot is of a goose-neck shape, and of sufficient length to draw the spike entirely from its fastening. The same is substantially true of a large majority of the tack-hammers and nail-hammers in common use. The applicant's device may differ somewhat in form from ordinary claw-hammers, but not essentially or materially.

The examiner refuses to consider the application under the head of designs, and says: ("Function can form no part of a design patent.") From this decision the applicant appeals under Rule 44.

The law has provided for granting patents to the inventors

or discoverers of new and useful arts, machines, manufactures, and compositions of matter, and also of any improvements thereof.

This class of inventions has to do with functional qualities of matter and things. The term "useful," in connection with machine patents, relates to the office the thing patented fills in producing a desired effect; or, if the thing patented is the result or effect, that is, the article produced, then "useful" relates to its adaptation to serve some practical purpose in supplying some physical or tangible want.

But the law authorizing design patents was intended to provide for an entirely different class of inventions, inventions in the field of esthetics, taste, beauty, ornament.

The question an examiner asks himself while investigating a device for a design patent is not "What will it do?" but "How does it look?" "What new effect does it produce upon the eye?" The term "useful" in relation to designs means adaptation to producing pleasant emotions.

The section of the law which enumerates the subjects of design patents reads as follows:

Any person who, by his own industry, genius, efforts, and expense, has invented or produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, pattern, print, or picture, to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, &c.

The Legislature never intended by this section (Act of July 8, 1870, Sect. 2) to let down the standard for patents. It was never contemplated to grant a design patent for every possible change of form that might be given to a machine or article of manufacture. By "article of manufacture," as used in this section, the legislature evidently meant only ornamental articles, articles used simply for decoration.

The inventor in this line must not merely change the form or the color, but he must produce a new esthetic effect. He must, by the exercise of industry and genius, invent or produce, not only a new, but an original design. He must

do a little more than invent—he must produce, that is, create. Creative genius is demanded in giving existence to a new and original design.

The idea of stretching the section in question to cover slight changes in the form of crow-bars, spades, plows, scrapers, &c., is simply ridiculous, and tends to bring the whole system into disrepute.

If a man wants a trade-mark let him adopt one and have it registered; but before he can have the monopoly of a patent, he must have produced something substantially new.

The practice of the office in granting design patents has been not only liberal but lax. To real inventors the office should be liberal and generous, and all doubts should be solved in their favor. But the man who comes to the office with a machine or article of manufacture and seeks a design patent simply for some slight and unimportant change of form or color, requiring neither inventive nor creative genius, and producing no new or esthetic effect, deserves but little favor or consideration. In general, such men are impostors, and desire a design patent merely to obtain the right to put the word “patented” upon their manufacture, and thereby deceive the public and wrong real inventors, for they well know that not one person in ten thousand will ever learn the fact that the patent only covers the design.

The interests of real inventors, and a proper regard for the public good, demand that design patents be limited exclusively to the field herein suggested, and it is clear to my mind that a proper construction of the law fully warrants such limitation.

My learned predecessor's administration was an epoch in the history of the Patent Office. He established many boundaries and land marks that before had been very uncertain and indefinite, and instituted many reforms in the office practice that have rendered it far more simple and certain. It is after much hesitation that I differ from any of his recorded opinions, yet in the celebrated Bartholomew case, decided December 2, 1869, it is clear to my mind that he opened the door to design patents far too widely.

The action of the primary examiner is fully sustained.

*Ex parte* WILLIAM WHYTE.

Decided November 28, 1871.

Com. Dec., 1871, page 304.

In the matter of the application of William Whyte for letters patent for a Design for Ornamental Print for Fabrics.

The design for an article of manufacture, contemplated by the statute, must be permanently affixed to the article, or so wrought into the texture as to become in effect a part of it.

Surface designs intended to subserve merely a temporary purpose, such as to distinguish an article by its presence upon it, until sold, are not within the statute. Such are in effect trade-marks only, which are excluded, by implication at least, from the provisions of the act.

The specification not mentioning any article to which the design is applicable or to be applied, and upon the intrinsic evidence furnished by the design itself, it must be held that it is really intended for a trade-mark.

Suggestion in *Ex parte* King (C. D., 1870, p. 109) that a design patent to be valid should particularly specify the article to be ornamented or to which is applicable, approved.

*Duncan, Acting Commissioner:*

The design shown in this application consists of a shield or escutcheon, within which is a representation of a scroll and of the lower part of the human leg, the two crossing each other nearly at right angles. This is entitled by the applicant an "ornamental print for fabrics," and is described in the specification as a "new and original impression or print to be printed or painted upon paper or other fabrics or woven or otherwise worked into the same."

The examiner declines to entertain the case and inquire into the novelty of the design, assigning as the reason that the design is really intended for a trade-mark, and that the applicant accordingly must obtain protection, if at all, by registering it as a trade-mark and not by patenting it as a design. It is from this decision that the present appeal is

taken, and applicant's prayer is for an order upon the examiner directing him to proceed with the case.

In *ex parte* William King, Commissioner's Decisions, September 19, 1870, it was held that designs for trade-marks are excluded from the category of subjects made patentable by what is known as the design section of the patent act. One reason for this ruling was that as the statute in later sections provided a special means of obtaining protection for trade-marks, such provision must be interpreted as excluding all other modes not as specifically enacted, and therefore, as excepting trade-marks from the operation of that clause which enumerates, in general terms only, as subjects for design patents, "any new and useful impression, ornament, pattern, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article of manufacture." The rule then laid down still governs the office practice; so that the only question at issue in this appeal is as to the real object of the design to which it relates.

There can be but little doubt that, in the enumeration of subjects for design patents as contained in the clause of the statute above quoted, regard was had to the external ornamentation of articles of manufacture; and that to this end it was the intent of the law that the various designs should be so affixed to the manufactured articles, or so wrought into their texture as to become in effect a part of them. They were not intended to subserve merely a temporary purpose—such, for instance, as to distinguish the article by their presence upon it until it should have passed into the hands of the consumer; rather, they were to be incorporated into its very structure, and to abide with it after it had reached the consumer, and until obliterated by the natural and gradual deterioration resulting from use.

Applying this test, how are we to regard the present case? Is the design one that the applicant intends to use for the purpose of ornamentation? Does he propose to himself so to incorporate it into the structure of the articles to which he applies it that it will become a permanent part thereof? To be sure, he speaks of it as something "to be printed or painted upon paper or other fabrics, or woven or otherwise worked into the same;" but there is no suggestion that the



fabrics upon which it is thus to be printed or painted, or into which it is thus to be woven or otherwise wrought, are themselves to be worked up into definite articles of manufacture, and are not to be used simply for temporary attachment to other manufactures for the purpose of indicating their ownership or origin. In the absence of any positive declaration to the contrary it must be assumed that the latter is the real intention of the applicant, for it is difficult, if not impossible, to conceive of any article of manufacture the value of which would be the least enhanced in the estimation of the public by the permanent attachment to it of the design in question. There is too little of the beautiful or even the grotesque in it to warrant the expectation of such a result. If placed upon a surface of plate, or used for other kindred purposes, it might give a special value in the eyes of the owner to the articles upon which it is thus impressed; but this would be a matter affecting the public indirectly only, and more frequently, perhaps, than otherwise would actually depreciate the articles in the public estimation. In the absence from the specification of all mention of the articles, if any, upon which it is proposed to place the design as an ornamentation, and to which it would be adapted for such a purpose, and upon the intrinsic evidence of the design itself, it must be held that it is really intended as a trade-mark.

This view is strengthened by reference to the history of the case. As first filed, the drawing had the word "trade-mark" imprinted upon the scroll within the shield, and the oath of invention first filed spoke of the design as being for a trade-mark. Since the first action of the examiner raising an issue as to the character of the application, the word "trade-mark" has been erased from the drawing and an amended oath has been filed which corresponds in phraseology with the specification.

The suggestion of the applicant's attorney, that from the filing of the present application it must be presumed that applicant does not seek to protect his design as a trade-mark; since, if this were his object, he would not have proceeded under the design section of the law, but under that branch of it which related to trade-marks, by which for a smaller fee he would have obtained a longer term of

protection, is without force. It is more likely that applicant chose the present form of application, thinking that by securing the exclusive use of the design he could apply it at pleasure to all classes of goods; and that, being protected in that exclusive use, he would thus, in the lapse of time, become possessed of a veritable trade-mark for as many different classes of goods as he might himself have manufactured, or might have procured to be manufactured by others, while under the trade-mark sections of the law a single fee would have secured registration for the design as a trade-mark in its application to a single class of goods only.

If this result would follow, there is all the more reason why special care should be exercised to prevent a loss in this direction to the revenues of the Government by an adroit evasion of the spirit of the law. It may be, however, that applicant mistakes as to the extent of his rights under a design patent. It is true that under the old law, there being at the time no statute specifically relating to trade-marks, parties were permitted to take out patents for designs for trade-marks, and this without naming any particular class of goods upon which such design was to be thus used; but in *ex parte W. King*, above referred to, the commissioner characterizes that construction of the design law which tolerated this practice as a forced interpretation, and plainly intimates the opinion that a design patent to be valid must particularly specify the special article to be ornamented by the pattern, print, picture, &c., upon which the patent is granted. If this view be correct, the grant of such a patent would create no right to the exclusive use of the design upon other articles than a particular one specified.

It is not recalled that there has been any adjudication of the courts upon the validity of a design patent which contains no specification of the class of goods to which the design is applicable; but the doubt thrown upon the question by the above-named decision of the Commissioner of Patents may well be pondered by all who would surrender the particular measure of protection afforded by the trade-mark law, thinking that by so doing they can, under the design law, obtain larger rights at a smaller cost.

The decision of the examiner in the premises is affirmed.

*Ex parte* J. D. DIFFENDERFER.

Decided July 8, 1872.

Com. Dec., 1872, 154.

Appeal from the principal examiner in the matter of the application of John D. Diffenderfer for letters patent for a Design for Desk-standard.

1. In an application for a design patent both the obverse and reverse of the design may be shown, but the views should correspond, that is, illustrate like portions of the device claimed.
2. A patent for a design cannot be granted where the function of a device forms an element of the claim. When the claim is for a "design substantially as shown and described," and the description contains references to the purpose and use of certain devices: Held, that function is thereby carried into the claim, which therefore should not be allowed.

*Thacher, Acting Commissioner:*

In taking this appeal, applicant says: "The question for decision is, can applicant show and describe the inner as well as the outer side of his standard?" I have no hesitation in giving an affirmative answer to this question. Every applicant for a design patent has an undoubted right to show both the obverse and reverse of the ornamental work which he has devised. But the two faces should correspond; if one be shown entire the other should be also. In this case, while the obverse of the standard is fully illustrated the reverse is only partially shown. The drawings should be amended to correct this error: Fig. 2 should be made to correspond with Fig. 1, so as to represent the reverse of the entire standard.

I find, upon examination, that this is not the only question in the case. In his first letter of rejection the examiner states his objection to the grant of a patent as follows:

The application above named embraces much more than can be admitted in a design. The exterior form or configuration is all that can be allowed. The other parts, relating to function, must be erased from the specification and drawing.

Subsequently to this action applicant amended his specification and drawing so as to overcome, as he supposed, the objection of the examiner. This, it seems, he failed to accomplish, for on the 1st instant, the examiner rejected the case a second time, restating his position, as follows:

The same objection exists to the specification as amended as to the original; and nearly the same form of a school-desk can be found in this room, which was placed there on the third day of January, 1870.

It becomes necessary, then, to examine the description and claim in this case, to determine whether the function of the standard forms any part of the invention claimed. Applicant claims—

The design for a desk-standard, substantially as herein shown and described.

Turning to the description I find that in describing the inner side, or reverse of the standard, certain flanges and projections are described and referred to by letter, the purpose of which, as stated by applicant, is to form supports for the bottom, end-pieces, and shelves of the desk. This language obviously carries the function of the parts mentioned into the claim for the design, for said claim refers directly back to the description for its interpretation. This class of claims in application for design patents has already been criticised by the commissioner, and the field to be occupied by such patents clearly defined in the appeal case of Peter C. Parkinson, C. D., 1871, p. 251.

The present case, in my opinion, comes clearly within the ruling in the decision referred to above, and in accordance therewith the applicant should be required to erase from his description all reference to the function of the standard, or any portion thereof, described.



*Ex parte* T. B. DOOLITTLE.

Decided July 31, 1872.

Com. Dec. 1872, 176.

Appeal from the Primary Examiner in the matter of the application of T. B. Doolittle for letters patent for Improvement in Button-hole Cutters.

When utility is cited as the purpose of a "peculiar shape," the invention cannot, under such description, be the subject of a design patent.

Useful purpose is the characterization of a machine patent, so called; ornamentation, that of a design patent.

*Thacher, Acting Commissioner :*

The fifth claim was rejected by the examiner on the ground that the invention was "a proper subject of a design patent; but not for a mechanical patent."

This objection was not noticed by the examiners-in-chief when considering this application on appeal, probably because they very properly regarded it as a question appealable directly to the Commissioner. Such an appeal is now taken by the applicant.

The claim in question is for "the peculiar shape of the end of the shield, so that all danger of grasping it at a dangerous locality will be avoided, as hereinbefore explained." If the shape here referred to was for the purpose of ornamentation, the objection of the examiner would be valid; but in the claim utility is suggested as the object of the peculiar form of the end of the shield.

Upon referring to the description the useful purpose subserved by this form is found to be still more distinctly set forth.

Inasmuch, therefore, as the peculiar shape of the end of the shield is not mere fanciful ornamentation, but was devised to serve a useful purpose, to wit: to form a safe handle for the instrument, it constitutes proper subject-matter for a claim in a machine patent.

Perhaps, however, the claim should be amended so as more carefully to define the invention to which it relates, and the examiner is advised to require such amendment before allowing the subject.

The claim is, of course, open to any objection the examiner may raise if he finds, upon examination, that the invention is wanting in novelty.

The decision of the examiner is overruled.

*Ex parte* H. W. COLLENDER.

Decided October 2, 1872.

Com. Dec. 1872, 217.

A patent for design and one for structure cannot both be granted for the same subject matter. A single device, however, may embrace subject matter for both classes of patents; that for one being a particular configuration or ornamentation, and that for the other, the structure of the device, involving its mechanical uses and adaptation.

*Thacher, Acting Commissioner :*

Applicant claims "a billiard table formed with bevelled side rails, or with the sides of its body bevelled under."

The object of beveling the sides of the frame under the table is alleged to be so to change the form of the frame as to make room for the leg of a player when it becomes necessary for him to "hug" the table closely, and bend forward in order to strike the cue-ball at the greatest distance without using the bridge, which it is desirable to avoid. This is the theory advanced; but the fact is, this construction will not enable the player to strike his cue-ball at any greater distance from the cushion than the old one would. On the contrary, the rule of the game being, as I am informed, that only one foot must necessarily be kept upon the floor while making a shot, a player cannot reach so far with his leg under the table as he can when it is not under the table. The common practice, which is in accordance with the rules of the game, is in making a long shot without the bridge, to rest the weight on one foot or on the ball of the foot, beyond or outside the space covered by the tabletop, and lean forward against the cushion-rail. The distance reached depends upon how tall the player is, and how long his arms are, and not in the least upon this particular construction of the table-frame beneath the top. The truth of this may be verified by observation of a game between experts, and by reference to the rules of the game. So this basis of the utility of these beveled sides vanishes at once. They do not possess the practical utility alleged.

Nevertheless I do not doubt that they do possess a peculiar practical utility, not in connection, as alleged, with the long shots in which the bridge is ordinarily used, so that they operate to dispense with its use, but rather in connection with ordinary shots, or shots where the cue-ball rests at only a moderate distance from the cushion, and it is desirable to have the weight of the body supported by the foot advanced rather than by the bridge-hand. The beveled construction of the frame will allow the foot to be advanced and the body supported steadily to make shots just so much further from the cushion, in this advantageous position, than can be made on the old tables, as there is space gained by the beveling. This is an improvement, therefore, which will be valued by billiard players, as is evident from the fact that beveled tables are now fast superseding the old square-framed tables, and billiard-saloon proprietors are compelled by the public preference to supply them.

The only question, therefore, as to the patentability of this improvement upon a proper specification, is raised by the fact that applicant has already taken out a design patent showing and covering, as a design, the identical form of table now presented. Its effect, however, is merely to secure to him the particular configuration shown. Claiming to be the inventor of the useful plan of construction embodying broadly the beveled frame as well as of the configuration adopted, he now seeks protection for said beveled frame without regard to configuration.

The case of Bartholomew (Com. Dec., 1871, p. 298) is precisely in point. In that case a design patent was granted for a particular conformation of a rubber eraser, possessing the æsthetic utility and novelty required for a design patent, and afterwards a patent was granted covering the plan of construction, which possessed the elements to support the grant of a mechanical patent. At the same time the rule was not violated that a mechanical patent and a design patent should not be granted for the same subject matter. The subject matter was essentially different, although found in the same device. The same difference exists in the case under consideration. The definite ornamental configuration presented is already secured by patent, and now the plan of construction, which may be of varied

design, and which relates exclusively to utility, except when applied in connection with some particular embodiment of form, which it is made to assume for æsthetic effect as well as for utility, is proper, because different, subject-matter for patent.

The decision of the board is reversed, and the application is remanded to the examiner, who will require the specification to be amended in accordance with the above suggestions, when an interference may be necessary before ordering a patent to issue.

---

COLLENDER *v.* GRIFFITH.

Decided January 30, 1873.

Com. Dec., 1873, page 14.

If an application is filed for a mechanical patent for a construction, and if a design for which a patent has been granted can be produced only by that construction, an interference should be declared between the application and the patent.

*Thacher, Acting Commissioner :*

This is an appeal from a decision of the examiner dissolving the interference. The main reason for the dissolution is that an interference is improper between an application for a mechanical patent and a patent for a design.

This is urged on the ground that the interests are not and cannot be identical, inasmuch as the patentee of the design cannot reissue and obtain a claim for the construction, even if successful in the suit. Although this argument appears plausible, it is really unsound and should not prevail. An interference does not necessarily result in the grant of a patent to one of the parties for the subject-matter involved. It frequently happens that the prior inventor is adjudged, for various reasons, not to be entitled to a patent. The question in this case is not whether Griffith is entitled to a patent, but whether Collender shall have the patent for which he prays. Now, it is admitted that Griffith, in applying his design, must use the construction claimed by Collender, and therefore the grant to



the latter of the patent sought would subordinate a design patent of earlier date. Under these circumstances it is perfectly evident that it would be improper to issue a patent to Collender until he proves himself the prior inventor. An interference, therefore, was necessary, and in this instance properly declared.

The decision of the examiner dissolving the interference is overruled.



### COLLENDER *v.* GRIFFITH.

Decided March 11, 1873.

Com. Dec., 1873, page 48.

An interference should be declared between an application for a mechanical patent and a design patent which shows the alleged invention, although the applicant holds a prior design patent showing the same.

If the designs embraced in the two patents are so dissimilar as not to be in conflict, it is unnecessary to include the earlier patent in the interference.

The burden of proof is on the applicant for the mechanical patent, notwithstanding his design patent first shows the invention; but he may have the benefit of it by introducing it in evidence.

*Leggett, Commissioner:*

This is a motion to dissolve the interference. The case is somewhat anomalous. Collender obtained a patent for a design for an ornamental billiard-table frame, June 6, 1871. On October 6, 1871, a design patent was granted to Griffith, also for an ornamental billiard-table frame. The two designs, as such, are distinctly dissimilar. There was no interference between them as designs, and they were properly patented. January 16, 1872, Collender filed his present application for a patent, claiming to be the inventor of a beveled frame for billiard-tables, which is alleged to be a material practical improvement upon the square vertical-sided frame in common use. The beveled frame was shown in his design patent and in that of Griffith. Having in itself, however, a practical, useful

function, without regard to any particular ornamental configuration or design, it was held—following the practice adopted in the Bartholomew case (Commissioner's Decisions, 1871, p. 298)—to be proper subject-matter for a mechanical patent. An interference became necessary to determine which of the parties, Collender or Griffith, was the inventor of the beveled frame. In it Collender's design patent was not embraced, and the question now is whether or not it should have been. The invention now claimed can never be secured to Collender or his representatives by reissue of that design patent. This is true also as to Griffith's design patent. The question is which of the parties is entitled to a mechanical patent upon separate application therefor, or, more immediately, whether or not Collender is upon his application. It is his application that raises this issue, and not his design patent. To be sure, he is alleged to be the inventor of both the design and the mechanical construction he shows, which are substantially identical in both his cases. But inasmuch as he cannot secure protection for the latter in his design patent by reissue, it is not necessary to place that patent in interference with his own application. That would be allowed without an interference were it not that another inventor shows the subject-matter claimed. Neither is it necessary to place it in interference with Griffith's design patent, because the two designs, as such, do not interfere. The case is not altered by assuming that Collender's design patent may be in the hands of assignees whose interests might be affected. They could never have an interference either with Griffith's design or Collender's mechanical patent, should he obtain one. Questions which might arise between them and Collender, growing out of the grant to him of the patent he now seeks, would be of a different nature and come before another tribunal. If Griffiths should be awarded priority, he may file a new application and obtain a patent without obstruction from Collender's design patent. The fact that the burden of proof is upon Collender in this instance arises, under the rules, from the record, and I see no reason why the rules should be modified in his favor. He can put in his design patent as evidence, and thus avail himself of it. But there is no reason why it should be

embraced in this interference, and therefore there is none for relieving him of the burden of proof which he sustains upon the records in the cases which are actually and necessarily in interference.

The examiner's decision is sustained.

---

*Ex parte* T. B. OGLESBY.

Decided February 24, 1873.

Com. Dec., 1873, page 35.

1. When an alteration in any article is calculated to give it a better appearance merely, it can be protected only by a design patent.
2. If the alteration is intended to change its functions or improve its operation, or effect a new result, it may be the subject of a mechanical patent.

*Leggett, Commissioner :*

Applicant claims a peculiarly-shaped saw-tooth for cotton gins, on account of the construction or form of which several important advantages are alleged to be gained, referring both to the cost of making the tooth and to its use in ginning. No question is made by the examiner as to the novelty or utility of the tooth, but he maintains that as it exhibits merely a change of form, it is therefore proper subject-matter for a design patent only. This position is not tenable in this case. Admitting that there is no more than a change of form in the tooth itself, it is necessary to go further and inquire what is the object and what are the results of the change of form. If the shape of the tooth has been altered for the purpose of improving its appearance merely, without changing its function or increasing its practical efficiency, then the modification is calculated to produce the novelty and utility requisite to warrant the grant of a design patent. But if the shape of the tooth has been altered for the purpose of improving its operation, and actually does, as alleged, greatly increase its efficiency, then there is clearly presented subject-matter for a mechanical patent. When the common screw was simply provided

with a pointed instead of a blunt threaded end, there was only a change of its form and seemingly a very slight and obvious one. Yet the object of the change, and the advantage resulting from it, rendered it an important and patentable mechanical invention. This case is analogous, and the examiner's decision must therefore be overruled.



*Ex parte* L. W. FAIRCHILD.

Decided March 12, 1873.

Com. Dec., 1873, page 45.

1. A name-sign, with an imitation gold pen attached to it, constitutes a proper subject for a design patent.
2. The case of Parkinson, *ex parte*, Commissioner's Decisions, 1871, page 251, distinguished from this and approved.
3. All descriptions of the mechanical construction of the article represented in a design for which a patent is asked should be eliminated from the specification, as well as all reference to the utility of its purpose.

*Thacher, Acting Commissioner :*

Applicant attaches an imitation gold pen to a name-sign, and asks a patent for the whole as a new design. The examiner holds that this is not proper subject-matter for a design patent, and from this decision an appeal is taken.

The decision of the commissioner in Parkinson, *ex parte*, 1871, is cited as authority for the opinion of the examiner. In that case the article was a tool for mechanical purposes, and the peculiar form, for which a design patent was asked, was intended solely for purposes of utility. In the present case the completed article has no mechanical function whatever, and the design represented is a matter of taste. It is not, therefore, in my opinion, open to the criticisms so justly made in the Parkinson case.

As the subject-matter of this application is a matter of taste, and, to some extent, ornament, designed to attract the eye, I think there can be no doubt of the propriety of granting a patent for the design as requested.

The decision of the examiner to this extent is overruled; but, of course, without pronouncing upon the question of novelty, which is not brought up by this appeal.

The specification, however, requires careful revision. All description of the mechanical construction of the article should be eliminated, as well as all reference to its purpose as a matter of utility. All matter of this description is improper in a design patent. The examiner will, therefore, require suitable amendments in the case before further action.



*Ex parte* ALOIS KOHLER.

Decided May 17, 1873.

Com. Dec. 1873, p. 84.

1. A patent will not be granted for a design which is shown in the drawings annexed to a patent already issued for a machine, although the machine or design may either of them be capable of use without the other.
2. Although the grantee of the machine patent is the applicant for the design patent, he should be denied in such a case.
3. If the patentee of a machine disclose in his specification his intention of obtaining a patent for the design shown in his drawings, it seems that he might then obtain such a patent.
4. The cases of *ex parte* Bartholomew, Com. Dec., 1871, p. 298, and *ex parte* Collender, 2 Off. Gaz. 360, commented on.

*Leggett, Commissioner :*

A patent was granted the applicant May 7, 1872, the drawing of which exhibited the design now claimed. That patent covered the construction of the opposite edges of a blind slat, whereby a peculiar hinge connection was formed. This construction was entirely concealed from view when the slats were united to form blinds. It was intended to perform a practical useful function, and was wholly independent of the exterior conformation of the slat shown, or of any other particular exterior design. It could be used as well with one design exhibited by the surface of the slat

as another, and this fact was set forth in the specification of the patent in the following words: "A represents the slats made with any suitable molding, form, or design upon their broad faces. This is all of the specification of the patent that refers to the design. The patent does not protect it, of course, and cannot be reissued so as to protect it, because it is not subject matter which a mechanical patent will protect. It is proper subject matter for a design patent, and the construction of the hinge connection is entirely distinct subject matter, and was properly patented as a mechanical device.

In view of this state of facts, the examiner and the board of examiners-in-chief have refused the application, the examiner holding that the patent of May 7, 1872, is a bar to the patent now sought, but the applicant continues his appeal, holding that, following the precedents set in the Bartholomew case (Com. Dec., 1871, p. 298) and the Colender case (Off. Gaz., Vol. 2, p. 360), he is entitled to a patent.

In each of the cases cited, the patent for the design was first obtained, and the mechanical patent subsequently applied for and allowed. In the present case the mechanical patent was first allowed, fully showing the design, and the design patent is now sought—sought upon drawings which are exact duplicates of those upon which the mechanical patent was granted. The cases are radically different. A design patent relates only to configuration and arrangement for æsthetic effect. The mechanical patent is for practically useful mechanism. The design may be shown and described in the case pending without developing the mechanism upon which the patent was granted, but the mechanism could not have been described in accordance with the requirement of law without showing some design. Hence the design patent might have been first granted and afterwards the mechanical, but not *vice versa*, for the mechanical is the greater, and must include the right to use the design shown, unless it was previously patented, but the design is the less, and does not necessarily include the mechanism. It will be remembered that in this case the special mechanism and special design have no necessary connection, as either can be used without the other. But when the ap-

plicant applied for his mechanical patent he was obliged to show his invention in some form in his drawings and model. He chose to adopt the identical form which he now seeks to cover by a design patent. If a valid patent, could be given him, he could then say to the assignee of his former patent that said assignee shall not use the mechanical invention in the manner and form set forth and fully described in that patent. The law certainly never contemplated the granting of patents that might thus come in conflict with each other. If the precedents quoted go that far, which I deny, then it is high time they were reversed.

If the applicant, at the time he applied for his mechanical patent had at the same time applied for his design patent, and had put a clause in the specification of the mechanical application stating that the design shown was a subject of a pending application for design patent, I should not question his right to both patents, for then the purchaser of the mechanical patent would buy with notice; but having fully shown his design in the mechanical patent without notice of intention to claim it, he has barred himself from setting up any subsequent claim to it, and has dedicated it to at least any person who now does, or may hereafter, own the mechanical patent. It might be said that both of these patents will belong to the inventor, hence will not come in conflict; but as they may, by future contingencies, either with or without the patentee's consent, fall into different hands and become antagonized, the office must be guided by the same principles as if the existing patent had already been assigned. The cases relied upon as precedents have gone to the utmost verge of propriety, if not a little beyond. The intent has been to correct mistakes, the applicants having taken patents for designs when they should have taken mechanical patents.

The decision of the board is affirmed, and the patent denied.

*Ex parte* BLOOMFIELD BROWER.

Decided October 28, 1873.

Com. Dec., 1873, page 151.

1. A square inkstand, with its angles chamfered, and a square-headed movable stopper with its angles similarly chamfered, held not to constitute a patentable design for a single article of manufacture.
2. The ordinary use of an article, for the form of which a design patent is sought, is a controlling consideration in determining whether or not it presents proper subject matter for a design patent.
3. As the ordinary use of an inkstand and stopper requires their separation, they do not present such a fixed unit as to constitute them a single design.
4. The relative position of connected parts to constitute a design ought to be uniform and fixed, because, as a rule, a design is essentially unitary and unvarying in character. It cannot embrace alternates or equivalents of form, but is arbitrary and unchangeable.

*Thacher, Acting Commissioner:*

Applicant claims a "design for a glass inkstand and stopper of glass, made square, with equally chamfered edges, substantially in the manner above described."

The edges or angles of a square inkstand are all chamfered, and the chamfers are all of equal width. A square stopper head is provided, having its edges or angles all similarly chamfered. The photographic illustration filed exhibits the square chamfered stopper in the chamfered inkstand in such a position that the sides of the squares are parallel with each other.

The examiner holds that the bottle and the stopper are separate articles, and exhibit separate and independent designs. On the other hand, it is maintained in behalf of the applicant, in substance, that while this is true in one sense, the two have an intimate relation respecting the harmony of their individual forms to produce an æsthetic



effect when they are brought together for use or display, and are presented to the eye as a unit. He alleges that he has made the stopper head of the form of the inkstand in conformity with a law of fitness or correspondence relating to forms to be connected or conjoined, from which what is pleasing to the eye, and what we naturally term beautiful, results. There is apparently some force in this reasoning; but it should be remembered that the ordinary use of an article for which a design is presented, is a controlling consideration in determining whether or not the design is proper subject matter for patent as such.

The object of an inkstand and stopper is to preserve the ink for use; but whenever it is being used they must be separated. The stopper must be removed, and that destroys the design alleged to be constituted by the two. There is not, therefore, such a fixed unity of design, considering the ordinary use of an inkstand and its stopper, as to constitute the two separable and often separated parts a single design.

Another consideration of importance, is that the relative positions of the two parts, when connected, ought to be uniform and fixed, in order to constitute a design which is, as a general rule, a thing essentially unitary and unvarying in character. A design cannot embrace in its scope alternates or equivalents of form. It is arbitrary and unchangeable, either by the separation or the rearrangement of its features. In this case it is obvious that there is nothing in the construction presented to preserve the alleged design shown, even when the stopper is in place, for it may be turned out of parallelism with the square of the stand, whereby the æsthetic effect described will be violated and the original design destroyed. It would then be like a capital misplaced on the shaft of a column.

It is not denied by the applicant that a design for an inkstand and a stopper-head, respectively, might be patented. The exterior of the stand and the stopper, being individually ornamental and novel in form, would each present subject matter for patent. The two permanently united, or so constructed as always to occupy the same relative positions to each other, might also, no doubt, present subject matter for patent were such a union consistent with

their ordinary use; but neither of these conditions is found in this case. I therefore concur with the examiner that a division of this application is necessary. The inkstand and stopper, as presented, do not constitute a single unitary design for an article of manufacture.

The examiner's decision is affirmed.

---

*Ex parte* CHARLES A. SEAMAN.

Decided January 5, 1874.

4 O. G., 691.

1. The form of the body or swab of a lamp-chimney cleaner held not to be subject matter for a design patent, because the form was adopted for practical use and not for ornament, and, in the body of a lamp-chimney cleaner, was without utility as an ornament.
2. The words "useful" shape in the statute relating to designs refer to the utility of ornamental form and appearance rather than to that of operative mechanical function.
3. By design for "an article of manufacture," as the subject of patent, is to be understood ornamental forms of articles employed merely for decoration.
4. When "an article of manufacture" is presented for patent in order to determine to which statutory class of patents it should be referred for protection, it should be asked, Is its form, without reference to the function of the article, intended to be ornamental? and is the article itself a thing which may, for any practical purpose, have a merely ornamental configuration, and therefore have, in that sense, sufficient utility to warrant the grant of a patent?
5. The law is based upon the universal truth that the influence of the beautiful is beneficial to mankind, and there is no reason for excluding "the decorative arts" from recognition under the statute wherever there is room for real decoration.

*Leggett, Commissioner :*

The applicant makes a lamp-chimney cleaner with a "pear-shaped" body, and seeks a design patent covering

this form of the article. The examiner holds that this is not proper subject matter for a design patent.

Under the old law, which provided that he who invented "any new and original shape or configuration of any article of manufacture," should have a design patent therefor, Commissioner Foote held—

"It (the statute) does not say 'ornamental' design, or 'artistic' shape or configuration, and I am unable to perceive any good reason why designs for utility are not fairly and properly embraced within the statute, as well as those relating to ornamentation merely. The line of distinction between what is useful and what is merely ornamental, is, in some cases, very indefinite." (Commissioner's Decisions for 1869, p. 7.)

Commissioner Fisher expressly concurred in this opinion, and added—

"I am of opinion that the class of cases named in the act as arising from 'new shape or configuration,' includes within it all those new changes of form which involve increase of utility." (Ib. p. 105.)

The Act of July 8, 1870, adds the word "useful," and provides that "any new, useful, and original shape or configuration of any article of manufacture" may be patented as a design. Under this act, Acting Commissioner Duncan held (Commissioners Decisions for 1871, p. 53)—

"There is here no limitation as to the use to which the article wrought into the particular shape designed for it, is to be subjected; and no suggestion that mere beauty of form or ornamental configuration are the ends sought. In fact, the language quoted expressly implies that utility may be the sole object had in view in the invention or selection of the particular form to be impressed upon the manufacture; and I am of opinion that, under the present statute, if a new, and at the same time, useful, shape be devised for a particular article of the manufacture, even though no ornamental effect be produced thereby, the inventor of the same is entitled to protection for it under the design section of the patent law."

Upon mature deliberation, and in view of the different statutes and the decisions under them, I came to a different conclusion as to the purpose and scope of the law author-

izing the grant of patents for designs, and as to the meaning of the language of the statute, construed with reference to what I conceived to be the object of the law and the ground it covered as a supplement to the statutes authorizing the grant of patents for mechanical inventions. This conclusion I announced in the case of P. C. Parkinson (Commissioner's Decisions for 1871, p. 251). It was to the effect that the law authorizing design patents was intended to provide for a distinct class of inventions, "inventions in the field of æsthetics—taste, beauty, ornament;" that the words "useful," shape, in the statute relating to designs, refer to the utility of ornamental form and appearance rather than to that of operative mechanical function; and that by a design for an "article of manufacture" as the subject of a patent is to be understood ornamental forms of articles employed merely for decoration, the articles themselves, irrespective of mere ornamental form, frequently having mechanical utility. At last, in 1872, a case reached the Supreme Court of the United States, under the present statute, and the object of the law, at least, was definitely and authoritatively settled. The subject before the court was a certain ornamentation on the handles of table-forks and spoons. The court said:

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

\* \* \* The thing invented or produced for which a patent is given is that which gives a peculiar or distinctive appearance to the manufacture or article to which it may be applied or to which it gives form. The law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. It therefore proposes to secure, for a limited time, to the ingenious producer of these appearances the advantages flowing from them. Manifestly, the mode in which these appearances are produced has very little, if anything, to do with giving in-

creased salableness to the article. It is the appearance itself which attracts the attention and calls out favor or dislike. It is the appearance itself, therefore, no matter by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense. The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly, but, in whatever way produced, it is the new thing or product which the patent law regards. To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities. \* \* \*

Identity of appearance, or, as expressed in *McCrea v. Holdsworth*, sameness of effect upon the eye is the main test of substantial identity of design. (*The Gorham Manufacturing Company v. White*, Official Gazette, vol. 2, p. 592.)

If the object of the law is to encourage "the decorative arts," and if "the appearance is the new thing or product which the patent law regards," then it must of necessity be exclusively ornamental appearance or conformation that is the subject matter of design patents. The active useful mechanical features or functions of devices, whether due to form or combination, are amply secured to inventors by the law authorizing what, for want of a better designation, have been termed mechanical patents. The only questions, then, when an "article of manufacture" is presented for patent, and there is a doubt as to which statutory class of patents it should be referred for protection, are: Is its form, without reference to the function of the article, intended to be ornamental, and is the article itself a thing which may, for any practical purpose, have a merely ornamental configuration, and therefore have, in that sense, sufficient utility to warrant the grant of a patent?

The body of a chimney-lamp cleaner is a mere swab, not intended for display, but for a very dirty use; and when not in use it is usually kept as far out of sight as possible. It is sought by the public, not for its beauty of contour, but because its form is adapted to fit and clean the interior of lamp-chimneys. This appears to have been the view of the applicant originally, when, as the examiner reports, he applied for a mechanical patent for this identical device. His application having been rejected upon references, he

apparently sought his remedy in an application for a design. The law is based upon the universal truth that the influence of the beautiful is beneficial to mankind, and there is no reason for excluding "the decorative arts" from recognition under the statute wherever there is room for real decoration. But the province of ornamentation is a high one, and the law should not be so applied as to degrade it. "The beauty of an ornament is one great test of its utility." (*Magic Ruffle Co. v. Douglas*, 2 Fish. p. 336.) There can hardly be sufficient utility in the way of ornamentation in the form of a swab for cleaning lamp-chimneys to justify the grant of a design patent.

I concur with the examiner that the merit of the form of this device relates wholly to its mechanical function, and not to ornamentation, and that the application does not embody proper subject matter for a design patent.

---

*Appeal of* FRED. G. & WM. F. NIEDRINGHAUS.

Supreme Court, District of Columbia.

Decided December 26, 1874.

S. O. G., 279.

In the matter of the application of Frederick G. and William F. Niedringhaus for a patent for a "Design for Ornament for Enameled Iron-ware," filed June 3, 1874. Appeal from the decision of the Commissioner of Patents.

1. A beautiful appearance does not of itself entitle an applicant to a design patent. The design must also be new and original, and the result of invention and genius.
2. Mere exhibition of skill on the part of workers in enamel in giving beautiful forms and colors to their productions, when they are the common efforts of persons ordinarily skilled in the art, is not the invention which is protected by the law.
3. The use of an old design is clearly excluded from patent by the statute, and mere change or "double use" cannot receive its protection.
4. The same degree of originality is required both in design and functional patents—that is, the claim must not comprehend what is already in existence.

5. A design consisting in a mere mottled appearance to be given to enameled iron-ware is not patentable.

MR. JUSTICE MACARTHUR delivered the opinion of the court:

This is an appeal from the decision of the Commissioner of Patents refusing a design patent in enameled ironware to Frederick G. Niedringhaus and William F. Niedringhaus. The statute in regard to design patents reads as follows:

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

In their specification, the applicants claim to have invented and produced a new and original design or ornament or pattern, to be printed, painted, or otherwise placed on, or worked into the various articles of enameled iron-ware which they make and sell. A photograph is annexed to illustrate the outline. They also say that, “the article itself, however, when completed, presents to the eye, a beautifully-mottled appearance, resembling granite in color, which the illustration fails to exhibit. It is this peculiar mottled appearance which constitutes the chief merit of our design, and it is on this we place most importance.”

The primary examiner, the examiners-in-chief, and the commissioner have all concurred in refusing the application for the patent. The commissioner, in his decision, says:

“I concur in the opinion of the examiners-in-chief, so far as want of patentability in the general subject matter em-

braced by the application is concerned. The so-called design is effected by printing, painting, or in any other way placing upon ironware a peculiarly mixed color. The enameling of ironware in various colors is an art well known. If applicant has achieved anything new, it is to be found in the mixing of colors, by which he produces a mottled appearance having the effect of granite coloring. If he has in this way obtained a new paint, it may or may not be patentable; but the application of such a paint in an ordinary way does not constitute the subject matter of a design patent, even under the most liberal construction of the statute."

The court are unanimously of the opinion that the decision of the commissioner ought to be affirmed. The art of enameling has been practiced for many centuries, and the different kinds of enamel have been produced in every variety of shade and color. The materials used for the purpose of coloring, and the process by which they are fused, have been known so long that to change them requires only the taste and skill of one engaged in the business. The appellants, of course, do not mean to claim any exclusive title to what is so well known. But their specification certainly seems to suggest that the change of color "resembling granite," imparts great value to their invention. They say, "the mottled appearance, which constitutes the chief merit of our design, and it is on this we place the most importance." The specimen of enameled ironware exhibited by counsel on the argument was of a color resembling granite, and was marked by spots of different shades darker than granite. The enamel and coloring substances are manifestly liquified by intense heat, such as enamellers use, until they are completely fused, and they are laid upon the ironware in this condition. The spots are then formed at random, in larger and smaller patches, without regard to regularity or design of any kind. No two of the articles are alike, except to color and general appearance. It is undoubtedly ornamental to the article, and has a pleasing effect on the eye. This is equally true of the hundreds of objects upon which this art is employed. Ornamental work in great variety, and paintings that never lose their freshness, are executed in enamel. Indeed, the



primary object of this art is to impart greater luster and beauty to every article of luxury or utility to which it is applied. A beautiful appearance is not in itself patentable. The design must be new and original, and the work of invention and genius. The ingenuity and taste of workers in enamel are quite wonderful to all but those employed in it; but no one would imagine that these exhibitions of skill in giving beautiful forms or colors to their productions was the kind of invention to be protected by the law. They are the common efforts of persons ordinarily skilled in the art. The appellants contend in their brief that it matters not if the design has been previously used, if now combined with an "object" with which it has not been hitherto combined, and if, as a result of such association, a new and distinctive aspect is given to such object, the law is complied with, and refer to former decisions by the Commissioner of Patents as cases in point. We cannot concur in this view. The thing provided for in the law is in express language, "any new and original design for a manufacture;" "any new and original design for printing;" "any new and original impression;" "any new, useful, and original shape;" "the same not having been known or used by others before his invention or production thereof." The use of an old design upon an old object is clearly excluded by the statute, and mere changes or "double use" cannot receive its protection. Besides, it is now well understood that the same degree of originality is required in both design and functional patents. That is, the claim must not be for a copy or imitation of what is already in existence. If, for instance, the applicants should manufacture their ironware with the figure of a statue of the Three Graces, it might improve the appearance of the article, but would scarcely entitle them to the benefits of a patent. To manufacture it with enamel is a change of the same kind, for the same thing has been performed on metals from time immemorial. To give the enamel any particular color is a matter of ordinary skill and taste. The coloring substances have always been fused with the enamel in the heat of the furnace. We can, therefore, observe nothing in the present specification to which the term invention can be applied. I am aware that the Supreme Court of the United States,

in *Gorham Company v. White*, 14 Wall, 524, have said in regard to design patents, that "they contemplate not so much utility as appearance, and that not an abstract impression but an aspect given to those objects mentioned in the arts." That was an action brought for the infringement of a design patent for the handles of table-spoons and forks. The design consisted in the configuration of the spoon and the ornamentation of the handle. The outline and all the details of the design were new, and invariable in each spoon alike. No question was discussed as to the originality of the patent, for it had never been known before, and the court decided that the article manufactured and sold by the defendant did not differ substantially from plaintiff's, and that it was therefore an infringement. But the whole tenor of the decision is to the effect that the appearance or aspect of the object must be of a design that is new and original. Indeed, no other view is admissible, for such is the express requirement of the law.

The decision of the Commissioner is affirmed.



**BENNAGE v. PHILLIPPI *et al.*—*Interference.***

Decided June 5, 1876.

9 O. G., 1159.

1. In an interference proceeding, the question of novelty should be first disposed of, and when that question is raised it controls the matter of jurisdiction of the Commissioner of Patents in adjudicating upon the rights of the parties.
2. In an application for a design patent, the arbitrary selection of the form of a now well-known and celebrated building to be applied to toys, inkstands, paper weights, etc., does not evince the slightest exercise of invention, industry, genius, or expense.
3. An alleged design, consisting of a mere imitation of an existing form or configuration, which any artisan has the right to apply to any object his fancy may dictate, is not properly the subject of a patent.
4. If neither the article produced, nor the appearance of it, is original, there is no evidence of what the law contemplates as originality, genius, or invention.

5. The same degree of originality is required in both design and functional patents—that is, the claim must not be for a copy or imitation of what is already in existence.

*Doolittle, Assistant Commissioner :*

This is an appeal from the Examiner of interferences refusing to dissolve the interferences between the applications.

All the applicants claim, as a new design, the figure of the Memorial Hall at the Centennial Exposition, in imitation of which they have shaped articles of manufacture. Phillippi works the design into a “metallic casting for toy banks, inkstands,” &c. Stewart makes a paper-weight of that form, and Bennage an inkstand.

The motion to dissolve is based upon the ground that the design is intended in each case for different articles of manufacture, and that the law gives protection to any design that may be placed for the first time upon a particular article of manufacture, notwithstanding the fact that the same design may have been used upon other articles of manufacture; that the article in each case was not for an analogous purpose, and that, therefore, the further objection of double use of the design does not apply.

As the question of patentability, when raised in an interference case, controls the matter of jurisdiction of the Commissioner in adjudicating the rights of the parties, it becomes necessary that that question should be first disposed of. It is impossible to determine whether this interference should continue without first considering the grounds on which it was declared.

The Primary Examiner originally rejected each of these cases for the reasons that no one of them contained patentable subject-matter; that the proposed design was not original with any of the applicants; that its adoption in these articles was not the result of invention, and therefore not entitled to the protection of the patent laws. Upon appeal this decision was reversed by the Board of Examiners-in-Chief.

Section 4929 provides that—

“Any person who, by his own industry, genius, efforts and expense has invented and produced any new and original design for a manufacture, bust, statue, alto-relievo, or bas-

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

Section 4933 provides that—

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

The articles in question are probably included within the phrase, "any new, useful, and original shape or configuration of any article of manufacture."

Comparatively few adjudications of design patents have been had by the United States courts in which a construction of the law has been given. The first decision which I have been able to find setting forth the purpose of the design patent act is that of *Wooster v. Crane*, (2 Fish. 583). In that case the patent had been granted the complainant for a design and configuration of a reel in the shape of a rhombus. The statute relied on by complainant was the Act of March 2, 1861, Section 11, which, in its provisions as to patentability, is substantially the same as the present law. The court there held:

"In this case the reel itself, as an article of manufacture, is conceded to be old and not the subject of a patent. The shape applied to it by the complainant is also an old and well-known mathematical figure. Now, although it does not appear that any person ever before applied this particular shape to this particular article, I cannot think that the act quoted above was intended to secure to the complainant an exclusive right to use this well-known figure in the manufacture of reels. The act, although it does not require utility in order to secure the benefit of its provisions, does require that the shape produced shall be the result

of industry, effort, genius, or expense, and must also, I think, be held to require that the shape or configuration sought to be secured shall at least be new and original as applied to articles of manufacture. But here the shape is a common one in many articles of manufacture, and its application to a reel cannot fairly be said to be the result of industry, genius, effort, and expense. \* \* \* \*

No advantage whatever is pretended to be derived from the adoption of the form selected by the complainant, except the incidental one of using it as a trade-mark. Its selection can hardly be said to be the result of effort even; it was simply an arbitrary chance selection of one of many well-known shapes, all equally well adapted for the purpose. To hold that such an application of a common form can be secured by letters patent, would be giving the Act of 1861 a construction broader than I am willing to give it."

I have quoted this decision thus fully for the reason that by substituting therein the present design for the one there mentioned, the reasoning and conclusions would be precisely the same; and also, because the doctrine in that case has never been reversed or departed from by the courts.

The arbitrary chance selection of the form of a now well-known and celebrated building, to be applied to toys, ink-stands, paper-weights," &c., does not, in my opinion, evince the slightest exercise of invention, industry, effort, genius, or expense. It is a mere imitation which any artisan has the right to apply to any object his fancy may dictate. And as the objects of fancy are innumerable, so the number of patents for this design might also be innumerable if the government were foolish enough to grant them.

It is true that the Supreme Court, in the Gorham Manufacturing Company case (14 Wall. 511) speak of the value of manufactured articles being enhanced by giving them new and beautiful appearances, and that the object of the law was to protect the producers of such appearances in the right to use them, but at the same time they distinctly allude to such appearances as having been "invented or produced," and add that the law "proposes to secure for a limited time to the ingenious producer of those appearances the advantages flowing from them."

They describe these original designs as the 'finished

products of invention.” The mere abstract idea or impression is not patentable, but becomes so when it has been or is to be applied to some particular article. If neither the article nor the appearance given it is original, wherein consists the originality, genius, or invention of the “finished product?” It is not like a patentable combination in mechanics, where two or more old elements may be combined to produce a new result, but the element here called the appearance, must, in all cases, be a new and original one.

Say the Supreme Court of this District, in the late case of *Niedringhaus* (8 Official Gazette, 279):

The appellants contend in their brief that “it matters not if the design has been previously used, if now combined with an object with which it has not been hitherto combined; and if, as a result of such association, a new and distinctive aspect is given to such object, the law is complied with,” and refers to former decisions by the Commissioner of Patents as cases in point. We cannot concur in this view. The thing provided for in the law is in express language,—“any new and original design for the manufacture;” “any new and original design for printing;” “any new and original impression;” “any new, useful, and original shape;” “the same not having been known or used by others before his invention or production thereof.” The use of an old design upon an old subject is clearly excluded by the statute, and mere changes or “double use” cannot receive its protection.

Besides, it is now well understood that the same degree of originality is required in both design and functional patents. That is, the claim must not be for a copy or imitation of what is already in existence.

And in alluding to the *Gorham* case, they add:

I am aware that the Supreme Court of the United States in *Gorham Co. v. White* (14 Wall. 524), have said in regard to design patents, that “they contemplate not so much utility as appearance, and that not an abstract impression, but an aspect given to those objects mentioned in the acts.”

That was an action brought for the infringement of a design patent for the handles of tablespoons and forks. The design consisted in the configuration of the spoon and the ornamentation of the handle. The outline and all the

details of the design were new, and invariable in each spoon alike. No question was discussed as to the originality of the patent, for it had never been known before, and the court decided that the article manufactured and sold by the defendant did not differ substantially from plaintiff's, and that it was therefore an infringement. But the whole tenor of the decision is to the effect that the appearance or aspect of the object must be of a design that is new and original. Indeed, no other view is admissible, for such is the express requirement of the law.

The Acts of Congress "were plainly intended," as the United States Supreme Court said, "to give encouragement to the decorative arts," but the authority for their enactment is the same provision of the Constitution that authorizes the grant of patents generally, and which provides for securing, for limited times to inventors, the exclusive right to their discoveries.

This provision has never been regarded by Congress or the courts as offering protection to servile imitators either in mechanics or the fine arts, but to encourage and protect the products of inventive genius.

This interference is, therefore, not only dissolved, but the applications will stand rejected.



*Ex parte* D. L. PROUDFIT.

Decided September 28, 1876.

10 O. G., 585.

1. The rejection of an application on the ground that it does not present the proper subject-matter for a design patent goes to the merits of the case, and may be appealed to the board.
2. The board have appellate jurisdiction whenever a statutory bar is interposed and the patentability of the subject is denied.
3. Only such matters as affect office practice and are interlocutory in their nature are appealable direct to the Commissioner.
4. All the reasons for rejecting an application should be given at once.

*Duell, Commissioner :*

The examiner has refused to consider this case, upon the ground that it does not "present proper subject-matter for a design patent," in view of certain decisions of the Commissioner.

The attorney, recognizing the former practice of the office in this particular, inquires whether his proper course is to appeal to the board or to the Commissioner in person.

Heretofore, matters of this kind have uniformly been disposed of by the Commissioner on interlocutory appeal, but such proceeding, I am convinced, was erroneous.

The Supreme Court, in *Commissioner of Patents v. Whitely* (4 Wallace, 522), decided that an application must be received before it can be acted upon, and that if the Commissioner actually refuse to receive an application a mandamus would lie to compel him, but that a mandamus would not lie where there was a remedy by appeal, as in the case of a refusal to allow the application after it had been received.

The statute provides that whenever an application is twice rejected, an appeal may be taken to the Board of Examiners-in-Chief, from them to the Commissioner, and thence to the Supreme Court of the district.

This has reference to all matters which go to the merits of the invention, and applies whenever a statutory bar is interposed and the patentability of the subject denied.

Only such matters as affect office practice and are interlocutory in their nature are appealable direct to the Commissioner in his executive or ministerial capacity.

In the case under consideration the objection clearly affects the merits, and involves the question of its patentability under the statute. The appeal should, therefore, be addressed to the board.

The examiner is directed to present all his objections to the application, so that a second appeal will not be necessary should his decision on this question be overruled.



*Ex parte* OTTO PRESSPRICH.

Decided February 1, 1877.

11 O. G., 195.

The rejection of an application upon the ground that it does not constitute the proper subject-matter for a design-patent, has reference to the merits, and is appealable to the board.

*Doolittle, Acting Commissioner :*

The examiner denies that the matter included in this application is the proper subject for a design patent, and, upon his suggestion, applicant takes this appeal.

The practice in this matter was changed in the case of D. L. Proudfit (10 Official Gazette, 585), where it was determined that the rejection of an application, on the ground that it does not present the proper subject-matter for a design patent, has reference to the merits of the case, and is subject to revision by the Board of Examiners-in-Chief upon appeal.

The case does not, therefore, come under the provisions of Rule 44, with reference to preliminary or intermediate questions, and the appeal is accordingly dismissed.

—o—

*Ex parte* PARKER.

Decided November 13, 1877.

13 O. G., 323.

Appeal from the decision of the Examiner of Trade-marks in the matter of the application of Thomas E. Parker, filed August 8, 1877, for Registration of a Label.

1. Registrable prints or labels and trade-marks are recognized by the terms of the law, and the decisions of the courts, as applicable only to some kind of merchandise.
2. Labels give the names of manufacturers, place of manufacture, nature or quality of goods, directions for use, &c. Trade-marks are arbitrary symbols, which serve to distinguish the

manufactured goods from those of a similar character made by other persons. Both are affixed in some manner to the goods they designate, and are not an essential constituent of the merchandise itself.

3. Hence, the figure of a boy, together with certain words, printed in minute squares upon a sampler-card, is the subject of a design patent. It is not to be attached as a distinguishing label or symbol to certain merchandise, but is the article itself.

*Doolittle, Acting Commissioner :*

Applicant described his label as consisting of the figure of a boy, and the words "Scratch my back," surrounded by a border of parallel lines, as shown, the figure and the words being formed of numerous squares, printed and arranged as represented. This label is for use on cards, or sheets of abrasive paper or cloth, and as a pattern for sampler-work, to be wrought on the squares, in order to so finish the label when desirable. The cards thus labeled are intended for use in firing friction-matches.

I am informed that it is quite common to work designs of precisely this character upon the back of abrasive paper or cloth, but the question of novelty is not the one at issue, but rather that of identity. Is it a label, trade-mark, or should it be copyrighted?

As held in the Simpson case (10 Official Gazette, 333), one definition given by Webster of a label is about what the office regards as being the proper matter to be registered as such. "A narrow slip of silk, paper, parchment, &c., affixed to anything denoting its contents, ownership, and the like, as the label of a bottle or a package." So far as this definition includes fanciful and arbitrary matter, which may be used for the sole and independent purpose of a trade-mark, to denote origin or ownership, it is not applicable to matters registered as labels.

Registrable labels or prints and trade-marks are recognized by the terms of the law and the decisions of the courts as applicable only to some kind of merchandise; labels, as giving the names of the manufacturers, place of manufacture, nature or quality of goods, directions for their use, and the like; and a trade-mark as some arbitrary

symbol to distinguish the same from those goods of a similar character made by other persons.

The trade-mark statute requires applicants to specify "the class of merchandise and the particular class of goods comprised in such class" to which the mark has been, or is intended to be, appropriated.

The section of the copyright law relating to labels provides that no prints or labels to be used for "any other articles of manufacture" than pictorial illustrations of works connected with the fine arts shall be entered under the copyright law, but may be registered in the Patent Office.

And the penal Act of August 14, 1876, embracing within its terms both trade-marks and labels, applies to the fraudulent affixing of them to goods or packages containing the same.

The courts have always sustained trade-marks and labels on precisely the same principles, and they uniformly discuss these matters as having been fixed, in some way, to goods, as merchandise, and not as constituting the merchandise itself.

This was remarked by the learned judge in the case of *Moorman v. Hoge* (2 Sawyer, 78), in passing upon an alleged trade-mark. He stated that he had examined with care a large number of cases involving infringement of trade-marks, including all the recent cases which he had been able to find bearing upon the question, and that he had found no case in which the use of an article or package containing it had been enjoined, unless there was some symbol, word, letter, or form impressed or affixed to the article, and which, considered separately from the article or package, was used as the trade-mark.

This view of the law was also approved by the United States Circuit Court for the Southern District of New York, in the case of *Harrington v. Libby* (12 Official Gazette, 188).

In the present instance, then, the matter sought to be registered is not a label, print, or a trade-mark affixed to goods or merchandise, to denote ownership, or the character of the goods, and the like, but is the article itself—a fanciful pattern wrought or to be wrought into or upon the

article—forming part of the article and giving to it a certain value, by way of a new appearance, like a new pattern worked upon a slipper.

Neither is it designed to be published as a work of fine art, and therefore is not the subject of copyright.

We are now led to consider whether the design act applies to the case.

The law relating to designs provides for the granting of patents to those who, among other things, have invented and produced “any new and original impression, ornament, pattern, print, or picture to be printed, painted, cast, or otherwise placed on, or worked into, any article of manufacture.”

The Supreme Court have held that the object of this act was to extend the protection of a patent to the ingenious producer of new and original appearances given to manufactured articles, whereby their salable value was enhanced, and the demand for them enlarged.

They add that this appearance may be the result of the peculiarity of configuration or of ornament alone, or of both conjointly. *Gorham Manufacturing Company v. White*, 14 Wall., 511.

In view, then, of the fact that the matter in question is ornamental in character, and is to be incorporated into the structure of the article, to be a permanent part thereof, I am of opinion that it comes within the terms and meaning of the design act. See case of *White*, Com. Dec., 1871, p. 304.

The subjects to be protected under the design, copyright, label, and trade-mark acts are often so nearly the same in character that it is difficult always to say to which class they belong, especially in the absence of definitions in the statutes, but these provisions differ in some respects so widely that the executive departments must give them some positive interpretation to insure an orderly administration of public business.

The decision of the Examiner of Trade-marks is affirmed.

*Ex parte* ROGERS *et al.*

Decided April 2, 1878.

13 O. G., 596.

1. An application for a design patent in analogy to an application for a mechanical patent need not be divided if the separate subordinate designs to which claim is made form, when united, one principal and complete design.
2. Nor is there objection to making claim to each subordinate feature, provided it is of a distinct and separable part of the whole design.

*Spear, Commissioner :*

This appeal is taken from the ruling of the examiner requiring a division of the application. The application is for a patent for a design consisting of a screw-head formed to represent a crown surmounted by a cross, together with a base of peculiar shape and configuration, to which the screw-head is fitted.

Two claims are made: one for the design of the screw-head, and the other for a design of the base plate. It is represented that although the two are especially fitted for each other, and form when in place one complete design, yet that the screw-head may be used with an entirely different shape of base, and the base may be used with an entirely different shape of screw-head.

The examiner, following the decision of the acting commissioner in *ex parte* Brower, Com. Dec., 1873, p. 151, required a division of the application, holding that the subject matter was such as to be properly in two distinct applications. The decision quoted may possibly go to that extent, but I cannot agree with it, and think that it would be unnecessary hardship to require the applicant to make two separate applications and take out two separate patents, both parts forming, when united, one complete design, while, as has been stated, they are separable, and can be used without the other with good effect.

If each design is patentable at all, I do not see why they might not be claimed as parts of one whole.

The law relating to design patents provides "that any person who, by his own industry, genius, efforts, and expense, has invented or produced any new or original design, &c., \* \* \* may, upon payment of the fee required by law and other due proceedings had, the same as in cases of invention or discoveries, obtain a patent therefor."

The law plainly indicates what seems in itself reasonable, that the same principle should be applied in the issue of design patents, so far as they may be applicable, as those which govern in the issue of patents on what are called mechanical subjects.

I cannot conceive of any reason for refusing to allow particular claims for the particular elements of a design any more than for refusing to grant claims for subordinate elements and combinations in a machine, provided the parts are distinct and separable, and at the same time go to make up with beneficial effect the whole design.

The decision of the examiner is reversed.

---

*Ex parte* BEATTIE.

Decided May 3, 1879.

16 O. G., 266.

More than one separate and independent design cannot be claimed in the same application; but, where the design is an entirety, a claim for the entire design, as well as claims for sub-combinations of the parts, is allowable.

*Applicant claims—*

1. The design herein described for the handle of a spoon or analogous implement, consisting of the general configuration of a spear-head or dart, having a blunted point and obtuse angles upon the sides.
2. The handle made in the form of a spear-head with obtuse angled sides and a blunted point, and having an enlargement at c, between the same and the shank, as shown and described.

*Doolittle, Acting Commissioner :*

The examiner's objections to these claims, in matter of form, are twofold:

*First.*—That the claims do not embrace the ornamentation.

*Second.*—That they present two independent designs, and not a unitary device.

As to the first objection, the claims and descriptions are made as to mere configuration, without regard to ornamentation, and this, under the law, is permissible. Applicant might have claimed the ornamentation without regard to the configuration.

As to the unity of the design, all the parts are included in the second claim, and this properly should be the first claim. The first claim is for a sub-combination of the features, omitting the enlargement, c.

Care should be taken that an application for a design patent does not embrace claims for more than one separate and independent design. In such case the application should be divided, as in other classes of inventions. But where one claim is made which covers the entire device, there is no reason why the practice in other classes of also making claims for combinations of the separate features should not be here permitted. (Sheppard, *ex parte*, Com. Dec., 1870, 22.) Otherwise an infringer might use with impunity almost the entire design. In the present case for instance, if the design could only be claimed in one form, with the enlargement, c, near the shank of the handle as an unvarying part thereof, another would not invade applicant's right, as claimed, by omitting this enlargement and using the rest of the design, which is, by all odds, the most conspicuous and important part thereof.

If an applicant is the inventor of a design as an entirety, as well as of each of its parts or several of its parts in combination, his claims should be commensurate to his rights.

The decision of the examiner is reversed.

*Ex parte* SHOENINGER.

Decided November 20, 1879.

15 O. G., 384.

Under Section 4929 of the Revised Statutes a design patent may be granted for any shape or configuration of an article of manufacture which is new and useful, whether it is or is not at the same time ornamental.

*Paine, Commissioner:*

The question is, whether, under Section 4929 of the Revised Statutes, a patent may be granted for a "shape or configuration of any article of manufacture," which shape or configuration is useful, whether it is or is not also ornamental. It is not to be denied that the record of the office on this question is somewhat ragged. The decisive words of the section (Rev. St., 4929) are these: "Any new, useful, and original shape or configuration of any article of manufacture." The corresponding clauses of the Acts of 1842 and 1861 took the following form: "Any new and original shape or configuration of any article of manufacture."

The word "useful" was first employed in the Act of 1870, and constitutes the only point of difference between that act and the Acts of 1842 and 1861, so far as the clause in question is concerned.

On the 20th of April, 1869, the Commissioner said, in Crane's case (1869, C. D., 7) that since the passage of the Act of 1842 it had been construed in the Office as exclusively applicable to designs for ornament; but he concluded that this construction was erroneous, and stated his opinion of the effect of the Act of 1842, in the following words:

"Whenever there shall be produced by the exercise of industry, genius, effort, and expense, any new and original design, form, configuration, or arrangement of a manufactured article, it comes within the provisions and objects of the act creating design patents, whatever be its nature, and whether made for ornament merely or intended to promote convenience and utility."



On the 2d of December, 1869, a succeeding Commissioner, in Bartholomew's case (1869, C. D., 103), expressed the same opinion as to the effect of the Acts of 1842 and 1861, but questioned the accuracy of this statement respecting the previous construction of those acts in the office. He said:

“Fortunately no such uniform practice has existed, and the office is relieved from so grievous an imputation. The practice seems to have been taken for granted by the appellate tribunals, and, so far from being as stated, is, as nearly as possible, the reverse of it. Articles have been and are being constantly patented as designs, which possess no element of the artistic or ornamental, but are valuable solely because, by a new shape or configuration, they possess more utility than the prior forms of like articles. Of this character are designs for ax-heads, for reflectors, for lampshades, for the soles of boots and shoes, which have been heretofore patented as designs; and to this class might be added, with great propriety, that class of so-called mechanical patents granted for mere changes of forms, such as plow-shares, fan-blowers, propeller blades, and others of like character. \* \* \* I am of opinion that the class of cases named in the act as arising from new shape or configuration includes within it all those new changes of form which involve increase of utility.”

In Fenno's case, decided February 27, 1871, after the enactment of the law of 1870, the Acting Commissioner said:

“I am of the opinion that, under the present statute, if a new and, at the same time, useful shape be devised for a particular article of manufacture, even though no ornamental effect be produced thereby, the inventor of the same is entitled to protection for it under the design section of the patent law.” (1871, C. D., 52.)

But, on the 25th of September, 1871, a third Commissioner, in Parkinson's case (1871, C. D., 251), questioned the doctrine of Bartholomew's case. He decided that usefulness, in the sense of the Act of 1870, consisted in adaptation to the production of pleasant emotions; in other words, that the term “useful” means pleasing, in the clause authorizing the issue of a patent for “any new, useful,

and original shape or configuration of any article of manufacture.”

My attention has been called to no judicial authority beyond a dictum in *Gorham Manufacturing Company v. White* (14 Wall., 511), decided under the Act of 1861, in the following words:

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

If, using language in a very broad, not to say fanciful, sense, we may predicate utility of mere beauty, it is nevertheless, certain that in the language of legislation, as well as of common life, the words useful and ornamental are not so employed; and that such an extraordinary meaning as that adopted in *Parkinson's* case cannot fairly be imputed to the word useful in the statute seems to be very clear. In my opinion, the provision as it stood in the Acts of 1842 and 1861 covered designs which were ornamental, although they were at the same time useful; and the provision as it stands in the Act of 1870 covers designs which are useful, whether they are or not ornamental. The weight of authority seems to be in favor of this view of the law.

The examiner's objection in this case is not that the design is for a shape or configuration wholly useful, but that it is not for a shape or configuration wholly ornamental. He thinks the presence of utility as one of the qualities of the design renders it unpatentable, notwithstanding the simultaneous presence of beauty as another quality.

But I think that if the design is new and original, and also useful, it is patentable under the law, whether it be or not ornamental or beautiful.

The examiner will conform his action in the case to the foregoing opinion.

The decision of the primary examiner is affirmed.

*Ex parte* PALMER.

Decided November 30, 1881.

21 O. G., 1111.

A previous mechanical patent is of itself no bar to the grant of a patent to the patentee therein for a design shown in such patent. Former decisions commented on and disapproved.

*Marble, Commissioner :*

This application comes before me upon a question of law, submitted by the examiner of designs, as follows :

“Can an application for a design patent be properly rejected upon a mechanical patent to the same party showing the same design ?”

It appears that this question has been already considered by three different Commissioners; but the applicants in this case and in another, in which the same point has arisen, urge that in view of a recent decision of Mr. Justice Blatchford in *Collender v. Griffith* (18 O. G., 241), the former practice of the office is improper, and should be discontinued.

The decision by Commissioner Fisher in *ex parte* Stuart and Bridge (Com. Dec., 1870, 15), was made under the Act of 1861, which contained a different provision in reference to prior knowledge and use from the Act of 1870, and hence has no weight in the present case.

The decision in *ex parte* Kohler (Com. Dec., 1873, 84) was based upon the ground that if a design patent should be granted, any subsequent assignee of the mechanical patent could not use the form in which the inventor originally embodied his invention, and that he must consequently be considered to have “dedicated it to at least any person who now does or may hereafter own the mechanical patent.” To bar the grant of a patent upon the ground of abandonment, such abandonment must be to the public, and not simply to the assigns of the inventor, and hence it seems that the position taken by the commissioner in this case is not tenable.

In *ex parte* Towne & Taylor (19 Com. Mss. Dec., 6) which also presented the same question, the Commissioner

allowed a design patent upon the ground that the parties in the patent and application were not the same, the design being shown in a previous mechanical patent to Taylor, but being, in fact, the joint invention of Taylor and Towne. He, however, approved the decision in Kohler's case, though basing his approval upon the ground that the previous mechanical patent was a publication.

As the statute requires, in order to defeat the grant of a patent, that a publication shall be made before the invention or production of the subject matter thereof, it does not appear how the previous mechanical patent can have such effect. If the design was invented by the patentee at all it must have been invented before the filing of the application for the mechanical patent in which it is shown, and hence a publication, to be a bar, must have been made before the invention of the mechanism embodying the design.

The point which arises here is not exactly the same as that in *Collender v. Griffith*, above referred to, the design patent in that case having been first granted, and the question at issue was whether it was a bar to a subsequent mechanical patent, but the principles laid down by the court are equally applicable to the present case. The court says:

“The claim of the design patent is to shape. The claim of the reissued mechanical patent is a claim to a mechanical combination. The shape of the structure may be the same as the shape in the design patent, but the subject matter of the two claims is not the same. The shape covered by the claim of the design patent may be attained without following the mechanical combination claimed in the reissued mechanical patent.”

There seems to be no doubt that the court by this language meant to declare the subject matter of design and mechanical patents to be entirely different. Nothing else could have been intended, for in the one case ornament is the basis, and in the other mechanical function. It therefore follows that whichever kind of patent is first obtained by an inventor it will not be a bar to the grant to him of a patent of the other kind.

It has long been held by the office that where the applicant is the same, a previous design patent is no bar to the

grant of a mechanical patent (*ex parte* Bartholomew, Com. Dec., 1871, 298, and Collender, Com. Dec., 1872, 217), and I am also of the opinion that of itself a previous mechanical patent is no bar to the grant of a patent to the patentee therein for a design shown in such patent.

The view herein taken accords with that of the court in *Burton v. Greenville* (18 O. G., 411), where this precise question arose, but which they did not think it necessary to decide. They say:

“A question is made by the defendants whether an inventor is not to be presumed to abandon his design when he exhibits it in the drawings of a mechanical patent. I do not see why this consequence should follow until the design has been in use for two years.”



*Ex parte* NORTON.

Decided June 16, 1882.

22 O. G., 1205.

1. The term “useful” in the patent law is used in contradistinction to “mischievous.” A design, if not mischievous, is useful if it is attractive, and the utility consists in such a shape or configuration of a given article that persons needing it will purchase it because of such shape or configuration in preference to other articles for the same purpose, but different in shape or configuration.
2. Matter descriptive of the mechanical functions of a device should be omitted from a design application.

*Marble, Commissioner:*

Applicant claims as a new article of manufacture—

“The T-shaped shingle machine frame, consisting of the parts a and b, the part b being the jointer-casing and supporting the saw-arbor, substantially as set forth and illustrated.”

Two of the examiners-in-chief unite in holding that the decision of the primary examiner should be affirmed, but on different grounds.

The statute provides that design patents, among other things, may be granted for "any new, useful, and original shape or configuration of any article of manufacture." It is not denied that what is claimed here is an article of manufacture, and that it is new, but its utility seems to be questioned. An examination of the representation of the article shows that for its functional or mechanical use it is useful, being strong and compact, and in such shape as to recommend it to those engaged in the business for which it is intended. Such being the case, the question arises as to whether it is useful as a design for a shingle-machine frame. "'Useful,' in the patent law, is in contradistinction to 'mischievous.' The invention should be of some benefit." (*Cox v. Briggs*, 2 Fish., 174.) A design, if not "mischievous," is useful if it attracts persons to it or to articles made like it. It may not be of great artistic excellence, but if it be attractive it is useful.

So, I think, in articles of manufacture like the one under consideration, if the applicant has by his industry, genius, and efforts made a design of an article of manufacture—viz., the frame of a shingle-machine—which, because of its design and not because of its mechanical structure (by which I mean its strength and durability), commends itself to persons desiring to purchase such articles, it is useful, and the applicant should be protected in its manufacture and sale. It is not necessary that it should be ornamental, although it may be, to entitle the applicant to a patent therefor. The utility in an article of this kind consists in having a shape or configuration of such a character that persons needing it will purchase it because of its shape or configuration in preference to other articles for the same purpose but different in shape or configuration. Applicant, however, must strike out of his application everything descriptive of the mechanical functions of the device.

The decision of the Board of Examiners-in-Chief is overruled, and the patent will be allowed.

*Ex parte* POPE.

Decided June 30, 1883.

25 O. G., 290.

1. A claim for other than the entire design, or a distinctive integral part thereof, not allowable.
2. In an application for a design patent, a claim merely for a portion of the design, capable of being attached or connected with different forms to make up an entire whole, is inadmissible. The claims must be restricted to the entire design and distinctive, segregable, integral parts thereof.

*Marble, Commissioner:*

Appeal is taken from the decision of examiners-in-chief affirming the decision of the examiner rejecting the following claim, viz.:

“The upper portion of a seat-riser ornamented with segments or arches, a, a, a, (the centre arch terminating in knob-like portions, c, c,), the bifurcations at o, and the hook-like parts, b, b.”

A claim for the entire design has been allowed. Applicant now desires to have a claim for the upper portion of the design, because, as he alleges, the lower portion thereof may be varied, and thereby the invention rendered of little or no value. The examiner and the examiners-in-chief unite in holding that the claim is not for a definite, segregable, distinctive part of a design, but only for a part of an entire whole, and hence is not allowable. Applicant cites certain patents in which segregable portions of an entire design were allowed to be covered by separate claims, and urges that because such claims were allowed this claim should be, although the matter described is not segregable as presented from the entire design. He also calls attention to the fact that distinct parts and distinct combinations in machines are permitted to be covered by distinct claims.

I think applicant fails to draw the line where it is drawn in the decisions referred to, either in granting the patents mentioned or in deciding what may be covered by claims. An invention is an entirety, and when a patent is issued covering an invention, if properly issued, it covers the

entire invention. If it be a machine, the invention may be made up of many parts and many combinations, each of which in itself is integral, and under the practice claims for such parts or combinations are allowable.

The claim here presented is not for an integral part of a design, nor is it for an entirety; but it is rather for a portion of a design which is capable of being attached or united with different forms to make up an entire whole. It is because the portion sought to be covered by this claim is susceptible of such attachment or arrangement that applicant desires a separate claim therefor. I think his desire to have it covered by such claim arises from a misapprehension of the law. It is not every colorable change which may be made in a design, which renders it patentable. On the contrary, designs which in general appearance are the same are held to be the same designs, although in some particulars they may be varied, either intentionally or otherwise. (See *Gorham Mfg. Co. v. White*, Simonds on Design Patents, pages 30 to 50.) If, therefore, a design should be manufactured by some other person or company having the upper portion of the seat-riser the same as the one here presented and claimed, with the lower portion of some other form of construction, it would clearly be an infringement of this design, the part which would attract the eye and give general appearance to the structure being the upper rather than the lower part.

I find no error in the decision of the examiners-in-chief, and therefore affirm the same.



*Ex parte* LEE & SHEPARD.

Decided September 8, 1883.

24 O. G., 1271.

Matter patented as a design cannot be registered as a trade-mark.

The office, after having adjudicated certain subject-matter patentable as a design, and granted a patent therefor, thereby giving the patentee the exclusive right to use the same for the term of years mentioned therein, cannot register as a trade-mark substantially the same design, and give to another and different party the right to use it as a trade-mark.



*Marble, Commissioner :*

Applicants' appeal from the decision of the Examiner of Trade-marks refusing registration of "an ornamental book-cover, having projecting beyond the edges thereof silk or other fringe." The examiner refused registration for two reasons: first, because the book-cover described is anticipated by Design Patent No. 13,040, to G. Bourck, dated July 18, 1882; and, second, because the book-cover is not a trade-mark. The book-cover here claimed is in all essential particulars the same as the card-cover patented as a design to Bourck. Bourck has the right under said patent to use his design not only as a cover for cards, but for books as well. There can be no question that the subject-matter covered by Bourck's design patent was patentable as such.

While it is true that a design may be used as a trade-mark, and that which is properly the subject for a design patent may also be the proper subject for a trade-mark, still the office, after having adjudicated certain subject-matter patentable as a design, and granted a patent therefor, thereby giving the patentee the exclusive right to use the same for the term of years mentioned therein, cannot register as a trade-mark substantially the same design, and give to another and different party the right to use it as a trade-mark. Conflict in the rights of parties would at once arise. One would claim that he had the right to sell his production under his trade-mark, and the other under his design patent. The office should not knowingly bring about such a controversy.

Bourck filed his application long before Lee & Shepard's application was filed, and took his patent in the regular course of proceedings. The office will do nothing to cast a shadow upon his title to the invention covered by his patent.

As the decision of the examiner must be affirmed on the first point, it is unnecessary to consider the second. The decision is affirmed.

*Ex parte* TRAITTEL.

Decided November 12, 1883.

25 O. G., 783.

1. A design is merely a delineation of form or figure, either plane or solid—a shape or configuration. The character of the material, or the colors in which a design finds expression, form no part of it, and are of no possible importance in describing the design itself.
2. There is no design which is not capable of delineation and description on paper, one or both, such delineation being the primary means; but where the forms are known forms, as in the case of geometrical figures, language may be employed as an auxiliary to describe them.
3. A grouping together of certain materials in an article of manufacture, so as to produce an ornate effect, may be patented as an article of manufacture, in which case the applicant may properly mention the mechanical structure, character, and qualities of materials, colors, &c.; but if he wants to patent a design, he must confine himself to a delineation of the form, shape, or configuration the manufactured article is to assume. He must not prepare his specification under one classification, as a predicate for asking a patent under another separate and distinct class.
4. If the examiner decided erroneously in a former case, it will hardly be urged that such decision under the rule *stare decisis* would bind the appellate tribunal.

*Butterworth, Commissioner:*

This case comes up on appeal from the decision of the primary examiner.

The appellant makes application for a patent for a novel design for finger-ring settings. The examiner held the specification to be defective, on the ground that the materials, color, and mode of manufacturing the article for which the design is intended are improperly referred to and described therein; that, instead of describing a design for an article of manufacture, the applicant in fact describes

an article of manufacture and the materials and mode of constructing it.

The specification is in the following language, viz :

“My invention relates to a novel design for finger-ring settings, and consists in a stone formed with a depression in which is mounted a metallic ornament, said depression being greater in extent than its contained ornament, so as to be distinctly visible, as will be hereafter more fully described.

“Previous to my present invention, finger-ring settings have been made with stones, in the faces of which have been engraved initial letters, monograms, or other things ; and settings have also been made in which the stones thus engraved or cut have been provided with metallic letters, monograms, or other things which were set within the engraved or cut portions of the stones, so as to wholly fill the same and present a substantially smooth and unbroken exterior surface.

“I have illustrated my invention in the accompanying drawings, in which I have shown at figure 1 a top view, at figure 2 a side view, and at figure 3 a cross-section taken at the line xx of figure 2.

“In the several views the same part will be found designated by the same letter of reference.

“A is the shank or band of the ring, and B the metallic base or bearing for the stone ornament C, which latter is provided with a depressed or sunken portion, c, within which is mounted or arranged a metallic letter, b, preferably of gold. The depression c in the stone C, I make of greater area than is necessary to encompass the metal letter b, so as to be clearly visible, and show in relief its contained ornament.

“I have shown my invention embodied in a stone rectangular in contour and curved in form, but do not consider the same as limited to a stone of any particular shape or color ; and, although I have shown the depression in the stone elliptical in outline, this may be changed without departing from the spirit of my invention ; and of course, instead of the metallic letter T shown, any other metallic letter or monogram or device may be used.

“The ends of the shank of the ring are shown, orna-

mented with a series of curved notches, n, and perforations, m; but this ornamentation may be used or not with a setting containing my invention, at the pleasure of the manufacturer.

“What I claim as my invention, and desire to secure by design letters patent is—

“1. A finger-ring having substantially the configuration and ornamentation shown and described.

“2. A finger-ring setting of stone, formed with a depression, c, in which is arranged a metallic ornament, substantially as shown and described.

“3. A finger-ring setting consisting of a curved stone having a depression, c, elliptical in outline, in which is arranged a metallic ornament, substantially as shown and described.”

The points raised on this appeal may be determined by correctly answering the following questions:

*First.* Does the specification describe a single specific design?

*Second.* Is the design described in appropriate terms?

*Third.* What is a design as contemplated by the statute?

SECTION 4899. “Any person who, by his own industry, genius, efforts, and expense, has invented and produced any new or original design for a manufacture, bust statue, alto-relievo, or bas-relief; any new and original design for the printing of woolen, silk, cotton, or other fabrics; any new and original impression, ornament, patent (pattern), print, or picture to be printed, painted, cast or otherwise placed on or worked into any article of manufacture; or any new, useful, and original shape or configuration of any article of manufacture, the same not having been known or used by others before his invention or production thereof, or patented or described in any printed publication, may, upon payment of the fee prescribed, and other due proceedings had the same as in cases of inventions or discoveries, obtain a patent therefor.”

A design is merely a delineation of form or figure, either plane or solid—a shape or configuration. The construction of an article in accordance with that delineation is the materialization of the conception of design. The concession of a building of some particular shape, form, or con-

figuration, and which is delineated on paper or described in language, is a design. The various shapes and figures which appear in colors on the surface of prints and carpets are the expression of so many different designs.

The material out of which the building is constructed, whether of stone, brick, wood, or glass, forms no part of the design. The character of the material, whether velvet, cloth, cotton, or wool, upon which the designs find expression, form no part of the design. The colors in which they find expression are of no possible importance in describing the design itself. A combination of red and blue and green may be beautiful, and the effect very desirable, but it forms no part of the design, but is the medium through which a design, which relates solely to form and configuration, finds expression or materializes. Then, since a design as used in the statute relates solely to form and configuration, how should it be described?

There is no design which is not capable of delineation and description on paper, one or both, such delineation being the primary means. Where the forms are known forms, as in the case of geometrical figures, language may be employed as an auxiliary to describe them. And it follows as a corollary to the foregoing that the applicant's design, if he has one, is capable of being described or delineated on paper without reference to the materials used, or the colors employed, or the mode of their utilization in the construction of the article for which the design is intended.

Does the specification describe a single specific design? The applicant has delineated upon paper what is called a design; but in the specification he does not confine himself to any particular shape, form, or configuration. What he does in fact claim, is any form of ring or ring-setting that may be the product of his method of construction. Has he used apt and proper language to describe a or any design? Clearly he has not. He has proceeded to describe, with much particularity a manufactured article, has given the materials employed, including color preferable. The form and configuration, which alone relate to, describe, and constitute a design, being, if not hidden altogether, at least very obscure.

The appellant says, in effect, that he is unable to convey the idea of what he regards as his design without mentioning the materials, the color, and mechanical structure. If this is true, the difficulty arises, not because it is impossible to describe or delineate a design without reference to the materials, color, and mechanical structure, but from the fact that what he seeks to describe is not merely a design—a form or configuration for an improvement for a ring-setting, but the means of producing a pleasing effect resulting from the qualities, color, and texture of the materials used.

It is urged that the very idea, end, and purpose of the inventor may be to so group together certain materials in an article of manufacture as to produce an ornate effect—to produce, in other words, “a thing of beauty,” the beauty resulting largely, if not altogether, from the character or quality of the materials used and the arrangement of them in the manufacture. And I am asked, may there not be a design in that? Undoubtedly there may, and the inventor may have a patent for the article of manufacture, in which case the applicant may properly mention in the specification the mechanical structure, mode of constructing, and character and quality of materials, colors, &c., as the appellant in the case at bar does. Or, if he desires simply to patent a design—that is, the form, configuration, which the manufactured article is to assume when it materializes—he will confine himself to a delineation of that form, shape, or configuration; but he must not prepare his specification under one classification as a predicate for asking a patent under another separate and distinct class. The object of the rule, which reflects the intent of the statute, is to prevent this, and it is in obedience to that rule that the examiner declared the specification in the application under consideration incompetent. He was right in his action. The line which marks the boundary between the classification of subjects which the statute makes patentable should be carefully and sharply drawn to avoid confusion; otherwise it may frequently occur that, instead of protecting and encouraging the genius of invention, a mere monopoly is created and fostered.

My attention is called to the fact that the examiner who

objects to the specification in this case has heretofore and recently passed, without objection, specifications with reference to the same subject-matter, and which are almost identical in manner and form with those under consideration. It is enough to say that, if the appellant is correct, the action of the examiner was erroneous; and it will not be urged that the decision of the primary examiner, under the operation of the rule *stare decisis*, would bind the appellate tribunal.

The decision of the examiner is approved.

---

*Ex parte* PATITZ.

Decided November 19, 1883.

25 O. G., 980.

1. Rule 41 makes no distinction as to applications, and a design is equally within its terms as a mechanical application.
2. Where there is no necessary connection between the designs exhibited in two articles, the fact that they are adapted to be associated does not constitute a unity of design, and the two must be presented in separate applications.

*Butterworth, Commissioner:*

The application presents two distinct articles of manufacture having uses as separate and distinct as those pertaining to a watch and the chain to which it is to be attached; and to each of these articles he gives a pleasing appearance by means of certain ornamentation. He has manufactured a mirror-frame, not a new thing, but made presumably according to a new design, and also a sconce embracing a certain design. The sconce may be attached to the mirror-frame, and provision is made therefor; and it is suggested that the "design" may be varied and changed to suit the taste by disassociation of the particular mirror-frame from the sconce, and *vice versa*.

There is no necessary connection between the design for the mirror-frame and the sconce, and their union in the manner contemplated in this application does not constitute a unity of design. Nor is there, in fact, a unity of struc-

ture. The grouping together of the two articles produce an ornate effect; but it is the result of mere aggregation or association of the sconce and mirror-frame; hence, the two can no more be included in the same application than if they were not adapted to be associated.

It can hardly be doubted if an application for a mechanical patent had been filed describing a peculiar formation of mirror-frame and a peculiar construction of sconce, and containing separate claims to these constructions, that a division would have been required, notwithstanding the sconce might be detachably secured to the mirror-frame. At all events, previous decisions would give a negative answer, and Rule 41 accords with them. This rule makes no distinction as to applications, and a design is equally within its terms as a mechanical application. The same considerations apply to the two classes of applications in regard to this question of joinder of invention. To permit the two claims now presented to be embraced in one application will confuse and cripple the classification established for the proper and orderly administration of the business of the office. This decision is in the line of precedent. (See *Ex parte* Brower, C. D., 1873, p. 151.)

The decision of the examiner is affirmed.



*Ex parte* STETSON.

Decided May 26, 1884.

36 O. G., 343.

1. The ornamentation of a clock-dial is a legitimate subject for a design patent under Section 4929 Revised Statutes, but the ornamentation must be distinctly separable from and irrespective of particular time-indicating figures and characters and their particular arrangement upon the dial. This latter feature, being solely of functional value, is not the subject of the design section, but of Section 4886 Revised Statutes.
2. A design cannot consist of any mere arrangement of particular letters or numerals, but it may consist of the shape or configuration of a particular letter or numeral—never in their combination to make up a function in an organized apparatus.



Examiner's Statement: "Consideration of the above entitled application having been refused by the Examiner of Designs on the ground that the same fails to offer, as described, shown, and claimed, proper subject-matter for a valid patent under Section 4929 Revised Statutes, the same being instead, as set up, for an improved clock-dial, and, therefore, falling within the terms of Section 4886 Revised Statutes, applicant notes an appeal under Rule 140.

"It has been held (*ex parte* Proudfit, 10 O. G., 585, and *ex parte* Pressprich, 11 O. G., 195) that an objection upon the grounds above indicated is not properly appealable under Rule 140, but that such objection goes to the merits, and is only appealable under Rule 128. The question involved, however, being in substance the same as that presented in *ex parte* Traitel (25 O. G., 783), the examiner sends the appeal forward for such consideration as the Commissioner may determine it deserves.

"Perhaps the simplest statement of the examiner's objection to the consideration of the application under the act relating to design patents, and one which at the same time demonstrates the fallacy of applicant's belief that he has produced 'a new and original design,' would be formulated in the following question: Are the particular numerals set forth in this case of the essence of the invention? If they are, and in the organization shown, then it is to say that applicant's invention is not a design under the act, for a design cannot consist of any mere arrangement of particular letters or numerals, as shown, described, and claimed in this case. A design may, however, consist of the shape or configuration of a particular letter or numeral—never in their combination to make up a function in an organized apparatus; but when, as in tickets, passes, coupons, blanks, notes, checks, calendars, etc., a certain function of novel and useful kind of character is obtained by the definite and specific combination—*i. e.*, 'arrangement' of the ordinary letters of the Roman alphabet or the numerals of the Arabic system of notation—then a new article is 'invented or discovered' for which the patent act in Section 4886 Revised Statutes, affords ample protection; and the classification of this Office shows many valuable patents issued upon this subject-matter. If, moreover, applicant should allege

himself to be the inventor and producer of a new font of printing type which should be adapted to produce the representation of an individual type of hybrid letter or numeral such as shown upon his clock-dial, he would clearly be within the pale of the act relating to designs, for he would then have produced a (possibly) new 'impression.' In that event he would be entitled to make use of his representation wherever and whenever he might find it desirable; but to seek to cover by a design patent an arrangement or combination of particular letters and numerals which confessedly is without value, except in the particular arrangement shown, is to attempt to invade the sphere of Section 4886 Revised Statutes, and would, if successful, be the means of securing to applicant an invalid patent. (*Pratt et al. v. Rosenfeld et al.*, 21 O. G., 866.) It is as if an application should be made for a design patent for a bank-check in which the entire novelty or essence of the design alleged should be described and shown as consisting in the fact that the letters and numerals represented thereon were printed in a particular type—possibly in a type or impression never before known or produced. Is it, then, to be contended that, granting such impression to be a new impression, the bank-check so printed is a 'new and original design?' Or, further, would the fact that the said check was printed in a particular type or impression make that check a 'design' in the statutory sense of the word or in the classification of this office? Manifestly not. Because the type or impression is the proper and legitimate subject of a design patent, can it, therefore, be lucidly maintained that a specific functional arrangement or combination thereof in any symbols, sentences, or emblems in or upon a particular article not itself the subject of a design patent renders that article a proper subject for a valid patent of that character? If the contrary to this proposition were true, then, indeed, it is not easy to discover where the true line of demarcation is to be drawn between these two sections of the Revised Statutes herein referred to.

“If called upon to examine the application as presented, the first requirement of the examiner, under the rules and practice of the Office, would necessarily be that applicant

should eliminate from the drawing all letters and numerals, and from his specification all description thereof and reference thereto, such being inadmissible in any 'new and original design.' And this for the reason that the same indicates on the one hand, either function which is unlawful in a design patent, or, on the other hand, objectionable matter of the nature of surplusage, as being either of trademark character or as lacking in the statutory 'genius, industry, efforts, and expense' required for the production of a design.

"The touchstone, then, whereby to determine whether applicant has produced a new design is: Is the design new, irrespective of the particular letters and numerals shown and described? If the answer is in the affirmative, the examiner admits his error. Had he believed an affirmative answer would have been admitted by the applicant, he would have assumed jurisdiction of the case, and required applicant to remove the objectionable features and make claim to the design that should remain; but what design would be shown with the particular, functional, time-indicating features of the dial eliminated. Applicant, however, alleges that a clock-face is a legitimate subject for an ornamental design. The statement is not denied, for its ornamentation falls directly within the provisions of Section 4929 Revised Statutes; but this ornamentation is, and from its nature must be, always clearly separable from and irrespective of the particular time-indicating figures and characters and their arrangement—*i. e.*, their combination, *interesse*—upon the dial. In applicant's case there is absolutely no ornamentation, but, as described, shown, and claimed, the letters and figures, in their combination and arrangement, are the very essence and gist of the alleged invention. And this is not patentable as a design, however valuable the invention may be *per se*.

"It would appear, however, in view of the well-known twenty-four hour dial shown in the Prince Pierre Soltykoff collection, in Paris, giving all the functional features of applicant's invention, and known to be several centuries old, that applicant has carefully prepared his case relating solely to one class of applications as a predicate for asking a patent under another class, a practice condemned as

tending to confuse and mislead both the public and the Office in *ex parte* Traitel, *supra*.”

*Butterworth, Commissioner:*

The decision of the examiner is approved. His action is sustained by the reasons submitted and the authorities cited by him.



*Ex parte* BAILEY.

Decided November 9, 1886.

37 O. G., 781.

1. When an application for a design patent is received which is a clear, palpable, and manifest error, and for the subject-matter of which applicant is entitled to, if anything, a mechanical patent, the case should be withheld by the application clerk, and applicant advised.
2. When, however, such error is not plain, palpable, and manifest, and the case goes to a division for examination, the preliminary fee cannot be refunded to applicant or applied upon a new application.

*Montgomery, Commissioner:*

On the 3d of May last this application was received, in which applicant asked for a patent for a design for the term of three years and six months. The application was accompanied by a fee of ten dollars. On the 4th of May the drawing was discovered to be informal. The case was therefore sent to the draftsman's division for the correction of the drawing, and on the 4th of June a new drawing was prepared by the office, for which applicant was charged three dollars. On the 1st of July the application was reached for examination, and applicant informed by office letter that it was “manifest from the drawing and description that the subject-matter is for a mechanical improvement, and not for a design.” On the first of November, instant, applicant transmitted to the office his petition for a mechanical patent, together “with five dollars to com-

plete preliminary fee," and asked that his new application be received and filed and considered in the usual way without further payment.

I think it very plain that applicant's request cannot be granted.

In the case of *ex parte* Sellers (1870 C. D., 58), Mr. Commissioner Fisher held that a fee of fifteen dollars, which had been forwarded to the office with an application for mechanical patent, could not thereafter, when applicant discovered that he was not entitled to a mechanical patent but was entitled to a design patent, be applied in part payment of the fees required for such design patent. The reasoning of that case seems to apply to the case under consideration. Suppose, for instance, that the examiner had, as he had the undoubted right to do, and as applicant had the undoubted right to insist upon, passed upon the application for design patent as he received it. Applicant would have been rejected, and would have been entitled to appeal. Upon such appeal the examiner had been affirmed. Would applicant claim under these circumstances that his original and first fee should be applied upon a fee which should thereafter accompany a new application?

I have no doubt that where an application is received which is palpably and manifestly a mistake, it would be the duty of the application clerk to withhold the same and notify applicant thereof. It must, however, be a very plain case—such a one as admits of no question—or such applicant might properly charge the application clerk with impertinent voluntary advice. It can hardly be presumed, however, that such manifest and palpable mistakes will occur except in rare cases. When, however, such error is not plain, palpable, and manifest, and the case goes to a division for examination, I see no reason why the accompanying fee should be refunded, and no practical ground upon which such refunding can be asked for or based.

*Ex parte* HARRIS.

Decided December 22, 1886.

38 O. G., 104.

An application for patent upon "a design for ornamenting the surface of the walls of railway cars," &c., which, in the opinion of the examiner, contains nothing which can "constitute proper subject-matter for a design patent" should be by such examiner rejected. From such rejection an appeal will lie to the Board of Examiners-in-Chief, as in ordinary cases of the rejection of claims.

*Montgomery, Commissioner :*

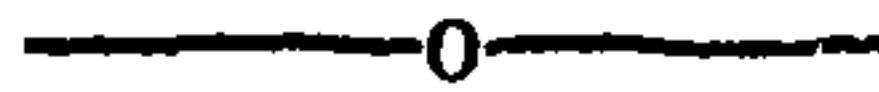
Applicant asks for a patent upon a design for ornamenting the surface of the walls of railway cars, &c. His design consists of colors in combination upon a dark ground to produce on walls a frosted effect. July 27, 1886, applicant was informed by office letter that a consideration of his case was refused for the reason that, in the opinion of the examiner, the thing proposed could "in no sense constitute proper subject-matter for a design patent." Since this action on the part of the examiner, the same has been substantially repeated several times, the last time on the sixteenth of last month. On the following day applicant filed a petition, in which he asks, in substance, the Commissioner to "instruct" the examiner that the design which he presented did "constitute proper subject-matter for a design patent," and therefore an examination of the state of the art should be made. The situation seems to be as follows: The primary examiner refuses to either pass or reject this application, for the reason that, in his opinion, the thing proposed to be patented can "in no sense constitute proper subject-matter for a design patent." This statement, properly interpreted, simply means that, in the opinion of the examiner, applicant presents nothing patentable. He does not find fault with the form in which the thing proposed is presented. He requires no correction of the specification or claim. He simply says, "the thing which you bring here is not patentable." This objection

is in no sense a formal one, but one which goes to the very life of the application itself. If the examiner is correct in his opinion that applicant presents nothing which "constitutes proper subject-matter for a design patent," very clearly consideration of the case should not be refused, but the application should be considered and rejected. It need hardly be said that if the examiner is right there can be no occasion to examine the state of the art.

The statute, Section 4929, provides in express terms that—"Every applicant for a patent \* \* \* any of the claims of which have been twice rejected \* \* \* may appeal \* \* \* to the Board of Examiners-in-Chief."

Section 4933 declares that—"All the regulations and provisions which apply to obtaining \* \* \* patents for inventions \* \* \* shall apply to patents for designs."

The case will go back to the primary examiner. If he shall remain of the opinion that the thing which applicant proposes to patent does not "constitute proper subject-matter for a design patent," he will reject for that reason. From such rejection applicant has the absolute right of appeal, not to the Commissioner direct, but to the Board of Examiners-in-Chief, thence to the Commissioner, and lastly, to the Supreme Court of the District of Columbia.



*Ex parte* SCHULZE-BERGE.

Decided January 5, 1888.

42 O. G., 293.

1. Objections by the examiner that the alleged invention shown in an application for a mechanical patent should be made the subject of a design application, held to be a rejection of the application, the appeal from which must go to the examiners-in-chief.
2. The word "useful," employed by Congress in legislation upon the subject of mechanical and design applications, defined and distinguished, and held when applied to designs, to relate to matters of decoration and æsthetic art which reach the senses through the eye, and so used in an entirely different sense from that in which it is applied to the subject of mechanical inven-

tion, where the usefulness contemplated by the statute relates to the employment of dynamic force, its modification or operation.

3. An inventor of a mechanical invention is entitled to give to it such enhancement by way of ornamentation and decoration as it is capable of receiving, and this without in any way modifying or detracting from his right to a patent.
4. Such inventor may also receive a design patent for the configuration, ornamentation, or decoration which the mechanical invention is capable of receiving.

*Hull, Commissioner :*

This is an application for patent for an improvement in corrugated or ondoyant glass, the function of which is to permit the passage of light, and yet obscure vision.

On the 11th of July, 1887, applicant was informed as follows by office letter:

“This application cannot be considered in the class of mechanical inventions. The application should be for a design patent.”

On the 7th of October, 1887, applicant answered as follows:

“We request a reconsideration of the last action in this case, for the reason that applicant does not claim a design for plate-glass, but has made an improvement in corrugated or ondoyant glass, the function of which is to permit the passage of light and yet obscure vision. This applicant’s invention does more perfectly than the former devices, in that while it more perfectly obstructs vision it obstructs the passage of light to a much less extent.”

On the 13th of October, 1887, the office replied in the following language:

“The argument filed in this case, October 8th, has been considered, and applicant is advised that the office still entertains the views expressed in the official action of July 11, 1887. The fact that applicant’s design serves a useful purpose does not change its classification as a subject of invention. This case comes under the clause of Section 4,929 Revised Statutes, which says that “any new, useful, and original shape or configuration of any article of manu-



facture' is the subject of a design patent. The official action of July 11, 1887, is reiterated."

Thereupon the applicant appeals to the commissioner, and prays that the action of the examiner may be reversed, and that he may be directed to entertain the application and act upon the merits thereof, for the reasons, first, that the invention involves the functions of or result produced by the article claimed as a new article of manufacture; second, that the action of the examiner is contrary to the views held by the office, &c.

In view of the decisions in *ex parte* Proudfit (10 O. G., 585), *ex parte* Presspich (11 O. G., 195), and *ex parte* Bailey (Com. Dec. 1886, 39), I am of opinion that the action of the examiner in this case must be held to be a rejection of the application, and that the appeal must go to the examiners-in-chief. It is true the examiner has simply advised applicant that the invention described and shown in his application must be covered by a design patent, and not by a mechanical patent; but the applicant asks for the latter kind of patent, and the office has no right or power to insist upon his filing an application for a design patent or any other patent than that which he wishes. This application is pending in the office and must be disposed of. I know of no way of disposing of it except by allowing or rejecting it; and when the examiner has twice advised applicant, after a discussion of the merits of the question, that he must pursue another course, and file an application for a design patent, he in fact refuses to allow the present application, for the reason that it is not for an invention upon which a patent, as now asked, can be based. But in view of the fact that the case must go back to the examiner for further consideration, and will be within his jurisdiction until applicant sees proper to take an appeal to the Examiners-in-chief, I feel justified in offering some suggestions to the examiner.

I have examined very carefully the answer of the examiner to this petition and the authorities cited by him, and I am disposed to think that the invention shown and described in this case, if new, contains patentable merit as claimed by the applicant. Up to 1842 there was no provision of law authorizing the issue of design patents. The

field of art in which invention could proceed, and for which patents might issue, was limited to the four classes specified, viz: "any new and useful art, machine, manufacture, or composition of matter;" but in that year Congress saw proper to recognize and establish another and different field of art. It is difficult to define this new field other than by the language Congress has employed:

"Any new and original design for a manufacture, whether of metal or of other material or materials, or any new and original design for the printing of woolen, silk, cotton, or other fabrics, or any new and original design for a bust, statue, or bas-relief, or composition in alto- or basso-relievo, or any new and original impression or ornament to be placed on any article of manufacture, the same being formed of marble or other material, or any new and useful pattern, or print, or picture to be either worked into or worked on, or printed, or painted, or cast, or otherwise fixed, on any article of manufacture, or any new and original shape or configuration of any article of manufacture, not known or used by others before his or their invention or production thereof," &c.

It will be noticed in this extract from the statute that the only instance in which the word "useful" is employed is with reference to "pattern, or print, or picture, to be either worked into or worked on," &c., any article of manufacture, &c. The statute has since been modified until we find in Section 4929 of the Revised Statutes that the only employment of the word "useful" is in this clause: "Or any new, useful, and original shape or configuration of any article of manufacture."

Under the former statute there seems to have been some contrariety of opinion as to the dividing line between inventions which might be the subject of "design patents," and attention has been called to the decisions in *ex parte* Crane (C. D., 1869, 7); *ex parte* Bartholomew (C. D., 1869, 103); *ex parte* Fenno (C. D., 1871, 52), and *Wooster v. Crane* (2 Fisher, 583). In some instances the Commissioner has been of opinion that the word "useful" justified the issue of a mechanical patent for any form, shape, or configuration, provided the thing whose shape or form was involved possessed usefulness or utility in a mechanical sense. In my judgment, the decisions which have pursued

this line of reasoning have given too great importance to the word "useful," employed in this connection. I cannot avoid the conclusion, from an examination of later authorities, that the subject of design patents was intended by Congress to relate to matters of decoration, of esthetic art, which reach the senses through the eye.

There can be no doubt that an invention to be the subject of a mechanical patent must possess utility or usefulness; but it is a usefulness which relates to mechanics, the modification or control of physical forces. On the other hand, the subject of a design patent may also be useful in an entirely different sense or direction, and I think the word "useful" in the statute, Section 4929, Revised Statutes, is employed in a different sense. The subject of invention, so far as form, or shape, or configuration is concerned, must be useful in the sense that it tends to promote pleasure, refinement, comfort, depending upon the sense of the beautiful; it must be useful in the sense that it must not be mischievous, obscene, or tending to produce evil or wicked reflections. Invention in this field of art relates to the intangible, and its power consists in its ability to awaken pleasant and agreeable sensations, conceptions, and thoughts, and the usefulness involved is that which brings about these results.

The decisions above alluded to, have dwelt upon the technical meaning of the word "useful," overlooking the fact that Congress, by its legislation upon the subject of mechanical and design patents, had clearly marked out two separate and distinct fields of invention, which were purposely made separate and distinct from each other, and that, while the word "useful" is employed in the statute relating to each, it was not intended to apply to the same kind of usefulness in each.

As already suggested, the usefulness contemplated by the statute for mechanical patents was such as related to the employment of dynamic force, its modification or operation. The usefulness indicated in the statute with reference to designs was in the other direction and intended to be limited to that kind of usefulness.

Says Leggett, Commissioner, in *ex parte* Parkinson (C. D., 1871, 251):

“The law has provided for granting patents to the inventors or discoverers of new and useful arts, machines, manufactures, and compositions of matter, and also of any improvements thereof.

“This class of inventions has to do with functional qualities of matter and things. The term ‘useful,’ in connection with machine patents, relates to the office the thing patented fills in producing a desired effect; or, if the thing patented is the result or effect, that is, the article produced, then ‘useful’ relates to its adaptation to serve some practical purpose in supplying some physical or tangible want.

“But the law authorizing design patents was intended to provide for an entirely different class of inventions, inventions in the field of esthetics, taste, beauty, ornament.

“The question an examiner asks himself while investigating a device for a design patent is not ‘What will it do?’ but ‘How does it look?’ ‘What new effect does it produce upon the eye?’ The term ‘useful’ in relation to designs means adaptation to producing pleasant emotions.

\* \* \* \* \*

“The Legislature never intended by this section (4929) to let down the standard for patents. It was never contemplated to grant a design patent for every possible change of form that might be given to a machine or article of manufacture. By ‘article of manufacture,’ as used in this section, the Legislature evidently meant only ornamental articles, articles used simply for decoration.”

In the case of *Thomas S. Cox v. Jacob W. Griggs et al.* (2 Fisher, 174), Judge Drummond held:

“You must be satisfied that the invention is a useful one, and of this slight evidence only is necessary. ‘Useful,’ in the patent law, is in contradistinction to ‘mischievous.’ The invention should be of some benefit.”

(See also *Wooster v. Crane*, Id., 583; *Gorham Manufacturing Company v. White*, 14 Wall., 511).

In *ex parte Norton* (C. D., 1882, 14) Commissioner Marble held:

“‘Useful,’ in the patent law, is in contradistinction to ‘mischievous.’ The invention should be of some benefit. (*Cox v. Griggs*, 2 Fisher, 174.) A design, if not ‘mis-

chievous,' is useful if it attracts persons to it or to articles made like it. It may not be of great artistic excellence; but if it be attractive it is useful. \* \* \* It is not necessary that it should be ornamental, although it may be, to entitle the applicant to a patent therefor. The utility in an article of this kind consists in having a shape or configuration of such a character that persons needing it will purchase it because of its shape or configuration in preference to other articles for the same purpose but different in shape or configuration."

In *Theberath v. Rubber Co.* (C. D., 1883, 205), Circuit Court of New Jersey, Judge Nixon uses the following language in speaking of design patents:

"They differ from patents for inventions or discoveries in this respect, that they have reference to appearance rather than to utility. Their object is to encourage the arts of decoration more than the invention of useful products. A picture or design that merely pleases the eye is a proper subject for such a patent without regard to the question of utility, which is always an essential ingredient in an invention or discovery patent."

Applying these decisions to the present case, the applicant claims that he has invented a plate glass which is useful, because while it admits a great quantity of light it practically excludes vision. It is true that this function of the glass depends upon the peculiar manner in which applicant gives form and shape to one of its surfaces, which he claims may be made irregularly and without any design whatever, or it may be made in forms which would be pleasing to the eye, such as designs of figures; but when so made such configuration is a mere incident to the purpose for which the plate glass is constructed. It must be conceded that such a plate glass would have no attraction and no practical utility as a mere design or picture, and no person would purchase it for that alone. The great and predominant utility of the plate glass is that it may be used in the construction of houses in windows and doors, so as to admit light into the rooms and apartments of the building without enabling vision from either side.

In the examiner's discussion of the distinction between mechanical and design patents, he says:

“The one is that which the letter of the statute seems to suggest, viz. : on the line of configuration pure and simple—that is to say, where the invention is for an article of manufacture, and consists in shape or configuration, it should be protected by a design patent, and no other. This is the line clearly suggested by Commissioner Fisher, and possesses the merit of clearness and simplicity, besides that of strictly following the letter of the statute.

“Another line is that of function. That is, where the subject-matter of the invention is an article of manufacture and the invention consists of shape or configuration, the classification may depend upon the use for which the article is designed. If its function is mechanical—that is, if its function is to transmit or modify mechanical force—then it should be a mechanical patent. The articles suggested by Commissioner Fisher in the Bartholomew case as properly belonging to the classification of designs would come under this category—‘plow-shares, fan-blowers, propeller-blades, and others of like character.’ On the other hand, if the function of the article is to gratify the eye or to serve some useful purpose and promote convenience in a way not connected with the transmission, generation or modification of a mechanical power, then it should be protected by a design patent.”

I am not able to agree that a propeller-blade, the form of which is devised by an inventor for use in propelling a vessel and to transmit vast power by reason of that form, should be covered by a design patent; its function is mechanical, and its object is to transmit or modify mechanical force, and that being true, it should be covered by a mechanical patent; and so of the other illustrations cited by the examiner.

In the case now before me the whole object or purpose of the invention is to modify and transmit mechanical force—that is, the force called “light.” The rays of light are dispersed or scattered in such a way that, while the light is admitted, by reason of this dispersion vision is prevented. Light is a force, and it flows in at the window much as a current of water flows over a dam; it produces results, and its modification in hundreds of particulars is desirable. The invention now under consideration is made with a

view to accomplishing such modifications, and it modifies or transmits that force as much as a wheel or other device operating in a current of water would modify or change such current, and is therefore as much the subject of a mechanical patent as the other. Having made this invention, the inventor is next entitled to give to it such enhancement by way of ornamentation and decoration as it is capable of receiving, and this without in any way modifying or detracting from his right to patent. As already suggested, if the invention admit of it, the inventor may arrange the irregular surfaces of the glass in figures and designs pleasing to the eye. This every inventor may do with all the varieties of invention conceivable, and I know of no reason why an inventor of a mechanical invention may not in many instances also have a patent for a design for such configuration, ornamentation, or decoration made upon the same. Of course the two are different inventions—one relating to the transmission or modification of mechanical force, and the other to the ornamentation that is pleasing to the eye.

A mechanical patent has been held to be no bar to the grant of a patent to the same patentee for a design shown therein. (*Ex parte Palmer*, C. D., 1882, 5; *Collender v. Griffith et al.*, 18 O. G., 241; *ex parte Bartholomew*, C. D., 1871, 298.)

It is sometimes exceedingly difficult to separate the form and configuration of a body from its function. This seems to have been the difficulty in cases hereinbefore cited, where reference has been had to propeller-blades, plow-shares, and other like instrumentalities. Take, for instance, a lens for converging or diverging light, which depends entirely upon its configuration, no one would pretend, if it were new, that it would not be the proper subject of a mechanical patent, and for the sole reason that it modifies the force called "light" in its transmission through it. So, too, of a goose-necked valve or trap used in plumbing; the function depends upon its form; and yet no one would contend, I apprehend, that, if new, it should not be the subject of a mechanical patent. So, I think, we may go through the entire list of subjects where the invention and form depend upon each other, and the true distinction will always

remain, that when the function of the invention for the accomplishment of some physical result depends upon its form, it cannot be deprived of its mechanical patentability by reason of form or configuration.

I have made these suggestions because I deem the subject of considerable importance, and in order that the examiner may, if he sees proper, give them consideration, before the case proceeds further. It is to be understood that they are not at all conclusive upon him, and he is at liberty to permit the case to remain just as it is—rejected—so that the applicant, if he chooses, may take an appeal upon the merits to the examiners-in-chief; but, it being evident that the examiner has not understood that he has rejected the case upon its merits, I deem it proper to go into the question to some extent in order that the examiner may feel at liberty to reconsider his decision, and be justified in taking such further action as to him seems right and proper.

The present appeal is dismissed, and the case is remanded to the primary examiner for such action as the applicant or the examiner may see proper to direct.

---

*Ex parte* GERARD.

Decided May 22, 1888.

43 O. G., 1235.

1. It is well understood that, while the courts, when construing the validity, scope, and extent of the claims in patents, will regard the words "as shown and described" as ever present, and when absent will not construe patents to embrace more than is shown and described, it is the policy of the office while it has control over applications to insist that the form and phraseology adopted and employed by applicants should not be misleading nor unintelligible to the common people who seek to deal with patent property. It has therefore been customary to require that the words "as shown and described" shall be employed in the claims of design patents, in order that the patents may be limited to the subject-matter shown and described. The introduction of such words operates as a guide-post to inform all



persons that the patent is limited to the precise invention shown and described, and that there is no hidden mystery nor secret trap, by which those who attempt to enter the same field of invention, or to use other articles, may be arrested in their efforts or mulcted in damages.

2. A design application will not be permitted to embrace more than one subject of invention. The same principles in this particular which control in mechanical applications must obtain in design applications. A distinct and separate invention relating to the form or configuration cannot be lawfully included in a patent embracing a distinct and separate invention as to surface ornamentation—as, for instance, an alto-relievo cannot be joined with an ornamentation or picture to be worked into a woolen fabric; but when the shape and the ornamentation are parts of the same article of manufacture, so that both unite in producing the same result, then they are not distinct and separate within the purview of the rule.
3. Under the statute the design must be a finished and completed thing—must be one entire and integral thing. It cannot consist of several integral different designs aggregated, so as to protect the several individual parts, nor so that these parts may be separately applied to other and different articles or parts of articles of manufacture.
4. The doctrines of combination and elements of combinations and of genus and species obtaining in mechanical inventions cannot be applied to designs. In a mechanical combination, when one element is withdrawn, that combination ceases; but in a design a subordinate and unimportant feature may be withdrawn, and yet the design as a whole remain, and to simulate the predominant features would infringe the whole.
5. The test of infringement is the “identity of appearance, determined by the eye of the ordinary observer.” (*Gorham Co. v. White.*) As the subject of identity of the design is addressed to the eye of the ordinary observer—the public—so the questions of the extent and character of claims in patents for distinctive and segregable parts, must be determined largely by the skill and judgment of the experts of the Office.
6. Objections to claims for non-segregable parts relate to the merits rather than to form, and upon rejection the appeal should go to the examiners-in-chief.

7. A new and original design under the statutes may also be the subject of a mechanical patent. (*Ex parte Schulze-Berge*, 42 O. G., 293.)

*Hull, Commissioner :*

Applicant appeals in this case from the action of the examiner in the three following particulars:

*First.* In requiring applicant to incorporate into his specification a brief statement of the leading features of his design.

*Second.* In requiring applicant to state his respective claims separately and singly as to each subject of the claims, instead of incorporating a preamble introductory to all the claims, "in a design for a plate or dish," &c., and then adding the statement of what is claimed in such design. The examiner also required that the applicant should add to his claims the usual words, "as shown," &c.

*Third.* The rejection of claims 3, 5, 6, 7, and 8, in that they were not for distinctive and segregable matter as required by *ex parte Pope* (26 O. G., 290).

Applicant in his appeal requests the commissioner to instruct the examiner by what principles he should be guided in rejecting claims because of non-distinctiveness and non-segregability, in view of the frequency of the citation of *ex parte Pope*, and also to determine whether a rejection on this ground should be regarded as relating to the merits which gives an applicant the right of appeal to the examiners-in-chief, or whether it should be regarded as an objection relating to form, which would be appealable to the commissioner.

The design for which applicant seeks a patent is a dish of certain form and shape, the upper surface of which bears certain ornamentation. The dish is made with a central circular depression or bowl, while the rim is rectangular with defined corners. The corners are ornamented with a peculiar design, while the bowl and panels possess their own respective designs or ornamentation.

The claims are as follows:

In a design for a plate or dish, the following defined novel and segregable features, substantially as hereinbefore

described, and as shown in the accompanying photographs, namely:

1. The design for the shape of the dish, consisting of a rectangular outline with the corners formed by straight lines, a a, forming obtuse angles with the sides, and the circular arc, b, interposed between the lines, a a.

2. The design for the shape of the dish, consisting of the depressed center of circular outline, and the rim with square outline, with its corners formed by lines, a a, at obtuse angles with the sides, and intervening circular arc, b.

3. The design for the corner of the dish, consisting of circular arc, b, and straight lines, a a, forming the edge outline of the dish, with a surface ornamentation consisting of a circular figure, A, entering said arc, b, and a concentric border, B, extending to and interrupted by said lines, a a.

4. The design for the surface ornamentation of the corner of the dish, consisting of a circular figure, A, composed of a conventionalized flower with radial petals, and the concentric border, B, characterized by the circular row of pointed figures, e e, radiating from the common center.

5. The design for the rim of the dish, consisting of the corner ornamentations, A B, and the intervening panels, C C, filled with ornamentation consisting of diagonally-arranged figures, as shown.

6. The ornamentation for the panels, C C, on the rim of the dish, consisting of diagonal bends, h, i, j, k, and l.

7. The ornamentation for the depressed center of the dish consisting of the figures, D D.

8. The ornamentation for the depressed center of the dish, consisting of the annular border, G.

9. The ornamentation for the depressed center of the dish, consisting of the radial figures, D D, the annular border, G, interrupted by said figures and appearing to pass beneath them, and the central rosettes, E.

The examiner allowed claims 1, 2, 4, and 9, but rejected claims 3, 5, 6, 7, and 8, the ground of his decision being that these latter claims did not embrace parts or features which were distinctive and segregable from the entire design.

It appears from the official action of the examiner and his statement in reply to the appeal that he has waived and

abandoned the formal objections as to the "distinctive features" of the design and the introduction of the preamble to the claims, and only insists upon the use of the customary words, "as shown and described," &c. As to the latter subject, I concur with the views expressed by the examiner. It is well understood that, so far as the validity, scope, and extent of a patent are concerned, these words are immaterial. The courts regard them as ever present, for the patent can extend no further and can embrace no more than is shown and described; but the Office has control over the form and phraseology of the patents issued by it to the extent of rendering them easily intelligible to the common people, so that they cannot be the means of deluding or misleading those who seek to deal either with patent property or the articles of manufacture made under such exclusive privileges. The introduction of those words operates as a guide-post to point the fact which many, but by no means all, persons know, that a patent is limited to the very subject matter "shown and described" and its equivalents, and that there is no hidden mystery nor secret trap by which those who attempt to enter the field of invention in the same class of arts or to use other articles of manufacture may be arrested in their efforts or mulcted in damages. It has always been customary to use those words in claims of design patents. It is the policy of the Office to require them to be used, and the action of the examiner in requiring them in this case must be affirmed.

As to the rejected claims, an examination of the statutes relating to design patents shows that the subject matter, "a new and original design," relates to an article of manufacture. A new and useful article of manufacture may also be the subject of a mechanical patent (*ex parte* Schulze-Berge, 42 O. G., 293), depending upon its construction or mode of construction; but it may possess a new and original form, or surface ornamentation, or both. Shape must relate to the outward form or contour, while the surface ornamentation relates to illustrations and delineations that are printed or impressed upon or woven into it.

So far as applicable, the statutes and rules pertaining to mechanical patents relate also to designs. Letters patent issued on one application will not be permitted to embrace

more than one subject of invention in designs. The same principles in this particular which control in mechanical patents must obtain in this. The statute provides (R. S., Sec. 4929) that :

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

The peculiar disjunctive character of this section relative to the two classes of invention, shape and ornamentation, when considered in conjunction with the statutes, decisions of the courts, and rules of practice of the Patent Office applicable to mechanical patents, is conclusive that a distinct and separate invention as to form or configuration cannot be lawfully and properly embraced in the same patent with a distinct and separate invention as to surface ornamentation. An alto-relievo cannot be joined with an ornamentation or picture to be worked into a woolen fabric, in the same patent; but when the shape and the ornamentation are parts of the same article of manufacture, so that both unite in producing the same result, viz., the usefulness of beauty in the same article, then they are not distinct and separate within the purview of the rule. Such an instance can scarcely be held to be an exception to the rule. As already stated, the invention which is the subject of the design patent cannot exist separate and apart from the article of manufacture. An article of manufacture may wear the garment of form and also that of surface ornamentation; but both features combine to constitute a single garment, and the article remains the same article of manufacture. Its usefulness is one and integral. The design of form may have been conceived and applied first; but

when that of surface ornamentation came into existence and was applied the two in their application blended and united in a new creation, which was one and indivisible. In such a case a patent for the design consisting of shape and surface ornamentation possibly might not protect the shape alone; but this question is not before me, and I only suggest, but do not express, any opinion upon it. I conclude simply that the designs of form and those of surface ornamentation, when applied to the same article of manufacture, constitute the proper subjects for single letters patent.

What elements or features of design are covered and protected by a design patent? In the language of the statute, the thing to be patented must be new and original, and it must have been invented and produced. It must necessarily be a finished and completed thing. Whether it consists of form or surface delineations, or both, the design must be one entire and integral thing. It cannot consist of several integral different designs aggregated, so as to protect the several parts individually and separately, nor so that these parts may be separately applied to other and different articles or parts of articles of manufacture made or hereafter to be made. The doctrines of combinations and elements of combinations and of genus and species, which obtain in mechanical inventions cannot be applied to designs. Shape and contour and surface delineations may have predominant features—may be divisible, in a certain sense, into parts; but these parts do not co-ordinate and co-act as elements in mechanical combinations do. In the latter when an element is withdrawn that combination ceases. In a design some of the subordinate and unimportant features may be withdrawn and yet the design as a whole remain, and to simulate the predominant features would infringe the whole, upon well-known principles to be stated hereinafter.

Curves or outlines, areas or surfaces, and solids, all having forms and contours, may be classified, depending upon their co-ordinates or relations of curve and angle. The curves of conic sections, the sphere, cube, and paraboloid, &c., may be classified mathematically; but they are incapable of differentiation into varieties and species. As matters of

beauty and ornamentation addressing themselves to the eye, they are always the same. The moment either loses its quality of cube or sphere, so as to become a variety of cube or sphere, it ceases to exist and becomes something else. If it be cubical or spherical, though not a perfect cube or sphere, it does not change to a species or variety, but retains a resemblance which will still classify and arrange it as one or the other. Genus possesses constant qualities which are common to all included varieties or species. The variations or modifications upon which the species depend relate to features of structure other than mere similitude of form and shape. Every bust could be classified under genus and species if complexion, eyes, nose, mouth, and hair—common features of the races of men—were to be considered; but the design of a bust does not depend upon the representation of these features as such. The bust of Henry Clay would not be patentable as such, for that would prevent other artists from making busts of the same individual. So, also, of portraits to be impressed upon or woven into fabrics. That which is patentable is the ideal characteristic pertaining to the design which the artist has created and not borrowed or copied. There is in this respect but one characteristic which is common to mechanical and design patents, and that is equivalency. With reference to mechanical inventions, an equivalent is defined to be:

“A thing that performs the same function, and performs that function in substantially the same manner as the thing of which it is alleged to be the equivalent.” (Mason *v.* Graham, 23 Wall., 275; Potter *v.* Stewart, 18 Blatchf., 563.)

But designs are addressed to the eye, and their usefulness relates to the enjoyment of the beautiful which their consideration and contemplation awaken. The protection afforded by the patent law for such inventions necessarily depends upon identity, which embraces the idea of equivalency in the law of patents. The reproduction and simulation by others of the invented design are forbidden.

The Supreme Court of the United States in *Gorham Manufacturing Company v. White* (14 Wall., 511) has clearly stated and limited the force and meaning of a patent for a new and original design. That case was appealed

from the Circuit Court for the Southern District of New York. The court below held views approved by the Supreme Court as to the identity of design, but instructed that this identity was to be determined by the eye of the expert and not that of the ordinary observer. The judgment proceeded upon this idea that a design was a subject of art and skill, and its qualities and characteristics must be determined by experts skilled in such arts. As to the standard of distinction in the matter of identity, or the means and manner of defining the subject of a design patent, the Supreme Court differed from the Circuit Court. The opinion is a leading one upon this subject:

[Here follows opinion in *Gorham v. White*, 14 Wall.]

From these observations of the court it is clear that "identity of appearance, determined by the eye of the ordinary observer," is the test of piracy or infringement, and defines the protection which a patent affords to the inventor. This identity does not descend to the mere lines and dots, the various and infinite details of the design, but depends rather upon the predominant and characteristic features, the *tout ensemble*. Even with changes, variations, or omissions of these, if the indicated design contains the dominating features, or as a whole so simulates the original design covered by patent, that "there is identity of appearance," or, as expressed in *McCrea v. Holdsworth*, "sameness of effect upon the eye," then it is guilty of infringement:

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

This is the protection afforded, and while an applicant may embrace claims covering distinctive and segregable parts of his design, as recognised in *ex parte Pope*, this will not increase or enlarge the extent of his protection. He does not thereby secure a patent for more than one design, and that one is the whole completed and finished design, made up of the distinctive and segregable parts, combined with the non-distinctive and non-segregable.



I am aware of what was said by Mr. Justice McLEAN as to combination of parts in *Root v. Ball & Davis* (4 McLean, 177, 1846), and by Commissioner Fisher, *ex parte* Bartholomew (C. D., 1869, 103), as to generic claims and variations. (See, also, *ex parte* Sheppard, C. D., 1870, 22). But *Gorham Company v. White* is later and higher authority, and certainly is conclusive as to what may be patented as a design.

In *ex parte* Bartholomew Commissioner Fisher says:

“Thus, if the invention were of a design for an ornamental button, the face of which was grooved with radial rays, it would seem that the first designer of such a button might properly describe a button of five rays, and, having stated that a greater number of rays might be used, might claim a design consisting generally, of radial rays, or of ‘five or more’ rays, and that it could not be necessary for him to take out a patent for each additional ray that could be cut upon this button. So if the design were the ornamentation of long combs by a chain of pearls it would seem that a claim for such a design might be maintained against one who arranged the pearls either in curved or straight lines, or who used half pearls only, and that such modifications, if they had occurred to the designer, might properly have been enumerated in his specification as possible and equivalent variations. In short, I can see no reason under the law why designs may not be generic, why what are called ‘broad claims’ may not be made to them, and why the doctrine of artistic or æsthetic equivalents may not be applied to them.”

But it is evident that whatever form the claim for the button or the comb assumed, the patent would protect whatever simulated its identity to the eye of the ordinary observer. In the case of the button this would be true whether there were more or less than five rays. There may be variations and immaterial departures from the specific details set forth in the patent which will be perfectly protected by it. The claim may be made “broadly,” so as to cover them; but it cannot state them so broadly or generically as to cover a design not yet conceived, and which, as a work of art, would be so different from that exhibited in the patent that the eye of the ordinary observer would re-

gard it as new and different. To permit such claims would enable the patentee to forestall the future, and to usurp the ownership of unconceived and uncreated subjects of shape and ornamentation.

What, then, is the purpose of claims for distinctive and segregable parts? Evidently to enable the applicant for himself, and the Patent Office for the public, to point out those predominant and controlling features in a design, the use of which alone would be regarded as preserving the identity of a design, even when other parts are omitted. Unquestionably whatever features or parts of a design which, if used by another, would constitute an infringement may be used by and protected to the patentee, and that is the limit and extent of the variation which the law will sanction or permit. The whole subject resolves itself back into a question of identity—sameness to the eye of an ordinary (unskilled) observer. The common observer is not familiar with the genus and species of design (if such distinctions can have any existence), and his liability to be misled or deceived in matters of resemblance and identity does not depend upon them. While, therefore, there is some little analogy between claims for distinctive and segregable parts in design patents and claims for elements and co-acting parts in mechanical patents, they are not founded upon the same principles.

An applicant may seek to patent a design for a stove in which is included the form or shape of the stove with the surface ornamentation for its sides and top. In such case he cannot secure a claim for the design as to ornamentation as applied to the sides and top of any stove, regardless of its form and configuration. If he wishes to secure a design for a side or panel of a (any) stove, he must take out a separate patent for that. In the case supposed his patent will cover the ornamentation, with such variations thereof as will preserve its identity upon the form or shape of the stove—with such variations thereof as will preserve its identity to the eye of the ordinary observer of both. He cannot in the same patent secure claims for distinct and separate parts independent of the whole design. (*Ex parte* Neil, MS. Dec., Vol. 24, 236; *ex parte* Hill, MS. Dec., Vol. 28, 124.)

Undoubtedly in cases like the present, where the design consists of a combination of shape and ornamentation, claims covering greater variation may be allowed, based upon distinctive and segregable parts, than where shape alone or ornamentation alone is the subject of the design. Thus the shape of the dish in the case under consideration, with some slightly distinctive features of ornamentation, might more easily deceive or mislead the eye of the ordinary observer than such distinctive feature of the ornamentation applied to a dish of wholly different shape and contour. As the subject of identity or sameness of design is addressed to the judgment of the eye of the ordinary observer, so the questions of the extent and character of claims in patents for distinctive and segregable parts must be determined largely by the skill and judgment of the experts of the Office. Whenever the claim is to such distinctive and predominant parts as, when used and applied to an article of manufacture, would induce the ordinary observer to accept them as the whole design, the claim should be allowed; but when the segregation goes so far that the identity of the whole design ceases, and the ordinary observer would not be likely to recognize the sameness or resemblance between the segregated parts and the whole design, they should not be allowed. The ordinary observer—the public—is not learned in patent law nor the nice distinctions in matters of claims. The public is not required to be skilled in matters of art. In dealing with designs, patented or unpatented, ordinary observers judge of the design as a whole, and are not called upon to dissect and analyze it with accuracy. To permit claims for parts that belong to details which possess no distinct and visible resemblance to, and create in the mind no impression of, the whole design, would be to set traps for the unskilled and unwary. This is against public interest, and will not be tolerated.

Claims for distinctive and segregable parts of a design indicate the skilled judgment of the Office as to what parts and features of the design, if segregated from the whole and applied to an article of manufacture, would accord with the eye of the ordinary observer, and preserve the identity of the original and entire design. Evidently such claims

should be carefully scrutinized; otherwise the applicant may in the same patent cover a multiplicity of designs. The courts would probably not interfere to defeat such patents nor to limit them to the one original design, but, regarding each distinct design as an original, would rest the validity of the patent upon the discretion vested in the Commissioner as to such matters.

In the present case there is no claim presented for the design of the form of the dish and its ornamentation as a whole, unless the preamble and nine paragraphs can be regarded as one claim. I do not see how claims can be allowed for distinctive and segregable parts of a design when there is no claim for the whole design. If patented, is the completed design to be free, and its distinctive parts subject to patent? Or is the entire and finished design to be protected because the eye of the ordinary observer is required to recognize its identity with some of the segregated parts? Evidently, if variation in designs is to be recognized by allowing claims for distinctive parts, they must be formulated with reference to the whole design. The interests of the public require this.

In the case under consideration, claim 1 is for the rectangular rim of the dish with reference to the central bowl or any ornamentation whatever. Claim 2 is for the shape of the bowl with circular outline and the rim, without reference to the ornamentation. These two claims together would cover simply the shape of the dish, "as shown and described," but without such words or the implication of the law would embrace the rim with any kind of a central part, and the bowl with any kind of a rim, and the whole shape without any ornamentation. In effect, as was stated in *ex parte* Hill, the claims would cover two designs, in which case applicant should be required to take out two patents. Claim 3 covers the corners of the dish with their surface ornamentation. Claim 4 is for the surface ornamentation of the corners. Claim 5 is for the ornamentation of the corners and panels, composing the entire rim of the dish. Claim 6 covers the ornamentation of the panels of the rim. Claims 8 and 9 relate alone to the ornamentation, but these claims for ornamentation do not appear to be limited to a dish of the form and shape shown, and, as

already stated, this is essential where a design consisting of both form and surface ornamentation is to be embraced in a single patent.

The examiner calls attention to the fact that under *ex parte* Harris (38 O. G., 104) objections to claims for non-segregable parts relate to the merits rather than to form, and an appeal from such rejection should go to the examiners-in-chief. I concur in this view and follow that decision, but as the present appeal is taken as to matters of form as well as merits, I have felt justified in giving more consideration to the case than I otherwise would. The decision is affirmed as to the requirement that the words "as shown and described" be used in the claims, and the case is remanded to the primary examiner, to take such further action on the claims as he may see proper, in view of the principles expressed herein. If applicant desires to appeal from such action, his appeal from rejection of claims covering distinct and segregable parts must be taken to the examiners-in-chief.



*Ex parte* GERARD.

Decided May 22, 1888.

43 O. G., 1240.

1. The relation of genus and species does not exist in designs. The question involved in designs is one of identity.
2. A patent for a design must be limited to a single invention; but such patent may cover any variation or modification, provided the distinct and predominant features so far remain as to preserve the identity of the original completed design.

*Hall, Commissioner:*

In this case applicant seeks to patent designs consisting of both shape and surface ornamentation. Six dishes are shown in the drawings, all differing in shape or contour. Each dish is ornamented with its own surface ornamentation; but the entire surface ornamentation of each dish is unlike that of any of the other five. In the shape of each

is some slight feature, such as a notch or indentation at a corner, and in the surface ornamentation of each is also found some features which are common to all. These features the applicant chooses to call distinct and segregable parts of his design, and upon them attempts to found a genus of design and its subordinate species. There is, and in the nature of the case can be, no entire and complete design—no one single design. Consequently, there is no claim for a single design as a whole, with other claims for distinct and segregable parts; but an attempt is made to apply the principles of generic and specific claims, which obtain in applications for mechanical patents.

Applicant devises certain rather unimportant forms relating to shape, and certain surface ornamentation; then exercising his skill and ingenuity in producing dishes of various shapes, he introduces his specific features of surface ornamentation. He claims, broadly, his specific features, and also incorporates claims for as many various and different forms of dishes, with their varied and different ornamentation as his imagination can produce. He has presented nineteen claims, one of which covers the shape of the dish, and the remaining eighteen cover the surface ornamentation of eighteen different dishes.

Claim 19 is as follows:

“The design for the shape of a plate or similar dish, consisting of straight sides, rounded ends, indentations a, a, at the approximate junction of the sides and ends, and radial ribs f, f, extending from said indentations across the rim.”

With this broad claim for the shape or form applicant presents, as just stated, eighteen claims for as many different designs, based upon the fact that they possess some one or more features of form common to the parent design, or in common with each other.

On July 22, 1887, the examiner advised applicant as follows:

“The statute of designs (Section 4929, R. S.) provides for a new and original shape for an article of manufacture, or a new and original ornamentation thereof. A new and original shape may also have a new and original ornamentation; but a generic claim must be made for applicant’s

invention in accordance with the doctrine in *ex parte* R. N. Eagle (C. D., 1870, 137).

“A claim may also be made for one of the species belonging to applicant’s invention, but not for all the species which may exist under the generic invention.”

“On renewed consideration of the application above entitled, it appears that there is no generic claim covering applicant’s invention as disclosed, while there are many claims for various species and fragments thereof, contrary to the practice as above indicated. The objections noted in previous office letter are therefore withdrawn, and will not be insisted on at the present time, being dominated by the above-noted objection.”

This action, as I understand, was not a rejection nor an objection to any specific claim, but was simply a declaration that the examiner could not proceed to a consideration of the case until applicant had presented a claim for one entire completed design. He required a generic claim to be made. This action being repeated, the applicant appeals to the Commissioner.

In another appeal by this applicant I have had occasion to discuss the nature and character of claims for distinctive and segregable parts, and my remarks in that case are equally applicable to this. I think the examiner was correct in requiring applicant to submit a claim for the one entire completed design invented by him, for from that alone can it be determined what is and what is not distinct and segregable. As explained in *ex parte* Gerard, above referred to, this depends upon identity as determined by the eye of an ordinary observer. Without the original entire design it is impossible to make comparison or define the segregable parts. The examiner was unfortunate, I am disposed to think, in acting upon this supposed analogy of mechanical patents, and requiring a generic claim for applicant’s invention in accordance with the doctrine in *ex parte* Eagle (C. D., 1870, 137).

The relation of genus and species, in my opinion, does not exist in designs. As explained in the other case of applicant, the question is one of identity. A patent for a design must be limited to a single invention; but such patent will cover any variation or modification, provided

the distinct and predominant features so far remain as to preserve the identity of the original and completed design.

The decision of the examiner was correct, and is affirmed; but the case is remanded, and the examiner is at liberty to modify his statement of the requirement, or take such other action as he may see proper, in accordance with this decision.

—o—

*Ex parte* CARTY.

Decided July 9, 1888.

44 O. G., 570.

In the matter of the request of Martin Carty for the return of the fee paid on the 30th of March, 1888, for filing Caveat for Design for Ladies Collars and Cuffs.

1. Section 4902 of the Revised Statutes, providing for the filing of caveats for any new invention or discovery, does not apply to the subject of designs, nor is there any statute authorizing the filing of caveats for this class of inventions.
2. A design invention covers the form, contour, or ornamentation, and such design cannot exist in an incomplete condition. A patent when issued covers all the dominant and controlling features, all the distinct and segregable parts. Petition granted and fee ordered to be returned to applicant.

*Hull, Commissioner :*

Martin Carty presented to the office on the 30th of March, 1888, a caveat for a design for ladies' collars and cuffs, paid the filing fee of ten dollars, and requested that his caveat should be filed in the confidential archives of the office, in accordance with the rules and the statute. The examiner declined to file the caveat, or instrument called a "caveat," for the reason that in his opinion, the subject of design patent, as provided by statute, was not comprehended in Section 4,902 of the Revised Statutes, which provides for the filing of caveats in the Patent Office. That section is as follows:

"Any citizen of the United States who makes any new invention or discovery, and desires further time to mature



the same may, on payment of the fees required by law, file in the Patent Office a caveat setting forth the design thereof, and of its distinguishing characteristics, and praying protection of his rights until he shall have matured his invention. Such caveat shall be filed in the confidential archives of the office and preserved in secrecy, and shall be operative for the term of one year from the filing thereof; and if application is made within the year by any other person for a patent with which such caveat would in any manner interfere, the Commissioner shall deposit the description, specification, drawings, and model of such application in like manner in the confidential archives of the office, and give notice thereof, by mail to the person by whom the caveat was filed. If such person desires to avail himself of his caveat, he shall file his description, specifications, drawings, and model within three months from the time of placing the notice in the post-office in Washington, with the usual time required for transmitting it to the caveator added thereto; which time shall be indorsed on the notice. An alien shall have the privilege herein granted, if he has resided in the United States one year next preceding the filing of his caveat, and has made oath of his intention to become a citizen."

After receiving notice of the action of the examiner the caveator, being in doubt as to the correctness of the decision, and desiring to file the caveat, if it could be done, and if not to have the filing fee returned to him, raised the question before the Commissioner by a petition setting forth the facts and requesting the return of such filing fee. In answer to this petition the examiner has renewed his statement that Section 4902 does not apply to design patents, and that there is no law authorizing the filing of caveats for such class of inventions. Briefly stated, his proposition is that before a design can have an existence for any purpose whatever, it must be invented and completed, and that a design which is incomplete can have no recognition under any of the statutes relating to the subject.

As is well understood, the subjects of design patents are form or contour and surface ornamentation, and it is physically impossible for any entity of that character to exist in an incomplete condition. There can be no circle when a

segment of it is absent. There can be no continuous line when it is broken. I concur fully in what the examiner has said upon this subject. At first I was disposed to think, in view of the decision announced in *ex parte* Gerard (43 O. G., 1235), that it would be proper to file a caveat for the predominant and controlling features of a design, enabling the caveator within the period provided by law to fill out the details and subordinate parts, in much the same manner as a caveator of a mechanical device would be enabled to describe generally his invention in the caveat and reserve the period allowed by law within which to complete and put it in practical operation, or reduce it to practice. But I am satisfied upon reflection that this is not the correct view, because if the design has reached such a state of completion that it may be said to be perfect in its distinct and segregable parts, it is in a condition to be patented, and there is no necessity for a caveat, and the caveat could serve no useful purpose.

As was stated in the case of Gerard, above cited, a patent which covers a completed design covers all the distinct and segregable parts with the mere minor details omitted, so that it may be conceded that the immaterial and subordinate details of designs are not regarded as a part of the patent; that so long as the dominant and controlling features, called the "distinct and segregable parts," occupying their proper place and relation to each other exist, the patent relates to and covers them, and, as just stated, when the design has reached this state of perfection, it may be said to be complete and capable of becoming the subject of a patent.

I therefore sustain the petition of the applicant for the return of the filing fee, and direct that it be returned to him.

— o —

*Ex parte* HALEY.

Decided July 16, 1888.

44 O. G., 1399.

An applicant who has filed an application for a design patent for the term of three and one-half years, which has received examina-

tion on the merits, will not be permitted to have the government fee paid on filing such application applied as part payment on a second application filed for the full term of fourteen years for the same subject-matter.

*Hall, Commissioner :*

Applicant petitions to be allowed to file a new application for a design for a term of fourteen years upon the payment of \$20, the deficiency being made up by applying \$10, previously paid on an application for the term of three and a half years. Applicant alleges that he made a mistake in filing the first application for three and a half years instead of for the full term.

The records of the Office show that on April 4, 1888, applicant filed a completed application for a design patent for glassware for the term of three and a half years. Accompanying this application was the necessary fee of \$10. This application was duly forwarded to the examiner on April 6, 1888, and was examined by him as a complete application. On April 9 applicant was informed of the state of the art and of certain informalities, upon the correction of which the application, so far as then advised, would be in condition for allowance. Thereupon applicant, instead of correcting the informalities in his application, on May 3, 1888, filed a petition, asking that the period named by him, without which statement his application would not have been open to the consideration of the examiner, might be extended from three and one-half years to fourteen years. Such petition was not within the jurisdiction of the primary examiner, but was addressed to the Commissioner in person. On May 22, 1888, the assistant Commissioner denied this petition, but without prejudice to the right of the petitioner to renew it. (MS. Dec., vol. 37, p. 91.) Thereafter applicant prepared a new application for a patent for his design, and requested that the patent should run for the full term of fourteen years. This application was presented to the Office, accompanied by a request that the sum of \$20 tendered therewith might be accepted and that the remainder of the fee required—viz., \$10—be made good by applying the \$10 paid, as applicant claims by mistake, on the first application.

It is evident that this second application has not been received by the Office as a completed application, because the full fee has not yet been paid. The present request, like the former one, is addressed to the Commissioner in person. As the case now stands the only question presented is whether the \$10 paid on filing the first application was paid through mistake; if so, whether it ought to be returned to applicant or placed to his credit to be applied with the \$20 to make up the full fee required for his second application.

I have examined the statements of applicant, and am not able to see that they show any evidence that a mistake was committed. Applicant simply says that he was not aware at the time he filed his first application that the law authorized design patents to be issued for different terms, but supposed there was a single uniform period for all such patents. This is only ignorance of the law, and not a mistake. Had applicant consulted an attorney concerning the preparation of his application, or had he made any inquiry whatever, he could have obtained all necessary information. If applicant should show that he made inquiry and obtained incorrect information, upon which he had acted, then he would present a showing of something in the nature of a mistake. Acting upon such information as he possessed, and without making any inquiry, applicant sent his application to the Office in such form as justified the action of the Office in making the usual examination. He has no right after having been advised of the state of the art, and being in no danger of losing the fee by an adverse decision, to use his ignorance or want of information under the circumstances as a plea for changing the term of his application from three and one-half years to the full term of fourteen years.

There are other reasons why it is against the policy of the Office to grant such requests unless the party who petitions discloses the fact that an actual mistake has been made, such as courts of equity recognize.

The petition is denied, and it will be necessary for the applicant before he can receive action upon his second application to pay the fee required by the statute.

# INDEX.

THE REFERENCES ARE TO THE PAGES.

	PAGE
<b>Abandonment—</b>	
By public use prior to application.....	4, 68
See statutes, notes.....	2, 4, 5
Construction of statute by U. S. Court.....	73, 122
Construction of statute by Patent Office.....	267, 274, 304
By public sale of ornamented article before application.....	122
By prior description in mechanical patent.....	86, 274, 304
 <b>Account—</b>	
Of profits, and assessment of damages.....	179
 <b>Acts of 1842, 1861, and 1870—</b>	
Construed and compared.....	8
 <b>Aggregation—</b>	
Distinguished from combination.....	16, 28, 93, 333.
Of old ornaments not patentable as a design.....	7, 28, 41, 45
(See Unity of Design.)	
 <b>Alien.</b>	
(See Application.)	
 <b>Analogous use.....</b>	<b>15</b>
(See Patentability.)	
 <b>Appeal—</b>	
From primary examiner, on patentability.....	292
To Supreme Court, what determined.....	204
 <b>Appearance—</b>	
The sole object of design law.....	21, 146
May be in configuration or in surface ornamentation.....	146
Is the result, not the means.....	21, 146
Is the test of identity... ..	95, 129, 146, 168
Is the aspect, not the abstract picture.....	147

**Application.**

Alien authorized to make, under Acts of 1842, if one year a resident.....	2
And without restrictions under Act of 1861 and 1870.....	3
May be made by alien or citizen generally under Rev. Stat.....	5
When must be made before public use or sale.....	122, 239
Must contain election as to term.....	238, 351
For mechanical patent cannot be changed to one for design...57,	242
Error in claiming design patent when it should have been for mechanical.....	321

**Artistic or æsthetic usefulness.**

(See Utility.)

**Burden of proof—**

On defence of abandonment (see Abandonment).	
On defence of want of novelty and patentability.....	73, 111, 113, 155
On assessment of profits and damages.....	181, 196
On novelty and patentability.....	113, 155
On infringement.....	129

**Caveat—**

Not applicable to designs.....	57, 349
--------------------------------	---------

**Citizen.**

(See Application.)

**Claim.**

Form of.....	134, 196, 264
Plurality of.....	61, 196, 241, 298, 299
Broad or generic.....	229, 333, 346
Narrow or specific.....	61, 229, 346
Construction of.....	63, 116, 134, 333
For segregable parts of design.....	61, 298, 299, 308
Of mechanical patent cannot be construed to be for a design.....	66
Is for the distinguishing features of a design.....	71, 172

**Color.**

How far it may constitute design novelty.....	13, 45, 255, 311
---	------------------

**Commissioner of Patents.**

Patentability as design, appealable to Board, only in first instance .....	292, 294, 323, 325
--	--------------------

**Common knowledge.**

Matters of, considered on question of novelty.....	71, 118
--	---------

**Configuration.**

Patentable under Act of 1842.....	229
Patentable under Act of 1861.....	229
Patentable under Act of 1870, and Rev. Stat.....	337-343
May be claimed with surface ornamentation in one patent.....	16, 59 149
Old form, adapted to new subject.....	15, 45, 229, 287
Degree of novelty in shape required.....	83, 257

**Conjoint use—**

By defendant of two patented designs in one article, suable in one action.....	166, 178
Or of a patented mechanical invention and a design in one article.....	31, 35, 155, 178

**Costs—**

On sustaining or rejecting master's report.....	188
Costs may be apportioned by Supreme Court on appeal.....	196
On dismissal as to one patent, and decree as to the other, where bill founded on two patents conjointly used.....	166

**Creative genius—**

Required for design invention.....	255, 257
------------------------------------	----------

**Damages.**

Measure of, for infringement.....	179-212
Penalty under Act of 1887.....	6, 187
English statute on.....	187

**Decree.**

Form of.....	196
<i>Pro confesso</i> , certain objections concluded by.....	197

**Declaration—**

Of intention to patent, in rebuttal of presumption of abandonment.....	122
--	-----

**Defendant.**

Subject to penalty for infringement by making.....	187
Subject to penalty for selling without notice.....	187
Costs recoverable by and against.....	166, 188, 196

**Demurrer—**

To bill, for omission to describe invention or make profert of patent.....	178, 189
For non-patentability appearing on face of patent.....	49
For want of novelty in view of common knowledge.....	118

**Description—**

Of invention, in specification.....	273
Of article applicable to, suggested.....	260
Of materials and mode of construction allowable.....	229, 253
What not necessary, of surface ornamentation.....	204

<b>Designs.</b>	
Classification of, in the various statutes.....	3, 4, 5
Relate to results only, not means.....	149
What constitutes.....	7, 18, 311, 317, 334
Instances of what do not involve patentability as.....	31, 35, 39, 260 272, 279
Must be fixed and determined and capable of specific description either in words or by illustration.....	283, 311
<b>Disclaimer.</b>	
Applicable to design patents.....	58
<b>Double use.....</b>	15, 45
(See Patentability.)	
<b>Drawings—</b>	
Should show obverse and reverse of design.....	62, 264
May be sufficient without written description.....	204
<b>Effect—</b>	
Of appearance in determining identity.....	149
Of means in determining identity.....	149
<b>Employer and workman.</b>	
(See Suggestions.)	
<b>English Statute—</b>	
On damages.....	187
<b>Equivalents.</b>	
Doctrine of, applicable to design patents.....	60, 157, 229
<b>Examiners-in-chief of Patent Office.</b>	
Patentability appealable to, only, in first instance..	292, 294, 323, 325
Appeals to, on objections as to non-segregability.....	334
<b>Exceptions.</b>	
(See Master's Report.)	
<b>Exhibits.</b>	
Of alleged prior articles, necessary to defeat design patent.....	99
The best evidence on issue of infringement...131, 132, 157, 163,	204
<b>Experts.</b>	
Design patents not addressed to.....	130, 146
<b>Extensions.</b>	
Under Act of 1861.....	3, 248
Right repealed by Act of 1870.....	5, 58, 248



<b>Evidence—</b>	Of infringement, by exhibits only.....163, 204	
	damages.....182-190, 193, 196, 204, 212	
	patentability.....	8
	novelty.....	9
	prior use.....	69
	abandonment.....	68
	Before Masters.....	196, 204
<b>Fees.</b>	Graduated according to term selected.....	3, 5
<b>Foreign.</b>	Design patent laws.....	7, 187
<b>Form.</b>	(See Configuration.)	
<b>Function.</b>	Description of has no place in design patent...59, 264, 273, 279, 306	
	Conflicting decisions of Patent Office, on.....227, 229, 250, 257, 265	
	..... 272, 279, 301, 317	
	(See Utility.)	
<b>Identity.</b>	Determined by appearance or aspect.....	18
	And this whether design is of configuration or surface orna- mentation.....	18, 19
<b>Improvement.</b>	Effect of this word, in design patent specification.....	17, 168
	If merely in degree, not sufficient.....	100
<b>Infringement.</b>	Character of proof of.....	129, 131, 133, 163
	Determination of, dependent on construction of claim, in view of state of art.....	106
	Comparison must be made of the designs, and not of the articles of manufacture of which they form a part.....	136
	Not affected by material on which design is impressed.....	155
	Copy need not be of the whole design in detail, to constitute.....	175
<b>Injunction.</b>	Preliminary may be allowed more liberally in design cases.. ....	107
<b>Intention—</b>	To abandon, rebutted by declaration. (See Declaration.)	
<b>Interference—</b>	Between design application and mechanical patent.....	58, 270
	Between design application and design patent.....	287
	Between design patent and mechanical application.....	267, 269
	Decision of, by Patent Office, not conclusive.....	23

<b>Inventor</b> .....	7, 13
<b>Invention.</b>	
Degree of, required.....	7, 14, 19, 257, 283, 287
<b>Inventive genius</b> .....	53, 255, 257
<b>Joinder—</b>	
Of two patents in bill.....	155, 178
(See Conjoint Use.)	
(See Multifariousness.)	
<b>Manufacture.</b>	
Article of, identity of not to outweigh dissimilarity of design thereon, on issue of infringement.....	166
Character of, on question of measure of damages.....	183
Design must be permanently affixed to, and form a part of.....	260
<b>Master's Report.</b>	
Costs of reference. (See Costs.)	
<b>Materials.</b>	
Not affecting design novelty.....	15, 49, 243, 253, 311
Not affecting question of infringement.....	155
<b>Mode of construction.</b>	
Description of, not essential in specification of design.....	229
Should not be made any part of claim.....	229
Is not the thing patented, but the appearance resultant therefrom.....	147
<b>Modifications</b> .....	61, 229, 346
<b>Multifariousness</b> .....	155, 178
<b>Notice.</b>	
Want of notice of patent, no defence to charge of infringement..	74
Necessary in case of vendor, to recover penalty.....	188
<b>Novelty.</b>	
Character of, required.....	19
Want of, proven by evidence of state of art.....	69
Want of, evidenced by matters of common knowledge.....	71
<b>Original design.</b>	
Distinguished from merely NEW design.....	257
<b>Ornamentation.</b>	
The sole object of designs.....	8, 279
May consist of both shape and surface ornamentation in same article.....	9, 11, 148, 339

**Particular patents.***In suit, sustained.*

Elastic bed for printing design. Clark v. Bousfield.....	21
Design for newel post. Simpson v. Davis.....	41
Design for corsets. Kraus v. Fitzpatrick.....	51
Ornamental design for stove. Root v. Ball.....	73
Ornamental design for stove. Perry v. Starrett.....	93
Ornamental design for jewelry pins. Foster v. Crossen.....	107
Design for dress trimmings. Dreyfus v. Schneider.....	111
“ “ show case. Lehnbeuter v. Holthaus.....	113
“ “ radiator. Eclipse Co. v. Adkins.....	118
“ “ floor oil cloth. Sparkman v. Higgins.....	122
“ “ fork and spoon handles Gorham v. White.....	146
“ “ sleeve buttons. Miller v. Smith.....	157
“ “ lace fabric. Jennings v. Kibbe.....	163, 166
“ “ jewelry settings. Wood v. Dolby.....	168
“ “ embossed trimming. Werner v. Reinhart.....	171
“ “ vegetable dish. Tomkinson v. Willets.....	175
“ “ carpet pattern. Dobson v. Carpet Co.....	196
“ “ carpet pattern. Dobson v. Dornan.....	204

*In suit, defeated for want of novelty.*

Design for annunciator dial. Western Electric Co. v. Odell.....	45
“ “ street lamp post. Burton v. Greenville.....	80
“ “ billiard table. Collender v. Griffith.....	86

*In suit, defeated for want of patentability.*

Design for reel. Wooster v. Crane.....	19
“ “ provision safe. Northrup v. Adams.....	28
“ “ sieves. Adams, &c., v. St. Louis, &c., Co.....	31
“ “ packing can. Wilson Co. v. Clapp.....	35
“ “ arranging buttons on cards. Pratt v. Rosenfeld.....	39
“ “ curtain and loop. Post v. Richards.....	49
“ “ banner-rod. Osborn v. Judd.....	53
“ “ ornamental surface for rubber mat. N. Y. Belting Co. v. N. J. car spring, &c., Co.....	54
“ “ billiard table. Collender v. Griffith.....	83
“ “ harness trimmings. Theberath v. Trimming Co.....	99
“ “ easel. Crocker v. Cutter Tower Co.....	106

*In suit, defeated for other reasons.*

Design for watch case. Untermeyer v. Jeannot.....	62
Embossed lines on writing paper. Cone v. Envelope Co.....	63
Design for figured silk buttons. Booth v. Garrelly.....	77
“ “ album leaf. Meers v. Kelly.....	116
“ “ textile fabric. Streat v. White.....	125
“ “ watch case. Margot v. Schnetzer.....	170
“ “ skirt patterns. Dryfoos v. Friedman.....	172

<b>Patent.</b>	Must contain but a single invention.....	58, 59, 73, 299, 333, 346
<b>Patentability.</b>	Requisites of.....	283
	Determined solely by appearance.....	311
	By what evidence determined.....	70
<b>Penalty.</b>	For infringement, under statute of 1887.....	187
<b>Petition.</b>	Requisites of; must elect as to term, &c.....	238
<b>Pleadings.</b>	Initial pleadings must describe invention or make profert of patent.....	178
<b>Presumption.</b>	From patent.....	73, 111
	Of abandonment. (See Abandonment.) novelty and utility.....	73, 113
<b>Prima facies of patent.</b>	As against evidence of prior knowledge or use.....	73, 111
<b>Prior description or use.</b>	By publication, or actual use.....	68, 69, 83, 289
	mechanical patent.....	68, 80, 86, 239, 270, 274, 304
	sale of goods bearing design.....	122
<b>Profert.</b>	Pleadings must make profert of patent, or describe invention...	178
<b>Profits.</b>	(See Damages.)	
<b>Public.</b>	The judges of identity.....	137
<b>Public use.</b>	By patentee before application, what constitutes.....	122
	Under Act of 1842.....	4, 73
	Under Act of 1861, and subsequent statutes.....	4, 5
<b>Re-issue.</b>	No reason exists why design patents may not be reissued.....	58
	But cannot be reissued in divisions, one for design and the other for mechanical features.....	239

<b>Remedies—</b>		
	For infringement.....	178
<b>Requisites—</b>		
	Of design to constitute patentability.....	7 19
	specification. (See Specification.)	
	petition. (See Petition.)	
	drawings. (See Drawings.)	
<b>Result—</b>		
	Not means, is the subject of design patent.....	21, 171
<b>Res judicata.</b>		
	By decree <i>pro confesso</i> in former suit against same defendant on same patent.....	75
<b>Segregability—</b>		
	Of design, determines whether plurality of claims are allowable. 59, 298, 308	
	Objections as to non-segregability, appealable to Board.....	334
<b>Specification.</b>		
	Requisites of.....	59, 60, 283
	Sufficiency of.....	204
<b>Sub-combinations.....</b>		299
	(See Claims.)	
	(See Segregability.)	
<b>Subject-matter—</b>		
	Of design patent. (See Designs.)	
<b>State of Art.</b>		
	Proof of always admissible.....	69
	Determination of novelty by..	70
	Determination of patentability by.....	53, 70
<b>Statutes, Analysis of.</b>		
	Act of 1842.....	1, 2
	Act of 1861.....	2, 3
	Act of 1870.....	5
	Act of 1887.....	6
	Revised Statutes, Sects. 4929-4934.....	5
	English Statute, on damages.....	187
<b>Suggestions—</b>		
	To inventor by workman.....	122
	To workman by employer.....	13, 125

**Term of Patent.**

Under Act of 1842.....	2
Under Act of 1861, 1870, and Revised Statutes.....	3, 4, 5, 57

**Trade-mark—**

Designs not patentable for use as.....	243, 255, 260, 309
Designs distinguished from.....	295

**Unity of Design.**

Necessary between parts of which it is composed.....	16, 17, 277 298, 316, 333, 339
--	-----------------------------------

**Useful.**

Meaning of in design statute.....	8, 9, 324
-----------------------------------	-----------

**Utility.**

Functional..	10, 51, 73, 225, 227, 229, 250, 257, 265, 272, 279, 301, 317
Ornamental.....	265, 279, 324
Aesthetic.....	257

**Variations.**

Will not relieve from infringement.....	113, 131, 168, 175, 339
What will constitute new design.....	41, 172
Can be shown and claimed.....	61, 229, 346

**Validity.**

Need not be previously judicially established, for allowance of preliminary injunction.....	107
---	-----

**Witnesses.**

Experts not the persons by whom designs are to be compared..	129, 146
Ordinary observers the proper judges of identity..	129, 168, 175, 177

**Workman.**

(See Employer and Workman.)