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THE LAW
of
PATENTS for DESIGNS

With particular reference to the practice which obtains in the prosecution of applications for design patents in the United States Patent Office as shown by the rules and decisions.

By
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ABBREVIATIONS USED.

"App. D. C."..... Decisions of the Court of Appeals of the District of Columbia.

"Bann. & Ard."..... The five volumes of patent cases, 1874 to 1880, collected by Banning and Arden.

"Blatch."..... Reports of Samuel Blatchford.

"C. D."..... Decisions of Commissioners of Patents.

"F."..... Federal Reporter.

"F. C."..... Federal Cases.

"Gour."..... Gourick's digest of Patent Office manuscript decisions.

"O. G."..... Official Gazette of the United States Patent Office.

"U. S."..... Decisions of the Supreme Court of the United States.

"Wall."..... Wallace's Supreme Court Reports.

DESIGN PATENTS.

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PREFACE.

Two treatises only on the subject of design patents have been published in the United States during the seventy-two years the laws granting patents for this character of inventions have been in force. The first was presented in 1874 by former Commissioner of Patents, Wm. E. Simonds; the second, in 1889 by Hector T. Fenton, Esquire, of the Philadelphia bar.

That the texts and the decisions have not satisfactorily established a well understood, uniform practice in design patent cases is shown by the comments of courts and writers. Mr. Simonds in his work said:—

"The decisons of the Patent Office have been conflicting and the court cases are not altogether harmonious."[1]

In 1871, Commissioner Leggett in discussing the intent of the design law stated that:—

"The practice of the Office in granting design patents has been not only liberal but lax."[2]

A few years later in discussing a question which was often raised in design cases, the Commissioner of Patents said:—"It is not to be denied that the record of the Office on this question is somewhat ragged."[3]

In the leading case of Rowe v. Blodgett & Clapp Co.[4] the practice of the Office in issuing design patents was condemned on the ground that it was not uniform. In this case the court approved the view of the design law set forth in ex parte Parkinson, supra, and cited several

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1—Simonds on Design Patents—Preface.
2—Parkinson, 1871, C. D. 251.
3—Shoeninger, 15 O. G. 384; 1878 C. D. 128.
4—112 F., 61; 98 O. G., 1286; 1902 C. D. 583.

cases in which the interpretation of the law given in that decision had been upheld. The court in Marvel Co. v. Pearl[1] condemned the grant of a design patent for a syringe as "a perversion of the statute".

At the present time much doubt and confusion exists as to what is proper subject matter for a design patent; nor is the practice in this class of patents well settled. Whether the specification should contain a description of the design, and whether a patent may be issued for a surface ornamentation are among the questions which have received considerable attention and not altogether satisfactory answers.

Relative to many questions of design practice what Commissioner Fisher said in 1869 is true today. "The practice of this Office has not been uniform, and the true practice is still to be adopted and followed."[2]

It is hoped that this small contribution on the subject of design patents will assist in determining the questions of law and procedure which are still unsettled by bringing together for consideration the conflicting views and decisions, for nothing makes for the better elucidation of a subject than to have the different views on it considered together.

That the interest in the subject of design patents has increased during the last few years is indicated by the larger number of applications for patents filed and the amount of litigation on this subject. In 1905, 781 applications for design patents were filed in the Patent Office; in 1910 the number had increased to 1155; in 1911 to 1534, and in 1912 to 1844. During the year 1913, about 2100 applications were filed, which is approximately 175 per centum more than in 1905.

The questions of novelty and infringement of designs are so closely related and have been so often considered

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1—114 F., 946.
2—Bartholomew, 1869 C. D. 103.

together[1] that is has been concluded advisable to treat them in the same chapter.

The collection of the data which has been utilized in writing this volume was begun in connection with the preparation of lectures delivered before the students taking the course in Patent and Trademark Law in the Washington College of Law.

WILLIAM L. SYMONS.

Washington, D. C., 1914.

1—Kraus v, Fitzpatrick 34 F., 39; 42 O. G. 1912; 1888 C. D. 291; Redway v. Ohio Stove Co. 38 F., 582; Ripley v. Elson Glass Co. 49 F., 927; Bevin Bros. v. Starr Bros. 114 F., 362; Gorham v. White 14 Wall, 511.

THE LAW OF DESIGNS.

CHAPTER I.

DESIGN PATENT STATUTES.[1]

1. First Design Patent Act.—Patents for designs were first authorized by section 3 of the Act of 1842. In this Act the words "invented or produced" were used instead of the words "invented or discovered" used in the original patent Act of 1790, and in subsequent laws. The fee in design cases was by this Act fixed at one half the sum then required by the patent laws in force, and the duration of the patent was limited to seven years. Only 1387 patents were issued under this law.

2. Subsequent Laws.—The Act of 1842 was repealed in 1861. This Act of 1861 made slight changes in the subject matter for which a design patent might be issued. It changed the terms of design patents to three and one-half, seven or fourteen years at the election of the applicant, and the fees to ten, fifteen or thirty dollars respectively.

The patent Act of 1870 repealed the Act of 1861, but made very little change in the former design law. The sections of this Act of 1870 relating to design patents became sections 4929 to 4934 of the revised statutes in 1874. Design patents were granted under these sections of the revised statutes until the Act of May 9, 1902, amended materially section 4929 which is the section under which design patents are now granted.

The laws of 1842, 1861 and 1870 were almost identical in their definition of the subject matter granted protec-

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1—The early Design Patent Acts are printed in full as foot notes to Chapter 1 of Fenton on Designs. They are reviewed in that chapter with some detail.

tion. Generally speaking the articles which could be patented under these laws were (1) a new and original design for a manufacture, bust, statue, alto relievo or bas-relief; (2) a new and original design for the printing of woolen, silk, cotton or other fabrics; (3) a 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; and (4) any new and original shape or configuration of any article of manufacture. The most important difference between this Act of 1870 and the Acts of 1842 and 1861, and the difference which for a time caused the most discussion, was the use in the Act of 1870 of the word "useful" in the clause relating to the shape or configuration of an article of manufacture. This word appeared in the Acts of 1842 and 1861 modifying the word "pattern;" in the Act of 1870 it was omitted before the word "pattern," but appeared, as above stated, in the clause relating to the grant of a patent for the shape or configuration of an article of manufacture.

A consideration of the design law as it now exists will, it is believed, show that the scope of these former laws was broader than is the present law. There is much that might have been said in favor of granting a design patent for a surface ornamentation under the old laws that is not now pertinent. An article which might possess a new and original shape might not be an ornamental object. Could it not be more forcibly urged that such an article came within the purview of the old law than within the present Act?

In the Gorham case[1] the court said the design law was intended to encourage " the decorative arts." The Patent Office had in the Parkinson case[2] expressed the same

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1—Gorham Mfg. Co. v. White, 14 Wall, 511.
2—1871 C. D. 251.

view. This interpretation of the law was strictly adhered to by the Office subsequent to the decision in the Gorham case in the decision in the case of ex parte Chas. A. Seaman[1].

3. Design Patent Laws Now in Force.—The laws now in force which relate particularly to designs are as follows:

"Revised Statutes, Section 4887. No person otherwise entitled thereto shall be debarred from receiving a patent for his invention or discovery, nor shall any patent be declared invalid by reason of its having been first patented or caused to be patented by the inventor or his legal representatives or assigns in a foreign country, unless the application for said foreign patent was filed more than twelve months, in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Statutes, and four months in cases of designs, prior to the filing of the application in this country, in which case no patent shall be granted in this country.

"An application for patent for an invention or discovery or for a design filed in this country by any person who has previously regularly filed an application for a patent for the same invention, discovery, or design in a foreign country which, by treaty, convention, or law, affords similar privileges to citizens of the United States shall have the same force and effect as the same application would have if filed in this country on the date on which the application for patent for the same invention, discovery, or design was first filed in such foreign country, provided the application in this country is filed within twelve months in cases within the provisions of section forty-eight hundred and eighty-six of the Revised Stat-

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1—4 O. G., 691.

utes, and within four months in cases of designs, from the earliest date on which any such foreign application was filed. But no patent shall be granted on an application for patent for an invention or discovery or a design which had been patented or described in a printed publication in this or any foreign country more than two years before the date of the actual filing of the application in this country, or which had been in public use or on sale in this country for more than two years prior to such filing."

* * * * * * * * *

"Section 4929. Any person who has invented any new, original, and ornamental design for an article of manufacture, not known or used by others in this country before his invention thereof, and not patented or described in any printed publication in this or any foriegn country before his invention thereof, or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law and other due proceedings had, the same as in cases of invention or discoveries covered by section forty-eight hundred and eighty-six, obtain a patent therefor.

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

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

"Section 4933. All the regulations and provisions which apply to obtaining or protecting patents for inven-

tions or discoveries not inconsistent with the provisions of this Title, shall apply to patents for designs.

* * * * * * * * *

"Section 4934. The following shall be the rates for patent fees:

* * * * * * * * *

"In design cases: For three years and six months, ten dollars; for seven years, fifteen dollars; for fourteen years, thirty dollars."

Act of February 4th, 1887:

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

"Section 2. That nothing in this act contained shall prevent, lessen, impeach, or avoid any remedy at law or

in equity which any owner of letters patent for a design, aggrieved by the infringement of the same, might have had if this act had not been passed; but such owner shall not twice recover the profit made from the infringement."

The question is sometimes raised whether the general provisions of the patent laws not inconsistent with the laws relating to designs are applicable to design patents. This appears to be answered clearly in the affirmative. Even prior to the date of the passage of the section of the revised statutes which makes the general provisions of the patent laws applicable to design patents, (Section 4933 Revised Statutes) it was suggested by a good authority that they were applicable[1].

1—Simonds p. 206.

Chapter II.

SUBJECT MATTER FOR DESIGN PATENT.

4. Some Definitions of a Design Patent.—What is a "design" within the meaning of this term as used in the patent laws? Robinson's definition is:—

"A design is an instrument created by the imposition upon a physicial substance of some peculiar shape or ornamentation which produces a particular impression upon the human eye, and through the eye upon the mind[1]."

Renwick in his work on Patentable Invention defines a design as follows:—

"The design of an article whatever it be, is the appearance of the thing, as distinguished from its structure[2]."

The Circuit Court of Appeals for the Second Circuit in the case of Rowe v. Blodgett & Clapp Co.[3] said:—

"Patents for designs are intended to apply to matters of ornament, in which the utility depends upon the pleasing effect imparted to the eye, and not upon any new function * * * Design patents refer to appearances, not utility. Their object is to encourage works of art and decoration which appeal to the eye, to the esthetic emotions, to the beautiful."

Mr. Pettit has made this interesting statement in regard to designs:—

"A design is a delineation of form or figure, either plain or solid, a shape or configuration. The construc-

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1—Sec. 200.
2—Sec. 71.
3—112 F., 61; 98 O. G. 1286; 1902 C. D. 583.

tion of an article in accordance with that delineation is the materialization of the conception of the design. Under the decisions in design cases it has been held that the Act requires that the shape produced shall be the result of industry, effort, genius and expense; and also requires that the shape, form or configuration, sought to be secured, shall also be new and original, as applied to an article of manufacture."[1]

The Commissioner of Patents in 1902 in an argument presented to the Senate Committee in support of the bill which became the Act of May 9, 1902, (Section 4929 of the Revised Statutes as amended) had this to say relative to the nature of a design patent:—.

"It is thought that if the present bill shall become a law the subject of design patents will occupy its proper philosophical position in the field of intellectual production, having upon the one side of it the statute providing protection to mechanical constructions, possessing utility of mechanical function, and upon the other side the copyright law, where objects of art are protected, reserving to itself the position of protecting objects of new and artistic quality pertaining, however, to commerce, but not justifying their existence upon functional utility. If the design patent does not occupy this position there is no other well-defined position for it to take. It has been treated of late years as an annex to the statute covering mechanical cases, since the introduction of the word "useful" into it. It is thought that this practice should no longer continue[2]."

The Circuit Court of Appeals for the Seventh Circuit in the case of Pelouze Scale & Mfg. Co. v. American Cutlery Co. et al[3] defined a design as follows:—

1—The Law of Invention—Horace Pettit, Philadelphia, January 1, 1895.

2—Scientific American, May 24, 1902, Val 86, No. 21, p. 361.

3—102 F. 916.

"Design, in the view of the patent law, is that characteristic of a physical substance which, by means of lines, images, configuration and the like, taken as a whole, makes an impression, through the eye upon the mind of the observer. The essence of a design resides, not in the elements individually, nor in their method of arrangement, but in their *tout ensemble,* in that indefinable whole that awakens some sensation in the observer's mind. Impressions thus imparted may be complex or simple; in one a mingled impression of gracefulness and strength, in another the impression of strength alone. But whatever the impression, there is attached in the mind of the observer, to the object observed, a sense of uniqueness and character."

The design under consideration was a scale frame.

5. Must be Original.—In order that a design may be patentable, it must be "original" with the inventor; that is, it must not be obtained from another. This word as used in the statute is not synonymous with "new[1]." The presumption of originality arises from the grant of a design patent in the same manner as it does from the issue of the other class of patents, usually referred to as "mechanical patents" in constradistinction to " design patents."

6. Design Must Be Ornamental.—Although it was generally held by the Patent Office and the Courts before the design law was amended by the Act of May 9, 1902, that designs to be patented must be "ornamental," this word was new to the design laws when used in the amendatory Act of May 9, 1902. It was clearly the desire of those who secured the passage of this amendatory Act to lessen the doubt upon the question of what was proper subject mat-

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1—Parkinson 1871 C. D., 251.

ter for a design patent. With this in view the word "useful" was omitted and the word "ornamental" was placed in the statute.

7. **"Ornamental" Defined.**—The term "ornamental" as used in reference to designs indicates an object which is produced for the purpose of giving a pleasing appearance. This may result from surface ornamentation, from symmetrical outline, from harmonious arrangement of parts, from balanced effect of the various features of the design, or in other ways. If the object produced is beautiful, it is "ornamental" within the meaning of the statute. A thing may also be beautiful and therefore ornamental in the sense here used if it is grotesque, bizarre, or ludicrous. The design is "ornamental" if it appeals to the esthetic emotions.[1] But although it must be "a thing of beauty" it is not necessary that it show any high degree of esthetic excellence. A low order of ornamentation is under the law entitled to encouragement the same as a low order of invention,[2] or an unpretentious degree of intellectual or artistic merit[3].

The word "ornamental" was substituted for the word "artistic" in the House of Representatives on the recommendation of the committee on Patents, the word "artistic" having been used in the original draft of the bill which became the Act of May 9, 1902[4].

There are many articles which all agree are ornamental objects clearly entitled to protection under the design

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1—Rowe v. Blodgett & Clapp Co., 112 F. 61; 98 O. G. 1286; 1902 C. D. 583; Wright v. Lorenz 101 O. G. 664; 1902 C. D. 340; Knothe, 102 O. G., 1294; 1903 C. D. 42; Hartshorn, 104 O. G., 1395; 1903 C. D., 170.

2—Diamond Rubber Co. v. Consolidated Rubber Tire Co. 220 U. S. 429-435; 166 O. G. 251; 1911 C. D. 538.

3—Bleistein et al v. Donaldson Lithographing Co. 188 U. S., 239; 102 O. G., 1553; 1903 C. D. 650.

4—H. R. No. 1661, 57th Cong. 1st Session.

law, such as watch cases, spoons, medals, vases, various kinds of glassware, and many other articles. There are other articles in regard to which there may be strong doubt whether they are proper subject for protection. The adjudicated cases in which was considered the question whether the particular design was proper subject matter for protection as an ornamental object are helpful in reaching a determination of the meaning of the word "ornamental."

A box for fur sets was held patentable as a design in one of the earliest reported Patent Office decisions[1]; so also was a rubber eraser[2], and a damper for stove pipes[3].

A casing for a disinfecting apparatus is an ornamental object[4], as is a grass hook[5]. A metal sink[6], a machine frame[7], a casing for multicylinder gas engines[8] and a face plate for vending machines[9], have all been held by the board of examiners-in-chief, as disclosed by the patented files ornamental objects entitled to be protected by the issue of a design patent.

8. Design Held Not Ornamental.—In the early case of ex parte Peter C. Parkinson[10] the Commissioner of Patents changed the practice which had prevailed for some time which he designated as "not only liberal but lax" and held that the design patent laws were intended to protect "ornamental articles used simply for decoration." A design for a claw hammer was not such an article. This decision was followed by the decision in

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1—Crane, 1869 C. D., 7.
2—Bartholomew, 1869 C. D., 103.
3—Fenno, 1871 C. D., 52.
4—West Disinfecting Co. v. Frank et al, 149 F., 423.
5—Earle Mfg. Co. v. Clarke & Parsons, 154 F., 851.
6—Design patent 40, 064, Frank H. Caldwell.
7—Design patent 42, 294, E. H. Oderman.
8—Design patent 41, 543, W. Kelly
9—Design Patent 38, 762, C. C. Travis.
10—1871 C. D. 251.

the case of ex parte Seaman[1] in which it was held that a lamp chimney cleaner was not proper subject matter for protection under the design patent statutes, as it was not an ornamental object. In the case of Williams Calk Co. v. Kemmerer[2], in considering the question of what constitutes an ornamental design the court said:—

"We think the design patent is invalid. Section 4929 of the Revised Statutes (U. S. Comp. 1901, p. 3396) was not intended to embrace a patent for such a design as is set forth in the design letters patent under consideration. It was intended, in order that a design might be patentable, that it should of itself, as an artistic configuration, present something new and useful from an esthetic point of view. Within the meaning of the Act, there is nothing artistic, ornamental, or decorative in the design of a horseshoe calk; it is essentially a mechanical, and not an esthetic, device. It is impossible to suppose that it should be bought or used because of its esthetic features. Its success as a calk would depend upon its useful, and not artistic character."

Again in the case of Rose Mfg. Co. v. E. A. Whitehouse Mfg. Co.[3] it was held that patents for vehicle number plate supports were invalid. The court stated:—

"A valid design patent does not necessarily result from photographing a manufactured article and filing a reproduction of such photograph properly certified in the Patent Office. The designs of the design patents in suit are for the most part alike. No. 41,389 differs, however, from No. 41,388 in having braces which unquestionably strengthen the arm, to which the number plate is attached. It is not only apparent that this is their function, but it is also established to be such by the evidence. Indeed,

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1—4 O. G., 691.
2—145 F. 928.
3—201 F. 926.

every feature of these patents is mechanical and functional, and not ornamental. Even ordinary rivet heads are made to appear as beautiful circles in this scheme of ornamentation. If, moreover, the braces or supports of patent No. 41,389 were intended for ornamentation, they apparently failed in their mission, but, if otherwise, then every piece of mechanism can, with the aid of photography and the machinery of the Patent Office, be readily crystallized into a design patent."

In the case of Star Bucket Pump Co. v. Butler Mfg. Co.[1] doubt was expressed as to whether a pump curb (patent No. 28,190) was subject matter for protection. The court thought it probably was not properly associated with decorative objects.

The bath tub seat shown in design patent No. 29,993, was held to have nothing to commend it to the eye as an ornamental object.[2]

The Patent Office has held that a shade roller[3], a jar of the character shown[4], and a side frame for car trucks[5], are not ornamental objects, and patents for these designs were refused.

The Federal courts, have held invalid, patents issued for a syringe[6], a belt fastener plate[7], an insulating plug for electric line supports[8], a washer for thill couplers[9], a bottle of the design shown[10], and a lamp bracket[11].

The last two were held invalid because not pleasing, artistic objects; but it is gathered from the decisions either that they were not novel in view of the existing

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1—198 F. 857.
2—Buffalo Specialty Co. v. Art Brass Co., 202 F. 760.
3—Hartshorn, 104 O. G., 1395; 1903 C. D. 170.
4—Wright v. Lorenz, 101 O. G. 664; 1903 C. D. 340.
5—Bettendorf, 127 O. G. 848; 1907 C. D. 79.
6—Marvel v. Pearl, 114 F. 946.
7—Eaton v. Lewis, 115 F. 635.
8—Williams v. Syracuse and S. R. Co., 161 F. 571.
9—Bradley v. Eccles, 126 F. 945.
10—Chas. Boldt Co. v. Turner Bros. Co., 199 F. 139-144.
11—Note to Bolte & Weyer Co. v. Knight Light Co., 180 F. 412.

forms or that it did not involve invention to produce these objects in view of the art disclosed. It can not be safely held on these decisions that bottles and lamps are not proper subject matter for protection as ornamental objects.

9. **Article For Obscure Use.**—It apparently is assumed in the decisions holding a design invalid because for obscure use that such an article is not ornamental. Does this necessarily follow? Why may not a design which is covered up and which is never seen while in use possess a high degree of artistic excellence? This question is probably entirely a moot question for the articles which are used in an obscure manner are usually without any claim to ornamental value.

An insulating plug for electric lines was said to be for an obscure use as well as not ornamental and therefore the patent issued for it was held invalid.[1] A metal spool for use in a typewriter is an article for obscure use and a patent for this was decided to have been improperly issued.[2] The question whether a vehicle number plate support is not obscured in use, and is therefore not subject matter for a design patent was raised in the case of Rose Mfg. Co. v. E. A. Whitehouse Mfg. Co.[3] but was not decided. A horseshoe calk[4] and a washer for thill couplers[5] are not articles for which a valid patent can be issued in accordance with the views expressed in the cases referred to.

10. **"Useful."**—It has been pointed out that the word "useful" was first used in the design patent Act of 1870 as modifying the term "shape or configuration"[6]. This

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1—Williams v. Syracuse and S. R. Co., 161 F. 571.
2—Wagner Typewriter Co. v. Webster Co., 144 F. 405.
3—201 F. 926.
4—Rowe v. Blodgett & Clapp Co., 112 F. 61; 1902 C. D. 583; and Williams Calk Co. v. Kemmerer et al., 145 F. 928.
5—Bradley v. Eccles, 126 F. 945.
6—Section 2.

word caused a great deal of discussion and was considered in many decisions[1]. To get rid of this difficulty in construing this word as applied to design patents the Committee on Patents of the House of Representatives in reporting the bill which became the Act of May 9, 1902 said:—

"Under the existing statute the United States Supreme Court has said that consideration may be given to the word 'useful' in the granting of a patent. Other courts in attempting to define what consideration shall be given to the word 'useful', define it as 'adaptation to producing pleasant emotions'. This has nothing whatever to do with mechanical utility.

This state of affairs has brought into the Patent Office much contention and some confusion. To avoid these difficulties and to make plain the distinction between mechanical patents, where 'utility' is an essential element, and design patents, where 'utility' has nothing to do with it, but where ornamentation is the proper element of consideration, the amendment offered by this bill is proposed."[2]

A majority of the courts which have decided what meaning should be given to this word "useful" as used in the Act of 1870 and section 4929 of the Revised Statutes before that section was amended, have held that it referred to the usefulness resulting from creating an ornament or a beautiful thing. In the case of the Westinghouse Co. v. Triumph Co.[3] the Court of Appeals of the Sixth Circuit said:—

1—The views expressed in the decisions in the case of Crane, 1869 C. D., 7; Bartholomew, 1869 C. D., 103 and Fenno, 1871 C. D. 52, on the side of liberal construction are opposed by the rulings in the cases of Parkinson 1871 C. D., 251 and Seaman, 4 O. G., 691. In 1879, in the case of ex parte Shoeninger, 15 O. G., 384; 1878 C. D. 128, it was ruled that if a design was new, original and also useful it was patentable even if not ornamental, or beautiful.

2—H. R., #1661, 57th Cong. 1st Session.

3—97 F. 99; 90 O. G., 603; 1900 C. D. 219.

"We think it very doubtful whether the word 'useful', introduced by revision of the patent laws into the statute, is to have the same meaning as it has in the section providing for patents for useful inventions. The whole purpose of Congress, as pointed out by Mr. Justice Strong, speaking for the Supreme Court, in the case of Gorham Co. v. White (14 Wall, 511) was to give encouragement to the decorative arts. It contemplated not so much utility as appearance. We must infer that the term 'useful' was inserted merely out of abundant caution to indicate that things which were vicious and had a tendency to corrupt and in this sense were not useful, were not to be covered by the statute".

The Court of Appeals of the District of Columbia showed that it held a somewhat different view in the case of in re Tournier[1]. It said:—

"But since the introduction of the word 'useful' into the statute, the Supreme Court of the United States has held, in more than one case, that in certain classes of designs embraced by the statute in addition to the mere esthetical or artistic effect of the design upon the senses of the spectator, the element of functional utility may be considered in considering the question of the patentability of the design claimed. (Lehnbeuter v. Holthans, 1882 C. D., 263; 105 U. S., 94; Smith v. Whitman Saddle Co., 1893 C. D., 324; 148 U. S., 674).

We do not, however, understand the court as intending to go further than this, and to hold that functional utility is to be regarded as a controlling or even an essential element in a design patent. For if so, the design patents would virtually be placed upon the same footing and with the same requirements of patents for mechanical inventions."

1—17 App. D. C. 481; 94 O. G. 2166; 1901 C. D. 306.

These decisions were all rendered before the design Act was amended by the elimination of the word "useful" and the substitution of the word "ornamental".

What part does functional utility now play in the consideration of design patents?

In the decision in the case of ex parte Knothe[1] rendered soon after the amendment of the design Act the Commissioner of Patents said:—

"It has finally been settled, however, that designs refer to appearance and not to mechanical utility" * * * *

The Revised Statutes provide protection to the inventor of a new manufacture which is useful under Sec. 4886 and to the inventor of an ornamental design for an article of manufacture under Sec. 4929 within like limitations relating to prior knowledge or use, patenting or publication, public use or sale, and abandonment. These two sections, 4886 and 4929, cover distinct subject matters of invention. These distinct subject-matters may both be present in a single article of manufacture or either may be present in the absence of the other".

To the same effect is the ruling by the Commissioner of Patents in the case of ex parte Hartshorn[2]; ex parte Kern[3]; ex parte Nickel and Crane[4], and ex parte Bettendorf[5]. In the decision in the Hartshorn case supra, it is brought out that the fact that the shade roller under consideration was not only created for a functional purpose, but that this particular article did not contain any embellishment. It was the fact that there was no ornamentation present which rendered the design unpatentable.

There are several cases which hold that the question of use does not enter into consideration in designs[6].

1—102 O. G., 1294; 1903 C. D. 42.
2—104 O. G., 1395; 1903 C. D. 170.
3—105 O. G., 2061; 1903 C. D. 292.
4—109 O. G., 2441; 1904 C. D. 135.
5—127 O. G., 848; 1907 C. D. 79.
6—Segelhorst, 109 O. G., 1887; 1904 C. D. 125; Hess, 19 Gour., 74-27. Sherman, 147 O. G., 237; 1909 C. D. 170. Mygatt, 186 O. G., 987. Mygatt, 188 O. G., 1055.

A rather close distinction is shown in the cases of in re Tournier[1], and in re Sherman[2]. In the former, decided while the word "useful" was still in the statute, the court said that functional utility was not to be regarded "as a controlling or even as an essential element in a patent for a design". In the latter the same court said in a case which arose after the design law had been amended by the elimination of the word "useful", and the substitution of the word "ornamental", that "in a close case utility may be given some consideration". It would appear that if the utilitarian aspect of a design was in a close case held sufficient to justify upholding the patent, that the functional utility in that case controlled, for it is hard to see why an element, the consideration of which, results in sustaining the validity of a design must not be considered as essential.

A design patent used as a gambling device is not valid. The principles applicable to mechanical patents to the effect that the patent laws do not uphold an invention which is injurious to the health, morals or good order of the community apply to designs[3]. A design patent for a casing for a coin controlled machine which had been used as a gambling device was held invalid[4].

11. Mechanical Function.—The mechanical means used to accomplish a certain purpose can only be covered by a mechanical patent[5]. Patents have repeatedly been refused, or held void when issued, if the only distinguishing feature is the mechanical form or function[6].

The fact, however, that a design is useful, if it is an ornamental object, does not affect its patentability as such[7].

1—17 App. D. C., 481; 94 O. G., 2166; 1901 C. D. 306.
2—35 App. D. C., 100; 154 O. G., 839; 1910 C. D. 125.
3—Bedford v. Hunt F. C. 1217; Device Co. v. Lloyd, 40 F. 89.
4—Reliance Novelty Co. v. Dworzek, 80 F., 902.
5—Royal Metal Mfg. Co. v. Art Metal Works, 121 F. 128.
6—Roberts v. Bennett, 136 F. 193. Lane Bros. Co. v. Wilcox Mfg. Co., 141 F. 1000. Hess Jr., 19 Gour., 74-27. Johnson, 159 O. G., 992; 1910 C. D. 192. Mygatt, 186 O. G. 987.
7—Mygatt v. Zalinski et al., 138 F. 88.

A claim in a design application which relates to the mechanical function is not allowable[1].

12. Article of Manufacture.—A "mechanical" patent as distinguished from a design patent, is granted for an art, machine, manufacture or composition of matter; a design patent, by the terms of section 4929 Revised Statutes, is limited to an article of manufacture.

In the case of Parkinson[2] the Commissioner of Patents said: "By 'article of manufacture' as used in this section, the legislature meant only ornamental articles; articles used simply for decoration". The important part of this statement is that a manufacture is referred to as an "article." In the case of ex parte Wm. Whyte[3] an alleged design for a shield or escutcheon was under consideration. In discussing the provision of the Act of 1870 then in effect, granting design patents for "any new and useful impression, ornament, pattern, print, or picture to be printed, painted, cast, or otherwise placed on or worked into any article manufacture, the Commissioner said:

"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 article, 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, and until obliterated by the natural and gradual deterioration resulting from use."

1—Mygatt, 188 O. G. 1055.
2—1871, C. D., 251.
3—1871, C. D., 304.

This decision is important in that it shows that at a time when the design statute permitted the granting of a patent for an ornament, a picture, or similar article placed on or worked into an article of manufacture, the statute was held to mean that the ornamentation of whatever character must be a part of the article. Throughout the early decisions occur the words "definite article of manufacture." In the Whyte case, supra, the Commissioner concluded that:—

"In the absence from the specification of all mention of the articles, if any, upon which it is proposed to place the design as an ornamentation, and to which it would be adapted for such a purpose, and upon the intrinsic evidence of the design itself, it must be held that it is really intended as a trademark".

In the case of ex parte Wm. King[1], decided soon after the trademark Act of 1870 was passed, and in which it was held that a trademark could not be patented as a design, in discussing the only provision of the Statute under which it might be possible to patent an ornamental design which was not applied to any particular goods, that is, the provision "any new and original impression, ornament, etc.", the Commissioner said: "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."

In the Whyte case this ruling is referred to with approval, with this comment:—

"It is not recalled that there is 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".

1—1870 C. D., 109.

The views expressed in these early cases were subsequently followed. In the case of ex parte Gerard[1] it was announced that:—

"The invention which is the subject of the design patent cannot exist separate and apart from the article of manufacture."

In 1898 in the case of ex parte Hill and Renner[2] in which an attempt was made to patent a design for a show card holder, two forms being presented, the Commissioner criticised the disclosure on the ground that the application was not limited to a "single article of manufacture" as required by the statute. In the case of ex parte Amberg[3] the applicant desired a patent for a "design for banners, badges, buttons, and other decorative devices and displays." In other words, he desired a patent for the artistic surface ornamentation which he had invented. The issue was here met directly by Commissioner Duell, who said:—

"Granting the applicant's contention is correct that the design is a surface ornamentation that may be placed on other articles than that shown, yet from his description this surface ornamentation has been applied or produced only on a flag or banner. Applicant has not invented or produced this design on any other article of manufacture than a flag or banner. He should confine the title of the invention and the claim to what he has produced and shown and described in his application, leaving to the courts the question as to whether he may use it on any other article than a banner or flag or whether any other party using it on other devices would infringe his design . This is the gist of the present practice."

1—43 O. G., 1235; 1888 C. D., 37.
2—82 O. G., 1988; 1898 C. D., 38.
3—84 O. G., 507; 1898 C. D., 117.

To the same effect is the ruling in the cases of ex parte Hartman[1]; ex parte Hewitson[2], and ex parte Remington[3].

This interpretation of the statute was in various decisions regarded as in accord with the ruling of the Supreme Court in the Gorham case in which this statement occurs:—

"The apperance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly, but, whatever way produced, it is the new thing or product which the patent law regards."

In a number of cases the question has been raised whether a certain definite article is an "article of manufacture." In the case of Crier v. Innes[4] such an article was defined in this manner:—

"It is next contended that the patent is invalid because it relates to a monument which is not a "manufacture" within the meaning of the design patent statute. We think this contention not well founded. A *monument* is manufactured, and in our opinion, is a 'manufacture' and not, as urged by the defendants, a species of architecture. It comes within the dictionary definition of the former term, and if we go beyond that and look at trade usage, we find in the present record the defendants' own witnesses describing themselves as monument 'manufacturers,' and speaking of manufacturing monuments."

The term "manufacture" may not be extended to include a class of goods. The term "table-ware" is too indefinite[5].

1—84 O. G., 648; 1898 C. D., 120.
2—87 O. G., 515; 1899 C. D., 77.
3—114 O. G., 761; 1905 C. D., 28.
4—170 F., 324.
5—Proeger 57 O. G., 546; 1891 C. D., 182.

In holding that a dwelling house is not a "manufacture," and therefore not entitled to protection under the design patent act, the Commissioner of Patents in the case of ex parte Lewis[1] said:—

"The word 'manufacture' must be limited to manufactured articles, that is to say, articles made by hand, machinery, or art from raw or prepared materials, and any construction that will make it include a dwelling house or any other article of realty would involve such a departure from the received signification of the word as employed in statutes relating to patents as to be wholly inadmissible".

In the case of Graff, Washbourne & Dunn v. Webster[2] in holding a design patent for a border section of a dish valid some apparent force is given to the view that a fragment is patentable. In that case the court said it would seem that an inventor could patent some component detail of his design. The court may, however, have regarded the border section as an independent article of manufacture.

The Circuit Court of Appeals of the Second Circuit held the Tomkins patent for a design for a bed spring invalid for lack of patentability or not infringed[3]. Although the Court did not directly so rule, the question is worthy of serious consideration whether the invalidity did not result in reality from the failure of the inventor to disclose in the drawing or describe in the specification a complete article.

It is difficult however to reconcile the practice of issuing some design patents with the rulings of the Office requiring a definite article of manufacture to be specified. Patents, for instance, have been issued for a design for the "backs of playing cards".

1—54 O. G., 1890; 1891 C. D. 61.
2—189 F. 902.
3—James E. Tomkins Co. v. New York Woven Wire Mattress Co., 159 F. 133.

The very recent decision in the case of ex parte Fulda[1] changes the practice relative to that class of designs which reside in superficial ornamentation. In this case the Commissioner said:—

"Where the design is for the form or configuration or involves the relative proportions of parts of an article of manufacture, said article of manufacture must necessarily be disclosed in the application. Where, however, as in the present case, the design is for an ornament adapted to be applied to any article of manufacture, I fail to find in the statute any requirement that the applicant shall disclose his design as applied to some particular definite article of manufacture, as required by the Examiner."

Even before the decision in the case of ex parte Fulda, supra, was rendered, patents were issued in which the specification recites that no novelty is claimed in the shape of the article[2]. Surface decoration is the ornamental feature of these designs.

13. Machine Not Patentable As a Design.—The terms "art", "machine", "manufacture", and "composition of matter" have a well recognized meaning in the patent laws. While section 4886, Revised Statutes permits the grant of a patent for any new invention in any of them, section 4929 names only a "manufacture" as proper subject matter for a design patent. A machine therefore is not proper subject matter for a design patent. This has been repeatedly so held in Patent Office decisions.[3]

There are some cases in which the question whether a device is a manufacture or a machine is a close one. Some aid in determining it may be obtained by considering some of the decisions on this question.

1—194 O. G. 549 (August, 1913).
2—Patents 44421, Smith, and 44381, Owen.
3—Adams, 84 O. G., 311; 1898 C. D. 115; Steck 98 O. G., 1228; 1902 C. D. 9.

In ex parte Smith[1] it was decided that an atomizer was not proper subject matter for protection under the design statute because of the presence of movable parts which when moved changed the appearance of the device. It apparently was the view of the Commissioner that if the movable handle was removed it would not be objectionable as presented and a patent was subsequently issued on this application for an atomizer body[2]. In the case of ex parte Tallman[3] a design patent for a can opener was refused on the ground that the knife forming a part of it was a movable part and when shifted the shape or contour of the article was changed. A patent for a can opener body was subsequently issued on this application[4]. A pair of tongs consisting of two members of the same shape pivoted together is an operative device and not within the purview of the design laws[5]. In this case the Commissioner stated:

"If applicants have invented and produced anything that is novel, it is not a pair of tongs, but the shape or configuration of a member or jaw of a pair of tongs. The description and claim should be limited to this".

In the case of ex parte Adams, and ex parte Steck, supra, a design for truck side frames and for a frame for water towers, respectively, were held not patentable in that they were apparatuses having movable parts.

The design patent to Hill No. 27,272, for a furniture support consisting of two parts which were joined together in a way that permitted them to be moved, was held valid in the case of Chandler Adjustible Chair and Desk Co. v. Heywood Bros. and Wakefield Co.[6] The Court in this case thought that the broad proposition

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1—81 O. G., 969; 1897 C. D. 170.
2—Design Patent No. 30,293, DeWane B. Smith.
3—82 O. G., 337; 1898 C. D. 10.
4—Design Patent 28,232, Tallman.
5—Kapp, 83, O. G., 1993; 1898 C. D. 108.
6—91, F. 163.

that the design law was not intended to apply to structures having movable parts was not supported by any judicial decisions, and that to hold this desk support, made up of two parts which might be raised or lowered to vary the height of the desk, was not a "manufacture" was an unwarrantable and unreasonable limitation of the term as used in the statute.

14. Superficial Ornamentation.—Some forms of surface ornamentation are applicable to many different objects. The question then arises why a patent for a particular ornamentation should not be granted so that the inventor will not be directly or indirectly limited to the use of his surface decoration on any particular object. An ornamentation which might embellish a door knob may be equally applicable to a curtain pole, a lighting fixture, a handle, a piece of glassware and many other articles. Why should he be compelled to specify any article when by doing this he might limit the right to the use of his invention, for it is possible that another might use his decoration on an article so different from the one specified by the inventor that a court would not hold the second user an infringer. This is improbable but it is a reasonable contingency against which an inventor may well desire to protect himself. The answer of the Patent Office to these questions has been that it is necessary under the statute to point out definitely an article of manufacture (See Section 12).

There is some interesting discussion of this question in the cases of ex parte King[1] and ex parte Wm. Whyte[2]. In both of these cases there were under consideration ornamental designs which the Commissioners who considered the cases thought were trademarks. They were however decorations of the character which if placed upon a badge, emblem or similar article, would probably be regarded as proper subject matter for a design pat-

1—1870 C. D., 109.
2—1871 C. D., 304-306.

ent. In both of these cases the subject matter of the applications was regarded as a trademark, but the direct statement is made that for a design patent to be valid it must specify the particular article to be decorated. These decisions rendered at a time when the law enumerated as one of the subjects of protection "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", are of some value in reaching a correct conclusion on the question whether a patent for surface ornamentation, per se, is valid.

Mr. Fenton in his work refers to the decision in the case of Booth v. Garrelly, 1 Blatch, (C. C.) 247[1] as instructive for the reason that the patent under consideration comprised two claims, one for the configuration of the article, a button, and "the other for the surface ornamentation of the completed button."

The discussion of the subject of surface ornamentation which appears in the case of ex parte Gerard[2] is instructive. It was pointed out that a patent might be obtained for a stove including the shape of the stove with the surface ornamentation of its sides and top, but that, "In such case he can not 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".

The decisions in the cases of ex parte Proeger[3], and ex parte Hartman[4] are usually referred to as prohibiting the grant of a patent for a surface ornamentation. The rulings in these cases however, are directly to the effect that in order to obtain a patent a particular article of manufacture must be specified. A patent was granted to Proeger in which the claim is for "the design for a vessel"[5].

1—Fenton on Designs—pp 9-10.
2—43 O. G., 1235; 1888 C. D. 37.
3—57 O. G., 546; 1891 C. D. 182.
4—84 O. G., 648; 1898 C. D. 120.
5—Design Patent No. 21,181, Proeger.

A patent now is granted in accordance with the ruling in the case of ex parte Fulda[1] for a design consisting of surface ornamentation.

15. Unitary Structure.—The attempt has often been made to secure a patent on a device which is not a single, unitary structure, the Patent Office holding that the term "article of manufacture" means such a structure and not two or more parts, although they are joined together. Some idea of what is meant by the term "unitary structure" may be obtained by a consideration of those structures which have been held not unitary.

In the earliest reported case found bearing on this subject the question whether a patent should be issued on a design for a glass inkstand and a glass stopper was discussed[2]. The Commissioner ruled that the inkstand and stopper did not constitute a single unitary design for an article of manufacture" and that both were not patentable in a single application. As another objection to granting a single patent on both the inkstand and the stopper this was presented:—

"Another consideration of importance is, that the relative position 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 can not 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 esthetic effect described will be violated and the original design de-

1—194 O. G. 549.
2—Bloomfield Brower, 1873, C. D., 151.

stroyed. It would then be like a Capital misplaced on the shaft of a column."

During the time when a plurality of claims was allowed the Office held that a claim for a "definite, segregable, distinct part" of a device was allowable, but that a claim for a part of an entire whole was not allowable[1]. Mr. Fenton has well stated the law on this subject:

"Unity of design constitutes another very important question in design cases, and it may be laid down as a general rule that where there is no necessary connection between two designs or parts of a design, there is an absence of unity to render them a single patentable design,"[2]

citing ex parte Patitz[3], and ex parte Gerard[4].

A cradle supporting frame and a cradle body were held not to be a unitary structure although used together[5]. They were two separate designs. So also were two castings which were adapted to interlock to form a joint[6]. As these castings bore no resemblance to each other in shape or configuration, they did not constitute a unitary design but were merely an aggregation of two designs.

16. Design and Copyright Protection.—There are some articles which may be subject to protection under either the copyright laws or the design laws. Whether they should be entered under the former, or patents should be obtained under the latter depends upon circumstances. While dolls, toys, tools, glassware and many other similar articles are not subject to copyright[7],

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1—Pope, 25, O. G., 290; 1883 C. D. 74.
2—Fenton on Designs, p 16.
3—25 O. G., 980; 1882 C. D. 101.
4—43 O. G., 1235; 1888 C. D. 37.
5—Haggard, 80, O. G., 1126; 1897 C. D. 47.
6—Brand, 83 O. G., 747; 1898 C. D. 62.
7—Rule 12, Bulletin 15, Copyright Office.

paintings and sculpture are, and under the title, sculpture, a statue or statuette would be classified which is also subject matter for a design patent[1]. Design patents have also been issued for pictures[2].

The very important question arises whether protection may be obtained under *both* laws for those objects which are capable of protection under either. The subject is discussed at some length in the case of Louis De Jonge & Co. v. Brenker & Kessler Co.[3], in which it is stated that the precise question had apparently never been considered before. In this case the subject matter under consideration was a small water color entitled "Holly, Mistletoe and Spruce". It was intended to be used for a fancy paper design to cover boxes and other articles for the holiday season. It was, however, the Court stated, a work of art when it was completed by the artist. Relative to protection under the two laws the Court said:—

"Since it was qualified for admission into the two statutory classes, I see no reason why it might not be placed in either. But it could not enter both. The method of procedure, the term of protection, and the penalties for infringement, are so different that the author or owner of a painting that is eligible for both classes must decide to which region of intellectual effort the work is to be assigned, and he must abide by the decision. Ordinarily of course, there is no difficulty. Not many paintings are suitable for use as designs, and only a few designs possess the qualities demanded by the fine arts. But it is easily conceivable that here and there a painting may be eligible for either class and the water color in question is, I think, an excellent example. Such a work may be used in both the fine and the useful arts; but it can have protection in only one of these classes. The author or

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1—Design Patent to Pretz, No. 39,603.
2—Design Patent to Chapman, No. 43,667.
3—182 F. 150.

owner is driven to his election and must stand by his choice."

The copyright obtained in this case was held invalid because of the failure of the proprietor to give the proper copyright notice on the copies exposed for sale. The ruling of the lower court upon the invalidity from improper notice was affirmed on appeal[1].

17. A Trademark Not a Design.—The distinctions between a trademark and a design have not always been kept clear. A trademark has been defined as "the commercial substitute for one's autograph"[2]. It is usually referred to as a distinctive and arbitrary mark used to indicate origin or ownership of the goods upon which it is placed[3].

Soon after the passage of the Act of 1842 attempts were made to protect trademarks under that Act, and some two hundred design patents were issued for "designs for trademarks". It was never the intent of the design law that trademarks should be patented under it. This was pointed out by Mr. Upton who wrote a treatise on the subject of trademarks in 1860[4]. This practice of granting patents for trademarks was continued until the decision in the case of ex parte Wm. King was rendered in 1870[5]. The trademarks which were patented as designs were such marks and labels as are commonly used on tobacco, medicines, soap and other goods. The ruling in the King decision, supra, was adhered to in the case of ex parte Wm. Whyte[6].

1—Louis De Jonge & Co. v. Brenker & Kessler Co., 191 F. 35.
2—Leidersdorf v. Flint, No. 8219 F. C.
3—See definitions of a trademark in Elgin National Watch Co. v. Illinois Watch Case Co., 179 U. S., 665; Davis v. Davis, 27 F. 490; Newman v. Alvord, 51 N. Y. 189; Standard Paint Co. v. Trinidad Aspha't Mfg. Co., 220 U. S. 446; 165 O. G. 971; 1911 C. D. 530.
4—Upton on Trademarks, pp 18-19.
5—1870 C. D., 109.
6—1871 C. D., 304. For a discussion of this subject see Vol. CVII No. 16 p 33 of the Scientific American, Oct. 19, 1212, "Early Attempts to Protect Trademarks" by Wm. L. Symons.

The case of Hoeb et al. v. Bishop et al.[1], is a peculiar one. In that case an ornamental badge which was attached to a cigar by means of a pin was claimed to be a trademark by the dealer who first put out cigars with this badge on them. The Court thought the badge was an object of value and capable in itself of ownership and that it could not therefore be a trademark. If, the Court said, this was a trademark such a holding would lead to the result that any two salable articles of merchandise might be attached together and that one might be claimed as a trademark of the other. Proper protection in this case apparently could have been secured under the design patent laws.

The Patent Office having decided that a certain device is a design for which a patent has been issued will not grant to another registration of this same design as a trademark. To do so would cast a shadow on the right of the patentee[2].

Registration of a design the patent for which has expired will be granted if use of the design as a trademark is shown in accordance with the statute[3].

In holding a design patent for a horseshoe calk invalid the Circuit Court of Appeals of the Second Circuit stated:—

"The designer of articles of manufacture not otherwise entitled to receive design patents can not justify the issuance of such patents on the theory that the design is a trademark"[4].

In this case the court thought that the shape of the particular article under consideration could only have the effect of advising the purchaser that the calk was

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1—49 O. G., 1845; 1889 C. D. 695.
2—Lee & Shepard, 24 O. G., 1271; 1883 C. D. 66.
3—King, 46 O. G., 119; 1889 C. D. 3.
4—Rowe v. Blodgett & Clapp Co., 112 F. 61; 98 O. G., 1286; 1902 C. D. 583; see also Coats et al. v. Merrick Thread Co., 149 U. S., 562; O. G. 1531; 1893 C. D. 373.

made by the patentee; the calk was not ornamental or attractive.

It is, of course, well established that the name of a patented article is not a valid trademark, and this rule was applied in a case involving a design patent.[1] After the design patent had been secured on the image known as "Billiken" an attempt was made to register the word as a trademark for images. This was refused. At the expiration of the term for which the patent was issued, the public is entitled to manufacture the design covered by the patent. The grant of a trademark would prevent the use of the descriptive term "Billiken" for that design which is the only term by which it could be properly designated.

An ornamental feature of a fire alarm box (the well known Gamewell fire alarm box) was refused registration as a trademark[2]. The ornamental casing if new would probably have been subject matter for protection under the design patent laws. An effort to register the ornamental feature of a spoon as a trademark was unsuccessful[3].

18. Internal Structure.—The definitions of a design patent (section 4) show that it relates to appearance; to the effect on the mind through the eye. It therefore follows that the internal structure of an object can not be made the subject matter of a design patent, or be considered as an element in determining the question of patentability. This is pointed out in the case of Feder v. Poyet[4].

An attempt to show a wire or bar which in the complete article for which the design patent was desired was

1—The Craftsman's Guild, 143 O. G., 257; 1909 C. D. 91.
2—The Gamewell Fire Alarm Telegraph Co., 185 O. G. 827; 1912 C. D. 394.
3—Oneida Community, Ltd., 190 O. G., 1027.
4—89 O. G. 1343; 1899 C. D. 218.

hidden was not successful. The Commissioner of Patents said that this bar was a feature of internal construction and should therefore not be disclosed in the drawing[1]. This ruling was subsequently approved[2].

In the case of ex parte Kohler[3] relative to the requirement of the Examiner that the applicant cancel a figure which showed internal structure, the Commissioner of Patents ruled:—

"Fig. 3 shows the design in cross section, and it is very clear that the article will never have this appearance to any one seeing it. The petitioner says that this figure does not show the interior construction of the article, since there is no interior construction shown, and in this way he seeks to distinguish this case from ex parte Colton, (104 O. G., 1119). It is, nevertheless true, that this figure shows the construction rather than the appearance, for, as above stated, the figure has an appearance which the article itself can never have. The drawing should illustrate the design as it will appear to purchasers and users, since the appearance is the only thing that lends patentability to it under the design law."

It does not follow that sectional views are entirely prohibited. If a cross section clearly illustrates a feature of the design and is not used for the express purpose of showing internal construction, such a view is permissible[4]. In the Lohmann case the Commissioner of Patents expressed the opinion that the sectional view showed clearly that the surface ornamentation was in relief and not intaglio[5].

1—Tucker 97 O. G., 187; 1901 C. D., 140.
2—Colton, 104 O. G., 1119; C. D., 156.
3—116 O. G., 1185; C. D., 192.
4—Lohmann 184 O. G., 287; 1912 C. D., 336.
5—Lohmann Design Patent No. 43, 331.

19. Improvement.—Section 4886 of the Revised Statutes provides for the granting of a patent for any new and useful art, machine, manufacture or composition of matter which has been invented or for any new and useful improvement thereof; the design patent statute does not refer to "improvements". It is therefore only for an original design for which a patent under this statute may be issued; not for an improvement thereof. This view was advanced in the first text book on the subject. Simonds expressed himself thus:—

"It is tolerably clear that unless the improvement were carried so far as to make the improved design substantially unlike the original, it would not be patentable * * * * * * both the text of the law and the construction of the court point to the conclusion that a design patent can not be allowed for a design which is tributary to another, or a mere improvement thereon, and not in substance unlike it"[1].

These views apparently do not refer to designs produced by the same inventor; if so the Patent Office has not agreed with the interpretation Mr. Simonds placed upon the law for the patents issued show designs granted to the same inventor which are not substantially unlike.

In the case of Wood v. Dolby[2] it was contended that the patent in suit was invalid because it was for an improved design. The court said this word "improved" did not mean that the design in question was an improvement upon another, but that the design was new and distinctive and "improved" as compared with others. This ruling was subsequently followed.[3]

1—Simonds on Design Patents p. 203.
2—7 F. 475; see also sections 22 and 23, Fenton on Designs.
3—Anderson v. Saint 46 F. 760; 57 O. G., 546; 1891 C. D. 506.

It is the established practice of the Patent Office to object to the use in the specification of the word "improved" in referring to a design.

Chapter III.

INVENTION.

20. Invention Necessary.—Design patent applications are often prosecuted as if it were not necessary that the design should be the result of invention in order to be patentable. This is an erroneous view. Section 4929 of the Revised Statutes requires that a design in order to be patentable should be "invented[1]."

21.. What Constitutes Invention.—What constitutes invention is always a question of considerable difficulty. Greater difficulty is often experienced in design cases than in other classes of patents. This is due partly to the nature of a design and in part to the statements which occur in some decisions to the effect that a lower degree of invention will support a design than a mechanical patent. In the case of Untermeyer v. Freund et al[2] the court said:—

"It is impossible to read the literature upon this subject without being convinced that the courts, though applying the same rules, have looked with greater leniency upon design patents than patents for other inventions. A design patent must relate to subject matter comparatively trivial. The object of the law is to encourage those who have industry and genius sufficient to originate objects which give pleasure through the sense of sight."

To the same effect is the ruling in the case of Smith v. Stewart[3]. The court in this case said relative to the

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1—Freeman 109 O. G., 1339; 1904 C. D. 619; Mygatt v. M. Schauffer-Flaum 191 F., 836; Westinghouse Electric & Mfg. Co. v. Triumph Electric Co. 97 F., 99; 90 O. G., 603; 1900 C. D. 219; Bolte & Weyer Co. v. Knight Light Co. 180 F. 412; Williams, Jr. 58 O. G., 803; 1892 C. D. 23; Smith v. Whitman Saddle Co., 148 U. S., 678; 63 O. G., 912; 1893 C. D., 324; Foster v. Crossin 44 F., 62; 54 O. G., 1115; 1891 C. D. 304; Cary Mfg. C. v. Neal, 98 F., 617; 90 O. G., 1950; 1900 C. D., 235.

2—37 F. 342; 47 O. G., 527; 1889 C. D., 424.

3—55 F. 481.

invention shown in the creation of designs (a design for decorating rugs in the case then under consideration) that:—

"The invention in a majority of patent designs is very small and of a lower order. All the statute, as commonly interpreted, requires is the production of a new and pleasing design which may add value to the object for which it is intended. The invention consists in the conception, and production of this, however simple it may be."

Other rulings are opposed to the views given in these cases, and are to the effect that as high a degree of inventive skill is called for in the production of a design which is entitled to protection under the patent laws as is necessary to support the other kind of patent[1]. In Fenton's treatise is this statement:—

"It is now tolerably well settled that design patents stand on as high a plane as other patents, in that they require to support them the exercise of the inventive or originative faculty in as high a degree."[2]

This was the view expressed by the Supreme Court of the District of Columbia in the case of E. G. & W. F. Niedringhaus[3] and followed by the Commissioner of Patents[4].

The Federal Courts have held the same. In the case of Cahoone Barnet Mfg. Co. v. Rubber & Celluloid Harness Co.[5] this decided statement was made:—

1—Perry v. Hoskins, 111 F., 1002.

2—Fenton on Designs, Sec. 18.

3—8 O. G., 279; 1875 C. D., 22.

4—Bennage v. Phillippi, 9 O. G., 1159; 1876 C. D., 135.

5—45 F. 592.

"I think it may be taken as settled that, to sustain a design patent there must be exhibited in the production of the design an exercise of the inventive or original faculty as clear and of as high degree as is called for in patents for inventions or discoveries. In the latter class there must be novelty and utility; in the former, beauty and originality. In both, the final production must have been engendered by the exercise of brain power, and to such an extent that it may be said to be born of genius."

As high a degree of invention is required in design patents as in utility patents is the ruling in Electric Mfg. Co. v. Odell[1].

The Patent Office expressly ruled in the case of ex parte Williams, Jr,[2] that design patents require as high a degree of originality as other patents. In an early decision it was stated that while "constructive genius" was probably sufficient to support a mechanical patent, "creative" genius was necessary in a design.[3]

That invention must be shown in order to support a design patent is established; whether a lesser degree is sufficient can not be so satisfactorily stated. A method of determining the different degrees of invention which may exist in several designs has not been pointed out by any one; nor can the exact place where expected skill ends and invention begins be determined by any known rule.

Writers and the majority of the leading decisions agree that genius must be shown in the creation of a design. Simonds thought that if an article was given a pleasing appearance that was sufficient evidence of the exercise

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1—18 F. 321.
2—58 O. G., 803; 1892 C. D., 23.
3—Weinberg 1871 C. D., 244.

of genius to support a patent[1]. Fenton said: "There must be originality and the exercise of genius involved. Mere artistic dexterity in grouping is not enough; it may be likened to mere mechanical skill as applied to subjects of functional patents."[2]

Mr. Justice Brown in the case of Northrup v. Adams[3], pointed out that:—

"To entitle a party to the benefit of the Act, in either case, (referring to the laws granting mechanical patents and the laws for design patents) there must be originality, and the exercise of the inventive faculty. In the one there must be novelty and utility; in the other originality and beauty. Mere mechanical skill is insufficient. There must be something akin to genius, an effort of the brain as well as the hand. The adaptation of old devices or forms, however convenient, useful or beautiful they may be in their new role is not invention."

The Supreme Court quoted this with approval in its decision in the case of Smith v. Whitman Saddle Company.[4] Relative to design patents it said:—

"The exercise of the inventive or originative faculty is required, and a person cannot be permitted to select an existing form and simply put it to a new use any more than he can be permitted to take a patent out for the mere double use of a machine. If however, the selection and adaptation of an existing form are more than the exercise of the inventive faculty, and the result is in effect a new creation, the design may be patentable."

1—Simonds on Designs, p. 195.
2—Fenton on Designs, p. 14.
3—F. C. 10328; 12 O. G., 430; 1877 C. D. 322.
4—148 U. S., 678; 63 O. G., 912; 1893 C. D., 324.

The Commissioner of Patents subsequent to the passage of the Act of May 9, 1902, after a consideration of the leading decisions on the subject of invention as relating to designs, said this:—

"A new and ornamental design will be found in an article of manufacture when there can be found in such article a new appearance created by inventive process and serving the purpose of embellishment. Such new appearance may be superficially applied or it may rest more or less deeply in the structure of the parts, but it must be a creation of inventive genius, accomplishing the purpose of ornament and not used for its functional value."[1]

In this case it was ruled that no invention was shown in allowing the corners of buckle-frames to remain angular instead of rounding them as shown to be common in the references. This was a mere matter of choice.

The Commissioner of Patents said in the case of ex parte Kern[2] in considering an application for a design patent for cross straps for garment supporters that:—

"It is as necessary that invention should be exercised in producing the subject matter to be secured by a design patent as it is in the production of the subject matter of a mechanical patent. Something in each of these classes of cases is expected to be within the reach of the skilled workman in the arts, and a design to be patentable must surpass that which is expected of the workman and rise to the dignity of invention which it will do when its creation involves an exercise of the constructive imagination beyond that which may be expected to be usually employed by any competent workman."

1—Knothe, 102, O. G., 1294; 1903 C. D. 42.
2—105 O. G., 2061; 1903 C. D. 42.

No invention was found in this case in placing a well known ornamental figure on the center of the cross-strap used for a functional purpose.

Examples of invention not shown.—The mere change of shape of the lamp shade in issue was held not sufficient in a recent case to support a design patent, many similar shapes, some of them invented by the same inventor, being shown[1]. No invention was disclosed in placing ceriphs which were shown to be old in the art on letters found also to be old[2]. Such a change was held to be obvious. There was no patentable invention involved in the idea of placing an ornament on an album case, the patentee not having been the designer of either the album or the ornament[3]. The slight changes in a font of type which the applicant had produced were held not to have involved invention in view of what was old in the art[4]; skill only and not invention was involved in the changes made in the design for a card of buttons[5]. Invention was not found in the production of the saddle under consideration in the case of Smith v. Whitman Saddle Co.[6]. The difference in form of applicant's machine bed from prior beds would suggest itself to any workman, and did not involve invention[7]. A design for a tube which differs from a patented tube merely in a rounded instead of a flat bottom and the addition of a bead near the top does not disclose patentable invention[8]. No invention was shown in the production of the monument which was considered in the case of Perry v. Hos-

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1—Mygatt v. M. Schauffer-Flaum Co., 191 F., 836.
2—Barnhart, 115, O. G., 247; 1905 C. D., 68.
3—Bergner v. Kaufmann, 52 F., 818.
4—Schmohl, 115 O. G., 505; 1905 C. D., 78.
5—Pratt v. Rosenfeld, 3 F., 335; 21 O. G., 866; 1882 C. D., 146.
6—148 U. S., 678; 63 O. G., 912; 1893 C. D., 324.
7—Hanson, 105 O. G., 2058; 1903 C. D., 284.
8—Lambert, 119 O. G., 1925; 1905 C. D., 531.

kins[1]. The court found no invention in the bottle shown in design patent 39, 921[2].

Instances of invention shown.—The change in the form and arrangement of the parts of a lamp by which a new and ornamental appearance was produced was held to involve invention[3]. Invention was held to be shown in the mantel which was the subject of the suit in the case of Anderson v. Saint[4]. Invention was shown in the Webster "thin model" clothes brush[5]. The hay fork pulley disclosed in design patent 16031 was valid, showing invention[6]. A cooking stove which was the result of invention was the subject matter of the suit in Redway et al v. Ohio Stove Co.[7]. Invention was present in the creation of a rug as shown in design patent 18703[8]. A coach lamp resembling a tulip conventionalized in form showed sufficient evidence of invention to sustain a patent[9]. It was not so clear that a badge lacked invention that a demurrer alleging want of invention should have been sustained[10]. The dignity of invention was accorded the gas lamp shown in design patent No. 35,481[11].

22. Novelty Not Sufficient.—Novelty alone is of course not sufficient to sustain a patent for a design. The assumption is apparently often made in the prosecution of applications that if the design is shown to be new a patent should be issued. Slight attention given to the

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1—111 F., 1002.
2—Chas. Boldt Co. v., Turner Bros. Co., 199 F., 139.
3—Gray 114 O. G., 543; 1905 C. D. 21.
4—46 F., 607; 57 O. G., 546; 1891 C. D. 506.
5—Tilden Thurber Co., v. T. W. Foster & Bro. Co. 195 F. 538.
6—Stearns v. Beard, 46 F. 193.
7 38 F., 582.
8—Smith v. Stewart, 55 F. 481.
9—Britton v. White Mfg. Co., 61 F. 93.
10—Caldwell v. Powell, 73 F. 488.
11—General Gas Light Co. v. Matchless Mfg. Co., 129 F. 137.

design statute must show the fallacy of this. The design must have been "invented."

This is well illustrated in the case of Wooster v. Crane[1]. The reel in suit was new; no one had ever used the particular shape of reel patented by the complaintant, but as a reel was an old article of manufacture and the shape was a well known mathematical figure, no invention was disclosed and the patent was held invalid. This is also illustrated in the case of Collender v. Griffith[2]. The novelty due to the difference in the bevel of the sides and end of the complaintant's table was not sufficient to sustain a patent. The court found that no new idea was present and the lack of invention was fatal to the patent. The Patent Office clearly pointed out in the case of Wright v. Lorenz[3] that a design was not patentable merely because the shape rendered it distinguishable from other articles. In the case of Bolte and Weyer Co. v. Knight Light Co.[4] it was said that to hold that every symmetrical article should be the subject of a design patent seemed unconscionable; that the design must disclose inventive genius. There are many other decisions to the same effect.[5]

23. Non-Analogous Arts.—A design found to be old in an analogous art would not of course be patentable[6].

1—F. C. 18036.

2—Reported in Fenton on Designs, p. 83.

3—101 O. G., 664; 1902 C. D. 340.

4—180 F., 412.

5—Freeman 109 O. G., 1331; 1904 C. D. 619; Mygatt v. Schauffer-Flaum, 191 F. 836; Westinghouse v. Triumph Electric Co. 90 O. G., 603; 1900 C. D. 219; Knothe 102 O. G., 1294; 1903 C. D. 42; Kern 105 O. G., 2061; 1903 C. D. 42; Hartshorn, 104 O. G., 1395; 1903 C. D. 170; Perry v. Hoskins, 111 F. 1002; Lambert 119 O. G., 1925; 1905 C. D. 531; Rowe v. Blodgett & Clapp 112 F. 61; 98 O. G., 1286; 1902 C. D. 538.

6—Fenton on Designs, p. 15; Niedringhaus, 8 O. G., 279; 1875 C. D. 22.

This would be a mere double use, and the principle applicable in mechanical cases would apply. Nor is the adaption of a well known existing object to a new purpose invention[1]. In the case of Northup v. Adams[2] Mr. Justice Brown said:—

"The adaption of old devices to new purposes, however convenient, useful or beautiful they may be in their new role is not invention."

In this decision, the ruling in the case of Bennage v. Phillippi[3] is referred to with approval. The design claimed in that case was the representation of the Memorial Hall at the Centennial Exposition which had been made into an inkstand and a paper weight by the respective parties to an interference proceeding involving the design. It was contended that as the parties used the design for articles in non-analogous arts both should have a patent. The Commissioner of Patents made this statement in the discussion of the question raised:—

"The arbitrary chance selection of the the form of a now well known and celebrated building, to be applied to toys, inkstands, paper weights, etc., 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 may also be innumerable if the government were foolish enough to grant them."

1—Osborn v. Judd, 29 F., 96; 38 O. G., 1132; 1887 C. D., 227.
2—F. C., 10328; 12 O. G., 430; 1877 C. D. 322.
3—9 O. G., 1159; 1876 C. D. 135.

An attempt was made to prevent the infringement of designs for jewelry pins one representing a spoon and the other a table fork. In deciding that no invention was involved in the use as jewelry of forks and spoons the Circuit Court for the District of Rhode Island said in Foster v. Crossin[1] that:—

"In the light of the words of the statute, and of the uniform course of decisions upon the subject, we can have no doubt that a design for a piece of metal in the shape of a spoon or fork two inches long, precisely similar in appearance both generally and in form of edge to common spoons or forks six inches long, lacks the novelty necessary to support a patent."

These decisions have pointed the way to the practice which prevails. To take an object found in nature and apply it to the use of some article of manufacture without making an appreciable change in it does not involve invention; nor, is there invention in taking an object or ornamentation in one art and using it in a non-analogous art. The error in thinking there is results from the supposition that the idea of using an existing object in one art is capable of protection under the design law; the design law protects the ornamental design, not the thought which results in applying the design from one art to another art.

The Supreme Court after referring to the ruling in the case of Northrup v. Adams, supra, with approval summed up the law on the subject of the adaptation of old devices to new purposes in the case of Smith v. Whitman Saddle Co.[2] as follows:—

"Many illustrations are referred to, as for instance, the use of a model of the Centennial Building for paper

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1—44 F., 62; 54 O. G., 1115; 1891 C. D., 304.
2—148 U. S., 678; 63 O. G., 912; 1893 C. D., 324.

weights and inkstands; the thrusting of a gas pipe through the leg and arm of the statue of a shepherd boy, for the purpose of a drop light; the painting upon a familiar vase of Steuart's portrait of Washington, none of which were patentable because the elements of the combination were old. The shape produced must be the result of industry, effort, genius, or expense, and new and original as applied to articles of manufacture (Foster v. Crossin 44 F. 62). The exercise of the originative faculty is required, and a person cannot be permitted to take a patent for the mere double use of a machine. If, however, the selection and adapation of an existing form are more than the exercise of the imitative faculty and the result is in effect a new creation, the design may be patentable."

An automobile bell unlike any other bell previously produced was the subject of the suit in Bevin Bros. Mfg. Co. v. Staar Bros. Bell Co.[1] The court pointed out that in determining the question of invention it could avail itself of such knowledge as is possessed by the general public, and held the patent void in this manner:—

"The eyes of the Court can not be closed to the fact that in the court room itself are electric light fixtures, placed there long before the date of the patent, which show a sphere with a neck and rim so nearly identical with those of the patent that the difference is a mere matter of immaterial proportions. Nor can the andirons of our fathers, the door knobs from time immemorial, the old chime bell of the sleigh, the conventional cuspidor, be overlooked. The Court must take judicial notice of the oblate spheriod and neck common to the whole field of every day arts, and must hold that this design is, at most, the adaption of an old form to a new purpose."

1—114 F., 362.

The Circuit Court of Appeals for the Sixth Circuit[1], and the Circuit Court of Appeals for the Seventh Circuit[2], both held the Boldt design patent No. 39921 for a bottle, void, finding anticipations outside of the bottle art or any art analogous to it. The rulings of the Patent Office are to the same effect[3]. In the Knothe[4] case this statement is made:—

"The doctrine of double use applies as well as to mechanical inventions and has an even wider application in the case of designs * * * * * In designs the doctrine of double use is not limited to the selection of devices in the same or analogous mechanical arts, since relating solely to shape or appearance the mechanic in producing a design may avail himself of old shapes wherever they are found and for whatever purpose they were before used."

One decision only opposed to the doctrine herein set forth has been found. In the Bartholomew case[5] the application for a design patent for rubber erasers had been refused on the ground that the form of the eraser was already old in artists' stumps. Relative to this rejection the Commissioner of Patents said:—

"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

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1—Chas. Boldt Co. v. Nivison-Weiskoff Co. 194 F 871.
2—Chas. Boldt Co. v. Turner Bros. Co., 199 F. 139.
3—Leigh v. Saart, 101 O. G., 663; 1902 C. D. 367.
4—Knothe, 102, O. G., 1294; 1903 C. D. 42.
5—1896 C. D., 103.

substantially the same articles of manufacture as erasers, the old form applied to this new article is unquestionably entitled to protection."

The decisions of the Patent Office and the courts are overwhelmingly against the conclusion reached in this decision. An anticipation of a design may be obtained from a non-analogous art.

24. Aggregation of Old Ornaments Not Invention.— A mere aggregation of old well known ornamental devices does not constitute invention in designs. There must be something more; a combination, blending, arrangement, proportioning of the parts in a manner to produce a structure which the mind will regard as a distinct, unitary structure, is necessary.

Mr. Fenton has happily expressed the idea thus:—

"The law of combinations is equally applicable to design. As in mechanical devices, a mere aggregation of designs, like a mere aggregation of mechanisms does not constitute patentable combinations arising to the dignity of invention. As in combination of mechanisms, to be patentable they must coact to produce a united result, so in designs a mere grouping together of old ornaments or designs to be patentable as a new design must produce as a whole a new effect, result, or appearance, due to all the parts as a unit, and not resulting from the separate appearance of each of the separate or separable parts.

* * * * * Mere artistic dexterity in grouping is not enough; it may be likened to mere mechanical skill as applied to subjects of functional patents[1]."

These statements are well supported by several cases.

1—Fenton on Designs, p. 14.

In the decision in the case of Northup v. Adams,[1] decided in 1877, the patent involved was a design for a cheese safe which was shown to be produced by the mere aggregation of old shapes and means of embellishment, all of which were well known. In holding the patent void the court made these observations:—

"If a combination of old designs be patentable at all, of which I have some doubt, the combination must be such as to produce a new appearance. If the effect produced be simply the aggregation of familiar designs, it would not be patentable."

The patented design in suit in the case of Perry v. Starrett[2] which was for a stove is an instance in the opinion of the court for the Southern District of New York, of a harmonious arrangement, of parts and embellishments, some of which were old, to produce a new, ornamental effect. The complete newel post shown in design patent No. 12026 was held valid in the case of Simpson v. Davis.[3] In this case, however, are laid down some of the proper means of determining whether a structure is a mere aggregation of old forms or ornamentations not producing a new and original effect or whether taken as a whole it can be regarded as the embodiment of a new idea in ornamentation. In Kraus v. Fitzpatrick[4] in considering the question of the validity of a design patent for a corset (No. 13,620) the court succintly put the matter thus in upholding the patent:—

"Most of the special features of this design are to be found, separately, in prior things, but they are nowhere

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1—F. C. 10328; 12 O. G., 430; 1877 C. D. 322.
2—3 Bann. & Ard., 489; 14 O. G., 559; 1878 C. D. 368; Design Patent No. 7456.
3—12 F., 144.
4—34 F., 39.

combined so as to make such an effect as a whole, and that is what is to be looked at.''.

An examination of the patents issued within the last three or four years discloses illustrations of designs which have been held by the board of examiners-in-chief or the Commissioner as unitary designs which produce a distinctive effect and which are not mere aggregations of old shapes or ornaments.[1] The board of examiners-in-chief in reversing the examiner in the Estes application discussed the question of aggregation as follows:—

''The examiner has not positively rejected the appealed claim upon the ground that it defines a construction built up from aggregated features of design. He has, however, cited against the appealed claim a plurality of references in which he severally points out by way of justifying his action, certain elements or features which more or less resemble portions of the applicant's design, also specified. An action of this character is justifiable only in cases where a design has been produced by aggregating independent features old or new, and in such a case a rejection placed clearly upon the ground of aggregation will suffice.

''We are not prepared to rule that the applicant's design is not of an unitary character. In consequence of this position, we cannot affirm the examiner's rejection upon a plurality of references alleged to show features resembling portions of the applicant's construction. In determining whether a design is of an unitary or an aggregated character, the test to be applied must be the impression received through the eye of the observer upon the mind. If the impression thus received be in fact of

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1—Design patents to Nelson, No. 40,717; De Vilbiss, 40,790; Madden, 41,441; Pope, 42,295; Leichter, 43,052; Estes, 43,739.

an unitary character, the inquiry in that direction ends, and such an impression cannot be disposed of by arbitrarily separating an applicant's construction into different portions and applying aptly worded characterizations thereto."

The right of an inventor of a design to have it considered as a unitary body is emphasized in many decisions[1].

25. Change in Color, Material or Size, Not Invention.—Whether color forms the proper subject for a design patent was the subject of consideration in one of the earliest cases on the subject of designs. In the case of ex parte Weinberg[2] the Commissioner answered the question thus:—

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

The Commissioner, however, pointed out that he was not prepared to say that no design might be based on colors.

In considering an application for a design for finger ring settings the Commissioner of Patents in the case of ex parte Traitel[3] discussed the question under consideration in this section as follows:—

1—Jammes v. Carr-Lowry Glass Co., 132 F. 827; Chas. Boldt v. Turner Bros. Co. 199 F., 139-142; Graff, Washbourne & Dunn v. Webster, 195 F., 522.

2—1871 C. D., 244.

3—25 O. G., 783; 1883 C. D. 92.

"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 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 the design, which relates solely to form and configuration, finds expression or materializes."

In the case of ex parte Neidringhaus[1] was presented the question whether an alleged design was patentable which apparently consisted in mixing a paint which when applied to metal-ware produced a mottled appearance resembling granite. The Commissioner thought such a paint might be patentable, but that the application of it in the ordinary way did not constitute subject matter for a design patent.

Placing different shades of color on an old flag does not amount to invention[2]. The substitution of green glass for white glass does not avoid infringement, for color forms no part of the design[3].

"Color constitutes no element of a design patent" is the statement made in a case recently decided[4].

In a well considered case it was pointed out that colors applied to the design—in this case a carpet—do not affect the essential characteristics[5].

Patentability in design cases is, generally speaking, not dependent on the material from which the article is constructed. The ornamental effect, the configuration,

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1—1875 C. D., 22.

2—Caldwell & Co. v. Powell, 73 F. 488; 75 O. G., 1206; 1898 C. D. 625.

3—Jammes v. Carr-Lowry Glass Co., 132 F. 827.

4—Star Bucket Pump Co. v. Butler Mfg. Co., 198 F. 857-864.

5—Whittall v. Lowell Mfg. Co., 79 F., 789; 80 O. G., 809; 1897 C. D. 599.

etc., is the same whatever the material. In an early decision[1] a design patent was sought upon a hollow hexagonal column. In rejecting the claim the Commissioner pointed out that "A new shape or configuration is independent of materials or modes of manufacture".

The substitution of a metallic loop for a loop formerly made of silk, woolen or other material was held, in the case of Post v. Richards Hardware Co.[2] as not involving invention.

Material and size are immaterial in design cases, the Commissioner of Patents said in 1901 in the case of Tyler v. St. Amand[3].

1—Geo. H. Sellers, 1870 C. D., 58.
2—26 F., 618.
3—94 O. G., 1969; 1901 C. D. 301.

Chapter IV.

NOVELTY AND INFRINGEMENT.

26. How Determined.—A design to be patentable must be "new". How is novelty or identity to be determined?

The celebrated Gorham case was decided by Justice Blatchford in the Circuit Court of the Southern District of New York[1]. In answering the question whether two designs were substantially the same the Court refused to assent to the test of infringement proposed by the complainant; that is, the effect on the eye of the ordinary observer. The same principles which are applied in determining the question of infringement of mechanical patents, should be applied, the Court thought, in determining the infringement of designs. Whether a certain design presented novelty, and of course whether one was an infringement of another should be determined by experts who placed the articles side by side. The court thought a patent for a design was for the means of producing a certain result or appearance and that therefore if the same appearance was produced by substantially different means, the later design was not an infringement.

The Supreme Court of the United States reversed the lower court upon all points, but with three Justices dissenting[2]. The Court said in order to answer the question whether there had been infringement and whether the defendant's designs were substantially the same as the complainant's it was necessary "to understand what constitutes identity of designs and what amounts to infringement". After pointing out that a patent for a design was for the thing itself, and not for the manner of

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1—Gorham v. White, 7 Blatch. 513.
2—Gorham v. White, 14 Wall. 511.

producing it, the Court presented the following upon the question of what is the true test of identity of design:—

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

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

If, then, identity of appearance, or, as expressed in McCrea v. Holdsworth, sameness of effect upon the eye, is the main test of substantial identity of design, the only remaining question upon this part of the case, is whether it is essential that the appearance should be the same to the eye of an expert. The court below was of opinion that the test of a patent for a design is not the eye of an ordinary observer. The learned judge thought there could be no infringement unless there was 'substantial identity in view of the observation of a person versed in designs in the particular trade in question; of a person engaged in the manufacture or sale of articles containing such designs; of a person accustomed to compare such designs, one with another, and who sees and examines the articles containing them side by side.' There

must, he thought, be a comparison of the features which make up the two designs. With this we cannot concur. Such a test would destroy all the protection which the Act of Congress intended to give.

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

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

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

While it is true that the comparative appearance of two designs must be determined by the average observer, and not by the expert, it is not meant that the test must be made by one wholly unfamiliar with the design under consideration. A purchaser, for instance, has usually some knowledge of the form and appearance of the objects he wishes to buy, and the knowledge possessed by such a person may fairly be used[1].

The rule of the Gorham case for determining novelty has been generally applied. In the case of Braddock Glass Co. Ltd. et al. v. Macbeth et al[2], this rule was stated:—

1—Byram v. Freidberger, 87 F. 559; 82 O. G., 1420; 1898 C. D. 380.

2—64 F. 118; 70 O. G., 1799; 1895 C. D. 271.

"The novelty of a design is to be tested not by the investigation of the means employed for its creation, but by ocular comparison of the design itself with the prior designs which were alleged to be substantially the same".

The test applied by the Supreme Court was interpreted by another court in this manner:—

"If in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer and sufficient to induce him to purchase one supposing it to be the other, the one first patented is infringed by the other".[1]

The rules of this case are further applied to the same effect in other cases[2].

27. Substantial Identity Negatives Novelty or Establishes Infringement.—Novelty is negatived by showing, and infringement is made out by using, substantially the same design. It is not necessary that a picture of the article under consideration be found to be old or in use by the defendant. To this effect is the ruling in the first case involving a design patent ever tried[3]. In holding the defendant's stove an infringement of the complainant's patent the Court ruled:—

"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 in-

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1—Miller v. Smith, 5 F., 359; 18 O. G., 1047; 1880 C. D. 643.

2—Simpson v. Davis, 12 F. 145; Perry v. Starrett, 3 Bann. & Ard. 489; 1878 C. D. 368; Redway et al v. Ohio Stove Co., 38 F. 582; Monroe v. Anderson, 58 F. 398; Britton v. White Mfg. Co., 61 F.93.

3—Root v. Ball & Davis, F. C. 12035.

fringed 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 produce 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."

In the Gorham case, supra, this same test was applied; not identity but substantial similarity was all that was required to establish infringement or negative novelty.

Although two designs are easily distinguishable when placed side by side, if they are so nearly alike that an ordinary purchaser giving such attention, as is usually given, would be deceived, infringement is established[1].

The Court of Appeals of the District of Columbia in the case of in re Freeman[2] found some differences between a patented device and the device shown in the application, but held a patent properly refused on the ground that the differences were not substantial. To the same effect was the ruling in the case of in re Schraubstadter[3]. The Court found that there were differences between applicant's font of type and the art but said that as these differences were small and would hardly be appreciated by the ordinary observer, the test applied in the Gorham case negatived novelty of applicant's design.

This subject is well discussed with a citation of authorities in the case of Tompkinson v. Willets Mfg. Co.[4]:—

"In approaching this subject (the question of infringement) the rule with reference to design patents should be kept steadily in view. It is by no means necessary

1—Friedberger-Aaron Mfg. Co. v. Chapin, 151 F., 264.
2—109 O. G., 1339; 1904 C. D. 619.
3—120 O. G., 1167; 1906 C. D. 541.
4—23 F., 895; 32 O. G., 382; 1885 C. D. 365.

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 the 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; Lehmbeuter v. Holthaus, 105 U. S. 94; Wood v. Dally, 7 F. 475; Sim. Pat. 218; Walh, Pat. Sec. 375)".

In a recent well considered case[1], in determining the question whether respondent's lamp shade infringed the complainant's shade the Court said:—

"The principles upon which we may determine this controversy as to infringement are the same as those we have referred to for the purpose of determining the validity of the patent, except perhaps, as to the use of expert testimony and observation of the manufactured article in use."

After quoting from several cases[2] which lay down the true rules to be followed, the decision concludes:—

1—Macbeth-Evans Glass Co. v. Rosenbaum Co., 199 F. 154-164.

2—Gorham v. White, 14 Wall., 511; Ripley v. Elson, 49 F. 927; Hutter v. Broome, 114 F. 655; Frieberger Aaron Mfg. Co. v. Chapin, 151 F. 264; Scofield v. Browne, 158 F. 305; Graff v. Webster, 195 F. 522; Jennings v. Kibbe, 10 F. 669.

"The true tests of identity are therefore, first, sameness of appearance; second, the eye of the ordinary observer, an observer of ordinary acuteness bringing to the examination of the article upon which the design has been placed that degree of observation which men of ordinary intelligence give."

The Court further pointed out that in the case at bar it was proper in determining the question of infringement to take into consideration the appearance of the shades when lighted up as they would be in use. This was so held the Court said in accordance with sound reasoning on the authority of the ruling in Phoenix Knitting Works v. Hygienic Fleeced Underwear Co.[1].

The different manner of determining the question of identity of design and infringement was further stated in this way:

"In determining the validity of a patent whether two designs are identical is to be determined by examining the drawings and the manufactured article, and that it is only in determining this question of infringement that we may resort to and consider the design in use."

In the case of Smith v. Whitman Saddle Co.[2], however, it was held that the defendant's saddle did not infringe because of the marked differences between its saddle and complainant's saddle in the one feature which was not old in the saddle art. The dissimilarity was so marked as to produce a substantial difference in appearance.

It is not sufficient to show that all the important elements which constitute a design are old; these may be so arranged as to produce an entirely new entity[3].

1—194 F. 696.

2—148 U. S., 678; 63 O. G., 912; 1893 C. D. 324.

3—Walker on Patents, Sec. 64.

28. Character of Evidence Which Negatives Novelty or Establishes Infringement.—Novelty is not negatived by the evidence of experts to the effect that two designs were produced by the same process or method nor by the statement of such witnesses that the designs present a similarity of appearance due to features or characteristics which are discoverable to such witnesses but which would not be apparent to the ordinary purchaser or user of such articles. Courts have repeatedly held that novelty was negatived by showing that the ordinary observer would mistake one design for another which was old. Evidence to be successfully used in negativing novelty must show that the general characteristics of two designs are the same and that these would produce the same effect on the ordinary beholder.

The testimony of experts is held in most decisions in design cases not admissible to determine the question of novelty or infringement.[1]

In the case of Kraus v. Fitzpatrick[2], these succinct statements bearing directly on the character of evidence required upon the question of infringement and novelty are made:—

"The test of infringement of a design patent appears to be the question of such similarities as will lead ordinary persons to think the articles in question are the same, (Gorham v. White, 14 Wall. 511; Jennings v. Kibbe, 10 F. 669). The test of novelty would therefore appear to be the existence of such differences between articles embodying the patented designs and those existing before as would be recognized by the same class of persons. (Lehnbeuter v. Holthaus, 105 U. S., 94).

1—Gorham v. White, 14 Wall. 511; Schraubstadter, 120 O. G., 1167; 1906 C. D. 541; Ripley v. Elson Glass Co., 49 F. 927; 60 O. G. 298; 1892 C. D. 467.

2—34 F. 39; 42 O. G., 1292; 1888 C. D. 291.

29. Illustrative Cases.—In the early case of Jennings v. Kibbe[1] Justice Blatchford in the absence of testimony by the defendant on the question of identity compared the nubia made by the defendant with the patent and found infringement to exist. He was of the opinion that this practice could not be extended to other patents and not to all design cases. A design for jewelry settings was the subject of the suit in Wood v. Dolby[2]. The evidence presented to establish lack of novelty did not show the patented design in appearance, outline or detail. The Court therefore held that novelty was not negatived. The defendant's device in this case differed from the patent in several minor respects. These differences, the Court said, did not change the artistic effect, and considered as desirable ornaments were immaterial. The patent on which the suit was brought in the case of Perry v. Starrett[3] was for a stove which the evidence showed was old as to several of its parts and ornamentations. This proved, the defendant contended, that the complainant's stove was a mere aggregation and not patentable. Upon this point the Court said:--

"If all the patentees did was to take the legs of the Smith stove, the base of the Lighthouse, the ash pit and mica sections of the Smith stove, the reservoir and top of the American and the urn of the Oriental, and join them together, it is also clear that they did nothing entitling themselves to a patent. (Burriss v. Woodruff, 4 Wash. 48; Wooster v. Crane, 2 Fisher 584). Or, if they did no more than to join them t. .ther with such adaptations to each other as would be .de by the exercise of the ordinary skill of workmen in that trade, probably they did not. But the evidence shows that they did much

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1—10 F., 669.
2—7 F., 475; 20 O. G., 523; 1881 C. D. 340.
3—3 Bann. & Ard., 489; 14 O. G., 599; 1878 C. D. 368.

more than either. Although the legs of the Argand and of the Smith stove are *cyma reversa* in general form, those of the Argand are quite different from the others in proportion and style. The base of the Argand is not exactly like that of the Lighthouse. The curves of its ash-pit section are different from those of that section of the Smith stove. The lower mica section of the Smith stove is convex below and concave above in outward form, while that of the Argand is slightly convex throughout. The lines and curves of the mica section of the Argand are different from those of the Smith stove, and in the Argand the rear extension, to include the exit pipe, is carried upward on that section, while in the Smith stove it is not. And the top and the urn of the Argand differ somewhat from those of either the Lighthouse or the Oriental.

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

The Court therefore said that the new form and the new ornamentation together made up a valid design. It requiring study of the differences and fixing them in the mind, to be able to distinguish the defendant's stove from the design of the patent when they were not considered side by side although there were minor differences of form and ornamentation, it was held that the defendant infringed. This decision is important in that it points out that the test of infringement is not properly made by placing the patented and alleged infringing device side by side; such a test is too severe on the validity of the patent.

In the case of Miller v. Smith[1] the Court was advised relative to the nature of the patented design and of the exhibits and publications placed in evidence by expert witnesses. In this case much stress was laid on the statements of the expert.

The case of Dukes, Receiver, etc. v. Bauerle et al[2] is of interest for the reason that the Court points out the various details of the design patents in suit which were for sewing machine cases and also the art in view of which the patents were said to be lacking in novelty.

A close question of similarity of designs is presented in the case of Frank v. Hess[3]. The Court found two designs for caps in both of which the same general style of ornamentation was used so different that when placed side by side and held in a certain way the effect was not the same. Infringement was therefore not established. The patent in this case was strictly limited to the design shown.

A design patent for trimming for underwear was alleged to be infringed. This trimming consisted of three elements, two of which were well known and old in the art. The difference between this new element in the defendant's trimming and the same element in the patent was slight the Court said in Byram v. Friedberger[4], but as these differences could be discerned and changed the pattern, the patent was held not infringed.

Novelty was negatived the Court decided in Welker v. Weller[5] by showing that the prominent features of the complainant's design were old.

The character of evidence which is regarded as insufficient to negative novelty was carefully reviewed in the

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1—5 F., 359; 18 O. G., 643; 1880 C. D. 643.
2—41 F., 783; 51 O. G., 805; 1890 C. D. 311.
3—84 F., 170; 82 O. G., 1566; 1898 C. D. 397.
4—100 F., 963; 82 O. G., 1420; 1898 C. D. 380.
5—73 F., 299; 75 O. G., 185; 1896 C. D. 307.

case of Redway v. Ohio Stove Co.[1]. In this case the Court referred to the fact that when parts of the stove of the patent were placed by the side of one of the parts of the designs which were said to negative novelty, the differences were apparent to a casual observer. In this case infringement was found because of the same general appearance of the defendant's design and the design of the patent although several features of ornamentation were omitted by the defendant. The use of the name of the defendant on its stove conspicuously displayed did not relieve the defendant from liability as an infringer. The court thought the practice in this regard should be the same as in trademark cases citing Menendez v. Holt.[2]

30. Effect of Same Design in Another Art.—A design is anticipated if found to be old in an art not analogous to that to which it belongs. As invention is not shown in taking an object old in one art and using it in another[3], so also is novelty wanting in a design which is disclosed in an art entirely different from the art to which it belongs. Accordingly the Circuit Court for the District of Rhode Island in the case of Foster v. Crossin[4], refused to sustain a patent for a jewelry pin consisting of the representation of a spoon which was made in accordance with the design of a spoon shown to be well known in the spoon art.

No decision of a Federal Court has however been found in which the direct issue was whether a complainant could prevent the infringement of his design by the use by the defendant of the same design in an art entirely different from that to which the complainant's design belonged. A question of this kind, for instance, has not been authoritatively answered. Is an ornamental design for a drinking glass infringed by the use of the same de-

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1—38 F., 582.
2—128 U. S., 514.
3—Section 23.
4—44 F., 62; 54 O. G., 1115; 1891 C. D. 304.

sign by another, on an automobile door; or is a design for a lamp shade infringed by the use of the same design for a door knob?

In the case of Wooster v. Crane[1] a patent for a reel for containing ruffle trimming, etc., was held invalid on the ground that the shape which was that of a rhombus was old in many articles of manufacture, although not old as an ornamental reel. This ruling was followed by the Commissioner of Patents in the case of Bennage v. Phillippi[2] in which he refused to grant design patents for a toy bank and for a paper weight, both in the form of the Memorial Hall at the Centennial Exposition. The applicants claimed that the designs were for different articles of manufacture, articles for non-anagolous purposes, and that as the designs were new as applied to those particular articles, both should be granted a patent. The Circuit Court for the Eastern District of Michigan, approved the ruling of the Patent Office in rendering a decision in Northrup v. Adams[3].

The ruling in Bennage v. Phillippi, supra, was followed by the Patent Office in Leigh v. Saart[4], and ex parte Knothe[5]. In the last case the Commissioner of Patents stated:—

"In designs the doctrine of double use is not limited to the selection of devices in the same or analogous mechanical arts, since relating solely to shape or appearance the mechanic in producing a design may avail himself of old shapes wherever they are found, and for whatever purpose they were before used."

1—F. C. 18036.
2—9 O. G., 1159; 1876 C. D. 135.
3—F. C. 10328; 12 O. G., 430; 1877 C. D. 332.
4—101 O. G., 663; 1902 C. D. 367.
5—102 O. G., 1294; 1903 C. D. 42.

This was the doctrine announced by Mr. Simonds[1], and approved in Western Electric Mfg. C. v. Odell[2]. In the case of Untermeyer v. Freund this statement though *obiter* is made:—

"If the patented design consisted in a transfer of an old form which had existed upon something else to a watch case, or in the mere adaptation by imitation of a pre-existing form to a watch case, it would not have been an invention."[3]

In the cases of Bevin Bros. v. Star Bros. Bell Co.,[4] and Charles Boldt Co. v. Nivison-Weiskopf Co.[5] the Court considered as negativing novelty of the designs in suit various ornamental objects in arts non-analogous to arts to which the patented designs belonged.

31. State Of The Art.—The questions of novelty and infringement are dependent upon the "state of the art" in design cases as well as in mechanical, although not so much stress can be placed upon it partly for the reason that a design is not an "improvement" as this term is understood in the patent law. Repeated reference is, however, found in the decisions to the state of the art. The case of Sutro Bros. Braid Co. v. Schloss et al[6] is an example. The plaintiff's patented braid was a three ribbed design having something of the general appearance of a trefoil. The evidence showed that ribbed braid was old in the art. The defendants four ribbed braid was declared not an infringement for a broad construction could not be given

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1—Simonds on Designs, p. 212.
2—18 F., 321.
3—58 F., 205; 65 O. G., 1767; 1893 C. D. 664.
4—114 F., 362.
5—194 F., 871.
6—44, F. 356.

the patent in view of the state of the art. A patent for a lamp resembling a tulip conventionalized was entitled to a broad construction as it was new as shown by the state of the art presented to the court. This was the ruling in Britton v. White Mfg. Co.[1] Care must be exercised however in considering the state of the art for the purpose of negativing novelty. Even if features of a design are old, it may be that the new additional feature makes the design distinct and novel over the art[2].

The doctrine is well illustrated in the case of Untermeyer v. Jeannot et al.[3] The design was for a watch case which was decorated with a locomotive engine and tender upon a railroad track with ornamental plants all surrounded by a ring of dots and an ornamental border. The art showed watch cases ornamented with locomotives and tenders on railroad tracks. The Court pointed out that with this state of the art existing, the patentee could not be protected except from infringement of his peculiar design. In the case of Hugh W. Collender v. Wm. H. Griffith[4] the Court said that the design patent for a billiard table should never have been issued in view of the state of the art disclosed. Giving the limited construction to the patent required by the state of the art resulted in holding that the defendant did not infringe in the case of Meers v. Kelly[5]. There are other references to this subject[6]. The state of the art is a limitation of a design claimed notwithstanding the claim is in the conventional form; that is, the design shown in the drawing.

Another illustration of a design patent receiving a limited construction in view of the state of the art is

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1—61, F. 93-96.

2—Fenton-Sec. 4, and cases cited.

3—20 F., 503.

4—Reported in Fenton on Designs, p. 83.

5—31 F., 153.

6—Dukes, Receiver v. Bauerle et al. 41 F., 783; 51 O. G., 805; 1890 C. D. 311.

afforded in the case of Croker v. Power Co.[1]. The plaintiff's design for an easel was restricted to the particular design disclosed in the specification in view of what was old.

The state of the art as bearing on the question of the construction to be given to complainant's design was discussed in the case of Britton v. White Mfg. Co.[2], it being held that a monthly magazine was a printed publication which might be admitted to show the state of the art.

The state of the art disclosed in the Whitman case[3] showed that it was customary to vary the shape of saddles to suit purchasers. This lack of novelty, due to the state of the art, was an important fact in reaching the conclusion that infringement did not exist.

The "state of knowledge," as it is called in the English texts is regarded as an important element in determining infringement[4].

32. Common Knowledge.—Courts will take judicial notice of matters of common knowledge in design cases as in other patent cases in determining the question of novelty of a design[5]. In the case of Eclipse Mfg. Co. v. Adkins[6], the Court pointed out to what extent common knowledge might be relied upon to defeat a patent. The judge must not act as an expert or on special knowledge he may have. The decision states:—

"I am free to say that I should not feel justified in holding a patent void for want of novelty on common knowledge, unless I could cite instances of common use

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1—29 F., 456.
2—61 F., 93.
3—Smith v. Whitman Saddle Co. 148 U. S., 678; 63 O. G., 913; 1893 C. D. 324.
4—Swan, Patents, Designs and Trademarks, p. 271 and cases cited.
5—Fenton, p. 71; Bevins Bros. Mfg. Co. v. Starr Bros. Bell Co. 114, F., 362.
6—36 F., 554.

which would at once, on the suggestion being made, strike persons of usual intelligence as a complete answer to the claim of such a patent."

In the case of Western Electric Mfg. Co. v. Odell[1], the patent in suit was held invalid on demurrer, the court ruling that it was matter of common knowledge that it was old to decorate the face of a dial in the way the patentee had ornamented the face of his dial plate.

In the case of Britton v. White Mfg. Co.[2] the court took judicial notice of common knowledge as to the shape of certain flowers in determining the validity and scope of the complainant's patent. Novelty of a bell was negatived by the common knowledge of the general public of which the court availed itself[3].

33. Generic Idea of Ornamentation.—In one of the earliest reported decisions of the Patent Office[4], it was held that a patent might be issued for a generic design and that a specific patent might be issued for every variety and species of that design which would be tributary and subordinate to the patent covering the genus. This rule like many others which have been announced has not been uniformly followed. If it had been many perplexing questions which have arisen and which are now unsettled might have been avoided.

Mr. Simonds was of the opinion that the test applied by the Supreme Court in the Gorham case[5] gave a generic effect to some claims even if the claims were not generic in form[6]. He pointed out that if the test of similarity was the observation of an ordinary purchaser,

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1—18 F., 321.
2—61 F., 93.
3—Bevin Bros. Mfg. Co. v. Starr Bros. Bell Co. 144 F. 362.
4—Bartholomew, 1869 C. D., 103.
5—Gorham Mfg. Co. v. White, 14 Wall. 511.
6—Simonds, pp. 198-199-203.

designs specifically different would be held to be the same. The generic construction, however, must cease when the differences are sufficient to be discerned by the character of person described. The conclusion reached by this authority was that, "A design patent can not be allowed for a design which is tributary to another, or a mere improvement thereon, and not in substance unlike it."

In the case of ex parte Gerard[1] it was definitely denied that the doctrine of genus and species as understood in mechanical cases applied to designs. In this case a lengthy discussion of the subject appears, in which is this statement:—

"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."

There are many other decisions of the Patent Office holding that there is no such distinction between generic and specific design patents as is recognized in mechanical cases[2].

The decisions in the case of Cushman v. Lines[3], two by

1—43 O. G., 1235; 1888 C. D. 37.

2—Hill & Renner, 82 O. G., 1988; 1898 C. D. 38; Adams, 83 O. G., 1994; 1898 C. D. 109; Jenks, 83 O. G., 1513; 1898 C. D. 81; Schraubstadter, 110 O. G., 2015; 1904 C. D. 229; Burdick, 97 O. G., 1373; 1901 C. D. 184; Kurz, 113 O. G., 2215; 1904 C. D. 557; Little, Jr., 160 O. G., 1272; 1910 C. D. 227.

3—77 O. G., 153; 1896 C. D. 62; 78 O. G., 2051; 1897 C. D. 346; 79 O. G., 335; 1897 C. D. 19.

the Commissioner of Patents and one by the Court of Appeals of the District of Columbia, were rendered with the view apparently that the generic idea of configuration or ornamentation shown was old when Cushman and Lines came into the field. This statement is not directly made but the decisions are easily understood with this an accepted view.

The decisions in the case of Ashley v. Samuel C. Tatum Co.[1] have been variously construed and have received much comment. The Circuit Court of Appeals found that the distinction between the designs could be discerned by the ordinary purchaser as well as by the expert when the designs were considered together or apart. If this is true the patent to Hilles in accordance with which Tatum's design was made was not a species of the generic ornamentation discovered by Ashley. This view, however, leaves for consideration the suggestion which arises from the language of the ruling rendered by the Court of Appeals to the effect that if the complainant had secured a claim for the dominant features of his design he might have protected those features with or without ornamentation, unless the ornamentation was carried to such an extent that it changed the effect produced.

34. Penalty for Infringement—Act of February 4th, 1887.—Minimum damages of two hundred and fifty dollars are fixed by the Act of February 4th, 1887, for knowingly infringing a design patent. For what character of infringement this amount may be recovered has not been consistently decided.[2] To recover under this Act the infringement must have been committed with knowledge of the plaintiff's patent[3]. The Act expressly states

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1—181 F., 840 (C.C.); 186 F., 339 (C.C.A.)

2—Walker on Patents, Sec. 571a and cases cited.

3—Lichtenstein v. Straus et al 166 F. 319; Dunlap v. Schofield, 152, U. S., 244.

that if the profits made by the infringer exceed the sum of two hundred and fifty dollars he shall be liable for the excess of such profits above that amount.

Chapter V.

APPLICATIONS AND LETTERS PATENT.

35. Petition.—The general form of petition required in applications for mechanical patents is used in making application for a patent for a design. The period for which the grant is desired must be set forth, and instead of the request that a patent for an "improvement" be granted, the prayer should be for a new and original design.

36. Specification.—The preamble to the specification should also follow the usual form used in the other character of patents. Reference should then be made to the invention as "a new, original and ornamental design". If no description of the design in words is given, reference should be made to the drawing as a specification of the invention.

37. Should Specification Contain a description of the Design?—As the provisions of 4888 of the revised statutes necessitate the filing among other things of a written description of the invention before a patent may be issued, and as section 4933 makes all regulations for obtaining other patents applicable to designs if those regulations are not inconsistent with the provisions of the design act, it would appear to follow that the specification in a design case must, in order to obtain the issue of a valid patent, contain a written description, for it can hardly be said that there are any words in section 4929 inconsistent with the requirement made in section 4888.

What is the history of this subject? The earliest issued design patents contain a written description. Be-

cause apparently of the difficulty of describing in words some designs, it soon became the practice to refer to the drawing as the specification and description of the design. In the case of Untermeyer v. Jeannot[1] decided in 1884, the invention involved in the suit was of a character difficult to describe in words. The specification was accompanied by a photograph of the design but the important features were not described except by name. The limited scope given the patent was apparently on account of the absence of description of the features which the complainant claimed had been infringed.

Two years later the question came up directly whether a design patent in which there was no description of the design except the drawing was valid. Upon this question the Supreme Court said:—

"It is contended that Section 26 of the Act of July 9, 1870, applies to the present case. That section provides that before any person shall receive a patent for his invention or discovery, he shall file in the Patent Office a written description of it and 'particularly' point out and distinctly claim the particular 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 the 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 repre-

1—20 F. 503.

sented by the photographic illustration than it could be by any description and a description would probably not be intelligible without the illustration. * * * * * In the present case the design is sufficiently identified by the illustration without the aid of any description. In the language of Section 72 (now section 4930 revised statutes)before cited, the design is sufficiently represented by the photograph."[1]

This decision has been repeatedly referred to in subsequent decisions and there is no reported case in which the patent was held invalid simply because the specification did not contain a *written description*[2].

The rules of the Patent Office apparently contemplate the omission of a word description of the design, for Rule 82 which specifies the order of arrangement of a design specification does not provide for a detailed description but only a description of the figures of the drawing. This interpretation of the rules is further emphasized by the statement in Rule 81 that "the appearance can be disclosed only by a picture of the article".

Shortly after the design act had been amended (May 9, 1902,) the Patent Office, endeavored to cut down or eliminate all detailed description in a design specification. In the case of ex parte Freeman,[3] after referring to the complete description of the design, a hose supporter, the Commissioner said:—

"This descriptive language illustrates, in connection with the drawing of this case, the utter futility of at-

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1—Dobson v. Dornan, 118 U. S. 10.

2—Tompkins Co. v. New York Woven Wire Mattress Co., 159 F. 133; Cheney Bros. v. Weinreb & Weinred, 185 F., 531; 157 O. G., 1002; 1910 C. D. 262; Ashley v. Tatum, 186 F., 339; Mygatt v. M. Schauffer- Flaum Co., 186 F., 343; Phoenix Knitting Works v. Rich 194 F., 708; Graff Washbourne & Dunn v. Webster 189 F., 902-905.

3—104 O. G., 1396; 1903 C. D. 172.

tempting by words to describe the appearance of an object which may be perceived immediately upon inspection of a picture thereof. In designs the appearance is the new thing which is to be secured by the patent. Words do not explain, but rather confuse, when added to the disclosure of the drawing. For this reason such descriptive material should be reduced to a minimum, or, better still entirely eliminated from design patent descriptions".

The Court of Appeals of the District of Columbia in considering this ruling on appeal[1] said that in the presence of the picture of a design a verbal description was generally useless and often confusing. In the decisions in the cases of ex parte Goldsmith[2], and ex parte Lloyd[3], the office required detailed descriptions of the design to be canceled, holding that Rule 82 was properly interpreted to mean that the description of the figures of the drawing required should be limited to a statement whether they were elevations, plans or perspectives.

In the case of ex parte Mygatt[4] the point in controversy was whether certain description of the design, a reflector, should be canceled. The Commissioner said the description related to the mechanical construction of the device and should be canceled. Upon appeal[5] the Court of Appeals of the District of Columbia considered the question of description in a design specification and claim and held that while in many cases the design was sufficiently disclosed in the drawing, the design under consideration and many others required a description.

The practice of the Office which for a while was decidedly against permitting a word description to be inserted

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1—Freeman, 109 O. G., 1339; 1904 C. D. 619.
2—110 O. G., 309; 1904 C. D. 152.
3—112 O. G., 251; 1904 C. D. 373.
4—117 O. G., 598; 1905 C. D. 243.
5—121 O. G., 1676; 1906 C. D. 596.

in the specification has been both approved[1] and condemed[2].

While it has never been held that a design patent was invalid because it did not contain a written description in addition to the drawing, and probably never will be unless the Supreme Court overrules its holding in Dobson v. Dornan,[3] it is clearly permissible and the right of the applicant, if he desires to exercise it, to have a written description in his patent.

The scope of design patents has often been limited by a lack of description and while in some classes of designs a description may be confusing and therefore undesirable, in many others it is necessary in order to protect adequately the right of the inventor. The subject matter must be considered in each case. A safe rule, it is believed, would be to resolve the doubt in close cases in favor of a description. If the design is a complex one and is a slight advance in the art, a description would probably be inadvisable; if, however, the design is broadly new and has prominent, distinguishing features, a description is desirable. It is not a question whether it is convenient for the Patent Office to permit a description of the design, but whether the inventor has set forth his invention in a form not prohibited by the law.[4]

38. Character of Description Permissible.—As appearance is the proper subject matter of a design, the description should relate clearly to that, and should not contain statements relative to the function of some of the parts

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1—Cheney Bros. v. Weinreb & Weinreb, 185 F. 531; 1910 C. D. 262; National Casket Co. v. New York & Brooklyn Casket Co., 185 F., 533.

2—Ashley v. Tatum, 186 F., 339; Phoenix Knitting Works v. Rich, 194 F., 708; Tompkins Co. v. New York Woven Wire Mattress Co., 159 F., 133.

3—118 U. S., 10.

4—New York Belting and Packing Co. v. The New Jersey Car Spring and Rubber Co., 53 F., 810; 62 O. G., 589; 1893 C. D. 172; Lunken, 76 O. G., 785; 1896 C. D. 22.

constituting the design[1]. In the case of ex parte L. W. Fairchild[2] the Commissioner of Patents said:—

"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."

If, however, the utility of features of a design may be considered in determining patentability, it is not clear why those features may not be described[3]. The character of the material of which the design is made and the color of the material are not elements to be considered in a design case and should not be described[4]; neither is size an element[5].

The Court of Appeals of the District of Columbia has recently disapproved the attempts to make the result or mechanical function of a device an element of the design[6]. In this case the applicant sought to have a claim setting forth results alleged to have been obtained by a certain character of structure.

39. Modifications and Variations.—There has been no more uniformity in the practice permitting or prohibiting a description of modifications or variations in designs than there has been in design practice in many other respects. The subject was considered in the Bartholomew case[7]. The Commissioner said it had been assumed that

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1—Diffenderfer, 1872 C. D., 154.
2—1873 C. D. 45. See also Norton, 22 O. G. 1205; 1882 C. D. 14.
3—Tournier, 94 O. G., 2166; 1901 C. D. 306; Sherman, 154 O. G., 839; 1910 C. D. 382.
4—Traitel, 25 O. G., 783; 1883 C. D. 92; Weinberg, 1871 C. D., 244; Post v. Richards Hardware Co., 26 F., 618; 35 O. G., 1226; 1886 C. D. 247.
5—Tyler v. St. Amand, 17 App. D. C. 464; 94 O. G. 1969; 1901 C. D. 301.
6—Mygatt, 39 App. D. C. 432; 188 O. G. 1055.
7—1869 C. D., 103.

the uniform practice of the Office had been to consider any variation however slight a new design, but that investigation showed this was not true, calling attention to the practice of granting patents for fonts of type, sets of silver plate, a series of miniature shoulder straps and a monagram which might be varied. The conclusion was that a patent might be granted for a new genus or class of ornaments and for species and varieties of the genus. This practice appears to have been questioned in ex parte Gerard[1].

These decisions were followed by others which directly held that it was improper to permit a description of variations or modifications in a design specification[2]. In the Finck case the Commissioner pointed out that the claim in a design patent covers the specific thing and that:—

"What range or scope a claim in a design patent has under this principle of law is a question to be determined by the courts and not by the Patent Office, and in view of this, it is thought not to be proper for the Office to permit the issue of a design patent which on its face purports to cover an indefinite variety of modifications which may or may not be within the proper scope of the claim, as that matter shall be determined by the courts."

The holding in these cases was overruled in the case of ex parte Bark[3], and it was then decided that modifications might be shown and described. This view was approved in ex parte Lunken[4]. In the Lunken case the view expressed was that variations might be described

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1—43 O. G., 1235; 1888 C. D. 37.

2—Hess & Hess, 56 O. G., 1334; 1891 C. D. 142; Petzold, 55 O. G., 1652; 1891 C. D. 97; 57 O. G. 1277; 1891 C. D. 207; Finck, 60 O. G., 157; 1892 C. D. 139.

3—69 O. G., 369; 1894 C. D. 108.

4—76 O. G. 785; 1896 C. D. 22.

if they did not destroy or change the unity of the design. This quotation shows the attitude of the Office:—

"Variations are covered by a design patent within the holding of the Court in Ripley v. Elson Glass Co. (60 O. G. 298; 49 F. 927) in the opinion of Mr. Justice Jackson. If the variations are within the scope of a design patent when the patent is before the court, it is presumed that the Office, to the extent of its jurisdiction, should apply the same. This would seem to be an additional safeguard to the patentee and the public alike."

The Office soon began to lean the other way and in a line of decisions finally reached the conclusion that no modification or variation should be described[1]. In some of these cases the statement is made that the doctrine of genus and species is not recognized in design cases[2].

40. Essential and Immaterial Features.—It is usual to say that a statement of what constitutes an essential and what an immaterial element in the description in a design specification is not permissible. What is meant by this rule however is not that these words may not in any case be used in a design specification, but that their use in such a manner that they will indicate that the structure shown in the drawing is not all a part of the design or is not necessary to constitute the design is objectionable. The words which are commonly used to point out certain

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1—Coe, 81 O. G., 2086; 1897 C. D. 187; Hill & Henner, 82 O. G. 1988; 1898 C. D. 38; Brand, 83 O. G., 747; 1898 C. D. 62; Jenks, 83 O. G. 1513; 1898 C. D. 81; Eldon, 83 O. G. 748; 1898 C. D. 63; Adams, 83 O. G. 1994; 1898 C. D. 109; Amberg, 84 O. G. 507; 1898 C. D. 117; Burdick, 97 O. G. 1373; 1901 C. D. 184; Freeman, 104 O. G., 1396; C. D. 172; Schrubstadter, 110 O. G., 2015; 1904 C. D. 229; Kurz, 113 O. G. 2215; 1904 C. D. 557; Remington, 114 O. G. 761; 1905 C. D. 28.

2—See also Wiessner, 85 O. G., 937; 1898 C. D. 236; Feder v. Poyet, 89 O. G., 1343; 1899 C. D. 218; Litle, 160 O G., 1272; 1910 C. D. 227.

features are "distinguishing," "important," "prominent," or similar words. That is, when it is considered undesirable to describe all the features or parts of a design in words, a description of those which the inventor regards as new with him may be set forth by pointing out those features with appropriate words of the kind indicated leaving it to be inferred that the other parts of the design not described are old in the art of decoration, but not that they are unnecessary to make up the design. In other words a design can not be a skeleton or a method of producing an ornamental object; it must be a complete structure, and if some of the parts necessary to produce such a structure are described as not a part of the design this rule relative to a complete structure would be violated.

In the case of ex parte Remington[1] it was ruled that a statement that certain parts of the structure were immaterial was not permitted. Although the statement made in ex parte Freeman[2] is somewhat different, it is apparently intended to convey the same idea.

In the case of ex parte Requa[3] the Patent Office required the applicant to remove from the drawing certain words and figures which were not essential to the design.

41. New Matter.—The rules relative to new matter that apply in mechanical applications govern in design cases. In a case reported in Gourick's digest[4] the question of new matter was considered. A claim containing what is regarded as new matter will be entered and rejected as such; the drawing will however not be entered for the reason that the old drawing could not be readily restored if it became necessary to cancel the new drawing and act on the original drawing filed.

1—114 O. G.; 761; 1905 C. D. 28.
2—104 O. G. 1396; 1903 C. D. 172.
3—60 O. G. 295; 1892 C. D. 148.
4—Furness, 15 Gour. 30-25; see also Furness, 104 O. G. 1655.

In a recent case the subject of new matter was considered and the proper practice was indicated[1].

42. The Claim.—The practice of the Patent Office since the decision in the case of ex parte Wiessner[2] rendered in 1898 has been to allow but one claim in a design patent. The former practice of the Office and the reasons for asking for the allowance of more than one claim are reviewed in this decision, and the conclusion reached that separate claims for the entire design and for segregable features should not be permitted in one application. These are some of the reasons for that conclusion:—

"If the separate claims do in fact cover the 'predominant and controlling features' which are in and of themselves suggestive of the design in its entirety, it is obvious that they cover exactly the same thing, in so far as the protection furnished is concerned, as the claim to the entire design. The claim to the entire design gives the patentee protection on and prevents others using the 'predominant and controlling features' embodied in any article which would be mistaken for that shown in the patent, and no more protection is furnished by an additional claim. The only object in permitting such additional claims seems to be merely as an expression of opinion as to the scope of the patent and is in effect merely a statement by the Office that in its opinion an article embodying the features set forth would so nearly resemble the patentee's design as to be mistaken therefor by the ordinary purchaser and would therefore be an infringement of the patent;

"This is not, in my opinion, proper practice. The

1—Miller 190 O G. 793.

2—85 O. G., 937; 1898 C. D. 236.

Office necessarily exercises judicial functions in determining whether the design is patentable over those already known in the art, but when that is done it has nothing to do with the question of infringement. It grants a patent on the thing which the applicant has invented and should then leave to the courts what things made thereafter would infringe the patent. This is the tenor of the recent decisions of the Office."

The Commissioner then points out that if the separate claims which it was at the time the practice of the Office to allow do not cover the "predominant and controlling features," the patent covers two or more independent designs, and reaches the conclusion above stated against the allowance of more than one claim.

Since this decision was rendered no record has been found of the direct issue between an applicant and the Office upon the question of a plurality of claims.

In the first design patent case, Root v. Ball & Davis[1], tried in 1846 the objection to the validity of the patent on the ground that it contained two claims, one for a stove and the other for particular parts of it, was not sustained.

In 1870 the Office held in the case of ex parte Sheppard[2] that two or more claims might be allowed. The Examiner in his statement said that it had not been the usual practice of the Office to allow more than one claim for the reason that a design was a complete, unitary structure, and that any departure from the exact form disclosed was a new design. The Commissioner found upon investigation that the Office had not consistently refused to grant more than a single claim, but had granted a plurality in a number of instances. He was of the opinion

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1—F. C., 12035.

2—1870 C. D., 22.

that claims might be allowed for a combination of novel features and for these features singly.

This subject was considered by the Supreme Court in the case of Dobson v. Carpet Co.,[1] and although there is no satisfactory determination of the question, it not being necessary to discuss it fully in order to decide the case, the Court said the patent was not invalid because it contained nineteen claims.

Mr. Simonds in his work argued that a plurality of claims was necessary to protect properly an inventor. He said:—

"Where a design contains features which are separate and distinct from the other features, there seems to be no good reason why a claim may not be made to each of such features. Suppose a design for the ornamentation of the surface of a circular plate to consist of three features, radial rays at the center, a wreath of flowers outside of this, and ornamental serrations at the periphery. It would seem absurd to compel the producer to take a patent for the design as a whole, thus permitting any one so disposed to use any two of these three features with impunity."[2]

The practice approved in Shepard of a plurality of claims was continued as indicated by several decisions[3], until the Wiessner decision was rendered.

In 1894 in the case of Britton v. White Mfg. Co.[4], it was expressly ruled that claims for the entire design and for its separate parts were properly allowed in a single

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1—114 U. S., 439.

2—Simonds, p 197.

3—Rogers & Huggins, 13 O. G., 556; 1878 C. D. 62; Beattie, 16 O. G., 267; 1879 C. D. 142; Petzold 61 O. G., 1789; 1892 C. D. 235; Britton et al v. White Mfg. Co. 61 F. 93; 79 O. G., 2195; 1897 C. D. 500; Coe, 81 O. G., 2086; 1879 C. D. 187.

4—61 F., 93.

patent. This ruling was apparently made in view of the decision in the case of Dobson v. Carpet Co.[1].

In New York Belting and Packing Co. v. New Jersey Car Spring and Rubber Co.[2] the two claims which defined the specific design made were held valid. No objection to the plurality of claims was found.

It was for a time the practice to grant generic and specific claims in design patents. This was the ruling in the Bartholomew case[3]. In this case the decision was that generic and specific claims might be granted in the same patent:—

"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, 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."

Mr. Simonds writing in 1874 thought it inadvisable to introduce generic claims into design cases[4], but the practice of allowing this class of claims apparently continued until 1888 when the decisions in the two cases of ex parte Gerard[5] were rendered. In the decision in the second case the Commissioner disapproved the requirement of the Examiner that a generic claim be presented, and decided that the relation of genus and species does not exist in design cases.

These decisions in the Gerard case however did not disapprove the practice of drawing claims for the whole

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1—114 U. S., 439.
2—137 U. S., 445.
3—1869 C. D., 103.
4—Simonds on Designs, p. 199.
5—43 O. G., 1235; 1888 C. D. 37.

design and for distinct and segregable parts of it. In the first Gerard decision[1] the following discussion of the character of the claims for segregable parts appears:—

"Claims for distinct 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 Court 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 cases."

Subsequent rulings of the Office are against the granting of patents containing generic and specific claims.[2]

Although there are several decisions indicationg the desire of the Patent Office at one time at least, not to permit a description of the design or its salient features in a claim[3], the ruling of the Court of Appeals of the District of Columbia in the case of in re Mygatt[4] settles the practice in favor of permitting a proper descriptive claim if such a claim is presented. The decision in this case points out that prior to 1897, at least, the suggested

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1—43 O. G., 1235; 1888 C. D. 37.

2—Coe 81 O. G., 2086; 1897 C. D. 187; Eldon 83 O. G., 748; 1898 C. D. 63; Jenks 83 O. G., 1513; 1898 C. D. 81; Feder v. Poyet 98 O. G,. 1343; 1899 C. D. 218; Schraubstadter 110 O. G., 2015; 1904 C. D. 229; Kurz 113 O. G., 2215; 1904 C. D. 557; Little, Jr., 160 O. G., 1227; 1910 C. D. 227.

3—Freeman 104 O. G., 1396; 1903 C. D. 172; Goldsmith 110 O. G., 309; 1904 C. D. 152; Mygatt 117 O. G., 589; 1905 C. D. 243.

4—121 O. G., 1676; 1906 C. D. 596.

forms provided for a claim which included a description of the design, and that although a claim was held by the Supreme Court as valid, notwithstanding it merely referred to a photographic illustration, it did not hold that a further description was not permissible. The court said that although the form suggested by the Patent Office rules for a claim in a design application did not include any description of the design that if this meant that no description was in any case permissible, the rules were probably in conflict with the statutes. The court thought the design before it, a reflector, was of the class in which a description of the salient features was not only advisable but necessary and concluded:—

"What is a full, clear, concise and exact description of a design depends upon what the design is. The same is true of the claim. What is a sufficient compliance with the statute which requires that a claim shall particularly and distinctly point out the invention, depends upon the character of the design."

Out of the conflict of rulings on the subject of design claims, this safe conclusion, it is believed, may be reached. Section 4888 revised statutes is applicable to design cases as well as to mechanical. Section 4933 makes it so. The former section requires an inventor to "particularly point out and distinctly claim" that which he has invented. If this can be done in a design case by showing the design in the drawing and referring to it in the claim, then words of description in the claim are not necessary. No design patent has ever been held invalid simply because of the absence of a word description in the claim. But if the design is not plainly shown by the drawing then the claim should contain a description of what applicant has invented; that is, the prominent, sailent, distinctive and essential features should be fully set forth

in the claim. There are some cases in which a word description would not aid in the understanding of the invention; but would be confusing[1]. In such cases the formal claim referring to the drawing should be used. It takes experience, skill and great care to know when to describe a design in words and when not to attempt this. In case of doubt it would apparently be the dictate of reason to resolve such doubt in favor of a description.

During the time the Patent Office showed a desire on the part of its officers to reduce to a minimum the length of the specification, a ruling was made that the preamble should be limited to the words, "I claim" and that other words were superfluous[2]. The words, "In testimony whereof, etc.," may, however, be used in a design patent[3]. The words "substantially as shown" may be used in a claim[4].

The words "design and form" in a design claim should be amended by cancelling "and form"[5].

The words "and described" should be used as a part of the claim if a description of the design is given.[6].

The claim should not in accordance with the ruling in the case of ex parte Remington[7] refer to the article claimed in the plural, but should be limited to the particular thing claimed.

43. Drawing.—A drawing is required in a design application of the same character as in an application for a mechanical invention[8]. It is good practice to show the

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1—Freeman 109 O. G., 1339; 1904 C. D. 619.

2—Weihman 118 O. G., 2252; 1905 C. D. 437.

3—Patent to Oderman, No. 42,249.

4—Owen, 195 O. G., 1049.

5—Kahn 116 O. G., 2008; 1905 C. D. 212.

6—Gerard 43 O. G., 1235 1888 C. D. 37; Voncanon 152 O. G., 487; 1910 C. D. 40.

7—114 O. G., 761; 1905 C. D. 28.

8—Rule 84, Rules of Practice.

article in one view at least in complete form; a perspective view is often the best.

Words and figures not forming an essential part of a design should not be placed on the drawing[1].

Although the decision in the case of ex parte Parker[2] requires the entire design to be illustrated, it does not mean that all the views shall show the entire article; one complete view only was in fact required in the Parker patent. The ruling in the Parker case has not been uniformly followed, and although in most designs it is best to show a complete picture of the article, in others, such a showing is not necessary. Patents for china plates and rubber tires have often been issued with only a part of the article shown in the drawing.

In the case of ex parte Adams[3] the question whether parts of a design may be shown in dotted lines and other parts in full lines was discussed. The conclusion reached in that case that they might be has not been uniformly followed, and was apparently intended to be overruled by the decision in ex parte Remington[4]. Whether it was or not, the practice however for some time has been to require the design to be shown on the drawing in full lines and to permit the article in connection with which the design is used to be disclosed in dotted lines. For instance in the patent to Reischmann[5] the foot rest for stools which is the subject of the patent is shown in full lines and the part to which it is attached in dotted lines. This is the practice notwithstanding the decision in the case of ex parte Burdick.[6]

1—Van Slyke Co. 60 O. G., 893; 1892 C. D. 175; Burdick 97 O. G., 1373; 1901 C. D. 184; Requa 60 O. G., 295; 1892 C. D. 148.

2—80 O. G., 1892; 1897 C. D. 73.

3—83 O. G., 1994; 1898 C. D. 109.

4—114 O. G., 761; 1905 C. D. 28.

5—No. 42,773.

6—97 O. G., 1373; 1910 C. D. 184.

The question has often arisen whether internal construction[1] may be shown in design cases by sectional views, and the practice for a long while under the decisions noted was not to permit sectional views. This practice was changed by the ruling in the case of ex parte Lohmann[2], and now sectional views may be shown provided they are not used for the express purpose of disclosing features of internal construction.

Such views often show a particularly prominent feature of external construction which could not be well shown by using any of the other well recognized views common to illustrations by pen and ink drawings.

Parts of a design which together form the design should not be separately illustrated is the ruling in the case of ex parte Mygatt[3]. Such views may be misleading and may not properly show the complete structure which has been invented. Neither are panoramic views permissible for the same reason.[4] Such views would not show the article as it would appear to the observer.

Whether a design which has appreciable extension in the third dimension may be sufficiently disclosed by a top and a bottom plan view, for instance, without a side elevation, has been the subject of some consideration mainly for the reason, it is believed, that the inventor desired a patent for a design which could be made in various shapes with the same ornamentation on all of them. Such a patent which did not show the shape of a glass shade, for instance, if valid, would give the applicant a monopoly in a short shade, a long shade, one with convex sides, sides with composite curves, and in-

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1—Feder v. Poyet 89 O. G., 1343; 1899 C. D. 218; Tucker 97 O. G., 187; 1901 C. D. 140; Colton 104 O. G., 1119; 1903 C. D. 156; Kohler 116 O. G., 596; 1905 C. D. 192.

2—184 O. G., 287; 1912 C. D. 336.

3—101 O. G., 661; 1902 C. D. 363.

4—Weilman 118 O. G., 2252; 1905 C. D. 437.

numerable other shapes. A disclosure showing two dimensions only was held not sufficient, on petition to the Commissioner[1]. In this case the Commissioner said that the contour of the article was an element of the design and that the invention claimed did not reside in surface ornamentation. If the invention resides in surface ornamentation, such a question as arose in this case need not arise in view of the ruling in the Fulda case[2].

There appears to be no objection to interior views, if the inside of the design is ornamental. The ruling in ex parte Tucker[3] and ex parte Colton[4] are not interpreted to prohibit such views. The inside of a box may be the only ornamental feature of it. Many design patents for lockets showing the interior decorations have recently been issued.[5]

A figure illustrating graphically the optical effect produced by a design will not be permitted.[6]

44. The Original Drawing—Changes or Additions.—Whether a drawing presented after the application has been filed discloses new matter will not be considered on petition; this question is appealable as it involves the merits of the design.[7]

45. Oath.—Section 4887 of the revised statutes provides that if an application for a design patent which has been granted was filed in a foreign country more than four months prior to the filing of the application in this country no patent shall be issued here. The time within

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1—Mygatt 171 O. G., 1257; 1911 C. D. 186.
2—194 O. G., 549.
3—97 O. G., 187; 1901 C. D. 140.
4—104 O. G., 1119; 1903 C. D. 156.
5—Design patents Nos. 44,524 and 44,525.
6—Walsh, 13; Gour., 22-20; (April 1901).
7—Miller 190 O. G., 793. See also Sec. 40.

which an application for a mechanical patent under similar circumstances may be filed is twelve months. The oath therefore in a design case should contain the statement that the design has not been patented in a foreign country on an application filed more than four months prior to this application.

The oath in design cases in other respects conforms very closely to the oath required in other cases.

46. Changing Mechanical to Design Application, or Vice Versa.—Commissioner Fisher in 1870 held that an application for a mechanical invention which was found not to be allowable could not be changed to an application for a design. Not to make an application for the proper kind of protection was in his opinion a mistake which the Commissioner had no authority to rectify. The subject matter which could properly be protected under the design laws was as entirely different from that which was protected under the laws relating to the other class of inventions as copyright was different from either. He therefore ruled in the case of ex parte Sellers[1] that after an application for a mechanical patent had been refused it would not be changed to an application for a design. A later request to have a design application changed to a mechanical application was denied[2]. The Commissioner thought it would be good practice for the application clerk, if he found that the wrong kind of application had been filed, to notify the applicant in order that he might have an opportunity to correct his error.

A mechanical patent may not be construed to be a patent for a design[3].

If the Office makes a mistake in the designation of the character of application filed or if the applicant is mis-

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1—1870 C. D., 58.
2—Bailey, 37 O. G., 781; 1886 C. D. 39.
3—Cone v. Morgan Envelope Co., 4 Bann. & Ard., 107.

lead by any suggestion of the Office, the mistake will be rectified, and the wish of the applicant as to the character of patent desired will be complied with[1].

47. **Mechanical and Design Applications Showing Same Structure.**—It is obvious that double protection may not be obtained by securing a design patent and a mechanical patent for the same subject matter[2]. A design which was shown in a mechanical patent could not, under the Act of 1861, which did not give the inventor the right to make application within two years after public use or sale, as the statute now does, be subsequently patented[3]. The same was held under the Act of 1870.[4] In the case of Burton v. The Town of Greenville,[5] the Court asked the question whether the inventor is to be presumed to have abandoned his design if he discloses it in the drawings of his mechanical patent, but did not answer it directly, a decision on this point not being necessary. It did say, however, that no reason appeared why this should be regarded as true until the design had been in use two years.

In the case of ex parte Palmer[6] this question is discussed:—

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

The previous decisions on the subject are reviewed and the conclusion reached that it is immaterial which kind of a patent the inventor first obtains. He may

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1—Hartje, 95 O. G., 2485; 1901 C. D. 56; Saunders Jr., 131 O. G., 1164; 1907 C. D. 363.
2—H. W. Collender, 1872 C. D., 217.
3—Stuart & Bridge, 1870 C. D., 15.
4—Kohler, 1873 C. D., 84.
5—3 F., 642; 1880 C. D. 602.
6—21 O. G., 1111; 1882 C. D. 5.

subsequently secure the other kind. In the case of ex parte Schulze-Berge[1] the Commissioner made this reference to the former decisions:—"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." In the case of ex parte Lunken[2] the ruling was made that the grant of a mechanical patent did not prevent the issue of a design patent to the same applicant for a valve casing although substantially the same casing was shown in the mechanical patent that was claimed in the design application, both applications having been filed within eleven days of each other. It was pointed out that the grant of the design patent for fourteen years would not extend the monolopy beyond the term of the mechanical patent which had been granted about three years before the design was held allowable on appeal.

The decision in the case of Carey Mfg. Co. v. Neal et al[3] rendered in 1898 holds that a design patent may not be issued for a structure shown and not claimed in a mechanical patent issued more than two years before the application for the design patent was filed. The Court said:—

"It is said that the inventor of a machine or manufacture may have a patent for the thing, and another for the design of the thing. This may be true; but the description of the thing would show the design, and an inventor can not have a valid patent applied for two years later for what is described in a prior patent to himself, any more than in one to another. Campbell v. Jones 104 U. S., 356. What is in that patent may limit the right, therefore, to a valid patent for what is in this."

1—42 O. G., 293; 1888 C. D. 4.
2—76 O. G., 785; 1896 C. D. 22.
3—90 F. 725.

In a case decided soon after that case was decided it was held that a design patent was not invalid although the court found that the design was shown in a mechanical patent issued more than six months before the design application was filed[1].

The grant of a design patent covering the form of an article does not prevent the issue of a functional patent to the same inventor[2]. In the case of ex parte Jones[3] the Commissioner ruled that a design patent covering the shape or configuration of an article was not a bar to the issue of a mechanical patent covering the structure of the device although the figures of the drawing of the mechanical application were fac-similes of the figures shown in the design patent. This decision was later held not to mean that a design patent may not under certain conditions be a reference against an application for a mechanical structure[4]. What those conditions are was not pointed out.

48. Division of Application.—There is one decision of the Patent Office to the effect that a mechanical application is not a proper division of an earlier design application[5]. The fundamental principle governing divisional applications requires this practice. The filing of an allowable design application is not a constructive reduction to practice of the mechanical structure which the inventor would desire to claim in his division of his design application.

The principles enunciated in this case are approved in the case of McArthur v. Gilbert[6].

1—Flomerfelt v. Newwitter, 85 O. G., 458; 1898 C. D. 562.
2—W. N. Bartholomew, 1871 C. D., 298; H. W. Collender, 1872 C. D., 217; Collender v. Griffith, 2 F., 206; 18 O. G., 241; 1880 C. D., 578; ex parte Gerard, 43 O. G., 1235; 1888 C. D. 37.
3—84 O. G., 1281; 1898 C. D. 155.
4—McQueen, 85 O. G., 609; 1898 C. D. 227.
5—Waterman, 100 O. G., 233; 1902 C. D. 235.
6—110 O. G., 2509; 1904 C. D. 245.

49. Re-issue.—The practice of the Patent Office is to reissue design patents under the same conditions as mechanical patents.[1]

50. Terms of Design Patents.—The terms for which design patents may be issued are fixed by statute at three and one half years, seven years and fourteen years, at the election of the applicant. Until the recent decision in the case of in re Forward[2], it was the practice to require the applicant to elect for what term he desired his patent at the time he filed his application. This decision permits the applicant to change from the shortest term to either of the longer terms.

51. Fees.—The fees in a design case must be paid in full, at the time the application is filed and are ten dollars for a three and one half year patent, fifteen dollars for a seven year patent, and thirty dollars for a patent for fourteen years. If the term is changed from one of the shorter terms to one of the longer in accordance with the ruling in the case of in re Forward,[3] the balance of the fee for the longer term may be paid at the time the request is made.

There is no authority of law to return a fee paid in a design application after the application has been found not to be allowable[4], nor apparently at any time after filing unless clearly paid by mistake.[5]

52. Rules and Regulations for Mechanical Applicable to Design Patent Applications.—Section 4933 of the re-

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1—Fenton p 58; Re-issued design patents to Snow, No. 11771 and to Buerman No. 10321.

2—196 O. G., 275.

3—196 O. G., 275.

4—Flomerfelt, 73 O. G., 1411; 1895 C. D. 101;; Busky, 98 O. G. 2588; 1902 C. D. 111.

5—Sec. 4936, R. S.

vised statutes makes all provisions and regulations of law not inconsistent with the statutes particularly relating to designs applicable to such inventions[1]. It follows from this provision of law that the rules which apply to mechanical applications apply with equal force to design applications if not inconsistent with the design laws and rules based specially on those particular laws.[2]

The doctrine of experimental use has been held however not applicable to designs[3]. The reasons for permitting experimental use of a mechanical invention do not apply. In the Tournier case the Commissioner said:—

"The production of the design is what corresponds to the reduction to practice of a mechanical invention, and any subsequent use of it in public is not experimental use, but is public use."

53. Form of Application.—The form of application given in the Rules of Practice of the Patent Office[4], is as follows:—

Petition for Letters Patent for a Design:

To the Commissioner of Patents:

Your petitioner, ..., a citizen of the United States and a resident of ....., in the county of ..... and State of ..... (or subject, etc.), whose post-office address is ...., prays that letters patent may be granted to him for the term of three and one-half years (or seven years or fourteen years) for the new and original

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1—Theberath v. The Rubber & Celluloid Harness Trimming Co., 15 F., 246; 23 O. G., 1121; 1883 C. D. 205.

2—Gerard, 43 O. G., 1235; 1888 C. D. 37; Bettendorf, 184 O. G., 801; 1912 C. D. 353.

3—Tournier, 90 O. G., 1948; 1900 C. D. 37.

4—Edition of July 17, 1907, Eighth reprint of May 1, 1913.

design for ....., set forth in the annexed specification.

Signed at ....., in the county of ..... and State of ....., this ..... day of ....., 19.....

.....

Specification.

To all whom it may concern:

Be it known that I, ..., a citizen of the United States, residing at ....., in the county of ....., and State of ..... (or subject, etc.), have invented a new, original, and ornamental Design for Watch-Cases, of which the following is a specification, reference being had to the accompanying drawing, forming part thereof.

The figure is a plan view of a watch case, showing my new design.

I claim:

The ornamental design for a watch case, as shown.

.....

Witnesses:

. .....

.....

The words "and described" should be included in the claim if the specification contains a description of features of the design.[1]

1—Voncanon, 152 O. G., 487; 1910 C. D. 40.

Oath.

..... } ss:—
.....

[1]......, the above-named petitioner...., being sworn (or affirmed), depose.... and say.... that ..... citizen.... of[2] ..... and resident.... of[3] ....., that ..... verily believe ..... to be the original, first, and [4]..... inventor of the design for [5]..... described and claimed in the annexed specification; that ..... do.... not know and do.... not believe that the same was ever known or used before ..... invention thereof, or patented or described in any printed publication in any country before ..... invention thereof, or more than two years prior to this application, or in public use or on sale in the United States for more than two years prior to this application; that said design has not been patented in any country foreign to the United States on an application filed by ..... or ..... legal representatives or assigns more than four months prior to this application; and that no application for patent on said design has been filed by ..... or ..... representatives

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1—If the inventor be dead, the oath will be made by the administrator; if insane, by the guardian, conservator, or legal representative. In either case the affiant will declare his belief that the party named as inventor was the original and first inventor.

2—If the applicant be an alien, state of what foreign country he is a citizen or subject.

3—Give residence address in full; as "a resident of ....., in the county of ..... and State of .....," or "of No. ..... street, in the city of ....., county of ..... and State (Kingdom, Republic, or Empire) of ....."

4—"Sole" or "joint."

5—Insert title of invention.

or assigns in any country foreign to the United States, except as follows:[1] .....

Inventor's full name:[2] .....
.....

Sworn to and subscribed before me this ..... day of ....., 19....

[SEAL.]

[3] .....
[Signature of justice or notary.]

.....
[Official character.]

This form of specification may of course be changed if a description of the features of the design is desired. The claim may be altered to describe what is claimed as the important features of the invention.

1—Name each country in which an application has been filed, and in each case give date of filing the same. If no application has been filed, erase the words "except as follows."

2—All oaths must bear the signature of the affiant.

3—* * * "When the person before whom the oath or affirmation is made is not provided with a seal, his official character shall be established by competent evidence, as by a certificate from a clerk of a court of record or other proper officer having a seal."

A certificate of the official character of a magistrate, stating date of appointment and term of office, may be filed in the Patent Office, which will obviate the necessity of separate certificates in individual cases.

When the oath is taken abroad before a notary public, judge, or magistrate, his authority should in each instance be proved by a certificate of a diplomatic or consular officer of the United States.

54. Marking a Design "Patented".—The sections of the revised statutes[1] requiring patentees to give notice to the public that their articles have been patented apply to patentees of designs. The form of notice prescribed by the statute which consists of the word "patented" and the day and year the patent was granted, does not enable the public to determine whether the article is protected by a design patent or the other character of patent. If the notice required the number of the patent to be given, this could be determined, for the highest number of design patents now issued is in the forty-five thousands, whereas the other character of patents now receive a number beyond the million mark and all such patents bearing the number 45000 have long expired. The public is therefore not informed by the prescribed notice whether an article is protected by a design or a mechanical patent.

If the marking of a design in accordance with the statutory provision is omitted, the burden of proof is on the plaintiff to show that the defendant has had proper notice of the fact that the design is patented.[2]

1—Sections 4900 and 4901.
2—Schofield v. Dunlop, 42 F. 323; 52 O. G. 1369; 1890 C. D. 449.

Chapter VI.

PROCEDURE IN THE PATENT OFFICE.

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55. Examination.—The general rules for the examination of other applications to determine if the application is formal apply to design applications.

Design patents have not been reclassified by the classification division of the Office. They are now classified in the following classes arranged alphabetically:

DESIGNS.

Advertising
Aeration and Bottling
Apparel
Baths and Closets
Beds
Book Binding
Boots and Shoes
Bread, Crackers and Lozenges
Brushing and Scrubbing
Builders' Hardware
Butchering
Care of Live Stock
Carpentry
Carriages and Wagons
Chairs
Chemicals and Medicines
Clasps and Buckles
Clay and Pottery
Coffins
Confectionery
Crinoline and Corsets
Curtain Fixtures
Cutlery
Dairy Appliances
Dentistry
Educational Appliances
Electricity
Felting and Hats
Fences and Gates
Fine Arts
Fire-Arms, Shields, and Targets
Fishing and Trapping
Fuel
Furniture
Games and Toys
Garden and Orchard
Grinding and Polishing
Glass
Harness
Harrows and Diggers

Harvesters
Hoisting
Horology
Hose and Belting
Household Articles
Jewelry
Journals and Bearings
Knitting and Netting
Lamps and Gas Fixtures
Laundry Appliances
Locks and Latches
Masonry
Measuring Instruments
Mechanical Powers
Metal Working
Mills and Machinery
Musical Instruments
Optical Instruments
Packing and Storing Vessels
Paper Manufactures
Paving
Photography and Appliances
Plows
Pneumatics
Presses
Printing
Pumps
Railway Cars
Refrigeration
Roofing
Safes
Sewing Machines
Ships and Boats
Signals
Soap and Candles
Stationery
Steam Vacuum Pumps
Steam Boilers
Steam Engines
Steam Valves
Stone Working
Store Furniture
Stoves and Furnaces
Surgery
Threshing
Tobacco
Toilet
Trunks and Equipments
Umbrellas and Fans
Vegetable Cutters and Crushers
Velocipedes
Wheels and Tires
Weaving Fabrics
Wood Working

In determining whether a design is anticipated a search is made of the design patents classified in one of the classes to which the design belongs specified above, and in other classes in which experience has shown that the device may probably be found. The patents classified in

mechanical divisions which are of the same general nature as the applicant's device are also examined. A large part of the "search" in design applications is made through catalogues filed in the Office.

The protection given in most foreign countries to the invention or creation which in this country is subject matter for the issue of a design patent is of a different character from that given under our laws. None of these certificates of registration or other forms of grant are filed with the copies of our design patents, and foreign patents except those which are filed in the mechanical divisions of the Patent Office are rarely searched in making an examination of a design patent application.

As the doctrine of analogous art is not recognized in design patents the search for references may be made without regard to the art to which the particular design application relates. To make a preliminary search or a search on an application is therefore a matter of much diffienlty.

Final action by the Patent Office on an application for a design cannot be prevented by a change in the description of the design or in the form of the claim, for patentability depends upon the appearance of the design as an entirety, and not on the form of the claim.[1]

56. Interference.—An interference is now declared by the Patent Office only between design applications or between design applications and design patents, not as formerly between a design application and a mechanical patent or a mechanical application and a design patent.[2]

The general rules of pleading and practice applicable to interferences in mechanical cases are followed in design

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1—Hanson, 103 O. G., 1417; 1903 C. D. 284; Segelhorst, 109 O. G., 1887; 1904 C. D. 125; Kurz, 113 O. G., 2215; 1904 C. D. 557.

2—Collender v. Griffith, 3 O. G., 91; 1873 C. D. 14; 3 O. G., 267; 1873 C. D. 43; McArthur v. Gilbert, 110 O. G., 2509; 1904 C. D. 245.

interferences, and the same general tests, of course, apply in determining the presence of interferring subject matter as in deciding novelty or infringement.

If the claims in the applications or the patents involved are the conventional claims for the design as shown and described, the issue will be interpreted by a consideration of the description and drawings.[1]

As experimental use of a design is not necessary to determine its value a design is reduced to practice when it has been completely produced[2]. This is true for the reason that it is not necessary for a design to be "useful" in the sense the word is used in section 4886 of the revised statutes.

An applicant who has disclosed his design in his application for a mechanical patent is not entitled to be the senior party if another has filed a design application before the former has filed an application for his design disclosed in his mechanical application[3]. The filing of the mechanical application is not a constructive reduction to practice of the design invention. In such a case however the mechanical application may be relied upon to show prior conception.

57. Petitions and Appeals.—The general rules governing petitions[4] and appeals[5] apply to design applications.

An objection by the exainmer that an alleged invention shown in a mechanical application was proper subject matter for a design application was held to amount to a rejection of the application[6]. The objection of the examiner that the claims in a design application did not

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1—Feder v. Poyet, 89 O. G., 1343; 1889 C. D. 218.

2—Tournier, 90 O. G., 1948; 1900 C. D. 37; Tyler v. St. Amand, 94 O. G., 1969; 1901 C. D. 301.

3—McArthur v. Gilbert, 110 O. G., 2509; 1904 C. D. 245.

4—Rule 145.

5—Rule 135 et sq.

6—Schulze-Berge, 42 O. G., 293; 1888 C. D. 4.

set forth proper subject matter for a design patent should have been a rejection, and a petition from such objection will not lie[1]. The requirement that an applicant set up a single definite article of manufacture relates to the merits and will not be considered on appeal.[2]

The question whether certain description in the specification should be canceled may be considered on petition[3]. In a later decision the requirement that the specification be revised was held not a proper subject for petition[4]. In this case however the claim had been rejected and a patent refused on the ground that the specification was not of that character required by the statutes. Whether a change in the drawing involves new matter will not be determined on petition[5]. This question relates to the merits. A petition that the drawing be amended was held to have been properly filed and a ruling on the subject was made.[6]

1—Bishop, 63 O. G., 153; 1893 C. D. 48; Adams, 84 O. G., 311; 1898 C. D. 115; Groves, 89 O. G., 1671; 1899 C. D. 226.

2—Sherman v. Harms, 89 O. G., 2067; 1899 C. D. 240.

3—Mygatt, 117 O. G. 598; 1905 C. D. 243; 118 O. G., 1685; 1905 C. D. 409; 190 O. G., 1029.

4—Goldsoll, 189 O. G., 523.

5—Miller, 190 O. G., 793.

6—Mygatt, 171 O. G., 1257; 1911 C. D. 186.

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3-2-11

SUPPLEMENT No. 1

TO

SYMONS

ON

"THE LAW OF PATENTS FOR DESIGNS"

BY

THE AUTHOR OF THAT VOLUME

A Review of all Decisions and Patent Office Rules
Published on this Subject from the Date of
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THE TABLE OF CONTENTS OF THE VOLUME WHICH WAS PUBLISHED IN MARCH, 1914, IS GIVEN BELOW. SOME OF THE PRESS NOTICES WHICH IT HAS RECEIVED APPEAR ON PAGES 7 - 8. A BLANK ON WHICH THIS VOLUME MAY BE ORDERED IS A PART OF PAGE 8.

THE LAW OF PATENTS FOR DESIGNS

With Particular Reference to the Practice Which Obtains in the Prosecution of Applications for Design Patents in the United States Patent Office as Shown by the Rules and Decisions.

BY

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Examiner, United States Patent Office.

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SUPPLEMENT NUMBER 1.

(January 1, 1914, to October 1, 1915).

Amendment to Rule 80, Rules of Practice, 200 O. G., 1.

On Feb. 21, 1914, Rule 80 was amended by adding the following paragraph:—

"Where the applicant requests that the patent issue for one of the shorter terms, he may at any time before the allowance of the application, upon the payment of the additional fee, amend his application by requesting that the patent be issued for a longer term."

Ex Parte Sanford, 204 O. G., 1346 (Commissioner of Patents).

The applicant in this case had been refused a design patent on a pitcher top on the ground that the top was a part of a pitcher on which a patent had been issued to him. The Commissioner held that inasmuch as the applicant could not include in one patent the pitcher top alone, and the pitcher including the top, he could, following the analogy in the well established practice relating to mechanical cases as set forth in ex parte Mullen and Mullen (1890 C. D., 9, 3d case), obtain a patent on the top alone, application for it having been filed without undue delay.

Ex Parte Klemm and Schreiber, 218 O. G., 603 (First Assistant Commissioner of Patents).

This is a decision on a petition involving the question whether a design patent should be granted for a chair which has relatively movable parts. The Commissioner held that a design patent should not be refused simply because a device has moving parts.

Rose Mfg. Co. v. E. A. Whitehouse Mfg. Co., et al., 208 F., 564 (C. C. A., 3d Cir.).

The holding of the district court that two design patents to Rosenbluth (Nos. 41,388 and 41,389) were invalid because for mechanical and functional features of a vehicle number plate support and not for an ornamental design, was affirmed.

Dominick & Hall v. R. Wallace & Sons Mfg. Co., 209 F., 223 (C. C. A., 2d Cir.).

The validity of three patents for designs for spoons and forks was sustained. The court thought it made no difference that the outline of the handle separately was old and that handles of other shapes had grooves or ridges extending along the edges; the features in combination were new.

The defense that the complainant's goods were made of sterling silver and the defendant's only in plated ware was not good. The infringement was aggravated by this.

Bush & Lane Piano Co. v. Becker Bros., 209 F., 233 (D. C., N. Y.).

This was a suit for infringement of a design patent for a piano case (No. 37,501, July 25, 1905, Walter Lane).

A written description of the invention was held to be wholly unnecessary; the drawing clearly representing the piano was sufficient, citing Dobson v. Dornan, 118 U. S., 10.

It was pointed out that a design patent must involve invention, but that invention is not negatived by combined features that were separately old in other articles of the same class.

Infringement of a design is established if the defendant's device imparts to the mind the same general idea of ornamentation as does the complainant's.

Mygatt, et al., v. Schaffer, 218 F., 827 (C. C. A., 2d Cir.).

This suit involved two designs for glass reflectors for which patents were granted to Otis A. Mygatt (Nos. 37,967, and 40,182).

Glass reflectors which have a useful mechanical function and which make a pleasing impression on the eye were held to be proper subject matter for a design patent. The court pointed out that, "It is a mistake to assume that a patent for a design applies only to certain ornamentation upon an article of manufacture, and that it cannot properly apply to the article of manufacture itself as that article of manufacture is designed and produced." The present design statute permits the grant of a patent for an ornamental shape or configuration of an article of manufacture.

The defense that one of the patents on which suit was brought was anticipated by an earlier patent to the same inventor was held not to have been made out. The court said that a different effect upon the eye was produced by the two shades.

The charge of infringement was held to have been completely sustained, although the defendant's design was not a "Chinese" copy of the complainant's.

In this decision, however, the other patent sued upon was held invalid on an earlier issued patent to the same inventor. This relieved the defendant of the charge of infringement as suit was not brought on the earlier patent. This part of the decision touches upon an important problem for design inventors. They may not show modifications in a design application, but if they secure more than one patent on substantially the same design, they run the risk of having the later held invalid on the earlier.

Ashley, et al., v. Weeks-Numan Co., 220 F., 899 (C. C. A., 2d Cir.).

This suit was for infringement of the patent for an inkstand granted to Frank M. Ashley, January 9, 1912, No. 42,077. The defendants' design is shown in patent No. 41,846. The defenses were invalidity of the Ashley patent because (1) it was for a mechanical function, and (2) because it was anticipated.

The court held both defenses bad and stated as it had formerly done in Mygatt v. Schaffer, supra, that a design patent may be granted for a new and original shape given to an article of manufacture as well as for an ornamentation to be placed upon an article, and that the appearance was none the less patentable although a mechanical function was involved.

The proper test by which to determine infringement, the court said, was given in the case of Gorham v. White, 14 Wall., 511. After pointing out that the validity of design patents had been sustained when they contained no written description of the invention, the court said relative to the patent sued upon:—

> "The patentee having a patent with written specifications relating to an entirely new form of inkstand, he is entitled, not only to the exact design shown in his drawing of the patent, but also to the protection of the court against the making and marketing of inkstands which contain the dominant features of the design described in the specification."

The applications for the patents in suit were copending in the Patent Office without an interference being declared. This the court thought was of little importance, as it was well known that the Patent Office is not particularly concerned with the question of infringement.

The recovery of damages was limited to the time subsequent to the filing of the bill.

Baker & Bennett Co. v. N. D. Cass Co., et al., 220 F., 918 (C. C. A., 2d Cir.).

A patent for an ornamental set of character blocks was held invalid as not involving invention, it having been shown that it was old to make similar letters and figures which were used in the manufacture of signs.

Grelle, et al., v. City of Eugene, Ore., et al,. 221 F., 68 (C. C. A., 9th Cir.).

A design patent for a lamp post was held valid although various parts were not new. The court stated the well known doctrine in design cases to the effect that although the elements of the design are old, invention may reside in the manner in which they are assembled.

In this decision is given a long list of cases in which the rule laid down by the United States Supreme Court in the case of Gorham v. White (14 Wall., 511), for determining the identity of designs has been uniformly followed.

Bush & Lane Piano Co. v. Becker Bros., 222 F., 902 (C. C. A., 2d Cir.).

The Circuit Court of Appeals agreed with the District Court that the patent for a piano case owned by the complainant was valid and infringed. This holding as to the validity of the complainant's patent was made, although the court thought the casual observer would hardly be able to distinguish the patented design from some of the designs shown in the prior art. There were, however, some characteristic features of the design which distinguished it from the prior art.

The District Court had awarded to the complainants the profits from the sales of the defendant's pianos and not the profits on the piano cases alone. This was held to be error as the patent was for a piano case and not for a piano. One of the three judges dissented from this view and said the value of a design patent was as a seller of the article to which it was applied.

PRESS NOTICES

The rapidly increasing importance of the subject of design patents requires that more attention and thought be directed to that branch of law and Patent Office practice confessedly not yet well settled and understood. The need for a treatise in which the provisions of the statutes, regulating the issuance of design patents and the subsequent enforcement of the rights acquired under them, are analyzed and considered in the light of Court and Patent Office decisions, has been supplied by the author. There can be little doubt but that "Patents for Designs" will meet with favor at once, and that it will be of inestimable value to all interested in its subject matter.—**Scientific American,** June 6, 1914.

A new Treatise on the Law of Patents for Designs, by William L. Symons, has just been issued by the publishing house of John Byrne & Co., of Washington, D. C. In the very interesting preface, the author has fully shown the necessity for a new work on this subject. It is the first complete treatise to be issued since the year 1889, since which time, of course, this branch of the law has progressed in common with other branches.

The text is succinct and always to the point, and every statement made by the author is supported by references to decisions set forth as footnotes. The arrangement of the work is such that where there has been a recent modification of earlier decisions, the same are specifically pointed out with references, and the later doctrine, or the present state of the law, is clearly shown.

This work is one that we can recommend to anybody interested in the subject matter as an aid and a guide along the right path of procedure and practice.—**Trade Mark Record,** June 1, 1914.

This handy little book, which is published by John Byrne & Co., of Washington, D. C., deals in a most lucid manner with the practice relating to designs in the United States of America. This book undoubtedly fills a long-felt want, and is sure to prove of great service to inventors and attorneys both in this country and in the country of its origin, in so much as there have been all too few books published in the United States dealing with the subject in question.

Owing to the originality displayed in the compilation of this book, and the lucid manner in which each section of the Act is discussed, we can highly recommend it to both inventors and attorneys alike.—**Patents & British Machinist,** July, 1914.

"Patents for Designs" is well written and endeavors to untangle the mazes of legal intricacy which surrounds our inventors in securing patents on designs, and anything else, for that matter. It at least is particularly clear in telling us what we cannot do, and in that way may save the rash inventor from rushing in blindly where angels fear to tread. There will never be a patent book written which will hold itself at its true value until the entire patent department of our country has been reconstructed along sane and basic lines. The whole subject is reviewed quite carefully in six chapters with numerous subheadings, and to those interested in design patents we can recommend this book as being devoid of the intricate language in the general treatment of such subjects.—**The Brass World,** May, 1914.

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The timeliness of a work on the law of patents for designs having "particular reference to the practice which obtains in the prosecution of applications for design patents in the United States Patent Office as shown by the rules and decisions," will be obvious in consideration of the efforts now being put forth by the National Registration League for the Protection of Commercial Designs by Registration. The book bearing the title which heads this article has been issued by John Byrne & Company, Washington, D. C., and the author, William L. Symons, LL.M., member of the bar of the District of Columbia, lecturer on the law of trade-marks and patents for designs in the Washington College of Law, and examiner for the United States Patent Office, certainly bring a sufficiency of knowledge and experience to the subject to illuminate it satisfactorily. In arrangement the book is admirably suited for reference and citation.—**Inland Stationer,** July, 1914.

This small volume will prove a suitable addition to every business man's library, inasmuch as it gives a summary of the statutes covering the general subject of designs from the first design patent act through the various subsequent acts to the present date, as well as a brief treatise on the subject matter for design patents, what constitutes novelty and infringement, and detailed information as to how applications should be made and the procedure of the Patent Office. The work is rich in facts, arranged in a form that can be appreciated by the busy man and can be easily gotten at from the complete index in the back.

The work will answer practically all the questions which come up to the merchant and manufacturer in regard to design patents quickly and effectively, and it will serve to straighten out the confusion and doubt which often exist as to what is the proper subject matter for a design patent, while showing clearly what should be the practice employed. It will assist in determining the questions of law and procedure which are still unsettled by bringing together for consideration the conflicting views and decisions. It will be even more valuable to the lawyer than to the business man, but for the latter it is practically the only work on the subject which will meet his demand for information on these lines in a way that he wants to get it.—**Jewelers' Weekly,** April 29, 1914.

JOHN BYRNE & CO.,
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SUPPLEMENT No. 2

TO

SYMONS
ON
"THE LAW OF PATENTS FOR DESIGNS"

BY

THE AUTHOR OF THAT VOLUME

A Review of all Decisions and Patent Office Rules Published on this Subject from October 1, 1915, to October 1, 1916.

JOHN BYRNE & COMPANY
Publishers of Law Books
715 14th Street Washington, D. C.

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SUPPLEMENT NUMBER 2.

(October 1, 1915, to October 1, 1916.)

Denton, et al., v. Fulda, 225 F., 537 (C. C. A., 2d Cir.).

The design patent upon which suit was brought, No. 39,413, and which was held void, was for a locket consisting of a butterfly with upfolded wings mounted on an ornamental field or background. The court said there was nothing novel about a butterfly with folded wings or wings in any other condition, and that no invention was involved in placing such an insect upon a pendant, for "to hold otherwise will permit those who select a different design for a pendant, such, for instance, as a shell, a flower, or a bird, to obtain a patent in each instance. Nothing patentably novel is produced by placing such objects in new environments."

Byers v. F. T. Pearce Co., 228 F., 720 (D. C., R. I.).

In this case a design patent for a pen or pencil clip (Byers, No. 45,102) in which the distinguishing feature of the design was a serpent coiled around a pencil with the head forming the clip and the tail having a peculiar twist, was held not infringed by the defendant's design in view of the prior art, and that if the patent was liberally interpreted to cover the defendant's design, it was void on the ground that a similar design used by the defendant was of earlier date than the design of the patent in suit.

Tubular Rivet & Stud Co. v. Standard Finding Co., Inc., 231 F., 170 (C. C. A., 1st Cir.).

The patent sued upon (Bray, No. 39,201) for a lacing hook was held invalid on the ground of lack of invention. The court said that the adaptation by Bray of the oval shape to the head of a lacing hook did not involve more than ordinary mechanical skill. It was further decided that although the evidence showed that the design had met with commercial success, this fact was not sufficient to resolve any doubt in favor of the validity of the patent.

Steffens, et al., v. Steiner, et al. (ten cases), 232 F., 862 (C. C. A., 2d Cir.).

Suit was brought upon ten design patents for cigar bands. As to seven of the patents the bills were dismissed by the

district court on the ground the design did not involve invention, and no appeal was taken. As to three, infringement was found, and an injunction was directed by the district court. The Circuit Court of Appeals found as to the three patents held valid by the district court that the slight variation of the old elements of prior cigar bands made by the patentee did not amount to invention, and held the patents void.

President Suspender Co. v. MacWilliam, 233 F., 433 (D. C., N. Y.).

A mechanical patent for a garment supporter was held invalid on a design patent issued seven months before application was made for the mechanical patent on the ground that no invention was involved in the mechanical patent over the design patent.

Bush & Lane Piano Co. v. Becker Bros., 234 F., 79 (C. C. A., 1st Cir.).

The court held, with one judge dissenting, that the profits allowed the complainant under the Act of February 4, 1887, on the design infringed should bear the same relation to the entire profits made by the defendant as the cost of the manufacture of the case, the design patent being for a piano case (No. 37,501), bore to the cost of the complete piano.

In the dissenting opinion, the judge said that it seemed to him the logical result of the rule laid down by the majority should be that the complainant recover all the defendant's profits on the whole piano.

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This book was published in 1914. It has received the most favorable press comments, and has been cited as an authority in briefs filed in design cases in the Supreme Court of the United States and in many Federal Courts. It has been quoted in decisions rendered by the United States Patent Office.

It is the only text book on the subject published since 1889. The history of the design patent law; its development, and the present law and practice are fully discussed in it.

Design patents are now of great interest to lawyers, manufacturers, merchants and others dealing with industrial property.

Supplement No. 2 to this book is enclosed. A copy of the book and Supplement No. 1, which contains a review of all decisions affecting design patents rendered between January 1, 1914, and October 1, 1915, may be ordered on the blank printed below.

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