

No. 3616 9

IN THE
United States Circuit Court of Appeals
For the Ninth Circuit

MAJESTIC ELECTRIC DEVELOPMENT COMPANY
(a corporation),

Appellant,

vs.

WESTINGHOUSE ELECTRIC & MANUFACTURING
COMPANY (a corporation),

Appellee.

BRIEF FOR APPELLEE.

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BRIEF FOR APPELLEE.

This is an appeal in a patent infringement suit in which the appellant was the plaintiff in the lower court.

For convenience, the parties will be referred to here as the plaintiff and the defendant.

SUBJECT MATTER.

The basis of this suit is design letters patent No. 51,043, granted to the plaintiff-appellant upon an application filed by Edmund N. Brown and purporting to cover a design for an electric heater casing.

The device shown and claimed in the patent in suit is that which constitutes the subject-matter of the Brown utility patent No. 1,245,084, infringement of claim 1 of which is alleged in a companion suit, between the same parties, bearing No. 3617 in this Court, and embodies, as essential elements, a heating unit, a concavo-convex reflector, a wire guard or cage, a supporting stand and a reflector casing having a protective flange; all having such structural characteristics and co-operative relations *as are dictated by functional considerations*.

Judge Dietrich held, principally, that design patent No. 51043 was not infringed by defendant's device, but, in so doing, he expressed grave doubt as to the propriety of the grant of the patent, in view of the fact that the structure shown was, in his opinion, devoid of purely ornamental features. This position is in full accord with the law and authorities, as will be shown by the following review of decisions.

REQUISITES OF A DESIGN PATENT.

Section 4929 of the Revised Statutes of the United States, under the provisions of which design patents are granted, provides that a patent may be granted to anyone who has invented a new, original and ornamental design for an article of manufacture. It follows, as a matter of course, that any design for an article of manufacture which lacks any one of the elements specified in the Statute is unpatentable. In other words, the design must embody invention. This is not only a requirement

of the Statute but it has been emphasized by the Courts in construing many design patents, for example,

“The law applicable to design patents does not materially differ from that in cases of mechanical patents, and all the regulations and provisions which apply to the obtaining or protection of patents for inventions or discoveries * * * shall apply to patents for designs. * * * To entitle a party to the benefit of the act, in either case, there must be originality, and the exercise of the inventive faculty. In the one, there must be novelty and utility; in the other originality and beauty. Mere mechanical skill is insufficient. There must be something akin to genius—an effort of the brain as well as the hand.” (*Smith et al. vs. Whitman Saddle Company*, 148 U. S. 675.)

“The same general principles of construction extend to both. To entitle a party to the benefit of the act, in either case there must be originality and the exercise of the inventive faculty. In the one, there must be novelty and utility; in the other, originality and beauty. Mere mechanical skill is insufficient. There must be something akin to genius—an effort of the brain as well as the hand.” (*Frank Northrup et al. vs. Samuel Adams*, 2 Banning & Arden 567.)

“The difference in the curve at the bottom is one which would suggest itself to any workman and does not involve that exercise of the inventive genius which is as necessary to support a design patent as a mechanical patent.” (*Westinghouse Electric & Manufacturing Company v. Triumph Electric Company*, 97 Fed. Rep. 99.)

“It is, of course, extremely difficult to clearly mark the line at which symmetry and attractiveness cease to be mere matters of good taste and become touched with a spark of inventive genius. Indeed,

a glance at the decisions which have sustained design patents seems to suggest that there may be often more inventive genius displayed by the court in finding invention in design patents than the inventor disclosed in placing it there. However, the statute means something, and when this is comprehended it is the duty of the courts to give it effect.”

* * * * *

“Neither that decision (Smith et al. vs. Whitman Saddle Company, 148 U. S. 675) nor the statute have, however, been modified as to the significance of the term ‘invention’, used in both, and it may be assumed that, notwithstanding the construction which appellant claims the courts have later placed upon them, that term has not become meaningless, and must yet be deemed the main feature to be taken into consideration in determining the validity of a design patent.” (*Charles Boldt Co. v. Turner Bros. Co.*, 199 F. R. 139.)

“The question in the case at bar is not whether a design patent can be sustained, although each separate element in the design may be old, but it is whether what has been done in assembling the old elements in the new designs rose in these particular cases to the level of invention. * * * To sustain a design patent the design must involve something more than mere mechanical skill. There must be invention.” (*Steffens et al. v. Steiner et al.*, 232 F. R., Page 862.)

“Mere change in construction, displaying no originality and no added beauty, cannot be the subject of a design patent.” (*R. E. Dietz Co. v. Burr & Starkweather Co.*, 243 F. R., Page 592.)

“the test for invention is to be considered the same for designs as for mechanical patents; i. e., was the new combination within the range of the ordinary routine designer?” (*Strause Gas and Iron Co. v. William M. Crane Co.*, 235 F. R. Page 126.)

See also *Foster v. Crossin et al.*, 44 F. R. 62, *Perry vs. Hoskins*, 111 F. R. 1002 and *Charles Boldt Co. vs. Nivison-Weiskopf Co.*, 194 F. R. 871.

Furthermore, the presence of invention is not in and of itself sufficient because one may have invented what he believes to be a new design and, so far as his knowledge, at the time of exercising his inventive ability, is concerned, he believes himself to be an original inventor; but, if it subsequently appears that the same design was previously disclosed in patents or printed publications or embodied in devices publicly sold and used, the Statute requirements of novelty and originality are lacking.

Furthermore, a design may be a product of invention, may be new and may be original but, if it is not ornamental, it lacks one of the important characteristics made necessary by the Statute. This requirement of the Statute has also been emphasized repeatedly by the Courts and, in this connection, attention is invited specifically to the following rulings:

“The statute (Rev. St. 4929 (U. S. Comp. St. 1901, p. 3398), as amended by Act May 9, 1902, c. 783, 32 Stat. 193 (U. S. Comp. St. Supp. 1911, p. 1457)), authorizes the issue of such a patent under certain conditions to ‘any person who has invented any new, original and ornamental design for an article of manufacture’. Hence, it appears that a valid design patent demands, as has uniformly been held, an exercise of the inventive faculty the same as a mechanical patent. The design, however, thus invented must be not only new and original, but ornamental. It must exhibit something which appeals to the aesthetic faculty of the observer. *Rowe v. Blodgett & Clapp Co.* 112 Fed. 61, 50 C. C. A.

120; *Williams Calk Co. v. Kemmerer*, 145 Fed. 928, 76 C. C. A. 466. 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.” (*Rose Mfg. Co. v. E. A. Whitehouse Mfg. Co. et al.* 201 F. R. 926.)

“It is a reasonable conclusion that a device, in order to justify the granting of a design patent, must be such as to satisfy a person of ordinary judgment and good eyesight that it is ornamental, entirely independent of the character of the article to which it is applied. It is not enough that it should present in an unobtrusive form some utility that might otherwise be clothed in less endurable garb. It must disclose inventive genius—a creation which transcends the mere attractiveness almost universally availed of by dealers in every line of trade. That every symmetrical article should be made the subject of a design patent seems unconscionable. Patent monopolies are granted for the purpose of encouraging men of genius to place their mental powers at the service of the public without sacrifice. If every one who makes a graceful adaptation of a utility to the purposes for which it is endured at all can secure a monopoly thereby, one may soon be afraid to twist a wire or whittle a stick, lest he infringe.” (*Bolte & Weyer Co. v. Knight Light Co.*, 180 Fed. Rep. Page 412.)

“A design patent is addressed to the eye, and is to be judged by its ability to please. *Rowe v. Blodgett & Clapp Co.* (C. C.) 103 Fed. 873. *There may be no objection to the article to which it relates being useful as well as ornamental, but the attempt to patent a mechanical function, under cover of a design, is a perversion of the privilege given by the statute.* *Rowe v. Blodgett & Clapp Co.*, 112 Fed. 61, 50 C. C. A. 120; *Marvel Co. v. Pearl* (C. C.) 114

Fed. 946; *Eaton v. Lewis* (C. C.) 115 Fed. 635." (*Weisgerber v. Clowney*, 131 Fed. Rep. 477.) (Italics ours.)

"To successfully establish the validity of the design patent, and to entitle the inventor to protection, he must establish a result obtained, which indicates, not only that the design is new, but that it is beautiful and attractive. It must involve something more than mere mechanical skill. There must be invention of design. The District Judge concluded that the screwdriver is beautiful and attractive, and he says, even ornamental. We cannot, however, agree that the appellee's structure, made pursuant to this patent, has such a pleasing effect imparted to the eye, as to create beauty or attractiveness, or to make it ornamental. It provides for a new utility. Design patents refer to appearance. Their object is to encourage works of art and decorations which appeal to the aesthetic emotions—to the beautiful. We do not think that the device constructed by the appellee has a subject matter for such beauty and attractiveness as is contemplated by the statutes which permit the patent office to grant design patents, and conclude that the learned District Judge erroneously sustained the Patent" (*H. D. Smith & Co. vs. Peck, Stow & Wilcox Co.* 262 F. R. 415.)

In view of the above decisions, we contend that the design patent constituting the subject matter of this suit is invalid because every element of the device embodying the design is there for a useful or functional purpose, and the elements are so shaped and arranged as to insure a maximum degree of utility for the structure as a whole. The evidence in the case is conclusive on this point, but, if anything additional were needed, the teachings of the utility patent No. 1,245,084 granted to the same inventor and constituting the subject matter

of the companion suit No. 3617 is amply sufficient to meet this requirement.

The patentability of a design for article of manufacture should be dependent, provided the design is new, upon whether the change in, or addition to, previously existing designs carries with it an improved or a different function, or, on the other hand, whether change in, or addition to, previously existing designs changes the appearance in an ornamental fashion without changing or destroying the function previously performed. For example, such articles as china plates, cups, saucers, forks and spoons, silver, glass and china pitchers, tumblers, bowls, platters, etc. are susceptible of a considerable variety of patentable designs, as regards both form and surface ornamentation, but, in the majority of cases, such changes in form or surface ornamentation do not add to or detract from the functional possibilities, inasmuch as the articles are utilizable as tableware in the same manner and to hold articles of food and drink with the same efficiency, whether the design is of one type or kind or another.

In the present case, every element of the heater serves a specific function and such elements are all combined to co-operate in the performance of a joint function, and to remove or materially alter any one of the elements takes away just so much of the function which was previously performed and, to this extent, makes the device of less utility.

We do not contend that a utility device may not embody a patentable design, but, in the case of the patent

in suit, there is no purely ornamental feature, and the form of the device, as a whole, and that of its individual elements are such as are dictated, not by decorative or ornamental considerations, but for utility reasons.

It is not contended here that the patented design is devoid of ornamental quality, in the sense that it is repulsive in appearance, but it is contended that the device is not sold and is not used as an ornament. The purchaser selects and purchases the device solely because of what it will do. (See testimony of the witness Wentworth, page 95 of the record, to the effect that, in purchasing a heater, he was seeking heat only.) In other words, the device is purely a device of utility and all of its parts function, both collectively and individually, as utility elements. (See *Weisgerber v. Clowney*, *supra*, and *Roberts v. Bennett*, 136 F. R. 193.)

It was presumably intended by the framers of Section 4929 to provide for the granting of patents upon designs for articles of manufacture that are useful but, in order that such designs may be patentable, they must impart something more to the articles of manufacture which embody them or to which they are affixed than mere functional qualities or characteristics.

The purchaser of a rug, a carpet, a roll of wall paper or a lighting fixture unquestionably purchases it because it has utility and is needed to perform a useful function but the particular article purchased is usually selected because the design which it bears appeals to the purchaser as ornamental.

The design is something additional to and, in a sense, apart from the functional qualities. For example, two rugs or two carpets may be of uniform quality, so far as their floor-covering function and resistance to wear are concerned, but the purchaser selects the rug or the carpet having the design which appeals to him as the more ornamental. The same is true of wall papers, lighting fixtures, etc.

While the purchaser of an electric heater may not be entirely indifferent to its appearance, it is not selected and purchased because of its ornamental characteristics.

It would be a person of extraordinary taste who would select and purchase a heater like that shown in the patent in suit solely because of its decorative value.

The facts in the case at bar are very nearly on all fours with those of *Ferd Messmer Mfg. Co. v. Albert Pick & Co. et al*, 251 F. R. 894, in that a utility patent and a design patent covering a single structure were in suit, and the feature of the patented device for which novelty was claimed was embodied therein because of its functional utility. With reference to the design patent, the court said:

“So far as the question of double patenting is concerned, we do not think it can arise in this case, for the reason that we are of the opinion that the design patent is not valid. The bulge in the patented glass cannot be said to be ornamental within the meaning of section 4929 of the Revised Statutes (Comp. St. 1916, 9475). There is nothing in the bulge of the patented glass which would appeal to the esthetic emotions or to our idea of the beautiful. While the bulge may be new and useful, we cannot say that it has added anything to decorative art.”

Counsel for plaintiff construes a certain statement made by Judge Dietrich in his opinion to mean that the design of an article of manufacture, in order to be patentable, must embody surface ornamentation. The court made no such ruling. What the Judge said was that the devices "are entirely devoid of purely ornamental features, either of form or drapery". The term "drapery" may perhaps be construed to mean what counsel for plaintiff alleges, but the word "form" has quite a different meaning and merely indicates that Judge Dietrich had in mind the recognized scope of Section 4929 as extending to designs for articles of manufacture which have ornamental novelty of form or configuration as well as ornamental novelty of surface ornamentation. There was clearly no misconception of the law in the ruling made by Judge Dietrich.

We contend further that the design patent in suit is invalid for lack of novelty on account of the prior state of the art. Before taking up the specific prior-art devices, a general review of the art may be profitable.

GENERAL PRIOR ART.

The art of generating radiant energy and reflecting it in a beam of rays having some approximation to parallelism is very old, it being a matter of common knowledge that searchlights, railway-locomotive headlights and automobile headlights have for many years utilized this principle of beam reflection to project radiant energy along a single path or upon a single person or

object or upon a relatively small group of persons or objects.

The general art of generation and projection of radiant energy is further exemplified by so-called flood-lighting which consists in projecting a beam of reflected light upon an object or a relatively small space which is to be illuminated, and this branch of the art, which has been practiced for a considerable number of years, culminated in the extraordinarily successful illumination of the buildings of the Panama-Pacific Exposition in San Francisco in 1915.

Although the reflection of radiant energy in the relations and by the means just mentioned was practiced for the purpose of illumination, the laws of operation were the same as those governing and controlling the radiation and projection of energy rays for the purpose of heating a circumscribed space or a definite object and, as stated by defendant's witness, Beam, the commercial production of light without the attendant production of heat has never been accomplished. (pp. 71 and 72 Rec.)

The projection of reflected radiant energy in a beam for the illumination of an object or a defined space by a searchlight; a similar illumination of a defined and limited path by a locomotive or automobile headlight, and the projection of reflected energy rays in a beam to heat a person or an object are all effected by combustion or by electrical resistance and a concavo-convex reflector. Devices pertaining to the particular branch of the art represented by the patent in suit are characterized by portability, which obviously demands

devices of compact form and light weight in order that they may be moved from place to place in an office or a room of a residence and may be readily transported from one office to another or from one room or residence to another and be so designed and constructed as to be utilizable in electrical systems of distribution the primary purpose of which is illumination.

By reason of the necessity for portability and utilization by connection to electric-lamp sockets, these devices necessarily embody, as heating units, electrical conductors of high resistance and concavo-convex reflectors located adjacent to the heating units to reflect the heat rays in a single direction, and preferably embody protective wire guards of some convenient form to prevent accidental contact with the heating units.

Electrical heaters having the essential elements and characteristics just mentioned are disclosed in defendant's exhibits E, F, G, H, I, 1, 2, 4, 5, 6, 7, 8, 9, 10, 11, 12 and British patent 19,971 of 1913, and are exemplified in defendant's exhibits A, B, C, D and M.

We now request consideration of these exhibits, as embodying elements and principles above set forth and also such additional features as are shown in the patent in suit.

PRIOR PATENTS, PUBLICATIONS AND DEVICES.

The Morse patent No. 881,017, granted March 3, 1908 (defendant's exhibit F), discloses a concavo-con-

vex reflector, a heating unit supported in operative relation to the reflector, a pad or rim on the edge of the reflector and a protective cage in the form of a screen of coarse wire mesh or similar construction.

It is apparent that the Morse patent, although disclosing no supporting stand and embodying a heating element enclosed in a vacuum instead of being exposed to the air, discloses a structure which serves to refute any claim made by the plaintiff to the effect that the patented design is something broadly new in the art, or that there was anything new in the idea of projecting a beam of heat.

The heater shown in the Geiger patent No. 1194168 (defendant's exhibit G), and represented by defendant's exhibit M, embodies a concavo-convex reflector, two heating units so located with reference to the reflector that the heat generated by them is reflected in one direction only. In other words, the Geiger device, of which large numbers were marketed by the defendant, in the days before nickel-chromium or other oxidization-resisting wire was available, is a portable electric heater having a polished reflector to project the generated heat in a single direction to heat a single object or person, or a small group of objects or persons, and, in addition, is strikingly ornamental.

A radiant electric heater, called the "Ferranti Fire" is described in defendant's exhibit No. 1, a portion of the description being as follows:

"A circular bowl of polished copper which concentrates and reflects the heat rays. Like the Bastian heater, the greater part of the energy is given

out as convected heat, but there is considerable radiant energy, and owing to the reflecting properties of the bowl this can be distinctly felt at a distance of many feet. It has much the appearance of a red-hot fire, hence its name, and its effect is much the same."

The heating unit is described as

"A closely wound spiral disk of nichrome or similar tape, interleaved with mica (a modified variety of the old Ferranti winding), and held in close contact with a circular plate of quartz glass six inches in diameter."

This device, therefore, comprises a concavo-convex reflector and a heating unit which bears a relation to the reflector which corresponds substantially to the relation of the heating unit to the reflector of the patent in suit.

It is further stated that "It would be an obvious improvement to protect the disk by a suitable form of guard".

The Ferranti Fire is described also in defendant's exhibit No. 2, a portion of the description being as follows:

"A new style of electric heater has lately been introduced in which a circular plate of quartz glass is caused to glow at a bright red by contact with a spiral resistance unit in front of which it is clamped. By means of a bowl-shaped copper reflector surrounding the heating surface, and carried on trunnions, the heat rays can be focussed in any desired direction."

and, further,

"It would be a simple matter to protect the heated disc by the use of a guard of expanded

metal or a wire netting with large mesh. Neither method need detract from the appearance of the heater nor reduce its efficiency, and both could be made detachable so that the disc could be used for water boiling as at present. The guard could be clipped round the flange which surrounds the quartz disc, *or it could be secured to the outer edge of the copper reflecting bowl.*' (Italics ours.)

Defendant's exhibit No. 4 illustrates and describes the Ferranti Fire. Attention is specifically directed to a portion of the descriptive matter as follows:

"It will be seen that the heating element is mounted in the centre of a polished brass or copper reflector, which, being supported on bearings, is capable of rotation through 180 degrees."

and, further,

"An ornamental ring, seen in Fig. 184 covers the joint between the element and the reflector, and secures a wire guard when necessary."

In defendant's exhibit No. 11 appears a further description of the Ferranti Electric Fires in which reference is made to the large reflecting bowl, the color scheme of which gives an appearance of warmth, etc.

In defendant's exhibit No. 12 is illustrated an example of the Ferranti Electric Fire, as to which no specific mention is necessary except to call attention to the smaller figures of the cut.

Defendant's exhibit No. 3 embodies a cut of a device for generating and reflecting radiant energy that is primarily intended for lighting purposes. The device embodies, however, a concavo-convex reflector having a rim or bead around its edge to which is attached a

wire protective cage corresponding substantially to that of the patent in suit and having a heat and light-generating unit located in front of the reflector.

Defendant's exhibits Nos. 5 and 7 illustrate and describe a so-called "Calor" electric fire comprising an electric heating unit and a reflector of bowl-shape which has a flat peripheral flange projecting from its edge.

Attention is particularly directed to the cut of exhibit No. 7 designated as Fig. 3—Pedestal Type "Calor Fire", especially as illustrating a device that embodies an electric heating unit, a concavo-convex reflector having an annular member extending outwardly from its margin and a supporting stand of the desk telephone type.

Defendant's exhibit No. 6 illustrates and describes a so-called "Redglo" fire embodying an electrical heating unit, and a bowl-shaped reflector having a supporting stand and a peripheral flange extending outwardly from the edge of the curved portion of the reflector.

Defendant's exhibits Nos. 8 and 9 and British patent No. 19,971 of 1913 illustrate and describe a radiant or beam heater manufactured by Simplex Conduits, Limited, of London, and designated as the "Plexsim" electric fire.

It will be noted that the Plexsim heater is illustrated and described definitely and distinctly as a beam heater in which the heat is generated by a cylindrical coil of

wire and is reflected from a polished copper surface in approximately straight lines, as a beam.

In defendant's exhibit No. 10 is illustrated and described an electric heater called "The 'D. G.' Bowl Electric Fire" and comprising a heating unit and a reflecting copper bowl having a relatively wide flat marginal rim and a wire cage for preventing accidental contact with the heating unit. In the descriptive portion of the exhibit appears this statement:

"Around the circular element is a bowl reflector of solid copper, accidental contact with the glowing coils being prevented by a light grid of stout wire."

Defendant's exhibit 14 discloses a device the reflector and supporting stand of which closely resemble the reflector and stand of the patent in suit. Although the device shown in this exhibit is not a heater and has no casing provided with a marginal flange, it is intended to reflect energy rays.

The device illustrated in each of Figs. 14 and 17 of defendant's exhibit 15 embodies light and heat-generating units, a concavo-convex reflector and a protective cage the ends of the wires of which are fastened to the rim of the reflector.

Defendant's exhibit No. 16 contains a cut of one of plaintiff's No. 2 heaters, defendant's exhibit B being one of these heaters.

The Shoenberg patent (defendant's exhibit I), under which plaintiff operates, comprises a concavo-convex reflector, a heating unit of the same type and form as

that of the patent in suit and supported as nearly at the focus of the reflector as is the unit of the patent in suit; the reflector is supported within, and spaced from, a protective casing which has a projecting flange or rim, and guard wires are provided the ends of which are attached to the flange or rim of the protective casing (Fig. 10).

With reference to the reflector, the specification of the Shoenberg patent states (p. 1, lines 48 to 53):

“The reflector consists preferably of a highly polished metal shell 1, which is somewhat hemispherical or dome-shaped and serves to reflect the heat waves received from the heater and direct them outwardly from its inner concave surface.”

The specification states further (p. 2, lines 9 to 17):

“The coil of the heating element is made of bare wire of high resistance which becomes very hot and I therefore provide guard wires 14, which cross and have their ends secured in apertures in the rim of the reflector. These guard wires serve not only to prevent any inconvenience by accidental contact with the hot wires, but also to protect the heater unit from injury.”

There is no escape from the conclusion that the Shoenberg patent discloses every element of the patent in suit, combined and operating in the same manner and to perform substantially the same functions, the only differences being that the reflector of the Shoenberg patent is not exactly reproduced in the patent in suit, and the peripheral rims or flanges of the protective casings are not exact duplicates. Nevertheless, the reflector of the Shoenberg patent is concavo-convex,

the heating unit is supported in the same relation to the reflector as in the patent in suit, the rim or flange extends outwardly from the margin of the reflector and the ends of the guard wires of the protective cage are attached to the rim or flange of the casing, as will be seen by reference to Fig. 10 of the drawings of the patent.

In Fig. 2 of the drawings of the Shoenberg patent, the reflector is shown as provided with a flange or annular member having the same location and general relations as the flange of the patent in suit except that the forwardly-projecting portion or rim is wider than the portion projecting laterally, whereas, in the patent in suit, the laterally-projecting portion is materially wider than the forwardly-projecting portion at its outer edge.

The protective cage of the patent in suit obviously differs from that of the Shoenberg patent in comprising a relatively large number of arched guard wires, but plaintiff is barred from any benefit in this regard because exactly this form of protective cage is embodied in each of its prior heaters 1, 2, 2B and 3, represented by defendant's exhibits A, B, C, D and E.

If any patentable novelty attaches to the protective device of the patent in suit, which defendant does not admit, *it must reside in the specific form and dimensions of the annular flange or rim* inasmuch as the protective casing is found in the Warner patent No. 1,120,003 and a protective pad or rim 2 is disclosed in the Morse patent No. 881,017.

It would be a more than liberal grant of credit as an inventor to accord to the patentee Brown the right to exclude others from the use of a protective annular flange, in view of the structure of the Morse patent and that of the Shoenberg patent, that of the "Calor" fire device illustrated in defendant's exhibits 5 and 7 and that of the "Redglo" device illustrated in defendant's exhibit 6.

It will be noted that plaintiff's earlier heaters, represented by defendant's exhibits A, B, C, D and E, embody elements the same in number, form and location as those shown and described in the patent in suit, namely, a supporting base and standard, a concavo-convex reflector, an electrical-resistance coil of tubular form, mounted upon an insulating tube and disposed transversely to the axis of the reflector and in front of it and a wire guard or cage disposed in front of the heater and reflector for the purpose of protecting the user or anyone in proximity to the device from becoming burned by contact with the heater element or with the heated reflecting surface.

It will be noted further that the Warner patent No. 1,120,003, a copy of which constitutes defendant's exhibit H, discloses a radiant electric heater embodying a concavo-convex reflector, a heating unit and a protective wire cage, all supported upon a stand of the familiar desk-telephone type.

Although the reflector of the Plexsim device disclosed in defendant's exhibits 8 and 9 and in British patent No. 19,971 of 1913 is not shown as provided with

an annular flange, the structure has all of the other elements of the patent in suit and, in the illustration of exhibit No. 9, the protective cage is similar to, though not exactly like, that of the patent in suit.

Defendant's exhibit J was made in conformity to the illustration of exhibit No. 9 except that its reflector was parabolically curved and provided with a smooth reflecting surface, in accordance with the disclosure of British patent No. 19,971 of 1913, a certified copy of which is in evidence.

It will be noted that, in lines 20 and 21 of page 2 of the specification of the British patent No. 19,971, it is stated that the reflector may be "the frustum of a cone, or of parabolic configuration" and that in lines 25 to 29, page 3, it is stated

"We have found that a diameter at the large end approximately equal to the depth of the cone gives good results, but the cone angle may be greater or less than that so indicated, or the reflector may be, in longitudinal section, in whole or in part of parabolic or the like contour, according to the form desired for the emergent beam of rays."

Judge Dietrich made reference to Kempton British patent No. 12,320 of 1848 as disclosing a parabolic reflector for heating purposes, gas jets being disposed in proper relation to such reflector in order that the heat produced by the burning gas might be thrown forward in a beam.

Counsel for plaintiff objects to any consideration of the British patent just mentioned because it was not

formally offered in evidence in any of the three cases now on appeal in this court. This objection by counsel for plaintiff is purely technical, inasmuch as the three suits against the Westinghouse Electric & Manufacturing Company and a suit against Holbrook, Merrill & Stetson were tried consecutively and were all argued together.

Inasmuch as Judge Dietrich prepared a single opinion for the four cases just mentioned, he naturally and properly made use of the exhibits without attempting to differentiate as to the specific cases in which they may have been formally offered in evidence. By so doing, he made the Kempton British patent a part of the instant case and this court cannot properly ignore it, provided it is deemed of material value, any more than it can ignore a matter of such common knowledge as to be properly subject to judicial notice, even though not represented by any exhibit or testimony or specifically presented by counsel for consideration of the court. In any event, this patent is neither vital nor essential to a decision on the validity or scope of the patent in suit.

Counsel for plaintiff alleges in his brief that the judge of the lower court ruled that the patent in suit is valid. This, we deny. The judge found there was no infringement and, therefore, apparently held that it would be a superfluous matter, and one with which he had no concern, to go further and rule specifically that the patent was invalid *because of anticipation*.

In view of the prior Majestic devices (exemplified by defendant's exhibits B, C and D), the illustrations and descriptions of the Ferranti, Redglo, Calor and Plexsim devices (shown and described in defendant's exhibits Nos. 1, 2, 4, 5, 6, 7, 8, 9, 11 and 12), the Morse patent (defendant's exhibit F); the Warner patent (defendant's exhibit H); the Shoenberg patent (defendant's exhibit I), and the Porter patent (defendant's exhibit N), the design of the patent in suit embodies no novel element.

It is true that no one of the defendant's exhibits discloses all of the features of the patented design having the same co-operative relation as is there set forth, but the Majestic No. 2 heater (defendant's exhibit B) embodies every such element and constitutes a complete anticipation except for the casing and its broad marginal flange surrounding the reflector. Therefore, no one infringes or can infringe the patent in suit who utilizes the elements of the Majestic No. 2 heater, in the combination and relations which they have in that heater, provided he omits the only added feature which makes the design of the patent in suit, in any sense, manner or degree, new; namely, the protective casing having the broad marginal flange.

It must be clearly borne in mind that the patent in suit is limited to what is there shown, and such illustration does not include any copper-colored reflector. So far as the reflector is concerned, it may be white, black, green or any other color, and still embody the design of the patent in suit as effectively and as surely as does the polished copper reflector of the No. 7 heater.

The actual features of the plaintiff's No. 7 heater which serve to distinguish it from the prior heaters (Nos. 2, 2B and 3) manufactured and sold by the plaintiff are:

1. Size, which the plaintiff admits is immaterial and cannot affect the patentability of the design or its infringement.
2. The color, which is no part of the patented design, but is the striking feature of the device itself, as manufactured and sold, and serves, more than anything else, to impress an observer giving such attention as one ordinarily gives to such devices.

The relatively large reflecting bowl of burnished copper is not only pleasing in appearance, because of its color, but it gives to the observer a visible impression of warmth to supplement the heat actually imparted by the reflected rays of energy.



ALLEGED FAILURE AND ABANDONMENT OF EARLY DEVICES.

The brief for plaintiff characterizes the Majestic heaters 1, 2, 3, 1b, 2b and 3b, four of which are exemplified in defendant's exhibits A, B, C and D and three of which are illustrated in the photograph of the Majestic Company exhibit at the Panama-Pacific Exposition, constituting defendant's exhibit E, as unsuccessful experiments and as failures. There is no evidence in the record in support of such characterizations, and, in fact, the evidence discredits and disproves them.

The devices which were manufactured and sold extensively over a considerable period of time and exhibited at the Panama-Pacific Exposition as commercial products were not experiments and cannot be construed to be such, and there is no item of evidence in the record to the effect that the devices in question were unsuccessful or were failures.

The only sense in which abandonment enters into the case, so far as the devices in question are concerned, is in the sense that manufacture of these earlier devices was discontinued after manufacture of the No. 7 device was begun.

Public sale or use of an invention forever debars another subsequent inventor from securing a valid patent thereon, and no valid patent can be issued upon an application filed by the original and first inventor more than two years after public sale or use occurs.

It is immaterial that heaters Nos. 1, 2, 2B and 3 were manufactured and sold by the plaintiff, instead of by some other party, inasmuch as the patent in suit covers an alleged invention made by one Edmund N. Brown, who had no connection with, or relation to, the design of the said heaters Nos. 1, 2, 2B and 3, these having been manufactured and sold under Shoenberg patent No. 1109551.

NO EXCLUSIVE RIGHT BECAUSE OF COMMERCIAL ACTIVITY.

The vigorous and persistent attempt by the plaintiff to establish an exclusive right to the commercial field occupied by radiant electric heaters of the beam

type by way of evidence as to the period and extent of its own commercial exploitation of its No. 7 heaters is unwarranted because based upon the fictitious assumption that the commercial success attendant upon the manufacture and sale of No. 7 heaters was due to the novelty and efficiency of that device and the further fictitious assumption that competitors of the plaintiff entered the field because of the popularity achieved by the No. 7 heater.

If any claim for patentable novelty is to be based upon evidence of large sales, relationship of invention to volume of sales must rest upon something more tangible than conjecture. The courts are rarely willing to accept evidence of commercial popularity as evidence of invention and will never do so unless the question of invention is one of grave doubt.

On this point, the Supreme Court said, in *McClain v. Ortmyer*, 141 U. S., 419

“That the extent to which a patented device has gone into use is an unsafe criterion, even of its actual utility, is evident from the fact that the general introduction of manufactured articles is as often affected by extensive and judicious advertising, activity in putting the goods upon the market and large commissions to dealers, as by the intrinsic merit of the articles themselves. * * *

If the generality of sales were made the test of patentability, it would result that a person, by securing a patent upon some trifling variation from previously known methods, might, by energy in pushing sales, or by superiority in finishing or decorating his goods, drive competitors out of the market, and secure a practical monopoly without in fact having made the slightest contribution of

value to the useful arts. * * * While this court has held in a number of cases * * * that in a doubtful case the fact that a patented article had gone into general use is evidence of its utility, it is not conclusive even of that; much less of its patentable novelty.”

The Court affirmed this ruling in *Adams v. Bellair Stamping Co.*, 141 U. S. 539, and *Duer v. Corbin Cabinet Lock Co.*, 149 U. S. 216, and others. The District Courts and Circuit Courts of Appeals throughout the United States have made similar rulings in many reported cases, some of which have been in this Circuit, *Klein v. City of Seattle*, 77 F. R. 200; *American Sales Book Co. et al. v. Bullivant*, 117 F. R. 255, and *Hyde v. Minerals Separation, Limited, et al.*, 214 F. R. 100, being notable examples.

In view of the general recognition given by the courts to the principle enunciated by the Supreme Court in *McClain v. Ortmyer*, supra, further citations from the many published opinions appear to be unnecessary.

As a matter of fact, the commercial use of plaintiff's No. 7 heater was due to extensive advertising, both by the plaintiff and by its competitors, as shown by the testimony of the inventor, Brown, himself, in the companion case No. 3617, pages 118 and 119 of the record, and to the fact that the No. 7 heater was made larger than its predecessors, and that the reflecting bowl, being of burnished copper, was more striking and attractive in appearance.

In addition, the exploitation of the No. 7 heater was substantially coincident in point of time with the free-

ing of the plaintiff from restriction of its activities by the obtaining of a license under the Marsh patent on nickel-chromium wire, as set forth in the following paragraphs:

RIGHT TO UTILIZE NICKEL-CHROMIUM WIRE.

The record in this case shows that wire composed mainly of nickel-chromium alloy is the only available material which can be utilized to operate at an incandescent temperature in the open air without destruction or rapid deterioration, and that this material is covered by a certain Marsh patent under which all manufacturers of electrical heating devices and apparatus are operating as licensees.

Although the Nos. 1, 2, 2B and 3 heaters manufactured and exploited by the plaintiff prior to the production of its No. 7 heater embodied heating units which constituted infringements of the Marsh patent, during the period of manufacture and sale of these earlier heating devices, the Marsh patent was in process of litigation against the General Electric Company. Shortly after the termination of the litigation, which resulted in sustaining the patent, the plaintiff secured a license and, at about that time or very shortly thereafter, it began the manufacture and exploitation of its No. 7 heaters.

It is also of record that the defendant undertook the exploitation of its heater which is involved in the present suit as soon as it could do so after securing a license under the Marsh patent.

The allegation has been made that suitable material other than the so-called nichrome wire was available, and specific mention has been made of a material known to the trade as "Excello" wire. This allegation is true, so far as availability of material prior to the final decision in the suit based upon the Marsh patent is concerned, but it is without significance by reason of the fact that excello wire is a nickel-chromium alloy and is, therefore, an infringing material. (pp. 67 and 125 Rec.)

The fact that the plaintiff was willing to incur the risk incident to using nickel-chromium wire in its earlier heaters, prior to a final adjudication of the Marsh patent, may not properly be utilized as a basis for attack upon other manufacturers who did not care to incur such risk.

The substantial coincidence, in time, of the issuance of licenses under the sustained Marsh patent and the manufacture and exploitation of radiant or beam heaters by various manufacturers, including the increased exploitation by plaintiff, disposes of the contention on the part of the plaintiff that its No. 7 heaters established for it a commanding position in the field because embodying a pioneer invention.

NO INFRINGEMENT.

It has been clearly and definitely shown that, notwithstanding the contentions on the part of the plaintiff that the patent in suit is entitled to a broad interpretation of such character as is accorded to one cover-

ing a pioneer invention, the only features added by Brown to heaters Nos. 1, 2, 2B and 3 were a slight modification in the curvature of the reflector and the addition of a protective casing having an annular protective flange projecting laterally from its rim.

The supplemental protective casing is disclosed in the Warner patent, and a protective rim in the Morse patent and, also, in the Shoenberg patent.

The defendant's structure obviously embodies a concavo-convex reflector, a heating unit supported in front of said reflector and a protective cage having guard wires the ends of which are attached to the margin or rim of the reflector, but *the device has no annular member extending outwardly from the margin of the reflector.*

The designers of the defendant's heater secured all of the essential elements incorporated in the heater from the prior art which was also available to Brown when he made the alleged invention of the patent in suit.

Defendant's device is shown and described in British patent No. 19,971 of 1913, and in defendant's exhibit 9, except as regards the form of the reflector and that of the protective cage.

It will be noted that the supporting member of the defendant's device embodies a base having a frame of U-shape between the arms of which the reflector is mounted upon trunnions and that these parts correspond closely to like parts in the British patent.

It is to be noted, further, that, in the defendant's device, the heating unit comprises a supporting rod, an insulating cylinder on such rod and a coil of resistance wire disposed on the insulating cylinder, and that this unit is mounted in the axis of the reflector.

Corresponding parts, which differ only as regards the length of the unit, are disclosed in the British patent.

It is to be noted, further, that a more or less definite relation between the length of the heating unit and the depth of the reflector exists and, consequently, inasmuch as the designers of the defendant's heater elected to use a reflector of the form shown in the Warner patent (defendant's exhibit H), they necessarily utilized a heating unit the length of which conforms to the depth of the Warner reflector.

The protective cage of the British patent was rejected as less desirable than other forms known in the prior art and, consequently, substantially the form of that shown in the Porter patent No. 684,459 of October 15, 1901, (defendant's exhibit N) was adopted.

Or it may be assumed that the designers of the Westinghouse heater had knowledge of the specific cage shown in defendant's exhibit 16, which was obviously available to anyone desiring to make use of that specific form of protective cage. The device shown in exhibit No. 16 is the Majestic Company No. 2 heater, as exemplified in defendant's exhibit B, the design of which had been abandoned to the public by commer-

cial exploitation prior to the advent of plaintiff's No. 7 heater.

As has already been noted, the design of the patent in suit is characterized by a reflector casing of bowl-shape having a broad, flat, peripheral flange and supported upon a stand of the well-known desk-telephone type, a cylindrical heating unit, supported in front of the reflector, with its major axis at right angles to the axis of the reflector and a protective cage of bowl-shape composed of wires the ends of which are attached to the outer edge of the annular flange with which the reflector-bowl casing is provided. These several devices are combined to constitute an electric heater of a type generally well known in the art.

The design, as embodied in the plaintiff's No. 7 heater, does not differ from that shown in the patent in suit except in one striking particular, namely, the reflecting bowl and the face of the peripheral flange *are of burnished copper.*

Defendant's heater embodies elements the number and general co-operative relation of which are the same as in the plaintiff's heater except that *its reflector has no peripheral flange or double casing and its heating unit is disposed in the longitudinal axis of the reflector instead of at right angles thereto.*

Another striking difference between the defendant's heater and that of the patent in suit, is the supporting stand, which comprises a base and a frame of U-shape, between the upper ends of which the reflector is pivotally mounted in order that it may be tilted.

Plaintiff's counsel attempts to overcome this point of differentiation by stating that the pivotal mounting cannot be seen from the front of the heater, but, in doing so, he ignores the fact that Fig. 2 of the patent drawing is a side view showing the mounting of the casing on its pedestal and accentuating the structure from which defendant's device is distinguished by its own peculiar form of support.

The defendant's heater resembles the plaintiff's heater only because they both embody the same number of main elements or features having the same general arrangement and substantially the same color.

All human beings, if normal, have the same number and general arrangement of features and, if belonging to the same race, they have color resemblance as well but they are not often mistaken one for another because of these facts, even though the examination given is merely casual.

The possibility of mistaking the one device for the other if not placed side by side and compared, provided such possibility actually exists, is obviously due to two features, and to two features only, viz, the general form, which obtains because the function to be performed demands it, and the polished copper reflecting bowl which is not disclosed in the design patent in suit and, if it could ever have been covered by a patent, was old and in use long before the production of the patented design. (See defendant's exhibits 1, 2, 4, 5, 6, 7, 8, 9, 10, 11, 12 and M and British patent No. 19,971 of 1913.)

INFRINGEMENT TEST.

Counsel for plaintiff quotes, from the well-known *Gorham vs. White* decision by the Supreme Court, the rule for determining infringement of a design as the sameness of appearance to the eye of an ordinary observer giving such attention as a purchaser usually gives, and, as to this rule we take no exception, but we do except to the application made by counsel for plaintiff in the present case.

The defendant has been engaged in the manufacture and sale of heaters like plaintiff's exhibit No. 5 since the latter part of the year 1918 or the early part of the year 1919 and, during that period, it had unquestionably sold a very large number of such heaters. Whether that number be thousands, tens of thousands or hundreds of thousands, is not of record and is not material. Whatever may have been the number of sales, the plaintiff will undoubtedly admit that such number is large. Notwithstanding such large sales as must have occurred, the only evidence for use in applying the *Gorham vs. White* rule of infringement which the plaintiff offers in this case is the testimony of two of its witnesses and that of one witness testifying under subpoena for the defendant.

In this connection, it is pertinent to examine with some degree of particularity the testimony of the witnesses just mentioned.

First. Mrs. Lebatt, a friend of Mr. Brown, President of the plaintiff company, and not a purchaser or a prospective purchaser, testified that, when walking

along the street she saw a heater on exhibition which she assumed to be one of Mr. Brown's heaters, but noted that the heating element was disposed in a manner which differed from that of the element in the heater with which she was familiar. Upon re-examining the device with more care, she noted upon it the name "Westinghouse", but, until she noticed this name, she assumed it to be one of Mr. Brown's heaters with the element changed.

Mrs. Lebatt, although not an expert in electrical heating devices, was apparently familiar with Majestic heaters and no others, although she testified that she had seen a Hotpoint heater, *which she did not mistake for a Majestic heater*. It is notable that the witness did not mistake the Hotpoint heater for a Majestic heater, inasmuch as its heating element was of the same shape and disposed in the same manner as that of the Majestic.

The witness was not deceived, but, even if she had been, the test was not fair and reasonable because the inspection given to the Westinghouse device prior to her discovery that it bore the name Westinghouse was the casual glance of a passer-by on the street, instead of an inspection such as a purchaser usually gives.

The witness Hiller is the manager of the Boesch Lamp Company, which manufactures all of the parts of plaintiff's heaters except the electrical parts, and, consequently, as a business associate of Brown and an expert, could competently testify only with refer-

ence to his experiences with purchasers, or those occupying similar relations to him.

Mr. Hiller first testified to an incident with reference to the owner of certain electrical heaters, one G. L. Wentworth, who, according to Mr. Hiller, stated, that he had one of his (Hiller's) heaters upstairs, and that, upon inspection, the heater in question proved to be a Westinghouse heater.

Mr. Wentworth, testifying for the defendant under subpoena, stated that the heater in question was purchased for him by a clerk who was given no instructions as to the kind of heater to purchase, and that when the heater was installed and thereafter until the date of the incident respecting which Hiller testified, he had paid no attention to the heater in question and had no knowledge as to who manufactured it and no interest in its source or origin.

The testimony of Hiller and Wentworth with reference to the Westinghouse heater purchased and installed for the latter and used by him has no significance in this case, because the purchaser, Wentworth, not only did not give "such attention as a purchaser usually gives", but gave no attention whatever and did not even examine the device.

The witness Hiller testifies further to the effect that he was told by an owner of two heaters in Sacramento that they were out of order and, upon inspecting them, he, Hiller, found that they were not Majestic heaters. Upon further examination, he admitted that they were

Hotpoint heaters and they, therefore, have no significance in the instant case.

Hiller testified further that, at intervals, heaters made by manufacturers other than the Majestic Company were occasionally brought to his company for repairs. He assumed, for the purpose of this case, that such heaters were brought to his company under the supposition that they were manufactured by it. We submit that an assumption having at least as much basis to support it is that those bringing or sending heaters to the Boesch Lamp Company for repair did so because that company was known to be in a line of business which would naturally and properly enable it to make repairs upon devices of this character.

This testimony falls far short of even indicating, much less establishing, such deception as proves or even indicates that the Westinghouse design is like that of the patent in suit.

Inasmuch as proof of infringement was vital in the plaintiff's case and the best evidence of infringement is the testimony of witnesses who may be classed as ordinary observers giving such attention as a purchaser usually gives, it is a sad commentary on the defendant's case that, out of thousands, and probably hundreds of thousands, of sales of Westinghouse heaters, which plaintiff alleges infringe the patent in suit, it was possible for plaintiff to offer the testimony of only two witnesses, neither of whom was disinterested or—so far as the record shows—had purchased a Westinghouse heater or a Majestic heater or had ever

contemplated making any such purchase, and is further forced to the extreme of relying upon the testimony of a witness testifying for the defendant and who, although a purchaser of a Westinghouse heater, did not know or care whether it was a Westinghouse heater or one of some other manufacture until his attention was specifically called to it some weeks or months after its purchase and during which time it had been in regular daily use.

PRIOR LITIGATION.

Plaintiff's brief makes mention of certain prior suits by it against certain agents of the Hotpoint Electric Heating Company in which a verdict in favor of plaintiff was rendered by a jury. Although a writ of error was sued out in each of the actions in question, the matter was not prosecuted to final hearing in the Court of Appeals and, consequently, such litigation has no significance in this proceeding. Even though decisions in favor of the plaintiff had been rendered by the Circuit Court of Appeals, such decisions would have had no binding effect in the instant case because the subject matter constituting the alleged infringement here is materially different from that constituting the alleged infringement in each of the prior suits.

PLAINTIFF'S POSITION UNCERTAIN AS TO SCOPE OF PATENT IN SUIT.

Plaintiff's counsel devotes several pages of his brief to urging and demonstrating that the subject matter

of the patent in suit is the entire structure shown in the patent drawing, and then apparently seeks to establish a different state of facts by alleging, in a single brief paragraph on page 42, that the heater element is no part of the design, this allegation being apparently based on the fact that the patent bears, as its title a "Design for an electric heater casing".

Either construction is fatal to plaintiff's case. If the heating unit is a part of the design, defendant's device does not infringe. If the heating unit is not a part of the design, the patent is fully and clearly anticipated. Furthermore, if the terms "heater casing" mean something less than the entire device, plaintiff does not tell us how much less and we cannot otherwise know.

INFRINGEMENT DEPENDENT UPON VALIDITY AND SCOPE.

Respecting the question of infringement, as we have already noted, that resemblance which deceives or tends to deceive an ordinary observer giving such attention as a purchaser usually gives, has not been proved, but, apart from the testimony of witnesses, the only resemblance between the design of the defendant's device and that of the patent in suit which could otherwise support a finding of infringement, is swept away by the prior art. If there were no prior art, it might be permissible to hold that such deviation from the patented design as that found in the arrangement of the heating unit, the omission of the broad marginal flange and the casing of which it constitutes a part, and

the different form of supporting frame, should not be accepted as establishing non-infringement, but before infringement can be found and decreed the validity of the patent in suit must be established.

Assuming, without admitting, that the patent in suit is valid, the infringement test must be that applied in *Kruittschnitt v. Simmons et al.*, 118 F. R. 851, as follows:

“The attention of the public is not primarily or necessarily called to the specific design, but to the bordered aluminum sign plates as a new article of manufacture. Consequently, when the defendant’s manufactured bordered aluminum signs having patterns differing so widely from the patented design as not to infringe the same, they were purchased by persons who supposed they were getting plaintiff’s design, or who, at least, failed to distinguish the difference between them. Counsel for plaintiff, therefore, invokes the application of the familiar test,—‘the eye of the ordinary observer, giving such attention as a purchaser usually gives.’

For the reasons already stated, this test cannot be applied in this case without doing violence to the fundamental law of infringement—that in order to constitute infringement there must be an appropriation of the novel elements of the patented design. Because such aluminum signs are new, the purchasing public may mistake defendants’ design, which every one has a right to make, for the design which only the plaintiff has the right to make. But the defendants cannot be deprived of their common right. The plaintiff, then, must be limited in such test to configurations which appropriate his design.”

In this case the facts were obviously more favorable for the plaintiff than are those in the case at bar, in

which the border flange of the patent in suit has not been either appropriated or replaced by an equivalent element.

Another case of great persuasive value, if not of controlling importance as regards the question of infringement, is that of *Grelle et al. v. City of Eugene, Or., et al.*, decided in this Circuit and reported in 221 F. R. 68. In this case, the Court of Appeals said:

“In the nature of things, lamp posts manufactured for use in city streets must possess many features in common. In general form they must of necessity be somewhat the same. As stated by one of the defendants’ experts:

‘There is not much chance for originality. The only chance for originality the designer has in designing a post is in the detail.’

There is an additional reason why the defendants’ post should not be held to be an infringement of the Grelle patent. In the decisions which we have cited there were involved alleged infringements of design patents for silverware, ornaments, dishes, lamp shades, and similar articles. There is this distinction between such cases and the case at bar. In those cases the object and purpose of the specific design was to excel in artistry and ornamentation. In the present case it appears from the record that the object of the defendants in adopting the design of post claimed to infringe the Grelle patent was a practical one.”

(See also *Zidell v. Dexter*, 262 F. R. 145, and *Crane and Breed Mfg. Co. v. Elgin Silver Plate Co.*, 268 F. R. 543.)

CONCLUSION.

It is submitted, in conclusion, that the plaintiff-appellant has brought to this Court a cause of action which has no basis in equity—

1st. Because the design of the patent in suit embodies only what was taken from a well developed prior art and is therefore devoid of invention.

2nd. Because every element of the device shown in the patent in suit has a functional purpose and characteristic and no other and that no part of the structure could be omitted so modified as to materially change the design without omitting or materially changing such functional characteristic, and, therefore, the design is not “ornamental” within the meaning of Section 4929, R. S. U .S.

3rd. Because the wide marginal flange, which surrounds the reflector of the plaintiff’s design and constitutes a striking and important feature of it has no counterpart or equivalent in defendant’s design.

4th. Because the relation of the heating unit to the reflector in defendant’s heater differs so radically from that of the corresponding elements of the patented design as to establish non-infringement, the difference being such as to make an instant and striking impression upon the sight and mind of one of plaintiff’s own witnesses.

5th. Because the supporting member of defendant’s heater is so strikingly different from that of plaintiff’s heater that the most casual observer, if possessed of normal intelligence and power of vision, could not mistake the one for the other.

6th. Because every element of defendant's design and the design as a whole were taken from the prior art and, therefore, could not have been taken from the plaintiff's patent unless it constituted the medium through which the information was transmitted.

SUGGESTED MISTRIAL.

Appellant suggests a mistrial and consequent invalidity of the decree upon three grounds:

1. That Judge Dietrich decided the case and wrote his opinion while in the State of Idaho.

2. That Judge Dietrich performed these acts on October 4, 1920, subsequent to the expiration of the period during which he was designated to hold court.

3. That the decree was signed by Judge Bean, who did not decide the case.

The first answer, applicable to all these contentions, is that appellant must be deemed to have waived any possible error and is estopped to urge error because of appellant's failure to raise these objections before the entry of the decree and because of the fact that counsel for appellant himself prepared the decree and procured Judge Bean to sign it. Upon well settled principles, appellant cannot complain of a proceeding which it has induced and for which it is responsible.

Whipkey v. Nicholas, 34 S. E. 751 (W. Va.);

City of Oakland v. Hart, 129 Cal. 98;

Madden v. McKenzie, 144 Fed. 64 (C. C. A. 9th Cir.);

Ellington v. State, 123 Pac. 186 (Okla.).

There are further answers to each specification of mistrial.

1. There is nothing in the record to support appellant's statement that Judge Dietrich decided the case or took any other action while in Idaho. This is a gratuitous assumption on the part of appellant.

2. The decree contradicts appellant's statement that the case was decided and the opinion written on October 4, 1920. The decree declares:

“and thereupon after consideration thereof it was, on the 4th day of September, 1920, ordered that the bill of complaint be dismissed with costs to defendant, and that a decree be signed, filed and entered accordingly.” (Transcript, p. 36.)

Thus, it appears on the face of the decree that Judge Dietrich decided that case and completed his judicial function in September in strict conformity to the order of designation.

It is well settled that a recital in the decree is conclusive in support of its validity. But even if we look elsewhere in the record we find nothing to contradict the recital that the case was decided on September 4, 1920. It is true that there is in the record evidence to the effect that the opinion of Judge Dietrich was *filed* on October 4, 1920. This is found in the filing mark on the opinion (Tr. p. 35) and the recital in the clerk's minute order entered on the filing of the opinion. (Tr. p. 19.)

There is no necessary conflict here. The record would merely indicate that the opinion was written

and the cause decided in September, but that the opinion was not actually filed until October 4. This does not militate against the conclusion that Judge Dietrich had completed his task in September.

But, even assuming that there is a conflict between the recital in the decree that the order for dismissal was made in September and the recitals elsewhere in the record that such order was made in October, this conflict will be resolved so as to uphold the decree. The Court will not indulge in the contrary view for the purpose of accomplishing a reversal.

In *Western Union Tel. Co. v. Jackson*, 46 S. W. 279 (Tex.), it was held:

“The trial court’s conclusions of fact and law are marked filed, five days after the court adjourned for the term; and it is contended that they should not be considered, and error is assigned upon the alleged failure of the court to file such conclusions before the court adjourned. If it be conceded that the conclusions of fact and law could not be properly filed after the court adjourned for the term, still no ground for reversal is shown. The concluding part of the judgment is in these words: “Thereupon, on the request of defendant, the court filed his conclusions of law and facts; and, the same having been done, the defendant, in open court, excepts.” The judgment was rendered on the 28th day of October, 1897, which was three days before the court adjourned; and the solemn declaration made by the court, and incorporated in the judgment, to the effect that the conclusions of law and fact were then filed, should override and control the file mark indorsed upon the findings by the clerk.” (Page 280.)

In *Conrad v. Baldwin*, 3 Iowa, 207, it was held:

“The record leaves it doubtful when the defendant’s *answer* was filed. At one time stating it to be on the 8th—at another, on the 16th of April. Under such circumstances, we will presume it to have been filed on the day first named, for on this hypothesis, the action of the court below is clearly correct; and every presumption should be given in favor of such action. When a record presents conflicting dates as to any fact in a case, being governed by one of which, we would find error, while by the other, there would be no error, we should be guided by the one which will sustain the judgment below” (pp. 208-9).

To the same effect:

Davis v. Lezinsky, 93 Cal. 126.

As to the rule of presumption in favor of the validity of the decree, see:

The Alaska, 35 Fed. 555;

Weichen v. U. S., 262 Fed. 941;

Stockslager v. U. S., 116 Fed. 590 (C. C. A. 9th Circ.)

In conclusion, on this point, the order designating Judge Dietrich to hold court during August and September conferred authority on him to decide thereafter a cause which had been tried and submitted to him during the designated period.

The validity of judicial acts performed at times and under conditions not covered by express authorization is fully considered in *Shore v. Splain*, 258 Fed. 150, and the conclusion reached in that case is based upon principles of law and decisions that are controlling here.

In the case cited, Judge McMahon, a municipal court judge, was designated to act as judge of the police court pursuant to the act of Congress of February 17, 1909. The designation authorized Judge McMahon "to discharge the duties of either of the judges of the police court during their sickness, vacation or disability". Shore was tried and convicted by Judge McMahon. On the day of sentence, the two police court judges were in court discharging their duties. In upholding the sentence the Court of Appeals quotes from *Fisher v. Puget Sound Brick Co.*, 76 Pac. 107 (Wash.) as follows:

"That the return of the regular judge would not oust the special judge of jurisdiction to try and finally dispose of any case begun before him."

The Court of Appeals concludes:

"Between the submission of a case and its final disposition weeks may intervene, and if during that period the justice whose place the additional justice had taken must remain away from the court, although ready to act, it would greatly impede the dispatch of the public business here."

In *Roberts v. Wessinger*, 48 S. E. 248 (S. C.), a special judge was commissioned to hold court for an extra term ending November 28, 1903. The cause was heard and submitted to him on the last day of the term, and he then returned to his home where, several days later, he wrote the decree. He then forwarded it to the court for filing. On appeal it was objected that his jurisdiction was at an end at the expiration of the time mentioned in his commission. This contention was rejected and the decree upheld.

3. The signing of the decree was a purely ministerial act properly performed by the judge, who at the time was presiding in the court. It called for no exercise of discretion and for no judicial consideration of the issues of fact or of law. It was a pro forma proceeding in which it was unnecessary for the judge who had tried the case to participate.

In *Montgomery v. Viers*, 114 S. W. 251, it was held:

“The entry of the judgment is the act of the clerk; its signature the act of the judge. But it is not an act involving the exercise of discretion. It is ministerial, and, if there appears no good reason to the contrary, the judge may be compelled to sign a record which in law it was his duty to sign unconditionally. The judgment which was rendered (if one was) was the act of the court. Its recordation having been complete, as it is alleged it was, it remained only for the judge to sign it. Having died before signing it, the act loses none of its efficacy so far as it had gone; the matter had none the less passed into judgment. The suggestion that the respondent may not have such personal knowledge of what originally transpired as to warrant his accepting the entry as true is unsound. The personal recollection of the judge, though it may be exercised in approving the record originally, as the statute implies it may be, is rarely, if ever, resorted to to supply evidence even in aid of the record evidence in entering a judgment *nunc pro tunc*. If, then, the former judge could not properly have called his personal recollection of the matter to his aid in determining what judgment had been previously rendered, but would have been required to look alone to the files and record of the suit, what difference can there be that another is required to do the same, no more nor less? The present official can examine the record. He can see whether it imports a regular entry, and whether it is writ-

ten by the clerk who recorded the other entries of the time. He can see whether the summons had been served in due season, or whether the record shows that the defendants had appeared. He may examine the minute book and docket of the court. And from all these sources of record evidence can determine whether the judgment is correctly entered, and thereupon sign it, or though not entered, to enter it now for then, thereby securing the plaintiff in such rights as legally accrued to him by its virtue but for the omission complained of by which the record was not formally completed."

In *Ruckman v. Decker*, 27 N. J. Eq. 244, Chancellor Zabriskie filed his opinion on February 13, 1873. A decree signed by his successor in office, and filed June 11, 1873, was upheld.

See also *Grim v. Kessing*, 89 Cal. 478, 489.

Objections of the character now under discussion are not here presented for the first time. In *Stead v. Curtis*, 205 Fed. 439, the petition for rehearing raised every conceivable contention against the authority of Judge Dietrich to act as a member of this Circuit Court of Appeals pursuant to an order designating him to sit for the February, 1913, term. But the petition was denied without opinion. The same points were urged in a petition to the United States Supreme Court for writ of certiorari and there met the same fate. (234 U. S. 759.)

Wherefore, it is submitted that the decree of the District Court should be affirmed.

Dated, San Francisco,

March 5, 1921.

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