

12
Nos. 3616, 3617 and 3618

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

MAJESTIC ELECTRIC DEVELOPMENT COMPANY,
Plaintiff and Appellant,
VS.

WESTINGHOUSE ELECTRIC & MANUFACTURING
COMPANY,
Defendant and Appellee.

BRIEF ON BEHALF OF HOLBROOK, MERRILL
& STETSON AS AMICI CURIAE.

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Amici Curiae.

FILED

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Statement of the Case.

The plaintiff appellant has involved in this litigation a mechanical patent 1,245,084, granted October 30, 1917, and two design patents, 51,043 granted July 17, 1917, and 51,253 granted September 11, 1917.

Three separate suits were brought by the plaintiff against the Westinghouse Company, one on each of these three patents, and each suit charging the same device manufactured and sold by the Westinghouse Company as an infringement. These separate appeals are taken in these three cases.

The plaintiff brought a further suit against Holbrook, Merrill and Stetson upon the mechanical patent 1,254,084, and the design patent 51,043 involving both of these patents in the same suit.

These four suits were all tried at the same time before Judge Dietrich, and were all decided adversely to the plaintiff in a single opinion entitled in all the four cases.

Before the conclusion of the trial, the plaintiff filed a fifth suit in the same court against Holbrook, Merrill & Stetson charging infringement of the second design patent 51,253, the pleadings have been closed, a stipulation agreed to that the same evidence taken in the other four suits may be used in the fifth suit, and the trial of this fifth suit is awaiting the outcome of the present appeal.

The plaintiff has taken the three appeals here before this court on the three cases involving the Westinghouse device, but it has not appealed the case involving the Holbrook, Merrill & Stetson device, which is known under the name Simplex, and which is of very similar construction to the Westinghouse device. The plaintiff is within its technical rights in thus separating the appeals, and it has until April 8th next within which to take an appeal in the Holbrook, Merrill & Stetson case.

But this strategic move on the part of plaintiff has obviously left the defendant Holbrook, Merrill & Stetson in an embarrassing position. This court has recognized the situation by allowing Holbrook, Merrill &

Stetson to appear and be heard on these appeals as *amici curiae*.

The substantial issues raised between the plaintiff and these two defendants, the Westinghouse Company and Holbrook, Merrill & Stetson, are substantially the same, although Holbrook, Merrill & Stetson have presented additional evidence in their case, and some of the evidence presented by the plaintiff in the cases against the Westinghouse Company is not applicable to the case against Holbrook, Merrill & Stetson. Nevertheless, the decision which this court will arrive at on these appeals in the Westinghouse cases will, in all probability not be determined by these differences and will so control the decision on an appeal in the cases against Holbrook, Merrill & Stetson.

**A SEPARATE CONSIDERATION OF THE THREE APPEALS IS
NOT EQUITABLE.**

We respectfully submit that it is neither fair nor conducive to a correct understanding and a right decision of the matters in litigation between these parties that these three patents should be considered entirely separately and apart from each other.

The plaintiff has not so considered these patents.

(1) In notices sent to each defendant prior to the litigation it charged all three patents to be infringed by the same device.

(2) In the suit against Holbrook, Merrill & Stetson the mechanical patent and one of the design patents were joined.

(3) The bulk of the evidence in all four of the cases tried is substantially the same.

(4) The cases were all tried at the same time in immediate sequence.

(5) The cases were all argued together as a single case before the lower court.

(6) The cases were all decided in a single opinion by the court below.

(7) The three cases against the Westinghouse Company are all to be argued together before this court.

We shall therefore present the same brief as *amici curiae* in all three of these appeals in order that the court may properly appreciate the relation of each patent to the other, and to the defendants' devices.

THE MECHANICAL PATENT 1,245,084, AND THE DESIGN PATENT 51,043 ARE DIRECTED TO PRECISELY THE SAME DEVICE.

These two patents which were involved in two separate suits against the Westinghouse Company, and in a single suit against Holbrook, Merrill & Stetson are attempts to obtain a monopoly of precisely the same thing from two different standpoints. Observing the drawings forming a part of these patents, it will be seen that the same device is illustrated in both. The shape or configuration of the device is the same in each case.

It was the object of the mechanical patent to provide and cover certain protective features; *first*, the dead air space behind the reflector, and, *second*, the

annular marginal flange around the edge of the reflector. The provision of these two features was what, and what alone, produced the shape or configuration made the subject of the design patent.

The design patent is therefore purely and simply nothing but a copy of the mechanical patent, and every element disclosed therein is there solely for functional purposes, with no idea of an invention in an ornamental or pleasing effect.

This point we shall further elaborate, but this fact fully established on the very face of the record brings the design patent 51,043 within the well-established rule so clearly stated by this court in *Ferd Messmer Mfg. Co. v. Albert Pick & Co. et al.*, 251 Fed. 894. In that case, as in the case at bar, both a mechanical patent and a design patent upon the same thing were involved. The device was an ordinary glass tumbler formed with an annular bulge slightly below the upper edge. The object of this bulge was to prevent breakage or injury of the tumbler edge if the tumbler fell over. In that case, as has been suggested here, there had been commercial success, large sales of the patented tumbler having been made at a price twenty per cent greater than other tumblers on the market. The defendant copied the construction so closely that its tumblers could not be distinguished from the plaintiff's. This court held the design patent invalid, saying:

“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, Sec.

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.”

*
THE MECHANICAL PATENT, 1,245,084.

The specification of this patent is brief; it comprises less than a single page. It will take but a moment's examination to show that this patent on its face recognizes that it discloses nothing of a primary character, that it discloses no fundamentally new principle, and that it is restricted to minor details which, but for the vigor and extent of this litigation, we would not hesitate to characterize as trivial.

We note at the outset:

(1) No claim is anywhere made in the specification that the device produces a “beam”.

(2) No claim is anywhere made in the specification that the reflector is or should be parabolic in shape.

(3) No suggestion is anywhere made that the reflector is to be made of, or coated with, copper.

(4) No claim is anywhere made to the use of the necessary nichrome resistance wire.

(5) No claim is suggested as to any novelty in the wire guard.

It is a most singular thing, and most significant, that the patent itself not only fails to assert as novel, but also fails even to mention, those things which the plaintiff now asserts to be the controlling factors in the case.

The patentee Brown filed his application July 10, 1917, or about a year after, according to his own testimony; he had manufactured and placed these devices on the market, and yet in this patent he *does not even mention* the idea of the copper bowl, the idea of a parabolic or similar reflector, or the idea of the beam-like projection of the radiant rays of heat.

Brown, when he filed his application, was required by Section 4888, R. S., to

“explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.”

At the outset Brown pointed out that his invention related to a generally old type of device, saying:

“This invention relates to electric heaters in which the heat waves are generated by a resistance coil or heating unit and are then reflected from a highly polished surface” (page 1, lines 9-12).

He next proceeded to state the object of his invention, and, in a single paragraph, he stated but a single object, as follows:

“One of the main purposes of my invention is to provide an electric heater or radiator in which the highly heated portions are inclosed by protecting members, but one readily accessible for examination or repair” (page 1, lines 13-17).

What now were these “protecting members” which embody the only stated purpose of the alleged inven-

tion? They are clearly and definitely stated in the following language:

“The air-space 5, between the reflector plate 1 and the casing 3 prevents the latter from becoming heated. In order to prevent the outer exposed edge of the heater from being heated I provide the casing with a marginal annular flange 3a” (page 1, lines 60-65).

The four claims of the patent are of the most limited character. Claims two, three and four are devoted to the most trivial details, and have been withdrawn from consideration on this appeal. Even claim one, which is the only claim now before the court, does not claim both of these protective features, but only the “annular member extending outwardly from the margin of said reflector”, and that in combination with the old wire guard, and other old features.

During the progress of the application, the Patent Office Examiner inquired more particularly as to just what was this annular member, and as shown by the file wrapper, the applicant replied “it is the flange, 3a, shown in the drawing”, thus emphasizing the distinctive feature of his device.

It is unnecessary here to consider whether these two protective features thus made the subject of this patent are or are not of substantial value. *The essential point to note is that they, and they alone, constitute the sole object and purpose of the alleged invention.*

The plaintiff in this type of heater has always used a spool-like heating element, extending *transversely*

across the face of the reflector, and it is consequently obvious that with this unsymmetrical arrangement the heat reflected from this element on to the reflector must heat the reflector unevenly. It may well be, therefore, that the patentee conceived it desirable to provide these two features, *first*, the outer casing forming with the reflector the dead air space, and *second*, the annular member or flange extending outwardly from the margin of the reflector. In any event, the invention of the patent is based on the theory that these two protective devices are necessary.

This gives the reason for the mechanical patent, and determines the essential shape disclosed in the design patent.

But the defendants' devices, both the Westinghouse device and the Simplex device of Holbrook, Merrill & Stetson are constructed on an entirely different theory. In both defendants' devices the heating element is arranged not transversely, but axially of the reflector, and consequently the reflector is not unevenly heated. The theory in the defendants' devices is that no protective features, either in the nature of dead air space, or in the nature of an annular flange or member extending outwardly from the margin of the reflector are necessary.

Both of the defendants' devices correspond substantially in their final and complete shape to the reflector element 1 shown in the drawings of the Brown patent. That is to say, if the extra casing 3 and the dead air space feature are removed, and if the annular

flange or member 3a is removed from the plaintiff's device, there is left the reflector member 1 corresponding closely in function, shape and appearance to the defendants' devices.

We respectfully submit, therefore, that it is absurd to argue that when the two features, which constitute the sole object and purpose of the plaintiff's alleged mechanical invention, and which determine the characteristic appearance of the plaintiff's alleged design, are bodily removed, what is left can be an embodiment of either invention. And yet what is left corresponds to the defendants' structure in each case.

THE BEAM HEATER IDEA.

It is somewhat difficult to follow counsel for the plaintiff in his discussion of the fundamental principle of the invention, and at the same time have any regard for the undisputed evidence.

Many statements in plaintiff's brief and the cut appearing opposite page 12, would seem to indicate that the plaintiff claims that the patented heater produces a cylindrical beam of radiant energy. Much is said about the use of a parabolic reflector by the plaintiff, and the claim is made that this heater "produces a perfect shaft or beam of radiant energy" (page 12, Brief in 3617), and the prior art is distinguished because "they did not produce a *cylindrical* shaft or beam of parallel rays) (page 40 *idem*). Again the same brief on page 58 appears to state that

Brown has "a homogeneous cylindrical shaft or beam of parallel rays".

If the claim is that plaintiff's device produces a cylindrical beam, it is utterly unwarranted. It is sufficient to refer to the testimony of Mr. Henry, plaintiff's own expert. On pages 114 and 115 in the record of No. 3617, he discusses the nature of the beam produced by the plaintiff's heater and the Westinghouse heater, and concludes by saying,

"but in both cases you will get a decided heat beam 10 feet in diameter, or 10 feet wide, I will say at a distance of 9 feet from the unit".

In other words, there is nothing even approximating a cylindrical beam produced either by the plaintiff's own exemplification of its patent, or by the defendants' device.

It is admitted and is obvious that the only possible way in which a cylindrical beam could be produced would be by the concentration of the heating element at the focus of a parabolic reflector, but this is physically impossible even of close approximation. All the heating elements employed in these devices for many years have been relatively large, and have not even approximated a focal location. No part of the plaintiff's element is or can be at the focus, and the drawing inserted in plaintiff's brief (e. g. opposite page 12, in No. 3617) is entirely misleading.

There was nothing whatever novel in the idea embodied in these heaters of a general localization of the heat by reflecting the rays of radiant energy on to

the object to be heated. This has been done from the very beginning of the history of the art, and in many instances, with a much greater degree of concentration than that employed by either the plaintiff's or defendants' devices.

All that the Brown patent in suit sought to accomplish was to gather up and reflect forward upon the object the rays of radiant energy from the heating element.

We have already noted that Brown nowhere in his patent claims to form any particular kind of beam. He says nothing about it. He does not even describe any particular shape of reflector. In line 24 of page 1 of the mechanical patent he calls it "a concavo-convex reflector", and in the claims, he uses the same language, as, for example, in lines 84 and 85 of claim 1, the only claim before this court, where he recites "a concavo-convex reflector". He was thus describing his reflector by precisely the same language which had been used long before in the Warner patent for a similar device.

THE PRIOR WARNER HEATER.

Warner in his patent 1,120,003, granted December 8, 1914, described the reflector as "a reflector, b, of concavo-convex form" (page 1; lines 19-20), and in his claims described it as "a concavo-convex reflector mounted on the standard".

The reflector of this Warner patent, exactly as in the patent in suit, is illustrated and described as "of

concavo-convex form". Just what its precise shape is, that is, whether parabolic or hemispherical, is quite immaterial, either from the standpoint of function or of appearance. The plaintiff's brief in No. 3617 in discussing this patent at page 34, says:

"It shows a large hemispherical bowl of concavo-convex form, which is called in the patent a reflector."

We may accept this statement as true because, as we have noted, and as very clearly set forth in the same brief, the precise shape makes no difference. Plaintiff's counsel in the following statement on pages 10 and 11 of the same brief evidently has in mind the matter of infringement. But any rule which provides a test for identity in the matter of *infringement* necessarily makes the same test applicable for identity in the matter of *anticipation*. Plaintiff's brief says:

"The parabolic reflector is therefore the most perfect form for the projection of radiant energy. If, however, instead of having a perfect parabolic reflector, we have one approximating thereto, such as the segment of a circle, or, popularly speaking, a hemispherical reflector, then practically the same result will follow as in the case of a parabolic reflector. The difference will be manifested only in a slightly less perfect form of the shaft or beam. This difference, however, is so slight as not to be appreciable from a utilitarian point of view. Hence, we may say in a popular sense that the results in the two cases are the same, at least this is true in the sense of the patent law, which looks upon substantiality rather than upon minute variance."

This is a substantially correct statement, and we may accept it. The Warner patent was cited in the prosecution of the Brown mechanical patent in suit by the Patent Office, and was one of the compelling reasons for the acceptance of the narrow and specific claims which appear in the Brown patent. Warner showed the extra casing with the dead air space, but he did not show the protective annular flange or member extending outwardly from the margin of the reflector. Warner simply showed the small finishing bead or turned over edge of the reflector, which is employed both in the Westinghouse and the Simplex devices of the defendants.

The Warner patent, like the Brown mechanical patent in suit, says nothing about the use of copper for the reflector bowl, but that was an old feature and was actually embodied in the Warner devices, manufactured and sold under the Warner patent, a sample of which is in evidence as "Plaintiff's Exhibit 8".

THE PRIOR KEMPTON HEATER.

The substantial idea is shown in the Kempton British patent, No. 12,320 of 1848, where the heating element was a gas burner "placed in the focus of the parabolic or other shaped reflector, and the heat to be reflected into the apartment". The court below considered the Holbrook, Merrill & Stetson case, along with the Westinghouse cases in its opinion, and said:

"In English patent No. 12,320, Kempton claimed that by the use of a reflector of 'parabolic or

conical shape', located in a fireplace or in open space, for the purpose of throwing the heat into the room, gas could be used for heating purposes as cheaply as coal. He shows a gas jet in the same relation to the reflector as here the resistance coil."

Plaintiff's counsel complains in his brief because this patent was not technically offered in evidence in one of the Westinghouse cases. That may possibly be so, but it was offered in evidence in at least one of the cases which were all tried at the same time. We cannot believe that plaintiff's counsel really desires this court to shut its eyes to this ancient matter of historical interest clearly and fully disclosing the same fundamental idea applied nearly three-quarters of a century ago with gas as the heating element.

THE PRIOR MORSE HEATER.

The same fundamental idea appears in the Morse patent, 88,107, March 3, 1908. In this patent the heating element was an incandescent lamp located in front of a hemispherical shaped reflector, and the patentee said,

"when the electric light is turned on, the heat developed within it is reflected downwardly by the shell toward the surface of the body against which the lower edge of the shell rests. In this way when the device is properly applied the heat from the light is concentrated at the desired point" (page 1; lines 45-51).

The Morse patent also described the reflector or body of the device as one "which consists of a shell or hem-

isphere", so that applying the rule laid down by the plaintiff, and just referred to, we here have the same shaped reflector. Plaintiff argues that this is a therapeutical device, but it is entirely inconsequential whether the reflected radiant energy is utilized for this purpose or merely for comfort. Plaintiff's counsel on page 19 of his brief in No. 3617,

"But however that may be, the specification does not show or mention a reflector of any kind."

Evidently the plaintiff's counsel has not read the patent. In the quotation just given, the word "reflected" is used, and further on, beginning at line 72, the specification states:

"The feature of mounting the electric lamp in a horizontal position within the *reflector*, is considered highly advantageous, as by this arrangement, the lamp projects its *heat* more efficiently on to the surface of the body."

THE PRIOR FERRANTI HEATER.

Again the same fundamental idea appears in the Ferranti device. This is shown in a large number of publications, including defendants' Exhibits Nos. 1, 2, 4, 11 and 12, and others produced in the Holbrook, Merrill & Stetson case. No sample of the device has been offered in evidence, but it is very fully illustrated and described, and was extensively advertised. One of the best illustrations of the device is in the defendants' Exhibit No. 12, "Supplement to the Electrician" of September 20, 1912. It will be noted therefrom that the reflector was similar in shape to those here involved.

Its stated diameter of 18 inches makes it correspond in size closely to both the defendants' devices. Various forms of standards or pedestals were employed, and the form shown in the small cut at the left hand side of page 1 of this exhibit is similar to that shown in the patents in suit. This exhibit also describes the use of the "removable wire guard * * * covering the reflector", and quoting a price therefor of 10 shillings, 6 pence. In defendants' Exhibit No. 2, the Ferranti reflector is described thus,

"By means of a *bowl-shaped copper reflector* surrounding the heating surface, and carried on trunnions, the heat rays can be focused in any desired direction."

In the same paragraph a form of wire guard is described as,

"secured to the outer edge of the copper reflecting bowl".

In defendants' Exhibit No. 1, "The Electrical Times" for January 5, 1912, the reflector is thus described,

"a *circular bowl of polished copper*, which concentrates and reflects the heat rays * * * there is considerable radiant energy, and owing to the reflecting properties of the bowl, this can distinctly be 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 PRIOR CALOR HEATER.

The Calor heater is another of these devices illustrated and described in a number of publications, in-

cluding defendants' Exhibits Nos. 5 and 7, the "Electrical Times" for March 6, and October 9, 1913. The latter publication in figure 3 shows the concavo-convex reflector mounted on the pedestal type of standard. While the reflector is not described in this particular form as of copper, other forms are described as having the reflector of "polished copper".

THE PRIOR PLEXXIM HEATER.

The Plexsim heater is made the subject of British patent No. 19,971 of 1913, and is also illustrated and described in a number of publications, two of which appear as defendants' Exhibits Nos. 8 and 9, the "Electrical Times" of December 4, 1913, and the "Supplement of the Electrician" of October 16, 1914, respectively.

The plaintiff's counsel in his brief seems to be much worried, and rightly so, over the disclosures with respect to this Plexsim heater. Many other disclosures were produced in the Holbrook, Merrill & Stetson case, but those referred to are sufficient. This device is of interest because it embodies (1) a yoke shaped pedestal in which the reflector swings on trunnions as in the case of defendants' devices; (2) the parabolic copper reflecting bowl; (3) the arched wire guard springing from the margin of the reflector (a flat wire mesh guard is also shown, but that is an alternative); (4) a spool-like heating element extending axially of the reflector as in the defendants' devices, and not transversely as in the plaintiff's device; (5) the use of the same wattage, namely 600, as employed by the plaintiff and defendant.

The "Electrical Times" of December 4, 1913, defendants' Exhibit No. 8, contains a diagram showing the beam-like action of the Plexsim heater, and the article describing it states:

"The heater is of pedestal form, with cone-shaped reflector of polished copper, which is pivoted at the center, so that it can be swivelled to any angle. The heating element is arranged horizontally through the center of the reflector from the apex to the base, and consists of a special resistance alloy wound spirally over a fire clay carrier. * * * When on circuit the appearance is that of a glowing circle of fire, which produces a most cheerful effect, *the heat rays being thrown forward in a more or less parallel beam* in any direction, according to the angle at which the reflector is swivelled. * * * although the efficiency of the device is neither more nor less than that of any other electric heater in which the whole of the energy absorbed is given out in useful heat, *the user may receive a greater proportion of this heat owing to the concentrating and focusing properties of the specially shaped reflector used.*"

The British patent under which this heater was made repeatedly describes the copper reflector, the parabolic form, the beam-like reflecting action and the axially arranged heating element. We copy the following excerpts from this remarkably full disclosure:

"the object is to provide an apparatus of convenient form in which the *radiant heat* issues in the form of a *condensed beam* of rays".

"The reflector is * * * usually made of or lined with sheet copper, the inner surface being highly polished."

"the reflector may be in whole or in part of *parabolic* or the like contour according to the form desired for the *emergent beam of rays*".

“We prefer to mount the reflector pivotally on a forked stem * * * so that the *beam of rays* can be turned to point in any direction.”

“a reflector, the section of which on a plane containing said axis, is the frustum of a cone, or of *parabolic configuration*”.

“The reflector is so mounted * * * as to reflect the emergent rays in any desired direction.”

“A. is the conical reflector, which may be made wholly of copper * * *. The inner surface is highly polished.”

“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*”.

The claims are directed to the combination of the “conical or *parabolic* reflector”, with the heating element arranged like the defendants’ devices “so as to lie on the axis of the said reflector”.

It is idle for the plaintiff to dispute the full, accurate and detailed disclosures of this Plexsim heater, and to discuss trivial details such as the alternative corrugations described. Tested by any rule which may be laid down, we have here a complete anticipation of the main idea of this type of heater.

It is true that the Plexsim heater does not show, and did not have, the two protective features of the plaintiff’s patent, (1) the extra casing forming the dead air space behind the reflector, (2) the marginal annular protecting flange. These are the only things which the plaintiff sought or suggested as novel in his patent, but neither of these things are present in any of the defendants’ devices.

THE PRIOR REDGLO HEATER.

The Redglo heater is shown in the British patent to Martin, No. 2764, of 1912, which was cited by the Patent Office during the prosecution of the application for the patent in suit, and one form is advertised and described and illustrated in the "Supplement to The Electrician" of October 3, 1913, "Defendants' Exhibit No. 6". These disclosures are only of general interest, it being noted that the patent describes the

"reflector of a comparatively wide angle to throw out the radiated heat in any desired direction",

and points out that any style of stand or pedestal may be employed.

"The radiator above described may be used, however, with any other convenient form of support or stand, and this is mentioned by way of example only as a suitable form of support."

SUMMARY AS TO THESE PRIOR HEATERS.

Plaintiff's counsel complains that there is no evidence that these various devices were sold in this country. But what of it. The statute makes a complete bar to a valid patent here the fact that the device is

"patented or described in any printed publication in this or any foreign country" (Sec. 4886, R. S.).

It is seldom that a case contains such a wealth of clear and definite illustration and disclosure as appears in these foreign patents and publications setting forth the Plexsim and Ferranti Electric heaters. So far as the features common to plaintiff's and defendants' devices

are concerned, this disclosure is far more full, complete and accurate than is the disclosure of the Brown patent in suit.

THE PRIOR MAJESTIC OR SHOENBERG HEATER.

The earlier Majestic or Shoenberg heaters present a state of the art which is sufficient alone to explain why it was impossible for Brown in his mechanical patent in suit to urge novelty for anything more than trivial details, and in his design patent in suit, to include the destructive wide marginal flange.

We are at an utter loss to understand the allegation of plaintiff's counsel in his brief that these earlier Majestic devices were "abandoned experiments". It is absurd to argue, in view of the record in these cases, that these devices were experimental. Unquestionably they were not so successful as money-makers for the plaintiff company as its present device, but the reason is not far to seek.

The plaintiff did not use in any of these devices the glowing polished copper bowl, which is the outstanding, predominant and distinctive feature. This is the thing which catches the eye, which gives the "pleasing appearance", and which gives a highly efficient reflection, for as Mr. Henry, plaintiff's expert, says:

"Polished copper is a highly efficient surface for the reflection of radiant heat waves" (Record in 3617, page 102).

Let us make this matter perfectly certain by quoting Mr. Brown himself.

“Never prior to our No. 7 heater did we market a heater of portable type having a burnished copper reflector” (Record in 3617, page 125),

and by quoting plaintiff’s expert Mr. Henry, in discussing these earlier Majestic heaters,

“These exhibits are of nickel or of nickeled surface, and as such are not nearly as efficient in the reflection of the radiant heat rays” (Record in 3617, page 100).

But that these earlier Majestic heaters were extensively manufactured, sold and used can not be questioned.

These earlier heaters were made in slightly different forms known as No. 1, No. 2, No. 3, No. 1b, No. 2b and No. 3b, and samples of the actual devices are in evidence. The record in No. 3617 contains the following stipulation at pages 76 and 77,

“Plaintiff’s counsel admitted that the early Majestic devices 1, 2 and 3, hereinbefore referred to, were made and sold more than two years prior to the filing of the application for the patent in suit, but the manufacture and sale of the other devices referred to as 1b, 2b, and 3b were not made until the fall of 1915” (The latter date being prior to Brown’s invention),

and similar stipulations appear in the other records.

Various circulars of the Majestic Company illustrating, describing and advertising these devices are in evidence. The “Electrical Record” for May, 1915, defendants’ Exhibit No. 16, illustrates and describes one of them. Mr. Brown’s testimony on pages 120 and 121 in No. 3617 shows that all of these were manufactured and sold, and on cross-examination he testified,

“Our sales of the previous heaters, Nos. 1, 2 and 3, and 1b, 2b and 3b, were not confined to the Pacific Coast” (page 124, Record 3617).

There is also in evidence, as defendants' Exhibit E. a large photograph showing a most remarkable display of these earlier Majestic heaters at the Panama Pacific Exposition, prior to May, 1915.

The Shoenberg patent 1,109,551, granted September 1, 1914, is in evidence, and was cited by the Patent Office in the examination of the application for the Brown mechanical patent. The plaintiff's present form of heaters bear name plates in which they purport to be manufactured under this patent (Record 3617, page 42). This patent is of particular interest in showing the form of pedestal, the form of heating coil, and the form of arched wire protecting guard universally employed by the plaintiff. It also shows the dead air space behind the reflector, but this does not appear to have been used in the earlier heaters.

The attempt of plaintiff's counsel in his brief to differentiate the form of beam produced by the earlier Majestic or Shoenberg heater from that produced by the present Majestic heater accompanied by the misleading diagrams inserted in the brief, is without force when the heaters themselves are examined and the Shoenberg patent is read. The patent states beginning with line 48 of page 1,

“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.”

Another illustration of the Shoenberg heater, or earlier Majestic heater, substantially in the form known as the Majestic No. 3, a sample of which is in evidence as "Defendants' Exhibit D", the one having a glass knob at the top of the standard, appears in the British Taylor patent 102,070 of 1916, mentioned by the court below in its opinion in discussing the second design patent 51,253 in suit. Plaintiff's counsel seems greatly disturbed at this reference because this patent was only offered in evidence in the Holbrook, Merrill & Stetson case. It is quite immaterial, however, because the other disclosures of the prior Shoenberg or Majestic heater, formally in evidence in these cases, are amply sufficient.

It is doubtless true that the beam produced by the parabolic form of plaintiff's present commercial heater—a form which is not specifically mentioned or claimed in the patents in suit—condenses in a somewhat different manner the reflected radiant rays than the various forms employed in plaintiff's earlier heaters, but the difference is purely one of degree, and not one of principle. We might even accept the incorrect diagrams of the Shoenberg heater appearing in plaintiff's brief, when we bear in mind Mr. Henry's testimony previously quoted describing the beam produced by plaintiff's present heater and the defendants' heaters,

"but in both cases you will get a decided heat beam 10 feet in diameter, or 10 feet wide, I will say at a distance of 9 feet from the unit".

The important point to note is that none of these earlier Majestic heaters had the "annular member ex-

tending outwardly from the margin of said reflector", which distinguishes the single claim involved of the Brown mechanical patent, and which characterizes the appearance made the subject of the first design patent in suit. These earlier devices employed a finishing bead secured by turning back the peripheral edge of the reflector in much the same way as is done in the defendants' devices.

If we eliminate, as we must in considering either the question of anticipation or the question of infringement, the matter of relative size, the color whether nickel or copper, it is impossible to distinguish in a substantial respect, either in function or appearance, the Majestic No. 2 earlier heater from the defendants' heaters.

THE LIGHTING ART.

The lighting art is of interest because the laws governing the reflection of light and of radiant heat are the same. The court below brought out this point in a question the presiding Judge asked of plaintiff's expert.

"The COURT. Q. I want to ask one question. Should I desire to experiment with these various devices by the use of light, as I understand you, the laws of light are substantially the same as the laws of this radiant heat energy?

A. As regards reflection, yes.

Q. In other words, if they would throw a beam of light, they would throw a beam of heat energy.

A. Yes; in that case your light source should be the same size and position as the heat source" (Record in 3617, page 113).

Mr. Beam, beginning on page 136 of the same record discusses this matter at some length, but it is well known, and a matter of which the court may take judicial notice, that parabolic and similar reflectors have been used for many years in search lights, automobile head lights, and elsewhere, to reflect and project a beam of light and that the width and shape of the beam are varied as desired by the shape of the reflector.

A FLANGE VERSUS A BEAD.

There has been considerable discussion in the expert testimony in the record in these cases, in an attempt by plaintiff to suggest a similarity, by the use of words, between the "annular member extending outwardly from the margin of said reflector" of the claim of the Brown mechanical patent, and the finishing bead employed at the edge of the reflectors of the defendants' devices.

But we respectfully submit that all this talk is trivial. This court and this litigation is not concerned with *words* but with *things*. It is quite clear from the plaintiff's mechanical patent and from its first design patent that this "annular member" is a distinguishing feature of its invention, and is provided for a definite protective purpose clearly set forth in the mechanical patent. It is clear also that in the defendants' devices there is nothing but a strengthening bead or edge of the same character as employed in the Warner patent or in the earlier Majestic heaters.

We have already pointed out that if the annular flange or member 3a be bodily removed from the plain-

tiff's device, there still remains a reflector having a finishing bead or edge corresponding almost exactly to the defendants' construction.

It makes no difference what word or term be employed, the two things are different and are present for different purposes.

**THE ATTEMPT TO GIVE SUPPORT TO THE PATENTS BECAUSE
OF CONSIDERABLE COMMERCIAL SUCCESS.**

There is no doubt but that the plaintiff's devices, as well as those of a large number of responsible competing concerns, have had a very considerable sale, especially in this section of the country, but no degree of commercial success can give life to an alleged invention which is not novel, can broaden the terms of a claim beyond the substantial scope sought and obtained from the Patent Office, or make an infringement that which a defendant has a clear right to produce. Commercial success has always been recognized by the courts as an extremely unsafe criterion, either of invention or of infringement, only to be utilized in cases of grave doubt.

The extent of the plaintiff's business in these heaters is defined in a most nebulous manner. Brown testifies that up to the time of the trial, the plaintiff had sold in the neighborhood of 350,000 or 400,000, and that some had also been manufactured at Philadelphia (Record 3617, page 40). Hiller, who did the manufacturing, testifies that he should judge it was between 100,000 and 200,000 (same record, page 44). Shoenberg, the only other witness on this matter, testifies that he can-

not say as to the number sold (same record, page 43). This is sufficient to show the indefiniteness of the evidence. These men must have known, it was their business to know, and they could have informed the court just how many had been manufactured and sold, without leaving the figures between such a wide range as 100,000 and 400,000.

But assuming, as we may, that the sale has been considerable, the reason therefor is clearly disclosed by the record as something entirely apart from the embodiment in these heaters of the trivial details by which it is possible from any standpoint to distinguish these patents from the prior art.

The plaintiff's President Brown testified at length, but a careful study of his testimony fails to disclose any reason for the commercial superiority of this later form of Majestic heater, except where referring to "the trade", he says,

"They made the remark, 'Now, you have got something that looks right.' Never prior to our No. 7 heater did we market a heater of portable type having a burnished copper reflector" (Record 3617, page 125).

The court below was amply warranted in its findings in the paragraph of its opinion devoted to a disposal of this matter.

The adoption by the plaintiff of the glowing copper bowl taken bodily from the prior art, and to which neither patent in suit makes any claim, or in fact even mentions, is undoubtedly the thing which gave to these devices popular favor, but the plaintiff can take no ad-

vantage from his feature to which it never made any claim, and which was the common property of all.

The settlement of the Nichrome wire situation was undoubtedly another factor in the increase of plaintiff's business. This matter is fully discussed by Mr. Beam on pages 140 and 152 of the Record in 3617. It appears that the right to use this essential form of resistance wire was in litigation, and was not determined until late in 1915 by the decision of the Court of Appeals of the Seventh Circuit. We do not mean that the wire was not obtainable and was not being used before that time, but the whole matter was hanging like a cloud over the manufacturers of the country. After the decision sustaining the Marsh patent, almost the first thing that the plaintiff company did was to obtain a license to use this wire. Mr. Brown took a trip to the East in 1916 and obtained a license under the Marsh patent, and it was not until after the plaintiff obtained this license, that it began the sale of the heaters in question, and pushed them vigorously. The importance of this matter is further emphasized by Mr. Brown in his testimony giving the facts on page 42, Record 3617, when he states

“The price of our No. 7 heater is determined by two factors; one is the license agreement with the Hoskins Company, the patentees of the resistance wire which we use, who place a minimum charge on heaters of this type, and the second is the cost of manufacture.”

In other words, this license is so important that it determines the price at which the plaintiff's heaters are sold.

These two things, the adoption of the distinguishing burnished copper bowl reflector for the first time, and the obtaining of the important license under the Marsh patent, are of themselves sufficient to account for the increase in the plaintiff's business.

But as pointed out by the court below, the recent demand arising particularly because of the local conditions of climate and otherwise on the Pacific Coast, doubtless aided the increasing sales of the plaintiff.

But further, the record shows that almost at the same time the leading and most responsible electrical apparatus houses of the United States began the manufacture and sale of this type of device. It is sufficient to refer to Mr. Brown's testimony on this point, on page 118 of the Record in 3617, giving the names of these concerns, the Westinghouse Company, Simplex Electric Heating Company, Landers, Frary & Clark, Rutenber Electric & Manufacturing Company, Estate Stove Company, Hotpoint Company, Hughes Company, Edison Electric Appliance Company, and after giving these names the witness said:

“The manufacturers whose names I have just mentioned advertised their product pretty lively. The Hotpoint Company was a pretty big advertiser in everything. They advertised very liberally. They advertised in the Saturday Evening Post and some National Magazines; we advertised in the newspapers, and through circular matter, and at Expositions, Fairs, etc.”

It is not a source of wonder if, under these circumstances, a good many of these devices were sold, and, as the court below stated in its opinion,

“doubtless by means of advertising and the arts of salesmanship, the desire for said heaters was greatly stimulated”.

We respectfully submit, however, that the court below was clearly right in its conclusion after discussing this matter, when it said,

“But whatever may be the full explanation, such popularity as heater No. 7 may have had and may now have cannot reasonably be attributed merely to the slight change in the contour of the reflector or the addition of the broad annular flange, or to both of these changes.”

**THE RULE OF LAW FOR TESTING INFRINGEMENT OF A
DESIGN PATENT.**

The plaintiff's counsel in his brief has devoted a great deal of space to stating and re-stating the familiar rule laid down by the Supreme Court in *Gorham v. White*, 14 Wall. 511, as if there could be some controversy over this rule. This court has accepted this rule, and we know of no reason to controvert it.

But before this rule can be applied consideration must be given to two very important matters which the plaintiff's counsel entirely overlooks.

First, it must be determined that there is a valid design patent.

Second, if there be a valid design patent, the nature and extent of the invention covered thereby must be determined.

There can be no infringement of an invalid design patent. There can be no determination of infringe-

ment until we know just what the design is that is novel and patented.

Both of these points are passed over by the plaintiff's counsel and without regarding them, he marches directly to a consideration of the question of infringement.

This court has had before it and decided an unusual number of design patent cases, and has so fully, clearly and accurately stated the propositions of law which are controlling in the cases at bar that we would hesitate to re-state any of them, were it not for the nature of the briefs filed by the plaintiff.

**NOVELTY AND INVENTION ARE ESSENTIAL TO A DESIGN
PATENT.**

A design patent is required by the statutes to disclose an "ornamental" device, and this ornamental effect must not only be novel, that is, not substantially disclosed by the prior art, but it must be the result of inventive genius.

This proposition was clearly stated by this court a good many years ago in *Hammond v. Stockton Works*, 70 Fed. 716, involving a design patent for a form of open compartment street car which may still be seen in San Francisco. Judge Ross speaking for the court said:

"To entitle a party to a patent for a design under this act, there must be originality, and the exercise of the inventive faculty. This is so, because the Statute so declares, and because it has been so decided by the Supreme Court." (Citing *Smith v. Saddle Co.*, 148 U. S. 674, 679.)

In a little later case, *Myers v. Sternheim*, 97 Fed. 625, involving a design for a lamp stove, this court again speaking through Judge Ross said:

“The exercise of the inventive faculty is just as essential to the validity of a design patent as it is to the validity of a patent for any kind of a mechanical device.”

We do not understand that the court controverts the proposition asserted by the plaintiff that there need be a high order of invention, nor do we controvert that proposition.

The real point is that there must be *invention*—that is, the exercise of genius—in the production of the ornamental effect. This is the idea of the old and often cited case of *Northrup v. Adams*, 2 Bann. and Arden 567, where it was stated,

“There must be something akin to genius—an effort of the brain as well as of the hand. * * * If the effect produced be simply the aggregation of familiar designs, it would not be patentable. For example, if one should paint upon a familiar vase a copy of Stewart’s portrait of Washington, it would not be patentable.”

It makes no difference whether we refer to the shape or configuration constituting the design as being “ornamental” in the language of the statute, or as “of pleasing appearance”, in the language of plaintiff’s brief. The idea is that the invention must reside in this ornamental or pleasing effect, must be the result of some degree of inventive genius and must be novel.

It follows, therefore, that if the shape or configuration in question results solely from functional reasons,

that is to say, is the result solely of a functional purpose, it can not be an invention in a design. That is exactly the case here. All the features of the plaintiff's device are provided for, and owe their shape or configuration to, functional purposes. This we take it is just what the court below holds in its opinion, wherein it is said,

“But in the second place, in so far as they are alike, the plaintiff's casings, as well as those of the defendants are entirely devoid of purely ornamental features, either of form or drapery; they are nude utilities.”

The court below did not mean that it was necessary that there should be surface ornamentation to produce a patentable design. That would be absurd. It did mean, however, that where, as here, the shape arose solely to secure a required function, then there could not be an invention from a design standpoint. In this holding the court was in full accord with the authorities.

We have already referred to and quoted the bulged tumbler case, 251 Fed. 894, decided by this court on this very point.

Another case is that of *Bolte & Weyer Co. v. Knight Light Co.*, 180 Fed. 412, decided by the Circuit Court of Appeals for the Seventh Circuit. The subject matter in that case was not unlike that at bar, involving a lighting fixture with a reflector and support, pictures of the structures involved being shown in the report. The court affirmed the decision below, wherein it was said:

“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 adaption 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.”

Another case is that of *Rose Mfg. Co. v. Whitehouse Mfg. Co.* in the Circuit Court of Appeals for the Third Circuit, 208 Fed. 564. We quote from the opinion in 201 Fed. 926, which was affirmed on appeal:

“The statute (Rev. St. Sec. 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. 911, 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. 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, 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 recent case of *Backstay Machine and Leather Co. v. Hamilton*, 262 Fed. 411, the Circuit Court of Appeals for the First Circuit affirmed the decision of the district court on this point:

"The question presented, so far as the validity of the design patent is concerned, is whether the patentee in his article patent having conceived of a welt having a base with superimposed parallel beads or raised portions, mechanically constructed to function in a given manner, which may be of various shapes, and beads of some shape being essential to the functioning of the device, can be said to have exercised inventive thought of a character sufficient to warrant a design patent for a welt with beads or raised portions circular in cross

section. It seems to me to state the question is to answer it; that, having devised an article of manufacture with a base having parallel beads which may be of any suitable shape and beads of some shape being essential to constitute the article, it cannot be invention warranting a design patent to conclude that they should be round in cross section rather than some other suitable shape.

Furthermore, the use of the beads or raised portions, circular in cross section in connection with moldings, whether superimposed upon a base or not, is of such long standing that I cannot on the evidence regard the use made of them by the patentee in his design as disclosing inventive thought. *Tubular Rivet & Stud Co. v. Standard Finding Co.*, 231 Fed. 170, 173 (145 C. C. A. 358)."

In another recent case, *H. D. Smith & Co. v. Peck, Stow & Wilcox Co.*, 262 Fed. 415, the Circuit Court of Appeals for the Second Circuit had before it, as here, two patents, one a mechanical or utility patent and the other a design patent, disclosing the same article, namely, a screw driver. In holding the design patent invalid the court said:

"Whether the structure involves invention is a question of fact, and the determining factor is not whether the achievement is difficult or easy, but whether it has, in point of fact, given the world something of real value, that it did not have—a benefit conferred upon mankind."

"The appellee has sued upon both patents in this action. This it may properly do. *Eclipse Mach. Co. v. Harley-Davidson Motor Co.* (D. C.), 244 Fed. 463. 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 this patent."

In the case of *Roberts v. Bennett*, 136 Fed. 193, the Circuit Court of Appeals for the Second Circuit held invalid a design patent for a metal basket, saying:

"The functional utility entitled the patentee to the mechanical patent already discussed, but mere functional utility did not entitle him to a design patent for the same article."

Robinson in his able work on Patents puts the matter very clearly,

"Thus while an increase in the beauty of the substance is the purpose of this species of invention, a mere increase in beauty, without an alteration in the shape or ornamentation of the substance, does not possess the characteristics of a design; nor, on the other hand, does a change of shape or ornament intended to increase the practical value of an instrument in the industrial arts, although such change augments the beauty of the instrument, bring it within this species of invention."

This is the reason why color can form no part of the design. But color in this case is the very thing which gives something of beauty to these devices; which is there independent of function; which is the characterizing feature of the appearance; but which cannot be considered either on the question of anticipation or the question of infringement. There is unquestionably beauty in pure color. This was one of Ruskin's tenets. But such ornamental character as is imparted to these heaters by the color of the reflector or the color of the pedestal is a beauty which cannot be monopolized under the patent laws, even were it original with the plaintiff, which it is not, or even if it were set forth in the patents in suit, which it is not.

So also making the reflector bowl parabolic or spherical to control the distribution of the radiant rays, or adding a marginal flange to protect the user against the heated bowl, both of which things were old, even if they were new, could not constitute a patentable design because, in the language of Robinson, they are intended to increase the practical value of the device.

**THE ATTEMPT TO CONFUSE WITH THE DESIGN FEATURES
WHICH CAN FORM NO PART THEREOF.**

Robinson in his work on Patents makes this statement:

“The image formed upon the retina may often differ widely from that formed in the mind—one being the exact representation of the object as it

really is; the other being composed of certain features of the object only, or of those features in connection with such elements as are suggested by the imagination or the memory.”

This is a very clear expression of a well recognized principle. When one’s eye looks at a thing the mind may not carry the same impression that is made upon the eye. That principle underlies the consideration of these cases from the design standpoint.

There is unquestionably a resemblance between all of these devices, just as in popular phraseology there is said to be a similarity in appearance between all colored persons. When an ordinary observer or an intelligent observer, or anyone else, looks at one of the plaintiff’s or defendants’ devices we submit that the thing that makes the impression on the mind is the copper bowl. There is something striking about it. Its polished surface glows even when not in use, and when it is lit up, the effect is still more striking. It pushes into the background all remembrance of minor details of shape or configuration.

But this color effect as we have shown is and can form no part of the design, and neither design patent suggests that it is a part of the design. The court below was clearly right when it said that the attractiveness of the plaintiff’s heater was

“due not so much to slight changes in form as to increase in size, and more particularly, a substitution of the warm copper bowl with suitable trim in the place of the nickel type of heater.”

The plaintiff's counsel in his brief in No. 3616 argues that the plaintiff's heater has a distinctive and characteristic appearance, he says:

“It became identified in the mind of the public with the Majestic company, so that whenever any person saw exposed for sale a portable electric heater, having the elements of No. 7, with a polished reflector glowing like a ball of fire, such person would immediately conclude that it was a Majestic heater No. 7” (page 23).

This argument is repeated and the prior Majestic devices are belittled because “small” and “nickel-plated”.

It is absurd to argue in the face of the authorities and of the plaintiff's own design patent, that color forms any part of the design, and the argument is only made because counsel realizes that the copper colored glowing bowl is the vitally characteristic appearance factor, even although it has nothing to do with the issue.

This court and other courts have made it very clear in the decisions which we have quoted that in considering a design invention it must be first ascertained in what the invention consists. If the general shape or configuration of the article as a type is already old, it is obvious that the design must relate to details, and similarities arising from the common adoption of the generally old type of shape cut no figure. So also similarities arising from the use of a common color effect can cut no figure.

One of the best cases on this point is that of *Grelle v. City of Eugene*, 221 Fed. 68, decided by this court. The design patent in that case related to a street lamp post, and cuts of the patented design and of the defendants' device appear in the report. In sustaining a decree for the defendant, Judge Morrow, speaking for the court, 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.’”

Another case in point is *Kruttschnitt v. Simmons*, 118 Fed. 851, affirmed by the Circuit Court of Appeals for the Second Circuit on the opinion of the court below, 122 Fed. 1020. The design related to a bordered aluminum plate. The plaintiff was the first one to put on the market this kind of an aluminum plate, but there as here, the particular metal or color of metal could not form any part of the design, and the court said:

“When the defendants 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.”

Again this court applied this principle in the recent case of *Zidell v. Dexter*, 262 Fed. 145, speaking thus through Judge Gilbert:

“In a design invention which consists only of bringing together old elements with slight modifications of form, the invention consists only in those modifications, and another who uses the same elements with his own variations of form does not infringe, if his design is distinguishable by the ordinary observer from the patented design.”

The Circuit Court of Appeals for the Sixth Circuit in *Soehner v. Favorite*, 84 Fed. 182, put the same point in this language:

“for while it must be admitted (and this is the contention most pressed by the complainant) that to the casual observer or to one who regards their general appearance only, there is a sameness of appearance, yet it is only the sameness which results from the use by the defendant of the resources which were of right open to each—that is, in this case, the privilege of using an old kind of ornament, in its common style of application, to the improvement of the appearance of his stoves.”

These cases enforce the principle which is determining here. Any resemblance that does exist between the plaintiff's and the defendants' devices is a resemblance primarily due to the general shape or configuration which was old and common, or is due to the brilliant polished reflecting bowl which is and can form no part of either design.

THE RELATION OF THE HEATING ELEMENT TO THE DESIGN.

We do not understand what position the plaintiff takes on this point. The heating element, that is, the spool-like resistance wire wound device which occupies the prominent central position in front of the reflector, either constitutes a part of the design or it does not. So far as we are concerned, it makes no difference which position the plaintiff takes, but it cannot straddle, it must take one position or the other.

Both design patents are entitled "electric heater casing", and the plaintiff's briefs before this court are entitled in the same manner. The claims of both design patents are for

"the ornamental design for an electric heater casing substantially as shown".

Neither patent contains any specification, and as this court said in *Zidell v. Dexter*, *supra*, where there is no specification in a design patent, it is impossible to tell what the inventor considered the prominent feature, and the patentee must be held substantially to the design shown in the drawing. Plaintiff's counsel in his brief in No. 3616, at page 42, says:

“But furthermore, the patent is entitled ‘Design for an Electric Heater Casing’, and the specification and claim so designate the invention. It would seem from this that the heater element is no part of the design, but that the design is a casing to be used in connection with any kind of a heater element however that element is arranged.”

On page 36 of the same brief, the same counsel complains that the court below

“dismissed from consideration all parts or elements of the plaintiff’s assemblage save and except the reflector in connection with the attendant heater element, and then deduced the conclusion that the defendants’ reflector with a longitudinal arrangement of heater element presented a different appearance from the plaintiff’s reflector with a transversely arranged heater element.”

On page 11 of his brief in 3618 the same plaintiff’s counsel attempts to discard the Warner device as an anticipation because of the difference in the heater element, which he describes as

“its large circular metal grid work, and electric light bulb in the center of the bowl.”

Where does plaintiff’s counsel stand? If as he seems to say in one place, the heating element is not a part of the design, then we must compare the Warner patent without the heating element with the plaintiff’s device without the heating element. No ordinary observer could distinguish between these two devices under these conditions.

The record in No. 3616 contains the testimony of Mrs. Lebatt, a personal friend of Mr. Brown, who

never purchased or owned one of these devices (page 54), and of Mr. Hiller, who manufactured the devices for the plaintiff. This testimony of course has no bearing on the case of Holbrook, Merrill & Stetson, involving the Simplex heater, and does not appear therein. We fail to see, however, any significance favorable to the plaintiff in this testimony. If this is the best that plaintiff can do after selling between 100,000 and 400,000 of its heaters, that fact alone is significant. The thing of some materiality is that all that Mrs. Lebatt can emphasize is the matter of the heating element. That seemed to impress her as a distinguishing difference, and throughout her brief testimony, she repeatedly refers to it. There is no doubt but that the element, occupying as it does the center of the reflector toward which the eye is irresistibly drawn, is a noticeable feature, and readily distinguishes the two devices. *

If the heating element is a part of the design, then it is a very prominent and characteristic part, and the difference between the plaintiff's type and the defendants' type is a distinguishing difference.

This is what the court below correctly held:

“In its more conspicuous features the plaintiff's design also closely resembles the Warner device, the parabolic ‘Simplex’ and the ‘Ferranti Fires’. If it be said that the element in the Warner heater distinguishes its general appearance, the answer is that, as already noted, such distinction also exists between the plaintiff's designs and the alleged infringing devices.”

THE SECOND DESIGN PATENT, No. 51,253.

Little need be said specifically with reference to this patent involved in No. 3618, and in the suit against Holbrook, Merrill & Stetson, now awaiting trial in the court below.

The record in this case, so far as the testimony is concerned, is made up entirely of excerpts from the testimony in the other two cases, and no additional testimony was offered by either party.

It does not appear when and to what extent, if ever, the plaintiff manufactured and sold the particular heaters offered in evidence by plaintiff's counsel (Record 3618, page 37) without identifying or supporting testimony, and it is quite immaterial. This second design patent, 51,253, is, we submit, clearly invalidated by the earlier Majestic No. 2, or Shoenberg heater, samples of which are in evidence, and a number of which are excellently depicted in the photograph of the Majestic Company's exhibit at the Panama Pacific Exposition, "Defendants' Exhibit E".

This patent is but another regrettable example of the careless practice of the Patent Office in granting design patents so forcefully characterized by the Circuit Court of Appeals for the Second Circuit in *Rowe v. Blodgett*, 112 Fed. 61, as "not only liberal, but lax".

In addition, we submit the obvious proposition that it is impossible for the single structure of heater of either defendant to infringe two separate and distinct design patents which relate to the entire device.

Each of these design patents is for the shape or configuration of the entire heater or heater casing. This is not the case of two design patents, each directed to a different feature, as, for example, one to the shape of the reflector, and the other to the shape of the base, but this is a case where a single concrete device is alleged to infringe two separate and distinct design patents, both for the entire device or casing.

We respectfully submit that to state this proposition is to refute it. The axiom, "two things equal to the same thing are equal to each other" applies.

But we respectfully submit this second design patent is correctly and effectually disposed of by the court below when in its opinion it said:

"Indeed, it is difficult to perceive upon what basis a claim of patentable novelty for No. 51,253, the design without the annular flange, can be predicated. The casing shown is simply a reflector of the most familiar type, old in the art, and without novelty either in configuration or feature. True, upon placing the device of this design as actually manufactured side by side with the heater actually manufactured by the plaintiff under the Shoenberg patent, we have a substantial contrast in appearance, but the contrast is of material, color, and size, and not of form. Make both of the same size and finish them both in nickel or copper, and we have similarity instead of contrast. Who, without having the specific object in mind, would, after observing with reasonable care the drawing of patent 51,253, and thereupon being handed a photograph of the plaintiff's exposition exhibit, say with confidence that the device covered by the drawing is not shown in the photograph? The point is that in the absence of contrasting color or size there is a striking similarity in general appearance."

IN CONCLUSION.

We have thus at some length discussed the questions brought before this court by the appeals in these three cases, in the final outcome of which Holbrook, Merrill & Stetson are vitally interested for the reasons which we have set forth.

When all has been said, however, we can add little in substance to the carefully considered opinion of Judge Dietrich, dismissing the bills of complaint in these three cases and in the case against Holbrook, Merrill & Stetson. Judge Dietrich heard all the evidence and saw the witnesses, gave painstaking consideration to all of the cases, and dismissed the bills.

We respectfully submit for the reasons fully set forth in the opinion of the court below, and we trust helpfully amplified in the foregoing brief, that the decree in each case should be affirmed, with costs to the appellee.

Dated, San Francisco,

March 5, 1921.

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SAMUEL KNIGHT,

KNIGHT, BOLAND, HUTCHINSON & CHRISTIN,

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