

Nos. 3616, 3617, 3618

IN THE

**United States Circuit Court of Appeals**

**For the Ninth Circuit**

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MAJESTIC ELECTRIC DEVELOPMENT COMPANY  
(a corporation),

*Appellant.*

vs.

WESTINGHOUSE ELECTRIC & MANUFACTURING  
COMPANY,

*Appellee.*

**APPELLANT'S REPLY BRIEF.**

[Filed by leave of court granted at the oral argument.]

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*Solicitor for Appellant.*

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### Preliminary Objection.

At the oral hearing appellee's counsel handed up to the court a portfolio containing what he said was photostat copies of "the exhibits in the case". In that portfolio are what purport to be photostat copies of an *English patent No. 12,320 to Kempton*, and also an *English patent No. 102,070 to Taylor*. We protest this procedure because neither of said English patents was offered in evidence in these cases. Neither one is an

exhibit, and appellee's counsel has no right to hand up to the court copies of said patents and ask this court to give consideration to the same when rendering its decision.

We pointed out at the oral argument the injustice to us which would arise from such a course. If these English patents had been put in evidence at the trial we would have been entitled to meet them by counter-evidence, and that we surely would have done; but inasmuch as they were not put in evidence, we did not meet them by any counter showing. We would have specially made a counter showing in respect of the Taylor patent by carrying the date of our invention of the second design patent back of the date of the Taylor patent, and that would have nullified the effect of the Taylor patent; and as to the Kempton patent, we could have countered by showing that it related only to a gas stove made stationary in a fire place and did not relate to an electric heater at all, much less to a portable electric heater of the character involved in this case, and that it had neither the appearance nor function of Brown's heaters.

The inclusion of these two patents in these cases by the lower court is one of the errors of which we complain. That they were both considered by Judge Dietrich to be of controlling effect is apparent from the face of his opinion.<sup>1</sup> In that opinion (page 28 of the record, case 3616) it is said:

“But aside from the Shoenberg patent, the principle is clearly disclosed in the earlier patents and in the prior

art. 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."

Also at page 29 of the same record appears the following:

"Material also are the Warner patent \* \* \* and the Taylor patent of November 16, 1916 (English, No. 102,070)."

Also at page 32 appears the following:

"Moreover the design is almost identical with that shown in Figure 1 of the Taylor patent above referred to (English patent 102,070). Substantial identity is expressly conceded by counsel for the plaintiff, who, however, contests the priority of the Taylor patent. It is true that while this patent was applied for on January 11, 1916, it was not finally issued until November 15, 1916. It is further true that Brown's 'invention' as disclosed in his mechanical patent and his design patent 51043 (covering the annular flange) was made as early as April, 1916, although the patents were not applied for until the following year. But if there is any evidence that the design invention of 51,253 antedates the application, which was filed July 10, 1917, it has escaped my attention. It is not without significance that in the application for the Taylor patent, made before any of the Brown 'inventions', the applicant carefully limited her claim with the explanation that she was 'aware that it is not broadly new to construct an electric radiator with a resistance wire wound spirally upon a tubular member of refractory material, such resistance element being mounted in front of a reflector, with a protecting guard in front of the element'."

It must be apparent from the foregoing excerpts that the Kempton and Taylor British patents had a material effect upon Judge Dietrich's mind and that his conclusion was largely influenced thereby, notwithstanding the fact that neither of said English patents was in evidence in these cases against Westinghouse.

And we again call the court's attention to the statement of Judge Dietrich that "substantial identity is expressly conceded by counsel for plaintiff, who, however, contests the priority of the Taylor patent". This is misleading. That concession was *not* made in the Westinghouse cases. It was made only in the Holbrook, Merrill & Stetson case in respect of our first design patent, No. 51,043, and then its effect was nullified in that case by carrying the date of Brown's invention back of the date of the Taylor patent.

There was no such procedure followed in the Westinghouse cases, nor was there any occasion for such procedure, and that for the simple reason that the English patent was not in evidence in the Westinghouse cases. Yet the opinion of the lower court in respect of our second design patent, 51,253, charges us with having conceded its substantial identity with the Taylor English patent without having carried the date of our invention back of the English patent, and when we reach this court we are confronted with that supposititious situation with no means for meeting it. This is clearly an injustice to us. Every litigant is entitled as of right to meet the evidence of his adversary

by a counter-showing. Yet this privilege is denied us, if the English patent is to be considered.

It is argued in appellee's brief that Judge Dietrich by reference made these English patents a part of the instant case. But this is just what we complain of. The learned judge of the lower court had no authority to make these English patents "a part of the instant case". We think for this error alone, if for none other, the decrees in these cases must be reversed.

As further showing error in this behalf, it is to be noted (page 32 of the record, case 3616) that the lower court gave effect to the Taylor English patent as of the date of its application, to wit, January 11, 1916, instead of limiting it to its date of issuance, to wit, November 16, 1916. *This is a plain and palpable error.* Under the statute, English patents are effective against an American patent only as of the date of the issuance of the English patent and cannot be carried back to the date of the application. It was so held by this court in *Perfection Disappearing Bed Co. v. Murphy Wall Bed Co.* (262 Fed. 698, 700), following *Bates v. Coe* (98 U. S. 31), and *Dubois v. Kirk* (158 U. S. 58). That the lower court erred in this behalf seems plain.

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### As to Validity of the Design Patents.

In our opening brief we did not discuss the question of validity of our first design patent, No. 51,043, nor our mechanical patent 1,245,084, because we did not

consider that question to be before this court for review. The lower court did not find those patents invalid. It merely found that they were not infringed. We looked upon this as a holding, at least inferentially, that the patents were valid. Hence we refrained from discussing that question in our opening briefs in those cases. Counsel for appellee now attacks the validity of these patents. Hence we have obtained permission from the court to file this reply brief, and we entitle it in all three cases, discussing first the design patent and then the mechanical patent.

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**DESIGN PATENT 51,043.**

*The first ground advanced by appellee in this behalf is that every element of the design patent has a functional purpose and no other, and that no part of the structure can be omitted or changed without destroying its functional character, from which he concludes that the patent is invalid.* In other words, it is asserted that the *form* of each element is purely functional, and that such *form* cannot be changed without destroying the function, from which it is insisted that the design is not the proper subject matter of a design patent.

This is an erroneous conception. It may be conceded that in order to produce a heater performing the utilitarian function desired, it is necessary to have certain generic elements, viz, a support, a reflector, a heater element, and a protective device in front of the reflector. Those are the *generic* elements of a portable



electric heater; but it is by no means necessary that those several parts must have the *specific form* disclosed by the plaintiff's design. The distinction is between the *generic* form and the *specific* form. Plaintiff's design does not undertake to cover the generic form; it covers only the specific form. *That specific form* produces a certain appearance of pleasing aspect, and it is that appearance which is covered by the design patent. Defendant has adopted our specific form, or a colorable imitation thereof, and that is our complaint.

Our specific form consists of a substantial circular base plate, an upright standard extending from the center of the base plate, a concavo-convex reflector of parabolic or substantially parabolic contour, a cylindrical tubular heating element arranged as near the focus of the reflector as is possible, and a protective cage of arched guard wires extending from the rim of the reflector and meeting at a central point in front, thereby producing a distinctive appearance.

The defendant has adopted all of these forms, or merely colorable imitations thereof. He has adopted the identical form of circular base plate, even simulating the color. He has adopted the upright standard positioned in the center of the base plate, though he had added thereto a U-shaped yoke at the top of the standard, which U-shaped yoke, however, is not seen from a front view of the heater, but is concealed from view back of the heater.

He has adopted substantially the same form of reflector, the only change in that behalf being that instead of making it mathematically parabolic he has made it hemispherical; but this difference cannot be detected by the eye and the appearance of the two is identical.

He has adopted the same form of electric heater element as ours arranged as near to the focus as is possible, and has merely changed it from the horizontal to the longitudinal position.

And finally he has adopted the same form of protective cage, consisting of guard wires arched over the front of the reflector.

He could have adopted a different form of base plate and standard without impairing the functional utility of those devices. For instance, he could have used the four-legged stand and ornamental support shown in defendant's exhibit 8 (Plexsim Heater); or that shown in defendant's exhibit 12 (Ferranti Fire); or that shown in his own Geiger patent, defendant's exhibit G; or he could have used an ordinary tripod; or a square base plate; or the triangular base plate illustrated in one of the devices exhibited at the oral argument, or the differently shaped and fluted base plates of some of the illustrations exhibited at the oral argument; or a fluted Greek column as shown in the Majestic Device No. 2; or any one of the hundreds of different forms of base plate and supports known to the prior art in other connections. But instead of adopting any of these, he adopted the identical specific form of base plate of the plaintiff, even simulating the color.

As to the heater element, he might have adopted other forms shown in the prior art, such, for instance, as a pyramidal form, or elliptical form, or circular form. But instead of so doing he adopted the same form as that shown by the plaintiff, to wit, the cylindrical tubular form, varying from the patent only in the matter of its inclination.

As to the protective wire cage, he could have adopted the flat wire mesh screen shown in defendant's exhibit 8 (Plexsim Heater); or the double curved form shown in defendant's exhibit 9 (Plexsim); or the flat wire forms shown in defendant's exhibit 15 (Wm. Porter Sons Co. and Benjamin Electric Co.); or the flat wire mesh screen shown in the Morse patent, defendant's exhibit F; or he could have dispensed with the wire cage entirely. If he had used any of these prior forms, he would still have preserved the functional utility of the device, though it would have presented an entirely different appearance. But instead of adopting any of these prior forms he adopted the same form of arched wire guard shown in the plaintiff's patent, and by so doing he reproduced the same general appearance of the device as that shown by the plaintiff's patent.

*It is the use of these specific forms that we complain of as infringement of the design patent.*

We are not unmindful of the fact that the defendant has changed the flat flange around the rim of the reflector to the form of a curved flange and has changed the inclination of the heater element, but we insist that

these changes have not produced a change of appearance sufficient to avoid infringement; and in that behalf we rely upon the evidence in the case, to wit, the testimony of witnesses Labatt, Hiller, and Wentworth.

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**MISAPPLICATION OF A RULE OF CONSTRUCTION.**

And on this particular point we again reiterate that both the judge of the lower court and the counsel for appellee in this court have applied as a rule of construction to this design patent a rule applicable only to the construction of a mechanical patent. That rule as applied to mechanical patents is that where a defendant has omitted one of the elements of the patented combination without the substitution of a mechanical equivalent, he breaks the combination and does not infringe. The rule is too familiar to require the citation of authorities. But this rule is not applicable to design patents unless the omission of the element produces a different appearance of the article as a whole. In the case of a design patent, if omission of one element or part produces a different appearance of the article as a whole, then the rule applies and there is no infringement. But if the omission of that element does not produce a different appearance of the article as a whole then the rule does not apply, and infringement follows. In other words, in the case of a design patent the omission of one element of the design does not avoid infringement where such omission does not change the distinctive appearance of the design as a whole.

In this case the appellee says one of the elements of the first design patent is the flat annular flange; the appellee has omitted that flange; therefore, there is no infringement. If this rule had been applied to a mechanical patent, the argument would be sound; but it is here sought to be applied to a design patent, and in such case the additional question must be asked, does the omission of the flat flange produce a different appearance of the article as a whole from that of the patented design? If this question be answered in the negative, then the omission of the flat flange is immaterial. Here is where the learned judge of the lower court made the error. He held that the omission of the flat flange *ipso facto* avoided infringement just as in the case of a mechanical patent. But the crucial question is, does the omission of the flat flange produce a different appearance of the article as a whole? That the answer to this question must be in the negative is shown by the testimony of Labatt, Hiller, and Wentworth.

“Details in the matter and manner of construction of a design patent are unimportant except insofar as they enter into the ordinarily observant man’s conception or impression of the whole design. It is the picture made upon his mind in general, which governs, not the minor differences which close examination would reveal, nor those which might catch the scrutinizing eyes of an expert.”

*Bolte v. Knight*, 180 Fed. 415.

“It is by no means necessary that the patented thing should be copied in every particular. If the infringing design has the same general appearance, if the variations

are slight, if to the eye of an ordinary person the two are substantially similar, it is enough. It is of no consequence that persons skilled in the art are able to detect differences. Those who have devoted time and study to the subject, who have spent their lives in dealing in articles similar to those in controversy, may see at a glance features which are wholly unimportant and unobserved by those whose pursuits are in other directions, and who are attracted only by general appearances. If the resemblance is such that a purchaser would be deceived, it will not aid the infringer to show that he has deviated slightly from a straight line in one place and from a curved line in another, or that he has added or omitted something which an expert can discover."

*Tomkinson v. Willets*, 23 Fed. 895.

In *Redway v. Ohio Stove Co.*, 38 Fed. 584, the design was for a cooking stove embodying a collection of different features, and among them a representation of a bird and a butterfly. These latter features were omitted from the defendant's stove. In holding infringement the court said, at page 584:

"The defendant's design omits the bird and the butterfly, and in other but minor details is different from the complainants', but the general appearance and effect of the two are the same, and bring the defendant's design clearly within the rule laid down in *Gorham v. White*, cited *supra*. The Supreme Court say in that case that the acts of congress which authorize patents for design contemplate not so much utility as appearance, and that 'the law manifestly contemplates that giving certain new and original appearances to a manufactured article may enhance its salable value, may enlarge the demand for it, and may be a meritorious service to the public. \* \* \* Manifestly the mode in which these appearances are produced has very little, if anything, to do with giving increased salableness to the article. It is the appearance itself, therefore, no matter

by what agency caused, that constitutes mainly, if not entirely, the contribution to the public which the law deems worthy of recompense. The appearance may be the result of peculiarity of configuration, or of ornament alone, or of both conjointly, but, in whatever way produced, it is the new thing or product which the patent law regards'. Now, add to this the further consideration taken from the decision of the court in that case, that 'the purpose of the law must be effected, if possible; but plainly it cannot be if, while the general appearance of the design is preserved, minor differences of detail in the manner in which the appearance is produced, observable by experts, but not noticed by ordinary observers, by those who buy and use, are sufficient to relieve an imitating design from condemnation as an infringement', and we are forced to the conclusion that the omissions and changes in the design as used by the defendant do not relieve it from liability as an infringer, nor does the fact that it used its own name and the name of its own stove, conspicuously displayed, in connection with the design."

In the case of *George Borgfeldt v. Weiss*, 265 Fed. 268, the patent covered a doll having a bathing cap on its head. Defendant's doll omitted the cap. Here was a case of omission of an element. Infringement was decreed. Pictures of the two dolls are shown at page 270 of the report. If Judge Dietrich's decision is good law, then there would have been no infringement in the doll case.

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**ALLEGED WANT OF INVENTION IN DESIGN PATENT 51,043.**

It is urged by appellee that the first design patent is void for want of invention in view of the prior art "because the design of the patent in suit embodies

only what was taken from a well developed prior art” (Appellee’s brief, p. 43).

This means that each element of the patented design was taken from the prior art, one element from one source and another from another source, and so on. But this does not necessarily render the patent invalid. Brown was entitled to borrow all the elements from the prior art, and to assemble them together into a new collocation. If such new assemblage produces a new appearance, then the patent is valid, notwithstanding the fact that each individual element was old.

At page 24 of appellee’s brief, it is admitted “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”. This concession is fatal to the appellee, because it admits that Brown made a new assemblage of elements. That is what the design statute protects, and it is idle for appellee to argue that the patent is void because all of its elements individually and in different locations were old. Does he pretend to say that a combination of old elements is not patentable? It would so seem from his brief.

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#### QUESTION OF INFRINGEMENT OF DESIGN PATENTS.

The main contention of our adversary on this point is that such resemblance as exists between the heaters of plaintiff and defendant is that resemblance only which arises from functional characteristics. In other



words, it is contended that all portable heaters "look alike" from a generic point of view. To use the exact words, the brief says at page 34:

"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."

This argument is not sound. We are not complaining of the defendant's heater because it has "the same number of main elements or features having the same general arrangement and substantially the same color", that is to say, because it has the same *generic* elements. What we are complaining of is that the defendant's heater embodies the same *specific form of elements*, or colorable imitation thereof, covered by the plaintiff's patent, thereby producing the same general appearance.

Right here lies the crux of the whole controversy. Defendant had the right, without infringing, to use the same number of generic elements or features, possessed of the same functional characteristics as those of the plaintiff; but the defendant did not have the right to adopt the *specific form* of those elements covered by the plaintiff's patent whereby a distinctive appearance of the article as a whole is produced.

To lose sight of this distinction is to ignore the fundamental character of a design patent. Strictly speaking, there is no such thing under the law as a generic patent for a design. A patent for a design is

necessarily specific, and the distinction existing between generic and specific inventions as applied to mechanical devices is unknown to the law of design patents. This necessarily results from the fact that a design patent covers only *the appearance* of an article, and cannot be infringed unless that appearance is reproduced by the infringing structure. We repeat that every design patent is necessarily specific, and, therefore, when considering such patents the court is relieved from considering any of those rules of construction applicable to generic and specific claims in the matter of mechanical patents. Every design patent which is without a specification covers only what is shown and illustrated in the drawing, or colorable imitations thereof. Therefore, the question here, is not whether the two heaters are generically alike, nor whether they contain the same number of main elements having the same general arrangement, but the question is whether they have *the same specific features* and *produce the same general appearance to the eye of an ordinary observer.*

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**POLISHED COPPER REFLECTOR.**

*It is further insisted by our adversary that the similarity of appearance between the heaters is due to the polished copper reflector, and that feature is the main, if not the only, cause of similarity in appearance. This is purely the opinion of appellee's counsel. It may be conceded that the copper reflector contributes to the*

similarity. But it is not the sole contributing cause. The other features play an important part, and especially is this true of the protective cage made of arched guard wires. That feature gives as much of a distinctive characteristic to the article as does the copper bowl. The defendant could easily have avoided this by adopting some other form; but instead of adopting some other form he adopted the specific form shown in the plaintiff's patent. And the same may be said of the circular base plate. It was not necessary to the functional utility of his device that he should have adopted these specific forms. He could have adopted other forms producing the same functional utility and at much less cost of manufacture. It is apparent to any one versed in such matters that the cost of the arched wire form is greater than the cost of some other form, such, for instance, as a flat wire screen, or four strands of wire disposed flatwise across the mouth of the reflector. Why did the defendant decline to adopt one of these cheaper forms, which would have produced the functional utility he desired, but instead thereof adopted the more expensive complicated and ornate form of arched guard wires? We insist that the protective cage of arched guard wires is one of the material contributing factors in the general appearance of the article, as much so in fact as the copper reflector, and that in adopting that form, together with the other similar features defendant has produced a heater having the same general appearance as that of the plaintiff.

### Reply to the *Amicus Curiae*.

Hollbrook, Merrill & Stetson were permitted to file a brief as *amicus curiae*. On page 33 of that brief it is stated that a design patent must be the result of "inventive genius". If by that term is meant anything more than the faculty of invention in its lowest form, the statement is erroneous. In support of his assertion the *amicus curiae* cites the language of Judge Ross in the case of *Hammond v. Stockton Works*, 70 Fed. 716. But that language merely says that in the case of a design patent there must be the exercise of the "inventive faculty", and then says that this must be so because the statute so provides. There is certainly nothing in Judge Ross's opinion about "inventive genius."

On the other hand, in *Smith v. Stewart*, 55 Fed. 482, the opinion says:

"It would seem absurd to say that the designs covered by these patents, generally, exhibit the exercise of 'inventive genius', as the term is commonly applied to mechanical inventions."

And at page 483 of that decision it is said:

"The invention in the majority of patented designs is very small and of a low order. All the statute, as commonly interpreted, requires is the production of a new and pleasing design, which may add to the value of the object for which it is intended."

And the syllabus of the case says:

"The invention and novelty required in the case of design patents is very small and of low order, and differs from the novelty and invention required for mechanical

patents. All that the statute requires in the case of designs is the production of a new and pleasing design which may add value to the object for which it was intended."

Yet in that case the court sustained the patent and decreed infringement. And on the question of infringement the court said at page 483:

"Did the defendants infringe? They copied the rug literally except the 'border \* \* \*. The common observer would not discover any difference between the plaintiff's and defendants' rugs, granting that the borders are dissimilar."

And in *Untermeyer v. Freund*, 37 Fed. 345, we find the following language:

"It is impossible to read the literature upon this subject without being convinced that the courts, though applying the same rules, have looked with greater leniency upon design patents than patents for other inventions. From the nature of the case it must be so. A design patent necessarily must relate to subject matter comparatively trivial."

And in *Gorham v. White*, 14 Wall. 525, the following language with reference to the design patent is used:

"To speak of the invention as a combination or process, or to treat it as such, is to overlook its peculiarities."

The *amicus curiae* also asserts that the design patent is invalid because its shape or configuration results from functional reasons and for a functional purpose, and that all the features of the design owe their shape or configuration to the functional purpose (pp. 33-5). This is a repetition of the error committed by appellee's coun-

sel and heretofore adverted to by us. We most emphatically deny that "all the features of the plaintiff's device are provided for and owe their shape or configuration to functional purposes (p. 35). We have already pointed out that the device has non-functional characteristics and that such non-functional characteristics produce the pleasing appearance protected by the patent. By this we mean that while the features of our design have functional utility, nevertheless the specific form of those features produces a patentable appearance. Our complaint is not that the defendant has adopted the generic features of our heater, but the specific features, and while he could have adopted other specific features differing from ours in form but accomplishing the same functional utility, nevertheless he adopted our specific form, or a colorable imitation thereof.

The *amicus curiae* grows tremendously excited over the case of *Ferd Messmer Mfg. Co. v. Pick & Co.*, 251 Fed. 894, and seems to think it is decisive of the question here involved. On page 895 of the citation is shown a cut of the design and it consists simply and solely of an ordinary glass tumbler provided with a circular bulge or ridge around the upper part and formed integral with the glass of the tumbler. The plaintiff had two patents on that insignificant device, one a mechanical patent and the other a design. The court held the mechanical patent valid and the design patent invalid. That portion of the opinion holding the design patent invalid comprises six lines at the bottom of page 896, and they read as follows:

“The bulge of 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.”

How the *amicus curiae* can take any comfort from this decision passes our comprehension. It is merely a case where the court found as a fact that a certain thing was not ornamental. It is of no more value in the present case than would be the general assertion that sometimes the courts have held design patents invalid because they did not come within the purview of the statute.

Another case specially relied upon by the *amicus curiae* is that of *Kruttschnitt v. Simmons*, 118 Fed. 851, discussed at pages 43-4 of the brief. There the patentee took “plain sheets of aluminum”, which of course were old and well known in the art, and placed around the edge of such sheets an ornamental border of a specific form consisting of a “scrolled figure suggestive of a distorted Greek pattern having a mottled surface and a rectangular inner defining border line”. The defendant manufactured “bordered aluminum signs having patterns differing so widely from the patented design as not to infringe the same.” In other words the patent covered the border around the aluminum plate, and of course no one could infringe that patent without using that border or a colorable imitation thereof. Defendant used neither the specific border nor a colorable

imitation thereof. Therefore, he did not infringe because he had not used the thing patented. There is no difficulty about that case, because it was solely a question of fact. The patent was held valid, but not infringed.

The case has absolutely no bearing on any issue in the instant case; but we are grateful to the *amicus curiae* for citing it, because it fully sustains us in the contention which we have heretofore made in answer to the brief of appellee, and that contention is that there can be no such thing as a generic claim in a design patent which has no specification, and that the only claim which can be had in such case is necessarily a specific claim. In the case cited plaintiff sought to extend his patent to an aluminum plate having *any kind* of an ornamental border. In fine, he claimed a generic patent for a bordered aluminum plate without reference to the specific form of the border. The court denied him this, and held that his claim was confined to the specific form or character of border illustrated in his patent and that the defendant could use an aluminum plate provided it had *a different kind* of border. This is our precise contention. We make no claim to *generic* features, but only to *specific* features, and our ground of complaint is that the defendant has used those specific features or colorable imitations thereof.

We apprehend that the reason why the *amicus curiae* cited the aluminum sign case resides in the fact that the defendant's plates could be and were sold as and for the aluminum plates of the plaintiff. But this is



wholly beside the mark, because the defendant had not used plaintiff's invention at all. Defendant had not been sued generally for passing off his goods as those of the plaintiff, but he had been sued for using that invention. It became wholly immaterial, so far as the patent was concerned, whether the defendant's goods had been passed off as those of the plaintiff or not. For such a situation the law of unfair competition may apply, but not the law of patents. Indeed, the court held specifically that for the reason that the defendant had not infringed the patent, the familiar test of the eye of an ordinary observer could not be applied. Where no infringement exists, as a matter of fact, it is idle to discuss the tests of infringement where such infringement does exist. We submit that the aluminum sign case has no more bearing on the instant case than the bulge tumbler case.

In this connection the *amicus curiae*, with a singular disregard of consistency, cites the following language of this court from the case of *Zidell v. Dexter*, 262 Fed. 145:

“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”.

This is another and a positive and direct confirmation of our position. Our invention consists in bringing together old elements with such modifications of form as were deemed desirable or necessary for pro-

ducing a new and pleasing appearance. In the words of this court, "the invention consists only in those modifications". This is in accordance with the theory heretofore advanced by us that all design patents without a specification are necessarily specific in character. Of course, if another person "uses the same elements with his own variations of form, he does not infringe, if his design is distinguishable by the ordinary observer from the patented design". There could not be a better statement of the law. But where the defendant does not use "his own variations of form", but insists on using the plaintiff's variations of form, he comes directly within the purview of Judge Gilbert's language, and is an infringer. The defendant has used *our* modifications of form, indeed our specific form, in several particulars, the principal ones of which consist in the base plate with its upright standard to a certain point, the form of reflector, the form of tubular heating element, and the form of wire cage over the mouth of the reflector. The only variations of form which he has introduced consist of a different inclination of the heating element and the omission of the annular flange. But these variations of form, we contend, do not change the general appearance of the article at all, and that is the question to be answered by this court.

*Another point made by the amicus curiae is that both the mechanical patent and the design patent are directed to the same device. In other words, Brown's heater No. 7 is protected both by a mechanical and a design patent. It would seem from the brief of the*

*amicus curiae* that he challenges such procedure. While he does not assert directly, he seems to contend that an inventor cannot in any case have both a mechanical and a design patent for the same structure. To sustain him in that contention he cites the bulge tumbler case heretofore referred to. That case makes no such broad ruling. It does rule that in that particular instance the design patent was invalid, not however because of the existence of the mechanical patent, but because of the fact that the design as a design was not ornamental.

It is too well settled to admit of controversy that there is no inhibition against taking out both a mechanical and a design patent for the same structure in some instances. The books are full of such cases, and if the learned counsel for the *amicus curiae* were asked the direct question, he would undoubtedly answer it in the same way we have answered it.

*Another point made by the amicus curiae, on pages 40-41 of his brief, is the assertion that the feature of these heaters which makes the impression on the mind is the copper bowl. He argues that the copper reflector is the dominant feature of the article and the thing which gives to the article its peculiar and distinctive appearance. On page 42 he says that the "copper colored glowing bowl is a vitally characteristic appearance factor". In fact he says that the copper reflector "pushes into the background all remembrance of minor details of shape or configuration" (p. 41).*

And then with strange inconsistency he refers to the statement of this court in *Zidell v. Dexter*, that in a design patent, where there is no specification, it is impossible to tell what the inventor considered the prominent feature.

In respect of this situation we repeat what we have heretofore said in another portion of this brief. It may be true that the copper reflector is *one* feature which contributes to the general appearance; but it is *only one* of such features. All the other features likewise contribute to the general appearance, because it is the appearance of the article as a whole, which appearance is produced by a combination of *all* the features, that is covered by the patent. Is it not possible for the *amicus curiae* to get into his head the indisputable fact that in case of a design patent it is the *general appearance of the article as a whole* which is covered by the patent? It is impossible to pick out any one particular element and say that it produces the general appearance of the article as a whole. A design patent without a specification covers the general appearance of the article as a whole disclosed by the drawing, and it is idle to argue that any *one particular* feature of the drawing is the thing which produces the general appearance of *the whole*. Can a part be the whole of a thing?

In a decision of this court in *Zidell v. Dexter*, 262 Fed. 147, it is said:

“As already shown, we have no means of knowing which, in the mind of the inventor, was the predominant feature of his design”.

And so here we say there is no way of ascertaining whether any particular feature of the design was considered by the patentee to be the predominant feature, or, if so, what was that feature. All we know is that the patentee gathered together from the prior art all of the several features of his design, one from one source and another from another source, and combined them into one composite assemblage. Such a performance, says this court in *Zidell v. Dexter*, does not disprove invention.

Nor is it apparent what, if any, particular element of the design strikes the public as the predominant feature. One may be attracted by the copper reflector, another by the arched guard wires, or another by the form of the stand. By what authority, therefore, does the *amicus curiae* assert in his *ex cathedra* fashion that the predominant feature of the design is the polished copper bowl, which pushes into the background all the other features, and is *the* feature which gives to the article as a whole its distinctive and characteristic appearance? The argument evinces a total misconception of the theory and the nature of a design patent.

*Another point made by the amicus curiae is that it is impossible for the single structure of heater of the defendant to infringe the two separate and distinct design patents which relate to the entire device.* His argument is based on a mathematical formula and is in substance as follows: If the defendant's heater is equal to the first design patent and also equal to the second design patent, then it follows that the first design

is equal to the second design, because of the axiom that two things equal to the same thing are equal to each other. The *amicus curiae* may be a profound mathematician, but we venture to suggest that we are not discussing a question of mathematics. To say that defendant's heater is an infringement of the two design patents is not equivalent to the mathematical statement that "one thing is equal to another", nor is it equivalent to saying that the two designs are the same. Without question one structure may be an infringement of two patents, and that entitles the patent owner to sue on both patents. But it does not follow therefrom that the device of one of the patents in question is an infringement of the other patent, nor that the devices of the two patents are the same. The mathematical argument of the *amicus curiae* is, in our opinion, mere sophistry.

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#### THE MECHANICAL PATENT.

##### Radiant Beam Principle.

It is urged by the appellee that this patent does not cover the radiant beam principle, but is limited solely and entirely to the two protective devices consisting of the dead air space in the rear of the reflector and the flat marginal flange around the rim of the reflector (appellee's brief, p. 8). In the brief of the *amicus curiae* the same position is taken, and at page 8, when referring to these two protective elements, it is asserted

"and they alone constitute the sole object and purpose of the alleged invention".

Inasmuch as claim 1 of the patent does not mention the dead air space, but does mention the other protective feature consisting of the annular member around the rim of the reflector, the position of our adversary is that in so far as claim 1 is concerned, the only novelty of the combination resides in the annular member, which he designates as "a broad peripheral rim or flange 3a" (p. 8, appellee's brief). In other words, the position is that Brown invented nothing more than a flat flange extending around the rim of the reflector.

This position is sought to be sustained (1) by reference to the patent itself and (2) by reference to the prior art. Permit us to briefly examine the matter from these two standpoints.

#### **As to the Patent Itself.**

The specification says, beginning at line 9, page 1:

"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."

And further along in the specification, beginning at line 24, it is said:

"The radiator comprises a concavo-convex reflector 1, having a highly polished inner surface, and which is secured by screws or in other suitable manner to an outer casing 3 mounted on a base 4. The heating unit consists of a resistance coil 6, wound upon a refractory tubular core or bobbin 7, supported in any suitable manner in spaced relation with the reflector 1, and preferably at the focus of its curved surface."

And further along in the specification, beginning at line 80, it is said:

“It will be evident that various changes and modifications can be made without departing from my invention.”

It is not difficult to gather from these excerpts that the patentee had in mind the radiant beam principle. The location of the heating unit preferably at the focus of the curved reflector necessarily implies substantial parallelism of the heat rays. Of course it goes without saying that in such a structure *all* of the heat rays will not be in exact parallelism because of the fact that the heating unit is of substantial dimensions, and, therefore, cannot be located in its entirety at the mathematical focus. But at the same time it is located as near the focus as is physically possible. In such a construction, while some of the rays will not be in exact parallelism, nevertheless it is a fact that the majority of those rays will be in parallelism. Consequently, we can say with truth, in the sense of the patent law, that the heat rays of this device are in substantial parallelism. The patent law does not call for mathematical exactness, nor indeed for any other kind of exactness, but only for substantiality. The only thing that can be charged against Brown in this connection is that he did not make as full and complete a disclosure of the radiant beam principle as his machine exhibits. But, as we have already stated in our opening brief, it was not necessary for him to disclose the scientific principle of his device at all. He might have



been wholly ignorant of it, or being cognizant of it, he might have refrained from discussing it in its fullness, and in this behalf we again call attention to *Eames v. Andrews*, 122 U. S. 55, and *Diamond Rubber Co. v. Consolidated Tire Co.*, 220 U. S. 435-6.

In the first of these cases the Supreme Court says:

“It may be that the inventor did not know what the scientific principle was, or that, knowing it, he omitted from accident or design, to set it forth. That does not vitiate the patent \* \* \*. The principle referred to is only the why and the wherefore. That is not required to be set forth \* \* \*. An inventor may be ignorant of the scientific principle, or he may think he knows it and yet be uncertain, or he may be confident of what it is, and others may think differently. All this is immaterial if by the specification the thing to be done is so set forth that it can be reproduced.”

And in the second of the cases cited the Supreme Court used this language:

“A patentee may be baldly empirical, seeing nothing beyond his experiments and the result; yet if he has added a new and valuable article to the world’s utilities, he is entitled to the rank and protection of an inventor. And how can it take from his merit that he may not know all of the forces which he has brought into operation? It is certainly not necessary that he understand or be able to state the scientific principles underlying his invention, and it is immaterial whether he can stand a successful examination. \* \* \* He must indeed make such disclosure and description of his invention that it may be put into practice. In this he must be clear. He must not put forth a puzzle for invention or

experiment to solve, but the description is sufficient if those skilled in the art can understand it.

This satisfies the law, which only requires as a condition of its protection that the world be given something new and that the world be taught how to use it. It is no concern of the world whether the principle upon which the new construction acts be obvious or obscure, so that it inheres in the new construction."

The substance of these cases is that it was unnecessary for Brown to explain the radiant beam principle in his specification. That principle was "only the why and the wherefore". All that was required of him, and all that is required of any patentee of a mechanical device, is to disclose to the world how to build the machine, so that it may be put into useful practice. That Brown's specification fulfills this requirement cannot be doubted. It discloses to a person skilled in the art how to build the machine and put it into practice, and that is all that the law requires.

In support of their contention that the specification does not describe the radiant beam principle, our adversaries cite the following clause from Brown's specification:

"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."

And of this it is said on page 7 of the appellee's brief:

"This is a statement of the patentee's invention", etc.

This is entirely erroneous. The statement aforesaid is *not* a statement of the patentee's invention. It is merely a statement of *one* of the *purposes* of the invention. It was not necessary for Brown to have stated any purpose of his invention. The invention does not reside in its purpose. It resides in the mechanism itself. It is a familiar rule that a patentee is entitled to all the benefits and advantages to which his invention may be put, whether stated or not. For that reason the law does not require him to state the purpose of his invention. This is elementary.

In *General Electric Co. v. Bullock*, 152 Fed. 431, the Court of Appeals of the Sixth Circuit said:

“In a number of opinions of this court it has been held that it is not necessary for the patentee to describe in detail all the beneficial functions which he claims will result from his invention. It is enough if those functions are evident and obviously contribute to the success of the invention”.

In *Morgan Eng. Co. v. Alliance Co.*, 176 Fed. 107, where the court of appeals of the Sixth Circuit was referring to a certain purpose of the invention not mentioned in the specification, it was said:

“Even if the patentee at the time of making his application did not know of this advantage, or knowing failed distinctly to express it, he, in view of what he did state and show, is entitled to have his invention considered with reference to it. Indeed, the crane cannot be constructed and operated in accordance with the plain terms of his description without observing and securing this advantage. This alone is sufficient.”

Paraphrasing the language of that decision, we say of the Brown invention that the heater shown and described in the Brown patent cannot be constructed and operated without utilizing and securing the benefit of the radiant beam principle. Such utilization inheres in the mechanical structure itself.

And in the case of *Kellogg v. Dean*, 182 Fed. 998, the Court of Appeals of the Sixth Circuit said:

“It is objected that the advantage of avoiding side tones is not mentioned in the specifications. This is true. But this omission was not fatal if the advantage was necessarily achieved through the invention.”

Here too we may say that the advantage of the radiant beam principle is necessarily achieved through and by the mechanical structure shown in Brown's patent. The patent teaches the world how to build that structure and that is enough. The omission to mention the radiant beam principle specifically in his specification is of no moment whatever in the eyes of the patent law.

But furthermore, the statement quoted does not say that the protective feature is *the* purpose of the invention, nor the *only* purpose of the invention. It merely says that such feature is *one of the main purposes of the invention*. If there are any other purposes of the invention, the patentee is just as much entitled to them as though he had stated them *in totidem verbis*. These principles of the patent law are too well

settled to admit of question. And furthermore, we again call the court's attention to the following paragraph, beginning at line 80 of the specification:

• “It will be evident that various changes and modifications can be made without departing from my invention.”

• The position of our adversary comes down to this, that when Brown specified *one* of the purposes of his invention, he thereby limited himself thereto, and is not entitled to any other purpose for which the device might be used. This is an erroneous conception of the patent law.

#### **As to the Prior Art.**

*It is next asserted that by reason of the prior art the patent in suit is necessarily limited, so far as claim 1 is concerned, to the protective device consisting of the annular member around the rim of the reflector.* In other words, it is asserted that the radiant beam principle was old and well known at the time of Brown's invention, and all that Brown did was to utilize that principle in a form of mechanism containing the annular member. The contention is, so far as claim 1 is concerned, that Brown invented only said annular member and nothing else.

The prior art referred to consists of the Morse, the Geiger, the Warner, the Shoenberg and the Simplex patents, together with the English publications of the Ferranti Fires.

Of these the *Morse* patent is the first in point of time, it being dated March 3, 1908. That device has but little relevancy to the issue. As we have already pointed out, it was merely a cupping instrument used by physicians to concentrate heat on a particular part of the human body, as a substitute for the old style remedy of a hot brick or hot water bottle. In fact the specification states that it is for the same purpose as "a hot water bottle" (Spec. line 55). It is nothing more than a collector of heat. The very utmost that can be said of it is that it is a vague prophecy of what afterwards followed. It is no more pertinent to a subsequent successful device embodying the radiant beam principle than the prophecy of Mother Shipton would be as affecting the flying machine of the Wright Brothers. Prophecies are not inventions.

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#### THE ART FOLLOWING MORSE.

The subsequent history of the art supports us in this contention, for the matter seems to have remained quiescent for many years.

The first pertinent subsequent patent was that of Shoenberg, dated September 1, 1914, more than six years after the date of the *Morse* patent. Then followed the Simplex English patent on September 4, 1914, four days after the Shoenberg patent; then the Warner patent, dated December 8, 1914, a little more

than three months after Shoenberg; and finally came Geiger on August 8, 1916.

It would seem, therefore, that these four men became active in this matter at very nearly the same time, one in San Francisco, another in England, another in Massachusetts, and another in the employ of the defendant at Pittsburg.

We are not unmindful of the fact that in 1912 and 1913 the British publications contained illustrations of the Ferranti Fire. But we do not consider that device as having a material bearing on the issue, because it was not a radiant beam heater, but a convection heater, used largely for cooking purposes.

We assert that this prior art is a substantial confirmation of our theory, and we assert most emphatically and without fear of successful contradiction, that not one of these prior devices discloses the radiant beam principle in a concrete and successful form. The utmost that can be said of them is that they disclosed a conception of the desirability of utilizing that principle, but the fact is that the mechanism they describe for that purpose is wholly and utterly insufficient to carry it out in successful practice.

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#### SHOENBERG.

The Shoenberg patent, which may be considered the nearest approach of them all, does not project the

rays with any approach to parallelism, but scatters them around in all directions. The defendant's expert Beam states that it is the object of Brown's device "to project the heat from the reflector out in the room in the shape of a beam, as nearly solid as possible, without having those heat rays scatter around in other portions of the room, and for that reason they are generally designated by the trade as beam heaters".

Shoenberg's heater does *not* project the rays in the shape of a beam, but allows those rays to "scatter around" in all portions of the room. We illustrated this in our opening brief by a diagram of the Shoenberg heater opposite page 23. Counsel for both the appellee and the *amicus curiae* criticise that diagram by saying that it is incorrect and misleading in that the heat rays are there represented as proceeding from a single mathematical point. This criticism is wholly unjustified. That diagram illustrates ten rays, proceeding from ten different points on the outer surface of the heating element. It is quite true that those rays have been represented as being projected backward to a mathematical point in the interior of the heating element; but that does not mean that the heat rays emanate from that mathematical point. It merely shows that if the ten rays emanated from a single mathematical point, they would be reflected in exactly



the same way as they are shown to be reflected when emanating from the several points on the outside of the heater element as shown in the diagram. In other words, the projection or continuation of those rays back to the mathematical point was merely for illustrative purposes. No one having any intellectual powers at all would conclude from that diagram that we intended to assert that the heat rays there shown emanated from the said mathematical point. We submit, therefore, that the criticism on our diagram is wholly unwarranted. Indeed the criticism is so super refined that it reminds us of that vexed question of the medieval schoolmen as to how many angels can stand on the point of a needle. Have our mathematical friends allowed themselves to stray into the subtleties of scholastic disquisitions and become bewildered in the mazes of metaphysical jargon?

But the learned counsel for appellee has himself proved our contention in reference to the Shoenberg invention. On page 14 of his brief he has a diagram of the Shoenberg heater indicating the direction of the heat rays, in which he depicts 25 or 26 different heat rays, if we have counted them correctly. They are all shown as emanating from the outer surface of the heater element at different points, and wonderful to relate, the diagram shows that these rays "scatter around" with much more divergence than was shown

in our diagram. On the opposite page we reproduce our diagram from page 43 of our opening brief and appellee's diagram from page 14 of appellee's brief. A casual glance will show that our diagram is more liberal to Shoenberg than that of appellee. In appellee's diagram the rays "scatter around" more than in ours. This in confirmation of our contention regarding the Shoenberg heater. We feel grateful to the learned counsel for appellee in this behalf.

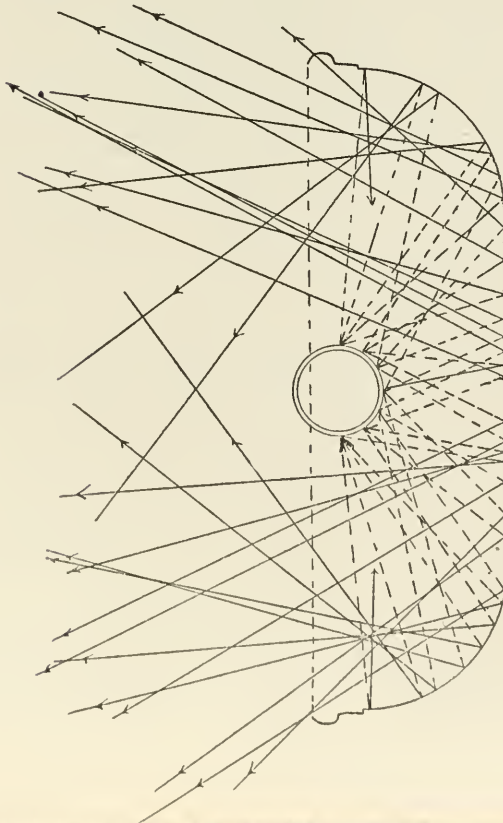
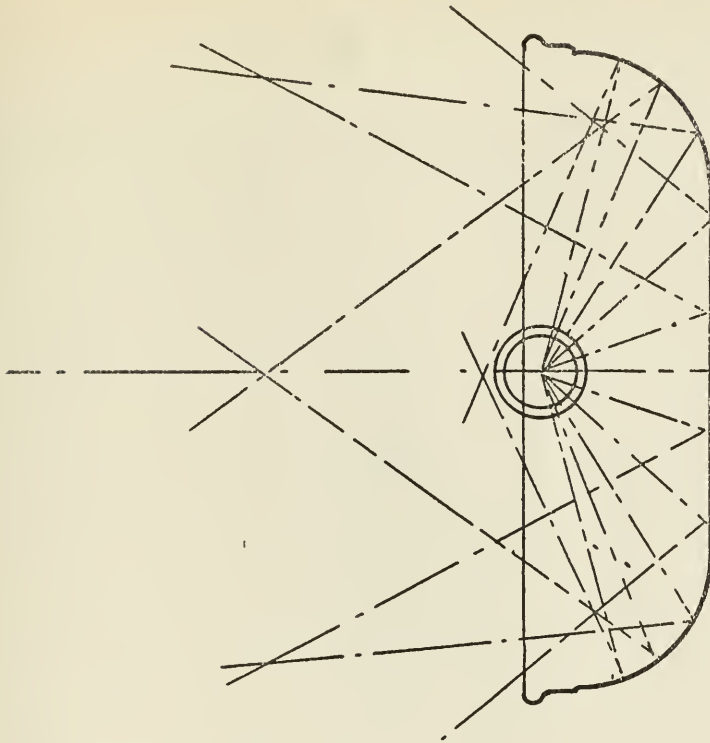
Furthermore, the history of the Shoenberg heater, represented by the early Majestic devices, is strong corroborative proof of our contention. Those devices were inefficient, and were abandoned immediately upon the advent of the Brown patented heater.

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#### SIMPLEX PATENT.

The Simplex English heater stands in the same category as the Shoenberg. The utmost it shows is a conception of the desirability of utilizing the radiant beam principle. But it fails utterly to disclose a concrete device capable of successfully carrying that principle into practice. We have already argued this matter at length in our opening brief, and need add but little thereto. We venture, however, to reproduce on the

## APPELLANT'S DIAGRAM—SHOENBERG HEATER

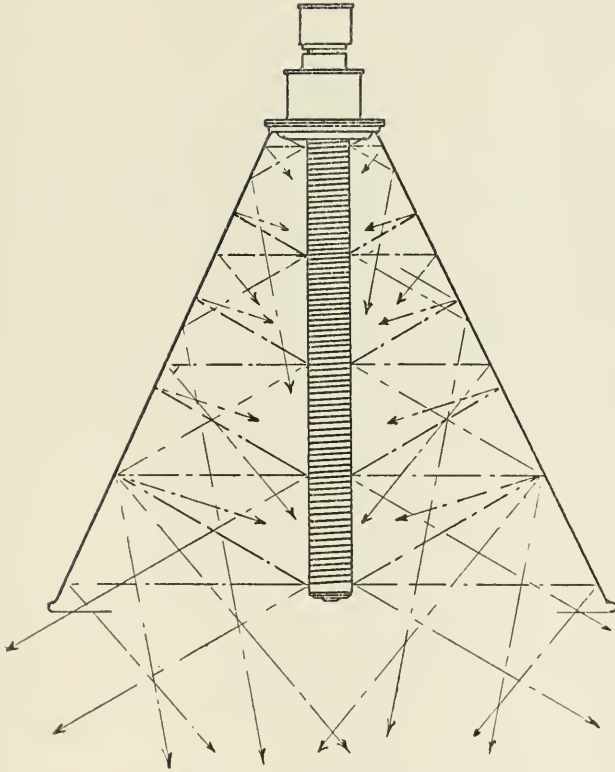


opposite page a diagram illustrating the operation of the heat rays in the English Simplex heater. It will be seen therefrom that these rays "scatter around" quite as much as in the case of the Shoenberg heater.

We also desire to make reference in this connection to the defendant's exhibit 8, which is a publication of the English Simplex heater in the "London Electrical Times". It is there called the "Plexsim Fire". In the first diagram eight heat rays are shown as being projected outward from the reflector in parallelism. The other rays, which will criss-cross each other as shown in our diagram, are not illustrated in the publication. In other words, the maker of this diagram seemed to have selected a small number of rays which would be in parallelism, and to have wholly disregarded the millions of other rays which would not be so projected but would criss-cross each other, and some of which would never get out of the cone at all. The majority of the others that would get out of the cone would "scatter around" in all directions. Therefore, according to defendant's expert Beam the Plexsim is not a radiant beam heater.

But the specific point we make in reference to this diagram of exhibit 8 is that it is wholly misleading, if it is intended to show that *all* of the rays emanating from the reflector will be in parallelism. In reference to this point we rely upon the testimony of plaintiff's expert witness, who says of this exhibit 8 at pages 110-11 of the record in case 3617:

"A. I certainly am. This reflector that you have referred me to, and particularly the diagram showing



**SIMPLEX ENGLISH PATENT**  
**No. 19971**

the arrows indicating supposititious divergent rays, I will say that in all probability those specific rays will be thrown out from that form of reflector, and that form of heater, but that is about all of the rays that will be thrown out, a very, very small percentage of the total heat. The rays that come from every other point on that long heat-generating unit will be thrown at all kinds of angles, every possible angle. So that the actual rays which will emanate from there in an axial direction are but such a small percentage of the total that I am convinced more than ever that that form of reflector would be inefficient for the production of a beam. There is no question but that the man wanted to produce a beam, but he did not do it in this form of reflector, or in that form of heater. He would have to get up pretty close to that, to feel the radiant energy. \* \* \* It will probably generate as much heat \* \* \* but that heat will not be directed in the form of a beam with a sufficient efficiency to warrant calling that form of heater a beam heater. It will get hot itself, it will heat air around it locally a little bit, and heat will be extending that way; but in the Brown form of heater, the idea was and the result was that a larger percentage of that heat is gathered and thrown out in the form of a beam as radiant energy. This diagram which you handed me is highly misleading; it is purely an advertising stunt; it is a salesman's idea of how to present a thing to the public and get them to buy, and I have no doubt he put it over. But it is as misleading as a diagram could be as regards the rays that emanate from the inside of that form of heater in action. \* \* \*

It shows a total misconception of the construction of a reflector and a heat unit to produce a radiant beam."

We say of this English patent, with all the emphasis at our command, that if the inventor had the conception of the radiant beam principle, he did not embody it in concrete practical form so as to make it useful to mankind. Unsuccessful and inoperative devices are not anticipations. Where the idea of the patent in

suit is not present in the prior patent and readjustments and modifications are necessary to bring out the idea and to embody it in successful concrete form, there is no anticipation (*Mershon v. Bay City*, 189 Fed. 745).

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**WARNER.**

The Warner patent stands on a more unsubstantial basis than even the Shoenberg or the Simplex, because that device is nothing more than a convection heater. Its purpose is to heat large volumes of air, which go out into a room and ascend towards the ceiling, thereby allowing fresh increments of cool air from the room to flow into the bowl, where they are in turn heated and discharged into the room. It is purely a convection heater, a hot air stove for heating an entire room.

Not only does the evidence show this, but there are many ear marks connected with the Warner patent sustaining the contention. The heating unit is shut up or inclosed within a housing, which separates it from the surface of the reflector, so that its heat rays cannot and do not reach the reflector. That heater element is not intended to become incandescent. It merely gets red hot. Nor is this heating element located near the focus. It is of circular form and is located near the rim of the reflector away from the focus. Again, an electric bulb is located in the center of the circular heating unit, presumably for the purpose of lighting up the structure. It is notable also that the reflector has no protective cage of arched guard wires over the mouth of the reflector.

This Warner heater is, as the specification says, a device "capable of readily heating large volumes of air, making it particularly useful for the heating of rooms".

We submit that the Warner heater has no relevancy to the issue here involved and fails utterly as an anticipation of Brown or even as a disclosure of the radiant beam principle in any form whatever.

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**GEIGER.**

The only other patent relied upon is that of Geiger, dated, August 8, 1916. This patent is strong corroborative proof of our contention. It is the property of the Westinghouse Company, the appellee. That company essayed to market that device before the Brown patent appeared in the field. Consequently, it may be assumed that it represented the best efforts of its experts in producing an acceptable electric heater. Of course, it is ridiculous to assert that Geiger is an anticipation of Brown. What we understand counsel to assert is that Geiger illustrates the radiant beam principle. That appears to be the limit of the contention. But in that behalf we assert that in Geiger's case there will be no substantial parallelism of heat rays. On the contrary they will "scatter around" in all directions. This must be true because the reflector surface is of corrugated form. In order to illustrate the radiant beam principle, as we understand it, there must be a reflector answering to a mathematical for-



mula, that is to say, it must be of a concavo-convex form, which is to say that it must be either parabolical or hemispherical. Geiger's reflector does not answer these requirements. It is neither an anticipation nor a limitation of Brown.

The history of the device is further confirmation of our contention. If it illustrated the radiant beam heater and was a successful and meritorious device, why is it that the Westinghouse Company abandoned it and adopted their present form of heater, which does illustrate the radiant beam heater and which is successful in practice? The answer is plain. Brown taught them how to embody the radiant beam principle in a successful mechanical form, and they merely followed in the footsteps of Brown. We again insist that prior to Brown there was not any portable electric heater embodying in successful and practical form the radiant beam principle.

The situation is quite simple as to the facts. We catalogue those facts as follows:

1. PRIOR TO BROWN THERE WAS A LONG FELT WANT FOR A RADIANT BEAM HEATER.

2. OTHER INVENTORS, REALIZING SUCH WANT, ENDEAVORED BY VARIOUS AND SUNDRY FORMS OF MECHANISM TO SATISFY IT.

3. EACH AND ALL OF THOSE PRIOR CONTRIVANCES PROVED INEFFECTIVE AND WERE ABANDONED; NOT ONE OF THEM SURVIVED, AND THEY CONFERRED NO BENEFIT ON MANKIND.

4. BROWN SOLVED THE PROBLEM WHEN HE PRODUCED No. 7-HEATER EMBODYING THE RADIANT BEAM PRINCIPLE,

WHICH FILLED THE WANT OF THE PUBLIC AND WENT INTO IMMEDIATE AND EXTENSIVE USE THROUGHOUT THE CIVILIZED WORLD.

5. HIS PREDECESSORS, WHO HAD ESSAYED TO MARKET THE PRIOR DEVICES, ABANDONED THE SAME AND PROCEEDED TO MARKET IN LARGE NUMBERS PORTABLE ELECTRIC HEATERS OF THE SAME TYPE AND EMBODYING THE SAME PRINCIPLE AS THE BROWN HEATER.

In these circumstances Brown made "a distinct advance in the art", a substantial contribution to the world, and his patent is entitled to a liberal interpretation.

The following decisions of this court sustain us in our view:

*Smith v. Seattle*, 261 Fed. 85;  
*Stebler v. Riverside*, 205 Fed. 740;  
*Letson v. Alaska Packers*, 130 Fed. 140;  
*American Can v. Hickmott*, 142 Fed. 144;  
*Simplex v. Hauser*, 248 Fed. 924.

In *O'Rourke v. McMullin*, 160 Fed. 938, the Court of Appeals for the Second Circuit (Lacombe, Coxe, and Ward) said:

"The principal question in such cases is: Has the patentee added anything of value to the sum of human knowledge, has he made the world's work easier, cheaper and safer, would the return to the prior art be a retrogression? When the court has answered this question, or these questions, in the affirmative, the effort should be to give the inventor the just reward of the contribution he has made."

From a review of all the cases on this subject we think it safe to say if there is one controlling purpose deducible from these cases, it is the steadfast determination of the courts to protect and reward the man who has done something which has actually advanced the condition of mankind; something by which the work of the world is done better and more expeditiously than it was done before.

We think Brown comes squarely within the purview of these considerations. He undoubtedly did something which has contributed to the comfort of mankind, something which is an advance in the art, something which has proved to be of substantial and material benefit. A return to the prior art would surely be a retrogression.

Dated, San Francisco,  
March 24, 1921.

Respectfully submitted,

JOHN H. MILLER,

*Solicitor for Appellant.*

