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Nos. 3616, 3617, 3618

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

MAJESTIC ELECTRIC DEVELOPMENT COMPANY
(a corporation),

Appellant,

vs.

WESTINGHOUSE ELECTRIC & MANUFACTURING
COMPANY (a corporation),

Appellee.

SUPPLEMENTAL BRIEF FOR APPELLEE.

(Filed by Leave of Court.)

WESLEY G. CARR,

DAVID L. LEVY,

WALTER SHELTON,

Solicitors for Appellee.

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SUPPLEMENTAL BRIEF FOR APPELLEE.

(Filed by Leave of Court.)

At the conclusion of the argument of appeal No. 3617, counsel for appellant requested permission to file a reply brief directed to the matter of validity of the utility patent constituting the subject-matter of that suit, on the ground that the opening brief had been prepared with the understanding that Judge Dietrich had found the patent in suit valid but not infringed. This request was granted by the court and it is possible that counsel for appellant intended to and did also request permission to file a reply brief respecting the bearing of the prior art upon design patent No. 51,043 and that the court intended to, and did, grant such permission.

The reply brief filed by appellant's counsel recognizes no such limitation but discusses not only the matter of the validity of each of the patents just mentioned but sets forth, at length, his views as to infringement which the original or opening briefs purported to cover fully.

It is in view of the discussion of matters outside the proper and legitimate scope of the brief which counsel for appellant was granted leave to file that we now present this supplemental brief.

APPELLANT'S PRELIMINARY OBJECTION.

Respecting the objection by counsel for appellant to our presentation to the court of copies of British patent to Kempton No. 12,330 of 1848 and British patent to Taylor No. 102,070 of 1916, we emphatically disclaim any attempt to improperly influence the court in its decision by presenting such copies or any intent to place before the court material which may not properly be considered.

Because of the failure of appellant to reproduce the paper exhibits as parts of the printed record, we assembled three sets of copies of the defendant's paper exhibits for the convenience of the court during, and subsequent to, the oral argument and, inasmuch as Judge Dietrich specifically mentioned the British patents Nos. 12,330 of 1848 and No. 102,070 of 1916 in his opinion, we believed that the court might desire to examine copies of such patents in order to acquire a full and clear understanding of such opinion.

The copies of the British patents in question were not presented to the court as exhibits but merely as, in effect, parts of Judge Dietrich's opinion and without any expectation that the court would make use of such copies, except in so far as they might be found convenient for the purpose just stated.

As a matter of fact, the patents in question are not material to appellee's case, and our only reason for presenting any argument here with reference to them is to make clear to the court that we had no ulterior motive in making such comments as we have heretofore made or in presenting copies for the inspection of the court.

As was noted in our main brief, the Kempton British patent is of interest only as embodying a very early disclosure of a heater embodying a parabolic reflector.

The objection by counsel for appellant to consideration of the Kempton patent in these suits may be technically well founded because the patent was not actually offered in evidence in any one of them and, if the court deems it proper to disregard this patent upon such ground, we, of course, have no objection to make.

So far as the Taylor patent is concerned, counsel for appellant alleges that he might have antedated such patent by evidence of prior invention if the patent had been offered in evidence in case No. 3618. Whatever may be the fact in this regard, we consider the matter to be immaterial because the heater disclosed in the Taylor patent is the Majestic No. 3 heater (Defendant's Exhibit D) many, or at least some, of which were manu-

factured and sold more than two years prior to the date of application for the patent in suit.

The substantial identity, so far as configuration is concerned, of the device shown in the Taylor patent and the defendant's exhibit D is so obvious that what Judge Dietrich said with reference to the Taylor patent might just as well have been said with reference to that exhibit. Such being the case, the complaint made by appellant's counsel respecting Judge Dietrich's statement has form without substance.

Even though it should be held that it was error on the part of Judge Dietrich to make reference to the Kempton and the Taylor British patents, it is clear that such error was inconsequential.

Patent No. 51,253 was correctly held to be invalid. Whether the invalidating subject matter is identified as a heater or as the picture of a heater is of no moment.

INVALIDITY OF DESIGN PATENT No. 51,043.

So far as the matter of invalidity of design patent No. 51,043 is concerned, Judge Dietrich distinctly held that the structure embodying the patented design, as a whole and as regards all its elements, is intended and employed only for utility purposes and such holding was fully discussed by counsel for appellant in his opening brief.

The further discussion in appellant's reply brief is inconclusive and unconvincing.

The brief alleges that it is the specific form of the design of the patent in suit that produces a certain appearance of pleasing aspect and then alleges that defendant has adopted such specific form or "a colorable imitation thereof". The brief then proceeds to specify the several elements of the device, *except the broad marginal flange which alone distinguishes the design from the prior Majestic devices (Defendant's Exhibits B, C and D).*

Appellant's counsel criticizes the appellee for adopting a circular base, an upright standard, a hemispherical reflector, a tubular, cylindrical heating unit and a cage of arched guard wires and, in that connection, alleges that appellee might have adopted some other form of base, some other form of standard, some other form of reflector, some other form of heating unit and some other form of guard.

Appellee admits that its heater might have been so designed as to embody elements having the forms suggested by appellant's counsel if the suggestions had been made at a sufficiently early date but it presumably would not have done so because it had a wide range of choice within the prior-art field.

Appellee preferred the base and standard of the British patent No. 19,971 of 1913 to any of the several forms suggested by appellant's counsel as available.

Appellee's adoption of a spherically curved reflector, such as is shown in the Warner patent (Defendant's Exhibit H), does not meet the approval of appellant's

counsel but hardly constitutes a reasonable ground of complaint.

Just why appellee should have adopted a heater element of "pyramidal form, or elliptical form, or circular form", as suggested by appellant's counsel, when the element of the British patent No. 19,971 of 1913 and that of the "abandoned" Majestic devices were available is not clear, so long as the cylindrical form was preferred.

As regards the protective wire cage, the suggestions of appellant's counsel are not helpful at this time, but would presumably have been rejected if offered at a sufficiently early date to have made them available because appellee preferred—for *protective purposes*—the arched wire guard of the Porter patent (Defendant's Exhibit N) or that of the "abandoned" Majestic heaters (Defendant's Exhibits A, B, C and D).

Appellant's complaint of "the use of these specific forms" as infringing the patent in suit is, therefore, a complaint that the patent in suit is infringed by the prior art.

THE DESIGN IS SPECIFIC.

We agree that the design of the patent in suit is specific, and necessarily so, because it would not otherwise be distinguished, in any manner or degree, from the prior art of record.

It is apparent from the prior art and also from appellant's utility patent No. 1,245,084 that the design of appellant's No. 7 heater, if new at the time the first

sample was produced, was new only because of the broad marginal flange which constituted a part of the enclosing casing and extended outwardly from the margin of the reflector. This is mainly what the patentee Brown added to the No. 2 Majestic heater (Defendant's Exhibit B). It is true also that Brown made the standard shorter and larger in diameter, the reflector larger in diameter and provided it with a reflecting surface of burnished copper, but, notwithstanding the lengths to which counsel for appellant is willing to go for the purpose of attempting to demonstrate validity and infringement of the patent in suit, he hardly dares to go so far as to allege that decreasing the length and increasing the diameter of the supporting standard, enlarging the diameter of the reflecting bowl and providing it with a surface of burnished copper are such changes as produce a new and patentable design.

If the appellant's design is new, in any patentable sense, its novelty is dependent solely upon the marginal flange and, while it may possibly be true that, notwithstanding such marginal flange, appellee's design might be held an infringement if it had some equivalent part not found in the prior art, *there is no escape from the fact that the appellee has omitted the marginal flange of the patent and, instead of providing a substitute, has merely utilized prior-art material which was available for use without paying tribute to anyone.*

An infringing colorable imitation of a patented design must be colorable away from, not into, the prior art.

In order to establish both validity and infringement, the appellant is in a hopeless position. *The marginal*

flange must be included in order to impart validity and must be excluded or ignored in order to establish infringement.

SCOPE OF PATENT IN SUIT.

A producer of a design for an article of manufacture may be an originator or an improver. If an originator, the designer produces a new type of either form or ornamentation. If an improver, he modifies, adds to, or subtracts from, an existing type. In the present case, the patentee Brown was not and could not be an originator because several English designers, Warner and Shoenberg and others had preceded him in the portable, radiant, reflector-type electric heater field.

Inasmuch as the Majestic Company had developed, manufactured and sold heaters of the type in question long prior to the production of the design of the patent in suit and these heaters were well known to the patentee Brown, we may, for convenience, select the Majestic No. 2 heater (Defendant's Exhibit B) as a representative of the type and, with that as a starting point, determine what Brown designed as an improver.

First, he changed the dimensions of the reflector and the supporting stand, without materially changing the form of either, and made the reflecting surface of copper in place of nickel. Even appellant's counsel would hardly go so far as to claim that these changes involved invention, within the purview of the design-patent statute.

But Brown did something more than this—*he added a supplemental back or casing for the reflector and a flat peripheral flange—both for protective purposes—not for ornament.* The protective casing does not make a sufficient change in the contour of the device to make it a patentable modification of the design any more than do changes in the dimensions of the reflector and the supporting stand.

Whether the broad marginal flange is an ornamental feature, within the purview of the statute, may be open to question but, whatever may be the fact in this regard, *the flange is all that Brown added which can by any possibility make his design new in any patentable sense.*

NO MISAPPLICATION OF RULE OF CONSTRUCTION.

The appellant alleges a misapplication by Judge Dietrich and by counsel for appellee of the established rule of construction for determining whether a given design is or is not an infringement of a design patent. In this counsel for appellant is in error. It would unquestionably have been held by Judge Dietrich that, if the patentee Brown had been an originator of a heater of a new type, slight variations, or perhaps, even variations of considerable proportions, would not serve to relieve the appellee's device from the charge of infringement, but, in the case of an improver where the feature constituting the improvement which differentiates the design from prior designs of the same type is omitted by the alleged infringer, colorable imitations which dif-

ferentiate only in the direction of prior-art devices cannot be held to amount to infringement without ignoring the facts and all decisions of the courts which have construed the statutes and applied them to facts of like character and import.

No amount of argument can make the appellant's and the appellee's designs different from what they actually are and no amount of argument can make them alike unless the prior devices which are exemplified and disclosed in defendant's exhibits are ignored.

UTILITY PATENT.

Patent No. 1,245,084 has been so fully discussed in our main brief that further comment is unnecessary except to call attention to and emphasize the erroneous allegation on the part of appellant's counsel that the patentee was the first to produce a so-called beam heater. As a matter of fact, the theory that a substantially cylindrical beam of heat is produced by the patented device did not originate with the patentee Brown, but apparently had its origin in the mind of counsel for appellant or that of his expert witness Henry. Considered apart from the device itself, the theory is attractive but, as we have already demonstrated, at least one-half of the heat generated in the element of the Brown device is radiated outwardly through a very wide angle without impinging upon the reflector, and those rays which actually do impinge upon the reflector are reflected in various direc-

tions in such manner and to such degree as to disprove the beam theory.

It was quite proper that the patentee should not describe the production of a beam of heat, because any such exposition would have been without support in fact and could not by any possibility have enabled the patentee to secure a valid claim which omitted the only element that served to differentiate the structure from the prior art, namely, *the marginal flange as a protective device*, HAVING NOTHING WHATEVER TO DO WITH THE PRODUCTION OF A BEAM OF HEAT.

The Majestic Company manufactured and sold, in considerable numbers and over a considerable period of time, the 1, 1b, 2, 2b, 3 and 3b heaters and there is nothing in the record to show that these heaters were unsuccessful, although the record does show that the manufacture and sale of these heaters was abandoned in favor of the No. 7 heaters.

It is quite within the range of possibility, if not probability, that, if the reflector of the No. 2 heater had been enlarged and provided with a burnished copper surface, the demand which appellant's counsel alleges was satisfied by the No. 7 heater would have been met by such enlarged, copper colored device, even though the supplemental casing and its peripheral flange had not been added.

The allegation of appellant's counsel that other devices made by other manufacturers prior to the exploitation of the No. 7 heaters proved ineffective and were abandoned is a statement of conclusion, and per-
statute

haps of belief, but is not substantiated by the evidence of record.

Dated, San Francisco,
April 12, 1921.

Respectfully submitted,

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