

The improved boot and shoe uppers, or other leather work, having a series of mock buttons, formed as described, each button being provided with embossed stitches, as shown and described.

The real and only question, then, which this case now presents is, whether the upper provided with these devices, which upper is to be substituted for the ornamental one now employed having genuine buttons and stitches, is patentable as an article of manufacture.

Tested by the criterion laid down in *Charles A. Moore*, (Decisions, 1871, p. 249,) the answer is easy: First, it is, of itself, an article of trade. Second, it is useful. And in this connection it is to be observed that there are two recognized and reliable tests of the utility of an article of manufacture; the first referring to its function or operation, and the second to its cost of production; and it is immaterial whether an article of manufacture works a benefit in what it does when in use, or in what it saves, as a substitute, in cost of production. It is, in either case, endowed with that element of usefulness required to render it patentable. Judged by what it saves in cost of production over the ordinary uppers having genuine buttons, this upper is, as already stated, useful. Third, it is "so different in essential points from other articles of the class to which it belongs as to be easily distinguished in the market." With reference to this point, in order that there may be no misunderstanding, the precise words of the Commissioner should be noted. He says, "so different in *essential points*," clearly referring to those prominent requirements of the law defining patentable subject-matter, and referring to the element of novelty which must attach to the article itself, and be apparent upon reasonable inspection by the public, or that portion of it for whom the article is intended.

As this case is now presented, I think it should be examined as to the novelty of the alleged invention, which is the only question I perceive as to its patentability.

J. D. DIFFENDERFER.

Appeal.

APPEAL FROM THE PRINCIPAL EXAMINER IN THE MATTER OF THE APPLICATION OF JOHN D. DIFFENDERFER FOR LETTERS PATENT FOR A DESIGN FOR DESK-STANDARD.

(Decided July 8, 1872.)

Practice under Rule 44—Design patents—Functional claims.

In an application for a design patent both the obverse and reverse of the design may be shown.

But the views should correspond, that is, illustrate like portions of the device claimed.

A patent for a design cannot be granted where the function of a device forms an element of the claim.

Where the claim is for a "design substantially as shown and described," and the description contains references to the purpose and use of certain devices: *Held*, that function is thereby carried into the claim, which therefore should not be allowed.

THACHER, Acting Commissioner :

In taking this appeal applicant says: "The question for decision is, can applicant show and describe the inner as well as the outer side of his standard?" I have no hesitation in giving an affirmative answer to this question. Every applicant for a design patent has an undoubted right to show both the obverse and reverse of the ornamental work which he has devised. But the two faces should correspond; if one be shown entire the other should be also. In this case, while the obverse of the standard is fully illustrated the reverse is only partially shown. The drawings should be amended to correct this error: Fig. 2 should be made to correspond with Fig. 1, so as to represent the reverse of the entire standard.

I find, upon examination, that this is not the only question in the case. In his first letter of rejection the examiner states his objection to the grant of a patent as follows:

The application above named embraces much more than can be admitted in a design. The exterior form or configuration is all that can be allowed. The other parts, relating to function, must be erased from the specification and drawing.

Subsequently to this action applicant amended his specification and drawing so as to overcome, as he supposed, the objection of the examiner. This it seems he failed to accomplish, for on the 1st instant the examiner rejected the case a second time, restating his position, as follows:

The same objection exists to the specification as amended as to the original; and nearly the same form of a school-desk can be found in this room, which was placed there on the 3d day of January, 1870.

It becomes necessary, then, to examine the description and claim in this case, to determine whether the function of the standard forms any part of the invention claimed. Applicant claims—

The design for a desk-standard, substantially as herein shown and described.

Turning to the description I find that in describing the inner side, or reverse of the standard, certain flanges and projections are described and referred to by letter, the purpose of which, as stated by applicant, is to form supports for the bottom, end-pieces, and shelves of the desk. This language obviously carries the function of the parts mentioned into the claim for the design, for said claim refers directly back to the description for its interpretation. This class of claims in application for design patents has already been criticised by the Commissioner, and the field to be occupied by such patents clearly defined in the appeal case of Peter C. Parkinson, C. D., 1871, p. 251.

The present case, in my opinion, comes clearly within the ruling in the description referred to above, and in accordance therewith the applicant should be required to erase from his description all reference to the function of the standard, or any portion thereof, described.