Statement of the case.

Now, therefore, I hereby certify to the Hon. William D. Bishop, Commissioner of Patents, that having assigned the 6th day of June instant for hearing said appeal, and the parties having been assisted by written arguments of counsel, I have considered said cause, and I do therefore adjudge and determine that there is error in the decision of the Commissioner of Patents heretofore rendered in this case awarding a patent to D. D. Jones, assignee of Edmund Morris; that said decision is hereby reversed, and that a patent must be refused and his said application be finally rejected and dismissed.

J. Dennis, Jr., for the appellant.

H. Howson, for the appellee.

IN RE MATHEW CHAMBERS. APPEAL FROM REFUSAL TO GRANT PATENT.

OFFICE PRACTICE—FORMS OF PROCEDURE IN THE OFFICE—NOT APPEALABLE.—As the manner in which the Commissioner shall aid the inventor—by information and suitable references, so as to assist his judgment in determining whether he shall persist in or abandon his claim—is submitted to the discretion of the Commissioner, no appeal lies from his action in this regard to the Circuit Court.

NOVELTY.—The invention compared with patent to Alexander Douglass, April, 21st, 1857, (No. 17,082,) and English patent 2513, of 1856, and found not to be anticipated.

(Before MERRICK, J., District of Columbia, June, 1859.

STATEMENT OF THE CASE.

The patent issued to Chambers, July 12th, 1859, No. 24,720, with the following claim: "Combining with and securing to a corset band extending in the rear, or in the rear and front downwards from the waist, to clasp the body around the hips of the wearer, the frame-work of a skirt or bustle, when said frame-work is composed of hoops disconnected and fastened in front, or thereabouts, substantially as described and for the purposes set forth.

REASONS OF APPEAL.

First. Because on an examination of the alleged new invention or discovery it did not appear that the same improvement in bustles had been discovered or invented by any other person in this country prior to the alleged invention or discovery thereof by the applicant, the said Mathew Chambers, or that it had been patented or described in any printed publication in this or any foreign country, or had been in public use or on sale with the applicant's consent and allowance prior to the application, or that the improvement such as this is not sufficiently useful and important to be worthy of a patent.

Second. Because in deciding against the said Chambers' application for a patent for improvement in bustles, by simply intimating that a certain English patent (Osman's) is considered to be an apposite reference, without giving any grounds to support such a position—which amounts to an *ipse dixit*—he departed from the correct practice of the Patent Office and acted contrary to the spirit of the law.

Third. Because he decided finally upon the appellant's case, by simply reaffirming the former action, without reconsidering the application.

Fourth. Because he decided that if upon appeal to the Commissioner a case be rejected, not upon the same references that had been given by the examiner, (said references having been declared by the Commissioner to be not in point, and therefore void and invalid,) but upon an entirely new reference, the applicant is not entitled to have his case re-examined on his former claim or on a claim substantially similar; thus deciding in effect that, because the examiner had erred (according to the Commissioner's own opinion) in deciding adversely to the applicant's claim, the applicant should be deprived of the privilege of a second examination or reconsideration of his claim, as provided by law.

Fifth. Because he decided that the appellant's claim of invention is covered by Osman's patent, contrary to the express language of the two specifications and claims.

Sixth. Because he decided that the objects and purposes intended to be accomplished by and derived from the appellant's invention might or could be accomplished by Osman's; whereas

his arrangement, on the contrary, is not at all available or serviceable for distributing the weight of the skirts in order to relieve the waist from over-pressure, which is the main object of the appellant's invention.

MERRICK, J.

In considering the reasons of appeal filed in this case, the second, third, and fourth appear to me to present questions more properly addressing themselves to the consideration of the Commissioner in connection with the internal discipline and routine of practice of the Office, not involving matters cognizable before a judge of the Circuit Court upon appeal. The law undoubtedly requires of the Commissioner to aid the inventor by information and suitable references in remedying a defective specification or claim, and to assist his judgment in determining whether he should withdraw or persist in a rejected application; but the manner of so doing is of necessity left to the sound discretion of the Commissioner; and whether the duty be well or insufficiently performed in a particular instance, is not the subject of review, and from the nature of such cases cannot be passed upon by a judge on appeal. I therefore dismiss those three objections from further inquiry.

The first, fifth, and sixth reasons of appeal amount to but one, viz., that his invention has not been anticipated by any other, and particularly that the English patent of Osman (described in the thirty-first volume of English Specifications for 1856, No. 2,513) does not embrace his claim. The examiner originally in charge of the case rejected the claim upon reference to the patent of Alexander Douglass of April 21st, 1857 (No. 17,082); but upon review of his decision upon two successive modifications of the claim, the Commissioner, confirming reports of the board of review, declared that reference inapplicable, upon the ground that Chambers relied upon a combination of a corset band with the frame-work of a hooped skirt, and that this was not to be found in Douglass' invention, but that the essential features of his invention were embraced by Osman's patent. Upon comparing Osman's patent with Douglass', I have not been able to discover the combination of a corset band furnished with distributing stays upon the back, sides, and front thereof, any more than in Douglass'; but in the element of usefulness and novelty most relied

upon in the present claim, to wit, the distribution of weight and compression upon the parts of the body best adapted to sustain weight and compression, the advantage appears to me to be with the Douglass patent, in this: that Osman's transfers the weight from the circle of the waist by three perpendicular strips of metal, forming the heads or fulcrums of the three springs which make the bustle, while the cords or adjustable metallic bands marked in Douglass' drawings *C C* distribute that same weight much more perfectly and on a much larger surface of the lower back and hips of the wearer. If, therefore, Douglass' invention is not in the way of the combination claimed by Chambers, neither is the patent of Osman. If the application of Chambers extended no further than to a partial relief of the waist of the wearer, by distributing a portion of the weight of the dress upon the strong parts of the back, I should feel obliged to reject the claim upon that reference; but the claim goes not only to the relief of weight upon the waist, but to the relief of the waist from the ill effects of the necessary confinement and compression along the front of the circle of the waist; and this is accomplished by the continuation of the corset and its arrangement in such way as to operate as an abdominal supporter, and making the weight and stricture, which might prove injurious if limited to the waist, beneficial, by distributing them, by means of the stays and lacings of the corset, over the whole abdomen. In this way, it appears to me that he has introduced a new feature of general distribution of weight and compression over the abdomen, loins, and back not found in the other patents, and sufficiently distinctive to entitle him to a patent for his combination of a bustle with a corset, in the manner described in his specifications. The vital element of Douglass' invention, although, as I have just said, it embraces some parts of Chambers' claim, consists in the admirable adaptation of the adjusting cords *C C*, which give lightness and form to the article and enable the wearer from time to time to change the arc of its curvature in obedience to the demands of good taste. And looking to this as the controlling idea in Douglass' patent, I cannot think that the invention of Chambers materially conflicts with it, and hence conclude that each should receive from a discriminating public the appropriate rewards for his ingenuity.

A. Pollok, for the appellants.