

Repealing Patents

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ABSTRACT

The first known patent case in the United States courts did not enforce a patent. Instead, it sought to repeal one. The practice of cancelling granted patent rights has appeared in various forms over the past two and a quarter centuries, from the earliest U.S. patent law in 1790 to the new regime of inter partes review (“IPR”) and post grant review. With the Supreme Court’s grant of cert in *Oil States Energy Services v. Greene’s Energy Group* and its pending review of the constitutionality of IPR, this history has taken on a new significance.

This essay uses new archival sources to uncover the history of patent cancellation during the first half-century of American patent law. These sources suggest that the early statutory provisions for repealing patents were more widely used and more broadly construed than has hitherto been realized. They also show that some U.S. courts in the early Republic repealed patents in a summary process without a jury, until the Supreme Court halted the practice. Each of these findings has implications—though not straightforward answers—for the questions currently before the Supreme Court.

INTRODUCTION

The first known patent case in the United States courts did not enforce a patent. Instead, it sought to repeal one.¹ Under the earliest federal patent laws, passed in 1790 and 1793, any member of the public could seek cancellation of a patent right. Rival inventors, business competitors, potential infringers, or aggrieved citizens generally—any of these were empowered, under certain conditions, to pursue revocation.

For recent observers of the patent system, this history might come with the shock of recognition. In 2011, in response to a wave of complaints about poor patent quality and the high cost of contesting a patent in litigation, Congress created two new proceedings for cancelling invalid claims. Inter partes review (“IPR”) and post-grant review (“PGR”) are trial-like adversarial hearings within the Patent Office, taking place before

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¹ *Jenkins v. Folger* (D. N.Y. 1792), unreported case minutes at National Archives, New York City. See *infra*, Part II.B.

administrative judges of the Patent Trial and Appeal Board.² Inter partes review has rapidly become popular as a means to invalidate issued patent claims. Designed to be cheaper and faster than district court patent litigation, IPR and PGR are accessible in another sense as well: they once again allow members of the public at large to challenge patent rights, albeit on limited grounds, regardless of whether they have any liability under the patent.³ The new measures depart from older historical practice by bringing adversarial cancellation trials into the Patent Office itself.⁴ But they follow a longstanding pattern in opening an affirmative channel to extinguish patent rights at a time when the politics of patent enforcement are running hot.

In that sense, history is repeating itself. The practice of revoking patent rights—meaning repealing a patent by a stand-alone proceeding, rather than by proving its invalidity as a defendant in an infringement case—has appeared in different forms over the past two and a quarter centuries of American law. It was never the primary means of contesting issued patents, a task that has instead fallen mostly to defendants in infringement litigation. But revocation has historically been one of the most sensitive indicators of the pressures within the patent system. At times, it has been a barometer of the problems of a particular statutory regime. On other occasions it has functioned as a safety-valve, venting some of the pent-up stresses created by aggressive patent enforcement. Perhaps understandably, given that revocation has been a repository for conflict over the patent system, the law has seldom been doctrinally straightforward: the grounds on which challengers were entitled to pursue repeal were frequently contested and controversial.

This history has taken on a new importance. Opponents of IPR have repeatedly challenged the constitutionality of administrative patent cancellation, alleging that the power to revoke an issued patent resides solely with the courts.⁵ The U.S. Supreme Court has now granted cert on a case, *Oil States Energy Services LLC v. Greene’s Energy Group, LLC*, that frames the challenge in terms of substantially historical inquiries about the nature of patent rights and the means of contesting them. The question before the Court is

² 35 U.S.C. §§311-329 (establishing IPR and PGR).

³ The option to seek a declaratory judgment of invalidity, previously the primary affirmative means of challenging a patent, depends on the challenger having Article III standing via an appropriate case or controversy with the patent owner. See *MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118 (2007).

⁴ A form of adversarial process for cancelling patent claims at the USPTO did exist before 2011. Inter partes reexamination, a precursor to IPR, was available from 1999 until 2011, and allowed any person to institute Patent Office review of a granted patent. The party initiating reexamination was allowed to participate in proceedings before the examiner and to appeal an adverse decision. See 35 U.S.C. §§ 314, 315 (2010), *amended by Leahy-Smith America Invents Act* (Sept. 16, 2011).

⁵ Greg Reilly, *The Constitutionality of Administrative Patent Cancellation*, 23 B.U. J. Sci. & Tech. 377 (2017).

Whether inter partes review—an adversarial process used by the Patent and Trademark Office (PTO) to analyze the validity of existing patents—violates the Constitution by extinguishing private property rights through a non-Article III forum without a jury.⁶

Two separate inquiries are entangled here. One is whether matters of patent validity are among the “suits at common law” in which the Seventh Amendment requires that “the right of trial by jury shall be preserved.”⁷ The other is whether the cancellation of an already-issued patent may be adjudicated by an administrative agency, outside the purview of the Article III courts. Under the Supreme Court’s Article III jurisprudence, “Congress may not ‘withdraw from judicial cognizance any matter which, from its nature, is the subject of a suit at the common law, or in equity, or admiralty.’”⁸ Challengers contend that IPR, by placing de facto trials of patent validity in the hands of an agency, does exactly that. However, the Court has recognized an exception to this doctrine for “public” rights that are integrally related to a federal statutory scheme.⁹ As a result, whether issued patents are by nature “private” or “public” rights may go a long way toward determining whether their validity may constitutionally be adjudicated by the Patent Office’s administrative tribunals.¹⁰

These are historical problems in the following sense. The Seventh Amendment “preserves” the jury right as it existed prior to the adoption of the Bill of Rights. The scope of the right is thus routinely decided after inquiries into founding-era English and American practices.¹¹ The public-right/private-right question is somewhat different, in that it need not be fixed to a particular point in the past. The “nature” of a patent right is not some eternal platonic truth, and there is no obvious reason why it should

⁶ *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, No. 16-712, 2017 WL 2507340, at *1 (U.S. June 12, 2017).

⁷ U.S. Const., Amendment VII.

⁸ *Stern v. Marshall*, 564 U.S. 462, 484 (2011) (quoting *Murray’s Lessee v. Hoboken Land & Improvement Co.*, 18 How. 272, 284 (1855)).

⁹ See *Stern*, 564 U.S. at 490-491 (“what makes a right ‘public’ rather than private is that the right is integrally related to particular Federal Government action”); see also *Granfinanciera, S. A. v. Nordberg*, 492 U.S. 33, 54 (1989) (Where Congress has acted “for a valid legislative purpose pursuant to its constitutional powers under Article I,” it may delegate even a “seemingly private right” to non-Article III courts if the right “is so closely integrated into a public regulatory scheme as to be a matter appropriate for agency resolution”) (citation and internal quotation marks omitted).

¹⁰ As a practical matter, a finding in favor of IPR on the Article III question will likely render the Seventh Amendment inquiry unnecessary. See *Granfinanciera*, 492 U.S. at 53-54 (holding that if Congress may constitutionally assign “the adjudication of a statutory cause of action to a non-Article III tribunal, then the Seventh Amendment poses no independent bar to the adjudication of that action by a nonjury factfinder”).

¹¹ See, e.g., *Feltner v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 346-52 (1998) (applying the Seventh Amendment to copyright statutory damages determinations); *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 376-83 (1996) (reviewing the question of whether patent claim construction was subject to the jury right under late-eighteenth-century English practice).

not vary with changes in the statutory scheme under which patents are created. But arguments on this point have nevertheless contained a heavy historical element, particularly around questions of whether eighteenth and nineteenth-century patents were described as private rights and/or thought to instantiate natural property rights of the inventor.¹²

My argument in this essay is that historical commentary on these points has been looking, if not in the wrong place, then not always in the right one. Specifically, the history of patent revocation under early American law has been missing.¹³ This omission is somewhat forgivable: although statutory patent repeal existed for the first forty-six years of American patent law, we have (up until now) known very little about its workings. But it is a problem, for several reasons.

For one thing, the American law of repeal seems a necessary part of the Seventh Amendment question. The Seventh Amendment is typically said to preserve “the right which existed under the English common law when the Amendment was adopted.”¹⁴ That makes sense in most cases: given the difficulty of locating an American common law before 1791, English practice makes a plausible baseline for founding expectations about the common law’s scope. But the United States *had a patent law before it had a Bill of Rights*.¹⁵ If the Patent Act of 1790 adopted a form of revocation distinct from English antecedents, then the Seventh Amendment inquiry should arguably turn on whether *that* proceeding included a jury trial.¹⁶

More generally, the law of patent revocation forced courts to articulate certain assumptions about the source and nature of patent protection. Was the patent a purely statutory creation or was it embedded in the common law? What was the nature of the public’s interest in an issued patent? If every patent was granted subject to some public right of revocation, then what were the grounds of that right, and what protections were afforded to the patentee? All of these questions were aired under America’s first patent

¹² See, e.g. the many briefs citing Adam Mossoff, *Patents As Constitutional Private Property: The Historical Protections Of Patents Under The Takings Clause*, 87 B.U. L. Rev. 689 (2007) and Adam Mossoff, *Who Cares What Thomas Jefferson Thought About Patents? Reevaluating the Patent “Privilege” in Historical Context*, 92 Cornell L. Rev. 953 (2007).

¹³ Statutory revocation does not appear, for example, in the leading Federal Circuit opinions on the constitutionality of IPR: *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284 (Fed. Cir. 2015) and *Cascades Projection LLC v. Epson America, Inc.*, 864 F.3d 1309 (Fed. Cir. 2015). Nor does it feature, other than indirectly, in the briefing to date in *Oil States*.

¹⁴ *Baltimore & Carolina Line, Inc. v. Redman*, 295 U. S. 654, 657 (1935).

¹⁵ The Patent Act of 1790 became law on April 10 of that year. The first ten amendments to the Constitution were ratified as of December 1791.

¹⁶ The Supreme Court has acknowledged the challenge that might be posed by American understandings conflicting with English practice in this context. See *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 376 n.3 (1996) (“Our formulations of the historical test do not deal with the possibility of conflict between actual English common-law practice and American assumptions about what that practice was, or between English and American practices at the relevant time. No such complications arise in this case.”).

laws, and all speak to the ways in which a patent was considered a public or private right. Again, the Article III question need not be decided on the basis of original meaning. But if history is to be invoked, then this history should be included.

To that end, this essay seeks to uncover the forgotten early history of American patent cancellation. Using new archival sources, it adds to and revises existing accounts.¹⁷ Part I traces the background of English patent law, less for its own sake than for the institutional and doctrinal legacy that American law would have to adopt, adapt, or move beyond. Part II then reconstructs early American statutes and practices. Some detective work is involved here. Because of the scarcity of traditional legal authorities—*i.e.* reported decisions and treatises—describing the law of patent repeal, understanding this legal regime means tracking the law in action. The results are revealing: revocation was more widely used and more broadly construed than has hitherto been realized, and the use of juries in repeal suits was a disputed issue.

The aim of this essay is not to take a firm position on the questions of constitutionality that *Oil States* must resolve. But I hope to illuminate and explain the historical complications with which those conclusions must engage.

I. THE ENGLISH BACKGROUND: *SCIRE FACIAS* IN THE NAME OF THE CROWN

American patent law emerged from English antecedents. Formally, the starting-point of each country's scheme was quite different: an English patent was a grant of royal privilege, granted as a matter of grace and favor by the crown.¹⁸ A United States patent was a constitutionally authorized exclusive right, intended “to promote the progress of . . . useful arts.”¹⁹ Even so, many of the essentials were similar. Both countries conferred a fourteen-year term of protection, based on a written specification of the invention and privately enforced through the courts. The founding era also saw substantial convergence between the two regimes. English patent law during the later eighteenth century drifted toward a less discretionary and more ordered conception of the patent, reimagining the royal privilege as a public benefit bestowed on the patentee in return for disclosure of the

¹⁷ The literature on this topic is led by, and consists largely of, Mark A. Lemley, *Why Do Juries Decide If Patents Are Valid?*, 99 Va. L. Rev. 1673 (2013). The state of the art on eighteenth-century English practice is now the Brief for H. Tomas Gomez-Arostegui and Sean Bottomley as Amici Curiae in Support of Neither Party, *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, No. 16-712, 2017 WL 3634324 (U.S., 2017).

¹⁸ W.A. Hindmarch, *A Treatise Relating to the Law of Patent Privileges for the Sole Use of Inventions*, 3 (London, V. & R. Stevens, G.S. Norton, and W. Benning, 1846); Oren Bracha, *Owning Ideas: The Intellectual Origins of American Intellectual Property*, 22 (2016).

¹⁹ U.S. Const. art. 1, §8, cl. 8.

invention.²⁰ Meanwhile American patents in the early Republic were, in the words of one historian, “a republican version of the traditional English patent framework.”²¹ The U.S. patent retained much of the character of an ad hoc patronage grant, and only gradually gained the trappings of a bureaucratically administered right. Although Americans contemplating their patent law often drew sharp distinctions between the two national orders,²² conceptual and doctrinal borrowing from England was inevitable and pervasive.²³

In their English form, exclusive rights for inventions were royal grants of privilege under “letters patent”—a category that included patents for invention, but also a wide range of other grants, monopolies, and offices. Sir William Blackstone, in his *Commentaries on the Laws of England*, described the King’s grants as “lands, honours, liberties, franchises, or ought besides . . . contained in charters, or letters *patent*, that is, open letters, *literae patentes*: so called, because they are not sealed up, but exposed to open view.”²⁴

The Crown granted, and the Crown could take away. For most of the period between the seventeenth century and the beginning of the twentieth, English patents for invention included a standard revocation clause permitting the monarch to withdraw the grant if it were deemed to be contrary to law, or “prejudicial” or “inconvenient” to the realm or to the King’s subjects.²⁵ Grounds for repeal included not only considerations such as novelty and priority, but also requirements that the invention be put into use, as well as broader questions about its impact on employment and trade.²⁶ During the seventeenth and early eighteenth centuries, the principal means for implementing this proviso was the Privy Council, a body made

²⁰ Bracha, *supra* note 18, at 22, 24-25.

²¹ Bracha, *supra* note 18, at 31, 191-201 (noting, *inter alia*, that “The logic of the 1790 statutory scheme was that of a republican version of the traditional English patent framework”).

²² *See, e.g.* Bracha, *supra* note 18, at 191-92.

²³ Justice Joseph Story, one of the principal architects of early American patent jurisprudence, began an 1818 essay on the subject by declaring that “[t]he patent acts of the United States are, in a great degree, founded on the principles and usages which have grown out of the English statute.” Joseph Story, “On the Patent Laws,” 16 U.S. (Appendix) 13, 13 (1818). The first American patent treatise cited almost entirely English authorities. *See* Thomas Green Fessenden, *An Essay on the Law of Patents for New Inventions* (Boston, D. Mallory & Co. 1810).

²⁴ 2 William Blackstone, *Commentaries on the Laws of England*, 346 (London, 10th ed., 1787) (*italics in original*).

²⁵ *See* D. Seaborne Davies, *The Early History of the Patent Specification*, 50 L. Q. Rev. 86, 102-103 (1934). The revocation clause continued to be prescribed through the Patent Act of 1902, by which time applications for revocation were handled by the Board of Trade of the Privy Council. *See* “Patents, Designs and Trade Marks,” 50, 65, in 9 *The Statutory Rules and Orders Revised* (London, H.M. Stationery Office, 1904).

²⁶ *See* Oren Bracha, *The Commodification of Patents 1600-1836: How Patents Became Rights and Why We Should Care*, 38 Loy. L.A. L. Rev. 177, 189-90 (2004); Adam Mossoff, *Rethinking the Development of Patents: An Intellectual History, 1550-1800*, 52 *Hastings L.J.* 1255, 1278-81 (2001).

up of the monarch's close advisors, which had the power to adjudicate both patent enforcement and petitions for revocation.²⁷ Privy Council deliberations were primarily debates about the public policy merits of specific monopolies.²⁸

During the eighteenth century, the role of the Privy Council in patent disputes faded.²⁹ Revocation came to rest less on a patent's political economy, and more on judicial scrutiny. This was the province of the writ of *scire facias*.

This form of litigation would repeatedly shape the assumptions of American doctrine, so it is worth unpacking its baroque form here. *Scire facias* (literally, "make known") was a writ founded on some official record, such as a record of court proceedings or a conveyance by the sovereign. Delivery of the writ required the defendant to show cause why the record might not be brought into court or have its subject matter overturned.³⁰ The writ traversed the landscape of royal privileges, applying to mistaken or unlawful grants by the crown, to offices neglected by their incumbents, and to franchises deemed abused by the holder or injurious to some vested right.³¹ According to Blackstone, a *scire facias* lay "[w]here the Crown hath unadvisedly granted any thing by letters patent, which ought not to be granted, or where the patentee hath done an act that amounts to a forfeiture of the grant."³² Surveying potential defects, Blackstone noted that "[w]hen it appears, from the face of the grant, that the King is mistaken, or deceived, either in matter of fact or matter of law, as in case of false suggestion, misinformation, . . . or if he grants an estate contrary to the rules of law; in any of those cases the grant is absolutely void."³³

Scire facias gained steam as a means of attacking patents for invention toward the end of the eighteenth century.³⁴ English patenting in general

²⁷ E. Wyndham Hulme, *Privy Council Law and Practice of Letters Patent for Invention from the Restoration to 1794* (pt. 1), 33 *Law Q. Rev.* 63 (1917).

²⁸ Bracha, *Commodification of Patents*, 189-91; Sean Bottomley, *The British Patent System during the Industrial Revolution 1700–1852: From Privilege to Property*, 105 (2014).

²⁹ The role of the Privy Council in patent adjudication began to wane as early as 1688. See Bottomley, *British Patent System*, supra note 28, at 111. Revocation cases persisted somewhat longer, with Privy Council involvement fading out in the later eighteenth century. Bracha, *Owning Invention*, supra note 18, at 22.

³⁰ Henry Campbell Black, *A Dictionary of Law*, 1065-66 (1891).

³¹ Thomas Campbell Foster, *A Treatise on the Writ of Scire Facias*, 12 (London, V. & R. Stevens and G.S. Norton, 1851); Joseph Chitty, *A Treatise on the Law of the Prerogatives of the Crown: And the Relative Duties and Rights of the Subject*, 330-31 (London, Joseph Butterworth & Son, 1820).

³² 3 Blackstone, *Commentaries*, 260-261 (10th ed., 1787).

³³ 2 Blackstone, *Commentaries*, 348 (10th ed., 1787).

³⁴ *Rex v. Arkwright* (1785) was the first reported decision in a *scire facias* case against a patent for invention, although an earlier case, *Rex v. Jacob* (1782) appears in Lord Mansfield's manuscripts. Five additional cases were reported between 1785 and 1800. See Sean Bottomley, *Patent Cases in the Court of Chancery, 1714–58*, 35 *J. Leg. Hist.* 27, 35 n.48 (2014); Lemley, supra note 17, at 1685 n.49. The most comprehensive survey of

accelerated during this period, as the Industrial Revolution took hold and as patent law in the courts became more coherent. *Scire facias* became part of the response to these developments. As applied to patents for inventions, the writ had a number of notable features.

First, *scire facias* presented a complicated mix of private and public action. The monarch had a right to sue to repeal his or her own patent. A private individual prejudiced by a wrongful patent also had the right to sue in the name of the King.³⁵ These private actions were theoretically allowed as of right, but were not necessarily easy to secure. Petitioners needed leave from the Attorney General, who could impose costs and delays.³⁶ At least the theory of individual participation was broad: as one leading authority summed it up, “[a]ll persons are injured by the existence of an illegal patent for an invention, and every one is therefore at liberty to petition for a *scire facias* to have it cancelled.”³⁷

Parties bringing *scire facias* actions also braved the intricate jurisdictional maze of the royal courts. To a modern American lawyer trying to characterize the nature of the writ—as legal or equitable, subject to jury verdict or judicial disposition—the picture seems wildly convoluted.³⁸ Because the writ was founded on an official record, *scire facias* to repeal a patent issued from the Court of Chancery, where the records of patents were enrolled. The Chancery Court was primarily known as an equity court, headed by the Lord Chancellor.³⁹ But patents belonged to a Chancery office

litigation to date found 29 *scire facias* cases brought between 1782 and 1852, most of them before 1830. See Bottomley, *British Patent System*, supra note 28, at 80, 83.

³⁵ 3 Blackstone, *Commentaries*, 261; Foster, supra note 31, 246-47 (citing *R. v. Butler*, 2 Ventr. 344 (1685); Hindmarch, supra note 18, at 385-86.

³⁶ William Hands, *The Law and Practice of Patents for Inventions* 16 (London, W. Clarke & Sons, 1808) (“[A] writ of *scire facias* . . . issues out of the Court of Chancery, at the instance of any private person, but in the name of the King, leave to issue it must therefore be previously obtained from the Attorney General.”); Hindmarch, supra note 18, at 386-87 (Reporting that “the *fiat* [of the Attorney General] . . . is always obtained as a matter of course,” but noting that from around 1790 Attorneys General began to demand a bond of £500 and a commitment by the petitioner to pay the attorney fees of the patentee if unsuccessful, in order “that patentees may not be vexatiously harassed by action of *scire facias*, in which they could not recover costs against the prosecutor”); see also Sean Bottomley, *British Patent System*, supra note 28, at 81 n.30 (describing an apparently successful attempt by counsel for Boulton and Watt to lobby the Attorney General to stall a threatened *scire facias*).

³⁷ Richard Godson, *A Practical Treatise on the Law of Patents for Inventions and of Copyright*, 197 (London, J. Butterworth & Son, 1823).

³⁸ These questions have arisen in connection with the 7th Amendment right to a jury trial on patent validity. See *In re Lockwood*, 50 F.3d 966, 975 (Fed. Cir. 1995), vacated sub nom. *Am. Airlines, Inc. v. Lockwood*, 515 U.S. 1182 (1995) (Concluding that “[a] proceeding to repeal a patent by the writ of *scire facias* was, with respect to the factual issues raised therein, a legal, rather than an equitable, affair, thereby entitling the parties to a jury as of right.”); *id.* at 984 (Nies, dissenting) (arguing that “[i]n England, prior to 1791, anyone could challenge a patent's validity by a *scire facias* writ in equity”).

³⁹ Law (or common law) and equity at this time were two separate jurisdictions, with distinctive procedures, remedies, and bodies of substantive law. See Erwin C. Surrency, *History of the Federal Courts* 232-46 (2d ed., 2002).

called the Petty Bag, which administered the Chancellor's separate common law jurisdiction.⁴⁰ *Scire facias* was thus the rare common law action brought in Chancery.⁴¹ To add to the jurisdictional tangle, cases that required findings of fact—and therefore a jury, which Chancery had no power to convene—were transferred to the Court of King's Bench for a jury verdict on the disputed facts at issue.⁴²

The final distinctive feature of a *scire facias* action was its result. *Scire facias* provided the only judicial means to terminate a patent.⁴³ It is important to understand for these purposes that, unlike today,⁴⁴ a finding of invalidity in patent infringement litigation did not destroy the claim. Courts spoke of a patent being “void” if the invention was anticipated or the specification inadequate.⁴⁵ But if a court found for a defendant on these grounds of invalidity, that decision bound only the parties to the case. Patentees could, and in at least one case did, bring further suits after losing an infringement action on validity grounds.⁴⁶ By contrast, a suit for *scire facias* repealed the grant outright. It was partly for that reason that the writ became a weapon of note in the 1780s.

For the purposes of this essay, it is not the long early-modern history of *scire facias* that matters, but its sudden and influential resurgence in England immediately before U.S. patent law was created. The formation of U.S. patent law followed hard on the heels of *scire facias*'s most famous outing: the case of *Rex v. Arkwright* in 1785.⁴⁷ The case brought the writ back from a period of dormancy, and did so in spectacular fashion.⁴⁸ Counsel for the Crown opened by informing the jury “that a case of greater importance, of greater value to the individuals disputing it, and to the public

⁴⁰ See Henry Maddock, 1 *A Treatise on the Principles and Practice of the High Court of Chancery* 3 (New York, Clayton & Kingsland 1817).

⁴¹ Older authorities debated whether the writ was also returnable in King's Bench, but the instances where that was allowed seem not to have been direct actions for the repeal of the patent. See Hindmarch, *supra* note 18, at 381-83.

⁴² Brief for H. Tomas Gomez-Arostegui and Sean Bottomley, *supra* note 17, at 30-31. In this respect *scire facias* actions were similar to patent infringement suits brought in Chancery, which would be referred to a court of law when validity was disputed. *Id.* at 16-24.

⁴³ See Hindmarch, *supra* note 18, at 64 (“The only means which the law provides for the repealing of letters patent, is by action of *scire facias* at the suit of the Queen”).

⁴⁴ See *Blonder-Tongue Labs. v. Univ. of Ill. Found.*, 402 U.S. 313 (1971) (establishing the rule that a final judgment of invalidity of a patent claim bars the patentee from relitigating the same claim against other defendants).

⁴⁵ Fessenden (1810), *supra* note 23, at 48-49.

⁴⁶ See Lemley, *supra* note 17, at 1686.

⁴⁷ *The Trial of a Cause Instituted by Richard Pepper Arden, Esq., his Majesty's Attorney General, by Writ of Scire Facias, to Repeal a Patent granted on the Sixteenth of December 1775* (London, Hughes and Walsh, 1785) (Hereafter “*Trial of a Cause*”).

⁴⁸ Instructing the jury, Justice Buller remarked that “[t]he proceeding by *scire facias* to repeal a patent, is somewhat new in our days; none such has occurred within my memory, though in former times they certainly were very frequent.” *Trial of a Cause*, *supra* note 47, at 172.

in general, was never yet tried in this or any other court,”⁴⁹ and that a decision upholding the patent would “endanger the loss of the most valuable manufactory that this country knows.”⁵⁰

Richard Arkwright’s machines for spinning and carding had transformed textile manufacture in Britain, and for more than a decade prior to *R. v. Arkwright*, his patents had hung menacingly over the Lancashire heartland of the industry.⁵¹ Arkwright’s prior litigation record was mixed: his key patent for a carding machine had stumbled in 1781, after a jury in the Court of King’s Bench found the specification defective.⁵² (Arkwright’s description of the invention was notoriously unclear, and the inventor himself confessed to obfuscating its workings).⁵³ Because a holding of invalidity did not by itself extinguish the patent, Arkwright was able to resume his enforcement efforts.⁵⁴ Manchester manufacturers, alarmed by the renewed threat, sought cancellation by *scire facias*.⁵⁵

The course of *R. v. Arkwright* taught both the power and the parameters of *scire facias*. Importantly, it embodied a shift in thinking about patent repeal, focusing on the validity of the patent itself and sidelining arguments about its social costs and benefits.⁵⁶ The writ for the prosecution led with the traditional assertion that the patent was “prejudicial and inconvenient to our subjects in general.”⁵⁷ Edward Bearcroft, lead counsel for the Crown, attempted to give mercantilist substance to the claim, declaring that “[t]he first objection, and the most serious, is that this grant is prejudicial and inconvenient to the public,” because trade and skilled labor would “go into

⁴⁹ Trial of a Cause, supra note 47, at 12.

⁵⁰ *Id.*

⁵¹ R.S. Fitton, *The Arkwrights: Spinners of Fortune* (1989).

⁵² *Arkwright v. Mordaunt* (1781), described in Trial of a Cause, supra note 47, at 23-24; John Hewish, *From Cromford to Chancery Lane: New Light on the Arkwright Patent Trials*, 28 *Tech. & Culture* 80, 84 (1987).

⁵³ Fitton, supra note 51, at 131-32.

⁵⁴ These efforts bore fruit: shortly after the *scire facias* action began, Arkwright’s carding patent was upheld in an infringement suit by the Court of Common Pleas. *Arkwright v. Nightingale* (1785), reported in John Davies, *A Collection of the Most Important Cases Respecting Patents of Invention and the Rights of Patentees*, 37-60 (London, W. Reed, 1816); Hewish, 84-85.

⁵⁵ Trial of a Cause, supra note 47, at 24; Fitton, supra note 51, at 117-18.

⁵⁶ Economic arguments against individual patents tended to have little purchase in the courts by this time, even in equity. See Bottomley, *British Patent System*, supra note 28, at 125 (suggesting that by the mid eighteenth century “it was uncommon for defendants in equity to claim that a patent was not in the public good, and as such void. . . . Instead, it was much more common for them to impugn the alleged novelty of the invention”). See also *Arkwright v. Nightingale*, in Davies, supra note 54, at 55 (“It is said, it is highly expedient for the public that this patent, having been so long in public use after Mr. Arkwright had failed in that trial, should continue to be open: but nothing could be more essentially mischievous than that a question of property between A. and B. should ever be permitted to be decided upon considerations of public convenience or expediency”).

⁵⁷ Trial of a Cause, supra note 47, at 7; Hindmarch, supra note 18, at 389 (“The first suggestion in a *scire facias* is usually—‘That our said grant was and is contrary to law, and was and is prejudicial and inconvenient to our subjects in general.’”).

foreign countries, if the monopoly is permitted.”⁵⁸ But Justice Buller interrupted to foreclose this line of argument. He did so for essentially procedural reasons: the facts needed to support a legal determination of prejudice had not been placed before the jury; the claim had been stated too generally, giving no chance for the defendant to contest its factual basis; it was a “consequential issue . . . which must stand or fall by the other particular issues.”⁵⁹

Justice Buller’s objections depended on the specifics of the Crown’s inadequate pleadings,⁶⁰ but the effect of his intervention was unmistakable. Buller’s instructions to counsel left the case resting on questions of the patent’s legal validity: whether Arkwright was the true inventor, whether the invention was new, and whether the specification was sufficient.⁶¹ This inquiry was a far cry from the welfarist reasoning of the old Privy Council revocation actions. Instead, Buller’s framing of the case recognized the new reality of a rapidly formalizing patent law, with a clearer set of requirements for disclosure and validity.⁶² This posture reframed the “wrong” addressed by *scire facias*—not as oppressive monopoly, or even necessarily as fraud on the monarch, but as violation of the basic bargain between patentee and the public: an exclusive right in return for disclosure of a novel invention. The result was to add *scire facias* to the collection of tools for policing the requirements of patentability.

The jury’s verdict for the Crown, and subsequent revocation of Arkwright’s patent, squarely demonstrated the new promise—or threat—of revocation attacks. Worried patent holders began efforts to form a “Patentees’ Association” to resist the “opulent manufacturers” who had “subscribed large sums to attack [patents] . . . by writ of *Scire facias*.”⁶³ Arkwright’s fate sowed fear among leading patentee-industrialists, including the pottery magnate Josiah Wedgwood and the steam pioneers Matthew Boulton and James Watt.⁶⁴ Even in the absence of a suit, the political threat of the writ loomed large. A decade after Arkwright’s trial, Boulton and Watt’s lawyer was referring to *scire facias* as a source of “dread” and “the bug-bear that has tormented us for so long.”⁶⁵

Fellow inventors were not the only observers for whom Arkwright and his patent loomed large. An ocean away, leaders of the newly-formed United States were engaged in efforts to build an industrial base and a patent system of their own. Prominent figures such as Alexander Hamilton and his

⁵⁸ Trial of a Cause, *supra* note 47, at 21, 30.

⁵⁹ *Id.* at 31-32.

⁶⁰ Later treatments suggested that the case left the door open for properly-pleaded economic arguments in a *scire facias*. But the same sources cite no later examples of this being attempted. See Godson, *supra* note 37, at 195.

⁶¹ *Id.* at 172.

⁶² See Bracha, *supra* note 18, at 24.

⁶³ H. I. Dutton, *The Patent System and Inventive Activity During the Industrial Revolution, 1750-1852*, 36-38 (1984) (quoting a circular of 1785).

⁶⁴ Fitton, *supra* note 51, at 140-41.

⁶⁵ Bottomley, *British Patent System*, *supra* note 28, at 81 n.30.

economic advisor Tench Coxe were deeply involved in attempts to draw British artisans and machinery to America, with particular attention to Arkwright's technology.⁶⁶ Patents, grants, and exclusive rights were central to schemes of industrial promotion. Against this background, Arkwright's well-known travails must have reminded the watching Americans that patents could be revoked as well as granted.

II. "SURREPTITIOUSLY OR UPON FALSE SUGGESTION": REPEALING PATENTS UNDER THE ACTS OF 1790 AND 1793

For the first forty-six years of the U.S. patent system, there was a specific statutory mechanism for cancelling patents. Successive governing statutes provided that any party could petition a federal district court to repeal a patent, within a set period after it issued, following a showing that the grant in question was obtained "surreptitiously, or upon false suggestion."⁶⁷ Any presumption of validity that attached to the patent during infringement litigation was absent in a repeal suit.⁶⁸

Evaluating what this institution meant for the nature of patent rights and the means of cancelling them involves two related inquiries. First, what was repeal for? The conventional wisdom today is that this was a measure directed against fraud in the patent application process, or what we would now call "inequitable conduct" in patent prosecution.⁶⁹ There is some truth to that idea. But both in theory and in practice, the scope of patent repeal proceedings was significantly broader. Revocation posited a particular

⁶⁶ See Doron Ben-Atar, *Trade Secrets: Intellectual Piracy and the Origins of American Industrial Power*, 122-24, 147 (2004); Anthony F. C. Wallace and David J. Jeremy, *William Pollard and the Arkwright Patents*, 34 *Wm. & Mary Q.* 404 (1977). For some time before the 1790 Patent Act, Coxe apparently hoped that Congress would authorize patents of importation so that he might secure an exclusive right to introduce Arkwright machines. Edward Walterscheid, *To Promote the Progress of Useful Arts: American Patent Law and Administration 1798-1836*, 101 (1994). One of the first U.S. patents applied for and granted was for a warmed-over version of Arkwright's invention, with the recipient being listed on the patent as "ass.[ignee] of Richard Arkwright." Wallace and Jeremy, *infra* at 404.

⁶⁷ Patent Act of 1790, ch. 7, § 5, 1 Stat. 109, 111 (repealed 1793); Patent Act of 1793, ch. 11, § 10, 1 Stat. 318, 323 (repealed 1836). The 1790 Act used the insubstantially different language "surreptitiously *by*, or upon" (emphasis added).

⁶⁸ Section 6 of the 1790 Patent Act provided "That in all actions *to be brought by such patentee or patentees* . . . for any penalty incurred by virtue of this act, the said patents or specifications shall be prima facie evidence, that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers of the thing so specified, and that the same is truly specified." Patent Act of 1790, ch. 7, § 6, 1 Stat. 109, 111 (repealed 1793) (emphasis added). Repeal suits, of course, were not "brought by [the] patentee," and the presumption of validity is mentioned nowhere else in the Act. The presumption was abandoned in the 1793 Act. See Walterscheid, *supra* note 66, at 229.

⁶⁹ See, e.g., Lemley, *supra* note 17, at 1693; David McGowan, *Inequitable Conduct*, 43 *Loy. L.A. L. Rev.* 945, 948-949 (2010); *In re Lockwood*, 50 F.3d 966, 989 (Fed. Cir.), vacated sub nom. *Am. Airlines, Inc. v. Lockwood*, 515 U.S. 1182 (1995) ("The contemporary analog of the writ [of scire facias directed against a patent obtained "surreptitiously or by false suggestion"] is thus an action for a declaration of unenforceability due to inequitable conduct....").

relationship between the public and the patent: the public had not only a power to call out wrongful misrepresentations by patent applicants, but a right to police the validity of the patents granted by the system.

Second, what procedures and protections accompanied the process of repealing a patent right? The action provided by Congress was a judicial one, but surprisingly little was clear about what it involved or whether it resembled any existing action in law or equity. Not least among the uncertainties of the statute was whether it adopted English practice in the form of a *scire facias*. In grappling with that question, the courts would divide over whether American patent law descended from English law or had made a fresh start.

A. *The Acts of 1790 and 1793*

The first U.S. patent laws included a formal mechanism for patent revocation. Even as the early Republic went through two quite different regimes of patent administration, the repeal provision was a constant feature. We will turn in a moment to the ways in which these tools were used. But first to the statutes themselves, which on their face raised more questions than answers.

The first Patent Act was short-lived, lasting from 1790 to 1793. It gave the United States a single patent system, with standardized rules of patentability and enforcement, in lieu of the scattered and ad hoc legislative patents previously issued by individual states.⁷⁰ The central feature of the 1790 Act was a patent board, consisting of the Attorney General, the Secretary of State, and the Secretary of the War Department. These senior officials were collectively empowered to grant patents to novel inventions “if they shall deem the invention or discovery sufficiently useful and important.”⁷¹ The board, and especially Thomas Jefferson as Secretary of State, pursued this work earnestly, issuing fifty-seven patents during the lifetime of the Act on more than twice that number of applications.⁷² But it soon became clear that the burden imposed on cabinet members was excessive. Proposals to replace the Act began when it was less than a year old.⁷³

When the replacement Act arrived, in 1793, it made a major change in the administration of patent law.⁷⁴ The new statute abolished the patent board and instead created a registration system: patents were issued without prior examination.⁷⁵ An office at the State Department collected the required specifications and models, but questions of validity were left for

⁷⁰ On state patents, see Camilla Hrdy, *State Patent Laws in the Age of Laissez Faire*, 28 Berkeley Tech. L.J., at 58-66 (2013).

⁷¹ Patent Act of 1790, ch. 7, § 1, 1 Stat. 109, 110 (repealed 1793).

⁷² P.J. Federico, Operation of the Patent Act of 1790, 18 J. Pat. Off. Soc’y 237, 244 (1936).

⁷³ Walterscheid, supra note 66, at 195.

⁷⁴ Patent Act of 1793, ch. 11, 1 Stat. 318 (repealed 1836).

⁷⁵ Patent Act of 1793, ch. 11, § 1, 1 Stat. 318, 320 (repealed 1836). The Act also adjusted the earlier statute’s rules for patentability, liability, and litigation defenses in several respects. See Walterscheid, supra note 66, at 223-231.

the courts. This system would face mounting criticism over its lifetime, particularly in its later years, as ever larger numbers of un-vetted patents accumulated and clashed. The Patent Act of 1793 nevertheless had a longer career, enduring until the creation of the modern Patent Office in 1836.

The patent repeal provision remained almost identical across the two Acts. Its 1790 version⁷⁶ (Section 5 of the Act): allowed any person, within one year of a patent being issued, to make an “oath or affirmation” to the judge of the district court where the patentee resided, alleging that the patent “was obtained surreptitiously by, or upon false suggestion.” If the matter appeared “sufficient” to the judge, he was to “grant a rule that the patentee . . . show cause why process should not issue against him . . . to repeal such patents.” Failure had the following, somewhat confusingly described consequences:

and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued as aforesaid, against such patentee . . . And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the first and true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent or patents.

The 1793 version (now renumbered as Section 10) hardly differed. The one-year period for challenging a patent was lengthened to three years, and the

⁷⁶ Patent Act of 1790, ch. 7, § 5, 1 Stat. 109, 111. In full, the relevant section of the 1790 Act read as follows:

Sec. 5. And be it further enacted, That upon oath or affirmation made before the judge of the district court, where the defendant resides, that any patent which shall be issued in pursuance of this act, was obtained surreptitiously by, or upon false suggestion, and motion made to the said court, within one year after issuing the said patent, but not afterwards, it shall and may be lawful to and for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee or patentees, his, her, or their executors, administrators or assigns, show cause why process should not issue against him, her, or them, to repeal such patents; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued as aforesaid, against such patentee or patentees, his, her, or their executors, administrators, or assigns. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the first and true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent or patents; and if the party at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in such manner as costs expended by defendants, shall be recovered in due course of law.

necessary allegation was slightly rephrased, to read “surreptitiously, or upon false suggestion.”⁷⁷

What did any of this mean? Candidly, it was not clear to many, either at the time or afterward.⁷⁸ The legislative histories of the two Acts are quiet on the motivation for the repeal provisions,⁷⁹ with two instructive exceptions. First, in early patent bills of 1789-90, the revocation section was prefaced by a statement that “patents . . . may be obtained surreptitiously or upon false suggestions, which may not only be prejudicial to individuals, but to the community.”⁸⁰ While constructed throughout as a private action, repeal promised to vindicate the interests of the public at large, not just of the party bringing suit. Second, the Senate committee report accompanying the 1790 bill observed that, under English practice, “any Person may sue out a Scire Facias to repeal the Patent for false Suggestions.”⁸¹ This note strongly suggests that the American repeal provision was consciously

⁷⁷ Patent Act of 1793, ch. 11, § 10, 1 Stat. 318, 323. Section 10 of the 1793 Act read as follows:

Sec. 10. *And be it further enacted*, That upon oath or affirmation being made, before the judge of the district court, where the patentee, his executors, administrators or assigns reside, that any patent, which shall be issued in pursuance of this act, was obtained surreptitiously, or upon false suggestion, and motion made to the said court, within three years after issuing the said patent, but not afterwards, it shall and may be lawful for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule, that the patentee, or his executor, administrator or assign show cause, why process should not issue against him to repeal such patent. And if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued against such patentee, or his executors, administrators or assigns, with costs of suit. And in case no sufficient cause shall be shown to the contrary, or if it shall appear, that the patentee was not the true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent; and if the party, at whose complaint, the process issued, shall have judgment given against him, he shall pay all such costs, as the defendant shall be put to, in defending the suit, to be taxed by the court, and recovered in due course of law.

⁷⁸ See *infra*, Part II.C.

⁷⁹ See *Proceedings in Congress During the Years 1789 and 1790, Relating to the First Patent and Copyright Laws*, Part 1, 22 J. Pat. Off. Soc'y 243 (1940), and Part 2, 22 J. Pat. Off. Soc'y 352 (1940); Walterscheid, *supra* note 66, at 109-222.

⁸⁰ H.R. 10, Copyrights and Patents Bill, June 23, 1789, reprinted at 4 *Documentary History of the First Federal Congress of the United States of America, Legislative Histories*, 513, 518 (Charlene Bangs Bickford and Helen E. Veit, eds., 1986); see also H.R. 41, Patents Bill, February 16, 1790, § 4, at 6 *Documentary History of the First Federal Congress of the United States of America, Legislative Histories*, 1626, 1630 (Charlene Bangs Bickford and Helen E. Veit, eds., 1986). This language was dropped when the repeal provision was removed from the section on infringement liability and given a section of its own. See H.R. 41, Patents Bill, March 10, 1790, § 5, at 6 *Documentary History of the First Federal Congress of the United States of America, Legislative Histories*, 1632, 1636 (Charlene Bangs Bickford and Helen E. Veit, eds., 1986).

⁸¹ Report of the Committee, March 29, 1790, reprinted in *Proceedings*, *supra* note 79, at 363.

connected to the *scire facias* action. At the very least it establishes a direct link between *scire facias* and the language used in the American repeal provisions.⁸²

This does not mean that the 1790 Act codified *scire facias*. The repeal section was conspicuously different from *scire facias* in key respects. No authorization from the government was required to bring the suit. Litigation was in the name of a private plaintiff, not the government. Nor was the patent-issuing authority involved in the process: while a *scire facias* issued from Chancery as the issuer and keeper of the grant, an action for repeal in the United States occurred solely before the district court, with no connection to either the patent board or the State Department. Perhaps the most practically important difference was the one-year and later three-year window for challenging a patent, which also had no equivalent in *scire facias*.

The limited period of post-grant challenge is, in fact, one of the puzzles of statutory revocation—and at the same time one of the most useful clues as to its function. If a wrongful patent was prejudicial to the public, then it is not clear why the public’s remedy should be temporary. One possible purpose was to give the patentee eventual security against harassing repeal suits, a concern that is also visible in the act’s award of costs against unsuccessful plaintiffs.⁸³ In the context of the 1790 Act’s institutional design, though, it may be best to view time-limited repeal as an integrated part of the administrative patent granting process. *Pre*-grant opposition was an established notion, used in England⁸⁴ and initially included in American patent bills, although it was ultimately removed from the 1790 legislation and replaced with examination by the patent board.⁸⁵ Similarly deleted by Senate amendment were measures requiring that patent applications be publicly advertised. That left post-grant repeal as the only means by which opposition to a grant might be registered, or by which public information about the validity of the claim could be generated.

Given the overwhelming informational obstacles to the patent board’s knowing the state of the art in any given technology, post-grant opposition within one year essentially offered a form of error correction for the examination process. It may seem strange to describe this judicial proceeding as part of the patent administration. But the government of the early Republic generally, and Congress’s designs for the patent system

⁸² One cannot assume that the drafters of American patent legislation had access to English case law. But various features of the patent bills proposed in the first Congress suggest some knowledge of the issues that English courts were addressing. See Walterscheid, *supra* note 66, at 92-94, 104.

⁸³ See Patent Act of 1790, ch. 7, § 5, 1 Stat. 109, 111 (“if the party at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit”).

⁸⁴ In English practice, under a so-called “caveat” system, parties paid to be informed of new patent applications and could intervene to oppose the grant. See Bottomley, *British Patent System*, *supra* note 28, at 53-54.

⁸⁵ See Walterscheid, *supra* note 66, at 135-36.

particularly, often lacked a hard line between executive and judicial functions. Congress assigned the federal courts a variety of “non-contentious” matters, including, in the early 1790s, responsibility for administering naturalization petitions and Revolutionary War pension claims.⁸⁶ In legislating patent matters, Congress similarly considered a variety of roles for the courts. The first patent bill of 1789-90 envisaged pre-grant opposition being handled by two Supreme Court justices; other proposals called for conflicting applications to go to juries; later Congress settled on a hearing before the Secretary of State and a board of appointed arbitrators.⁸⁷ Before the 1793 Act, some in Congress advocated having the federal district courts themselves issue patents.⁸⁸ Against this background, assigning the revocation function to the district courts might mean that the process was seen as inherently judicial, but it might also reflect a desire to have part of the patent-vetting function in the hands of geographically-distributed federal officials.

This wider view of the courts’ role also sheds light on a central feature of the statute: universal standing to bring a revocation suit. Whether the founding-era courts had any concept of “standing” akin to the modern Article III term is a much-debated question.⁸⁹ Injuries to the public at large, such as public nuisances, were judicially cognizable;⁹⁰ such harms may have been a suitable analogy for the “prejudic[e] . . . to the community” recognized in the legislative history of the 1790 Act.⁹¹ But English and American courts generally preferred that public interests of this type be vindicated by public authorities, rather than by private suit, absent some discernible private injury.⁹² English *scire facias*, as an action in the name of the Crown, was consistent with that approach. Revocation under the 1790 Act was not. On the other hand, statutory revocation fits with another “public rights model” of adjudication used in the Early Republic: statutes providing for actions by a common informer, who had knowledge of a wrong but no interest in the controversy other than that given by statute.⁹³ Blackstone termed such suits, including *qui tam* proceedings, “popular actions, because they are given to the people in general.”⁹⁴ Early Congresses applied informer suits to customs enforcement, prohibitions on slave trading, and other areas where private information could be mobilized

⁸⁶ See James E. Pfander and Daniel D. Birk, *Article III Judicial Power, the Adverse-Party Requirement, and Non-Contentious Jurisdiction*, 124 Yale L. J. 1346, 1361-65 (2015).

⁸⁷ See Walterscheid, *supra* note 66, at 100-103, 129, 133-35.

⁸⁸ See Walterscheid, *supra* note 66, at 219.

⁸⁹ See, e.g., Ann Woolhandler and Caleb Nelson, *Does History Defeat Standing Doctrine*, 102 Mich. L. Rev. 689 (2004); Cass R. Sunstein, *What's Standing After Lujan? Of Citizen Suits, "Injuries," and Article III*, 91 Mich. L. Rev. 163, 166 (1992); Steven L. Winter, *The Metaphor of Standing and the Problem of Self-Governance*, 40 Stan. L. Rev. 1371 (1988).

⁹⁰ See Woolhandler and Nelson, *supra* note 89, at 701-702.

⁹¹ See *supra* note 80 and accompanying text.

⁹² See Woolhandler and Nelson, *supra* note 89, at 701-702.

⁹³ See Winter, *supra* note 89, at 1406-1407.

⁹⁴ 3 Blackstone, *Commentaries*, 161 (10th ed., 1787).

to aid the functioning of government.⁹⁵ To the extent that revocation suits were a tool for injecting private information into the patent system, universal standing can be understood as a constitutionally unproblematic part of the regulatory scheme.⁹⁶

As a matter of institutional design, then, statutory repeal may have been an analog rather than a homolog of *scire facias*. The two shared a function and a form—both were actions for patent revocation available to any member of the public—but the American version enacted in 1790 and 1793 did not necessarily descend from the English.

In fact, many aspects of the statute were left ambiguous. Two questions in particular would define practice under the pre-1836 acts. The first was what kind of proceeding the repeal section created. The second was what grounds would support an action for repeal.

Both the Acts of 1790 and 1793 were silent on whether patentees facing revocation would receive a jury trial. The only stage of proceedings explicitly outlined in the statute was the show-cause hearing before the district judge, ending in a decree to make the rule “absolute”; what followed was described only as “process . . . to repeal such patent.” We have only hints of what was envisaged by that term. One comes from Thomas Jefferson, who, during the drafting of what became the 1793 Act, pondered the way that repeal would work as litigation.⁹⁷ While corresponding with the chair of the House committee steering the bill, Jefferson critiqued the inclusion of a repeal clause as “more difficult than I had on first view imagined.”⁹⁸ His concern was with strategic behavior both by and against patentees:

Will you make the first trial against the patentee conclusive against all others who might be interested to contest his patent? If you do, he will always have a collusive suit brought against himself at once. Or will you give every one a right to bring actions separately? If you do, besides running him down with the expences and vexations of law suits, you will be sure to find some jury in the long run, who from motives of partiality or ignorance, will find a verdict against him, tho’ a hundred should have been before found in his favour.⁹⁹

Jefferson concluded against allowing the patentee to be sued for repeal: “I really believe that less evil will follow from leaving him to bring suits

⁹⁵ See Winter, *supra* note 89, at 1406-1407 (citing statutes of 1789 and 1794).

⁹⁶ See *id.* at 1407-1408 (suggesting that approval of informer statutes in the First Congress indicates “that the Framers did not view the ‘case or controversy’ requirement of article III as limiting such ‘popular actions’ as informers’ suits”).

⁹⁷ As a member of the patent board, Jefferson took a close interest in the Act, although he was not himself one of its authors. Walterscheid, *supra* note 66, at 196-205.

⁹⁸ Thomas Jefferson to Hugh Williamson, 13 November 1791, 22 *The Papers of Thomas Jefferson*, ed. Charles T. Cullen 295 (1986).

⁹⁹ *Id.* Jefferson’s concern about “the long run” seems incongruous given the three-year window for seeking revocation in the statute. It is possible that Jefferson was responding to a version of the bill without a time limit.

against those who invade his right.”¹⁰⁰ The Congressman, however, was apparently unmoved; repeal stayed in the bill. Given that Jefferson’s views on the matter were ignored, his letter to Williamson hardly qualifies as legislative history. But he clearly assumed that the validity challenge would involve a jury trial.

Even years later, the law’s lack of clarity about how to try a repeal proceeding was conspicuous. Writing in 1816, Justice Joseph Story admitted that it was “not easy to give a construction” to the procedure laid out in the statute.¹⁰¹ The first step, if a judge thought the matter “sufficient,” was an order to the patentee to show cause why process should not issue to repeal the patent. If no sufficient cause were shown, the rule would be “made absolute,” and “the said judge shall order process to be issued as aforesaid, against such patentee.” But what was this “process”? Was it a trial on the question of repeal, or was it effectively an order to repeal the patent? In other words, was statutory repeal resolved by a summary hearing on the hearing on the order to show cause, or was that merely a preliminary step before a full trial? For a time, this was a major source of division in the application of the Act.¹⁰²

The question of what constituted proper grounds for repeal was equally perplexing. Clearly, challengers had to make a threshold showing that the patent had been obtained “surreptitiously, or on false suggestion.” These terms required some act of misrepresentation by the patentee. But they said nothing about the degree of deceptive intent or the burden of proof needed to show it. Did one have to show that the patentee knowingly lied in presenting his patent application, perhaps by stealing the invention of another or by deliberately deceiving the government as to the novelty of his claim? Or was it enough simply to show that the patentee was not in fact the first inventor, so that his application claiming otherwise constituted a “false suggestion”? How could one even tell whether an inventor had a mistaken belief in his own priority of inventorship or a knowing desire to patent what he should not?¹⁰³

The meaning of the repeal provision hinged on one’s answer to these questions. If patents could be revoked only for provable fraud in the application, then this proceeding was a minor tool for policing applicant conduct. If, on the other hand, a complainant could argue that *the invention was not new, and the patentee must be deemed to have known*, then an action for repeal was effectively a kind of suit for declaratory judgment of invalidity, albeit with a one- or three-year window for bringing the case.

¹⁰⁰ *Id.*

¹⁰¹ *Stearns v. Barrett*, 22 F. Cas. 1175, 1178 (C.C.D. Mass. 1816). Story offered his conclusion “[a]fter considerable hesitation.” *Id.* at 1179.

¹⁰² *See infra*, Part II.D.

¹⁰³ Our own experience with the doctrine of inequitable conduct two centuries later suggests that these lines are hard to draw. *See, e.g.* *Therasense, Inc. v. Becton, Dickinson & Co.*, 649 F.3d 1276 (Fed. Cir. 2011) (enforcing an extremely strict standard for showing inequitable conduct, in order to end a “plague” of assertions that applicants had deceived the Patent Office).

There were reasons to think that the latter view was correct. Most importantly, the statute itself seemed to contemplate a broader inquiry. After the order to show cause, repeal was supposed to follow “in case no sufficient cause shall be shown to the contrary, *or if it shall appear, that the patentee was not the true inventor or discoverer.*”¹⁰⁴ Taken at face value, this language suggested that, once the initial *ex parte* showing of surreptitiousness or false suggestion was out of the way, the question before the court would expand to cover inventive priority generally. The other reason to suspect a broader meaning of “false suggestion” is its connection to *scire facias*. Revocation under the writ in England had come to focus on issues of patent validity generally. American measures might be understood to do the same.

Even so, one could (and parties did) argue the point either way based on the text of the statute. To gauge what the law meant to the patent system, we must look to the evidence of practice under the acts.

B. America’s First Patent Case

It is not widely known that the first U.S. patent case sought to repeal a patent. But then, little is known about early U.S. patent litigation generally. The first reported patent case was *Reutgen v. Kanowrs*,¹⁰⁵ decided in Philadelphia in 1804. Only five more reported cases took place before 1810.¹⁰⁶ Reporting in those days was rare, though, and the lack of earlier published cases did not mean that no litigation took place. For example, Eli Whitney brought several suits in Georgia for infringement of his cotton gin patent, starting in 1797.¹⁰⁷ There is indirect evidence that litigation took place even before the 1793 Act. In 1794, Congress passed a supplemental Patent Act that restored any cases that had been “set aside, suspended or abated” by the repeal of the 1790 statute.¹⁰⁸ Historians have long noted that this would have been unnecessary if there had been no suits pending in 1793.¹⁰⁹

It turns out that the history of patent repeal can help to light this dark corner. The best candidate to be America’s first patent case—and, incidentally, the reason for the 1794 Act restoring older patent litigation—is a revocation suit under the 1790 statute.¹¹⁰ *Jenkins v. Folger* was

¹⁰⁴ Patent Act of 1790, ch. 7, § 5, 1 Stat. 109, 111; Patent Act of 1793, ch. 11, § 10, 1 Stat. 318, 323 (emphasis added).

¹⁰⁵ 20 F. Cas. 555 (C.C.D.Pa. 1804).

¹⁰⁶ Walterscheid, *supra* note 66, at 362.

¹⁰⁷ Denison Olmsted, *Memoir of Eli Whitney, Esq.*, 26-27 (New Haven, CT, Durrie & Peck, 1846) (quoting letter of Whitney’s associate describing the 1797 suit as their “first”). Whitney is said to have filed 27 infringement suits in total. D. A. Tompkins, *The Cotton Gin: the History of its Invention* (Charlotte, NC, self-published, 1901).

¹⁰⁸ Act of June 7, 1794, ch. 58, 1 Stat. 393 (1794).

¹⁰⁹ *See, e.g.* Walterscheid, *supra* note 66, at 333-34.

¹¹⁰ Since false suggestions of priority are a theme here, I should be clear that I am not the first to discover the case. Edward P. Alexander summarized the proceedings in a biography of New York’s first federal district judge. Edward Porter Alexander, *A Revolutionary*

commenced in the U.S. District Court of New York on May 26, 1792. It is impossible to say for sure that *Jenkins* had no forerunners—the records of the U.S. courts in the early 1790s do not all survive—but the possibilities would have been few: the patent in question was only the fortieth to issue under the 1790 Act; only forty-eight had been granted by the time the suit began, and all but eleven of those were less than a year old.¹¹¹

The circumstances of the case suggest a lucrative invention caught in an intra-industry dispute. Benjamin Folger, the patentee, was a merchant and a co-founder of Hudson, New York, a town originally settled in 1783 by whalers from Providence and Nantucket who sought a river port to escape British naval harassment during the Revolutionary War.¹¹² Folger and his fellow transplants brought Nantucket's whale-oil-fueled wealth with them and quickly established a thriving maritime center.¹¹³ In November of 1791, an emissary from Hudson visited Thomas Jefferson bearing a letter of introduction from Seth Jenkins, the city's first mayor. Jenkins explained that "His business is to obtain a Patent for Mr. Benjamin Folger, for securing an important discovery he hath made in manufacturing Whale Oil . . . I am fully convinced that the discovery is entirely new, and a very important one, and that it will prove highly beneficial to the United States."¹¹⁴ The subject matter was a method of separating out the sediment from common right whale oil, a process that both made the oil more valuable and produced material for candles.¹¹⁵ Folger estimated that the method added 500 pounds, or approximately 20%, to the profits of a whaling voyage.¹¹⁶ On January 2, 1792, a few weeks after his petition reached Jefferson, Folger received his patent.

Conservative: James Duane of New York, 207 (1938). Zorina Khan has already offered *Jenkins v. Folger* as the first recorded patent case, based on its having been mentioned in a later treatise. *Property Rights and Patent Litigation in Early Nineteenth-Century America*, 55 *J. Econ. Hist.* 58, 63 (1995). Khan reported that Folger's patent was successfully repealed, although I do not believe that to be the case. I have not previously seen *Jenkins v. Folger* credited for the existence of the 1794 Act.

¹¹¹ A List of Patents Granted by the United States from April 10, 1790, to December 31, 1836 (Washington, United States Patent Office, 1872).

¹¹² Stephen B. Miller, *Historical Sketches of Hudson: Embracing the Settlement of the City, City Government, Business Enterprises, Churches, Press, Schools, Libraries, Etc.*, 6 (Hudson, NY, Bryan & Webb Printers, 1862).

¹¹³ Miller, *Historical Sketches of Hudson*, at 14 (noting that "nearly all of [the Proprietors] were possessed of considerable pecuniary means," with one family reportedly bringing a quarter of a million dollars to the new settlement).

¹¹⁴ Seth Jenkins to Thomas Jefferson, November 7, 1791, 22 *The Papers of Thomas Jefferson*, ed. Charles T. Cullen 264 (1986).

¹¹⁵ Letter of Benjamin Folger to the Secretary, November 29, 1791, in 1 *Transactions of the Society for the Promotion of Useful Arts, in the State of New-York*, 363-64 (Albany, NY, Charles R. and George Webster, 1801).

¹¹⁶ *Id.* at 364.

The plaintiff in *Jenkins v. Folger*, commenced in May of that year, was Jonathan Jenkins of Nantucket.¹¹⁷ As recorded in the minutes of the U.S. District Court for New York, Jenkins’s counsel began the case by reading Jenkins’s affirmation that “the said Patent was obtained upon a false suggestion,” and moved that Folger be ordered to show cause why his patent should not be repealed.¹¹⁸ The minutes record no further detail of the basis for Jenkins’s claim, but based on his Nantucket location it is reasonable to assume that he was a competitor of Folger’s or otherwise involved in the whaling trade. Whether Jenkins had his own claim to the invention or knowledge of earlier use is unknown. On August 7th, Folger’s attorneys appeared for the hearing to show cause, and after arguments of counsel on both sides the court “took time to advise thereupon.”¹¹⁹ The following day, District Judge James Duane ordered that the rule “be made absolute and . . . that process issue to repeal the patent.”¹²⁰ There the record of the case ends, with no further indication of a trial or other proceedings in the archives of the court.

What happened next indicates (a) that Judge Duane’s decision making the rule “absolute” had *not* revoked the patent, and (b) that further proceedings were apparently forestalled by the February 1793 repeal and replacement of the Patent Act. In March of 1794, Jenkins petitioned Congress for the repeal of Folger’s grant, “which letters patent have been obtained by the said Benjamin Folger surreptitiously, and from false suggestions.”¹²¹ Folger counter-petitioned the following month.¹²² The House referred both petitions to a committee headed by a Nantucket Representative, Peleg Coffin,¹²³ which reported in short order.¹²⁴ The House then resolved “That the District Court of the United States for the State of New York, be authorized and empowered to proceed in the trial of the suit instituted in the said Court by Jonathan Jenkins against Benjamin Folger, for the repeal of certain letters patent granted to the said Benjamin Folger, . . . on the principles established by the act [of 1790].”¹²⁵ Coffin’s committee was directed to prepare legislation to that end.¹²⁶ Five days later, the committee presented what would become the Act of 1794 to restore all

¹¹⁷ Whether and how Jonathan Jenkins was related to Seth Jenkins of Hudson—or for that matter, to Benjamin Folger—is unclear. Both Hudson and Nantucket were awash with Jenkinases and Folgers in this period.

¹¹⁸ *Jonathan Jenkins v. Benjamin Folger*, May 26, 1792, Vol. 1, p. 116, Minutes and Rolls of Attorneys of the U.S. District Court for the Southern District of New York, 1789-1841, National Archives, New York City (hereafter “Minutes and Rolls”).

¹¹⁹ *Jonathan Jenkins v. Benjamin Folger*, August 7, 1792, Minutes and Rolls vol. 1 at 117.

¹²⁰ *Jonathan Jenkins v. Benjamin Folger*, August 8, 1792, Minutes and Rolls vol. 1 at 118.

¹²¹ House of Representatives Journal, March 21, 1794, at 98.

¹²² House of Representatives Journal, April 21, 1794, at 125.

¹²³ House of Representatives Journal, March 21, 1794, at 98; *id.*, April 25, 1794, at 132. The other two members of the committee were another Massachusetts man and a Marylander.

¹²⁴ House of Representatives Journal, April 25, 1794, at 132.

¹²⁵ House of Representatives Journal, May 1, 1794, at 135.

¹²⁶ House of Representatives Journal, May 1, 1794, at 135.

cases interrupted in 1793—leaving little doubt that this legislation was the product of Jenkins’s and Folger’s suit.¹²⁷ For all that effort, there is no sign that Jenkins and Folger renewed their dispute.

Jenkins v. Folger is a truncated case of which few records survive. Nevertheless, these scattered clues reveal useful details about the law. *Jenkins* shows that patent revocation was an active part of U.S. patent law at the beginning, possibly even before any infringement suits had been brought. The litigation hints that, as with *scire facias* in England, revocation could enable members of a trade to resist a prominent patent. And the case tells us about procedure under the 1790 repeal provision: most notably that a judicial decision on the rule to show cause—the stage reached by *Jenkins*—was not believed by the parties to conclude the suit. Some further process was apparently needed for successful repeal of the patent. What the case does not reveal is any in-depth discussion about the content of the law, or any sense of what “false suggestion” meant to its participants. For that we must turn to later practice, under the 1793 Act.

C. *The Uses of Patent Revocation*

After twenty years of U.S. patent law, repeal was still a mysterious process. To be fair, almost everything about American patent jurisprudence was opaque in those days. Only a handful of reported decisions existed, all from after 1804, and those were in limited circulation.¹²⁸ There was no American treatise until Thomas Fessenden’s *Essay on the Law of Patents* in 1810, which primarily described English law.¹²⁹ Justice Story used to say that when heard his first patent case as a judge, the law was so “vague and unsettled” that he would have sweated through his wig, had he worn one.¹³⁰

The law of repeal—now under Section 10 of the 1793 Patent Act—was especially opaque. Few such actions were known to have taken place. Apart from *Jenkins v. Folger*, no repeal cases have yet come to light in the archives before 1806. Fessenden, the treatise-writer, knew of only one repeal suit: *Perkins v. Odiorne*, begun in Boston at the end of 1809. He reported that, despite eminent counsel on both sides, “there existed considerable doubt and hesitancy relative to the most eligible mode of proceeding, as there are

¹²⁷ House of Representatives Journal, May 6, 1794, at 138. The remaining legislative progress of the 1794 Act appears in the following congressional journal entries: House Journal, Tuesday, June 3, 1794, at 197-99; Senate Journal, Wednesday June 4, 1794, at 102; House Journal, Friday, June 6, 1794, at 208-209; Senate Journal, Friday, June 6, 1794, at 109; House Journal, June 7, 1794, at 211-212.

¹²⁸ Walterscheid, *supra* note 66, at 362-65 (observing that “[f]or a number of years, both the federal courts and the counsel that appeared before them would have had easier access to the reported patent law opinions in Great Britain than they would have to those in the United States”).

¹²⁹ Fessenden (1810), *supra* note 23.

¹³⁰ William Wetmore Story ed., 1 *Life and Letters of Joseph Story*, 237 (Boston, Little & Brown, 1851). The date of Story’s first patent case is unknown, but he became a judge in 1811.

no American precedents, applicable to this case.”¹³¹ A decade later, one judge declared that “The true meaning of the tenth section of the patent law is indeed a great mystery. The profound obscurity in which, like the oracles of old, it is delivered to us, must continue to perplex the minds of men until a wiser generation shall arise to develop [sic] the hidden wisdom, and penetrate the dubious intentions of its authors.”¹³²

Between the 1810s and the end of repeal in 1836, litigants and judges moved to fill this vacuum. The way they did so suggests the breadth of revocation actions. The manuscript records of cases in the federal court archives, plus a handful of reported decisions, show a law that was not merely used to chastise fraudulent behavior by patent applicants. Instead it was deployed, and increasingly celebrated, as a way to subject patents to the examination for validity that they otherwise lacked under the registration-only 1793 Act. To put it in modern terms, rather than treating Section 10 only as a kind of action against inequitable conduct, plaintiffs shaped it into a variety of different roles: as a kind of suit for declaratory judgment of invalidity, or as a species of derivation hearing between an inventor and an alleged plagiarist.

Most early repeal cases arose directly from the central feature of the 1793 Act: the lack of any prior examination for validity. The Patent Office had no power to refuse a patent, even if it knew of previous patents on the invention.¹³³ “Interfering” applications for the same invention could be subjected to a panel of arbitrators to determine priority, but these proceedings did not extend to issued patents.¹³⁴ Section 10 offered a way for patentees and patent applicants to knock out conflicting grants after they had issued. The earliest case (after *Jenkins v. Folger*) thus far located in the archives took this form.¹³⁵ John Lamb, the owner of an 1803 patent to Simeon Rouse for a form of shipboard stove called a “cabouse,” sued to repeal George Youle’s newly-issued 1806 cabouse patent, asserting that Rouse was the true inventor.¹³⁶ Another patentee who found his prerogatives threatened by later arrivals was Jethro Wood, widely hailed as the pioneer of the iron plough, and a vigorous enforcer of his own 1819 patent.¹³⁷ Wood sued on multiple occasions to repeal later patents that he

¹³¹ Fessenden (1810), *supra* note 23, at 175-76. In lieu of American authority, Fessenden reproduced a summary of *scire facias* from an English digest. *Id.* at 179-81.

¹³² *McGaw v. Bryan*, 16 F. Cas. 96, 96 (S.D.N.Y. 1821).

¹³³ William Thornton, *Patents* (1811), reprinted in 6 J. Pat. Off. Soc’y 98 (1923) (stating, in a pamphlet issued by the Superintendent of Patents, that “as there is at present no discretionary power to refuse a patent, even where no just claim exists it may appear proper to caution the purchaser of rights against the supposition that the invention patented, is always valuable, or new, or that it interferes with no previous patent”).

¹³⁴ Patent Act of 1793, ch. 11, § 9, 1 Stat. 318, 319 (repealed 1836).

¹³⁵ *Lamb et al. v. Youle* (D. N.Y. 1806), unpublished case file at National Archives, New York City (hereafter *Lamb v. Youle* case file).

¹³⁶ *Lamb v. Youle* case file, affidavit of John Gove, November 6, 1806.

¹³⁷ See *Jethro Wood, Inventor of the Modern Plow*, 50-51 (Chicago, Rhodes & McClure 1882).

thought intruded on his rights.¹³⁸ Jesse Delano, a prominent maker of fireproof safes and owner of a patent issued to his father in 1826, similarly seems to have policed later grants that claimed his father's invention.¹³⁹

If these suits were effectively interference cases—priority disputes among rival inventors—others resembled what we would now think of as derivation actions: contests about whether a patentee had obtained his idea from another inventor. Despite the statutory requirement that the plaintiff show “surepitious[ness] or . . . false suggestion,” only a subset of repeal suits alleged deliberate copying of an earlier inventor's work. Samuel Stone of Vermont sought repeal of Ezekiel Olds's circular-saw patent of 1808 on the ground that Olds had obtained it “well knowing” that Stone was the true inventor.¹⁴⁰ Other cases gave more detail of the alleged plagiarism. Hezekiah Kelley of Brooklyn complained that he had shown his fireproof distillery equipment to one William Rapp, who hoped to reduce the flammability—and reassure the neighbors—of his own planned turpentine works. Rapp had then proceeded to Washington and obtained a patent mere weeks ahead of Kelley.¹⁴¹ Disputes between collaborators were another potential source of conflict. In 1806, both the silk dyer William Barrett and the mechanic Abner Stearns applied for patents on the dyeing machine Stearns had built for Barrett.¹⁴² Stearns later sued to repeal Barrett's patent, claiming to have been the true inventor, while Barrett retorted that Stearns had constructed the machine to Barrett's design.¹⁴³

As time went on, repeal suits took on an expanded character. Especially during the later years of the 1793 Act, numerous repeal cases simply alleged that the patented invention was not new. For example, James Hanrahan sued the leading industrialist Jordan Mott in 1835 on the theory that Mott was not the true inventor of his patented anthracite coal stove. Hanrahan alleged only that “the same was known by others” before Mott's purported discovery—essentially the traditional defense of invalidity by anticipation,

¹³⁸ *Jethro Wood v. Josiah Dutcher* (S.D.N.Y. 1824), unpublished case file at National Archives, New York City (challenge to Dutcher's plough patent of 1822); *Ex Parte Wood*, 22 U.S. (9 Wheat.) 603 (1824) (resulting from Wood's suit to repeal the 1820 plough patent of Charles Wood and Gilbert Brundage).

¹³⁹ *Jesse Delano v. Charles Gaylor*, (S.D.N.Y. 1833), unpublished case file at National Archives, New York City; *Delano v. Scott*, 20 J. Fr. Inst. 47 (E.D. Pa. 1835).

¹⁴⁰ *Complaint of Samuel Stone*, filed April 10, 1811, in *Stone v. Olds* (D. Mass. 1811), unpublished case file at National Archives, Boston.

¹⁴¹ *Hezekiah Kelley v. William Rapp* (S.D.N.Y. 1816), unpublished case file at National Archives, New York City, affidavits of Jacob Gerhart and Hezekiah Kelley, April 1, 1816. Rapp and Kelley received their patents in December 1815 and February 1816 respectively. See S. Alfred Elliot, *A List of Patents Granted by the United States, for the Encouragement of the Arts and Sciences, Alphabetically Arranged, from 1790 to 1820*, 18 (Washington, D.C., S. Alfred Elliot, 1823).

¹⁴² *Abner Stearns v. William Barrett* (D. Mass. 1814-1816), unpublished case file at National Archives, Boston (hereafter *Stearns v. Barrett* case file). Stearns received his patent in 1806. Barrett, after initially letting his application lapse, obtained a patent in 1809. See *Stearns v. Barrett* case file, exhibits E, F, G, and K.

¹⁴³ *Stearns v. Barrett* case file, depositions of Hugh Thompson, Robert Emes, Mesach Shattuck, and George Barrett.

but imported into the repeal action.¹⁴⁴ Reported decisions of the courts indicated a focus on questions of novelty rather than fraud: allegations of false suggestion were found to be adequately supported by “evidence, tending to show that the manufacture . . . was not new, or, in other words, that they were not the true inventors of discoverers”;¹⁴⁵ hearings on repeal investigated “the alleged originality of the manufacture . . . with much labour and assiduity.”¹⁴⁶ Judges apparently embraced the theory that a sworn patent application for a non-novel invention by itself sufficed for “false suggestion.” Eventually this position became explicit: charging a jury in 1834, New York’s district judge explained that if an invention “had been before published in works of art and science, the patentee was presumed to know it,” and that any prior publication thus supported repeal of the patent.¹⁴⁷

Revocation cases of this type stretched the terms of the statute beyond strictly fraudulent patent applications. The incentives for plaintiffs to read the law more broadly were straightforward: in a time before declaratory judgments were available,¹⁴⁸ repeal proceedings were a valuable means to bring an affirmative challenge to an undesirable patent. But why did judges accommodate, or even encourage, this move? The answer seems to lie in growing discontent with the shortcomings of the 1793 Patent Act. Judges’ opinions in repeal cases, far more than in infringement suits, referred to the growing pressure on the no-examination patent system, and to the litigation and assertion activities that accompanied mounting numbers of patents.

The fullest explanation of this climate came from William P. Van Ness, district judge of New York in the 1810s and 1820s. Van Ness was a well-connected jurist, active in Democratic-Republican politics, who in his younger years had served as Aaron Burr’s second in the duel that killed

¹⁴⁴ Petition of James Hanrahan for Repeal of Patent to Jordan L. Mott, March 3, 1835, in James Hanrahan v. Jordan L. Mott (S.D.N.Y. 1835), unpublished case file at National Archives, New York City; Patent Act of 1793, ch. 11, § 6, 1 Stat. 318, 319 (repealed 1836) (establishing a defense of invalidity where the invention had been “in use, or had been described in some public work anterior to the supposed discovery of the patentee”).

¹⁴⁵ Thompson v. Haight, 23 F. Cas. 1040, 1040-41 (S.D.N.Y. 1826).

¹⁴⁶ Id. at 1041. See also Morris v. Huntington, 17 F. Cas. 818, 820 (C.C.S.D.N.Y. 1824) (stating that “the sixth section [of the 1793 Act] which specifies the cause for which a patent may be declared void, shows the great object of inquiry to be whether there has been a prior use of the improvement . . . The same remarks are applicable to the 10th section.”)

¹⁴⁷ “Law Case—On a Patent,” Niles’ Register, Oct. 25, 1834, 122, 123 (reporting the trial of Falconer v. Clark (S.D.N.Y. 1834)). The jury in the case may not have followed the judge in equating lack of novelty with false suggestion: it “found for the complainants upon the ground that the defendant was not the true inventor, and also further found that the patent was not obtained surreptitiously, or upon a false suggestion.” Id. at 123. That this was a Section 10 repeal case is confirmed by William Falconer v. Edward Clark (S.D.N.Y. 1833-34), unpublished case file at National Archives, New York City (hereafter Falconer v. Clark case file).

¹⁴⁸ The federal courts gained the authority to issue declaratory judgments in 1934. See Edwin Borchard, *The Federal Declaratory Judgments Act*, 21 Va. L. Rev. 35 (1934).

Alexander Hamilton.¹⁴⁹ As the sole federal district judge in New York City between 1812 and 1826, he was a key figure in the law and practice of patent repeal. While no enemy of patents in principle, he became a strong critic of the 1793 regime. In a published 1826 decision, Van Ness inveighed against the “evils” of the patent system, which included “[t]he very great and very alarming facility with which patents are procured” and the resultant “flagitious speculations of imposters, and the arrogant pretensions of vain and fraudulent projectors.”¹⁵⁰

Like many critics of the patent system in the years before the 1836 Patent Act,¹⁵¹ Van Ness complained that “[s]ome mode should be devised of examining into the novelty and utility of alleged inventions, before patents are issued to the applicants.”¹⁵² With the same breath, he explained that any patent used before the date of application was “obtained surreptitiously and upon false suggestion.”¹⁵³ If the law would not screen patents for novelty before issue, Van Ness reasoned, then a repeal action could do it afterward. “That a summary inquiry into the nature, novelty, utility, and validity of these grants ought to be somewhere provided for and made, must be obvious to the common sense of the world.”¹⁵⁴ For the power of examination to reside with the courts, he pointed out, was not so outlandish: before the 1793 Act, Congress had considered proposals to have patents granted by the district courts.¹⁵⁵

Van Ness was not the only judge who saw repeal proceedings as a bulwark against the oppressive assertion of wrongful patents. His successor as U.S. district judge in New York, Samuel Betts, wrote that the Section 10 remedy “puts in possession of the Public a most convenient relief against indefensible Monopolies and vexatious prosecutions thereon.”¹⁵⁶ Joseph Hopkinson, the district judge in Philadelphia from 1828 to 1842, came around gradually to the idea that repeal proceedings should apply to general lack of novelty.¹⁵⁷ In doing so, Hopkinson characterized Section 10 as a weapon against spurious patent assertion:

¹⁴⁹ See Lin-Manuel Miranda, *The World Was Wide Enough*, in *Hamilton* (Original Cast Recording) (Warner Music Group, 2015) (“BURR: We rowed across the Hudson at dawn My friend William P. Van Ness signed on as my— BURR AND COMPANY: Number two!”); Peyton Farrell Miller, *A Group of Great Lawyers of Columbia County, New York*, 133-35 (1904).

¹⁵⁰ *Thompson v. Haight*, 23 F. Cas. 1040, 1041 (S.D.N.Y. 1826).

¹⁵¹ Steven Lubar, *The Transformation of Antebellum Patent Law*, 32 *Tech. & Culture* 932 (1991).

¹⁵² *Thompson v. Haight*, 23 F. Cas. at 1041–42.

¹⁵³ *Thompson v. Haight*, 23 F. Cas. at 1047.

¹⁵⁴ *McGaw v. Bryan*, 16 F. Cas. 96, 99 (S.D.N.Y. 1821).

¹⁵⁵ *McGaw v. Bryan*, 16 F. Cas. at 99 (“It was originally proposed in congress, to vest the power of granting patents, in the district courts, and to connect with it the English system of proceeding upon caveats; thus affording to the public and particular objectors an opportunity of being heard, in opposition to the application, before the letters issued”). See also Walterscheid, *supra* note 66, at 101-103, 219.

¹⁵⁶ Unpublished opinion of Samuel A. Betts, dated 1834, *Falconer v. Clark* case file.

¹⁵⁷ See *Delano v. Scott*, 7 F. Cas. 378, 383 (E.D. Pa. 1835) (explaining that Hopkinson had previously charged the jury that “[t]he mere fact that the patentee was not the original

A case is recorded of a patent for using the common stone coal in a common blacksmith's forge. The patentee went through the country exhibiting his parchment patent with the great seal of the department of state, and the signatures of the high officers of government appended to it. This would naturally alarm an ignorant smith, and as the patentee would sell him a right for two or three dollars, or for whatever he could get for it, a prudent man would prefer paying so small a sum, rather than go to law with an adversary apparently so well armed. To protect the public from such impositions, this tenth section was enacted, and gives the power to any person, interested or not in the discovery or the patent, to call upon the patentee for an examination of his right, and have it repealed.¹⁵⁸

In sum, the history of patent revocation before 1836 shows the courts grappling with a policy tool that was not clearly defined, and perhaps not well understood, but which was increasingly deployed in response to the shortcomings of the patent system. Of all the legal questions posed by that process, one emerged as by far the most controversial. It also happens to be an issue raised squarely by *Oil States* case: the dispute over whether patent revocation required a jury trial.

D. Summary Judgments

At least some patents issued under the 1793 Act were repealed summarily, in a bench trial based solely on a hearing to show cause, and without the sanction of a jury. This development eventually drew a rebuke from the U.S. Supreme Court, in the only Supreme Court decision to deal with revocation under the statute.¹⁵⁹ In that sense, summary repeal may not ultimately have been good law. But before being struck down it went on for years as the peak manifestation of revocation practice.

To step back for a moment: the nature of the process for repealing a patent under the statutes of 1790 and 1793 was initially unclear. Nothing in the patent acts explicitly authorized actions for *scire facias*, as practiced in England. And it was not self-evident that the revocation provisions were meant to enact a form of *scire facias*. There were compelling parallels, namely the use of the term “false suggestion” and the order-to-show-cause that initiated the proceeding. But there were also stark differences, such as the lack of need for government permission and the one-year or three-year time limit on challenges. Absent a clear model for the proceeding, the law was confusing on its face. If “sufficient cause” were not shown by the patentee-defendant in the initial hearing before the judge, would the patent

inventor of the thing patented, is not such a false suggestion as is contemplated by the act,” but had been “led to doubt the correctness of this opinion”).

¹⁵⁸ *Delano v. Scott*, 7 F. Cas. at 382.

¹⁵⁹ *Ex Parte Wood & Brundage*, 22 U.S. (9 Wheat.) 603 (1824).

proceed to trial before a jury? Or was the subsequent “process . . . to repeal such patent” merely a judicial order of revocation, needing only to be executed as a ministerial matter?

One early organic development was that parties, in their pleadings, began to refer to statutory repeal actions as *scire facias* suits. In the early years of the nineteenth century, probably because of the lack of usable precedent regarding Section 10, American lawyers found it easiest to behave as though the act authorized the English writ, despite its quite different design.¹⁶⁰

The applicability of *scire facias* could not be taken for granted, however. After losing a jury verdict in the Massachusetts case of *Stearns v. Barrett* (1816), the unsuccessful plaintiff at the district court appealed to the circuit court, claiming that the action should have been treated as a summary process, resolved by the district judge alone after the hearing to show cause.¹⁶¹ Justice Joseph Story, sitting on circuit, openly agonized over the question. He found the proceeding “peculiar” and the section “not easy to give a construction . . . free of difficulties.”¹⁶² Eventually, “[a]fter considerable hesitation,” he concluded that “the process, to be awarded upon making the rule absolute, is not a final process, but a judicial writ in the nature of a *scire facias* at the common law.”¹⁶³ At the same time, Story took a conservative view of the repeal provision generally, setting aside the jury verdict on the basis that it had broadly addressed priority of inventorship—rather than, as Story believed proper, deciding only the fact of whether Barrett had obtained his patent “surreptitiously or upon false suggestion.”¹⁶⁴

Because Story’s opinion was the only opinion on patent repeal published in the 1810s, some contemporaries were—and modern observers might be—led to believe that it represented the prevailing law of patent repeal. The problem with that reading is that other courts rejected *Stearns*. As we have seen, Story’s attempt to restrict revocation actions to cases involving fraud alone was widely ignored.¹⁶⁵ And five years later, New York’s District Judge, William Van Ness, declared it an “established practice” of his court that revocation was a summary proceeding, in which patents might be repealed after the hearing to show cause.¹⁶⁶ Van Ness reported having invalidated “several” patents in this fashion in recent

¹⁶⁰ See, e.g. [Unidentified Document 188] in *Lamb v. Youle* case file, 1806; [doc.] in *Cutter v. Reed* (D. Mass 1810), unpublished case file at National Archives, Boston.

¹⁶¹ *Stearns v. Barrett*, 22 F. Cas. 1175, 1177 (C.C.D. Mass. 1816).

¹⁶² *Id.* at 1178.

¹⁶³ *Id.* at 1179.

¹⁶⁴ *Id.* at 1180-81.

¹⁶⁵ Story’s hometown district court in Boston—over which Story had direct review as Circuit Justice—presumably remained strict. This may account for the fact that no revocation cases appear in the court’s archived case files after 1826, while the number in New York and Philadelphia climbed. See List of revocation suits filed in the District of Massachusetts, drawn from National Archives, Boston, and on file with the author.

¹⁶⁶ *McGaw v. Bryan*, 16 F. Cas. 96, 97 (S.D.N.Y. 1821).

years.¹⁶⁷ He justified this position by claiming that “it was natural, and in a great degree requisite, to protect the public against frauds and impositions, that some expeditious summary mode of investigating their merits and trying their validity should be provided.”¹⁶⁸

Van Ness went on to lay out the case for why the American repeal statute did not incorporate *scire facias*. Scoffing at the “magic influence” that would be required for Section 10 to draw after it “all the statute and common law of England,”¹⁶⁹ Van Ness stressed above all the United States’ break from England’s patent regime. English patents were grants of favor from the Crown; American patents pure “creatures of the statute.”¹⁷⁰ The modes of approving grants were different. And while the governing English statute, the Statute of Monopolies, explicitly required that patents be “‘examined, heard, tried, and determined, by and according to the common laws of this realm, and not otherwise’ . . . Our act contains no direct reference whatever, to the common law.”¹⁷¹ Elements of the English system not adopted “must be presumed to have been discarded,” and this striking omission, along with the act’s “radical departure from the English system of granting patents . . . press irresistibly upon my mind the conclusion that the proceedings under this section were not meant to be according to the course of the common law, but that it was intended to invest the district judge with a plenary supervision over the legality of patents.”¹⁷²

Van Ness was not alone in this opinion. In *Evans v. Eaton* (1822), an infringement suit, Justice Henry Brockholst Livingston of the Supreme Court distinguished the summary proceeding provided by Section 10 from infringement suits, in which he insisted that jury trials were required:

From the tenth section, also, an argument may be drawn against the right of a court to declare a patent void on mere inspection for redundancy or deficiency in a specification. This section provides a mode of proceeding before the district court where there may be reason to believe a patent was obtained surreptitiously or upon false suggestions, and if on such proceeding it shall appear that the patentee was not the true inventor, judgment shall be rendered by such court for a repeal of the patent. This is the only case in which

¹⁶⁷ *McGaw v. Bryan*, 16 F. Cas. at 97.

¹⁶⁸ *McGaw v. Bryan*, 16 F. Cas. at 97. Van Ness stressed that Congress could not have meant to require slow, expensive trials for the purpose: “Every presumption of reason and of law is against the position that . . . the expensive and dilatory forms of the common law were meant to be pursued in investigations of this sort. During their progress, an impostor or pretender might for a long time harass the community, and for a season reap the fruits of his iniquity and fraud.” *Id.* at 99.

¹⁶⁹ *McGaw v. Bryan*, 16 F. Cas. at 97.

¹⁷⁰ *McGaw v. Bryan*, 16 F. Cas. at 98.

¹⁷¹ *McGaw v. Bryan*, 16 F. Cas. at 97.

¹⁷² *McGaw v. Bryan*, 16 F. Cas. at 99.

a power is conferred on a court to vacate a patent without the intervention of a jury.¹⁷³

Livingston's observation was both dissent and dicta, but it revealed his reflexive—and uncontradicted—assumption that repeal was a summary proceeding.

On this issue, Justice Story held the trump card. The death of Justice Livingston in 1823 robbed Van Ness of a Democratic-Republican ally and circuit justice who had endorsed the summary view of patent repeal. One of Van Ness's summary revocations was appealed to the Supreme Court in 1824. In *Ex parte Wood and Brundage*,¹⁷⁴ Story wrote for the Court in prohibiting Van Ness's practice and enforcing a trial in actions for repeal. Like Van Ness, Story gave an account of American patent law that dwelled on its statutory origins. In Story's case, however, the appeal was not to the protection of the public, but to the security of the patent right:

The securing to inventors of an exclusive right to their inventions, was deemed of so much importance, as a means of promoting the progress of science and the useful arts, that the constitution has expressly delegated to Congress the power to secure such rights to them for a limited period. The inventor has, during this period, a property in his inventions; a property which is often of very great value, and of which the law intended to give him the absolute enjoyment and possession. . . . It is not lightly to be presumed, therefore, that Congress, in a class of cases placed peculiarly within its patronage and protection, involving some of the dearest and most valuable rights which society acknowledges, and the constitution itself means to favour, would institute a new and summary process, which should finally adjudge upon those rights, without a trial by jury, without a right of appeal, and without any of those guards with which, in equity suits, it has fenced round the general administration of justice.¹⁷⁵

Story concluded that Section 10 required “a process, in the nature of a *scire facias*, to the patentees, to show cause why the patent should not be repealed.”¹⁷⁶ The resultant trial should follow the standard pattern of an English *scire facias* case: “if the issue so joined be an issue of fact, then the trial thereof to be by a jury; if an issue of law, then by the Court, as in other cases.”¹⁷⁷ With this determination—which, to be clear, was statutory rather than constitutional in nature—Story brought the episode of summary patent revocation to a close.

¹⁷³ *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356, 450-51 (Justice Livingston dissenting).

¹⁷⁴ *Ex parte Wood & Brundage*, 22 U.S. (9 Wheat.) 603 (1824).

¹⁷⁵ *Ex parte Wood & Brundage*, 22 U.S. at 608.

¹⁷⁶ *Ex parte Wood & Brundage*, 22 U.S. at 614.

¹⁷⁷ *Ex parte Wood & Brundage*, 22 U.S. at 615.

CONCLUSION

The early history of patent repeal is convoluted. On some level, these complications do—and should—resist easy translation into the terms of modern argument. Uncertainty and ambiguity clouded the law of patent repeal in the United States even before the intervening centuries left moth holes in the record of events. Yet it is precisely because of these confusions and gaps that we should resist “law office history,” or cherry-picking from the historical record, and try to understand more fully what was going on. In that spirit, I will close with two brief observations about how the foregoing history might inform the *Oil States* case.

The “clean slate” question. One of the central issues raised by this account is the extent to which English antecedents matter. If the American system of patenting and patent adjudication is seen as continuous with the prior English tradition, then English *scire facias* practice is germane to the Seventh Amendment jury right—and leans in favor of the jury right, given the consistent use of juries to decide factual questions in *scire facias* actions. If, on the other hand, the 1790 Patent Act is admitted to have broken from the English tradition, then other calculations are in play. In that case, the jury right could depend on the nature of the repeal process contemplated by Section 5 of the 1790 Act, perhaps informed, in the absence of other evidence, by the experience of practice under Section 10 of the 1793 statute. Other historical arguments might similarly be affected: scholarly interest has recently gravitated toward Privy Council revocations in England, as potentially implying a right of the sovereign to repeal grants administratively and without judicial process.¹⁷⁸ If the creation of American patent law is shown to have broken from the assumptions of English law, both monarchical and institutional, then the applicability of such English arrangements fades.

The career of patent repeal offers a mixed picture of continuity with, and departure from, English law. English practice provided a constant reference point. Yet the departures may have been more substantial. The process of issuing patents under both the 1790 and 1793 Acts differed administratively and conceptually from the English regime. The American statutes did not incorporate the Statute of Monopolies, which explicitly required that in England “all monopolies, and all . . . letters patents . . . and the force and validity of them . . . ought to be, and shall be for ever hereafter examined, heard, tried, and determined, by and according to the common laws of this realm, and not otherwise.”¹⁷⁹ Likewise, the mode of revocation adopted in the United States’ first patent laws did not simply import English

¹⁷⁸ See, e.g. Brief for H. Tomas Gomez-Arostegui and Sean Bottomley, *supra* note 17, at 33-37.

¹⁷⁹ An Act concerning Monopolies and Dispensations with Penal Laws, and the Forfeitures thereof, 21 Jac. 1, c. 3, § 2 (1623).

practice. Patent documents were not required to state their revocability on their face, as in England. There was no provision even vaguely equivalent to repeal by the Privy Council. Nor did repeal under the 1790 and 1793 Acts self-evidently transplant *scire facias*, although this of course proved to be a vexed question. The case for a clean slate is at least a plausible one.

Open questions. The predominant fact about patent repeal in the Early Republic is that so much about its operation was uncertain or disputed. What should the constitutional significance of that be?

To take procedure first: if the repeal provisions of American patent law either clearly had, or clearly had not, created a guarantee of jury trial (or conversely, created a summary judicial action to repeal patents) then that would be grist to the mill of the *Oil States* case. But instead the statute was ambiguous. *Scire facias*, with its common law proceeding and jury trial on questions of fact, was not clearly adopted in the 1790 or 1793 Acts. After a few years of practice, however, at least some parties and courts had chosen to behave as though the statutory action took the form of a *scire facias*—an act of legal borrowing that ultimately brought further assumptions about procedure along with it. This assumption was then tested and resisted, first by unsuccessful parties before Justice Story and then successfully in the district court of New York. To be sure, our earliest hints about what the 1790 Act contemplated—Thomas Jefferson’s letter to Hugh Williamson, and the events of *Folger v. Jenkins*—both contemplated that a trial would follow the initial repeal hearing. But that point was sufficiently unclear that later courts could argue plausibly for a summary process. Even Justice Story initially found the matter ambiguous. On this point, the Supreme Court did ultimately rule: in *Ex parte Wood* in 1824, the nature of the statutory process was settled in favor of *scire facias* at common law, with a jury trial on questions of fact. But it would be misleading to think that *Ex parte Wood* confirmed what had always been “true”; the fact is that for decades there was no right answer.

If that tale of the law in action presents Seventh Amendment dilemmas, then the other open question in early patent repeal—whether “false suggestion” included general lack of novelty—bears on the Article III question, of private and public right. The grounds on which a patent might be revoked are primary evidence of the nature of the right at the time. For any member of the public to have standing to institute repeal, simply on the grounds that the invention was not new, and thus did not comply with the requirements of the statute, suggests a broader public stake in the working of the system. It recognized the harm caused to all by the existence of an improper patent, and the right of the public to ensure that only a true inventor benefited from the law. A property susceptible to public challenge in this way might be considered “integrated into a public regulatory scheme” for Article III purposes.

And just what was that scheme, in the terms of its own time? It is surely important that Congress made repeal a judicial matter. But the line between

judicial and administrative functions was not a bright one in the early patent system. The patent board under the 1790 Act exercised discretionary prior approval of patent grants, but could hardly examine applications in the modern sense (especially for novelty), while the 1793 Act offered no meaningful administrative screening at all. Under these circumstances, assigning repeal proceedings to the courts meant placing them in the hands of the institution principally responsible for determining patent validity. Whether that action was based on institutional competence or separation of powers was a contested question in its day. The district judges who heard repeal suits in the 1820s and 1830s asserted their power to police invalidity broadly in revocation proceedings. For Judge Van Ness in New York, repeal was explicitly a part of the administration of the patent law: a post-grant review where no prior examination existed. Conversely, Justice Story for the Supreme Court in *Ex parte Wood* presented the issued patent as a settled “property . . . of which the law intended to give [its owner] the absolute enjoyment and possession,” with all applicable guarantees of law and equity.¹⁸⁰ Some readers of *Ex parte Wood* will be inclined to see this statement as authoritative, defining the nature of patent rights in the early Republic and obliterating alternative conceptions. The evidence of historical practice is less clear-cut.

The United States finally gained an administrative patent system in 1836, at which point statutory revocation disappeared from the law. To apply the history of the pre-1836 period to modern questions is inevitably an act of transposition, setting the assumptions of the Early Republic amid the structures of the modern administrative state. As history, though, the fact remains: under America’s first patent acts, a wrongfully-issued new patent was one that the public retained the power to reject.

¹⁸⁰ *Ex parte Wood & Brundage*, 22 U.S. at 608.