

# Repealing Patents

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*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 and post-grant review. With the Supreme Court’s recent scrutiny of the constitutionality of inter partes review, this history has taken on a new significance.*

*This Article 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 They also show that some U.S. courts in the early Republic repealed patents in a summary process without a jury, until the Supreme Court halted the practice.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 new constitutional questions surrounding patent cancellation.*

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## INTRODUCTION

The first known patent case in the United States courts did not enforce a patent. Instead, it sought to repeal one.<sup>1</sup> Under the earliest federal patent laws, passed in 1790 and 1793, any member of the public could seek cancellation of a patent right.<sup>2</sup> Rival inventors, business competitors, potential infringers, and other aggrieved persons were empowered, under certain conditions, to pursue revocation.<sup>3</sup>

For recent observers of the patent system, this history might come with the jolt 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 U.S. Patent and Trademark Office (“Patent Office”), taking place before administrative judges of the Patent Trial and Appeal Board.<sup>4</sup> IPR 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 themselves have any liability under the patent.<sup>5</sup> The new measures depart from historical practice by framing cancellation proceedings as administrative trials held within the Patent Office rather than in federal courts.<sup>6</sup> But they

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1. *Jenkins v. Folger* (D.N.Y. 1792) (unreported case minutes at National Archives, New York City, N.Y.); *see infra* Section II.C.

2. *See* Patent Act of 1793, ch. 11, § 10, 1 Stat. 318, 323 (repealed 1836); Patent Act of 1790, ch. 7, § 5, 1 Stat. 109, 111 (repealed 1793).

3. Throughout this Article, I use the terms “revoke” and “repeal” to refer to the practice of cancelling a patent by a stand-alone proceeding, as distinct from proving its invalidity as a defendant in an infringement case.

4. 35 U.S.C. §§ 311–329 (2012) (establishing IPR and PGR).

5. *See* 35 U.S.C. §§ 311, 321. 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, 126–27 (2007).

6. *See, e.g.*, 35 U.S.C. §§ 311(a), 318, 321. A form of adversarial process for cancelling patent claims at the Patent Office did exist before 2011. *Inter partes* reexamination, a precursor to IPR, was available from 1999 until 2012 and allowed any person to institute Patent Office review of a granted patent. The party initiating reexamination was permitted to participate in proceedings

follow an older pattern in opening a public channel to attack patent rights that allegedly should not have been granted.

This history has recently taken on a new importance. Opponents of IPR have repeatedly challenged the constitutionality of administrative patent cancellation.<sup>7</sup> During the 2017 to 2018 Term, the U.S. Supreme Court heard and rejected one such challenge: *Oil States Energy Services, LLC v. Greene’s Energy Group, LLC*,<sup>8</sup> in which petitioners contended that IPR violated the separation of powers doctrine by withdrawing matters of patent validity from the Article III courts and assigning them instead to an executive agency. The Court preserved IPR by holding that patent cancellation qualifies as a “matter of public rights” that Congress may properly assign to an administrative tribunal.<sup>9</sup> Despite this conclusion, the constitutional landscape around patent cancellation is far from settled. *Oil States* was narrowly decided; the Court did not address potential arguments involving takings or the retroactive application of IPR to pre-2011 patents.<sup>10</sup> Nor did the Court need to reach the other question squarely presented in *Oil States*: whether matters of patent validity must be considered “suits at common law” in which the Seventh Amendment requires that “the right of trial by jury shall be preserved.”<sup>11</sup> The Seventh Amendment question as applied to IPR evaporated once the *Oil States* Court determined that administrative adjudication was proper.<sup>12</sup> But the broader notion that patent validity is subject to the constitutional jury right—a notion currently assumed in the federal courts—has a surprisingly thin basis in modern case law and could well

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before the examiner and to appeal an adverse decision. See 35 U.S.C. §§ 314–315 (2006), amended by Leahy-Smith America Invents Act, 35 U.S.C. §§ 314–315 (2012).

7. See Greg Reilly, *The Constitutionality of Administrative Patent Cancellation*, 23 B.U. J. SCI. & TECH. L. 377, 379–82 (2017).

8. 138 S. Ct. 1365, 1370 (2018).

9. *Id.* at 1378.

10. *Id.* at 1379.

11. U.S. CONST. amend. VII; *Oil States*, 138 S. Ct. at 1379. The question on which the Court granted certiorari ran as follows: “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.” *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 137 S. Ct. 2239 (2017) (mem); Petition for a Writ of Certiorari, at i, *Oil States*, 138 S. Ct. 1365 (No. 16-712), 2016 WL 6995217, at \*i.

12. *Oil States*, 138 S. Ct. at 1379:

This Court’s precedents establish that, when Congress properly assigns a matter to adjudication in a non-Article III tribunal, “the Seventh Amendment poses no independent bar to the adjudication of that action by a nonjury factfinder.” . . . Thus, our rejection of *Oil States*’ Article III challenge also resolves its Seventh Amendment challenge.

(citations omitted).

return in another context.<sup>13</sup> Finally, another complication of public patent review waits in the wings: the question of standing to appeal an unsuccessful IPR challenge in an Article III court.<sup>14</sup>

The new constitutional scrutiny of patent cancellation has placed history at the center of debate. Some of the questions involved are necessarily historical. Because 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 routinely decided after inquiries into Founding-era English and American practices.<sup>15</sup> The Article III question in *Oil States* was, at least in theory, less dependent on originalist analysis. The “nature” of a statutory patent right is not some eternal platonic truth, and there is no obvious reason why it should not change along with the statutory scheme under which patents are created. Even so, the dissent in *Oil States* rested primarily on originalist grounds, locating patent cancellation among “the traditional actions at common law tried by the courts at Westminster in 1789.”<sup>16</sup> The Court’s majority, while contending that historical practice is “not decisive,”<sup>17</sup> placed weight on the fact that patents in eighteenth-century England could be revoked by the Privy Council as well as the courts.<sup>18</sup> And both opinions repeatedly drew on historical descriptions, drawn from across the eighteenth and nineteenth centuries, to characterize the nature of the patent grant and its relationship to the public.<sup>19</sup>

My argument in this Article 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.<sup>20</sup> This omission is somewhat

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13. See Mark A. Lemley, *Why Do Juries Decide if Patents Are Valid?*, 99 VA. L. REV. 1673, 1675–76 (2013).

14. Although the statute that created IPR provides for appeal of final decisions to the U.S. Court of Appeals for the Federal Circuit, unsuccessful challengers who lack an injury-in-fact have been held to lack independent constitutional standing for an appeal. *Consumer Watchdog v. Wis. Alumni Research Found.*, 753 F.3d 1258, 1263 (Fed. Cir. 2014). A petition for certiorari on this question is currently pending. See *Petition for a Writ of Certiorari, RPX Corp. v. ChanBond LLC*, No. 17-1686 (filed June 18, 2018), 2018 WL 3778563, at \*i.

15. 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).

16. *Oil States*, 138 S. Ct. at 1381 (Gorsuch, J., dissenting) (quoting *Stern v. Marshall*, 564 U.S. 462, 484 (2011)).

17. *Id.* at 1378 (majority opinion).

18. *Id.* at 1377.

19. See *id.* at 1374–78; *id.* at 1381–85 (Gorsuch, J., dissenting).

20. For example, the Founding-era history of statutory revocation does not appear in the *Oil States* opinions, nor does it feature in the leading Federal Circuit opinions on the constitutionality

forgivable: although statutory patent repeal existed for the first forty-six years of American patent law, we have until now known very little about its workings. But it is a problem for several reasons.

For one, the American law of repeal holds a crucial, and hitherto unappreciated, position relative to the first constitutional amendments. The reason is that the United States *had a patent law before it had a Bill of Rights*.<sup>21</sup> This fact necessarily inserts the 1790 Patent Act into certain originalist inquiries. For example, the Seventh Amendment is often said to preserve “the right which existed under the English common law when the amendment was adopted.”<sup>22</sup> That makes sense in most cases. In most fields of law, it is difficult to describe a coherent, distinct American common law before 1791, so English practice makes a plausible baseline for founding expectations about the common law’s scope. But if the Act of 1790 adopted a form of patent revocation that was distinct from English antecedents, then the Seventh Amendment inquiry for patent validity should arguably turn on whether *that* proceeding included a jury trial.<sup>23</sup> The proxy value of deferring to English practice thus loses its force.

More broadly, the history of patent revocation highlights the different institutional choices made by eighteenth-century English and American patent law. Both the majority and the dissent in *Oil States*, in surveying the Founding-era modes of patent cancellation, assumed that the only available models were the two English forms: a trial at common law or revocation by the Privy Council.<sup>24</sup> Yet the early American statutes suggest that the United States had diverged in important ways from the forms and assumptions of the English patent system. The role of government, the standing of the public to bring suit, the involvement of a jury, and the line between administrative and judicial functions all took a different path in the United States.<sup>25</sup> This point only reinforces the dangers of engaging in an Anglocentric

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of IPR: *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284 (Fed. Cir. 2015); and *Cascades Projection LLC v. Epson Am., Inc.*, 864 F.3d 1309 (Fed. Cir. 2017) (denying petition for initial hearing en banc).

21. The Patent Act of 1790, ch. 7, 1 Stat 109 (repealed 1790), became law on April 10 of that year. The first ten amendments to the Constitution were ratified as of December 1791. U.S. CONST. amends. I–X.

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

23. The Supreme Court has acknowledged, but not resolved, 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.”).

24. See 138 S. Ct. at 1377–78; *id.* at 1381–83 (Gorsuch, J., dissenting).

25. See *infra* Part II.

originalism: not only is it inapposite to look solely at English practice but it is also problematic to read the early American law as though it merely replicated the system of royal patents.

Finally, the early American 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 laws, and all speak to the ways in which a patent was considered a public or private right. Whether one sees this history as authoritative, persuasive, or merely informative for the purposes of modern constitutional decisionmaking depends on one's prior convictions about constitutional interpretation and construction. But if history is to be invoked, then the history of patent revocation should be included.

To that end, this Article seeks to uncover the forgotten early history of American patent cancellation. Using new archival sources, it adds to and revises existing accounts of America's first patent laws.<sup>26</sup> 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 or 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 nature of the judge's power to repeal a patent, with or without a jury, was a disputed issue not settled until well past the Founding era.

The aim of this Article is not to take a firm position on the questions of constitutionality that faced the Court in *Oil States* or that future constitutional scrutiny of patent cancellation must resolve. But

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26. The leading scholarly account of patent cancellation under the 1790 and 1793 Acts is by Professor Mark Lemley. See Lemley, *supra* note 13 at 1693–67. The best review of eighteenth-century English practice is the Brief for H. Tomás Gómez-Arostegui and Sean Bottomley as *Amici Curiae* in Support of Neither Party, *Oil States*, 138 S. Ct. 1365 (No. 16-712), 2017 WL 3634324 [hereinafter Brief for Gómez-Arostegui & Bottomley]. See also H. Tomás Gómez-Arostegui & Sean Bottomley, *Privy Council and Scire Facias 1700–1883: An Addendum to the Brief for H. Tomás Gómez-Arostegui & Sean Bottomley as Amici Curiae in Support of Neither Party* (last revised Nov. 8, 2017) (unpublished paper) [hereinafter *Addendum to the Brief for Gómez-Arostegui & Bottomley*], [https://papers.ssrn.com/sol3/papers.cfm?abstract\\_id=3054989](https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3054989) [<https://perma.cc/K9H7-QRS4>].

I hope to identify 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 but did not simply replicate them. 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 favour" by the Crown.<sup>27</sup> A United States patent was a constitutionally authorized exclusive right, intended "to promote the Progress of . . . useful Arts."<sup>28</sup> Even so, many of the essential characteristics of the regimes 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 invention.<sup>29</sup> Meanwhile, 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. American patents in the early Republic were, in the words of one historian, "a republican version of the traditional English patent framework."<sup>30</sup> Americans contemplating their patent law often drew sharp distinctions between the two national orders.<sup>31</sup> But at the same time, conceptual and doctrinal borrowing from England was pervasive.<sup>32</sup>

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27. OREN BRACHA, *OWNING IDEAS: THE INTELLECTUAL ORIGINS OF AMERICAN INTELLECTUAL PROPERTY, 1790–1909*, at 22 (2016); W.M. HINDMARCH, *A TREATISE ON THE LAW RELATING TO PATENT PRIVILEGES FOR THE SOLE USE OF INVENTIONS* 3 (London, V. & R. Stevens & G.S. Norton & W. Benning & Co. 1846).

28. U.S. CONST. art. 1, § 8, cl. 8.

29. BRACHA, *supra* note 27, at 22, 24–25.

30. *Id.* at 195.

31. *See, e.g., id.* at 191 (quoting the 1793 statement of Congressman William Vans Murray, who contrasted the American notion of patents as "right[s] in the inventions [one] may make" with the English conception of patents as "privilege[s] bestowed").

32. 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 on the same subject." Joseph Story, *On the Patent Laws*, 16 U.S. app. 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).

In their English form, exclusive rights for inventions were royal grants of privilege under “letters patent”—a category that included patents for invention, as well as 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 . . . .”<sup>33</sup>

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 contrary to law or “prejudicial” or “inconvenient” to the realm or to the king’s subjects, or if the invention was not new or not the work of the patentee.<sup>34</sup> 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.<sup>35</sup> During the seventeenth and early eighteenth centuries, the principal means for implementing this proviso was the Privy Council, a body made up of the monarch’s close advisors, which had the power to adjudicate both patent enforcement and petitions for revocation.<sup>36</sup> Privy Council deliberations on these matters included debates about the public policy merits of specific monopolies.<sup>37</sup>

During the eighteenth century, the role of the Privy Council in patent disputes faded.<sup>38</sup> Revocation came to rest less on a patent’s

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33. 2 WILLIAM BLACKSTONE, *COMMENTARIES* \*346.

34. D. Seaborne Davies, *The Early History of the Patent Specification*, 50 *LAW Q. REV.* 86, 102 (1934). The revocation clause continued to be prescribed through the enactment of the Patent Act of 1902, by which time applications for revocation were handled by the Board of Trade of the Privy Council. See Form of Petition for Grant of Compulsory License or Revocation of Patent, in 9 *THE STATUTORY RULES AND ORDERS REVISED* 50, 50 (London, H.M. Stationery Office, 1904).

35. 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) (recounting the Privy Council’s ability to revoke patents found to be “inconvenient or prejudicial to the realm” (internal quotation marks omitted)); Adam Mossoff, *Rethinking the Development of Patents: An Intellectual History, 1550–1800*, 52 *HASTINGS L.J.* 1255, 1278–81 (2001) (describing instances in which patents were voided for, among other things, discontinued use).

36. See E. Wyndham Hulme, *Privy Council Law and Practice of Letters Patent for Invention from the Restoration to 1794*, 33 *LAW Q. REV.* 63 (1917) (examining the records of the Privy Council in order to formulate a limited history of patent law).

37. SEAN BOTTOMLEY, *THE BRITISH PATENT SYSTEM DURING THE INDUSTRIAL REVOLUTION 1700–1852*, at 105 (2014); Bracha, *supra* note 35, at 190.

38. The role of the Privy Council in patent adjudication began to wane as early as 1688. BOTTOMLEY, *supra* note 37, at 111. Revocation cases persisted somewhat longer, with Privy Council involvement fading out in the later eighteenth century. BRACHA, *supra* note 27, at 22.

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.<sup>39</sup> 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.<sup>40</sup> 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.<sup>41</sup> 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 . . . .”<sup>42</sup> 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 these cases the grant is absolutely void.”<sup>43</sup>

*Scire facias* gained steam as a means of attacking patents for invention toward the end of the eighteenth century.<sup>44</sup> English patenting in general 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 a patent that he or she had granted. A private individual prejudiced by a wrongfully

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39. *Scire Facias*, BLACK’S LAW DICTIONARY (1st ed. 1891).

40. *Id.*

41. JOSEPH CHITTY, JR., 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); THOMAS CAMPBELL FOSTER, A TREATISE ON THE WRIT OF SCIRE FACIAS 12 (London, V. & R. Stevens & G.S. Norton 1851).

42. 3 BLACKSTONE, *supra* note 33, at \*260–61.

43. 2 BLACKSTONE, *supra* note 33, at \*348.

44. *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. LEGAL HIST. 27, 34 n.48 (2014); Lemley, *supra* note 26, at 1685 n.49. The most comprehensive survey of litigation to date found seventy-three *scire facias* cases brought between 1782 and 1852, most of them before 1830. See *Addendum to the Brief for Gómez-Arostegui & Bottomley*, *supra* note 26, at 24–30 (cataloging the relevant cases).

granted patent also had the right to sue in the name of the king.<sup>45</sup> 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.<sup>46</sup> At least the theory of individual participation was broad: as one leading authority summed it up, “All 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.”<sup>47</sup>

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<sup>48</sup>—the picture seems wildly convoluted. 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 and was headed by the Lord Chancellor.<sup>49</sup> But patents belonged to a Chancery office called the Petty Bag, which administered the Chancellor’s separate common law jurisdiction.<sup>50</sup>

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45. 3 BLACKSTONE, *supra* note 33, at \*261; FOSTER, *supra* note 41, at 246–47 (citing Sir Oliver Butler’s Case (1685) 2 Vent. 344 (Eng.)); HINDMARCH, *supra* note 27, at 385–86.

46. See 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, [and] leave to issue it must therefore be previously obtained from the Attorney General.”); HINDMARCH, *supra* note 27, at 386–87 (reporting that “[t]he *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’s fees of the patentee if unsuccessful, in order “that patentees may not be vexatiously harassed by actions of *scire facias*, in which they could not recover costs against the prosecutor”); see also BOTTOMLEY, *supra* note 37, 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*).

47. RICHARD GODSON, A PRACTICAL TREATISE ON THE LAW OF PATENTS FOR INVENTIONS AND OF COPYRIGHT 197 (London, Joseph Butterworth & Son 1823).

48. These questions have arisen in connection with the Seventh Amendment right to a jury trial on patent validity. See *In re Lockwood*, 50 F.3d 966, 974 n.9 (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, J., dissenting) (arguing that “[i]n England, prior to 1791, anyone could challenge a patent’s validity by a *scire facias* writ in equity”).

49. 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) (explaining the unique rules and practices governing equity proceedings and detailing their eventual merger with law proceedings in federal courts).

50. See HENRY MADDOCK, 1 A TREATISE ON THE PRINCIPLES AND PRACTICE OF THE HIGH COURT OF CHANCERY 3 (New York, Clayton & Kingsland 1817) (explaining that in the Court of Chancery, “the process” to issue a writ of *scire facias* “issued out of the same, and was returnable there, and entered in the office, called the Petty Bag”).

*Scire facias* was thus the rare common law action brought in Chancery.<sup>51</sup> 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.<sup>52</sup>

The final distinctive feature of a *scire facias* action was its result. *Scire facias* provided the only judicial means to terminate a patent.<sup>53</sup> It is important to understand for these purposes that, unlike today,<sup>54</sup> 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.<sup>55</sup> 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.<sup>56</sup> 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 Article, 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.<sup>57</sup> The *Arkwright* case brought the writ back from a period of dormancy, and did so in spectacular fashion.<sup>58</sup> Counsel for the Crown opened by

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51. 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 27, at 381–83 (discussing cases in which *scire facias* was made returnable in the King’s Bench).

52. Brief for Gómez-Arostegui & Bottomley, *supra* note 26, 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.

53. See HINDMARCH, *supra* note 27, 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.”).

54. See *Blonder-Tongue Labs. v. Univ. of Ill. Found.*, 402 U.S. 313, 350 (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).

55. FESSENDEN, *supra* note 32, at 48–49.

56. See Lemley, *supra* note 13, at 1686 (noting that in eighteenth-century England, a court ruling did not invalidate a patent).

57. See 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, TO MR. RICHARD ARKWRIGHT, FOR AN INVENTION OF CERTAIN INSTRUMENTS AND MACHINES FOR PREPARING SILK, COTTON, FLAX, AND WOOL FOR SPINNING (London, Hughes & Walsh 1785) [hereinafter TRIAL OF A CAUSE].

58. 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.” *Id.* at 172.

informing the jury “that a case of greater importance, of greater value to the individuals disputing it, and to the public in general, was never yet tried in this or any other [c]ourt,”<sup>59</sup> and that a decision upholding the patent would “endanger the loss of the most valuable manufactory that this country knows.”<sup>60</sup>

Richard Arkwright’s machines for spinning and carding had transformed textile manufacture in Britain, and for more than a decade prior to *Rex v. Arkwright*, his patents had hung menacingly over the Lancashire heartland of the industry.<sup>61</sup> 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.<sup>62</sup> (Arkwright’s description of the invention was notoriously unclear, and the inventor himself confessed to obfuscating its workings.<sup>63</sup>) Yet because a holding of invalidity did not by itself extinguish the patent, Arkwright was able to resume his enforcement efforts.<sup>64</sup> Manchester manufacturers, alarmed by the renewed threat, sought cancellation by *scire facias*.<sup>65</sup>

The course of *Rex 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.<sup>66</sup> The writ for

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59. *Id.* at 12.

60. *Id.*

61. R.S. FITTON, *THE ARKWRIGHTS: SPINNERS OF FORTUNE* (1989).

62. See *TRIAL OF A CAUSE*, *supra* note 57, at 23–24 (describing *Arkwright v. Mordaunt* (1781)); John Hewish, *From Cromford to Chancery Lane: New Light on the Arkwright Patent Trials*, 28 *TECH. & CULTURE* 80, 84 (1987) (summarizing *Arkwright v. Mordaunt* through the Court of King’s Bench records).

63. See FITTON, *supra* note 61, at 131–32 (stating that Arkwright admitted to the “obscurity of the [patent] specification”).

64. 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), in *A COLLECTION OF THE MOST IMPORTANT CASES RESPECTING PATENTS OF INVENTION AND THE RIGHTS OF PATENTEES* 37–60 (John Davies ed., London, W. Reed 1816); Hewish, *supra* note 62, at 84–85.

65. FITTON, *supra* note 61, at 117–18; *TRIAL OF A CAUSE*, *supra* note 57, at 24.

66. Economic arguments against individual patents tended to have little purchase in the courts by this time, even in equity. See *BOTTOMLEY*, *supra* note 37, 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* (1785), *supra* note 64, at 55–56:

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.

the prosecution led with the traditional assertion that the patent was “prejudicial and inconvenient to our subjects in general.”<sup>67</sup> 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 foreign countries if the monopoly is permitted.”<sup>68</sup> But Justice Francis 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; and it was a “consequential issue . . . which must stand or fall by the other particular issues.”<sup>69</sup>

Justice Buller’s objections depended on the specifics of the Crown’s inadequate pleadings, but the effect of his intervention was unmistakable.<sup>70</sup> 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.<sup>71</sup> 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.<sup>72</sup> This posture reframed the “wrong” addressed by *scire facias*—not as oppressive monopoly, or even necessarily as fraud on the monarch, but as a violation of the bargain between patentee and the public in which an exclusive right was granted 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”

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67. TRIAL OF A CAUSE, *supra* note 57, at 7; *see also* HINDMARCH, *supra* note 27, 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.’”).

68. TRIAL OF A CAUSE, *supra* note 57, at 21, 30.

69. *Id.* at 31–32.

70. 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 47, at 194–95 (discussing *Arkwright v. Nightingale* and claiming that “if an issue were joined . . . such issue would capable of trial; and the patent might on that account be declared to be void.”).

71. *Id.* at 195.

72. *See* BRACHA, *supra* note 27, at 24 (describing the evolution of English patent law in the late eighteenth century).

who had “subscribed large sums to attack [patents] . . . by writ of *Scire facias*.”<sup>73</sup> Arkwright’s fate sowed fear among leading patentee-industrialists, including the pottery magnate Josiah Wedgwood and the steam pioneers Matthew Boulton and James Watt.<sup>74</sup> 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.”<sup>75</sup>

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 economic advisor Tench Coxe were deeply involved in attempts to draw British artisans and machinery to America, with particular attention to Arkwright’s technology.<sup>76</sup> 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,

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73. H.I. DUTTON, *THE PATENT SYSTEM AND INVENTIVE ACTIVITY DURING THE INDUSTRIAL REVOLUTION, 1750-1852*, at 37–38 (1984) (quoting an anonymous letter that circulated to a number of inventors in June of 1785).

74. FITTON, *supra* note 61, at 140–41 (discussing Wedgwood, Watts, and Boulton’s communications during this period, which included an effort to regain Arkwright’s patent).

75. BOTTOMLEY, *supra* note 37, at 81 n.30.

76. See DORON S. BEN-ATAR, *TRADE SECRETS: INTELLECTUAL PIRACY AND THE ORIGINS OF AMERICAN INDUSTRIAL POWER* 122–24, 147 (2004) (describing attempts to encourage European inventors’ passage to the United States, as well as attempts to engage in outright industrial espionage); Anthony F. C. Wallace & David J. Jeremy, *William Pollard and the Arkwright Patents*, 34 WM. & MARY Q. 404, 404–425 (1977) (discussing the “American pursuit of the Arkwright technology,” including a U.S. patent granted to an American manufacturer for a machine that included components drawn from Arkwright’s patents). 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 C. WALTERSCHEID, *TO PROMOTE THE PROGRESS OF USEFUL ARTS: AMERICAN PATENT LAW AND ADMINISTRATION, 1798-1836*, at 111 (1998). 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 & Jeremy, *supra*, at 404.

following a showing that the grant in question was obtained “surreptitiously, or upon false suggestion.”<sup>77</sup> Any presumption of validity that attached to the patent during infringement litigation was absent in a repeal suit.<sup>78</sup>

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 revocation was a measure directed against fraud in the patent application process, or what we would now call “inequitable conduct” in patent prosecution.<sup>79</sup> There is some truth to that idea. But both in theory and in practice, the scope of patent repeal proceedings was significantly broader. Most importantly, it included the ability to invalidate patents for general lack of novelty, regardless of the applicant’s intent. Revocation posited a particular relationship between the public and the patent: the public had not only a power to call out wrongful misrepresentations by patent applicants, but also 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 began afresh.

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77. Patent Act of 1793, ch. 11, § 10, 1 Stat. 318, 323 (repealed 1836). The Patent Act of 1970 used the insubstantially different language “surreptitiously *by*, or upon.” Patent Act of 1790, ch. 7, § 5, 1 Stat. 109, 111 (repealed 1793) (emphasis added).

78. Patent Act of 1790 § 6:

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.

(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 76, at 229 (addressing the changes the 1793 Act made to the burden of proof in patent litigation).

79. See, e.g., *In re Lockwood*, 50 F.3d 966, 974 n.9 (Fed. Cir. 1995), *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 . . . .”); Lemley, *supra* note 13, at 1693 (stating the 1790 Act allowed parties to petition a court to cancel a patent for fraud or inequitable conduct); David McGowan, *Inequitable Conduct*, 43 LOY. L.A. L. REV. 945, 948–49 (2010) (discussing the action for cancellation as an antecedent of inequitable conduct, although noting that “the most natural reading” of the 1790 statutory language suggests that “false suggestion” did not require deceptive intent).

*A. The Purposes of Patent Repeal*

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 we should look 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.<sup>80</sup> 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.”<sup>81</sup> 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.<sup>82</sup> 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.<sup>83</sup>

When the replacement Act arrived in 1793, it made a major change in the administration of patent law.<sup>84</sup> The new statute abolished the patent board and instead created a registration system: patents would henceforth be issued without prior examination.<sup>85</sup> An office at the State Department collected the required specifications and models, but questions of validity were left for the courts. This system would face

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80. On state patents, see Camilla A. Hrды, *State Patent Laws in the Age of Laissez Faire*, 28 BERKELEY TECH. L.J. 45, 58–66 (2013), which describes patents in early seventeenth-century American colonies as part of a class of exclusive rights, including those for corporate charters and franchises, that emphasized results rather than novelty.

81. Patent Act of 1790 § 1.

82. See P.J. Federico, *Operation of the Patent Act of 1790*, 18 J. PAT. OFF. SOC'Y 237, 244 (1936) (stating that three patents were issued in 1790, thirty-three in 1791, eleven in 1792, and ten in 1793 before the second patent act was approved).

83. See WALTERSCHEID, *supra* note 76, at 195–96 (“[O]nly seven months after the Act of 1790 had been passed, the House appointed a committee to bring in a bill or bills to amend it.”).

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

85. See Patent Act of 1793 § 1 (requiring petition only to the Secretary of State and allowing certification by the Secretary of State if the petition conforms with requirements of the Act). The 1793 Act also adjusted the 1790 Act's rules for patentability, liability, and litigation defenses in several respects. See WALTERSCHEID, *supra* note 76, at 223–31 (explaining numerous changes, including adding compositions of matter as patentable subject matter, limiting access to the patent system to U.S. citizens, liberalizing model requirements, reducing patentees' ability to sue, and changing how damages for infringement were calculated).

mounting criticism over its lifetime, particularly in its later years, as ever-larger numbers of unvetted 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. The 1790 version (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.”<sup>86</sup> 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.”<sup>87</sup> Failure had the following, somewhat confusingly described consequences:

[I]f 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.<sup>88</sup>

The 1793 version (renumbered as Section 10) hardly differed. The one-year period for challenging a patent was lengthened to three years, and the necessary allegation was slightly rephrased to read “surreptitiously, or upon false suggestion.”<sup>89</sup>

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86. Patent Act of 1790 § 5. In full, the relevant section of the 1790 Act reads 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.

*Id.*

87. *Id.*

88. *Id.*

89. Patent Act of 1793 § 10. Section 10 of the 1793 Act reads 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

What did this language mean? Candidly, it was not clear to many, either at the time of enactment or afterward.<sup>90</sup> The legislative histories of the two acts are quiet on the motivation for the repeal provisions,<sup>91</sup> with two instructive exceptions. First, in early patent bills of 1789 and 1790, 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.”<sup>92</sup> 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.”<sup>93</sup> This note strongly suggests that the American repeal provision was consciously 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.<sup>94</sup>

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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.

*Id.*

90. See *infra* Section II.D.

91. See *Proceedings in Congress During the Years 1789 and 1790, Relating to the First Patent and Copyright Laws*, 22 J. PAT. OFF. SOC'Y 243 (1940) [hereinafter *Proceedings I*] (no discussion of repeal); *Proceedings in Congress During the Years 1789 and 1790, Relating to the First Patent and Copyright Laws*, 22 J. PAT. OFF. SOC'Y 352, 363 (1940) [hereinafter *Proceedings II*] (noting only that “any Person may sue out a Scire Facias to repeal the Patent for false Suggestions”); see also WALTERSCHEID, *supra* note 76, at 109–222 (no discussion of repeal).

92. Copyrights and Patents Bill, H.R. 10, 1st Cong. (1789), reprinted in 4 DOCUMENTARY HISTORY OF THE FIRST FEDERAL CONGRESS OF THE UNITED STATES OF AMERICA, LEGISLATIVE HISTORIES 513, 518 (Charlene Bangs Bickford & Helen E. Veit eds., 1986) [hereinafter LEGISLATIVE HISTORIES]; Patents Bill, H.R. 41, 1st Cong. § 4 (1790), reprinted in 6 LEGISLATIVE HISTORIES, *supra*, at 1626, 1630. This language was dropped when the repeal provision was removed from the section on infringement liability and given a section of its own. See Patents Bill, H.R. 41, 1st Cong. § 5 (1790), reprinted in 6 LEGISLATIVE HISTORIES, *supra*, at 1632, 1636.

93. S. REP. ON PATENTS BILL, 1ST CONG. (Mar. 29, 1790), reprinted in *Proceedings II*, *supra* note 91, at 362, 363.

94. One cannot assume that the drafters of American patent legislation had direct 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 76, at 92–94, 104 (“[T]he bill envisages a registration system similar to that of the English.”).

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 judge, with no connection to either the patent board or the State Department, where patent records were housed.

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 more puzzling features of statutory revocation—and at the same time one of the most useful clues as to its function. The puzzle is this: If a wrongful patent was prejudicial to the public, then why should the public's opportunity for challenge be so fleeting rather than being available throughout the life of the patent? One possible purpose was practical and prudential: to give the patentee eventual security against harassing repeal suits. The 1790 Act awarded costs against unsuccessful plaintiffs, almost certainly reflecting that concern.<sup>95</sup>

In the context of the 1790 Act's institutional design, though, it may be best to view time-limited repeal as an integral part of the administrative patent-granting process. *Pre*-grant opposition was an established notion, used in England<sup>96</sup> and originally included in American patent bills, although it was ultimately removed from the 1790 legislation and replaced with examination by the patent board.<sup>97</sup> Senate amendments similarly deleted measures requiring that patent applications be publicly advertised. That left *post*-grant repeal as the only way to register opposition to a grant and the only way to generate public information about the validity of the claim—information that was all the more valuable given that the three-man patent board by itself had limited ability to discover the state of the art in any given

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95. See Patent Act of 1790, ch. 7, § 5, 1 Stat. 109, 111 (repealed 1793) (“[I]f 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.”).

96. 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, *supra* note 37, at 53–54 (“A caveat was a form submitted to a particular office requesting that the holder be given notice of any patent petition that passed through which was applicable to an area of interest as defined by the caveat.”).

97. See WALTERSCHEID, *supra* note 76, at 135–36 (explaining that the Senate removed the caveat process and the right of appeal to referees from the bill originally passed in the House).

technology. Post-grant opposition within one year offered an inbuilt form of error correction for the examination process.

From a modern perspective on the separation of powers, it may seem strange to describe a judicial proceeding as part of the patent administration. But the government of the early Republic generally, and Congress's designs for the patent system 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.<sup>98</sup> In legislating patent matters, Congress similarly considered a variety of roles for the courts. The first patent bills of 1789 and 1790 envisaged pre-grant opposition being handled by two Supreme Court justices; other proposals called for conflicting applications to go to juries.<sup>99</sup> Congress later gravitated toward a hearing before the Secretary of State and a board of appointed arbitrators.<sup>100</sup> Before the adoption of the 1793 Act, some in Congress advocated having the federal district courts themselves issue patents.<sup>101</sup> 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 use of the term is a much-debated question.<sup>102</sup> Injuries to the public at large, such as public nuisances, were judicially cognizable.<sup>103</sup> Such harms may have been a suitable analogy for the "prejudic[e] . . . to the community" recognized in the legislative history

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98. See James E. Pfander & Daniel D. Birk, *Article III Judicial Power, the Adverse-Party Requirement, and Non-Contentious Jurisdiction*, 124 YALE L.J. 1346, 1361–65 (2015) (explaining that the first naturalization act in 1790 granted federal courts the power to hear naturalization petitions and that beginning in 1792, federal courts were assigned responsibility for hearing pension claims from disabled veterans).

99. See WALTERSCHEID, *supra* note 76, at 100–103, 129, 133–36.

100. See *id.*

101. See *id.* at 219 ("Rep. Murray . . . presented a rather impassioned plea that a citizen should be permitted to obtain a patent from the judge of the district in which he or she resided.")

102. See, e.g., 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); Ann Woolhandler & Caleb Nelson, *Does History Defeat Standing Doctrine?*, 102 MICH. L. REV. 689 (2004).

103. See Woolhandler & Nelson, *supra* note 102, at 701–02 ("Public authorities could get courts involved in suppressing . . . nuisances.")

of the 1790 Act.<sup>104</sup> 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.<sup>105</sup> English *scire facias*, as an action in the name of the Crown, was consistent with that approach. Revocation under the 1790 Act was not.

Instead, statutory revocation fits with a different “public” 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.<sup>106</sup> Blackstone termed such suits, including *qui tam* proceedings, “popular actions, because they are given to the people in general.”<sup>107</sup> Early congresses applied informer suits to customs enforcement, prohibitions on slave trading, and other areas where private information could be mobilized to aid the functioning of government.<sup>108</sup> To the extent that revocation suits were a tool for injecting private information into the patent system, universal standing could be understood as a constitutionally unproblematic part of the regulatory scheme.<sup>109</sup>

### B. *The Design of Patent Repeal*

America’s patent repeal was an innovation, customized both for a specific new patent regime and for the new nation’s loose and decentralized judicial-administrative framework. English antecedents provided only a partial model. As a matter of institutional design, statutory repeal seems to 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 1790 and 1793

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104. See *supra* note 92 and accompanying text.

105. See Woolhandler & Nelson, *supra* note 102, at 701–02 (“When the maintenance of a public nuisance caused a particular individual to sustain special damage . . . he could bring an action at law against the person responsible for the nuisance.” (internal quotation marks omitted)).

106. See Winter, *supra* note 102, at 1406–07 (describing early American statutes that provided “a common mechanism to regulate, by judicial sanction, governmental officials where there was likely to be no aggrieved party with a private cause of action”).

107. 3 BLACKSTONE, *supra* note 33, at \*161.

108. See Winter, *supra* note 102, at 1406–07 (citing statutes of 1789 and 1794) (“The Framers, in their roles as members of the first Congress, passed legislation both creating and facilitating informers’ suits.”).

109. See *id.* at 1407–08 (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”).

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 Act of 1790 and the Act of 1793 were silent on whether patentees facing revocation would receive a jury trial. The only stage of proceedings explicitly outlined in the statutes was the show-cause hearing before the district judge, which ended in a decree to make the rule “absolute.”<sup>110</sup> What followed was described only as “process . . . to repeal such patent.”<sup>111</sup> 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, questioned how repeal would work as litigation.<sup>112</sup> While corresponding with Hugh Williamson, 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.”<sup>113</sup> 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.<sup>114</sup>

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 against those who invade his right.”<sup>115</sup> 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.<sup>116</sup> The first step, if a judge thought the matter “sufficient,” was an order to the patentee to show cause why

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110. Patent Act of 1790, ch. 7, § 5, 1 Stat. 109, 111 (repealed 1793).

111. *Id.*

112. As a member of the patent board, Jefferson took a close interest in the 1793 Act, although he was not himself one of its authors. WALTERSCHEID, *supra* note 76, at 196–205.

113. Letter from Thomas Jefferson to Hugh Williamson (Nov. 13, 1791), in 22 THE PAPERS OF THOMAS JEFFERSON 295 (Charles T. Cullen ed., 1986).

114. *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.

115. *Id.*

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

process should not issue to repeal the patent.<sup>117</sup> If no sufficient cause were shown, the rule should be “made absolute” and “the said judge shall order process to be issued as aforesaid, against such patentee.”<sup>118</sup> 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 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.<sup>119</sup>

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.”<sup>120</sup> 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?<sup>121</sup>

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.

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 first and true inventor or

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117. Patent Act of 1790, ch. 7, § 5, 1 Stat. 109, 111 (repealed 1793).

118. *Id.*

119. *See infra* Section II.E.

120. Patent Act of 1790 § 5.

121. 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).

discoverer.”<sup>122</sup> 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.

### C. 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*, decided in Philadelphia in 1804.<sup>123</sup> Only five more reported cases took place before 1810.<sup>124</sup> Reporting in those days was rare, though, and the lack of earlier published cases does 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.<sup>125</sup> There is indirect evidence that litigation took place even before the 1793 Act: Congress passed a supplemental Patent Act in 1794 that restored any cases that had been “set aside, suspended or abated” by the repeal of the 1790 statute.<sup>126</sup> Historians have long noted that this would have been unnecessary if there had been no suits pending in 1793.<sup>127</sup>

It turns out that the history of patent repeal can bring light to 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.<sup>128</sup> *Jenkins v.*

122. Patent Act of 1790 § 5; Patent Act of 1793, ch. 11, § 10, 1 Stat. 318, 323 (emphasis added).  
123. 20 F. Cas. 555 (C.C.D. Pa. 1804).

124. WALTERSCHEID, *supra* note 76, at 362 (“When the Act of 1793 repealed the Act of 1790 there were apparently patent actions pending before the federal district courts.”).

125. DENISON OLMSTED, MEMOIR OF ELI WHITNEY, ESQ. 26–27 (New Haven, Conn., Durrie & Peck 1846) (quoting letter of Whitney's associate describing the 1797 suit as their “first”). Whitney is said to have filed twenty-seven infringement suits in total. D.A. TOMPKINS, THE COTTON GIN: THE HISTORY OF ITS INVENTION (1901).

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

127. *See, e.g.*, WALTERSCHEID, *supra* note 76, at 333–34.

128. 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 revocation suit's proceedings in a biography of New York's first federal district judge. EDWARD PORTER ALEXANDER, A REVOLUTIONARY CONSERVATIVE: JAMES DUANE OF NEW YORK 207 (1938). Zorina Khan has already

*Folger* was commenced in the U.S. District Court for the District of New York on May 26, 1792.<sup>129</sup> 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.<sup>130</sup>

The circumstances of the case suggest a lucrative invention caught in an intra-industry dispute. Benjamin Folger, the patentee, was a merchant and a cofounder 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.<sup>131</sup> Folger and his fellow transplants brought Nantucket's whale-oil-fueled wealth with them and quickly established a thriving maritime center.<sup>132</sup> 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 “[h]is business is to obtain a Patent for Mr. Benjamin Folger, for securing an important discovery he hath made in manufacturing Whale Oil” and that Jenkins was “fully convinced that the discovery is entirely new, and a very important one, and that it will prove highly beneficial to the United States.”<sup>133</sup> 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.<sup>134</sup> Folger estimated that the method added five hundred pounds, or

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offered *Jenkins v. Folger* as the first recorded patent case, based on its having been mentioned in a later treatise. B. Zorina Khan, *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.

129. *Jenkins v. Folger* (D.N.Y. 1792), *microformed on* Minutes and Rolls of Attorneys of the U.S. District Court for the Southern District of New York 1789–1841, at 116 (National Archives, New York City, N.Y.).

130. U.S. PATENT OFFICE, A LIST OF PATENTS GRANTED BY THE UNITED STATES FROM APRIL 10, 1790, TO DECEMBER 31, 1836, at 4–6 (Washington 1872).

131. STEPHEN B. MILLER, HISTORICAL SKETCHES OF HUDSON 6 (Hudson, N.Y., Bryan & Webb Printers 1862).

132. *Id.* 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).

133. Letter from Seth Jenkins to Thomas Jefferson (Nov. 7, 1791), *in* 22 THE PAPERS OF THOMAS JEFFERSON, *supra* note 113, at 264.

134. Letter from Benjamin Folger to the Secretary (Nov. 29, 1791), *in* 1 TRANSACTIONS OF THE SOCIETY FOR THE PROMOTION OF USEFUL ARTS, IN THE STATE OF NEW-YORK 363, 363–64 (Albany, N.Y., Charles R. & George Webster 1801).

approximately twenty percent, to the profits of a whaling voyage.<sup>135</sup> On January 2, 1792, a few weeks after his petition reached Jefferson, Folger received his patent.<sup>136</sup>

The plaintiff in *Jenkins v. Folger*, commenced in May of that year, was Jonathan Jenkins of Nantucket.<sup>137</sup> As recorded in the minutes of the U.S. District Court for the District of New York, Jenkins's counsel began the case by reading Jenkins's affirmation that "the said Patent was obtained upon a false suggestion" and then moved that Folger be ordered to show cause why his patent should not be repealed.<sup>138</sup> 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.<sup>139</sup> Whether Jenkins had his own claim to the invention or knowledge of earlier use is unknown. Three months after the proceeding commenced, 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."<sup>140</sup> The following day, District Judge James Duane ordered that the rule "be made absolute and . . . that process issue to repeal the patent."<sup>141</sup> 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 both that Judge Duane's decision making the rule "absolute" had *not* revoked the patent and 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."<sup>142</sup> Folger counterpetitioned the following month.<sup>143</sup> The House referred both petitions to a committee headed by a

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135. *Id.* at 364.

136. U.S. PATENT OFFICE, *supra* note 130, at 6.

137. 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 Jenkinsons and Folgers in this period.

138. *Jenkins v. Folger* (D.N.Y. 1792), *microformed on* Minutes and Rolls of Attorneys of the U.S. District Court for the Southern District of New York 1789–1841 at 116 (National Archives, New York City, N.Y.).

139. *See id.*

140. *Id.* at 117.

141. *Id.* at 118.

142. H. JOURNAL, 3rd Cong., 1st Sess. 98 (1794).

143. *Id.* at 125.

Nantucket representative, Peleg Coffin,<sup>144</sup> which reported in short order.<sup>145</sup> The House then resolved

[t]hat 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].<sup>146</sup>

Coffin's committee was directed to prepare legislation to that end.<sup>147</sup> Five days later, the committee presented what would become the Act of 1794 to restore all cases interrupted in 1793—leaving little doubt that this legislation was the product of Jenkins and Folger's suit.<sup>148</sup> For all that effort, there is no sign that Jenkins or 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.

#### D. The Uses of Patent Repeal

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

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144. *Id.* at 98, 132. The other two members of the committee were another Massachusetts man and a Marylander.

145. *Id.* at 132.

146. *Id.* at 135.

147. *Id.*

148. *Id.* at 138. The remaining legislative progress of the 1794 Act appears in the following congressional journal entries: *Id.* at 197–99, 208–09, 211–12; S. JOURNAL, 3rd Cong., 1st Sess. 102, 109.

circulation.<sup>149</sup> There was no American treatise until Thomas Fessenden's *Essay on the Law of Patents* in 1810, which primarily described English law.<sup>150</sup> Justice Story used to say that when he 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.<sup>151</sup>

The law of repeal 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 occurring before 1806 have yet come to light in the archives. Fessenden, the treatise writer, knew of only one repeal suit: *Perkins v. Odiorne*, begun in Boston at the end of 1809.<sup>152</sup> 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 no American precedents, applicable to this case."<sup>153</sup> A decade later, one judge declared that

[t]he 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.<sup>154</sup>

Between the 1810s and the end of repeal in 1836, litigants and judges moved to fill this vacuum. As the examples that follow demonstrate, 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 (the term now used for deliberate deception in patent prosecution), plaintiffs shaped it into two different roles: as a kind of suit for declaratory judgment of invalidity and as a species of derivation hearing between an inventor and an alleged plagiarist.

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149. WALTERSCHEID, *supra* note 76, 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").

150. FESSENDEN, *supra* note 32.

151. JOSEPH STORY, 1 LIFE AND LETTERS OF JOSEPH STORY 237 (William Wetmore Story ed., Boston, Little & Brown 1851). The date of Justice Story's first patent case is unknown, but he became a judge in 1811.

152. FESSENDEN, *supra* note 32, at 175.

153. *Id.* at 176. Due to the dearth of American authority, Fessenden reproduced a summary of *scire facias* from an English digest. *Id.* at 179–81.

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

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.<sup>155</sup> “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.<sup>156</sup> Section 10 offered a way for patentees and patent applicants to knock out conflicting grants after they issued. The earliest case (after *Jenkins v. Folger*) thus far located in the archives took this form.<sup>157</sup> 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.<sup>158</sup> 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.<sup>159</sup> Wood sued on multiple occasions to repeal later patents that he thought intruded on his rights.<sup>160</sup> 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.<sup>161</sup>

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 “surreptitious[ness] or . . . false suggestion,”<sup>162</sup> only a subset of repeal suits alleged deliberate copying of an earlier inventor’s work. Samuel Stone of Vermont sought repeal

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155. 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”).

156. Patent Act of 1793, ch. 11, § 9, 1 Stat. 318–23 (repealed 1836).

157. *Lamb v. Youle* (D.N.Y. 1806), *microformed on* M965, roll 2 (National Archives, New York City, N.Y.).

158. Affidavit of John Gove, *Lamb v. Youle* (D.N.Y. 1806).

159. See FRANK GILBERT, JETHRO WOOD, INVENTOR OF THE MODERN PLOW 50–51 (Chicago, Rhodes & McClure 1882) (noting that Jethro Wood “very nearly exhausted all his property in unavailing endeavors to establish through the courts his rights as inventor and patentee”).

160. *Ex Parte Wood*, 22 U.S. 603 (1824) (appeal resulting from Wood’s suit to repeal the 1820 plough patent of Charles Wood and Gilbert Brundage); *Wood v. Dutcher* (S.D.N.Y. 1824), *microformed on* M965, roll 2 (National Archives, New York City, N.Y.) (challenge to Dutcher’s plough patent of 1822).

161. *Delano v. Scott*, 7 F. Cas. 378, 382 (E.D. Pa. 1835) (No. 3,753); *Delano v. Gaylor*, (S.D.N.Y. 1833), *microformed on* M965, roll 2 (National Archives, New York City, N.Y.).

162. Patent Act of 1793, ch. 11, § 10, 1 Stat. 318, 323 (repealed 1836); see also Patent Act of 1790, ch. 7, § 5, 1 Stat. 109, 111 (repealed 1793).

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.<sup>163</sup> 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.<sup>164</sup> 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.<sup>165</sup> 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.<sup>166</sup>

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.<sup>167</sup> Hanrahan alleged only that "the same was known by others" before Mott's purported discovery—essentially the traditional defense of invalidity by anticipation but imported into the repeal action.<sup>168</sup> 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 or discoverers."<sup>169</sup> Likewise, hearings on

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163. Complaint of Samuel Stone (filed Apr. 10, 1811), *Stone v. Olds* (D. Mass. 1811) (unreported case available at National Archives, Boston, Mass.).

164. Affidavits of Jacob Gerhart and Hezekiah Kelley, *Kelley v. Rapp* (S.D.N.Y. 1816), *microformed on* M965, roll 2 (National Archives, New York City, N.Y.). 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, at 18 (Washington, D.C., self-published 1823).

165. *Stearns v. Barrett* (D. Mass. 1814–16) (unreported case available at National Archives, Boston, Mass.). Stearns received his patent in 1806. Barrett, after initially letting his application lapse, obtained a patent in 1809. See *id.* at Exhibits E, F, G, and K.

166. Depositions of Hugh Thompson, Robert Emes, Mesach Shattuck & George Barrett, *Stearns v. Barrett* (D. Mass. 1814–16).

167. Petition of James Hanrahan for Repeal of Patent to Jordan L. Mott, March 3, 1835, *Hanrahan v. Mott* (S.D.N.Y. 1835), *microformed on* M965, roll 2 (National Archives, New York City, N.Y.).

168. *Id.* at 3; see also 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").

169. *Thompson v. Haight*, 1 U.S.L.J. 563, 564 (S.D.N.Y. 1822).

repeal investigated “the alleged originality of the manufacture . . . with much labour and assiduity.”<sup>170</sup> Judges apparently embraced the theory that a sworn patent application for a non-novel invention by itself sufficed for “false suggestion.”<sup>171</sup> 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.<sup>172</sup>

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,<sup>173</sup> 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.<sup>174</sup>

The fullest explanation of this climate came from William P. Van Ness, district judge of the Southern District of New York in the 1810s and 1820s.<sup>175</sup> Van Ness was a well-connected jurist, active in Democratic-Republican politics, who in his younger years had served as

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170. *Id.* at 1041; *see also* *Morris v. Huntington*, 17 F. Cas. 818, 820 (C.C.S.D.N.Y. 1824) (No. 9,831) (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” and noting that “[t]he same remarks are applicable to the 10th section”).

171. *Thompson*, 1 U.S.L.J. at 1046–47.

172. *Law Case—On a Patent*, NILES’ WKLY. REG., Oct. 25, 1834, at 122–23 (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, on 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 *Falconer v. Clark* (S.D.N.Y. 1833–34), *microformed on* M965, roll 2 (National Archives, New York City, N.Y.).

173. 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, 35 (1934) (“[O]n June 14, 1934, President Roosevelt signed the [Federal Declaratory Judgments] Act.”).

174. *See, e.g., Thompson*, 1 U.S.L.J. at 564 (claiming that “[t]he very great, and very alarming, facility, with which patents are procured, is producing evils of great magnitude”); *see also* *Delano v. Scott*, 7 F. Cas. 378, 382 (E.D. Pa. 1835) (No. 3,753) (noting that, unless the patent came before a court, a patentee under the 1793 Act could “avoid all examination of his right, and he may go on imposing upon the ignorant or timid, and lay his unjust contributions upon them”).

175. PEYTON F. MILLER, A GROUP OF GREAT LAWYERS OF COLUMBIA COUNTY, NEW YORK 133–34 (1904).

Aaron Burr's second in the duel that killed Alexander Hamilton.<sup>176</sup> 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 1822 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 peculations of imposters, and the arrogant pretensions of vain and fraudulent projectors."<sup>177</sup>

Like many critics of the patent system in the years before the 1836 Patent Act,<sup>178</sup> 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."<sup>179</sup> With the same breath, he explained that any patent used before the date of application was "obtained surreptitiously and upon false suggestion."<sup>180</sup> If the law would not screen patents for novelty before issue, Van Ness reasoned, then a repeal action could do it afterward.<sup>181</sup> In his view, "[t]hat 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."<sup>182</sup> 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.<sup>183</sup>

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176. See LIN-MANUEL MIRANDA, *The World Was Wide Enough*, on 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!"); see also MILLER, *supra* note 175, at 133–35 (describing William P. Van Ness's connections with Aaron Burr).

177. *Thompson*, 1 U.S.L.J. at 564.

178. See Steven Lubar, *The Transformation of Antebellum Patent Law*, 32 *TECH. & CULTURE* 932, 936–42 (1991) (explaining various criticisms of the early patent system, including those of Justice Story, who "often [found] that patents were insufficiently useful or not genuinely inventive").

179. *Thompson*, 1 U.S.L.J. at 566.

180. *Id.* at 578.

181. *Id.*

182. *McGaw v. Bryan*, 16 F. Cas. 96, 99 (S.D.N.Y. 1821) (No. 8,793).

183. *Id.*:

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 76, at 101–03, 219 (discussing the process for the administrative office to refer the matter to two Supreme Court justices if a petition opposing a patent has merit and remarking on a proposal which would have allowed citizens to obtain patents from district court judges).

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.”<sup>184</sup> 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.<sup>185</sup> In doing so, Hopkinson characterized Section 10 as a weapon against spurious patent assertion:

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.<sup>186</sup>

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, though ultimately sidestepped, by *Oil States*: whether patent revocation required a jury trial.

### *E. 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.<sup>187</sup> 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.<sup>188</sup> In that sense, summary repeal may not ultimately have been good law. But it

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184. Unpublished Opinion of Samuel A. Betts (1834), *Falconer v. Clark* (S.D.N.Y. 1833–34), microformed on M965, roll 2 (National Archives, New York City, N.Y.).

185. See *Delano v. Scott*, 7 F. Cas. 378, 383 (E.D. Pa. 1835) (No. 3,753) (explaining that Judge Hopkinson had previously charged the jury that “[t]he mere fact that the patentee was not the original 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”).

186. *Id.* at 382.

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

188. *Id.*

persisted for years as the peak manifestation of revocation practice before being struck down.

To step back for a moment: the nature of the process for repealing a patent under the Acts of 1790 and 1793 was initially unclear. Nothing in the patent acts explicitly authorized actions for *scire facias*, as practiced in England.<sup>189</sup> 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.<sup>190</sup> But there were also stark differences, such as the lack of need for government permission and the one- or three-year time limit on challenges.<sup>191</sup> 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 proceed to trial before a jury? Or was the subsequent “process . . . to repeal such patent”<sup>192</sup> merely a judicial order of revocation, needing only to be executed as a ministerial matter?

One early organic development was that some parties, in their pleadings, began to refer to statutory repeal actions as *scire facias* suits.<sup>193</sup> In the period before usable precedent had emerged regarding Section 10, American lawyers may have found it easiest to behave as though the 1793 Act authorized the English writ, despite its quite different design.

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 and resolved by the district judge alone after the hearing to show cause.<sup>194</sup> 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.”<sup>195</sup> Eventually, “[a]fter considerable hesitation,” he concluded that “the process, to be awarded upon making the rule

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189. Patent Act of 1793, ch. 11, § 10, 1 Stat. 318, 323 (repealed 1836); Patent Act of 1790, ch. 7, § 5, 1 Stat. 109, 111 (repealed 1793).

190. Patent Act of 1793 § 10.

191. *Id.*

192. *Id.*

193. See, e.g., *Cutter v. Reed* (D. Mass. 1811) (unreported case available at National Archives, Boston, Mass.) (“In the action and process of the United States, upon the motion and Complaint of William Francis Cutter, Plaintiffs in scire facias, against John Reed and Thomas Odiorne, Defendants.”).

194. *Stearns v. Barrett*, 22 F. Cas. 1175, 1177 (C.C.D. Mass. 1816) (No. 13,337).

195. *Id.* at 1178.

absolute, is not a final process, but a judicial writ in the nature of a *scire facias* at the common law.”<sup>196</sup> 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.”<sup>197</sup>

Because Story’s was the only opinion on patent repeal published in the 1810s, some contemporaries were<sup>198</sup>—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 squarely rejected *Stearns*. As we have seen, Story’s attempt to restrict revocation actions to cases involving fraud alone was widely ignored.<sup>199</sup> And five years later, New York 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.<sup>200</sup> Van Ness reported having invalidated “several” patents in this fashion in recent years.<sup>201</sup> 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.”<sup>202</sup>

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,”<sup>203</sup> Van Ness stressed above all the

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196. *Id.* at 1179.

197. *Id.* at 1180–81.

198. *See, e.g.*, FESSENDEN, *supra* note 32, at 303–25 (Boston, Charles Ewer, 2d ed. 1822) (reprinting *Stearns* as the sole U.S. authority on the nature of the repeal provision).

199. Justice Story’s hometown district court in Boston—over which Justice Story had direct review—presumably remained strict. This may account for the fact that no revocation cases appear in that court’s archived case files after 1826, while the number in New York and Philadelphia climbed. A list of the revocation suits filed in the District of Massachusetts from 1811 through 1826, compiled by the author from an index of cases held at the National Archives in Boston, is on file with the author.

200. *McGaw v. Bryan*, 16 F. Cas. 96, 97 (S.D.N.Y. 1821) (No. 8,793).

201. *Id.*

202. *Id.* 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.

203. *Id.* at 97.

United States' break from England's patent regime. English patents were grants of favor from the Crown; American patents were pure "creatures of the statute."<sup>204</sup> 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,'" the American patent statute "contain[ed] no direct reference whatever, to the common law."<sup>205</sup> Elements of the English system not adopted "must be presumed to have been discarded."<sup>206</sup> Van Ness emphasized that 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."<sup>207</sup>

Van Ness was not alone in this opinion. In *Evans v. Eaton*, an infringement suit decided in 1822, Justice Henry Brockholst Livingston of the Supreme Court distinguished the summary repeal proceeding provided by Section 10 from infringement suits, which he believed did require a jury verdict for invalidity:

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 a power is conferred on a court to vacate a patent without the intervention of a jury.<sup>208</sup>

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

Other courts took the same line. In Baltimore in 1817, Judge James Houston of the District of Maryland conducted a hearing on the notorious "winged gudgeon" patent of Michael Withers.<sup>209</sup> Newspaper

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204. *Id.* at 98.

205. *Id.* at 97.

206. *Id.* at 99.

207. *Id.*

208. *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356, 450–51 (Livingston, J., dissenting).

209. *Kirk v. Withers* (D. Md. 1816) (unreported case available at National Archives, Philadelphia, Pa.). Withers's 1813 patent was something of a poster-child for the vices of the no-examination era. The inventor and his assigns enforced it widely against mill owners, deliberately fostering the impression that the patent broadly covered a long-standing component of mill machinery. In response, William Thornton, the Superintendent of Patents, waged a public campaign against the patent, which he had issued himself (having no power to refuse an application under the 1793 Act). Thornton denounced Withers as an imposter and his patent as an invalid grant for a trivial variation on the prior art; Withers eventually sued him for libel. *See*

reporting described the hearing as a “proceeding . . . to vacate the patent in a summary way.”<sup>210</sup> Judge Houston ultimately declined to find the patent surreptitiously obtained, accepting Withers’s argument that his invention was only a narrow improvement and had not been anticipated.<sup>211</sup> But in doing so, he emphasized the difference between a regular validity trial and summary repeal under Section 10.<sup>212</sup> Judge Houston made it clear that he thought the patent invalid on other grounds, including lack of utility, but “that he could not, under the summary proceeding, decide on the point . . . that being in his opinion the proper province of a jury.”<sup>213</sup>

On this issue, Justice Story held the trump card. The death of Justice Livingston in 1823 robbed Judge Van Ness of a Democratic-Republican ally on the Supreme Court who had endorsed the summary view of patent repeal. One of Van Ness’s summary revocations was appealed to the Supreme Court the following year. In *Ex parte Wood and Brundage*, Story wrote for the Court in prohibiting Van Ness’s practice and enforcing a trial in actions for repeal.<sup>214</sup> 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.<sup>215</sup>

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.”<sup>216</sup> The resultant trial should follow the standard pattern of an English *scire facias* case: “[I]f the issue so joined

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Edward C. Walterscheid, *The Winged Gudgeon—An Early Patent Controversy*, 79 J. PAT. & TRADEMARK OFF. SOC’Y 533, 537–56 (1997).

210. *Winged Gudgeons*, NILES’ WKLY. REG., June 28, 1817, at 283, <https://babel.hathitrust.org/cgi/pt?id=pst.000055571159> [<https://perma.cc/WF6M-RPUB>].

211. *Id.*

212. *Id.*

213. *Id.*

214. 22 U.S. (9 Wheat.) 603, 614–15 (1824).

215. *Id.* at 608.

216. *Id.* at 614.

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.”<sup>217</sup> 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.

### 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 should instead try to understand more fully what was going on. In that spirit, I close with two brief observations about how the foregoing history might inform present constitutional inquiries, including those recently made in *Oil States*.<sup>218</sup>

*The “Clean Slate” Question.* One of the central issues raised by this account is the extent to which English antecedents matter. If we treat the American system of patent adjudication as fully continuous with prior English tradition, then various English practices have a tight grip on our constitutional understanding. For example, if we assume that the United States imported all English forms of patent adjudication—including *scire facias*—then the consistent use of juries in England supports a Seventh Amendment jury right on modern matters of patent validity in the United States. Likewise, Privy Council revocation can serve as a guide to the Framers’ expectations about executive prerogative in patent matters. As the *Oil States* Court explained, “Based on the practice of the Privy Council, it was well understood at the founding that a patent system could include . . . potential cancellation in the executive proceeding of the Privy Council.”<sup>219</sup> While the members of the Court differed on how to characterize English practice,<sup>220</sup> there is no doubt that they embraced the presumption of continuity and saw English law as their principal interpretive resource.

If, on the other hand, American patent law broke from some of the assumptions of English law, both monarchical and institutional,

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217. *Id.* at 615.

218. *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S.Ct. 1365 (2018).

219. *Id.* at 1377.

220. *See id.* at 1383 (Gorsuch, J., dissenting) (arguing that the historical record of Privy Council revocation does not support the Court’s holding).

then the applicability of such English arrangements fades. To be sure, Founding-era history offers a mixed picture of continuity and departure. English practice was a constant reference point, especially for the courts. Yet the larger structural departures were significant too. The process of issuing patents under both the 1790 and 1793 Acts was administratively quite different from the English regime. The conceptual starting point also differed. English patent law identified two points of origin: the royal grant, granted or revoked at the pleasure of the sovereign, and the Statute of Monopolies, which explicitly established that patents and their adjudication were governed by the common law.<sup>221</sup> United States patent law acknowledged neither of these foundations.

Seen in this light, the strong presumption of continuity between England and the United States is problematic. *Oil States* offers a particularly dubious example: the contention that the Framers *sub silentio* contemplated some power of “executive” cancellation as a counterpart to royal revocation.<sup>222</sup> The *Oil States* Court presumed that the Framers adopted English law unless they explicitly disavowed it, finding no “reason to think they excluded this practice [of Privy Council revocation] during their deliberations.”<sup>223</sup> Given the many differences between the English and early American patent laws, that seems to put the burden in the wrong place. And in any case, one could argue that there is such evidence. The Patent Act adopted by the first Congress in 1790—based on bills introduced only one year after the ratification of the Constitution<sup>224</sup>—had no counterpart to Privy Council revocation. Nor did American patents ever include the explicit defeasance clause, providing for Privy Council repeal, that every English patent carried in its text. The only form of revocation contemplated was statutory repeal by the district court.

That statute carries originalist weight of its own. Especially if the presumption of continuity with English law is relaxed, the Patent Act of 1790 becomes an important place to look when applying the Bill of Rights to patent questions. Where the amendments “preserve” the

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221. See English Statute of Monopolies 1623, 21 Jac. 1, c. 3, § 2 (Eng.) (“[A]ll 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.”).

222. *Oil States*, 138 S.Ct. at 1377.

223. *Id.*

224. See Copyrights and Patents Bill, H.R. 10, 1st Cong., (1789), reprinted in 4 DOCUMENTARY HISTORY, *supra* note 92, at 513. Ratification of the Constitution became effective on June 21, 1788. NCC Staff, *The Day the Constitution was Ratified*, NAT’L CONST. CTR.: CONST. DAILY (June 21, 2018), <https://constitutioncenter.org/blog/the-day-the-constitution-was-ratified> [<https://perma.cc/36LH-JD38>].

status quo at the time of ratification, the 1790 Act may even be dispositive. In that case, the Seventh Amendment jury right might not have applied to all matters of patent validity as of 1791; instead it would depend on the nature of the repeal process contemplated by the 1790 Act. Of course, the character of statutory repeal was itself a vexed question.

*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 be the constitutional significance of Founding-era patent law's unsettled meaning?

To take procedure first: if early American patent law had clearly guaranteed a right of jury trial in repeal cases—or, conversely, if the 1790 and 1793 Acts had explicitly created a summary judicial action to repeal patents—then that would be grist to the mill of the constitutional questions raised in *Oil States*. But instead the law 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, at least some parties and courts chose to behave as though the statutory action took the form of a *scire facias*.<sup>225</sup> Others, however, resisted the proposition or, in the case of New York's federal judges in the 1810s and 1820s, rejected it forcefully.<sup>226</sup> To be sure, there were hints in the 1790s that the acts contemplated a full trial to follow the initial repeal hearing.<sup>227</sup> But that point was unclear, allowing later courts to argue plausibly for a summary process. 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.<sup>228</sup> 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.

Other aspects of this history raise a different, more diffuse question: What does repeal tell us about the “nature” of a patent right? As ahistorical as it is to ascribe a fixed nature to patents, that task was directly before the *Oil States* Court. Petitioners contended that IPR fell afoul of Article III's constitutional prohibition on “withdraw[ing] from judicial cognizance any matter which, from its nature, is the subject of

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225. See *supra* text accompanying notes 193–197 (noting that, given a lack of guidance, both parties and courts tentatively relied upon *scire facias*).

226. See *supra* text accompanying notes 200–213 (arguing that the American repeal statute did not incorporate *scire facias*).

227. See *supra* text accompanying notes 113–115 (describing Thomas Jefferson's letter to Hugh Williamson) and text accompanying notes 141–142 (recounting the denouement of *Folger v. Jenkins*).

228. See *supra* text accompanying notes 214–217.

a suit at the common law, or in equity, or admiralty.”<sup>229</sup> Respondents and the government pointed to the exception for “public” rights that are integrally related to a federal statutory scheme.<sup>230</sup> As a result, the Article III question in *Oil States* turned on whether patent validity involved matters of “private” or “public” rights.<sup>231</sup> The Court chose the latter path by seizing on the long-standing idea, most closely associated with the mid-nineteenth century,<sup>232</sup> that a patent is a type of “franchise.”<sup>233</sup>

Although not used by the Court, the history of early American patent law could have provided more direct evidence of the public nature of the grant. Universal standing to seek repeal falls into this category. For any member of the public to have had standing to institute repeal, simply on the grounds that an 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 well be considered “integrated into a public regulatory scheme” for Article III purposes.<sup>234</sup>

And just what was that scheme, in the terms of its own time? This is the history that perhaps has the most potential to vindicate the conclusion of *Oil States*. The *Oil States* Court’s key determination was that IPR “involves the same basic matter as the grant of a patent,”<sup>235</sup> because it represents “a second look at an earlier administrative grant.”<sup>236</sup> In other words, there is no hard constitutional line between pre-grant and post-grant patents for the purposes of review and

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229. *Stern v. Marshall*, 564 U.S. 462, 484 (2011) (quoting *Murray’s Lessee v. Hoboken Land & Improvement Co.*, 59 U.S. (18 How.) 272, 284 (1855)).

230. *See id.* at 490–91 (“[W]hat 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) (noting that 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)).

231. *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 138 S. Ct. 1365, 1373–74 (2018).

232. *See, e.g.*, *Bloomer v. McQuewan*, 55 U.S. (14 How.) 539, 549 (1852) (“The franchise which the patent grants, consists altogether in the right to exclude every one from making, using, or vending the thing patented, without the permission of the patentee.”).

233. *Oil States*, 138 S. Ct. at 1373–74.

234. *Granfinanciera*, 492 U.S. at 54.

235. *Oil States*, 138 S. Ct. at 1374.

236. *Id.* (quoting *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016)).

repeal.<sup>237</sup> The history of early American patent law tends to support the point. Statutory repeal within one or three years was designed as an auxiliary to the granting process—a “second look,” in the words of the *Oil States* Court.<sup>238</sup> The majority’s elision of the difference between issuing patents and revoking them attracted stiff criticism from the *Oil States* dissenters,<sup>239</sup> but it is entirely consistent with early American practice.

Historical support for the general principle of post-grant review is only part of the story, though. Where the separation of powers is at issue, specific institutional choices matter. Here the history is cloudier. It is surely important that Congress made repeal a judicial affair: the executive itself was not given the power to claw back patents that it had issued. But the line between judicial and administrative functions was also not a bright one in the early patent system. The patent board under the 1790 Act 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 heavily 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.<sup>240</sup> 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.<sup>241</sup> 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

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237. See also *id.* at 1347 (“The primary distinction between inter partes review and the initial grant of a patent is that inter partes review occurs *after* the patent has issued. But that distinction does not make a difference here.”).

238. *Id.* at 1374.

239. See *id.* at 1385 (Gorsuch, J., dissenting) (“Just because you give a gift doesn’t mean you forever enjoy the right to reclaim it. And, as we’ve seen, just because the Executive could *issue* an invention (or land) patent did not mean the Executive could *revoke* it.”).

240. See *supra* text accompanying note 202.

241. *Ex parte Wood & Brundage*, 22 U.S. (9 Wheat.) 603, 608 (1824).

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 a historical matter, 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.