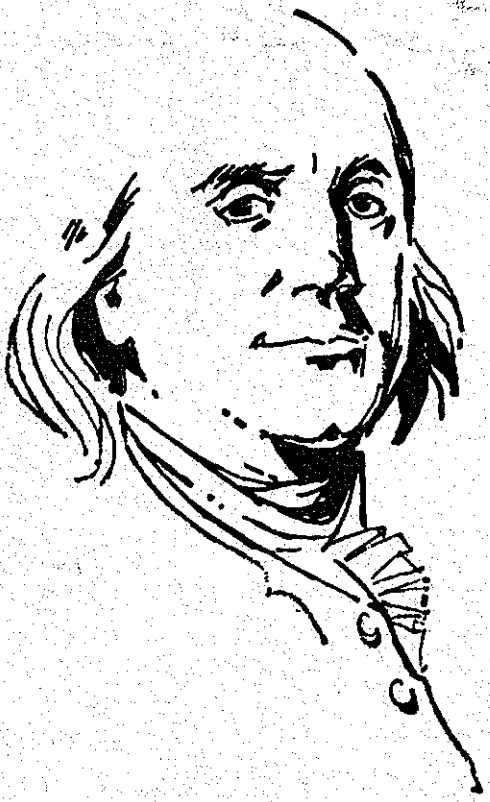

The Philadelphia Patent Law Association

Foreword

One of the basic provisions provided by the first Patent Act was the requirement that the inventor file a patent specification which would become a public document informing any interested person of the nature and character of the invention and how to apply it. Notwithstanding this provision requests made to the Patent Office for patent copies were originally regarded with suspicion and the Patent Office actually blocked efforts to obtain patent copies. The role of Philadelphia's Franklin Institute and "Philadelphia lawyers" in convincing government officials to provide patent copies upon request is preserved by correspondence obtained from the archives of The Franklin Institute.

MORE THAN thirty years passed after the Patent Act of 1790 before The Franklin Institute was founded in Philadelphia. On March 6 of 1824, Peter Browne, corresponding secretary of The Franklin Institute, addressed a letter to Dr. Thornton, the First Commissioner of Patents, informing him of the Institute and making the following request for patent copies:

> "A number of mechanic's and others of this City have associated themselves together for the purpose of diffusing scientific and useful information among that valuable class of the Community and particularly among the rising generation.
>
> "Their plan embraces an examination into and fair trials of all new inventions. It would therefore be highly useful to them to obtain the earliest and most accurate information relative to all patents taken out in Europe and this Country. With this object in view I have it in charge from the Managers to enquire from you the most favorable terms upon which we can obtain copies of all patents hereafter issued out of your office.

While matters remained in this state, Browne was shown a letter from William P. Elliott, a clerk in the Patent Office, to Edward Clark of Philadelphia, in which Elliott offered to supply, for publication purposes, copies of patents at eight cents per hundred words. The clerk further informed Clark "that Mr. Adams allowed him to make such copies, and that he was in the practice of furnishing them to a Mr. Little of Washington who publishes a similar journal." This discovery prompted Browne to again write to Dr. Thornton on January 7, 1825:

> "I have it in charge from 'The Franklin Institute of the State of Pennsylvania for the promotion of the Mechanic Arts' to enquire of you whether you still adhere to the opinion formerly communicated to me that you are under an 'honorary obligation' to withhold from us the copies of specifications of patents, until after the expiration of the term of exclusive privilege.
>
> "The occasion of troubling you again on this subject is that we entertain a hope that upon more mature reflection and especially after consulting with the Secretary of State you will have found reason to change that opinion."

Failing to receive an answer, Browne sent a stinging note to the head of the Patent Office, in which he inquired whether Dr. Thornton was "under no honorary obligation not to answer a gentleman's communication on public business relative to your office."

Dr. Thornton's reply on January 29, 1825, set forth an elaborate explanation of why he had not written sooner. It seems that Browne had not prepaid the postage on his letters and because Dr. Thornton did not have franking privileges the letters had been sent to the office of the Secretary of State before being forwarded to the Patent Office. Dr. Thornton reiterated his refusal to grant the copies requested:

> "I have referred to a copy of my letter to you of the 10th March last, which fully explains my ideas on the subject of your letters, except that I shall be at all times ready to grant

made the following appeal to the President for intervention on behalf of The Franklin Institute:

"For upwards of a year I have been endeavouring to obtain for The Franklin Institute of the State of Pennsylvania for the promotion of the 'mechanic arts' a highly respectable incorporated Society, to which I am Corresponding Secretary, the copies of the specifications of patents enrolled at Washington. These copies have been withheld by those who have the care of the patent office under various pretences. At first it was contended that there existed an honorary obligation to withhold copies of all specifications of unexpired patents unless they were required for some legal proceeding.

"That every Citizen of the United States is entitled ex debito justitiae, to a copy of a public record is a proposition of law which I believe no one but these officers ever devised: and I believe they have also been the first who have ventured to set up an honorary or supposed honorary obligation in derogation of the law of the land and the rights of the Citizens. But what renders their conduct still more reprehensible is their partiality; for at the very time that they were refusing these copies to this valuable society, to be used for the public good, they had granted them to others, and were in treaty to sell them to an individual for private emolument.

"In the month of January last, despairing of obtaining Justice from the patent officer, who would not even answer my letters, I addressed myself to you, Sir, as Secretary of State. Whether my letters ever reached you I am unable to say, as no answers were ever returned.

"After this appeal was made the patent officer changed his ground, and no longer contended for his supposed honorary obligation respected *all* specifications of unexpired patents not required for legal proceeding, but set up another distinction, unknown to the law, between these things which could and these which could not be used in secret.

patent for the improvements. But the Courts have decided that in making out my specification I must describe those parts of the machine that are old and those which are my new invention; but this is impossible to do without examining *A B's* specification. Shall I be denied a copy and thus be deprived of my right to patent my improvements?

"The X sec. of the act enacts, that a patent shall be declared void if made upon false suggestions. But how can anyone undertake to determine that a patentee has obtained his patent upon false suggestions if he is denied the privilege of examining those suggestions as contained in the specifications."

Browne further commented on the position taken by Dr. Thornton making a distinction between inventions which may and which may not be used in secret:

"Now Sir, where does Dr. Thornton find authority for making this distinction between inventions which may and which may not be used in secret? Have Congress made any such? Who is the Judge of what may be used in secret? What act of the Legislature of the Union has conferred on Dr. Thornton any such judicial powers? If he *has* the power it is unlimited, for any thing patented may be used in secret. In the case of Huddard v. Grimshaw, Davis's patent cases page 288, it was shown that cables were made in secret. The idea that the Franklin Institute wanted Specifications for making patent medicines is ridiculous enough; Dr. Thornton knew better. . . ."

Browne also commented on the partiality being imposed:

"If Dr. Thornton's position be the legal one, or even if it be an honorary one, which is binding in the case of any one citizen, it must be binding in all cases whatsoever. He cannot in that case grant one single copy without a breach of the law and of his honour. Now he has granted them in a variety of cases, but as one will prove my position as well as any number

it proper to furnish copies for a purpose thus expressly authorized by the law, I should find it equally proper to refuse them not only where there was reason to suspect or know to fear that the purpose might be fraudulent towards the Patentee, but where without such fraudulent purpose, the disclosure might be injurious to the fair interests of the Patentee, as in the case of Patent Medicines, put by the Superintendent. The 11th section, is, in my opinion so framed as to secure to the Patentee and those claiming under him the right to demand copies of papers connected with his patent *ex debito Justitiae;* and it is at the same time, in my opinion so framed as to refer it to the sound discretion of the department to what other persons, and on what other occasions such copies shall be furnished or refused: there being manifestly occasions on which such copies ought to be refused as in a case of meditated fraud, and as clearly occasions on which such copies ought to be furnished, as for the purpose of a defence expressly authorized by Law. The words of the proviso are not to be considered by themselves. They are not to be considered as they might be considered if they formed a separate and substantial enactment, instead of forming a proviso, they are not to be considered as they might be considered if they related to a different subject, to the proceedings of a Court of Justice, for example, all whose proceedings being open and public there is nothing of which justice to individuals can require the concealment construing the proviso *Secundium Subjectam Materiam* and in the form and connection in which it presents itself, I conceive that the only sound exposition is that which I have had the honour to submit."

Continuing the struggle in the face of these staggering odds, Institute members lost no time eliciting the help of two Philadelphia lawyers, Horace Binney and John Sergeant, who, after reviewing all of the facts presented the following rebuttal to Attorney General Wirt's line of reasoning:

Persons may want a copy to defend themselves from suit, by avoiding an infringement of the patent rights, as well as to defend themselves against a suit already instituted; they may want it to ascertain whether a suit ought not to be brought against a Patentee, for having violated a prior patent, or for having patented the invention of another surreptitiously."

American technological progress might never have reached its present day heights if the truth of the following statements had not been recognized:

"It is not the interest of a particular individual merely that is to be regarded in the interpretation of this law but also that of the public at large. The security of the Patentee is certainly one of the objects of the Act, but this security we apprehend does not lie in the concealment of his specification, nor was it the intention of Congress to promote it in this manner, but it is guarded by the treble damages awarded to him, and by these only, and as well for the purposes of scientific improvement, as for the protection of the public against the frauds of Patentees, it was intended by Congress and is we conceive essential to the due execution of the law that specifications should be open and accessible to all persons without discrimination.

"It must be acknowledged that under the Acts of Congress a Patent may be obtained by a third person for an improvement in the process of any composition of matter, and this, as is obvious from the second section of the Act of 1793 while the patent for the original composition of matter is in full force. How can this process be improved unless the patented process is accessible? It is moreover well settled that to make a Patent for such improvement valid, the Patentee must in his specifications distinguish it from the invention originally patented. But this may be and in general must be, impossible without access to the original specification. Then he has a right to a copy of it, as accessory to

that required by law of the payment at the rate of twenty cents for every copy sheet of one hundred words."

Two weeks later The Franklin Institute availed itself of its recognized right by requesting Dr. Thornton to furnish "a copy of the Specifications of a patent taken out by Messrs. Charles Cooper and Abm. Justin . . . for an improvement in making iron hoops for the wheels of carriages." Not knowing the length of the issued specification, Browne enclosed $5.00 with the request that the balance be remitted.

On October 4, 1825, the Department of State forwarded a copy of the requested patent noting that the charge was $1.00 and stating: "The five dollar bill you sent was offered at the bank for change, when it was pronounced a forgery. It is therefore, returned to you; if you will please to send the amount as soon as convenient." Browne responded on October 6, 1825, by reenclosing the same note with a certificate on the back subscribed by the Teller of the issuing bank that it was indeed genuine!

Science and industry owe a real debt to The Franklin Institute for its perseverance in obtaining this important decision.*

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*The interchange of knowledge made possible by the publication of patents was further promoted by the *Journal of The Franklin Institute* which was published by The Franklin Institute and contained data from time to time on patents, abstracts from the claims and comments supplied by the editors. 1976 marks the 150th anniversary of the *Journal* which is the oldest technical and scientific publication in the United States.

Interestingly, in 1828 Dr. Thomas P. Jones, the editor of the *Journal of The Franklin Institute,* was appointed Superintendent of the Patent Office succeeding Dr. William Thornton. When the Patent Office was reorganized in 1836 Dr. Jones became one of its two examiners, serving in this capacity until his retirement in December 1838.

This booklet was prepared by the Philadelphia Patent Law Association for distribution during the 1976 Bicentennial celebration in Philadelphia. The cooperation of The Franklin Institute in supplying copies of early correspondence referred to in the booklet is gratefully acknowledged.

his right of improving and also of patenting the improvement. This illustration might be much further extended. In regard to compositions of matter, patent medicines for instance, the protection of which seems to be particularly in view in refusing copies of these specifications, it is perfectly settled, that if the specification does not contain enough to produce the patented composition or contains more than enough, the patent is void, because the public are defrauded. If a specification is not accessible for the purpose of testing it, what is to prevent the patentee from enjoying his monopoly for 14 years, and giving the public nothing in return for it? He may make his specifications what he pleases, if it is not open to examination."*

The esteem with which Henry Clay held the opinion of Binney and Sergeant was such that he reconsidered the entire matter in light of their interpretation and on September 12, 1825, Clay dispatched the following letter to Browne:

"I have availed myself of the earliest opportunity of which circumstances would admit, since my return from Kentucky, to examine the law in regards to the right claimed by you in behalf of The Franklin Institute, to obtain copies from this office of the Specifications accompanying unexpired Patents. The result is a belief that I am authorized to direct the copies required to be furnished on application. They will accordingly be given whenever they shall be applied for by you in behalf of the Institute, with no other condition than

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*Binney and Sergeant also pointed to the publication practice in Great Britain.

". . . In Great Britain where this subject has been well considered, not only are all specifications, like all other Enrollments, open to the public, but there is one journal, 'The London Journal of Arts and Sciences' expressly devoted to the publication of *'all new Patents'* with a description of their respective principles and properties. In this Journal the specifications enrolled, are so far as material printed and circulated. . . ."

"The recognition of a universal right to copies of such specifications, is we think a matter of necessary implication from the Proviso to the first section. It admits that persons may *require* such copies — it implies that they may obtain them — and it interposes no condition but the payment of a certain fee. That some persons have the right, cannot be questioned, what is there in the terms of the Act, or in its *reason or spirit,* to confine the right to certain persons, or to make any officer of the government a *judge or tribunal* for ascertaining who those persons are?

* * * * * *

"The *reason and spirit* of the law are equally remote from confining the right to certain persons. We apprehend the design of these Acts is to give a monopoly for fourteen years, upon the condition of an immediate publication of the invention. The fullest disclosure is required as a condition precedent to the issuing of a patent; its fidelity in all respects is essential to the enjoyment of the patent; and there is not only no stipulation in the Act of secrecy or concealment, but the contrary is inferable from the public office in which all the papers are deposited or recorded, and is in our judgment essential to the due execution of the law, and therefore in coincidence with the intention of Congress. We are not aware to whom the right of copies can be confined, except either to the patentee or his assigns — persons in actual litigation with him or them, or such persons as the Secretary of State shall in his discretion approve. If not so limited, the rights must exist in all persons without discrimination.

"The Patentee and his assigns are as we have said, the last to want it, and it is certain, that the descriptions, specifications, explanations, and the record of the patent were not required for the benefit of the Patentee or of his assigns but of somebody else.

"Persons in actual litigation with the patentee or (sic, are) without doubt entitled — but there is nothing in the Act, which applies to such persons more than to others.

I will give you the following. He granted a copy of a patent to Frances Jones in 1822. My informant is Charles J. Ingersoll, Esquire of this City, who being called upon can prove it."

The next setback received would have been enough to discourage almost anyone else permanently from trying to obtain copies of issued patents. On April 10, 1825, Henry Clay sent a copy to Browne of an opinion rendered by William Wirt, the Attorney General, upholding the right of the Commissioner to restrict sale of copies of issued patents:

"I have considered the two questions which you have done me the honour to submit for my opinion on the 12 section of the patent law: and I do not consider the Proviso to this section as opening to all the Citizens of the United States indiscriminately, at their pleasure, and for any purpose that may suit them, the right to demand copies of papers respecting Patents granted to others. The Proviso considered with reference to the enactment which it was made to qualify and with reference also to the essential object of the whole law might well receive the strict construction which the superintendent of the Patent office has been disposed to place upon it, a construction which would limit the right to demand copies to the Patentee and those who should apply by his authority for such copies. The words, however, are susceptible without violence of a larger construction and they have been accordingly construed to extend to persons who have been sued for a violation of the Patent Right: The law itself (vide 6 sec) having expressly authorized such persons to defend themselves on the ground of the imperfection of the specification filed in the office by the Patentee was not the first inventor, to the purpose of either of which defences it seems but fair that the persons so sued should be furnished with copies of such specifications. To this construction so far as it concerns defendant in suits on Patent, I have heretofore given my official sanction, by an opinion which I presume is on file in the Department of State. But while I should hold

"Soon after the appointment of Mr. Clay to the Office of Secretary of State, with a view to bring this unpleasant business to a termination, I presented to that gentleman regular charges against the persons who conduct the patent office or are concerned therein. I send you a copy of these charges, with an additional one which has since come to my knowledge.

"Mr. Clay has not taken the slightest notice of my communication; from which I infer that my letters have not been permitted to reach his eye. I cannot persuade myself that the Secretary of State of this free Government will withhold from a citizen an answer to a respectful application; there is no precedent for this in the tyrannical governments of Europe.

"I have now Sir, determined to address myself to you, again. I feel assured that the Chief Magistrate of the United States will not suffer the acts of Congress to be set at naught and the privileges of a free people to be trampled upon by a public officer under his control."

No response was made by the President. However, in response to a letter from Henry Clay, Secretary of State, requesting additional information, Browne presented the following argument for making patent copies available:

"The invention for which the patent is acquired must be *new;* but can that be said to be new which is described in a former patent? Now suppose I have invented a machine and I am informed that it, or something like it, has been patented by *A B.* Cannot I obtain from the patent office a copy of the record of *A B's* specification to satisfy myself whether mine is new or not?

"Again, *A B* has invented a machine upon which I have made improvements; *he* has a right to enjoy his exclusive privilege of his machine, but I have a right to take out a

copies of such patents as cannot from their nature be practiced in secret; but patent medicines, or secrets that can be put into operation in such a manner as not easily to be detected. I cannot grant copies of except as before stated after they have expired, or if demanded by a Court of Justice, or with the consent of the patentee."

In the meantime Browne had tired of waiting and on January 29, 1825, wrote a letter directly to the then Secretary of State, John Quincy Adams, including copies of all of his correspondence with Dr. Thornton, requesting that Adams personally investigate the matter. In his letter Browne stated:

"You will perceive by the foregoing correspondence that I have been endeavoring to obtain for a very useful Society of this City, copies of Specifications of Patents as they are filed in the patent office and I think you will be surprised when you find that it is owing to a misconception of the patent law by Dr. Wm. Thornton that I have been obliged to make this appeal to you.

"As I flatter myself that you will entertain a different opinion of the Law, and as I am very sure you will take a pleasure in cooperating with its members in advancing the public's interest I am encouraged to request that you will permit the said copies to be furnished without charge.

"I enclose you a pamphlet which will give you the fullest information as to the respectability and objects of our institution, and take the liberty of referring to our member of Congress from the County, Samuel Breck, Esquire who is a member of the Institution, for any additional information."

This letter was never answered even though a second request was made for a response. Accordingly, in March of 1825 Browne again took up the cudgels on behalf of The Franklin Institute addressing a letter to Henry Clay, the new Secretary of State, and another letter to John Quincy Adams, who by that time had become President of the United States. After reviewing the circumstances of the case, Browne

"We do not want certified copies, but the most informal ones that can be taken, provided they are correct. As our object is intimately connected with the public good we have flattered ourselves that our infant institution, whose funds are yet low will be liberally treated by a gentleman of your known patriotism and public spirit and that you will furnish us with the required information upon as reasonable terms as possible."

This request was answered a few days later by Dr. Thornton advising Mr. Browne that in order to protect inventors copies of issued patents would not normally be provided until the patents expired:

"The law allows copies of Inventions, at the rate of twenty cents for every hundred words. — I have however considered myself in honor bound to protect the Inventor as much as I can, by allowing (unless in Law Suits where *required legally.*) no copies of their Inventions which could be used in secret until their Patents have expired: but anyone is at liberty to have copies of those which have expired, any that have not expired if the consent of the patentee be first obtained: Often a Person might be engaged to copy them at a more reasonable price than the Law allows. — Any facilities that depend on me will be granted with the utmost pleasure."

Convinced of the unsoundness of Thornton's position, Browne sent out a printed broadside to prospective members of The Franklin Institute, reporting on the progress of different projects and indicating: "With regard to the attempt to obtain copies of the patent specifications . . . I regret to say that owing to an opinion of Dr. Thornton's, (which is believed to be erroneous) that he is under an *honorary* obligation to the patentees to withhold the copies until after the expiration of the term of exclusive privilege, the Institution have not been able to obtain them. Congress have not yet been applied to on the subject, because it is hoped that Dr. Thornton, upon more mature reflection, and after advising with the Secretary of State, will render that measure unnecessary."