IDEA: The Journal of Law and Technology

1999

39 J.L. & TECH. 195

THE USE AND ABUSE OF HISTORY: THE SUPREME COURT'S INTERPRETATION OF THOMAS JEFFERSON'S INFLUENCE ON THE PATENT LAW

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I. Introduction

On a number of occasions, Justices of the Supreme Court have relied on the views of Thomas Jefferson as a means of explicating their interpretations of both the patent clause of the Constitution and various patent statutes. In so doing, these Justices have created a Jeffersonian mythology that, in a number of respects, is significantly at odds with the historical record. The Court has, in particular, overrated and over stressed Jefferson's ostensible influence on the early development and interpretation of the patent law through a selective use of the historical record.

II. Historical Methodology

The Supreme Court has long had a tradition of using extrinsic history n1 in its opinions. n2 A variety of rationales have been offered for

[*196] the Court's interest in - and some would even say that obsession with - extrinsic history. Professor Chemerinsky argues in the last decade or two the use of such history has been intended to place a constraint on judicial decision making and serves a strong ideological agenda. n3 As he puts it, "Justices want very much to make it appear that their decisions are not based on their personnel opinions, but instead are derived from an external source." n4

Burchfiel, in turn, suggests that the Court's use of extrinsic history comes about by analogy to its dominant emphasis on precedent. n5 In Burchfiel's view it is an easy transition from legal history involving prior decisions, litigation history, legislative history, etc., which is quite focused, to extrinsic history, which considerably widens the scope of inquiry. n6 The transition is particularly attractive to those Justices who find themselves in disagreement with judicial activism. n7 Yet, as I will seek to show here, reliance on a selective historical record can itself be a form of judicial activism by Justices who are either unhappy with existing legal precedent or who perceive a lack of adequate legal precedent for the position they desire to take. Indeed, constitutional historian Alfred Kelly has argued that "[t]he return to historically discovered 'original meaning' is . . . an almost perfect excuse for breaking precedent." n8

The reliance of the Court on extrinsic history has come under sharp attack. n9 This criticism is not so much because the use of extrinsic

[*197] history is considered bad per se, but rather, because extrinsic history is so often seen as incomplete, over selective, misleading, and biased. In short, rather than being a facially neutral resort to history, the use of extrinsic history too often is a form of advocacy. n10 In general, the critics strongly question the Court's historical methodology, n11 and Professor Chemerinsky and Burchfiel have both expressed strong reservations whether the citation of extrinsic history is an appropriate basis for the Court's legal and constitutional interpretations in view of the manifest defects commonly associated with such citation. n12 Professor Levy is perhaps bluntest of all when he states that "the Court has flunked history" n13 and that "[t]he Justices stand censured for abusing historical evidence in a way that reflects adversely on their intellectual rectitude as well as their historical competence." n14

As Professor Levy accurately reflects: "Judges always use history. . . . The intent that they find invariably bears out the result that they seek. In short, judges exploit history by making it serve the present and by making it yield results that are not historically founded." n15 Levy contends that the Justices of the Supreme Court, while bad historians, are "victims of their training as lawyers" n16 because "[t]he adversarial process is inherently hostile to the process of discovering and ordering facts in the way that historians [do]." n17 Yet too many lawyers, while acting as advocates, rely for historical precedent on history as set forth in Supreme Court opinions.

Although his emphasis is different, Burchfiel addresses, to some degree, issues I discuss in this article. n18 In challenging the historical methodology used by the Court in Graham v. John Deere Co., n19 Burchfiel contends the principal flaw in the Court's approach was its "sole reliance on Jefferson's often- changing views." n20 As a result of that reliance, the

[*198] Court's methodology "represents an extreme eclecticism that fails to consider either the views of Jefferson's contemporaries or the extensive early consideration by the courts of the patent power and its limitations." n21 In Burchfiel's view, a "basic disregard for historical facts deprives Graham of any claim to historical accuracy, and points to serious limits on the use of extrinsic history in defining constitutional norms." n22

Although I concur generally in the views expressed by Burchfiel, my purpose here is: 1) to carefully review the Court's various pronouncements concerning both Jefferson's views and Jefferson's influence on the patent law, 2) to compare those pronouncements to the historical record, and 3) to demonstrate where and to what extent the Court has overstated and misrepresented the nature of Jefferson's views and his influence on the early development of the patent law. While I join the chorus of those criticizing the Court's historical methodology, my primary emphasis is on a comparison of the actual historical record of Jefferson's views and influence with the Court's more narrowly circumscribed perspective. As I will demonstrate, the Court is not entirely to blame for its perspective, because even professional historians have had some difficulty in coming to grips with the Jeffersonian record as it pertains to the patent law.

III. The Court Discovers Jefferson

Although Jefferson wrote more on the subject of the patent law than did any other founding father, n23 it was not until the fourth decade of this century that any member of the Supreme Court deemed Jefferson

[*199] worthy of citation. In the more than one hundred patent opinions rendered by the Court prior to that time, there is no reference to Jefferson or his views concerning patents or the patent law. All that changed with the 1938 dissenting opinion of Justice Black in General Talking Pictures Corp. v. Western Electric Co. n24

The Court in General Talking Pictures held that a field-of-use patent license was lawful. n25 Justice Black argued, in dissent, that once a patented article is sold, it is no longer covered by the patent monopoly, and any licensing restriction on its use is improper. n26 In support of these views he cited Jefferson, noting that Jefferson had been a member of the Patent Board under the Patent Act of 1790 and had drafted the Patent Act of 1793. n27 Justice Black contended that, according to Jefferson, one of the rules adopted by the Patent Board was that "a machine of which we were possessed, might be applied by every man to any use of which it is susceptible, and that this right ought not to be taken from him and given to a monopolist." n28 Justice Black went on to state: "After the Patent Board's duties devolved upon the courts, Mr. Jefferson suggested that the rule be 'adopted by the judges' that 'the purchaser of the right to use the invention should be free to apply it to every purpose of which it is susceptible.'" n29

The next reference to Jefferson's views appears in a dissent by Justice Frankfurter in Marconi Wireless Telegraph Co. of America v. United States. n30 Justice Frankfurter, dissenting in part, notes Jefferson's letters in support of the statement: "It is an old observation that the training of Anglo-American judges ill fits them to discharge the duties cast upon them by patent legislation." n31

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But it was in 1966 that the Court itself, in Graham v. John Deere Co., n32 adopted, without dissent, an interpretation of the patent clause that had never before been offered n33 and, in so doing, relied almost entirely on Jefferson as authority for its interpretation. The Court provided, in support of this interpretation, copious quotations from Jefferson's writings n34 and, from them, drew certain conclusions. The contention was made, once again, that Jefferson "was not only an administrator of the patent system under the 1790 Act, but was also the author of the 1793 Patent Act." n35 Presumably because of this, as well as "his active interest and influence in the early development of the patent system," n36 the Court believed that "Jefferson's views on the general nature of the limited patent monopoly under the Constitution, as well as his conclusions as to conditions for patentability under the statutory scheme, are worthy of note." n37

According to the Court, "Jefferson, like other Americans, had an instinctive aversion to monopolies." n38 The Court further noted that "[h]is abhorrence of monopoly extended initially to patents." n39 However, "[h]is views ripened," n40 and, according to the Court, Jefferson would later write that "an inventor ought to be allowed a right to the benefit of his invention for some certain time" n41 and that "ingenuity should receive a liberal encouragement." n42 The Court stressed that Jefferson "clearly recognized the social and economic rationale of the patent system" n43 and believed that the patent monopoly "was a reward,

[*201] an inducement, to bring forth new knowledge." n44 The Court explained that Jefferson's "writings evidence his insistence upon a high level of patentability" n45 and that he "did not believe in granting patents for small details, obvious improvements, or frivolous devices." n46 The Court concluded that "[a]pparently Congress agreed with Jefferson and the [Patent] Board that the courts should develop additional conditions for patentability." n47

In 1980, in Diamond v. Chakrabarty, n48 the Court again ascribed authorship of the Patent Act of 1793 to Jefferson. n49 Moreover, in the eyes of the Court, "[t]he [1793] Act embodied Jefferson's philosophy that 'ingenuity should receive a liberal encouragement.'" n50 The Court stated that, in the 1793 Act, Jefferson defined statutory patentable subject matter as "any new and useful art, machine, manufacture, or composition of matter, or any new or useful improvement [thereof]." n51 Finally, the Court noted: "In 1952, when the patent laws were recodified, Congress replaced the word 'art' with 'process,' but otherwise left Jefferson's language intact." n52

The Court's most recent pronouncement concerning Jefferson in the patent arena occurred in 1989 in Bonito Boats, Inc. v. Thunder Craft Boats, Inc. n53 After stating that Jefferson was "the driving force behind early federal patent policy," n54 the Court went on to conclude that:

For Jefferson, a central tenet of the patent system in a free market economy was that "a machine of which we were possessed, might be applied by every man to any use of which it is susceptible." He viewed a grant of patent rights in an idea already disclosed to the public as akin to an ex post facto law, "obstruct[ing] others in the use of what they possessed before." n55

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But the Court was now being a little more judicious in interpreting the role of Jefferson in the drafting of the 1793 Patent Act, saying that he "played a large role" in that draftsmanship. n56 With unconscious irony, the Court appropriated what it undoubtedly thought was Jefferson's quite felicitous phrase, when it stressed that "from the outset, federal patent law has been about the difficult business 'of drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not.'" n57

Do these pronouncements accurately reflect Jefferson's views on - and more importantly his role in - the development of the early patent law? To what extent did his views reflect those of the Framers, the Congress, and, indeed, the public, at the time the patent law was being developed in the United States? To answer these questions, one must take a more detailed look at the Jeffersonian record, rather than merely the excerpts relied upon by the Court.

IV. A Closer Look at the Jeffersonian Record and the Patent Act of 1793

In looking more closely at the Jeffersonian record than the Court has, it is useful at the beginning to interject words of caution concerning the weight to be given to Jeffersonian pronouncements about patents and the patent law. First of all, we are examining a record that extends over three decades. In some instances, Jefferson's views changed with time; in others, he was simply inconsistent. His well-known propensity to seek to avoid disagreement makes it difficult at times to know precisely what his views actually were. Moreover, as will be shown, Jefferson's views frequently were neither those of the Congress that created the patent law nor those of the judiciary that interpreted it. Thus, to use Jefferson as an exemplar of contemporaneous views on the patent law at the end of the eighteenth century and the first part of the nineteenth century is to materially skew the historical record.

The appropriate place to begin is with the contention that Jefferson drafted the Patent Act of 1793. n58 The 1793 Act was a reaction to perceived problems with the Patent Act of 1790. n59 The Act of 1790 made the Department of State responsible for the issuance of patents. It

[*203] obligated a Patent Board consisting of the Secretary of State, the Secretary for the Department of War, and the Attorney General to examine patent petitions to ascertain whether the invention described in the petition was "sufficiently useful and important" to justify the issuance of a patent. n60 The 1790 Act provided, however, absolutely no guidance for determining what constituted sufficient usefulness and importance. If two members of the Board found the invention to meet this criterion, and if the ministerial requirements were met and the appropriate fees paid, the patent would issue. n61

It quickly became evident that neither inventors nor the high government officials who comprised the Patent Board were happy with the Act of 1790. The delays in obtaining patents must have been highly frustrating to inventors, as were the demands for information placed on inventors by the Board. n62 Moreover, inventors found themselves disputing the descriptions set forth in the issued patents, n63 most often on the ground that the description too narrowly described the invention and thereby restricted the scope of the patent. Finally, inventors were concerned that less than half of the patent petitions filed were resulting in issued patents. n64

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Beyond the concerns of inventors, there was a dawning recognition by the members of the Patent Board, and particularly by Jefferson, that they simply had insufficient time to properly carry out the tasks assigned to them under the Act. That recognition, more than anything else, soon produced an understanding in Congress that the Act of 1790 had to be amended or in some manner changed to avoid having high government officials responsible for the issuance of patents. n65 Thus, on December 9, 1790, only seven months after Congress passed the Act of 1790, the House appointed a committee to bring in a bill or bills to amend it. n66 This committee presented a bill, H.R. 121, on February 7, 1791, n67 but, Congress took no action on this bill before the session ended. n68 Another bill, H.R. 166, was not presented until March 1, 1792. n69 Again, Congress failed to act on it. n70 On December 10, 1792, H.R. 204, intended to create an entirely new patent act, was introduced. n71 An amended form of this bill became the Patent Act of 1793. n72 No specifi-

[*205] cally identified copy of H.R. 204 has been found, but it apparently was similar, although not identical, to H.R. 166.

Jefferson was in the forefront of those seeking a new patent statute. On February 4, 1791, he wrote "a bill is prepared for altering the whole train of business & putting it on a more easy footing." n73 He knew whereof he wrote because he was referring to a draft patent bill that he himself had prepared. n74 The draft was, in many significant ways, quite different from the Act of 1790 and was indeed intended to alter "the whole train of business." n75 However, as will be shown, whether it would have put it on a more easy footing depended entirely on one's point of view, and in fact it was almost immediately challenged.

Considerable confusion exists among historians as to whether Jefferson's bill was ever actually introduced and, if so, whether it was the bill introduced on February 7, 1791, H.R. 121. According to Paul Ford, editor of The Works of Thomas Jefferson, Jefferson's bill was "introduced into the House of Representatives Feb. 7, 1791 by [Rep.] White." n76 Ford unfortunately complicates the matter by then incorrectly stating that "[i]n the next Congress it was again introduced . . . and, after debate and amendment, was finally passed." n77

More recent editors have presented a different interpretation, albeit one which also appears to be incorrect. De Pauw et al. state that "[a] printed copy of what is probably the bill [introduced February 7, 1791] is E-23848." n78 Cullen et al. also believe that the February 7, 1791 bill (H.R. 121) is E-23848, yet, they assign a date of December 1, 1791 to the Jefferson draft and state that what he did with the bill after

[*206] preparing it is uncertain. n79 Contemporaneous documentation strongly suggests, however, that the February 7, 1791 bill was not E-23848 but, rather, was Jefferson's draft (or something closely akin to it) and that E-23848 was, actually, the March 1, 1792 bill, i.e., H.R. 166. Moreover, as will be shown, both the reference to a particular date in the Jefferson draft, as well as its failure to include any specific reference to a mechanism for deciding priority of invention, are indicative that the draft was prepared in early 1791.

The editors of The Papers of Thomas Jefferson, Cullen et al., maintain that "[a] comparison of the text of White's bill [which they assume to be E-23848 without stating the basis for their assumption] . . . and TJ's proposal indicates that they cannot be the same and that TJ's bill came later." n80 While a comparison does indeed quickly establish that they are not the same bill, it does not establish that Jefferson's bill came later. Perhaps recognizing this fact, Cullen et al. state the "conclusive reason" for assigning a date of December 1, 1791 to Jefferson's draft is that Jefferson "used that date when he recorded the draft of such a bill in SJPL ." n81 They stress that "[n]o record appears in SJPL for one prior to that date." n82 This is not, however, in any way conclusive.

The SJPL covers Jefferson's tenure as Secretary of State. n83 But the SJPL is an incomplete listing of Jefferson's correspondence as Secretary of State. In addition, as Cullen et al. acknowledge, the SJPL was not compiled daily, and entries were only made periodically "as a record of his chief public papers of the period." n84 Accordingly, the fact that Jefferson's draft was recorded in the SJPL on December 1, 1791 is not persuasive that it was prepared on or about that date. Rather, the entry in the SJPL appears to have been made as a result of a letter Jefferson wrote on November 13, 1791 to Rep. Hugh Williamson of North Carolina, who was chairman of the committee charged to prepare new patent legislation. n85

Jefferson began that letter by saying: "[o]n considering the subject of the clause you wished to have introduced in the inclosed bill, I

[*207] found it more difficult than I had on first view imagined." n86 It is clear from the SJPL entry of December 1, 1791 that the "inclosed bill" was in fact Jefferson's bill. More importantly, however, it is apparent that Williamson had seen Jefferson's bill at some earlier time and had requested that a particular clause be made a part of the bill that Jefferson was then commenting on. For the reasons discussed below, I believe that Rep. Williamson first saw Jefferson's bill much earlier in 1791, when it, or something closely akin to it, was introduced as H.R. 121 by Rep. White.

Jefferson's bill contained unique filing and publication requirements not found in any earlier patent bill and not reproduced in any later patent bill. Specifically, it required the applicant to: 1) obtain a certificate generally describing the invention from the Secretary of State, n87 2) obtain a warrant and Treasurer's receipt from the Secretary of the Treasury indicating payment of the requisite fee, n88 3) file the certificate, warrant, and receipt "of record in the Clerk's Office in every District Court of the United States," n89 and 4) publish these documents "three times in some one Gazette of each of the said Districts." n90 These requirements were extremely onerous and would have greatly increased the cost and extended the time of obtaining and enforcing a patent. Accepting the primitive state of the mail system in the United States in 1791, the only way an applicant could be assured that these requirements were met would be to personally travel to every judicial district in the country or have an authorized representative do the same.

One could reasonably expect that when the draft became known, inventors would object strenuously to these requirements, and one inventor immediately did so. On February 10, 1791

[a] petition and remonstrance of John Fitch, was presented to the House and read, complaining of the injurious operation which the bill now depending before Congress, intituled [sic], "A bill to amend the act to promote the progress of useful arts," will have on his interest, should the same be passed into a law. n91

Fitch protested the proposed filing and publication requirements, saying that he "had no Idea that he must go all the way from Kentucky to Cape

[*208] Cod, and quite the Distance of Province of Main[e], to publish his inventions, and to pay out large fees wherever he goes for the Same." n92 Fitch's petition is persuasive evidence that Jefferson's bill was introduced as H.R. 121 on February 7, 1791.

There is other internal evidence in Jefferson's bill suggesting that it was introduced as H.R. 121 on February seventh. Jefferson's bill makes reference to "applications for Patents [that] were on the lst. day of February in this present year, depending before the Secretary of State, Secretary at War, and Attorney General." n93 This express reference to February first appears totally arbitrary if the bill is dated December 1, 1791, as contended by Cullen et al., but makes eminent sense if the bill is in fact H.R. 121 introduced February 7, 1791.

Moreover, E-23848 cannot be the bill introduced February seventh, because E- 23848 does not contain the particular provision objected to by Fitch. Rather, other contemporaneous documentation shows that E-23848 is H.R. 166, introduced March 1, 1792. Joseph Barnes published a pamphlet in Philadelphia in 1792 that was critical of both the Act of 1790 and the March 1, 1792 bill. n94 Barnes stated that the bill "contemplates, at the expense of the American genius, to import European arts and literature!!!" n95 This referred to the provision of E-23848 "[t]hat the monies to be paid, as directed by this act, into the treasury, shall be appropriated to the expense of procuring and importing useful arts and machines from foreign countries . . . ." n96 No other patent bill of the period contained such language, so Barnes' pamphlet provides persuasive contemporaneous evidence that E-23848 is H.R. 166 introduced March 1, 1792.

The presence of an express provision for determining priority of invention in E-23848, but not in Jefferson's bill, is further evidence for dating the former at March 1, 1792 and the latter at February 7, 1791. In

[*209] April, 1791 the Patent Board unsuccessfully attempted to deal with the issue of priority when four separate inventors appeared to claim similar inventions. n97 If Jefferson had drafted his bill after April, 1791, it very likely would have contained a provision dealing with priority of invention. This is particularly likely given that Jefferson had previously argued to the Board that the Board had no authority to determine priority of invention under the Act of 1790. n98

There is one other source of contemporaneous documentation that has been ignored by the editors cited above. This source is the Fitch Papers, an extensive collection of documents which include documents held by the Library Company of Philadelphia and the Library of Congress. n99 Fitch believed that the White bill, introduced on February 7, 1791, was the work of James Rumsey. n100 But it is difficult to accept that any inventor, including Rumsey, would have proposed the onerous provisions respecting filing and publication in every judicial district that Fitch himself had so promptly objected to. It is likely that Fitch, not knowing the origin of the White bill, simply assumed that it must have been the product of his rival, Rumsey.

In Graham n101 and in Chakrabarty, n102 the Court cited no authority for its belief that Jefferson drafted the Act of 1793, but in General Talking Pictures Justice Black cited the Jeffersonian Cyclopedia. n103

[*210] Moreover, some modern Jefferson scholars have taken the same view. n104 The origin of this contention most likely resides in Paul Ford's 1904 footnote to the draft patent bill prepared by Jefferson in 1791. n105 For the reasons set forth above, Ford was correct in assuming that Jefferson's bill (or something closely akin to it) was in fact introduced as H.R. 121 on February 7, 1991. There is no basis, however, for his contention that H.R. 166 and H.R. 204 were in essence reintroduced versions of H.R. 121 which in amended form became the Act of 1793.

Somewhat naively, Jefferson seems to have expected early in 1791 that Congress would act expeditiously on the new patent bill pending before it. n106 His expectation was quickly quashed when the session ended without congressional action. n107 With the new session in the fall, a new committee chaired by Hugh Williamson was appointed to bring in a new patent bill. n108 The committee appears to have begun its work by looking at Jefferson's bill. Jefferson's letter of November 13, 1791 to Williamson was an apparent response to a request by the committee that Jefferson add to his bill a provision similar to one in the Act of 1790 which permitted anyone to challenge the validity of a patent in federal court for a period of one year after issuance on the limited ground that the "patent was obtained surreptitiously by, or upon false suggestion." n109 Jefferson found the issue of incorporating such a provision "more difficult than I had on first view imagined." n110 The lawyer in him could not resist doing a legal analysis of the issue, after which he

[*211] concluded that "less evil" would follow if the law forbade such suits seeking a declaratory judgment of invalidity, but only allowed a defendant to challenge validity in any infringement action brought by the patentee. n111

When the committee introduced H.R. 166 on March 1, 1792, the actual bill was materially different from Jefferson's bill and was clearly drafted by someone other than Jefferson. n112 Within a month of introduction, Jefferson provided his comments with respect to H.R. 166, although the substance of these comments is unknown. n113 The fact that Jefferson commented on H.R. 166 is the most obvious evidence that he did not draft it. If he made any further attempt to influence the content of what would become the Patent Act of 1793, no record of such attempt has been found.

The Act of 1793 was materially different from the bill Jefferson had proposed, although it did contain a number of the new provisions he had sought. Specifically, the Act of 1793 proclaimed that: 1) patents would henceforth issue on payment of a set fee into the Treasury, n114 2) the petition would be for an exclusive property right in the invention, n115 3) compositions of matter were patentable, n116 4) the petitioner would provide the description to be incorporated into the patent, n117 5) state patents obtained prior to the particular state's ratification of the Constitution were invalidated upon receipt of a federal patent for the

[*212] same invention, n118 and, most importantly from Jefferson's perspective, 6) the patent would issue when the petitioner conformed to the ministerial requirements, i.e., the system would now be one of registration rather than examination. n119

Several of Jefferson's proposals were not incorporated into the 1793 Act. These omissions include provisions calling for: 1) every patent to be registered and published in every judicial district, n120 2) an unobviousness standard, n121 3) a lack of knowledge defense, n122 4) the withholding of a patent specification from the public until after the patent had expired, n123 and 5) receipts from patent fees to be used to obtain books for a public library. n124 Additionally, Congress failed to act on Jefferson's proposal that the Patent Act should contain no provision for obtaining a declaratory judgment of patent invalidity. n125 While Jefferson exerted a significant influence on certain aspects of the Act of 1793, he did not author it, nor was he responsible for most of its content.

V. The Jeffersonian Record and the Court's Other Pronouncements

In General Talking Pictures, Justice Black was indeed correct in stating that, according to Jefferson, one of the rules adopted by the Patent Board was that "a machine of which we are possessed, might be applied by every man to any use of which it is susceptible, and that this right ought not to be taken from him and given to a monopolist." n126 But by emphasizing this particular language Justice Black sought to avoid the context of Jefferson's full statement:

[A] machine of which we are possessed might be applied by every man to any use to which it is susceptible and that this right ought not to be taken from him to be given to a monopolist because the first perhaps had occasion so to

[*213] apply it. Thus a screw for crushing plaster might be employed for crushing corn-cobs. And a chain-pump for raising water might be used for raising wheat: this being merely a change of application. n127

What Jefferson was actually addressing was the issue of a new use for an old machine, as opposed to the issue of a field-of-use limitation for an entirely new machine or process. While it is quite possible that Jefferson would have opposed field-of-use licenses, he never addressed field-of-use licenses, for such were unknown during his lifetime. n128

Justice Black also failed to note that Jefferson's only recollections of his activities on the Patent Board were published twenty-some years after the Board had ceased to exist. Even Dumas Malone, Jefferson's noted biographer, suggests that the principles Jefferson recalled in 1813 probably "were clearer in his mind when he thought about the subject long years afterward than in this time of beginnings." n129 More importantly, this "new use for an old machine rule" was not incorporated into the Patent Act of 1793. Justice Black was indeed correct that in 1814 Jefferson suggested that the courts should adopt a rule that "the purchaser of the right to use the invention should be free to apply it to every purpose of which it is susceptible." n130 Jefferson did so, however, only in private correspondence and made no public proposal of this kind. Moreover, Justice Black could point to no case under the Act of 1793 (which remained in effect for forty-three years) wherein any court had adopted such a judicial interpretation.

The Court also engaged in a bit of hyperbole when it suggested in Bonito Boats that Jefferson considered this "new use, old combination" rule to be "a central tenet of the patent system in a free market economy." n131 This Patent Board rule was not incorporated into H.R. 121, H.R. 166, or H.R. 204 and did not appear in the Act of 1793. If Jefferson truly believed this rule to be a central tenet of any American patent system, why did he not incorporate it into his own patent bill or

[*214] seek to have it incorporated into the Act of 1793? In this regard, the Act of 1793 did, interestingly, contain two of the other rules Jefferson stated to have been developed by the Patent Board. n132 Thus to the extent that Jefferson - in some unknown fashion - may have sought to have this supposed "central tenet" made a part of the Act of 1793, the Congress expressly rejected it.

The Bonito Boats Court was indeed correct that Jefferson, in 1813, argued that a grant of patent rights in ideas in the public domain "was akin to an ex post facto law 'obstructing[ing] others in the use of what they possessed before.'" n133 What the Court failed to note, however, was that two years later, in 1815, the Supreme Court expressly rejected arguments of the type that Jefferson had made. n134 Jefferson wrote in terms of what he called the "retrospection" given to the 1808 Act for the Relief of Oliver Evans. n135 Evans' patent for the milling of flour had expired in 1805 and in the 1808 Act Congress effectively authorized the renewal of the patent for another term of fourteen years, three years after the original expiration. n136

Jefferson was fully aware that the circuit courts for Pennsylvania and Maryland had both held that this Act was not an ex post facto law repugnant to the Constitution. n137 Moreover, Jefferson apparently understood that the circuit courts had authorized Evans to claim royalties under his renewal patent for machinery installed during the three-year period when his improvements were seemingly in the public domain and continuously used, but only from the date that the infringing millers had been given notice of the issuance of the new patent. n138 Jefferson strongly

[*215] disagreed with this judicial interpretation. n139 He acknowledged that the constitutional prohibition on ex post facto laws applied only to criminal law but argued that "they are equally unjust in civil as in criminal cases, and the omission of a caution which would have been right, does not justify the doing of what is wrong." n140 In his view, the retrospective construction was "contrary to natural right," n141 and "[l]aws . . . abridging the natural right of the citizen, should be restrained by rigorous constructions within their narrowest limits." n142 While these views would receive much sympathy today, in 1815 the Court expressly rejected such arguments and upheld the views expressed by the circuit courts.

The Graham Court was also correct in suggesting that Jefferson's writings evidence an insistence on a high standard of patentability. n143 Jefferson did indeed have a high standard of patentability, one that was probably higher than any that has been in existence in the United States for the past two hundred years, with the possible exception of the very restrictive standard of patentability espoused by the Court in the 1930s and 1940s. n144 Nowhere is this more evident than in Jefferson's view that Oliver Evans' patent for improvements in the milling of flour was a "frivolous" patent. n145 Yet Evans' patent was one of the more valuable early inventions made in the United States and had been both widely licensed and widely infringed by millers throughout the United States. n146 Indeed, Jefferson himself licensed and used those improvements for many years. n147 Evans' improvements not only greatly increased the efficiency

[*216] of flour milling, but, also produced a much higher quality of flour than usual before the improvements came into use. n148

Today, Evans' invention would clearly be considered an improved process for the milling of flour, although his improved milling process incorporated several improved machines. Under any standard of patentability that has existed in the United States (with the exception of that espoused by Jefferson), Evans' invention would be considered patentable. n149 The problem was that in the time of Evans and Jefferson, patents did not contain claims, n150 and Jefferson was convinced that patents could only be issued for machines and for compositions of matter. Jefferson could not conceive of a patent for a process or method of doing something. Nor did he believe that a combination of old and known elements could be patentable. n151 As Jefferson put it, "if we have a right to use three things separately, I see nothing in reason or in the patent law, which forbids our using them all together." n152

Jefferson, after some additional reflection, seems to have changed his mind on this latter point and came to consider "any new combination of the mechanical powers already known, as entitled to an exclusive grant." n153 Unfortunately for Evans, however, Jefferson permitted the wide publication of his view that Evans' patent was invalid because it was merely a combination of old elements (even though Jefferson admitted that one of those elements was new and patentable in its own right). Jefferson failed, however, to disseminate his change of mind on this point.

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VI. Jefferson's Views and Influence on the Patent System

To the extent that Jefferson influenced the development of the patent system, he did so through the incorporation of certain of his views in the Patent Act of 1793. But, as this article has shown in detail, Jefferson did not draft the Act of 1793 and many - if not most - of his proposals for a new patent law were rejected by the Congress. n154 The Jeffersonian proposal that was accepted was the move from an examination system to a registration system. n155 Jefferson proposed this for purely pragmatic reasons having nothing whatsoever to do with his supposed philosophy that "ingenuity should receive a liberal encouragement" as explained by the Chakrabarty Court. n156

In fact, the primary purpose of Jefferson's bill was to ease the burden on the Patent Board and the Secretary of State by specifically changing from an examination to a registration system and by placing the duty of preparing the description of the invention on the applicant rather than on the Board or a clerk in the State Department. n157 Moreover, Jefferson's bill expressly required specifications, drawings, and models of issued patents to be kept secret, n158 which would have further reduced by a substantial amount the ministerial duties placed on his clerks in the copying and administration of issued patents. For Jefferson, this entirely pragmatic consideration was the crux of the matter. More than anything else, he wanted to reduce the time required of him and his clerks in the domestic duties imposed by the administration of the patent system. n159 He wanted to be relieved of the responsibilities placed on him by the Act of 1790 "as being, of every thing that ever was imposed upon him, that which cuts up his time into the most useless fragments and gives him from time to time the most poignant mortification." n160

But Jefferson soon developed doubts about the merits and effectiveness of the registration system created under the Act of 1793. Jefferson set forth his views in a long and detailed letter in 1813 which he obviously intended for publication:

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[Patent] investigations occupying more time of the members of the board than they could spare from higher duties, the whole was turned over to the judiciary, to be matured into a system, under which every one might know when his actions were safe and lawful. Instead of refusing a patent in the first instance, as the board was authorized to do, the patent now issues of course, subject to be declared void on such principles as should be established by the courts of law. This business, however, is but little analogous to their course of reading, since we might in vain turn over all the lubberly volumes of the law to find a single ray which would lighten the path of the mechanic or the mathematician. n161 It is more within the information of a board of academical professors, and a previous refusal of a patent would better guard our citizens against harassment by lawsuits. n162 But England had given it to her judges, and the usual predominancy of her examples carried it to ours. n163

Here Jefferson was clearly being disingenuous for he, more than anyone else, had been responsible for the change in the law from an examination system to a registration system. n164 He was correct in the concerns he raised, but he could not bring himself to admit that he had been a major advocate of the system which he now found wanting and had been, as well, the person primarily responsible for its adoption by Congress. Jefferson candidly acknowledged that he was taking this opportunity to set forth his views on the patent law as a means of both justifying himself and distancing himself from the Act of 1793, "my name and approbation being ascribed to the act." n165

Contrary to the conclusion reached by the Graham Court neither Jefferson nor the Patent Board thought that it was desirable "that the courts should develop additional conditions for patentability." n166 No one on the Patent Board other than Jefferson ever wrote or said a word on the subject, and the Graham Court relied only on the first sentence of the long passage quoted above from Jefferson's letter to McPherson. n167 By

[*219] taking this sentence out of context, the Court ascribed a meaning to Jefferson's words that was diametrically opposite to that demonstrated by the passage taken as a whole. Rather than believing that courts should develop rules of patentability, Jefferson instead clearly thought judges were ill-equipped for this responsibility. Moreover, Jefferson sought to emphasize the point in subsequent correspondence, arguing that "when so new a branch of science has been recently engrafted on our jurisprudence, one with which its professors have till now had no call to make themselves acquainted, one bearing little analogy to their professional educations or pursuits," n168 one or two decisions before inferior and local tribunals should not act as precedent to "forever foreclose the whole of a new subject." n169

Perhaps most critically, the Graham Court's assertion that Jefferson "clearly recognized the social and economic rationale of the patent system," n170 is belied by the historical record. While the Court clearly recognized that Jefferson had opposed the intellectual property clause of the Constitution in 1788 and 1789, n171 the Court failed completely to note that three decades later, in 1813 and 1814, Jefferson was still not convinced of either the usefulness or the desirability of the patent system. In 1813, Jefferson expressed skepticism about the value of the patent system in the following terms: "generally speaking, other nations have thought that these monopolies produce more embarrassment than advantage to society; and it may be observed that the nations which refuse monopolies of invention, are as fruitful as England in new and useful devices." n172 In 1814, Jefferson reiterated his concern that, on balance, the abuses of the patent system through the issue of what he called "frivolous" patents outweighed its benefits. n173 Finally, in 1815, he indicated his displeasure at the manner in which the patent system might be used when he described an invention he made with respect to the processing of hemp and stated "as soon as I can speak of its effect with certainty, I shall probably describe it anonymously in the public papers, in order to forestall the prevention of its use by some interloping patentee." n174

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VII. Conclusions

Jefferson was never enamored of the patent system and throughout his life displayed a marked ambivalence toward it. Significant documentation exists showing his early opposition to the creation of the limited-term monopolies called patents n175 and to the effort he expended to administer the first patent system. n176 Contrary to the assertion of the Bonito Boats Court, Jefferson was not "the driving force behind early federal patent policy." n177 To the extent that such a policy could be said to have existed during the last decade of the eighteenth century, this policy was set by congressional enactment in the statutory framework. The rules that Jefferson said the Patent Board developed came on the scene very late in the tenure of the Board, were never published, and the extent to which these rules were actually applied is unknown. n178 In and of themselves, these rules consisted of an interpretation of only one part of federal patent policy under the Act of 1790, namely, the criteria that should be applied to determine when an invention was "sufficiently useful and important" to warrant a patent. n179

A highly relevant point which the Court has chosen to ignore totally is that two decades after Jefferson ceased to have primary responsibility for the operation of the nascent United States patent system, he expressed considerable skepticism concerning both its usefulness and its effectiveness. He clearly did not believe that patents promoted the progress of the useful arts - at least to any significant degree. Indeed, to the end of his life Jefferson privately believed that the patent system more often served to permit patentees to obstruct rather than promote the progress of useful arts. In his view, nations without patent systems did just as well as those with patent systems both in the number and in the nature of their inventions. Inherent in this view was the supposition, common at the time, that the purpose of a patent system was to promote invention. n180

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If a patent system must exist - and one most assuredly existed in the United States - Jefferson believed that the system had to include certain rules regarding patentability. His standards in this regard were high - indeed higher than most Americans at the time thought necessary and, in some respects, higher than the patent law in the subsequent two hundred years has thought necessary. Jefferson recognized that the science of patents was a young one undergoing transition and development, and he was reluctant to have its early development controlled by judges who knew little or nothing about it and could not provide "a single ray which would lighten the path of the mechanic or the mathematician." n181

Jefferson's advocacy of a few rules of patentability is well known. These rules are known almost entirely because of the existence of a single letter written in 1813. What has only recently been recognized, however, is that Jefferson was the first to propose, albeit unsuccessfully, what has now become a basic tenet of the United States patent law, namely, that to be patentable, an invention must be unobvious to one skilled in the art to which that invention pertains. n182 Had Congress written this approach into law in 1791 when proposed by Jefferson, the subsequent history of the patent law would have been quite different.

Although the Supreme Court has attributed the rules of patentability set forth in the 1813 letter to Jefferson, he never claimed authorship per se. While Jefferson certainly favored these rules, and may well have been instrumental in getting the Board to accept them, there is some question as to whether these rules were original to Jefferson. n183 Be that as it may, Jefferson espoused them and, in so doing, anticipated a future trend of the patent law. For this reason alone his views on patentability under the first statutory scheme "are worthy of note" as the Court has indicated. n184 However, Jefferson did not create the patent

[*222] system. While he influenced to a considerable degree the content of the Act of 1793, he came to regret the major change he instigated, the shift from examination to registration. When all is said and done, no substantive portion of the patent law, as it exists today, can be attributed to Jefferson.

The Court has also chosen to ignore almost entirely Jefferson's restrictive attitude toward the enforcement of patent rights. The provisions set forth in his patent bill - that a patent had to be registered and advertised in every judicial district in the United States before it could be enforced, and that every patent assignment had to be registered and advertised in like manner - were exceedingly onerous requirements. n185 One can only guess about Jefferson's motivation in proposing these requirements. If his motives were nefarious, however, one can scarcely conceive of a more effective means of sabotaging the newly created federal patent system. It is doubtful that this was Jefferson's actual intent, but there is little question that he wanted to limit the number of patents that would issue without actually placing the onus for such limitation on him or his department. Jefferson's later pronouncements that "an inventor ought to be allowed a right to the benefit of his invention for a certain time" n186 and that "ingenuity should receive a liberal encouragement" n187 are hard to reconcile with the impediments to such liberal sentiments contained in his patent bill.

In summary, the Court's treatment and use of the Jeffersonian record in its interpretation of the patent law is materially flawed in several respects. In making Jefferson into an exemplar of early views on the patent law and the patent system, when his views were, more often than not, unaccepted by either Congress or the judiciary and were at odds with most inventors of the day, n188 the Court has relied on a skewed historical record. Moreover, to the extent that Jefferson's views are relevant, the Court, through its use of excerpts, not infrequently taken out of context, has significantly misrepresented those views. There is little evidence that Jefferson ever "clearly recognized the social and economic rationale of the patent system" n189 and much to suggest that he would have been just as happy if it had never come into existence. But exist it did, and while acknowledging that fact, Jefferson much preferred

[*223] that the system be highly restrictive in the issuance of patents. n190 He truly considered all patents, regardless of their merits, to be "embarrassments." n191 Nor did he believe that the courts were the appropriate mechanism for developing rules of patentability, n192 as the Court has alleged. n193 On one occasion Jefferson suggested indirectly that a particular rule of patentability be offered up for the courts to consider, but as with most things involving the federal courts, he was skeptical that the judiciary was an appropriate or even a necessary forum for determining patentability. n194

VIII. Does It Matter?

One may reasonably ask whether it matters that the Court, in interpreting the patent law, appears to have placed undue reliance on its understanding of Jefferson's role and influence in the early development of that law. At one seemingly pragmatic level, it does not. Regardless of the Court's rationale, the Court's interpretation is determinative until it either modifies its interpretation or the Congress disagrees and changes the statutory language. Numerous examples may be cited to show that the Court's citation to the historical record in support of a particular legal interpretation is flawed, but this does not in and of itself make the interpretation invalid. Indeed, under the circumstances currently existing, the end result may be viewed as generally desirable by most neutral observers.

Moreover, all history is interpretation. Most historians, if not most members of the legal profession, are aware that, as Professor Levy puts it, "judges always use history." n195 Thus, historians display an innate skepticism toward historical arguments set forth in judicial opinions n196 and lawyers, who are trained as advocates, should too. Simply put, those who seek to rely on historical analysis relied upon by judges should be aware of the admonition: Let the advocate beware! As Jeffersonian scholars are aware, something can be found in the Jeffersonian record to support almost any premise.

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Yet, on a deeper level, the Court's reliance on a skewed Jeffersonian record should be a matter of concern. Historians do not engage in legal adjudication, but judges do. To the extent that the Court deems it desirable and necessary to use the historical record to interpret the law, the Court ought to seek a facially neutral approach. As Merrill Peterson pointed out many years ago, Jefferson has become all things to all people. n197 It is precisely for this reason that it behooves the Court to avoid using Jefferson as an exemplar of early American views on the patent law.

Jefferson has left a complex and confusing record. It is not surprising that the Court should be perplexed by the Jeffersonian record, as indeed professional historians are. Nonetheless, the Court's selective use of the Jeffersonian record, frequently out of context, as a form of advocacy, creates a mythology at odds with the contemporaneous record. Not only has the Court significantly misstated and misrepresented Jefferson's views, but the Court has also materially overstated the relevance and importance of those views and ignored the historical record demonstrating that Jefferson's views on patentability were not those generally accepted during his lifetime. The nation is ill served when the highest court in the land relies for legal interpretation on mythology largely of its own creation.

n1 I define "extrinsic history" to mean "sources, apart from precedent, developed in the litigation and adjudication of particular controversies by the Court." Kenneth Burchfiel, Revising the "Original" Patent Clause: Pseudohistory in Constitutional Interpretation, 2 Harv. J.L. & Tech. 155, 159 n.26 (1989). I agree with Burchfiel: "Because of the extreme diversity of nonprecedential sources and the corresponding invitation to select isolated favorable passages identified as 'history,' it is considered useful to group sources apart from readily-discoverable judicial precedent under such an inclusive rubric." Id.

n2 For recent examples of this practice, see *Loving v. United States, 517 U.S. 748 (1996); Lonchar v. Thomas, 517 U.S. 314 (1996);* 44 *Liquormart, Inc. v. Rhode Island Liquor Stores Assoc., 517 U.S. 484 (1996); Norfolk & Western Ry. Co. v. Hiles, 516 U.S. 400 (1996);* and *Markman v. Westview Instruments, Inc., 517 U.S. 370, 38 U.S.P.Q.2d (BNA) 1461 (1996).* For a review of the practice over the longer term, see also Charles A Miller, The Supreme Court and the Uses of History (1969).

n3 Erwin Chemerinsky, History, Tradition, the Supreme Court, and the First Amendment, *44 Hastings L.J. 901 (1993).*

n4 *Id. at 908.*

n5 Burchfiel, supra note 1, at 155-58.

n6 Id. at 161.

n7 Id. at 157.

n8 Alfred H. Kelly, Clio and the Court: An Illicit Love Affair, *1965 Sup. Ct. Rev. 119, 131-32.*

n9 See, e.g., Chemerinsky, supra note 3; Eric Schnaffer, Petitions for Redress of Grievances: Bad Historiography Makes Worse Law, *74 Iowa L. Rev. 303 (1989);* Burchfiel, supra note 1; Leonard Levy, Original Intent and the Framers' Constitution chs. 14-15 (1988); and Alfred H. Kelly, supra note 8.

n10 Levy, supra note 9, at 300.

n11 Id.

n12 Burchfiel, supra note 1, at 218; Chemerinsky, supra note 3, at 913.

n13 Levy, supra note 9, at 300.

n14 Id.

n15 Id. at 313.

n16 Id.

n17 Id.

n18 Burchfiel, supra note 1, at 159-61.

n19 *383 U.S. 1, 148 U.S.P.Q. (BNA) 459 (1966).*

n20 Burchfiel, supra note 1, at 209.

n21 Id.

n22 Id. at 212.

n23 Jefferson left a tremendous volume of papers and correspondence for posterity to review. The most recent effort to compile and edit Jefferson's papers and correspondence, at Princeton University, has filled twenty-six volumes but reaches only the later months of 1793. See Thomas Jefferson, The Papers of Thomas Jefferson (Julian P. Boyd et al. eds., 1956-1996) [hereinafter Jefferson's Papers]. Earlier collections commonly cited are the 12-volume The Works of Thomas Jefferson (Paul Leicester Ford ed., 1904) [hereinafter Jefferson's Works], The Writings of Thomas Jefferson (H.A. Washington ed., 1861) [hereinafter Jefferson's Writings I], and the 20-volume The Writings of Thomas Jefferson (Andrew A. Lipscomb et al. eds., 1903) [hereinafter Jefferson's Writings II]. In addition, citations of Jefferson's writings in Supreme Court opinions tend to be somewhat unclear. Where those citations are ambiguous, and cannot be tied to one of the collections listed in this note, the Supreme Court's citation language is retained.

n24 *305 U.S. 124, 128, 39 U.S.P.Q. (BNA) 229, 330 (1938).*

n25 *Id. at 127, 39 U.S.P.Q. at 330.*

n26 *Id. at 128-33, 39 U.S.P.Q. at 330-3* (Black, J., dissenting, joined by Reed, J.).

n27 *Id. at 128 n.1, 39 U.S.P.Q. at 331 n.1* (Black, J., dissenting).

n28 Id. (quoting 6 Jefferson's Writings I, supra note 23, at 181) (emphasis supplied by Black, J.)

n29 Id. at 128-9 n.1, 39 U.S.P.Q. at 331 n.1. (quoting 6 Jefferson's Writings I, supra note 23, at 372) (emphasis added by Black, J.).

n30 *320 U.S. 1, 57 U.S.P.Q. (BNA) 471 (1943).*

n31 *Id. at 60-61, 57 U.S.P.Q. at 496* (citing Letter from Thomas Jefferson to Isaac McPherson (Aug. 13, 1813), in 6 Works of Thomas Jefferson, at 181-82 (Washington ed.)). See *id. at 61 n.1, 57 U.S.P.Q. at 496 n.1* and the text accompanying note 161, infra Part III, for the Jeffersonian language relied upon by Justice Frankfurter.

n32 *383 U.S. 1, 148 U.S.P.Q. (BNA) 459 (1966).*

n33 Specifically, the Court explained that "[i]nnovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of . . . useful Arts.' This is the standard expressed in the Constitution and it may not be ignored." *Id. at 6, 148 U.S.P.Q. at 462* (emphasis in original).

n34 See notes 163-74 and accompanying text, infra Part III, for Jefferson's actual views.

n35 *Id. at 7, 148 U.S.P.Q. at 463.*

n36 Id.

n37 Id.

n38 Id.

n39 Id.

n40 *Id. at 7-8, 148 U.S.P.Q. at 463.*

n41 *Id. at 8, 148 U.S.P.Q. at 463* (quoting Letter from Thomas Jefferson to Oliver Evans (May, 1807), in 5 Writings of Thomas Jefferson, at 75-76 (Washington ed.)).

n42 Id.

n43 *Id. at 9, 148 U.S.P.Q. at 463.*

n44 Id.

n45 Id.

n46 Id.

n47 *Id. at 10, 148 U.S.P.Q. at 464.*

n48 *447 U.S. 303, 206 U.S.P.Q. (BNA) 193 (1980).*

n49 *Id. at 308, 206 U.S.P.Q. at 197* (majority opinion).

n50 Id. (quoting Letter from Thomas Jefferson to Oliver Evans (May, 1807), in 5 Writings of Thomas Jefferson, at 75-76 (Washington ed.)).

n51 Id. (quoting Act of Feb. 21, 1793, ch. 11, 1, 1 Stat. 318).

n52 *Id. at 309, 206 U.S.P.Q. at 197.*

n53 *489 U.S. 141, 9 U.S.P.Q.2d (BNA) 1847 (1989).*

n54 *Id. at 147, 9 U.S.P.Q.2d at 1850.*

n55 *Id., 9 U.S.P.Q.2d at 1850-51* (citations omitted) (quoting 13 The Writings of Thomas Jefferson, at 335, 326-27 (Memorial ed. 1904)).

n56 *Id., 9 U.S.P.Q.2d at 1851.*

n57 *Id. at 148, 9 U.S.P.Q.2d at 1851* (quoting 13 Jefferson's Writings I, supra note 23, at 335).

n58 Act of Feb. 21, 1793, ch. 11, 1 Stat. 318.

n59 Act of Apr. 10, 1790, ch. 7, 1 Stat. 109.

n60 Id. 2.

n61 Id. 2, 11.

n62 The Act required the inventor to deliver to the Secretary of State a specification in writing, containing a description, accompanied with drafts or models, and explanations and models (if the nature of the invention or discovery will admit of a model) of the thing or things, by him . . . invented or discovered, . . . which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art or manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use the same, to the end that the public may have the full benefit thereof, after the expiration of the patent term. Id. 2.

n63 These descriptions were prepared by clerks in the State Department acting at the direction of the Patent Board and were supposed to recite the allegations and suggestions of the patent petition and to describe the invention "clearly, truly, and fully." Id. 1. This, however, was difficult to do in the one-paragraph format adopted by the Patent Board for patents, and on at least one occasion a patent issued under the Act of 1790 was invalidated for failure to properly recite the allegations of the petition. *Evans v. Chambers, 8 F. Cas. 837 (C.C.D. Pa. 1807)* (No. 4,555).

n64 Although the number of petitions received under the Act of 1790 is not known, the Patent Board issued fifty-seven patents under the 1790 Act. P.J. Federico, Operation of the Patent Act of 1790, *18 J. Pat. Off. Soc'y 237, 244 (1936).* The only available contemporaneous documentation shows "that at least 114 applications for patents were filed during the first two years of the three year life of the patent act; [and] 49 of these applications resulted in patents." *Id. at 246.* In Federico's view, the actual number of applications filed must have been considerably higher because the documentation is incomplete and lists only the applications under consideration as of March 31, 1792 without indicating how many earlier applications the Board disposed of by refusing to grant a patent. Id.

n65 In a letter to Rep. Hugh Williamson, Jefferson said of the duty imposed on him by the Act of 1790: Above all things he [Jefferson] prays to be relieved from it, as being, of everything that ever was imposed on him, that which cuts up his time into the most useless fragments and gives him from time to time the most poignant mortification. The subjects are such as would require a great deal of time to understand & do justice by them, and not having that time to bestow on them, he has been oppressed beyond

measure by the circumstances under which he has been obliged to give undue & uninformed opinions on rights often valuable, & always deemed so by the authors. Letter from Thomas Jefferson to Hugh Williamson (Apr. 1, 1792), in 6 Jefferson's Works, supra note 23, at 459.

n66 H.J., 1st Cong. (3d Sess.) at 333.

n67 Id. at 371.

n68 The third session adjourned March 3, 1791 without action on H.R. 121. Id. at 402-09.

n69 H.J., 2d Cong. (1st Sess.) at 525.

n70 The first session adjourned May 7, 1792 without action on H.R. 161. Id. at 600-06.

n71 H.J., 2d Cong. (2d Sess.) at 636.

n72 H.R. 204 was read a second time and sent to a committee of the Whole House. Id. On January 29, 1793 the committee reported "progress" on the bill. Id. at 685. "[S]everal amendments" were made and presented to the clerk's table. Id. at 687. The amended bill was read and passed by the whole House on February 4, 1793. Id. at 689. The bill was amended in the Senate, passed by vote, and sent back to the House for concurrence on February 15, 1793. S.J., 2d Cong. (2d Sess.) at 487. The House concurred and the Vice-President signed the enrolled bill on February 18, 1793. Id. at 488. President Washington signed the Act on Feb. 21, 1793. H.J., 2d Cong. (2d Sess.) at 710.

n73 Letter from Thomas Jefferson to Robert R. Livingston (Feb. 4, 1791), in 6 Jefferson's Works, supra note 23, at 187-88.

n74 The bill is reproduced in 22 Jefferson's Papers, supra note 23, at 359, and in 6 Jefferson's Works, supra note 23, at 189.

n75 Letter from Thomas Jefferson to Robert R. Livingston, supra note 73, at 187-88.

n76 6 Jefferson's Works, supra note 23, at 189 n.1.

n77 Id.

n78 3 Documentary History Of The First Federal Congress Of The United States Of America 700 n.19 (Linda Grant De Pauw et al. eds., 1977) [hereinafter First Congress]. E-23848 is known as an Evans number and refers to the identifying number of a document published in Charles Evans' American Bibliography. More recently, the editors of First Congress have concluded that the February 7, 1791 bill, i.e., H.R. 121, is not E-23848, but is, instead, the Jefferson draft. See 8 First Congress at 67 (Kenneth R. Bowling et al. eds., 1998).

n79 22 Jefferson's Papers, supra note 23, at 361.

n80 Id.

n81 Id.

n82 Id.

n83 Id. at ix-x.

n84 Id. at ix.

n85 22 Jefferson's Papers, supra note 23, at 295.

n86 Letter from Thomas Jefferson to Hugh Williamson (Nov. 13, 1791), in 22 Jefferson's Papers, supra note 23, at 295, also in 6 Jefferson's Works, supra note 23, at 328.

n87 Draft Of A Bill To Promote The Progress Of The Useful Arts, in 6 Jefferson's Works, supra note 23, at 190 [hereinafter Jefferson's draft bill].

n88 Id. at 189.

n89 Id. at 190.

n90 Id.

n91 3 First Congress, supra note 78, at 706.

n92 8 First Congress, supra note 78, at 71.

n93 Jefferson's draft bill, supra note 87, at 191-92 (6 Jefferson's Works), at 360 (22 Jefferson's Papers).

n94 Joseph Barnes, Treatise on the Justice, Policy, and Utility of Establishing an Effectual System for Promoting the Progress of Useful Arts, By Assuring Property in the Products of Genius (Philadelphia, Francis Bailey 1792).

n95 Id. at 20 (emphasis in original).

n96 E-23848 10, reprinted in Edward C. Walterscheid, To Promote the Progress of Useful Arts: American Patent Law and Administration, 1787-1836 473, 477 (1998). E-23848 may also be found in the American Antiquarian Society's microfiche collection of early American documents. This provision was the result of a recommendation in Alexander Hamilton's Report on the Subject of Manufactures communicated to the House on December 5, 1791. See 10 Alexander Hamilton, The Papers of Alexander Hamilton 1 (Harold C. Syrett ed., 1966).

n97 For a discussion of the Board's problems in dealing with priority issues, see Frank D. Prager, The Steam Boat Interference 1787-1793, *40 J. Pat. Off. Soc'y 611 (1958).*

n98 *Id. at 639.*

n99 Fitch presented these papers to the Library Company in 1792 to be made available after his death, apparently for the purpose of demonstrating what he perceived to be the duplicity of Jefferson and the favoritism that Jefferson exhibited toward his archrival James Rumsey in their duel for patent priority with respect to the steamboat. Although obviously written from the perspective of Fitch, they provide a fascinating look at the early development of American patent law from the perspective of one highly involved inventor.

n100 Frank D. Prager, Proposals for the Patent Act of 1790, *36 J. Pat. Off. Soc'y 157, 166 n.28 (1954).* See also John Fitch, Steamship History, 244-246 (held by the Library Company, Philadelphia) and Fitch Papers doc. 2645, 2651-2 (held by the Library Company, Philadelphia and on file in the Library of Congress).

n101 *Graham v. John Deere Co., 383 U.S. 1, 57 U.S.P.Q. (BNA) 459 (1966);* see supra notes 32-47 and accompanying text.

n102 *Diamond v. Chakrabarty, 447 U.S. 303, 206 U.S.P.Q. (BNA) 193 (1980);* see supra notes 48-52 and accompanying text.

n103 *General Talking Pictures Corp. v. Western Elec. Co., 305 U.S. 124, 128 n.1, 39 U.S.P.Q. (BNA) 329, 331 n.1 (1938)* (Black, J., dissenting) (citing The Jeffersonian Cyclopedia 680 (Funk and Wagnall's 1900)).

n104 See, e.g., Merrill D. Peterson, Thomas Jefferson & The New Nation 938 (1970).

n105 6 Jefferson's Works, supra note 23, at 189 n.1.

n106 The Patent Board had originally scheduled a hearing for the first Monday of February, 1791 to resolve what it perceived to be a priority conflict between inventors John Fitch, James Rumsey, Nathan Read, and John Stevens. Walterscheid, supra note 96, at 187-88. Yet on January 25, State Department clerk Henry Remsen informed Fitch (and presumably the other parties as well) that the Board judging it most expedient not to proceed further in the business thereby committed to them, until a Bill supplementary to [the Patent Act of 1790], which is now before Congress, passes, have directed me to inform you, that the hearing of the Parties who have applied for Patents for the discovery of new applications of Steam to useful purposes [had been postponed.] Letter from Henry Remsen to John Fitch (Jan. 25, 1791) (Fitch Papers, Library of Congress). Remsen anticipated things a bit, because H.R. 121 was not actually introduced until February 7, 1791. H.J., 1st Cong. (3d Sess.) at 371.

n107 H.J., 1st Cong. (3d Sess.) at 402-09.

n108 22 Jefferson's Papers, supra note 23, at361.

n109 Walterscheid, supra note 96, at 467.

n110 Letter from Thomas Jefferson to Hugh Williamson, supra note 86, at 328 (6 Jefferson's Works), at 295 (22 Jefferson's Papers).

n111 Id. Jefferson based his conclusion on the following analysis: 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 extions 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 favor? Id. The Patent Act of 1793 rejected Jefferson's view that only a defendant in an infringement action should have the right to seek to invalidate the patent, and instead permitted such action to be brought by anyone within three years from the date of issuance of the patent. Act of 1793, ch. 11, 10, 1 Stat. 318.

n112 As has been shown, E-23848 is H.R. 166 and, while H.R. 166 contains elements of what Jefferson proposed, so many of its provisions are different from what Jefferson desired that there is simply no basis for suggesting that Jefferson drafted H.R. 166.

n113 Letter from Thomas Jefferson to Hugh Williamson, supra note 65, at 458.

n114 Act of Feb. 21, 1793, ch. 11, 11, 1 Stat. 318.

n115 Id. 1.

n116 Id. 1.

n117 Id. 3.

n118 Id. 7.

n119 Id. 11.

n120 Jefferson's draft bill, supra note 87, at 190 (6 Jefferson's Works).

n121 Id. at 191.

n122 Id.

n123 Id. at 192.

n124 Id.

n125 Letter from Thomas Jefferson to Hugh Williamson, supra note 86, at 328 (6 Jefferson's Works).

n126 *General Talking Pictures Corp. v. Western Elec. Co, 305 U.S. 124, 128 n.1, 39 U.S.P.Q. (BNA) 329, 331 n.1* (quoting 6 Jefferson's Writings I, supra note 23, at 181) (emphasis supplied by Black, J., dissenting).

n127 Letter from Thomas Jefferson to Isaac McPherson (Aug. 13, 1813), in 13 Jefferson's Writings II, supra note 23, at 335.

n128 What were known were geographic licenses limiting the licensed authority to particular geographic areas. Jefferson seems never to have suggested that such licenses were somehow invalid or illegal.

n129 Dumas Malone, Jefferson and the Rights of Man (2 Jefferson and His Time) 284 (1951).

n130 *General Talking Pictures, 305 U.S. at 129 n.1, 39 U.S.P.Q. 331 n.1* (Black, J., dissenting) (quoting 6 Jefferson's Writings I, supra note 23, at 372). See also Letter from Thomas Jefferson to Thomas Cooper (Aug. 25, 1814), in 14 Jefferson's Writings II, supra note 23, at 174.

n131 *Bonito Boats, Inc. v. Thunder Craft Boats Inc., 489 U.S. 141, 147, 9 U.S.P.Q.2d (BNA) 1847, 1850 (1989).*

n132 According to Jefferson, these two rules were "that a change of material should not give title to a patent" and "that a mere change of form should give no right to a patent." See *Graham v. John Deere Co., 383 U.S. 1, 10 n.3, 148 U.S.P.Q. (BNA) 459, 464, n.3 (1966)* (quoting Letter from Thomas Jefferson to Isaac McPherson (Aug. 13, 1813), in 6 Writings of Thomas Jefferson (Washington ed.) at 181). The Patent Act of 1793 provided "that simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery." Act of Feb. 21, 1793, ch. 11, 2, 1 Stat. 318.

n133 *Bonito Boats, 489 U.S. at 147, 9 U.S.P.Q.2d at 1851* (quoting 13 Writings of Thomas Jefferson, at 326-27 (Memorial ed. 1904)) (emphasis in original). See also Letter from Thomas Jefferson to Isaac McPherson, supra note 127, at 326.

n134 See *Evans v. Jordan & Morehead, 13 U.S. (9 Cranch) 199, 203-04 (1815).*

n135 Letter from Thomas Jefferson to Isaac McPherson, supra note 127, at 326.

n136 *Evans, 13 U.S. (9 Cranch) at 201-3.*

n137 Letter from Thomas Jefferson to Isaac McPherson, supra note 127, at 326-27.

n138 *Evans v. Weiss, 8 F. Cas. 889 (C.C.D. Pa. 1809)* (No. 4,572); *Evans v. Robinson, 8 F. Cas. 886 (C.C.D. Md. 1813)* (No. 4,571).

n139 Letter from Thomas Jefferson to Isaac McPherson, supra note 127, at 326-27.

n140 Id.

n141 Id. at 326. It is interesting that Jefferson should make such an argument because in this very same letter he presented a most convincing argument as to why inventions "cannot, in nature, be a subject of property." Id. at 334.

n142 Id. at 327.

n143 *Graham v. John Deere Co., 383 U.S. 1, 9, 148 U.S.P.Q. (BNA) 459, 463 (1966).*

n144 Donald S. Chisum & Michael A. Jacobs, Understanding Intellectual Property Law 2B[4][c], at 2-15 (1992).

n145 Letter from Thomas Jefferson to Thomas Cooper (Jan. 16, 1814), in 14 Jefferson's Writings II, supra note 23, at 62. In this letter, Jefferson asks Cooper if he has seen the memorial to Congress concerning Evans' patent rights. Id. Jefferson notes the "memorialists" also published his letter to Isaac McPherson concerning those rights, and Jefferson goes on to note that "the abuse of the frivolous patents is likely to cause more inconvenience than is countervailed by those really useful." Id.

n146 P.J. Federico, The Patent Trials of Oliver Evans, *27 J. Pat. Off. Soc'y 586, 657 (1945).*

n147 *Id. at 608, 671.*

n148 *Id. at 593.*

n149 Interestingly, after Evans' first patent and his renewal patent had expired, both were judicially held to be invalid. But this was not because of any belief that the invention was unpatentable, but rather, because of judicial holdings that the specifications of the issued patents failed to comply with statutory requirements as interpreted by the courts. *Evans v. Chambers, 8 F. Cas. 837 (C.C.D. Pa. 1807)* (No. 4,555); *Evans v. Eaton, 20 U.S. (7 Wheat.) 356 (1822).*

n150 Act of July 4, 1836, ch. 357, 6, 5 Stat. 117. See also *Markman v. Westview Instruments, Inc., 517 U.S. 370, 375, 38 U.S.P.Q.2d (BNA) 1461, 1466 (1996)* (explaining that "[c]laim practice did not achieve statutory recognition until the passage of the Act of 1836 . . . and inclusion of a claim did not become a statutory requirement until 1870."); Chisum & Jacobs, supra note 144, 2B[2], at 2-11.

n151 Letter from Thomas Jefferson to Oliver Evans (Jan. 16, 1814), in 14 Jefferson's Writings II, supra note 23, at 68.

n152 Id. at 66.

n153 Letter from Thomas Jefferson to Thomas Cooper, supra note 130, at 174.

n154 See supra notes 120-125 and accompanying text.

n155 See supra note 119 and accompanying text.

n156 *Diamond v. Chakrabarty, 447 U.S. 303, 308, 206 U.S.P.Q. (BNA) 193, 197 (1980)* (quoting Letter from Thomas Jefferson to Oliver Evans (May, 1807), in 5 Writings of Thomas Jefferson, at 75-76 (Washington ed.)).

n157 See Letter from Thomas Jefferson to Hugh Williamson, supra note 65, at 459.

n158 Jefferson's draft bill, supra note 87, at 190, 192 (6 Jefferson's Works).

n159 Letter from Thomas Jefferson to Hugh Williamson, supra note 65, at 459.

n160 Id.

n161 It was this language that Justice Frankfurter relied upon in his dissent in *Marconi Wireless Telegraph Co. v. United States, 320 U.S. 1, 61 n.1, 57 U.S.P.Q. (BNA) 471, 497 n.1 (1942).* See supra notes 30-31 and accompanying text.

n162 This was exactly what James Rumsey proposed to Jefferson in 1789, but Jefferson declined to incorporate such a provision into his 1791 patent bill. Letter from James Rumsey to Thomas Jefferson (June 6, 1789), in 15 Jefferson's Papers, supra note 23, at 171.

n163 Letter from Thomas Jefferson to Isaac McPherson, supra note 127, at 337-38. Within the year this letter was widely republished in memorials to the Congress and in newspapers and journals. Walterscheid, supra note 96, at 324 n.60; Federico, supra note 146, at 670.

n164 As noted, a basic tenet of Jefferson's 1791 patent bill had been a switch from examination to registration.

n165 Letter from Thomas Jefferson to Isaac McPherson, supra note 127, at 338.

n166 *Graham v. John Deere Co., 383 U.S. 1, 10, 148 U.S.P.Q. (BNA) 459, 464 (1966).*

n167 Id.

n168 Letter from Thomas Jefferson to Oliver Evans, supra note 151, at 67.

n169 Id.

n170 *Graham, 383 U.S. at 9, 148 U.S.P.Q. at 463.*

n171 *Id. at 7-8, 148 U.S.P.Q. at 463.*

n172 Letter from Thomas Jefferson to Isaac McPherson, supra note 127, at 334.

n173 Letter from Thomas Jefferson to Thomas Cooper, supra note 145, at 62.

n174 Letter from Thomas Jefferson to George Fleming (Dec. 29, 1815), in 14 Jefferson's Writings II, supra note 23, at 369.

n175 Letter from Thomas Jefferson to James Madison (Dec. 20, 1787), in 1 The Republic of Letters at 512 (James Morton Smith ed., 1995); Letter from Thomas Jefferson to James Madison (Aug. 28, 1789), id. at 630.

n176 Letter from Thomas Jefferson to Hugh Williamson, supra note 65, at 459.

n177 *Bonito Boats v. Thunder Craft Boats, Inc., 489 U.S. 141, 147, 9 U.S.P.Q.2d (BNA) 1847, 1850 (1980).*

n178 Edward C. Walterscheid, Patents and the Jeffersonian Mythology, *29 J. Marshall L. Rev. 269 (1995).*

n179 Act of Apr. 10, 1790, ch. 7, 2, 1 Stat. 109.

n180 In a somewhat different context, C. Miller has written that it was Jefferson's failure "to distinguish between a patent as a spur to invention and a patent as a spur to production (and production as the prelude to profit)" that caused him only with the greatest of reluctance to accept the idea of a patent grant at all, much less have the idea incorporated into the Constitution. See Charles A. Miller, Jefferson And Nature, An Interpretation 204 (1988).

n181 Letter from Thomas Jefferson to Isaac McPherson, supra note 127, at 337-38.

n182 Burchfiel, supra note 1, at 167, appears to have been the first commentator to point this out.

n183 For example, the idea that a change in the form or proportions of a machine ought not to constitute invention was suggested to him by James Rumsey in 1789. Letter from James Rumsey to Thomas Jefferson, supra note 162, at 171. Rumsey argued that "if every form that a machine can be put into should intitle [sic] a different person to use the same principle; there is no machine extent [sic] but what might be varied as often as their [sic] is days in a year, and still answer nearly the same purpose." Id.

n184 *Graham v. John Deere Co., 383 U.S. 1, 7, 148 U.S.P.Q. (BNA) 459, 463 (1966).*

n185 See supra notes 87-90 and accompanying text.

n186 *Graham, 383 U.S. at 8, 148 U.S.P.Q. at 463* (quoting Letter from Thomas Jefferson to Oliver Evans (May, 1807), in 5 Writings of Thomas Jefferson, at 75-76 (Washington ed.)).

n187 Id.

n188 See supra notes 91-100, notes 114-125, and accompanying text.

n189 *Graham, 383 U.S. at 9, 148 U.S.P.Q. at 463.*

n190 See supra notes 143-45 and accompanying text.

n191 Letter from Thomas Jefferson to Isaac McPherson, supra note 127, at 334.

n192 Letter from Thomas Jefferson to Oliver Evans, supra note 151, at 67.

n193 *Graham, 383 U.S. at 10, 148 U.S.P.Q. at 464.*

n194 Letter from Thomas Jefferson to Isaac McPherson, supra note 127, at 337-38.

n195 Levy, supra note 9, at 313.

n196 See, e.g., Chemerinsky, supra note 3; Schnaffer, supra note 9.

n197 Merrill D. Peterson, The Jefferson Image In The American Mind (1960). For a more recent perspective see Peter S. Onuf, The Scholar's Jefferson, 50 Wm. & Mary Q. (3d Series) 671 (1993).