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Edward C. Walterscheid

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ESSAY

PATENTS AND THE JEFFERSONIAN MYTHOLOGY

EDWARD C. WALTERSCHEID*

INTRODUCTION

A bust of Thomas Jefferson is prominently displayed in the United States Patent and Trademark Office. To the extent that they have any knowledge on the subject, most of those who work at the office believe that Jefferson was, in no small measure, the father of the American patent system. Most of the patent attorneys and other professionals who do business with the Office also believe he was. As with many other things Jeffersonian, an interesting mythology has arisen concerning his role and influence in the early development of the United States patent law and the resultant patent system. A part of that mythology states that Jefferson strongly influenced the content of the Patent Act of 1790,¹ and that he was primarily responsible for drafting the Patent Act of 1793² which remained the law until 1836.³ In 1966

* Edward C. Walterscheid is Deputy Laboratory Counsel at the University of California's Los Alamos National Laboratory, Los Alamos, NM 87545. He has published numerous articles on various aspects of the patent law. Although this work was prepared under a contract between the University of California and the Department of Energy, the views expressed herein are those of Mr. Walterscheid only.

1. Act of April 10, 1790, 1 Stat. 109. See also Kendall J. Dood, *Patent Models and the Patent Law: 1790-1880 (Part I)*, 65 J. PAT. & TRADEMARK OFF. SOC'Y 187, 196 (1983). In that article Dood noted:

Clearly the fundamental changes made by the Senate to the House patent bill, by making patents more difficult to win, brought the bill more into conformity with Jefferson's own views on the subject, and with so much to suggest his involvement with the formulation of the first patent law, and nothing to indicate to the contrary, it seems almost unavoidable to conclude that he was, indeed, the author of these features of our first patent law.

Id. See also Page Smith, 3 THE SHAPING OF AMERICA: A PEOPLE'S HISTORY OF THE YOUNG REPUBLIC 345 (1980) ("As secretary of state Jefferson had prevailed on Congress to pass the necessary [patent] legislation."); Levi N. Fouts, *Jefferson the Inventor, and His Relation to the Patent System*, 4 J. PAT. OFF. SOC'Y 316, 322 (1922) ("The first patent law . . . was drawn in conformity with Jefferson's ideas of what it should be. . . .").

2. Act of February 21, 1793, 1 Stat. 318. The Supreme Court played an instrumental role in advancing this point of view. It stated unequivocally in 1938, 1966 and again in 1980 that he was the author of the Act of 1793. See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 7 (1966). In 1989 the Court apparently decided that some equivocation was more in accord with the historical reality and now was

the Supreme Court significantly added to the mythology by saying that "[b]ecause of his active interest and influence in the early development of the patent system, 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."⁴ Jefferson, like several other founding fathers, left a tremendous amount of papers and correspondence for posterity to review.⁵ When asked about his view on patents, Jefferson freely expressed his opinion, as he normally was prepared to discuss most issues brought to his attention. His mythology thus has evolved precisely because his views on a variety of patent matters are better known than those of any other founding father.

Jefferson's mythology is alive and well.⁶ Surprisingly, however, very little detailed analysis of what Jefferson actually wrote about the early patent law and patent system exists.⁷ The expressions that exist about his role in developing that law and system have been largely conjectural and, to a considerable degree, based

stating more cautiously that Jefferson "played a large role in the drafting of our Nation's second Patent Act, which became law in 1793." *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 147 (1989). In *General Talking Pictures*, the Court cites *The Jeffersonian Cyclopedia* but in none of the later cases does the Court provide a specific citation supporting the views it sets forth with regard to Jefferson's role in the drafting of the Act of 1793. *General Talking Pictures Corp. v. Western Elec. Co.*, 305 U.S. 124, 138 (1938). It is possible that it sought to rely on the views expressed by Ford. See *infra* text accompanying notes 97-99.

3. Act of July 4, 1836, 5 Stat. 117.

4. *Graham*, 383 U.S. at 8.

5. The most recent effort to compile and edit Jefferson's papers and correspondence at Princeton University has now run through 25 volumes and has only reached the period to mid 1793. See, e.g., *THE PAPERS OF THOMAS JEFFERSON* (Julian P. Boyd et al. eds., 1956-92) [hereinafter *PAPERS OF JEFFERSON*]. Earlier works commonly cited are the 12-volume *The Works of Thomas Jefferson* and the 20-volume *The Writings of Thomas Jefferson*. *THE WORKS OF THOMAS JEFFERSON* (Paul Leicester Ford ed., 1904) [hereinafter *WORKS OF JEFFERSON*]; *THE WRITINGS OF THOMAS JEFFERSON* (Andrew A. Lipscomb et al. eds., 1903) [hereinafter *WRITINGS OF JEFFERSON*].

6. See, e.g., Paul J. Riley, *Patenting Dr. Venter's Genetic Findings: Is the National Institutes of Health Creating Hurdles or Clear the Path for Biotechnology's Voyage into the Twenty-First Century?*, 10 J. CONTEMP. HEALTH L. & POLY 309, 309 (1994) ("We have a 200-year old patent system established by Thomas Jefferson. . . ."); D. G. Scalise and D. Nugent, *Patenting Living Matter in the European Community: Derivement of the Draft Directive*, 16 FORDHAM INT'L L.J. 990, 1005 n.73 (1993) ("In 1952 Congress recodified the patents laws, the original language of which was written by Jefferson."); Note, *Standards of Protection for Databases in the European Community and the United States: Feist and the Myth of Creative Originality*, 27 GEO. WASH. J. INT'L L. & ECON. 457, 487 n.191 (1993).

7. The recent analysis does not contain the detail and context that I propose to pursue. See, e.g., Margaret Chon, *Postmodern "Progress": Reconsidering the Copyright and Patent Power*, 43 DEPAUL L. REV. 97, 140-44 (1993).

on isolated aspects of his writings. Accordingly, this essay seeks, through a careful review of Jefferson's papers and documents pertaining to the patent law and the patent system, to ascertain exactly how Jefferson actually sought to influence the development of the patent system in this country. This essay also provides some perspective on the role he played — and continues to play — in the interpretation of the patent law. In short, this essay searches to find the reality behind the myth.

I. BACKGROUND OF THE PATENT CUSTOM

United States patent law derives from a constitutional grant of authority to the Congress "to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries."⁸ Near the end of the eighteenth century, when the United States system of patent law was coming into being, the term "patent" (short for letters patent) began to have a precise and technical meaning, *i.e.*, a grant of monopoly power by the state over the commercial exploitation of an invention for a limited period.⁹ Prior to this time, the meaning attached to the term "letters patent" was much broader.¹⁰ Not surprising, when the Constitution was drafted in 1787, it made no reference to patents but, instead, it spoke of an authority to grant a limited term exclusive right to an inventor for his or her invention. Nonetheless, the first patent act in 1790, although entitled "An Act to Promote the Progress of Useful Arts," would expressly authorize the grant of letters patent.

In 1787, the European patent custom was several centuries old. Having originated in the Italian city states, it later spread to the German principalities, the Netherlands, France and England.¹¹ As Prager has noted, the legal forms of letters patent, at least in the English context, were not only time-honored but time-worn.¹² In 1623, the Statute of Monopolies¹³ provided the statutory foundation for the English patent custom, although the custom had existed in England for at least fifty years. In 1787, the statute was just beginning to receive considerable interpretation

8. U.S. CONST. art. 1, § 8, cl. 8.

9. See, *e.g.*, CHRISTINE MACLEOD, *INVENTING THE INDUSTRIAL REVOLUTION: THE ENGLISH PATENT SYSTEM, 1660-1800* 10 (1988).

10. Edward C. Walterscheid, *The Early Evolution of the United States Patent Law: Antecedents (Part 1)*, 76 J. PAT. & TRADEMARK OFF. SOC'Y 697, 700 (1994) [hereinafter *Evolution*].

11. *Id.* at 705-15.

12. Frank D. Prager, *Historic Background and Foundation of American Patent Law*, 5 AM. J. LEGAL HIST. 309, 309 (1961).

13. 21 Jam., c. 3, VII STATUTES AT LARGE 255.

in the common law courts. Under the common law at this time, no right to a patent existed, although an inventor could protect the exclusive privilege created by a patent at common law. A patent was uniquely the creature of the royal prerogative granted by the grace of the sovereign, and what the sovereign could grant, it could take away.¹⁴

A patent custom, involving exclusive grants of privilege for limited terms with respect to invention and importation, existed in a number of the American colonies and states prior to the formation of the federal patent system.¹⁵ America's custom developed on a parallel with England's system, albeit on a much more sporadic and less uniform scale. The patent custom in the colonies — such as it was — depended largely on the activities of local assemblies and legislatures which, "while not formally invested with such sovereign power, readily assumed the authority in practice."¹⁶ After the Revolution, the state assemblies and legislatures — beginning where their colonial predecessors ended — continued to exercise this self-assumed authority.¹⁷

II. JEFFERSON'S EARLY VIEWS

The Jefferson papers leave no clear indication when he became aware of a patent custom, either in Europe or in America, although he may have received an inkling of such a custom during the period when he studied and practiced law between 1762 and 1774. Nor do the papers clearly express when Jefferson first perceived a limited term exclusive right in invention as a property right, although he certainly viewed it in this light in 1791.¹⁸ The

14. See MACLEOD, *supra* note 9, for a discussion of the origin and development of the English patent custom to 1800.

15. Although occasional reference is made to colonial and state "patent systems" (see, e.g., M. Sherwood, *The Origins and Development of the American Patent System*, 71 AM. SCIENTIST 500 (1983)), it is a misnomer to characterize the early American patent custom as such because there was neither the uniform administrative practice nor the consonant legal principles applicable under a rule of law which properly define a "patent system." Bugbee carefully points out that, during the colonial era, neither the English patent practice nor that in the colonies was under what could properly be described as a "patent system." See BRUCE W. BUGBEE, *THE GENESIS OF AMERICAN PATENT AND COPYRIGHT LAW* 83 (1967).

16. E. BURKE INLOW, *THE PATENT GRANT* 36 (1950).

17. Although historians frequently refer to colonial and state "patents," the individual grants of limited-term monopoly rights made by the colonial legislatures and assemblies with respect to both importation and invention were not patents per se and were never held as such. During the colonial period, it was clearly understood that a grant of letters patent fell solely and uniquely within the royal prerogative. While the colonial grant might be quite similar to the royal letters patent, no one could call it such because that would usurp the royal prerogative. Perhaps as a holdover from the colonial custom, the states never called their early grants patents either before enactment of a federal patent law.

18. The first United States patent statute, the Act of 1790, which Jefferson was

first express reference Jefferson makes to the patent custom occurs in a letter written in 1787 while he was Minister to France and the Constitutional Convention was meeting.

In response to a French citizen who had invented a method of better preserving flour and who had inquired as to whether the United States government might want to purchase it, Jefferson stated:

But I am not authorized to avail my country of it by making any offer for its communication. Their policy is to leave their citizens free, neither restraining nor aiding them in their pursuits. *Tho' the interposition of government in matters of invention has its use, yet it is in practice so inseparable from abuse, that they think it better not to meddle with it.*¹⁹

The italicized language, while undoubtedly representing Jefferson's personal views at the time, was not, strictly speaking, accurate.

The government Jefferson referred to was the Continental Congress operating under the authority granted by the Articles of Confederation, and he was correct as to its lack of authority, but wrong as to the reason for that lack of authority. No existing materials indicate that the Congress had ever imparted to Jefferson any views concerning the granting of rights to inventions. The Congress did understand that under the Articles it could only exercise that authority expressly granted to it by the states, which did not include authority to issue patents or provide in any other fashion for exclusive rights with regard to inventions. Therefore, Congress made no attempt to do so.²⁰ Moreover, since 1781, various state governments had indeed interposed in the matter through the issuance of state patents, although Jefferson may have been largely unaware of this fact.²¹ Accordingly, one cannot help but conclude that to a considerable extent Jefferson spoke *ex curia* and assumed that his views were consonant with those of the United States Government.

Jefferson would have been surprised and perhaps a bit taken aback had he known that less than two weeks after he wrote this

largely responsible for administering in his role as Secretary of State, did not say a word about any property right in a patent. Act of Apr. 10, 1790, 1 Stat. 109. However, in 1791 he proposed that Congress change the statute to refer expressly to a patent as an exclusive property right in an invention. See *infra* text accompanying note 121.

19. Letter from Jefferson to Jeudy de L'Hommande (Aug. 9, 1787), in 12 PAPERS OF JEFFERSON, *supra* note 5, at 11 (emphasis added).

20. See Edward C. Walterscheid, *To Promote the Progress of Science and Useful Arts: The Background and Origin of the Intellectual Property Clause of the United States Constitution*, 2 J. INTEL. PROP. L. 1, 4-9 (1994).

21. See BUGBEE, *supra* note 15, at 84-103 for the issuance of state patents during this period.

letter, delegates at the Constitutional Convention introduced proposals which ultimately resulted in the express grant of authority to the Congress to interpose in the matter of invention in exactly the manner that he thought so inseparable from abuse. When James Madison sent him a draft of the Constitution, Jefferson wrote back in December 1787 to express his general satisfaction, but also to note his concern that the draft did not have a bill of rights. In setting forth his views on what a bill of rights should include, he indicated that it should provide "clearly and without the aid of sophism . . . for restriction against monopolies."²² In making this statement, he did not distinguish between bad monopolies and good monopolies (which patents presumably were).

When Jefferson found that the requisite nine states had ratified the Constitution, he expressed his pleasure to Madison in July 1788 and amplified his views concerning monopolies, in particular the patent monopoly, saying:

It is a good canvas, on which some strokes only want retouching. What these are, I think sufficiently manifested by the general voice from North to South, which calls for a bill of rights. It seems pretty generally understood that this should go to [among other things] . . . Monopolies. . . . [I]t is better . . . to abolish . . . Monopolies, in all cases, than not to do it in any. . . . The saying there shall be no monopolies lessens the incitements to ingenuity, which is spurred by the hope of a monopoly for a limited time, as of 14. years; but the benefit even of limited monopolies is too doubtful to be opposed to that of their general suppression.²³

Here, Jefferson argued that the grant of authority to Congress to issue patents (and copyrights as well) should be expressly amended out of the Constitution. His reference to a patent term of fourteen years also suggests some familiarity with the patent provisions of the Statute of Monopolies, which expressly set a term of fourteen years for English patents.

Madison responded several months later by commenting:

With regard to Monopolies they are justly classed among the greatest nuisances [sic] in Government. But is it clear that as encouragements to literary works and ingenious discoveries, they are not too valuable to be wholly renounced? Would it not suffice to reserve in all cases a right to the public to abolish the privilege at a price to be specified in the grant of it? Is there not also infinitely less danger of this abuse in our Governments than in most others? Monopolies are sacrifices of the many to the few. Where the power is in the few it is natural for them to sacrifice the many to their own partialities and corruptions. Where the power, as with us, is in the many not the

22. Letter from Jefferson to Madison (Dec. 20, 1787), in 1 *THE REPUBLIC OF LETTERS* 512 (James Morton Smith ed., 1995).

23. Letter from Jefferson to Madison (July 31, 1788), *id.* at 545.

few, the danger can not be very great that the few will thus be favored. It is much more to be dreaded that the few will be unnecessarily sacrificed to the many.²⁴

Madison's argument that copyrights and patents were monopolies that the government should tolerate because of the public good they could produce was, in essence, the common law justification for these limited-term grants. His suggestion that the government could issue patents and copyrights, with a proviso whereby the federal government could rescind them upon payment of a specified price, was an approach that several states had taken, but would never appear in the federal patent law.

Whether because of Madison's argument or otherwise, Jefferson now resigned himself to the inevitability that Congress would have the authority to issue patents and copyrights. However, he still would have preferred a change in the Constitution regarding that authority. In August 1789, Jefferson informed Madison that he would have been pleased if the proposed Bill of Rights had stated: "Monopolies may be allowed to persons for their own productions in literature and their own inventions in the arts for a term not exceeding — years but for no longer term and no other purpose."²⁵ Had the Congress adopted this language in the Bill of Rights, it would have avoided much later difficulty concerning the issues of whether American law authorized patents of importation²⁶ and the extent to which the government should renew or extend patents.²⁷ Jefferson's aversion to patents of importation at this time is perhaps not surprising, because he still believed that the destiny of the United States resided primarily in its agricultural production rather than any manufacturing base. Whether he would have taken this position after serving as Secretary of State and as President is an interesting question.²⁸

On June 6, 1789, James Rumsey wrote to Jefferson from England that he had just received letters from the United States indicating that a committee of Congress had been formed "to bring in a bill for establishing an office for establishing . . . exclusive wrights [sic] to inventors."²⁹ Rumsey stated that "This is a busi-

24. Letter from Madison to Jefferson (Oct. 17, 1788), *id.* at 566.

25. Letter from Jefferson to Madison (Aug. 28, 1789), *id.* at 630.

26. The first patent statutes were ambiguous in their wording and did not expressly preclude patents of importation which both France and Great Britain routinely granted. See Edward C. Walterscheid, *Novelty in Historical Perspective (Part II)*, 75 J. PAT. & TRADEMARK OFF. SOC'Y 777, 783 (1993) [hereinafter *Novelty*].

27. See P. J. Federico, *The Patent Trials of Oliver Evans*, 27 J. Pat. Off. Soc'y 657, 664 (1945) (discussing the trials and tribulations associated with the renewal and extension of the fourth federal patent issued).

28. No one will likely answer this question conclusively, because Jefferson never again specifically addressed the issue. Unlike Alexander Hamilton, he did not believe that the constitutional language precluded patents of importation.

29. Letter from James Rumsey to Jefferson (June 6, 1789), in 15 PAPERS OF

ness that is at present upon, but a bad footing in any part of world; England I believe has fixed it on the best [patent] Establishment, yet it is far short of being Equitable or Encouraging to ingenious men. . . ."³⁰ Moreover, Rumsey argued "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."³¹ He went on to state that:

[t]he French method of having [sic] new inventions examined [sic] by a committee of philosophical characters, before grants can be obtained, is certainly a good one, as it has a tendency to prevent many simple projectors from ruining themselves by the too long persuit [sic] of projects that they know but little about.³²

This letter probably caused Jefferson, for the first time, to actually contemplate what the content of a patent law in the United States might be.

III. CREATING THE PATENT ACT OF 1790

In his exchanges with Madison concerning the constitutional language, Jefferson could not have envisaged that within a few short years he would have the primary responsibility for administering the new United States patent law. Yet this is precisely what occurred, and the Jeffersonian mythology, in particular, arose from this period.

When Jefferson came to New York in March 1790 to assume his duties as Secretary of State, Congress was debating H.R. 41, the bill that became the Patent Act of 1790. The juxtaposition of Jefferson's arrival with certain changes made in this bill by the Senate has led to the argument that he significantly influenced the content of the first patent statute. As this section will show, this was almost certainly not the case, at least in the context that historians and scholars have suggested.

Dood, in particular, argues that Jefferson's influence caused the Senate to make significant changes to H.R. 41.³³ He contends that the elimination of language, which would have expressly authorized patents of importation, as well as the inclusion of language that required patent models, are clear evidence of

JEFFERSON, *supra* note 5, at 171.

30. *Id.*

31. *Id.* Rumsey seems to have argued that the first inventor of a new principle of machinery should have the right to a broad genus claim dominating all other forms or improvements in the machinery.

32. *Id.*

33. Dood, *supra* note 1, at 196.

Jefferson's influence on the first patent law.³⁴ In so doing, Dood considerably misapprehends the import of the evidence on which he bases his conjecture.

The first patent bill, H.R. 10, introduced on June 23, 1789, had died at the end of the first session of the First Federal Congress.³⁵ In Washington's address to Congress on January 8, 1790, at the commencement of the second session, he recommended "the expediency of giving effectual encouragement . . . to the introduction of new and useful inventions from abroad, as to the exertions of skill and genius in producing them at home."³⁶ Although Washington used language that was very diplomatic, he let Congress know that he favored the passage of legislation that would expressly cover patents of importation as well as true invention.

On January 11, 1790, the Senate responded with the following statement: "The introduction of new and useful inventions from abroad, and the exertions of skill, genius in producing them at home . . . are objects which shall receive such early attention as *their respective importance requires*."³⁷ In polite, but unmistakable language, the Senate notified Washington that it would decide when to enact appropriate legislation, and that it viewed native invention and importation as clearly having different levels of importance.³⁸

On February 16, 1790, the new patent bill, H.R. 41, was introduced in the House. This bill was similar in most respects to H.R. 10, which in turn had been rather closely patterned after the English common law of patents. Two important differences between the bills, however, created an express authorization of patents of importation. The phrase "not before known or used" was

34. *Id.*

35. INLOW, *supra* note 16, at 48. Inlow stated, "[t]hat it is probable that this bill was drafted by Jefferson" is based on an egregious misreading of the source cited, i.e., VI WORKS OF JEFFERSON, *supra* note 5, at 189. This citation is to a patent bill drafted by Jefferson which will be shown to have been introduced on February 7, 1791, almost 10 months after the Patent Act of 1790 became law. In short, Inlow confuses the first bill seeking to create what ultimately became the Patent Act of 1793 with the first bill seeking to create what would become the Patent Act of 1790.

36. See George Washington's address to Congress (Jan. 8, 1790), in III THE DOCUMENTARY HISTORY OF THE FIRST FEDERAL CONGRESS OF THE UNITED STATES at 253 (Linda Grant De Pauw et al. eds., 1977) [hereinafter DOCUMENTARY HISTORY].

37. *Proceedings in Congress During the Years 1789 and 1790, Relating to the First Patent and Copyright Laws*, 22 J. PAT. OFF. SOC'Y 243, 255 (1944) (emphasis added).

38. Dood suggests that this Senate language indicates a willingness to grant "patents to importers of new devices and processes as well as to native inventors," which was the usual and traditional approach to patenting. Dood, *supra* note 1, at 194. More likely, the Senate viewed patents of importation with less favor than patents for invention.

now expressly qualified by "in the United States."³⁹ In addition, a new Section 6 expressly stated that the government should treat the first importer of any art, machine, engine, device or invention, or any improvement thereon, as if he or she were the original inventor or improver within the United States.⁴⁰ As Dood correctly notes, one could reasonably infer from Jefferson's earlier correspondence with Madison that he did not favor the patents of importation that this language authorized.⁴¹

Dood argues that Jefferson was responsible for the major Senate amendments to H.R. 41 reported out of committee on March 29, 1791.⁴² He bases his argument on the coincidence between this action, Jefferson's arrival in New York on March twenty-first, Jefferson's supposedly "obvious interest in the bill as its future executor" and the nature of the amendments,⁴³ and in particular, the supposed removal of the authorization for patents of importation.⁴⁴

Although the known facts, do not specifically show who was responsible for the particular amendments on which Dood relies, they rather conclusively indicate that Jefferson was not. First, the House, and not the Senate, determined to remove the new Section 6 from H.R. 41 almost a fortnight before Jefferson arrived in New York to commence his duties. As I have shown elsewhere, one Richard Wells presented a petition to the House on March fourth to have Section 6 removed and was successful when the House deleted Section 6 before sending H.R. 41 to the Senate on March eleventh.⁴⁵ Moreover, Jefferson spent the greater part of his first week in New York "in almost unbroken conference with" President Washington.⁴⁶ Also, as Jefferson informed Washington in September 1792, he began his service as Secretary of State with the determination "to intermeddle not at all with the legislature" and "as I never did intermeddle, so I certainly shall not begin now."⁴⁷

The Senate received a copy of Wells' petition along with the

39. Thus, *e.g.*, Section one of H.R. 41 required the petitioner to allege that the invention was "not before known or used *within the United States*." *Id.* In addition, Section two required the specification "to distinguish the invention from other things before known and used *in the United States*." *Id.*

40. IV DOCUMENTARY HISTORY, *supra* note 36, at 1626-32.

41. Dood, *supra* note 1, at 196.

42. *Id.*

43. *Id.* at 195.

44. *Id.* at 196.

45. *Novelty*, *supra* note 26, at 780-82.

46. LEONARD D. WHITE, THE FEDERALISTS 103 (1948).

47. *Id.* at 95. He may have begun his tenure with such a determination but he did not follow through on it because he drafted the patent bill introduced in February 1791. Moreover, the mere existence of a draft patent bill prepared by him at some time during 1791 suggests that he was more than a bit disingenuous with Washington.

amended H.R. 41. It recognized that in the immediate press of business both Wells and the House had failed to appreciate that more than merely removing Section 6 was required to preclude express authorization for patents of importation. It also required removal of the phrase "in the United States" as a qualifier to "not before known or used." Because the Senate concurred with the House's view that the legislature should not authorize patents of importation, it removed "in the United States" more as a house-keeping amendment than anything else.⁴⁸

Dood relies on this house-keeping amendment, together with the insertion of a requirement for patent models, to support his view that Jefferson influenced the Senate amendments. With regard to the model requirement, Dood points to several reasonably contemporaneous papers of Jefferson referring to his interest in models. Yet, none of these papers makes any reference to patent models. Moreover, no existing materials indicate that merely because Jefferson found models useful in his discussions of mechanical things, he sought to require the use of models in the patenting process.⁴⁹ While Jefferson may well have been aware of these and other changes made by the Senate and quite likely approved of them, he did not initiate them.⁵⁰

IV. THE PATENT BOARD

The first federal patent statute became law on April 10, 1790.⁵¹ The statute completely vested the power to issue patents in three high officials, the Secretaries of State and the Department of War and the Attorney General. Any two of these officials could authorize the issuance of a patent. These three officials, who for the sake of convenience will be referred to as the patent board, out of necessity had to interpret the new patent statute. Little contemporaneous documentation exists about the roles and views of the respective members of the board regarding the issuance of patents. What little does exist pertains almost exclusively to Jefferson.⁵² The combination of Jefferson's department being re-

48. *Novelty*, *supra* note 26, at 783.

49. Dood has built a rather elaborate edifice seeking to show that Jefferson was responsible for the Senate model requirement. He acknowledges, however, that it is wholly conjectural. Dood, *supra* note 1, at 199-200. While Jefferson undoubtedly approved of the Senate model requirement, no historical record suggests that he was in fact responsible for it.

50. A possibility remains that Jefferson may have influenced the Senate change from the registration system of H.R. 41 to the form of examination system that went into effect in the Act of 1790. In this regard, Rumsey's letter of June 6, 1789, indicating approval of the French examination system may have caused him to suggest something of the sort. While such a view is plausible, no contemporaneous evidence exists to support it.

51. Act of Apr. 10, 1790, 1 Stat. 109.

52. When writing about the activities of the board, Jefferson made no attempt

sponsible for the ministerial acts involved in issuing patents and his interest in all things scientific and technical leaves little doubt that Jefferson, as Secretary of State, played the most influential role in the interpretation and practice under the Act of 1790.⁵³

The Act expressly conditioned the issuance of a patent to the circumstance, wherein at least two members of the patent board agreed that the invention or discovery was "sufficiently useful and important."⁵⁴ However, the Act provided the patent board with very little guidance concerning the criteria it should use to determine whether to issue a patent. Aside from requiring that the invention be "not before known or used" and "sufficiently useful and important," the Act did not set forth any other requirements.⁵⁵ Moreover, the Act did not provide definitions for the meaning of any of these terms.⁵⁶ The patent board was thus left almost entirely to its own devices in implementing the Act.

The patent board had to deal with both ministerial and patentability issues. Because Jefferson's department was responsible for issuing patents, it is likely that the other two board members deferred to him on almost all ministerial issues. In addressing one of the first ministerial issues, the board quickly agreed that the term of an issued patent would be fourteen years.⁵⁷ Another ministerial issue that Jefferson must have quickly addressed for the board was the format and content of an issued patent. The few extant copies of patents issued under the Act of 1790 suggest that the board adopted a rather standardized format of a single paragraph for the patents it authorized. This paragraph named the inventor, provided a "description" of the invention, and included a granting clause which set forth the exclusive right under the Act.⁵⁸

In view of Jefferson's methodical approach to almost everything he did, he quite likely had the board adopt standardized language for those portions of the patent that the board could

to distinguish who proposed what, but instead almost invariably referred to the board rather than any of its members.

53. Jefferson's role might have been quite different had the Congress adopted the proposal by John Vining of Delaware in July 1789. Vining proposed that in addition to the Departments of War, Treasury and State, a Home Department have as a part of its duties the management of patents and copyrights. WHITE, *supra* note 46, at 132. In rejecting this proposal, Congress "was influenced by a desire to hold the new government to an acceptable economy and by the opinion that [the fifteen tasks proposed for the Home Department] could be distributed among the three departments already created." *Id.*

54. Act of Apr. 10, 1790, 1 Stat. 109.

55. *Id.*

56. *Id.*

57. The Act stated that the board could cause patents to issue "for any term not exceeding fourteen years." *Id.*

58. *The First United States Patent*, 36 J. PAT. OFF. SOC'Y 615, 617 (1954).

reasonably expect to standardize. Thus, for example, the Act provided that "the said patents . . . shall be prima facie evidence that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers of the thing so specified."⁵⁹ It was therefore reasonable to assume some type of standardized wording for both the granting clause and the preamble to the effect that the named inventor "hath invented" the described invention. Indeed, the board seems to have generally followed such an approach. On at least one occasion, however, the board chose to use more circumspect language suggesting or implying that perhaps the petitioner was not prima facie the inventor.⁶⁰ In the one particular instance where historians know this occurred, Jefferson was responsible for the use of the language limiting the presumption.⁶¹

One example of the patentability issues that faced the board, was what interpretation should it give to the phrase "not before known or used"?⁶² Undoubtedly the board knew that the Senate had deleted the restrictive language "in the United States" from this phrase. This clearly seemed to suggest the Act intended to limit novelty to the circumstances wherein the "invention or discovery" had not been known or used elsewhere in the world. Aside from the pragmatic difficulty of trying to ascertain what was old in the United States, much less the rest of the world, the rules of statutory construction at the end of the eighteenth century did not permit one to look at the legislative history to interpret the words of a statute.⁶³ Moreover, the punctuation of the Act suggested that the phrase "not before known or used" was intended literally to modify only "any improvement therein," and not "any useful

59. Act of Apr. 10, 1790, 1 Stat. 109.

60. The patent to John Fitch begins said language, to wit: "Whereas John Fitch . . . *hath presented a petition . . . alleging and suggesting that he hath invented*" and concludes with a grant of "the sole and exclusive right and liberty of making, using, and vending to others to be used, the said invention, *so far as he, the said John Fitch, was the inventor, according to the allegations and suggestions of the petition.*" Karl B. Lutz, *Evolution of U.S. Patent Documents*, 19 J. PAT. OFF. SOC'Y 390, 395-96 (1937) (emphasis added).

61. John Fitch's patent was one of four that the board issued on the same day after the board refused to determine priority among those seeking patents for the same or similar inventions. *Id.* Jefferson undoubtedly chose this language precisely because a priority determination had not been made. Although no one knows the language of the three other patents issued that same day, they most likely contained similar qualifying language.

62. Section 1 of the Act required a petitioner for a patent to allege the invention of "any useful art, manufacture, engine, machine, or device, or any improvement therein *not before known or used.*" Act of Apr. 10, 1790, 1 Stat. 109.

63. H. Jefferson Powell, *The Original Understanding of Original Intent*, 98 HARV. L. REV. 885, 897 (1985) ("The modern practice of interpreting a law by reference to its legislative history was almost wholly nonexistent. . .").

art, manufacture, engine, machine, or device."⁶⁴ Faced with these difficulties, the board apparently adopted a pragmatic approach, making no attempt to distinguish between original and improvement inventions on the issue of novelty, or to ascertain what was known outside the United States. Indeed, little evidence exists to suggest that the board made any serious attempt to ascertain what was previously known in the United States.⁶⁵

Nonetheless, because it had neither case law nor statutory definitions to guide it, the board had to attempt to establish a general framework for what it would consider patentable. In this, it was never entirely successful.⁶⁶ Writing some twenty years after the board had ceased to exist, Jefferson described the process:

Considering the exclusive right to invention as given not of natural right, but for the benefit of society, I know well the difficulty of drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not. As a member of the patent board for several years, while the law authorized a board to grant or refuse patents, I saw with what slow progress a system of general rules could be matured. Some, however, were established by that board. One of these 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, because the first perhaps had occasion so to 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. Another rule was that a change of material should not give title to a patent. As the making a plowshare of cast

64. Prager certainly interpreted it this way in 1954 when he stated that "novelty was required only for improvements, not for arts, machines, etc." Frank D. Prager, *Proposals for the Patent Act of 1790*, 36 J. PAT. OFF. SOC'Y 157, 165 (1954).

65. Again, Jefferson quite likely suggested this. He could be quite legalistic when he chose. He and the board benefitted in determining that the statute did not obligate them to ascertain whether the invention was in fact novel, *e.g.*, not before known or used, but rather only whether it was "sufficiently useful and important" to warrant a patent. The contemporaneous record does not support Peterson's assertion that Jefferson "scrupulously guarded the privilege and investigated every claim to satisfy the test of originality." See M.D. PETERSON, *THOMAS JEFFERSON AND THE NEW NATION* 450 (1970). While Jefferson did indeed seek to maintain a reasonably high standard of patentability, he did not — and indeed could not have — investigated the originality of every invention proposed to be patented.

66. As Jefferson stated many years later:

the patent board, while it existed, had proposed to reduce their decisions to a system of rules as fast as the cases presented should furnish materials. They had done but little when the business was turned over to the courts of justice, on whom the same duty has now devolved.

Letter from Jefferson to Thomas Cooper (Aug. 25, 1814), in *XIV WRITINGS OF JEFFERSON*, *supra* note 5, at 174.

rather than of wrought iron; a comb of iron instead of horn or of ivory, or the connecting buckets by a band of leather rather than of hemp or iron. A third was that a mere change of form should give no right to a patent, as a high-quartered shoe instead of a low one; a round hat instead of a three-square; or a square bucket instead of a round one. But for this rule, all the changes of fashion in dress would have been under the tax of patentees.⁶⁷

As Jefferson tacitly admits in this same letter, either the board slowly developed these rules and did not apply them to early patents, or it made an exception to them with respect to at least one.

The patent in question, issued to Oliver Evans in January 1791, involved improvements in the milling of flour and meal and covered what, in effect, could be construed as five separate mechanical inventions.⁶⁸ The patent board seems to have developed an elementary division rule obligating inventions directed to distinct subject matter to coverage by separate patents, but permitting inventions related to the same subject matter to coverage by a single patent.⁶⁹ As Jefferson said with respect to three of the inventions covered by Evans' patent many years after the fact: "The elevator, the conveyor, the hopper-boy, are distinct things, unconnected but by juxtaposition."⁷⁰ He expressly argued in 1813 that the patent coverage for the elevator was invalid because such coverage violated all three of the general rules the patent board had set forth, *i.e.*, the elevator constituted merely the new use of an old device; it only involved a change of materials; and it constituted a mere change of form (square buckets instead of round).⁷¹

Jefferson also stated that: "These were among the rules which the uniform decisions of the board had already established, and under each of them Mr. Evans' patent would have been refused."⁷² Unfortunately, this statement is internally inconsistent. The record revealed that Evans' patent had in fact issued reading on his elevator so that the board had not refused the coverage of the elevator. Most likely, Jefferson's recollection had suffered

67. Letter from Jefferson to Isaac McPherson (Aug. 13, 1813), in XIII WRITINGS OF JEFFERSON, *supra* note 5, at 335.

68. P. J. Federico, *Operation of the Patent Act of 1790*, 18 J. PAT. OFF. SOC'Y 237, 247 (1936).

69. *Id.* A report by Henry Remsen, chief clerk in the State Department, makes reference to a requirement for division with respect to six separate inventions by one Leonard Harbaugh. *Id.* The inventions related to such disparate subject matter as a bark grinding machine, a pumping machine, a hemp and flax machine, a dredging machine, a rice shelling machine and a plan for propelling boats. *Id.* at 246.

70. Letter from Jefferson to Isaac McPherson (Sept. 18, 1813), in XIII WRITINGS OF JEFFERSON, *supra* note 5, at 381.

71. Letter from Jefferson to Isaac McPherson (Aug. 13, 1813), *id.* at 335.

72. *Id.* at 335-36.

somewhat with time, and when the board authorized Evans' patent in December 1790, the board had not yet uniformly established these rules. This is not surprising because the patent was only the fourth one the board issued under the Act of 1790.

The board also found itself having to deal with a dilemma which, while not unique to the United States patent system, nonetheless caused it a great deal of difficulty. At issue was the appropriate means of establishing priority of invention between conflicting claimants because the Act of 1790 did not provide any guidance. This same problem existed under the British system which had yet to satisfactorily resolve it. The British would ultimately adopt a standard procedure (as would the rest of the industrialized world with the exception of the United States) whereby, if separate individuals contended that they made the same invention, it was not the first to invent, but the first to petition for letters patent who would receive the patent, assuming always that the petitioner met the requisite formalities.⁷³ This "first to file" system has the decided advantage of simplicity,⁷⁴ and there was nothing which seemed to preclude the board from adopting it. However, the board did not adopt the system, and the primary reason for this appears to have been Thomas Jefferson.

A priority contest of sorts occurred on April 22, 1791, when the board held a hearing for four parties, all of whom wanted patents covering some aspect of steam navigation and inventions relating to steam engines.⁷⁵ During this hearing, the board discussed and discarded the idea of using a "first to file" approach. One of the parties, John Fitch, actually raised the issue when he asked that the board grant him the "oldest" patent. In response, Attorney General Edmund Randolph indicated that the "oldest" patent — by that he seems to have meant that which would issue first and might well be considered dominant depending on its content — should go to the first applicant.⁷⁶ In a rather clear attempt to avoid any priority determination, Jefferson declared that the board would make no distinction in the date of the patents, but would issue all with the same date.⁷⁷

According to Joseph Barnes, who represented one of the parties, James Rumsey, at the hearing, Jefferson further stated:

73. The first to file in many instances might also invent first, but who actually invented first is irrelevant under such a system.

74. For this reason, all industrialized nations other than the United States have adopted it.

75. Federico, *supra* note 68, at 248.

76. FRANK D. PRAGER, *FITCH AUTOBIOGRAPHY* 197-98 (1982).

77. T. WESTCOTT, *LIFE OF JOHN FITCH* 327 (1878). As Fitch put it, "Mr. Jefferson said that they could make no distinction in the patents nor give one the preference [sic] of another." PRAGER, *supra* note 76, at 198.

that there are but two questions which [the board] can decide, viz. (1) whether the discovery be sufficiently useful and important, (2) the originality; and the latter, notwithstanding their decision, being appealable to a court and a jury, they therefore had determined not in any instance to go into the merits or determine the priority but to grant patents to all applicants.⁷⁸

Nothing exists to indicate the basis for Jefferson's belief that any decision of the board relating to originality or novelty was subject to judicial appeal, because the Act of 1790 provided no authority for such an appeal. In all likelihood, Jefferson seized on this as a pretext to avoid antagonizing either Fitch or Rumsey, who had contested priority of invention with respect to the steamboat for six years, first in the states and then in the new federal patent arena. If so, he completely misread both of them, for they were enraged, frustrated and ultimately defeated by the outcome. By taking this approach, Jefferson may have, all unwittingly, delayed the commercial development of steamboats for a decade or more.⁷⁹

Jefferson had other difficulties with priority issues. John Clarke engaged in a series of correspondence with him regarding a patent petition that was apparently filed in the fall of 1792. The patent was contested, and it was finally issued under the Act of 1793 with a date of December 31, 1793. The Act of 1793 resolved Jefferson's dilemma by authorizing a board of referees to determine priority.⁸⁰

Another bit of Jeffersonian lore suggests that as a part of his duties on the patent board, Jefferson subjected inventions to "strict scrutiny," required "working demonstrations" of them, and rejected "unworkable devices."⁸¹ Frequently cited in support of

78. Frank D. Prager, *The Steam Boat Interference 1787-1793*, 40 J. PAT. OFF. SOC'Y 611, 639 (1958).

79. Fulton succeeded only after having achieved a monopoly of the waters of New York state and after having expended well nigh \$100,000. He got the necessary monetary backing because he had exclusive rights and the right connections (by which he got Fitch's New York patent rescinded). By granting patents for steamboats to both Fitch and Rumsey, the board gave neither an exclusive right. As a consequence, neither could obtain the necessary financial backing to commercially develop their steamboat ideas.

80. See letters from Clarke to Jefferson (Nov. 10, 1792); Jefferson to Clarke (Dec. 14, 1792); Clarke to Jefferson (June 15, 1793); Jefferson to Clarke (June 28, 1793); and Clarke to Jefferson (July 17, 1793), in 24 PAPERS OF JEFFERSON, *supra* note 5, at 604-05. That Clarke won the first formal priority contest under the Act of 1793 is revealed only by the following notation in a listing of patents submitted to the Congress in 1805 by Secretary of State James Madison: "Disputed claim for a machine to work in a current of water, etc., decided in favor of John Clarke." The interference was with an application by Daniel Stansbury and Apollos Kinsley. See letter from James Madison to the Speaker of the House, Feb. 18, 1805, No. 193, AMERICAN STATE PAPERS, MISCELLANEOUS (8th Cong., 2d Sess. 1805).

81. Dood, *supra* note 1, at 199. See also Daniel Preston, *The Administration and*

these supposed facts is a 1791 letter in which Jefferson invites the recipient to witness a demonstration by "a person of the name of Isaacks [who] . . . has discovered an easy method of rendering sea-water potable. . . ."⁸² Jefferson adds that "I have had a cask of sea-water procured, and the petitioner has erected a small apparatus in my office, in order to exhibit his process."⁸³

Jefferson did indeed witness a series of experiments by Isaacks in his office.⁸⁴ The experiments, however, in no way related to a petition for a patent.⁸⁵ Rather, Isaacks had not sought a patent, but instead had petitioned the Congress, offering to give his secret process for desalinating sea water to the government in return for "a reward suitable to the importance of the discovery and in the opinion of government adequate to his expenses, and the time he has devoted to the bringing it into effect."⁸⁶ The House in turn asked Jefferson to investigate the matter. Jefferson prepared a detailed report to the Speaker of the House in which he outlined the recent history of desalination experiments and the actual experiments conducted in his office. He concluded that Isaack's supposed discovery "produced no advantage either in the process or result of the distillation."⁸⁷

On another occasion in December 1792, Jefferson inquired into the utility of an invention for sawing and polishing stone at the request of the Board of Commissioners of the Federal District (the new District of Columbia). He concluded that while the invention was ingenious (by this he may have meant that it was novel), it was inferior to stone cutting and polishing mills in use in Europe. Jefferson supplied a hand drawing of the European version to show why it was better. Nonetheless, the board had granted a patent for the mill some twenty months before Jefferson commented on it.⁸⁸

While the patent board must have on occasion inquired into the utility of particular inventions for which patents were sought

Reform of the U.S. Patent Office, 1790-1836, 5 J. EARLY REPUBLIC 331, 332 (1985).

82. Letter from Jefferson to James Hutchinson (Mar. 12, 1791), in 19 PAPERS OF JEFFERSON, *supra* note 5, at 614.

83. *Id.*

84. The background and results of these tests and the resulting correspondence and documentation are set forth in an Editorial Note, in 19 PAPERS OF JEFFERSON, *supra* note 5, at 608-14.

85. *Cf.* Peterson, *op. cit.*, who incorrectly asserts that Isaacks had in fact filed a patent application and that Jefferson's investigation was done for the purpose of determining whether a patent should issue. *See also* MALONE, *infra* note 97, who also makes this same incorrect assertion.

86. Report on Desalination of Sea Water (Nov. 21, 1791), in 22 PAPERS OF JEFFERSON, *supra* note 5, at 319.

87. *Id.* at 321.

88. Letter from Jefferson to the Commissioners of the Federal District (Dec. 13, 1792), in 24 PAPERS OF JEFFERSON, *supra* note 5, at 731-32.

(as indeed it was required to do to determine whether they were "sufficiently useful and important") nothing indicates that it routinely required working demonstrations of inventions before granting patents. As previously noted, the inventor had performed the oft-quoted desalination experiments conducted in Jefferson's office so that Jefferson could respond to a request received from the House of Representatives and not for the purpose of determining whether to issue a patent. More than anything else, pragmatic constraints on the time of the members of the patent board precluded them from subjecting each and every patent application to "intense scrutiny" and obligating petitioners to show that their inventions functioned in the manner claimed.⁸⁹

Several months after passage of the Act of 1790, Jefferson wrote:

An Act of Congress authorising [sic] the issuing patents for new discoveries has given a spring to invention beyond my conception. Being an instrument in granting the patents, I am acquainted with their discoveries. Many of them indeed are trifling, but there are some of great consequence which have been proved by practice, and others which if they stand the same proof will produce great effect.⁹⁰

Although many have sought to take these words of Jefferson literally as showing that (a) the Patent Act did indeed act as a spur to invention and (b) this supposed spur to invention greatly impressed Jefferson, a word of caution is in order. In the two and one-half months that passed after the enactment, it is doubtful that many inventions occurred and even less likely that any one of those occurred because of the existence of the Patent Act.

It does seem clear, though, that the logjam of patent petitions that had grown during the preceding two years while Congress decided how to deal with them, had been almost entirely transferred to the Secretary of State for action.⁹¹ In addition, inventors who waited to see how Congress would address the issue of granting exclusive rights to inventors likely filed a number of new petitions directly with the Secretary of State. Thus, this flood of patent petitions was more likely the "spring to invention" cited by Jefferson, than any outright burst of invention. Be that as it may,

89. Jefferson himself noted that the board simply did not have the time to engage in a detailed review of each patent application or petition. See *infra* text accompanying note 116.

90. Letter from Jefferson to Benjamin Vaughan (June 27, 1790), in 16 PAPERS OF JEFFERSON, *supra* note 5, at 579. Note that this is a typical example of a proud American boasting to an Englishman of the new nation's accomplishments. I am indebted to Eugene R. Sheridan for this observation.

91. There were at least 20 patent petitions pending before Congress at the time the Act of 1790 was passed.

Jefferson obviously had read these petitions and formed preliminary conclusions with respect to the inventions covered by them at the time he penned this oft-quoted language.⁹²

Nonetheless the patent board moved cautiously and, by the end of 1790, had only "granted" three patents.⁹³ The board granted thirty-three in 1791, eleven in 1792, and ten in 1793, prior to February twenty-first, when the Patent Act of 1793 came into being. Thus, under the Act of 1790, the board issued fifty-seven patents.⁹⁴ The number of petitions for patents received during the time the Act of 1790 was in force is not known. P.J. Federico states that 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."⁹⁵ In his 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.⁹⁶

Clearly, the board received a great many more petitions for patents than it actually issued. Dumas Malone suggests that the dearth of issued patents resulted because Jefferson rejected "unworkable devices as well as those that were frivolous or amounted only to obvious improvements of things already well known and in common use."⁹⁷ Unfortunately, no contemporaneous documentation indicates why the board rejected any particular patent application, much less the reasons for apparently rejecting well over half of those that it received. Jefferson finally set forth the simple patentability rules developed by the board two decades later. It is unclear though when or to what extent the board actually applied these rules.⁹⁸

92. But he would later suggest that the granting of patents did in fact act as a spur to invention. Thus, in 1803 he wrote that: "In the arts, and especially in the mechanical arts, many ingenious improvements are made in consequence of the patent-right giving exclusive use of them for fourteen years." See letter from Jefferson to Pictet (Feb. 5, 1803), in *X WRITINGS OF JEFFERSON*, *supra* note 5, at 355-57. *Cf.*, however, his views expressed in 1813. See *infra* text accompanying note 162.

93. Four patents were dated in 1790; however, one to Oliver Evans was not delivered to him until January 7, 1791.

94. Federico, *supra* note 68, at 244. *Cf.* Peterson, *op cit.*, who incorrectly states that only 37 patents issued during Jefferson's tenure as Secretary of State. Actually, a total of 67 patents were issued during that period which extended through 1793. See *Historical Patent Statistics, 1791-1961*, 46 J. PAT. OFF. SOC'Y 89, 112 (1964). By comparison, in Great Britain 68 patents were enrolled in 1790; 57 in 1791; and 85 in 1792. See MACLEOD, *supra* note 9, at 150.

95. Federico, *supra* note 68, at 246.

96. *Id.* at 244.

97. DUMAS MALONE, *JEFFERSON AND THE RIGHTS OF MAN* 283 (1951).

98. As of April 1791, Jefferson was still taking the position that the board could

V. CREATING THE PATENT ACT OF 1793

It quickly became evident that neither the inventors nor the high government officials who comprised the patent board were happy with the Act of 1790. The delays in obtaining patents and the demands for more information by the board must have been highly frustrating for the inventors. The members of the board, and particularly Jefferson, began to recognize that they simply had insufficient time to properly carry out the tasks assigned to them under the Act. This, more than anything else, soon produced an understanding in the Congress that it had to amend the Act of 1790 to avoid having high government officials responsible for the issuance of patents. Thus, on December 9, 1790, only seven months after Congress had passed the Act of 1790, the House appointed a committee to bring in a bill or bills to amend the Act. This committee presented a bill, H.R. 121, on February 7, 1791, but Congress took no action on it before the session ended.

Another bill, H.R. 166, for the same purpose was not presented until March 1, 1792. Again, Congress failed to act on it. In the next session, yet another bill to create a new patent act, H.R. 204, was presented on December 10, 1792. This bill, in amended form, became the Patent Act of 1793. No specifically identified copy of it is available, but it apparently was quite similar to the bill introduced on March 1, 1792.

Against this background, the Supreme Court has on at least three occasions incorrectly stated that Jefferson drafted the Patent Act of 1793.⁹⁹ In reality, while Jefferson significantly influenced at least certain aspects of the Act of 1793, he did not draft it. He did, however, draft a patent bill which did not become law.¹⁰⁰ Considerable confusion exists among historians as to whether this bill was ever actually introduced, and if so, whether it was the bill introduced on February 7, 1791. Ford states unequivocally that "[t]his proposed bill was drafted by Jefferson, and introduced into the House of Representatives Feb. 7, 1791, by

only decide whether the invention was sufficiently useful and important to warrant and patent and whether it was original to the petitioner. See *supra* text accompanying note 78. Although Jefferson did believe that frivolous patents should not be granted, it is uncertain what he meant by "frivolous." To the extent that he used the term to encompass inventions, which he considered not sufficiently useful and important to be patented then, he was acting within the intent and meaning of the statute. However, it is not entirely clear that this was always what he meant. See *infra* text accompanying notes 182-84 for a discussion on this point.

99. See *supra* note 2.

100. The draft is reproduced in 22 PAPERS OF JEFFERSON, *supra* note 5, at 359-61; and VI WORKS OF JEFFERSON, *supra* note 5, at 189-93.

[Rep.] White."¹⁰¹ Federico also takes this view.¹⁰² Unfortunately, Ford complicates the matter by incorrectly stating that "[i]n the next Congress it was again introduced . . . and, after debate and amendment, was finally passed."¹⁰³

More recent editors take a different perspective. De Pauw *et al.* state that "[a] printed copy of what is probably the bill [introduced February 7, 1791] is E-23848."¹⁰⁴ Cullen *et al.* in turn accept the view that the February 7, 1791, bill is E-23848. They assign a date of December 1, 1791, to the Jefferson draft and state that what he did with it after drafting it is uncertain.¹⁰⁵ This essay seeks to show that the February 7, 1791, bill was not E-23848, but more likely was either Jefferson's draft or something closely akin to it and that E-23848 is in fact the March 1, 1792, bill.

Jefferson's draft contained a unique requirement not found in any earlier patent bill and not reproduced in any later patent bill. Specifically, it required that each inventor seeking a patent obtain a certificate from the Secretary of State:

wherein shall be inserted a shorter and more general description of the thing invented to be furnished by the applicant himself, in terms sufficient to point out the general nature thereof, and to warn against an interference therewith, *a copy of which certificate as also the warrant of the Secretary of the Treasury and Treasurer's receipt he shall file of record in the Clerk's officer in every District Court of the United States, and shall publish three times in some one Gazette of each of the said Districts.*¹⁰⁶

The italicized language was an extremely onerous provision which would have greatly increased the cost and extended the time of obtaining and enforcing a patent.

One could reasonably expect that when the draft became known, inventors would object strenuously. One particular inven-

101. VI WORKS OF JEFFERSON, *supra* note 5, at 189.

102. Federico, *supra* note 68, at 251.

103. IV WORKS OF JEFFERSON, *supra* note 5, at 189.

104. III DOCUMENTARY HISTORY, *supra* note 36, at 700 n. E-23848 is what is known as an Evans number and refers to the identifying number of a document published in Charles Evans' *American Bibliography* series.

105. 22 PAPERS OF JEFFERSON, *supra* note 5, at 361 n. According to Cullen *et al.*, "[t]he conclusive reason for assigning 1 Dec. 1791 to th[is] bill . . . is that TJ used that date when he recorded the draft of such a bill in SJPL. No record appears in SJPL for one prior to that date." *Id.* The acronym SJPL stands for the Summary Journal of Public Letters that covers Jefferson's tenure as Secretary of State. As Cullen *et al.* acknowledge, it was not compiled daily, but was prepared sometime later "as a record of his chief public papers of the period." *Id.* at ix. Consequently, the fact that Jefferson entered it into the SJPL on December 1, 1791 is in no way conclusive that it was prepared on or about that date.

106. 22 PAPERS OF JEFFERSON, *supra* note 5, at 359.

tor, John Fitch, did object. 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, [e]ntitled, '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."¹⁰⁷

Fitch's petition protested the proposed requirement for registration of each patent with every district court in the United States as well as publication in every such district by saying:

"The man who invented anything six years ago [this was a clear reference to himself and his invention of the steamboat in 1785], had no Idea that he must go all the way from Kentucky to Cape Cod, and then quite the Distance of Province of main[e], to publish his inventions, and to pay out large fees wherever he goes for the Same."¹⁰⁸

It is possible, but not likely, that Jefferson copied this onerous requirement from the bill introduced on February 7, 1791. Thus, Fitch could reasonably have referred to a bill based on Jefferson's draft. Since Fitch's petition was filed with the House on February 10, 1791, Jefferson's draft bill was most likely in existence prior to February 7, 1791.

In any case, E-23848 cannot be the bill introduced on February seventh because it does not contain the particular provision objected to by Fitch. Rather, good contemporaneous evidence shows that E-23848 is actually the second bill submitted to replace the Patent Act of 1790, which was introduced on March 1, 1792. Joseph Barnes published a pamphlet in Philadelphia in 1792, that was a commentary critical of both the Patent Act of 1790 and the March 1, 1792, bill.¹⁰⁹ With regard to the bill, the pamphlet stated that "it contemplates, at the *expense* of the *American genius* to import *European* arts and literature!!!"¹¹⁰ This expressly refers to the provision of E-23848 "That 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 or machines from foreign countries. . . ." ¹¹¹ No other patent bill of the

107. III DOCUMENTARY HISTORY, *supra* note 36, at 776.

108. VI DOCUMENTARY HISTORY, *supra* note 36, at 1644.

109. JOSEPH BARNES, TREATISE ON JUSTICE, POLICY, AND UTILITY OF ESTABLISHING AN EFFECTUAL SYSTEM OF PROMOTING THE PROGRESS OF USEFUL ARTS, BY ASSURING PROPERTY IN THE PRODUCTS OF GENIUS; TO WHICH ARE ADDED, OBSERVATIONS ON THE DEFICIENCY OF, AND EXCEPTIONS TO THE BILL REPORTED IN MARCH 1792 (Philadelphia 1792).

110. *Id.* at 20.

111. E-23848 at Section 10. 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.

period contained such language, so the comments of Barnes provide contemporaneous support for the view that E-23848 is in fact the March 1, 1792, patent bill.¹¹²

The presence of an express provision for determining priority of invention in E-23848, but not in Jefferson's bill, provides further evidence for the dating of the former at March 1, 1792, and the latter at February 7, 1791. Recall that in April 1791 the patent board unsuccessfully attempted to deal with the issue of priority when four separate inventors appeared to claim the same or similar inventions. If Jefferson had drafted his bill after April 1791, it most likely would have contained a provision that dealt with priority of invention, particularly because Jefferson was the one who had argued that the board could not determine priority under the Act of 1790. Since it did not contain such a provision, this is further evidence that it or a bill based on it was introduced on February 7, 1791.

Barnes also praised the French law that had come into being in 1791. Some historians have suggested that Barnes received information from Jefferson in this regard and that Barnes reflected Jefferson's views on the inadequacy of the existing American system.¹¹³ No contemporaneous documentation indicates that Jefferson did in fact favor the new French system, although he may indeed have brought it to the attention of Barnes. Again, however, we are in the realm of speculation.

In a letter dated February 4, 1791, Jefferson stated that "a bill is prepared for altering the whole train of business & putting it on a more easy footing."¹¹⁴ For the reasons previously discussed, Jefferson most likely referred to the bill he himself had drafted. He knew that the draft was in many significant ways quite different than the Act of 1790, and indeed intended to alter "the whole train of business."¹¹⁵ In particular, the bill intended to ease the burden on the patent board and the Secretary of State, by specifically changing from an examination system to a registration system, and by placing the burden of preparing the description on the applicant rather than on the board or a clerk in the office of the Secretary of State.

Jefferson believed that this was the crux of the matter. As he wrote in April 1792 with respect to the duty imposed on him by the Act of 1790:

112. It is possible, however, that E-23848 could be the December 10, 1792 bill and that this same provision was in the March 1, 1792 bill.

113. 24 PAPERS OF JEFFERSON, *supra* note 5, at 733-34.

114. Letter from Jefferson to Robert R. Livingston (Feb. 4, 1791), in VI WORKS OF JEFFERSON, *supra* note 5, at 187-88.

115. *Id.*

Above all things he prays to be relieved from it, as being, of every thing 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 and 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 crude & uninformed opinions on rights often valuable, and always deemed so by the authors.¹¹⁶

He also found that patentees were not happy with the descriptions of their inventions given in their patents. Some patentees believed the description was too detailed, and therefore, too restrictive of the scope of coverage of their inventions. Others contended that the description inaccurately reflected their invention.¹¹⁷ Jefferson did not oppose his department being responsible for issuing patents, but he quickly determined that the responsibility should be ministerial and not substantive.

Jefferson's bill proposed repealing the Act of 1790, and instead, allowing the Secretary of State to issue a patent on the following conditions: (1) that a designated fee be paid; (2) that an appropriate specification be provided; and (3) that a shorter and more general description be supplied by the applicant for inclusion in the patent itself. The patentee could not enforce the patent, however, until he had recorded it in every district court and published it in every district in the United States. The patentable subject matter was similar to that of the Act of 1790, although now the bill expressly included "composition of matter." This was the first known statement in the United States that a composition of matter should be patentable.¹¹⁸ The specification and model requirements were similar to those of the Act of 1790.

The bill continued to allow the defenses set forth in the Act of 1790, but certain new ones were now contemplated. Thus, for example, the alleged infringer could now show "that he did not know that there existed an exclusive right to the said invention" or that his "knowledge was not derived from any party from,

116. Letter from Jefferson to Hugh Williamson (Apr. 1, 1792), in 23 PAPERS OF JEFFERSON, *supra* note 5, at 363.

117. The Act required the patent to recite the allegations and suggestions of the petition and describe the invention "clearly, truly, and fully." This was obviously difficult to do in a one paragraph patent and must have led to some unpleasant exchanges between the patent board and patentees. As would be demonstrated with Oliver Evans' patent, an inaccurate and incomplete description could invalidate the patent, although it is not likely that Jefferson was particularly cognizant of this while he was Secretary of State.

118. Compositions of matter were being patented in Great Britain, but under the rubric of being called a manufacture.

through or in whom the right is claimed."¹¹⁹ This would presumably have cut off damages from the time prior to receipt of such knowledge, but not thereafter. The lack of derivation defense would have rendered it well nigh impossible for a patentee to obtain damages, except on a showing that the infringer had in fact derived his knowledge of the invention from the patentee or one claiming under the patentee's rights. In addition, the alleged infringer could have argued that the invention was "so unimportant and obvious that it ought not to be the subject of an exclusive right."¹²⁰ This appears to be the earliest American reference to what would ultimately become a fundamental tenet of the United States patent law, namely, that patentability is predicated on unobviousness as well as novelty.

The bill proposed several other changes to the Act of 1790 that are worthy of comment. First, the Secretary of State would issue a patent on the payment of a set fee into the U.S. Treasury rather than payment of fees to the various individuals involved in the process. Second, the bill allowed the petitioner to petition for "an exclusive property" in the invention.¹²¹ Third, the bill required that the board would only make the material of the specification, including any models, drawings and specimens, available to the public at the expiration of the patent term.¹²² Fourth, the bill contained an express proviso that obtaining a federal patent depended on surrendering any state patent rights that the petitioner had obtained before the ratification of the Constitution (but apparently not those state patents obtained after ratification).¹²³ Finally, the bill allowed the government to use the balance of the monies paid into the Treasury to purchase books for a public library at the seat of government.¹²⁴

119. 22 PAPERS OF JEFFERSON, *supra* note 5, at 360.

120. *Id.*

121. Insofar as can be ascertained, this was the first proposal anywhere that a patent be considered as an exclusive *property* in invention by statutory enactment.

122. Prager takes the view that this language was included at the specific behest of Rumsey. See Prager, *supra* note 64, at 166. There is little question that at this time most inventors shared the view that the specification should not be publicly available until the term of the patent expired. Jefferson was almost certainly aware of this view, but it probably was not the controlling factor in his decision to include this provision. Rather, it is more likely that his concern was to reduce the ministerial requirements placed on his clerks as much as possible. One obvious way to do that was to avoid any legal requirement — such as existed in the Act of 1790 — obligating him to provide copies of specifications to any one who requested them.

123. Whether this was what Jefferson actually intended is unclear, but it could be interpreted in this light and was certainly so interpreted by Fitch who thought it was a ruse to do away with his state patents while still permitting Rumsey to retain certain of his. See VI DOCUMENTARY HISTORY, *supra* note 36, at 1644.

124. This was part and parcel of Jefferson's life-long commitment to education

It should also be noted what Jefferson's bill did *not* contain. The bill made no reference to any of the patentability rules which many years later Jefferson claimed that the patent board had developed.¹²⁵ This rather clearly indicates that, at least as of early 1791, the board had not developed and implemented those rules, because had it done so Jefferson would very likely have incorporated them into his proposed bill. In any case, the Act of 1793 did have an express proviso "that simply changing the form or the proportions of any machine, or composition of matter, in any degree, shall not be deemed a discovery."¹²⁶

As previously noted, Jefferson's bill produced a strong protest from Fitch and not without considerable justification. Indeed, based on purely pragmatic considerations, Fitch's concerns had a great deal of merit. In particular, the bill required the patentee to file his or her patent in every district court in the land as well as publishing it in every district before the petitioner could enforce the patent. This provision would have resulted in the additional expenditure of substantial effort and money that would have made the costs and time involved in preparing and filing the patent minuscule by comparison. In view of the primitive state of the mail system, the only way a patentee could have complied with this requirement would have been to either personally or through a representative actually visit each district to assure that the necessary filing and publication took place. Fitch did not exaggerate when he declared that a patentee would have to travel from Kentucky to Cape Cod to Maine to accomplish the task.

Such an onerous provision would have resulted in a significant reduction in the number of patents actually sought, and the likely invalidation of many of those that did issue for failure to comply fully and completely with the requirements for publication and recordation in every judicial district. Since these same requirements were placed on patent assignment, they would have made transfer of rights in patents exceedingly difficult and would have substantially reduced the value of individual patents. One can only guess as to what Jefferson's motivation was in proposing them, but he obviously was not thinking in terms of the interests of patentees.¹²⁷

and learning.

125. See *supra* text accompanying notes 66 and 67.

126. Act of Feb. 21, 1793, § 2. This was exactly what Joseph Barnes had suggested. See BARNES, *supra* note 109 at 30-31. It is likely that Congress derived this language from him rather than from Jefferson.

127. Indeed, if his motives were nefarious, one can scarcely conceive of a more effective means of sabotaging the newly created federal patent system. It is doubtful that this was his actual intent. Nonetheless, throughout his life he retained a healthy skepticism about the value of the patent system, and there is little question that he wanted to limit the number of patents that would issue.

Whether because Congress had more important things to do or whether because of concerns with the content of Jefferson's bill, it took no action on the bill and allowed it to die when the session adjourned. As previously noted, the Second Federal Congress did not receive a new patent bill, *i.e.*, E-23848, until March 1, 1792. Jefferson did not author the bill, but he did comment in November 1791 on a subject that the chairman of the committee, responsible for drafting a new patent bill, proposed to incorporate into any new bill.¹²⁸ The bill would have permitted an inventor to challenge the validity of a patent in federal court through what would now be called a declaratory judgment, although under what circumstances is unclear.¹²⁹ Jefferson, who seems initially to have favored some ability to challenge patent validity independent of an infringement action, after some reflection:

found it more difficult than I had on first view imagined. 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 expenses & vexations of lawsuits, 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 found in his favor.¹³⁰

He 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.

Within a month after the March 1, 1792 bill was introduced, Jefferson provided his comments concerning it, although what they were is unknown.¹³¹ Thereafter, he apparently did not have any further direct connection with actions to amend or change the patent law,¹³² even while he was President. However, two de-

128. Letter from Jefferson to Hugh Williamson (Nov. 13, 1791), in VI WORKS OF JEFFERSON, *supra* note 5, at 328. The letter speaks of an "inclosed bill" but whether this was Jefferson's bill or an early version of E-23848 is unclear. From the context, it arguably is Jefferson's bill since he states he will "try to prepare a clause" if the objections he raises to it are overcome. It is possible that he sought to have his bill reintroduced in this session of the Congress, and this would account for the dating in the SJPL. See *supra* note 105. If so, he was unsuccessful, because for the reasons I have noted, the March 1, 1792 bill was most likely E-23848.

129. The Act of 1790 permitted such a challenge for a period of one year after issuance on the limited grounds that the patent "was obtained surreptitiously by, or upon false suggestion." The proposed clause seems to have expanded on this, but to what extent is unknown. Act of Apr. 10, 1790, 1 Stat. 109.

130. VI WORKS OF JEFFERSON, *supra* note 5, at 328.

131. Letter from Jefferson to Hugh Williamson (Apr. 1, 1792), *id.* at 458.

132. Centennial Edition, *The Patent Act of 1793*, 18 J. PAT. OFF. SOC'Y 77, 78 (1936).

acades later Jefferson would indicate that the registration system he had proposed, and that was incorporated into the Act of 1793, was a mistake.¹³³

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, patents would henceforth issue on payment of a set fee into the Treasury; the petition would be for an exclusive property right in the invention; compositions of matter were declared to be patentable; the petitioner would provide the description to be incorporated into the patent; state patents obtained prior to the particular state's ratification of the Constitution were invalidated upon receipt of a federal patent for the same invention; and, most importantly from his perspective, the patent would issue when the petitioner conformed to the ministerial requirements, *e.g.*, the system would now be one of registration rather than examination. Jefferson's proposals that every patent be registered and published in every district of the United States; that there be new lack of knowledge and lack of derivation defenses; that there be an unobviousness standard; that the specification not be publicly available until after the patent expired;¹³⁴ that there be no provision for a declaratory judgment of patent invalidity; and, that receipts from patent fees for books for a public library, were not accepted. While Jefferson exerted a significant influence on the content of the Act of 1793, he did not author it, nor was he responsible for most of its content.

VI. JEFFERSON'S LAST ACTION AS SECRETARY OF STATE

The Act of 1793 went into effect on February 21, 1793. Jefferson, who was still Secretary of State, wasted no time in proposing a new and simplified patent format to conform with the new law. In a memorandum to the Attorney General dated March 17, 1793, Jefferson sent for his examination:

... the abstract form of a patent proposed under the new law, wherein will be inserted the title only of the discovery, within the body of the instrument; and the description required by law to be in a schedule annexed to and making a part of the letters patent. [T]his will admit the very words of the petitioner to be used, without the possibility of importing to us either its legal defects, or grammatical improprieties.¹³⁵ [I]t will admit too of printing the

133. See *infra* text accompanying note 168.

134. Although for almost two decades, early in the nineteenth century, Superintendent of Patents William Thornton would refuse to provide copies of specifications of issued patents unless the patentee expressly authorized such release. See Edward C. Walterscheid, *When Patents Were Secret* (unpublished manuscript, on file with author).

135. What Jefferson did not address, but which the new format also effectively

whole of the letters patent with short blanks for the name of the inventor & title of his invention.¹³⁶ The patent certificate proposed by Jefferson would introduce the "schedule" into the lexicon of patent practice and would remain in effect in somewhat modified form for the next 73 years.¹³⁷

One of Jefferson's last official communications regarding a patent matter was a letter to Eli Whitney in which he stated that the board would issue a patent immediately upon the receipt of a model of his cotton gin. Jefferson also asked whether Whitney's machine had "been thoroughly tried in the ginning of cotton, or is it yet but a machine of theory?" He also wanted to know what quantity of cotton the machine could gin in several days and by how many hands? Finally, Jefferson asked the price of the machine. These questions had nothing whatsoever to do with the issuance of the patent, but rather were for his private interest — showing that he knew a good invention when he saw one.¹³⁸

VII. INITIAL INTERACTIONS WITH OLIVER EVANS

Jefferson's official relationship to the issuance of patents ended when he resigned as Secretary of State on December 31, 1793.¹³⁹ During the next ten years, he generally remained silent on his views respecting patent matters.¹⁴⁰ While serving as President Jefferson unofficially commented on the patent law as he understood it, but made no official pronouncement or effort to change the patent law. In 1813 and 1814, he took the opportunity to set forth his views privately on the patent law, and those views would soon become quite public. This section now begins a discussion of Jefferson's personal views on the patent law in his later years.

Jefferson finally revealed those views almost entirely as a

precluded, was the possibility that legal defects would be introduced if the office of the Secretary of State continued to be responsible for preparing the description to be a part of the patent. The possibility of this occurring was demonstrated in one of the earliest reported patent cases, *Evans v. Chambers*, decided in 1807. See *infra* text accompanying notes 147-52.

136. See K. B. Lutz, *Evolution of U.S. Patent Documents*, 19 J. PAT. OFF. SOC'Y 390, 408-09 (1937).

137. *Id.* at 397. See also T. G. FESSENDEN, *ESSAY ON THE LAW OF PATENTS FOR NEW INVENTIONS* 204-05 (1st ed. 1810) and 404-05 (2nd ed. 1822); W. PHILLIPS, *THE LAW OF PATENTS FOR INVENTIONS; INCLUDING THE REMEDIES AND LEGAL PROCEEDINGS IN RELATION TO PATENT RIGHTS* 523 (1837).

138. Letter from Jefferson to Whitney (Nov. 16, 1793), in *VIII WORKS OF JEFFERSON*, *supra* note 5, at 70-71.

139. As President, he would sign all issued patents; but aside from this ministerial function he would have nothing more officially to do with issuing them.

140. The only exception would be an almost off-hand comment in 1803 indicating a belief that the patent system did indeed promote invention. See *supra* note 92.

result of solicitations presented to him regarding the major litigation and controversy involved in the efforts of Oliver Evans to enforce two separate federal patents issued to Evans for the same subject matter. Evans, who obtained his first federal patent in January 1791, had expended considerable time and effort in advertising the value of his improvements in the milling of flour and had vigorously sought to license his patent rights. He had just as vigorously sought to defend those rights in court.¹⁴¹ To understand Jefferson's involvement in this area, a bit of background is required.

Evans, like most inventors of his time, thought that the fourteen year term of a federal patent was too short, and that at a very minimum, each patent holder should have an automatic right of renewal for some period of time.¹⁴² On December 21, 1804, he became the first patentee to formally petition the Congress for an extension of his patent right when he sought a seven-year extension "without injuring those who have already purchased the right of using it."¹⁴³ Much to his surprise and dismay, the Congress failed to act on this petition.¹⁴⁴

During the next session of Congress, Evans tried again even though the patent term had now expired,¹⁴⁵ and was again unsuccessful. Evans now changed his tack and on December 13, 1806, presented a more general petition seeking a modification of the patent law to extend the term of patents. It carried the resounding title of "Address of the Advocate of the Patentees, Inventors of Useful Improvements in the Arts and Sciences; Petitioners to Congress for Redress of Grievance . . . In Defense of Mental

141. For the details of Evans' long-term and massive effort to protect his patent rights, see Edward C. Walterscheid, *The Patent Management of Oliver Evans* (unpublished manuscript, on file with author).

142. See, e.g., FESSENDEN *supra* note 137, at 214. See also BARNES, *supra* note 109, at 6; New England Association of Inventors and Patrons of Useful Arts, *Remarks on the Rights of Inventors* (1807) at 11-12.

143. It is unclear why he waited until the eleventh hour to seek this extension, but he seems to have assumed (incorrectly) that the Congress would routinely give him a seven-year extension. See G. BATHE AND D. BATHE, *OLIVER EVANS: A CHRONICLE OF EARLY AMERICAN ENGINEERING* 101 (1935).

144. On January 22, 1805, the House Committee of Commerce and Manufactures recommended in favor of the term extension but also recognized that this was the first such request received by the Congress and that others were likely to seek term extensions. Accordingly, it suggested that the Congress amend the general patent law to allow for term extensions. See 1 ANNALS OF CONGRESS 1002-03 (Joseph Gales ed., 1789); see also No. 186, AMERICAN STATE PAPERS, MISCELLANEOUS (8th Cong., 2d Sess. 1805). A bill was prepared which would have accomplished both of these recommendations, but on February 6th, the House rejected it. See 2 ANNALS OF CONGRESS 1180-81 (1805). BATHE AND BATHE, *supra* note 143, at 103, incorrectly indicate that this was a bill for the renewal of Evans' patent.

145. Why he thought he could obtain an extension of an expired patent is not made clear in any of the extant documentation.

Property." Therein, he had the temerity to argue that patent rights should exist forever or at least for a minimum of fifty years. A week later, Evans wrote to President Jefferson stating that: "To represent the patentees petition to Congress for redress, I am making my last effort to draw the attention of the legislature of the nation to the oppressed and aggrieved state of the men of inventive genius of this country. . . ."¹⁴⁶ He hoped that Jefferson would look favorably upon this letter, because "one word from you would promote it more than all my feeble exertions."¹⁴⁷ Jefferson refused to engage in the issue, and Congress did nothing.

Somewhat surprisingly, however, Jefferson did address the matter some months later as a part of his response to another letter from Evans. As a part of Evans' continuing efforts to enforce his patent rights, he sued a miller named Chambers in Pennsylvania in 1804. For reasons which are unclear, the case did not come to trial until the spring of 1807. When it did, Evans received a most unpleasant surprise. Chambers' attorney did not deny infringement, but instead argued that the patent was invalid because the patent document failed to comply with the provisions of the Patent Act of 1790. Not prepared for such a response, Evans' attorney asked that the court carry the case over to its fall term, which it did. The next day, April seventeenth, Evans wrote to Jefferson describing what had occurred and in effect asking what he should do if the court deemed his patent invalid "owing to its want of legal form."¹⁴⁸

Jefferson's reply dated May 2, 1807 undoubtedly provided a great deal of solace to Evans. In essence, Jefferson stated that there were indeed legal conditions that were required to be met for the issuance of a patent under the Act of 1790, and that the offices of the Secretary of State, Attorney General and the President were necessary to assure that these conditions were met. When these officials were satisfied, they executed the patent, but the law did not require that the patent itself show that all necessary conditions of the law had been met. Moreover, to the extent the officials charged with performing the ministerial duties associated with the issuance of a patent failed to do so,

their negligence cannot invalidate the inventor's right, who has been guilty of no fault, [sic] On the contrary the patent which is a

146. BATHE AND BATHE, *supra* note 143, at 127.

147. *Id.* at 127.

148. *Id.* at 129-30. The idea of writing to the President of the United States concerning what had transpired in a federal court proceeding and fully expecting a reply would seem highly audacious today. However, under the circumstances it was not unreasonable, particularly since Jefferson was the Secretary of State who had issued the patent in question and he was quite familiar with the requirements of the Patent Act of 1790.

record, has conveyed a right to him from the public, and that it was issued rightfully ought to be believed on the signature of these high officials affixed to the patent, this being a solemn pledge on their part that the acts had been performed."¹⁴⁹

Almost as an aside, Jefferson then addressed the question of the patent term which Evans had raised five months earlier, saying:

Certainly an inventor ought to be allowed a right to the benefit of his invention for some certain time. It is equally certain it ought not to be perpetual; for to embarrass society with monopolies for every utensil existing, and in all the details of life would be more injurious to them than had the supposed inventors never existed; because the natural understanding of its members would have suggested the same things or others as good. How long the term should be is the difficult question. Our legislators have copied the English estimate of the term, perhaps without sufficiently considering how much longer, in a country so much more sparsely settled, it takes for an invention to become known, and used to an extent profitable to the inventor.¹⁵⁰

Here Jefferson comes out foursquare against any perpetual right in an inventor, although he does leave himself open to the possibility of an extension of the original patent term. Jefferson clearly recognizes both a societal interest and the interest of the inventor in a "profitable" return. He also accepts that the delineation of the patent term of necessity must seek to reconcile the conflict inherent in these two interests.

The Supreme Court would ultimately hold that Jefferson's advice concerning the legal form of the patent document was correct,¹⁵¹ but this was no solace for Evans. In *Evans v. Chambers*,¹⁵² one of the earliest reported patent cases in the United States, Justice Bushrod Washington, in his capacity as circuit judge, invalidated the patent. He stated that the patent failed to fully recite the suggestions and allegations regarding that portion of the invention known as the hopperboy, set forth in Evans' petition for patent.¹⁵³

149. XI WRITINGS OF JEFFERSON, *supra* note 5, at 200-02.

150. *Id.* at 201-02.

151. *See Hogg v. Emerson*, 47 U.S. (6 How.) 437, 437 (1848).

152. 8 Fed. Cas. 837, 838 (No. 4,555) (C.C.D.Pa. 1807).

153. *Id.* He relied on a literal reading of certain language of the Act of 1790 to reach his conclusion. Thus the Act required that the patent be made out "reciting the allegations and suggestions of the said petition," although it said nothing about what the specific content of the petition should be other than that it should set forth that the petitioner(s) "hath or have invented any useful Art, Engine, Machine, or Device, or any improvement therein not before known or used, and praying that a patent be granted therefor." Act of Apr. 10, 1790, 1 Stat. 109. As a consequence, petitions usually referred to the invention only by a title or other brief

VIII. JEFFERSON SPEAKS OUT

Evans immediately petitioned to Congress, protesting what he deemed as a highly inequitable result. Congress agreed, and where it had heretofore refused to grant a patent extension, it now passed a special act renewing the patent for a new term of fourteen years. President Jefferson signed it into law on January 21, 1808. Without realizing it, he and Congress, by authorizing the reissuance of a new patent three years after the first one had expired, had created a major contretemps. The whole theory behind patent law emphasizes that once a patent has expired, the right belongs to the public and all may freely use the invention. But what happens when Congress decides to give the right back to the inventor after the patent has expired, as it did with Evans? Clearly, during the intervening three years, those who had used the invention could freely do so without infringing upon any rights of Evans. But what of infringement that occurred after that time by those who had installed the machinery during the three-year period when no patent coverage existed?

Evans would have been well advised to voluntarily limit the scope of his patent right to those who had installed his patented improvements after the date of his new patent. However, he did not. Instead, Evans contended that he had a right to seek license fees or damages from all those using his patented improvements after the date of his patent, regardless of when they were installed. This approach, coupled with significant increases in the licensing fees, almost guaranteed that the patent would be the subject of extensive litigation, and indeed it was.¹⁵⁴

designation. Evans, however, had the misfortune of having been quite unusual in that his petition did apparently contain a detailed description of the hopperboy and its operation, which the clerk making out the patent in the office of the Secretary of State failed to incorporate. According to the Supreme Court many years later, Evans' petition constituted "the only exception found" to the general rule that petitions under the Act of 1790 did not provide detailed descriptions of the invention. *Hogg*, 47 U.S. at 481.

154. Through 1822 there were 44 reported patent cases and Evans was a party to twelve of them, eight at the circuit court level and four before the Supreme Court. The circuit court cases were: *Evans v. Eaton*, 8 Fed. Cas. 856 (No. 4,560) (C.C.D.Pa. 1818); *Evans v. Eaton*, 8 Fed. Cas. 861 (No. 4,561) (C.C.D.C. 1818); *Evans v. Kremer*, 8 Fed. Cas. 874 (No. 4,565) (C.C.D.Pa. 1816); *Evans v. Jordan*, 8 Fed. Cas. 872 (No. 4,564) (C.C.D.Va. 1813); *Evans v. Robinson*, 8 Fed. Cas. 886 (No. 4,571) (C.C.D.Md. 1813); *Evans v. Weiss*, 8 Fed. Cas. 888 (No. 4,572) (C.C.D.Pa. 1809); *Evans v. Chambers*, 8 Fed. Cas. 837 (No. 4,555) (C.C.D.Pa. 1807). The Supreme Court cases were: *Evans v. Hettich*, 20 U.S. (7 Wheat.) 453 (1822); *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356 (1822); *Evans v. Eaton*, 16 U.S. (3 Wheat.) 454 (1818); *Evans v. Jordan*, 13 U.S. (9 Cranch) 199 (1815). Evans actually engaged in significantly more patent litigation than this because throughout this period almost no district court cases were reported.

Among those Evans sued for infringement were a group known as the Baltimore millers, who vigorously disputed Evans' patent rights and sought to show that his patent was invalid. In seeking evidence to show that at least certain of Evans' patented improvements had been known and used before their invention by Evans, one of the Baltimore millers, Isaac McPherson, wrote to Jefferson on August 3, 1813, asking whether Jefferson had in his "possession a book of an old date that has the plates of the screw and elevators at work in a mill, for the same purpose as he [Evans] has them."¹⁵⁵ He further suggested that Evans might have derived his patented improvements from such a publication.¹⁵⁶

The Baltimore millers received more from Jefferson's response, dated August 13, 1813, which was rather quickly publicly disseminated,¹⁵⁷ than they anticipated. Jefferson gave a wide ranging exposition of his views on the patent law and the patent system, and went well beyond the specific query presented by McPherson.¹⁵⁸ Jefferson began by noting that he had received McPherson's letter "asking information on the subject of Oliver Evans' exclusive right to the use of what he calls his Elevators, Conveyers, and Hopper-boys." Of course, McPherson had not specifically asked this, but it gave Jefferson the opportunity to broaden the scope of his response which he did in detail.

Jefferson then presented his views concerning what he called the "retrospection" given to the 1808 Act for the Relief of Oliver Evans that authorized the new patent. He seemed 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. Moreover, Jefferson apparently understood that the circuit courts authorized Evans to claim royalties under his renewed 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 the infringing millers had received notice of the issuance of the new patent.¹⁵⁹ Jefferson strongly disagreed with this judicial interpretation. He ac-

155. The letter reproduced in BATH AND BATH, *supra* note 143, at 190.

156. *Id.*

157. Letter from Jefferson to McPherson (Aug. 13, 1813), in XIII WRITINGS OF JEFFERSON, *supra* note 5, at 326-38. It was published shortly after it was written, appearing as an addendum to vol. 5 of Nile's Weekly Register in Baltimore and almost immediately thereafter in 1 THE EMPORIUM OF ARTS AND SCIENCES 446-53 (New Series) (1814).

158. Letter from Jefferson to McPherson (Aug. 13, 1813), in XIII WRITINGS OF JEFFERSON, *supra* note 5, at 326-38. Thus, it was in this letter that Jefferson set forth the basic rules that he stated the patent board had developed more than 20 years earlier. *Id.* See *supra* text accompanying note 67.

159. See Weiss, 8 Fed. Cas. at 889-90; Robinson, 8 Fed. Cas. at 888; *supra* note 153.

knowledge 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." In his view, the retrospective construction was "contrary to natural right," and "[l]aws . . . abridging the natural right of the citizen, should be restrained by rigorous constructions within their narrowest limits." In 1815 the Supreme Court would disagree and uphold the views expressed by the circuit courts.¹⁶⁰

It was in this letter that Jefferson set forth his famous disavowal of any natural or inherent property right in invention, saying:

It has been pretended by some, (and in England especially,) that inventors have a natural and exclusive right to their inventions, and not merely for their own lives, but inheritable to their heirs. But while it is a moot question whether the origin of any kind of property is derived from nature at all, it would be singular to admit a natural and even an hereditary right to inventors. It is agreed by those who have seriously considered the subject, that no individual has, of natural right, a separate property in an acre of land, for instance. By a universal law, indeed, whatever, whether fixed or movable, belongs to all men equally and in common, is the property for the moment of him who occupies it, but when he relinquishes the occupation, the property goes with it. Stable ownership is the gift of social law, and is given late in the progress of society. It would be curious then, if an idea, the fugitive fermentation of an individual brain, could, of natural right, be claimed in exclusive and stable property. If nature has made any one thing less susceptible than all others of exclusive property, it is the action of the thinking power called an idea, which an individual may exclusively possess as long as he keeps it to himself; but the moment it is divulged, it forces itself into the possession of every one, and the receiver cannot dispossess himself of it. Its peculiar character, too, is that no one possesses the less, because every other possesses the whole of it. He who receives an idea from me, receives instruction himself without lessening mine; as he who lights his taper at mine, receives light without darkening me. That ideas should freely spread from one to another over the globe, for the moral and mutual instruction of man, and improvement of his condition, seems to have been peculiarly and benevolently designed by nature, when she made them, like fire, expansible over all space, without lessening their density in any point, and like the air in which we breathe, move, and have our physical being, incapable of confinement or exclusive appropriation. Inventions then cannot, in nature, be a subject of property. Society may give an exclusive right to the profits arising from them, as an encouragement to men to pursue ideas which may produce utility, but this may or may not be done, according to the will and

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

convenience of society, without claim or complaint from anybody.¹⁶¹

This impressive piece of writing shows that Jefferson likely gave considerable thought to the subject and awaited only the opportunity, given to him by McPherson, to express his views.

Jefferson further noted that he thought that until the United States copied her, England was "the only country on earth which ever, by a general law, gave a legal right to the exclusive use of an idea."¹⁶² Jefferson did acknowledge, though, that "[i]n some other countries it is sometimes done, in a great case, and by a special and personal act."¹⁶³ Of more particular interest in the present context, Jefferson next observed that "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."¹⁶⁴

With this observation, Jefferson was clearly disingenuous. He knew that France had enacted a general patent law in 1791 on principles directly contrary to those he espoused.¹⁶⁵ In 1813, England was in the middle of the industrial revolution and had the most advanced manufacturing capability in Europe. France was a close second. Both had general patent laws. Jefferson had no basis whatsoever for his contention that "the nations which refuse monopolies of invention, are as fruitful as England in new and useful devices." He simply had no way of knowing whether this was true or not, particularly when he seemingly did not have a very clear understanding of which countries granted exclusive rights in inventions. Jefferson could have legitimately argued that no hard economic data supported the view that patents encouraged invention, but he did not.¹⁶⁶

Besides his skepticism concerning the usefulness of the patent system as a whole, Jefferson had doubts concerning the merits

161. XIII WRITINGS OF JEFFERSON, *supra* note 5, at 333-34.

162. *Id.* at 334.

163. *Id.* Although Jefferson may have been unaware of it, there had been both an earlier general law in Venice and a much more wide spread use of the patent custom than he supposed. See *supra* note 10.

164. Letter from Jefferson to McPherson (Aug. 13, 1813), in XIII WRITINGS OF JEFFERSON, *supra* note 5, at 334. Cf. this with his statement in 1803 set forth in *supra* note 92.

165. France, through the patent law, believed that inventors did indeed have a natural, inherent property right in their inventions. See Frank D. Prager, *A History of Intellectual Property From 1545 to 1787*, 26 J. PAT. OFF. SOC'Y 711, 756-57 (1944) (discussing the French law of 1791).

166. Moreover, Jefferson seems entirely to have forgotten the view he had expressed in 1803, that the patent law did indeed appear to act as a spur to invention. See *supra* note 92.

and effectiveness of the registration system embodied in the Patent Act of 1793. As he stated to McPherson:

[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 if 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 law to find a single ray which would lighten the path of the mechanic or the mathematician. 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 law-suits. But England had given it to her judges, and the usual predominancy of her examples carried it over to ours.¹⁶⁷

Here Jefferson was again 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.¹⁶⁸ 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 in fact the person primarily responsible for its adoption by Congress.

Aside from these general issues of patent philosophy, Jefferson did address, in considerable detail, his understanding of what would now be called the "prior art" with respect to various aspects of Evans' patented improvements coupled with the "rules" established by the patent board. Jefferson began his discussion of patentability by assuming "it is a Lemma that it is the invention of the machine itself, which is to give a patent right, and not the application of it to any particular purpose, of which it is susceptible." As it would be phrased today, Jefferson took as his basic premise that a new use of an old machine is not patentable.¹⁶⁹ Based on this "lemma" and his review of what would now be termed the prior art coupled with application of the patentability rules developed by the board,¹⁷⁰ he concluded that the elevator

167. Letter from Jefferson to McPherson (Aug. 13, 1813), in XIII WRITINGS OF JEFFERSON, *supra* note 5, at 336-37.

168. Indeed a basic tenet of his 1791 patent bill had been a switch from examination to registration.

169. This basically prejudged the issue, because as the Supreme Court would subsequently point out, the issue turns not on whether the old machine is susceptible of a new use, but rather whether such new use would be obvious to one skilled in the art to which the new use is put. *See, e.g., Potts v. Creager*, 155 U.S. 597, 606-09 (1895).

170. *See supra* text accompanying note 67.

was old in the art and that the conveyor and hopperboy were new and patentable. Because the patent read on the unpatentable elevator, it would have been "refused" by the board.¹⁷¹ But this was not possible under the registration system in effect in 1808, when the second patent issued.¹⁷² While this may have been literally true, it was both irrelevant and to a considerable extent misleading.

It was irrelevant because patentability in 1808 was determined by the statutory provisions of the Act of 1793 and not by any rules the patent board may have adopted under the Act of 1790. Jefferson failed to inform McPherson that under the Act of 1793, the courts had clear statutory authority to invalidate the second patent if they viewed the invention as merely a change as being directly a change in form or proportion of an existing machine.¹⁷³ It was misleading because Jefferson ignored the fact that the board had indeed issued the first patent with a specification essentially identical to that of the second patent. Jefferson also failed to indicate that at the time Evans' first patent issued, *i.e.*, January 1791, the board had apparently yet to adopt these rules¹⁷⁴ and was not apparently engaging in any review of the "prior art."¹⁷⁵ Thus, Jefferson had set up a hypothetical construct without clearly identifying it as such.

IX. FINAL THOUGHTS

Why did Jefferson provide such a remarkably detailed and far-ranging response to a relatively innocuous inquiry from McPherson, whom he acknowledged he did not know? Jefferson himself suggested a two-fold answer in response. The first was that he truly believed that the retrospective interpretation of the

171. Presumably because the specification submitted by Evans was not sufficiently "particular . . . to distinguish the invention or discovery from other things before known or used." See Act of Feb. 21, 1793, 1 Stat. 318, § 2; Letter from Jefferson to McPherson (Aug. 13, 1813), in XIII WRITINGS OF JEFFERSON, *supra* note 5, at 336.

172. P. J. Federico suggests that Jefferson had in effect allowed the patent twice, first as a member of the patent board in 1790 and secondly when he as President signed the second patent in 1808. Federico, *supra* note 27, at 668. This suggestion has no merit because, pursuant to the Act of 1793, under which the second patent issued, Jefferson, as President, had absolutely no authority to refuse to sign a patent presented to him for signature. Jefferson could, however, have prevented the issuance of the second patent by vetoing the Act for the Relief of Oliver Evans. It is unlikely, however, that Jefferson gave much if any thought in 1808 to whether any reissued patent would be valid over the prior art.

173. Section 2 of the Act of 1793 expressly provided that "simply changing the form or proportions of any machine, or composition of matter, in any degree shall not be deemed a discovery." See *supra* note 126.

174. See *supra* text accompanying note 127.

175. See *supra* text and accompanying note 65.

Act for the Relief of Oliver Evans was inequitable and not in accord with the intent of the patent law. Moreover, as he informed McPherson, he had a mill built in the interval between the two patents which incorporated the Evans' improvements and had paid the royalties although he questioned the right of Evans to claim them. Thus, Jefferson had a personal motivation to express his views on the matter.

The second was that he wanted to express his views on "the law of the subject . . . merely in justification of myself, my name and approbation being subscribed to the act."¹⁷⁶ By "act" Jefferson presumably meant the Patent Act of 1793, although he may have referred to the Act for the Relief of Oliver Evans. Regardless, Jefferson, most importantly, wanted to present his own justifications for what he had done both in interpreting the patent law of the Act of 1790 and in formulating the content of the Act of 1793. He believed the courts had gone astray in the interpretation of the Act of 1793. As he stated, "had I not esteemed more the establishment of sound principles, I should now have been silent."¹⁷⁷ Jefferson sought to avoid "being brought into any difference with Mr. Evans, whom, however, I believe too reasonable to take offence at an honest difference of opinion."¹⁷⁸

Evans could be excused for viewing the matter in a somewhat different light as he objected both publicly and privately to the views expressed by Jefferson.¹⁷⁹ Nonetheless, Evans wrote to Jefferson on January 7, 1814, asking for an explanation of certain views expressed in his McPherson letter. Evans argued that his patent was for his improvements in the manufacture of flour "by the application of certain principles, and of such machinery as will carry those principles into operation."¹⁸⁰ Jefferson promptly responded and amplified to some extent on the views he had earlier expressed.¹⁸¹

Therein, Jefferson indicated that: "I can conceive how a machine may improve the manufacture of flour; but not how a *principle* abstracted from any machine can do it. It must then be the machine, and the principle of that machine, which is secured to you by your patent."¹⁸² By now, both Evans and Jefferson were

176. Letter from Jefferson to McPherson (Aug. 13, 1813), in XIII WRITINGS OF JEFFERSON, *supra* note 5, at 338.

177. *Id.*

178. *Id.*

179. Evans' public views were expressed in a pamphlet whimsically entitled A TRIP MADE BY A SMALL MAN IN A WRESTLE WITH A VERY GREAT MAN (Philadelphia 1813).

180. Letter from Jefferson to Evans (Jan. 16, 1814), in XIV WRITINGS OF JEFFERSON, *supra* note 5, at 63-67.

181. *Id.*

182. *Id.*

delving into philosophical waters concerning the emerging interpretation of the patent law. As the case law was then developed, Jefferson had the better of the argument, but this was only because the patenting of methods and the patenting of combinations of machines or apparatus to produce particular results was yet to be clearly understood.

This argument occurred in the era before the law required specific claims as to the nature of the invention.¹⁸³ In an attempt to avoid limits on particular embodiments, inventors frequently described their inventions in terms of general principles and argued that these principles, or the application of these principles, constituted the invention.¹⁸⁴ Evans tried precisely this. The courts, however, held that principles alone were not patentable, and that while applications of principles might be patentable, this generally required some change or improvement in the means used to effect the application.¹⁸⁵

In Jefferson's view, invention resided in a particular machine, instrument, or apparatus and not in a method or a combination of old machines, even if the result was a decided improvement over that which had gone before. He did not dispute that Evans' improvements resulted in the more efficient manufacture of a better grade of flour. His only concern was whether the individual elements which made up the improvements were old in the art. If they were, then it did not matter how much improvement resulted from the combination because the combination was unpatentable. 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."¹⁸⁶

He stressed that he had no personal interest in seeing any party prevail in the on-going disputes over Evans' patent. Rather, "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 education or pursuits,"¹⁸⁷ he was reluctant

183. It would not be until 1836 that the patent law would require patentees to both distinctly point out *and specifically claim* that which they considered to be their invention.

184. Thus, *e.g.*, in 1792, Joseph Barnes suggested that any new patent law should provide that "a person shall be entitled to obtain a patent, provided he shall have discovered a new principle in case of machines, or shall have discovered an improvement in the principle of any machine which is free or patented . . .". See BARNES, *supra* note 109, at 30-31.

185. See PHILLIPS, *supra* note 137, at 95-108 for an interesting discussion of these issues.

186. See Letter from Jefferson to Evans (Jan. 16, 1814), in XIV WRITINGS OF JEFFERSON, *supra* note 5, at 66.

187. *Id.* at 66-67.

to admit that one or two decisions before inferior and local tribunals¹⁸⁸ should act as precedent to "forever foreclose the whole of the new subject."

On the same day that he responded to Evans, Jefferson also wrote to his friend and correspondent Thomas Cooper.¹⁸⁹ In this letter, he took a somewhat different tack than he had with Evans. He asked whether Cooper had seen the memorial to Congress on the subject of Evans' patent and his letter to McPherson on the subject. Then, Jefferson stated,

The abuse of the frivolous patents is likely to cause more inconvenience than is counterbalanced by those really useful. We do not know to what uses we may apply implements which have been in our hands before the birth of our government, and even the discovery of America.¹⁹⁰

Implicit in this language is the view that he considered Evans' patent frivolous because it read on an elevator, the principle of which had been known for hundreds of years. Jefferson's assertion that the patent was frivolous was quite remarkable considering he had benefited so much from using Evans' improvements in his own flour mill and knew full well how widespread the use of those improvements had become in the country as a whole. Intellectually he could properly assert that the patent was invalid because certain of the subject matter was old in the art, but he could not deny the usefulness of that subject matter.¹⁹¹

Jefferson also reiterated a point that he had made to McPherson, namely, that on balance the abuses of the patent system through the issuance of what he calls frivolous patents outweighed its benefits. He particularly worried that patents may read on machines or tools that the industry had long known and used for other purposes. He was absolutely convinced that an old machine adapted to a new use may not be patented for that use.

188. It would not be until the following year that the issue of the validity of Evans' patent would reach the Supreme Court. It would then be before the Court four times in seven years. See *Evans v. Hettich*, 20 U.S. (7 Wheat.) 453 (1822); *Evans v. Eaton*, 20 U.S. (7 Wheat.) 356 (1822); *Evans v. Eaton*, 16 U.S. (3 Wheat.) 454 (1818); *Evans v. Jordan*, 13 U.S. (9 Cranch) 199 (1815).

189. Letter from Jefferson to Cooper (Jan. 16, 1814), in XIV WRITINGS OF JEFFERSON, *supra* note 5, at 54-63.

190. *Id.* at 62.

191. It is possible that in the context of the times he intended the term "frivolous" to mean invalid, but if so he still substantially overspoke. At the beginning of the nineteenth century "frivolous" in the legal context meant "manifestly insufficient or futile." This was clearly not the case with regard to Evans' patent which was upheld twice by the Supreme Court before finally being declared invalid in 1822 (four years after it had expired) not on the ground of no invention but rather on the legal technicality that Evans had failed to clearly distinguish his improvements over what was known in the art.

Some months later in August 1814, Jefferson again raised the point in a letter to Cooper.¹⁹² He had now modified his stance a bit. He suggested that affirmative steps should be taken to encourage judges to adopt a rule whereby "the invention of any new mechanical power, or of any new combination of the mechanical powers already known, [is] entitled to an exclusive grant; but that the purchaser of the right to use the invention should be free to apply it to every purpose of which it is susceptible."¹⁹³ Clearly, Jefferson had given some additional thought to the subject and now recognized that combinations of old machines might indeed be patentable. Once a patent holder granted a license for an invention, regardless of the nature of the invention, the licensee should have the right to use the invention for whatever purpose his fertile mind might conceive. Although field of use licenses had not been created, this thought strongly suggests that Jefferson would have opposed them.

That was it. Neither Jefferson nor Cooper seemed to have actively pursued the proposal. Although he lived for almost twelve more years, Jefferson, with but one exception, never addressed the issue of patents again in any of his writings.¹⁹⁴

X. SUMMATION

What to make of all of this? First of all, the mythology is of modern origin, for only in the twentieth century has the Supreme Court seen fit to consider Jefferson as an oracle regarding the early interpretation of the patent law.¹⁹⁵ Secondly, Jefferson clearly wrote more on the subject of patents than all the other founding fathers combined. The abundance of the Jeffersonian record has precisely contributed to his mythology insofar as patents are concerned. The mythology, however, has far outstripped the record. While Jefferson certainly influenced the administration of the first patent system under the Act of 1790, he did little or nothing to create that system, and bore little if any responsibility for the language of the patent statute. Jefferson did significantly influence certain language of the Act of 1793, but he did not draft it nor was he primarily responsible for its content. He was the driving force for the major change in the patent system brought about by that statute, *i.e.*, the change from examination

192. Letter from Jefferson to Cooper (Aug. 25, 1814), in XIV WRITINGS OF JEFFERSON, *supra* note 5, at 173-75.

193. *Id.* at 174.

194. The exception was to indicate his displeasure at the manner in which the existing patent system might be used. See *infra* note 197.

195. Prior to this century none of the opinions of the Supreme Court in patent cases even mention, much less seek to rely on, Jefferson's views on patentability or the patent law.

to registration. He later, though, strongly believed that the registration system was a mistake, although he would never admit that he was the one who brought it about. In particular, Jefferson came to rue the primacy of judicial interpretation which the registration system relied upon. Surprisingly, he seems never to have attempted, publicly or privately, to suggest modification or amendment of the Act of 1793, although he did indirectly seek to influence the judicial interpretation under that Act.¹⁹⁶

Throughout his life, Jefferson had a decided ambivalence concerning the merits and efficacy of the American patent system. Significant documentation exists showing his early opposition to the creation of the limited term monopolies called patents, and the effort he expended to administer the first patent system. A point, which has gone largely unnoticed but is highly significant, is that two decades after he had ceased to have primary responsibility for the operation of the nascent United States patent system Jefferson expressed much skepticism concerning both its usefulness and its effectiveness. He clearly did not believe that patents promoted the progress of the useful arts as set forth in the Constitution, 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 to promote the progress of useful arts.¹⁹⁷ In his view, nations without patent systems did as well as those with patent systems in the number and 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.¹⁹⁸

If a patent system must exist — and one most assuredly existed in the United States — Jefferson believed that the system

196. In his August 25, 1814 letter to Cooper Jefferson urged Cooper, as editor of *The Emporium of Arts and Sciences*, that "These rights [i.e., his proposed rule of patentability] appear sufficiently distinct, and the distinction sound enough, to be adopted by the judges, to whom it could not be better suggested than through the medium of the Emporium, should any future paper of that furnish place for the hint." Letter from Jefferson to Cooper (Aug. 25, 1814), in XIV WRITINGS OF JEFFERSON, *supra* note 5, at 175.

197. Thus, for example, in 1815 he described to George Fleming an invention he had made with respect to the processing of hemp and went on to state "that 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." Letter from Jefferson to Fleming (Dec. 29, 1815), in XIV WRITINGS OF JEFFERSON, *supra* note 5, at 365-69.

198. In a somewhat different context, Miller has written that it was his 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 reluctance to accept the idea of a patent grant at all, much less have that idea incorporated into the Constitution. See C. MILLER, JEFFERSON AND NATURE, AN INTERPRETATION 204 (1988).

had to include certain rules regarding patentability. His standards in this regard were high — perhaps higher than most Americans of the time thought necessary.¹⁹⁹ He 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 know little or nothing about it and could not provide “a single ray to lighten the path of a mechanic or a mathematician.”²⁰⁰

Jefferson’s advocacy of rules of patentability is well known — almost entirely because of the existence of his letter to McPherson²⁰¹ — but what has only recently become known is that he was the first to propose, albeit unsuccessfully, what has now long been a basic tenant of the United States patent law, namely, that an invention must be unobvious to one skilled in the art to which it pertains in order to be patentable.²⁰² Had Congress written this approach into the law when he first proposed it in 1791, the subsequent history of the patent law in the United States would have been quite different.

Although the mythology attributes the rules of patentability set forth in the McPherson letter to Jefferson, he never claimed authorship *per se*.²⁰³ While he certainly favored them and may well have been instrumental in getting the patent board to accept them, some question exists as to whether they were original with him.²⁰⁴ Be that as it may, Jefferson espoused them and in so doing anticipated the 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 Supreme Court has indicated. However, Jefferson did not create the patent system. While he influenced to a considerable degree the content of the Act of 1793, he came to regret the major change he caused to be brought about in that Act, namely, the change 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 Supreme Court has on occasion sought to rely on

199. See *infra* note 204.

200. See K. J. Burchfiel, *Revising the “Original” Patent Clause: Pseudohistory in Constitutional Construction*, 2 HARV. J.L. & TECH. 155, 167 (1989).

201. But that letter was more than 20 years after the fact, and these rules were not published or well known while the patent board was in existence.

202. Jefferson did so in his 1791 patent bill. Insofar as I have been able to ascertain, the first commentator to note this fact was K. J. Burchfiel, *supra* note 200, at 167.

203. Jefferson carefully referred to them as the rules developed by the patent board.

204. 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. See *supra* text accompanying notes 30 and 31.

Jefferson's "insistence upon a high level of patentability" as providing guidance to the contemporaneous meaning attached to the intellectual property clause of the Constitution in the context of a supposed nonobviousness standard.²⁰⁵ As K.J. Burchfiel notes, however, Congress expressly rejected Jefferson's proposed nonobviousness standard when it enacted the Act of 1793. Burchfiel accurately characterizes the Court's reliance on this Jeffersonian mythology as the use of pseudohistory in constitutional construction.²⁰⁶

205. See, e.g., *Graham v. John Deere Co.*, 383 U.S. 1, 6-9 (1966).

206. In his sharp critique of *Graham v. John Deere Co.*, he states:

The Court's sole reliance on Jefferson's often-changing views illustrates the principal flaw in its historical methodology. This flaw 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. The legal evidence is uncontradicted that in rejecting Jefferson's proposals, including a statutory nonobviousness standard, the second Congress disavowed the proposition that a high standard of patentability was required by the plain meaning of the patent clause or by the original intent of the constitutional framers.

Burchfiel, *supra* note 200, at 209.