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Preliminary Injunctions in Patent Cases

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The Section of Patent, Trade Mark and Copyright Law adopted the following resolution, August 29, 1902:

"*Resolved*, that the Committee on Publications of the Association be requested to print the paper read by Judge Hill, in pamphlet form, so that we may have it distributed separately from the Transactions of the Association."

PRELIMINARY INJUNCTIONS IN PATENT SUITS

BY

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At the time when the Constitution of the United States was framed, the useful arts were indebted to America for no practical improvements of value except Franklin's lightning-arresters and stoves. Every other art that was in use in this country had been borrowed from abroad, and in its new home retained the same crude forms that had prevailed in Europe for centuries. Locomotion found its highest expression in the old-fashioned stage-coach; motive power, in running water and the winds; textile manufactures, in the domestic spinning-wheel and hand-loom, with here and there a fulling-mill like that which 300 years ago proved so disastrous to Don Quixote's faithful squire; agriculture, in the hoe, the wooden plow, the scythe, the sickle, and the hand rake; and so on, through the whole category. America was a land of small farms. Her largest cities were mere villages. Her commerce was practically confined to the coasting and West India trade. Large manufacturing establishments were impossible, because, through the absence of transportation facilities, their source of supply was closely limited, and, unless they were situated on navigable water, the market for their output was necessarily confined to their immediate neighborhood. An old-fashioned saw-mill and grist-mill were to be found in almost every community. In the larger villages, an iron foundry, or a potter's wheel, was not unknown. Along the sea coast, a few distilleries turned West India molasses into New England rum, while in the mountainous interior, the same agency enabled our fathers to slake their thirst from the juices of their rye, corn and wheat fields. If we add to this list a few small and

crude smelting furnaces, scattered along through the Middle States, and some old-fashioned tobacco presses, we shall complete the enumeration of our manufacturing industries at that period. Our annual export of manufactured goods, including rum, tobacco, cotton and lumber, was somewhat less than a million dollars. It was not known till sixty years later that steel could be produced from American ore, and even at that late period, the discoverer, James Park, Jr., of Pittsburg, was put under guardianship as a lunatic, for announcing the discovery and endeavoring to follow it up by the practical production of American steel.

For many years prior to 1789 the industrial arts had remained substantially as stationary in this country as in China and Persia. Before the Revolution, the policy of Great Britain had been to suppress, as far as possible, the growth of manufactures in her colonies; and, besides, neither in the colonial period nor in the period of the Confederation, was there any inducement to the making of inventions and discoveries, because no system of rewards had been established for the encouragement of such efforts. Practically, for the inventor on this side of the Atlantic, protection could be obtained only in and for the British Isles—and they were so remote as to be substantially inaccessible to the ordinary American citizen. Even if a colonial legislature, or one of the states under the Articles of Confederation, had, in any instance, granted a patent, its scope was necessarily limited to the colony or state that granted it, and there the sparseness of population, dearth of manufactures and debased condition of the currency rendered it of no value. Thus the useful arts in this country were bound hand and foot against the possibility of making any independent progress, and our colonial and confederated forefathers were obliged to content themselves with following after European invention at a long distance in the rear, with no prospect or hope of catching up with the slow-moving procession. The prevailing conditions seemed to limit the mechanical and industrial development of

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America to a feeble and unpromising movement along the same old lines. She seemed destined merely to pick up the crumbs of mechanical improvement which might fall to her from foreign tables.

But the statesmen who framed the Constitution had other and far different plans for the consolidated republic which they were creating. Probably no men that ever lived had studied the history and science of human government more exhaustively and from such deep research had come to understand the true principles of government more thoroughly than Hamilton and Madison, who impressed their knowledge, their wisdom and their genius upon every part of the new Constitution. They were, on the one hand, absolutely familiar with the weaknesses and defects of the old colonial and confederate systems, and with the causes and evil consequences thereof; while, on the other hand, they clearly saw, as we see now, that the growth and strength of a great continental nation, such as they were forming, depended upon its manufactures no less than upon its commerce and agriculture. They found its agriculture limited by the limitations of its commerce and manufactures; and its commerce limited by the limitations of its agriculture and manufactures. Of the great industrial trinity, agriculture, commerce and manufactures, the development of the latter, therefore, was clearly of supreme importance, because, without its aid, both of the others were crippled; but they wisely planned to develop all three coincidently, by removing from American commerce its previous impediments, stimulating invention by patent laws, and guarding American manufactures by a tariff system which could at will be made protective to any extent desirable. It is an interesting fact that the first tariff act, passed by the Congress of the United States at its first session, and approved by Washington, July 4, 1789, was a protective tariff statute, commencing with a preamble which, in the following words, declared the general purposes of all our subsequent tariff legislation:

"Section 1. Whereas it is necessary for the support of govern-

ment, *for the discharge of the debts of the United States and the encouragement and protection of manufactures*, that duties be laid on goods, wares and merchandise imported: Be it enacted," etc., etc. (1 Stat. at Large, 24). The same Congress, at its second session, April 10, 1790, enacted our first patent statute (1 Stat. at Large, 109). The union of all the states into one consolidated nation had rendered it possible, for the first time in the history of this country, to establish a patent system of any material value to the inventor or the public.

The end which the constitutional convention had in view in adopting paragraph 8 of Section 8, Article 1, was clear and definite. The primary purpose was to promote the progress of the useful arts in this country by stimulating the production, publication and general adoption and use of improvements in machinery, processes and articles of manufacture. Patents were simply a means to that end. A system of direct money rewards for the making of new and valuable inventions was clearly impracticable, because it would inevitably lead to gross corruption and abuse, and could not be administered with any reasonable degree of justice. The experience of England for a century and a half had shown that a system of indirect pecuniary reward, by granting to the inventor for a limited period the exclusive right to all the profits growing out of the manufacture, sale or use of his invention, was not only a powerful stimulus to the exercise of the inventive faculties, but had the further advantage of easy and fair administration, and the great merit of automatically proportioning the extent of the reward to the importance and value of the invention itself, and to the energy and skill of the patentee or his representatives in bringing it into popular use. As compared with any other scheme of rewards, such a system is absolutely unobjectionable. It takes from the public nothing to which they ever had any right, or of which they ever had even any knowledge. It requires of the government nothing except the honest and fair protection, by its courts, of the ex-

clusive privilege, during the full term agreed upon. It is the only practicable system which the ingenuity of man has been able to devise for effectuating the great purpose of the makers of the Constitution, the forced development of the useful arts by the stimulation of invention and discovery; and they adopted it in terms which, without mentioning the word "patent," define both their purpose and the chosen means for effecting it, in language of such exquisite clearness and precision as to obviate for all future time the necessity for judicial interpretation or explanation.

"Section 8. The Congress shall have power . . . Eighth. 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."

Under such a constitutional provision, as held by the Supreme Court in Grant *vs.* Raymond (6 Pet. 218), and other cases, patents issued for new inventions are *contracts* between the government and the patentee, by which the government agrees "*to secure*" to him, for the term of his patent, "the exclusive right to his discovery" in consideration of his immediately making the invention known to the public and surrendering the exclusive use of it at the end of the stipulated period of protection. The government grants nothing to him, for it has nothing to grant—he is already in possession of the invention, with the exclusive right to use it so long as he can keep it secret. In its final analysis, therefore, a patent is nothing more nor less than the legal evidence of such a contract, identifying the invention, signed by the inventor and the representative of the government, and authenticated by the seal of the Patent Office, guaranteeing on the part of the government that if the inventor faithfully performs his part of the contract and applies for protection through the federal courts, they will, for the term of seventeen years, prevent anybody else from making, selling or using the invention without the consent of the patentee or his assigns. Of course, if the invention turns out to be old, or if the specification is

fraudulently made insufficient to disclose and identify it, the consideration totally fails, and the promise of protection is void. Otherwise, the government is bound, both at law and in honor, to fulfill both the spirit and the letter of its agreement. By that contract, says the Supreme Court in Grant *vs.* Raymond (*ubi supra*), "the public faith is pledged" to secure to the patentee the exclusive enjoyment of his invention during the entire term of the patent, and the court adds: "That sense of justice and of right which all feel pleads strongly against depriving the inventor of the compensation thus solemnly promised."

For the purpose of emphasis, let me repeat: A patent grants nothing—it is simply a *promise* to keep unauthorized persons out of the field of competition for seventeen years. If, during any portion of that period, they are not excluded from the field, the promise is, *pro tanto*, violated. The courts are clothed with full power to enfore such exclusion.

How does the government keep its promise? I answer that it has for many years shamefully disregarded its obligations, and has been guilty of systematically withholding from the patentee in every instance a very material portion, and in some instances the whole, of that protection which it solemnly promises not merely to grant, but to "*secure*," to the patentee, his heirs and assigns, during the entire term of the patent.

Who is responsible for this shameful violation of national obligations? Not the legislative nor the executive, but the judicial department of the government.

Congress is entirely without fault in the matter. From the very beginning it has done everything that could reasonably be expected of it to give full effect to the patent clause of the Constitution. In less than one year after the inauguration of Washington it gave the country a patent system, and, as experience disclosed defects or suggested improvements, it has continued from time to time ever since to pass amendatory acts for the purpose of adding to the vigor and efficiency of the

system, until now, it may be truthfully said that if the existing patent statutes were only enforced by the courts according to the spirit and the letter of the Constitution and the acts of Congress passed in pursuance thereof, our patent system would be substantially perfect. Congress has never for a moment lost sight of the fact that the primary object of such a system was, and is, to build up our manufactures by stimulating the production of new and useful inventions. That object was expressly stated in the title of the first patent act, that of April 10, 1790,—"An act to promote the progress of useful Arts,"—and the expression was repeated in the acts of 1793, 1794, 1836, 1837, 1839, 1842, 1852, 1861, 1863, 1864, 1865, 1866, as if to keep the idea constantly in the minds of the courts lest some of them, by forgetting it, might grow indifferent or hostile to the protection of patent property. In the earlier of these acts, the mistake was made of assuming that an action at law for damages, supplemented by heavy penalties (in the act of 1790, the forfeiture to the plaintiff of all infringing articles, and in the act of 1793, the tripling of the damages) would be an efficient protection against infringement; but when experience had shown that this assumption was erroneous, Congress, by the act of February 15, 1819 (3 Stat. at L. 481), added equity jurisdiction in all patent cases, and provided for the issue of injunctions to restrain infringement. In all subsequent legislation it has manifested the same disposition to uphold and strengthen the patent system.

The reason of this friendly interest on the part of the national legislature is not difficult to understand. From the very beginning the patent system demonstrated its wonderful efficiency as a means of stimulating the production of improvements in the useful arts. Within three years from the passage of the first patent act, the invention of the cotton gin revolutionized one of the most important industries and added incalculable wealth to the country. Experience had not yet shown the necessity for injunctional relief, and, in its absence, poor

Whitney failed to receive the pecuniary reward to which he was so justly entitled, and became impoverished rather than enriched by his great invention. Other important inventions and discoveries, however, continued to be made with better results for their authors, and the system became widely popular. The public began to realize that the law had created a new industry—that of making inventions—and that it opened to every man, even the poorest, the opportunity for sudden wealth. With the amendments of 1819 and 1836, which practically perfected the law, valuable inventions and discoveries multiplied with amazing rapidity, and the country entered upon an era of industrial progress unexampled in all history. Congress, in close touch with the people, participated in the general appreciation of the patent system, witnessed with satisfaction and pride its effect upon the development of our manufactures, agriculture and commerce, and has never since failed to maintain it and to adopt any measures agreed upon by its friends for the purpose of improving and perfecting it. Even during the hostile Granger agitation of the late '70s, which unquestionably reached and effected the courts, not an unfriendly word found its way into the patent statutes.

But, notwithstanding the plain language of the Constitution and the statutes, the general popularity of the patent system, the tender interest and regard manifested towards it by Congress and the ample powers given to the federal courts for the protection of the patent property, these courts have been, for years, systematically engaged in destroying the value of such property by confiscating the most important portion, and in some instances the whole, of the term of the patent, turning it over to the use of irresponsible infringers and guarding them against financial accountability for their piracies. I do not mean that the courts have intended to do all this, *but they have done it*, whether intentionally or not, and the evil has become so great as to demand imperatively the interposition of Congress to prevent its continuation.

In tracing the origin and growth of this evil, I must review briefly the history of patent legislation, and of the judicial practice thereunder.

The history of the patent system in this country embraces two eras—the first beginning April 10, 1790, and ending with the passage of the act of July 4, 1836; the second, beginning with the act last mentioned and extending to the present day. During the first era, our system was modeled upon that of Great Britain in which patents are granted, without investigation of the prior art, upon the mere filing of a petition and specification and the payment of the prescribed fee. Such patents, of course, carry with them no *prima facie* presumption of originality and novelty of invention, and the general rule in the British courts has been, as stated by Lord Cottenham, in Kay *vs.* Marshall (2 Web. P. C. 42), to require the plaintiff to show "at least a *prima facie* title" to relief before an injunction *pendente lite* will be granted in a contested case. Uninterrupted possession for a longer or shorter time, or the verdict of a jury sustaining the validity of the patent, is regarded as establishing such *prima facie* right for the purpose referred to, even where the chancellor himself may have grave doubts of the validity of the patent. As Lord Eldon expressed it, in Universities *vs.* Richardson, 6 Ves. 706 (A. D. 1802): "In the case of patent rights, if the party gets his patent, and puts his invention in execution, and has proceeded to a sale, that may be called possession under it; *however doubtful it may be whether the patent can be sustained*, this court has lately said possession under a color of title is ground enough to enjoin, and to continue the injunction, till it shall be proved at law that it is only color and not real title."

In the United States, under the act of 1819, which, for the first time, conferred equity jurisdiction in patent suits, the rule immediately adopted is stated by Mr. Justice Washington, in Isaacs *vs.* Cooper, 4 Wash. 259 (A. D. 1821), as follows:

"The practice of the court of equity, upon motions of this kind, is to grant an injunction upon the filing of the bill, and

before a trial at law, if the bill state a clear right and verify the same by affidavit. If the bill states an exclusive possession of the invention or discovery for which the plaintiff has obtained a patent, an injunction is granted, although the court may feel doubts as to the validity of the patent."

Such was the practice in England, and such the practice in this country prior to July 4, 1836, when patents were granted without any previous investigation of the state of the art, and therefore, were not even *prima facie* valid.

But the act of 1836 radically changed the system. Under that and all subsequent patent acts, the government itself undertakes to investigate and determine the question of validity before granting the patent. At the present time, this work of preliminary investigation is performed by two hundred and sixty-two examiners and assistant examiners, all of whom, under the civil service statutes, are practically appointed for life or good behavior. Inventors are divided into classes, according to subject-matter, and each principal examiner, aided by two or three assistant examiners and a suitable clerical force, is permanently in charge of one or two of said classes, thus enabling him and his assistants to qualify themselves thoroughly as expert specialists in their respective departments. For their use, the government provides an ample library, containing copies of all American patents, all foreign patents issued in printed form, and all important technical publications, together with digests and abstracts to facilitate their labors. The examiners are men of education, experience, and usually of ability, promoted by merit from the ranks of the assistant examiners, and, therefore, thoroughly trained for the practical discharge of their duties. The scheme is theoretically perfect, and its results have been as satisfactory as can be expected from any human agency.

Now it cannot be successfully denied that the presumption of novelty and validity arising out of the grant of a patent upon such an examination by trained government experts familiar with the particular art to which the patent relates and

with the history of the evolution of that art, is immeasurably stronger than that which arises out of the mere fact that a patentee, in a given instance, has used his invention for a while without anybody's infringing it, or that a few infringers have preferred to settle rather than incur the expense and risk of a suit. Nor can it be successfully denied that a vast majority of the patents issued by the United States are good and valid. It follows that an American patent, issued since the act of July 4, 1836, is *prima facie* valid from the date of its issue; and such has been the invariable ruling of the Supreme Court in all cases except where want of novelty was plainly apparent on the face of the specification (Mitchell *vs.* Tilghman, 19 Wall. 390; Cantrell *vs.* Wallick, 117 U. S. 695; Smith *vs.* Goodyear D. V. Co., 93 U. S. 486; Lehnbeuter *vs.* Holthaus, 105 U. S. 94). When such a patent is introduced in evidence the burden is cast upon the defendant to show that it is not good or that the patentee is not the first inventor (Seymour *vs.* Osborne, 11 Wall. 516, 538). In fact, the statute itself plainly renders the patent *prima facie* valid by requiring that the defenses of anticipation, prior public use, abandonment, etc., must be pleaded and proved before the court can consider them--and not only pleaded and proved, but the presumption of validity is so exceedingly strong as to cause the Supreme Court to hold that on such issues every reasonable doubt should be resolved against the defendant (Coffin *vs.* Ogden, 18 Wall. 120, 124; Cantrell *vs.* Wallick, *ubi supra*). There is but one higher grade of presumption, namely, that class which the law denominates "conclusive" because no proof can overcome them.

Now, we have already seen that, on motions for preliminary injunction, the British courts require evidence, either of a verdict sustaining the patent or of some degree of acquiescence, or, as they call it, "exclusive use" under it, because the patent itself, issued without any investigation of the prior art, has no *prima facie* presumption of novelty in its favor. The slightest degree of presumption in favor of the patent is held,

however, by those courts to be ample to authorize the grant of the injunction. In Universities *vs.* Richardson (*ubi supra*), Lord Eldon intimated that even a single sale by the patentee would be sufficient for the purpose, and said: "Possession under *color* of title is ground enough to enjoin," and that, under such circumstances, the injunction should issue, "however doubtful it (the validity of the patent) may be." Fifty-four years later Vice-Chancellor Stuart, in Gardner *vs.* Broadbent (2 Jur. N. S. 1041), said:

"There is no law of this court which prevents a patentee, by the recency of his patent, from applying for an injunction *ex parte*; and I wish it to be understood that the law of the court is that laid down by Lord Eldon in the case of the Universities of Oxford and Cambridge *vs.* Richardson."

In several other cases the English courts have held, in substance, that anything sufficient to indicate *prima facie* validity, or, as some of them call it, "color of title," is enough to support an *interim* injunction; and in all cases, without exception, they base the requirement of acquiescence upon the absence of any presumption in favor of the patent arising out of its grant. They established the rule arbitrarily as a sort of judicial fiction, not in a spirit of hostility to the patent, but in the interest of the patentee, to enable him to obtain the protection of preliminary injunctions. Under patents supported by no presumption of validity, the principles of equity jurisprudence would not justify the issue of such writs, and they sought an excuse for granting them. Alleged "acquiescence," or, as they call it, "exclusive use," was a flimsy excuse, but it was better than none at all, and was applicable in a great majority of cases; and so they seized upon it, weak as it was, and were thus enabled to give the patentee a measure of relief from the annoyance and injury of continued infringements.

There is no occasion for such a rule in this country, and no justification for adopting it—in fact, it is here nothing more nor less than a judicial absurdity. For, manifestly, it is simple self-stultification to hold, in one breath, that American

patents issue with a *prima facie* presumption of validity so strong that nothing but conclusive evidence can overthrow it, and, in the next breath, that they are on a par with English patents which issue with no presumption of validity whatever, and, therefore, on motions for preliminary injunction, that they must, like English patents, be fortified by some additional evidence, however weak, to give them at least an appearance of validity. In England, the effect of the rule that requires a period of exclusive use, is to establish a presumption of validity where none existed before; in the United States, its effect is to ignore an almost conclusive presumption of validity, already existing, and demand a different one of vastly inferior force—one which gives, as the English courts admit, a mere "*color* of title." In other words, our courts proceed upon the absurd theory that, while the greater presumption is not sufficient, the vastly inferior one is amply sufficient. So long as we do not apply for preliminary injunctions, they tell us, by their words, that our patents are not only *prima facie*, but almost conclusively, valid from the day of their issue; but when we move for a preliminary injunction, they take it all back and tell us, by their acts, that these same patents have no *prima facie* value whatever. They practically convert the presumption of validity into one of *invalidity* by requiring the patentee to prove the soundness of his patent by extrinsic evidence as a condition of granting him any protection whatever against even the boldest infringer. It is unfortunate that the question cannot be taken to the Supreme Court, for it is hardly conceivable that that court could fail to appreciate and correct the inconsistency and absurdity of the present practice.

The American practice on this subject was undoubtedly copied from the English practice, and its application in this country to patents granted since 1836 is a striking illustration of one of the most serious vices of American jurisprudence, namely, the proneness of our courts to ignore fundamental principles and blindly follow supposed precedents without as-

certaining the reasons upon which they were based, and in the absence of which they have no pertinency. The habit is attributable to a disposition to avoid labor and responsibility—in other words, to laziness and lack of independence. An indolent judge is naturally inclined to pospone the investigation of facts to final hearing, and to rely upon the literal words of a convenient precedent instead of studying out fundamental principles and balancing the weight of authority. A careful examination of the English decisions on the question of preliminary injunctions in patent cases would have clearly shown that while they were applicable and reasonable under patents having no *prima facie* validity, they were not only inapplicable under patents of the United States, but, in fact, require a practice here exactly opposite to that of the English courts.

This neglect of the federal courts to give due weight, on motion for preliminary injunction, to the almost conclusive presumption of validity which inheres in American patents from the moment of their issue, has inflicted, and is inflicting, an injury to our patent system and to the owners of patent property, which it is difficult to overestimate. It results in practically denying protection during the earlier years of the patent and freely allowing infringers to enter the field in competition with the patentee and ruin his business. If infringements begin early enough there can then be no period of "exclusive possession" or "acquiescence," and the patentee is obliged to wait until the final decree on the merits of the case, and then await the result of an appeal before he can receive any relief. Experience has shown that if the defendant be rich, and disposed to make a stubborn fight, he can delay the final hearing, and the hearing on appeal, from five to ten years, and in some cases almost or quite to the end of the term of the patent. Meanwhile, he is using the invention, and, perhaps, making a fortune out of it; and his success in pirating the patentee's property and avoiding punishment induces other infringers to enter the field, deters capitalists from coming to the aid of the patentee and destroys the market

value of the patent. I have encountered a case, in my own practice, where my client, who had made and patented one of the most valuable inventions of modern times, was obliged to spend the entire term of his patent in wearisome and expensive litigation. Just as the patent was expiring, the courts decided that it was broadly valid; but it was then too late to be of any substantial benefit to the patentee. He had exhausted his financial resources in the long struggle; had been obliged to witness infringers making millions out of his invention, while capitalists declined to embark in his enterprise by reason of the infringements and of the want of protection; had seen even the government itself profiting from it to the extent of about ten millions of dollars, through its infringing contractors, while its courts were refusing protection; and had been, all the while, unable to put his invention into use for his own benefit, because, under the conditions existing, capitalists declined to furnish the means necessary for that purpose. To him, the Constitution and the patent statutes passed in pursuance thereof were more than "hollow mockery"—they had actually enticed him to his ruin, by holding out the promise of protection, which the courts, for seventeen years, refused to perform. Under the practice by which that was done, every inventor who makes a valuable invention or discovery that requires a large capital to operate it, is liable to the fate of my unfortunate client; and the greater the money-making capacity of the invention, the greater the temptation to infringe, and the more stubbornly will the infringer contest, while his large profits enable him to protract the litigation almost indefinitely at the sole expense and risk of the patentee —for it is out of *his* property that all the expenses on both sides are paid. The rigid technical rules governing accountings in patent cases practically prohibit the recovery of profits or damages, and the infringer is left to enjoy his ill-gotten gains.

The time thus lost to the patentee is the most valuable portion of his term, when, usually, he is poor and needs pro-

tion to enable him to establish his business and secure a market, or to enable him to dispose of his patent for an adequate consideration. It is then that infringement is most disastrous to him; for it impairs public confidence in his rights, prevents capital from investing under them, encourages others to infringe, and, by unscrupulous and ruinous competition, destroys the possibility of deriving profits from his patents. In fact, I have known many cases where, through the inaction of the courts, the patent has been of vastly greater protection to the infringer than to the patentee.

I have said that it is difficult to overestimate the damage and injury inflicted upon the patent interests of this country by the present practice of the courts on motions for preliminary injunction. There are about 375,000 unexpired patents now in existence. To deprive them all of the right to injunction for only *one* year after their issue means an aggregate loss of 375,000 years of promised protection. But the courts do not stop at one year—they cut off, on the average, from five to ten years; and this runs the total score of loss up to millions of years. For everyone of these years, says John Marshall, in Grant *vs.* Raymond, "the public faith is pledged" to "*secure*" the exclusive right to the patentee; and yet for everyone of them the public faith is violated by the courts of the government that gives the pledge—and this, without any reason or excuse, except an arbitrary and unjust rule of practice, carelessly adopted through a misunderstanding of the meaning of the English authorities, and inconsistent with the Constitution, the statutes and the decisions of the Supreme Court.

To appreciate the gross injustice and illegality of the present practice, look at a few simple and indisputable facts: The Constitution gives Congress only one authority in the premises, namely. the authority to "*secure*" to the inventor "the exclusive right" to his invention or discovery for "for limited times," leaving it to that body to fix the limit; Congress (Rev. St. Sect. 4884) has fixed the limit at seventeen years, and has declared the right "exclusive" for that period; and (Sect.

4921) it has given the federal courts power to grant injunctions "*to prevent the violation of any right secured by patent.*" By the plain language both of the statutes and the Constitution, the right is to be *secured* to the inventor, is to be *exclusive*, and is to run, not for a portion of the period limited, but for the whole of it; and the purpose of the entire provision is "to promote the progress of" the "useful arts." By the practice of the courts, however, the right is *not* secured to the inventor, is *not* exclusive, does *not* run for the period limited, and the effect is *not* to promote, but to retard, the progress of the useful arts. The courts conceding themselves to be destitute of authority to *lengthen* the term of the patent, assume the authority to *shorten* it to any extent they may please by simply refusing to enforce the right until years have elapsed after the beginning of the term. I deny their authority to do anything of the kind; but the practice is, probably, too strongly entrenched now behind American precedents to be disloged without the aid of an act of Congress. It is seldom that we encounter in the lower courts a judge with courage enough to disregard a long line of precedents, however conclusively he may be satisfied that they are wrong in principle and bad in results.

If the patentee be a wealthy manufacturer, he ordinarily gets some protection, even under the present practice, because unscrupulous persons are deterred from infringing through the certainty of costly litigation and the knowledge that his wealth will enable him to cut prices temporarily to such an extent as to ruin them. In other words, he is protected by his wealth though not by his patent. But where the would-be infringer is a rival manufacturer of equal or greater wealth, no such deterring influence will affect him; and the knowledge that he can infringe with impunity, and can thereby inflict irreparable damage upon his competitor, strongly allures him to enter the field. The result is, that after a period of ruinous competition and fruitless litigation, the parties are substantially compelled to form a combination or "trust," by which the patentee divides his property between himself and the trespassers, and

thereafter all work together against the poorer manufacturers. The present practice is the fruitful parent of "trusts," and in every instance it works in favor of the rich and against the poor. The comparatively poor patentee has not the slightest chance in the world as against a rich infringer. It is only by forming a corporation and securing the aid of capital thut he can make any money out of his invention; and the capitalists, knowing his helplessness, squeeze him nearly dry in the process. The whole thing is distinctly discouraging to the making of inventions and obstructive to the progress of the arts, and the practice, which permits it, should be cut up root and branch.

But it may be argued that the present practice in such cases is justified by the language of the statutes—"power to grant injunctions according to the course and principles of courts of equity . . . on such terms as the court may deem reasonable." That argument, however, is clearly unsound. Both of these qualifying clauses are derived from the act of 1819, giving equity jurisdiction in all patent cases. At that time our patents were, like English patents, destitute of any *prima facie* presumption of validity, and the "course and principles of courts of equity" demanded the practice established by Lord Eldon, in 1802, and reaffirmed by Vice-Chancellor Stuart, in 1856, namely, that the injunction should be granted if there is even a "color of title," "however doubtful it may be whether the patent can be sustained" at final hearing. There were no previous precedents in this country, and "the course and principles of courts of equity" had to determined by resort to English authorities. But, seventeen years later, the act of 1836 supplied to American patents an almost conclusive presumption of validity, and thereafter "the course and principles of courts of equity," as defined by the English judges themselves, required the grant of an injunction wherever necessary to secure the inventor's exclusive right at any time after the date of his patent. It was no longer necessary, as in

England, to wait to establish a *prima facie* presumption of validity by *user* or verdict.

So far as concerns the power to grant "on such terms as the court may deem reasonable," this clearly confers the power to impose conditions upon the *injunction granted* but not upon the *patent*. That document is the government's solemn contract to secure to the patentee the exclusive right for seventeen years, and the courts have no power to vary its terms nor to annex to it any condition whatever. Its conditions are determined in advance by the Constitution and statutes; and for the courts to require further conditions not so determined—for example, to decree that the exclusive right shall not be protected until after it has been quietly enjoyed for several years, or has been fortified by a verdict at law or a decree in chancery, is simply judicial legislation tantamount to an amendment both of the Constitution and the statutes—a kind of legislation which, says Mr. Justice Baldwin, in Whitney *vs.* Emmett (Bald. Rep., p. 316), is "of the most odious kind, necessarily retrospective, and substantially and practically *ex post facto*."

There is, therefore, neither reason nor authority for our present practice, and it seems to be in plain violation of the law. There can be no question about its enormous injury to our patent system, and its retarding, rather than promoting, "the progress of science and useful arts." As the patentee comes before the courts with an acknowledged *prima facie* right, and, therefore, with a title which is good till somebody shows a better, they should enforce the maintenance of the *status quo* and restrain the infringer from interfering with it until he shall have produced the degree of evidence required to defeat the claim of validity. On the preliminary motion, the raising of a mere doubt should not be allowed to unsettle the plaintiff's right, because it is everywhere held in this country that even at final hearing upon full proofs the validity of a patent cannot be overthrown except by evidence beyond a reasonable doubt, and it is held even in England that the plaintiff

is entitled to his injunction upon showing a *prima facie* right, notwithstanding that the judges doubt the result of a final hearing. How inconsistent and absurd is our practice of holding that a reasonable doubt overcomes the plaintiff's right at the *preliminary* hearing, while the same doubt at the *final* hearing only operates to establish his case. Reason and common sense protest against such a practice, and demand that, at the preliminary as well as the final hearing, the infringer, upon whom is the burden of proof, shall be required to make good his contention before being allowed to disturb the quiet possession of the *prima facie* owner of the title.

Of course, if the courts were to adopt the practice of enforcing the *prima facie* right from the beginning of the term, "the course and principles of equity" would require of the patentee to be prompt in filing his bill and bringing his suit to final hearing on penalty of otherwise losing his equitable right through laches, for, under such conditions, delay would be inequitably injurious to the defendant. On the other hand, the defendant would have every incentive to expedite the final hearing, and the result would be to speed the cause, prevent the piling up of enormous records and lighten the labor of the courts. The practice of allowing the defendant to profit from the invention until finally arrested by a perpetual injunction, is mainly responsible for the long delays and immense records in patent cases of which the judges vociferously complain. In fact, it offers a great premium for these very evils. The courts have brought this trouble upon themselves, and they have only to change their unreasonable rules of practice to get rid of it.

Such change of practice would do no injustice to the defendant. *All the legal defenses enumerated in the statute* would still be open to him on final hearing, and even on the preliminary hearing, if he could then establish them beyond a reasonable doubt. On both hearings, all equitable defenses growing out of the peculiar circumstances of the case, and showing that an injunction should not be awarded under such

circumstances, would also be open to him. He would have every advantage that he now possesses, except that of being able to delay judicial action and pile up enormous expenses and costs until, by the use of the patented invention, he has enriched himself and ruined the patentee.

There is another strong reason why the present practice should be abolished, and that is, that such a change will materially conduce to the relief of Congress from extension cases in the future; whereas, under the practice now prevailing, such cases are liable to be multiplied almost indefinitely, and to demand much time and labor which could be profitably employed on matters of general legislation. Patentees who are robbed of protection by the courts for a considerable portion, or, as in some cases, for the whole of the term of their respective patents, have a strong equitable claim upon the government to make good its promise of protection for a period of seventeen years. They plead, with irresistible force, that the government has practically repudiated its solemn contract and, by false pretenses of future protection, has cheated them out of their inventions and out of the money paid to it for its worthless patent deed. No Congressman possessed of a fine moral sense trained in the study of law and equity can turn a deaf ear to petitions asking for such manifest justice; and the result is that much valuable time is employed in hearing and in considering them. By simply protecting the patent from the beginning of its term, all this unnecessary expenditure of congressional time and labor would be avoided. Applications for extensions might, of course, still come in occasionally in cases of extreme hardship; but they would appeal to the generosity and gratitude of the public, as in the cases of Dr. Graham's heirs (16 Fed. Rep. 543 and the Page heirs (1 Fed. Rep. 304), or seek relief from individual misfortunes or from private wrongs. Their number would be small, and they would easily be disposed of. No longer could they come in scores, imperatively demanding justice from Congress by

reason of the broken promises and bad faith of the government itself.

An immediate and potent remedy for the evils of the present practice may and should be provided. For that purpose I suggest an amendment to the statute, simply adding at the end of Section 4921 the following words:

"Injunctions to restrain infringement *pendente lite* shall not be denied on the mere ground that the patent is of recent date or has not been adjudicated, ~~nor where the validity of the patent, or the fact of infringement is supported by a preponderance of evidence.~~"

Such an amendment would not interfere with any legal or equitable defense, would relieve the government from the charge of bad faith, would save Congress from wasting its time on a multitude of extension cases, and, in my judgment, would add greatly to the efficiency of our patent system as a means of promoting the progress of science and useful arts.