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***O'Reilly v. Morse* and Claiming a “Principle” in Antebellum Era Patent Law**

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O'REILLY V. MORSE AND CLAIMING A
"PRINCIPLE" IN ANTEBELLUM ERA
PATENT LAW

Adam Mossoff[†]

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INTRODUCTION

Samuel Finley Breese Morse initiated the telecommunications revolution with his invention of the first functional electro-magnetic telegraph in the 1830s.¹ For the first time in human history, communication of information over long distances was no longer inexorably tied to the speed of horses or ships, or clumsily telegraphed short distances by smoke or flags.² Information traveled as fast as electricity. Morse’s telegraph was heralded at the time as the “Lightning Line” and Morse himself was called the “Lightning Man.”³ But Morse also casts a long shadow over the United States patent system, or, more precisely, Chief Justice Roger B. Taney casts this shadow with his 1854 opinion in the seminal case of *O’Reilly v. Morse*.⁴

In *Morse*, Chief Justice Taney invalidated a portion of Morse’s primary patent on his invention of the electro-magnetic telegraph on the ground that Morse aggrandized control over communications technologies in his patent far beyond what he had in fact invented.⁵ Similar to the telecommunications revolution born of Morse’s invention, Chief Justice Taney’s *Morse* opinion has been a fountainhead decision in U.S. patent law whose effects are felt to this day.⁶

Judges and scholars largely agree that *Morse* was correctly decided. There is a legalistic dispute about what specific rule in patent law was applied in the case, whether it was a problem with Morse claiming an

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1. Morse’s first patent issued on the American Electro-Magnetic Telegraph in 1840, see U.S. Patent No. 1,647 (issued June 20, 1840).
 2. See DANIEL WALKER HOWE, *WHAT HATH GOD WROUGHT: THE TRANSFORMATION OF AMERICA, 1815–1848*, at 1 (2007) (“For thousands of years messages had been limited by the speed with which messengers could travel and the distance at which eyes could see signals such as flags or smoke.”).
 3. KENNETH SILVERMAN, *LIGHTNING MAN: THE ACCURSED LIFE OF SAMUEL F.B. MORSE* 240, 244 (2004); see also *Smith v. Downing*, 22 F. Cas. 511, 519–20 (C.C.D. Mass. 1850) (No. 13,036) (stating that Morse’s telegraph “literally gives ‘letters to lightning,’ as well as ‘lightning to letters’”).
 4. 56 U.S. (15 How.) 62 (1854).
 5. See *id.* at 113 (“[Morse] shuts the door against inventions of other persons For he says he does not confine his claim to the machinery or parts of machinery, which he specifies; but claims for himself a monopoly in its use, however developed, for the purpose of printing at a distance. . . . The court is of the opinion that the claim is too broad, and not warranted by law.”).
 6. See ROBERT PATRICK MERGES & JOHN FITZGERALD DUFFY, *PATENT LAW AND POLICY: CASES AND MATERIALS* 110 (6th ed. 2013) (“Morse’s invention also occurred at the beginning of a revolution in patent law as significant as the one in communications.”).

unpatentable abstract idea or his failing the enablement requirement,⁷ but this is what William Blackstone would call a debate of “scholastic refinement.”⁸ *Morse* is recognized as a foundational case that reached the right decision.⁹ It is in law school casebooks¹⁰ and treatises.¹¹ Modern courts continue to cite it as authoritative precedent.¹² *Morse* was extensively discussed and debated by the Court of Appeals for the Federal Circuit in a decision that applied its rule to a patent on a new method of making an automobile axle, holding that it was an invalid claim to abstract idea.¹³ The Supreme Court continues to cite *Morse* as controlling precedent in patent eligibility cases, especially in its recent decisions addressing the patentability of modern innovations such as computer software programs and biotech-based medical tests.¹⁴

Such universal approbation obscures an important truth: It is an anachronism. It is anachronistic for at least two reasons. First, it fails to account for significant differences in U.S. patent law between the Antebellum Era and today, especially in the key difference in the nature

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7. See *infra* text accompanying notes 22–24 (identifying dispute whether *Morse* is enablement or patent eligibility case).
 8. 2 WILLIAM BLACKSTONE, COMMENTARIES *8 (noting the differences in detail between the prominent natural rights philosophers, Hugo Grotius, Samuel Pufendorf, and John Locke).
 9. See *infra* Part II.
 10. See MERGES & DUFFY, *supra* note 6, at 107–14; F. SCOTT KIEFF, PAULINE NEWMAN, HERBERT F. SCHWARTZ & HENRY E. SMITH, PRINCIPLES OF PATENT LAW: CASES AND MATERIALS 156–63 (Robert C. Clark ed., 4th ed. 2008); CRAIG ALLEN NARD, THE LAW OF PATENTS 92–96 (4th ed. 2017).
 11. See, e.g., CRAIG ALLEN NARD & R. POLK WAGNER, PATENT LAW 56–58 (2008); JANICE M. MUELLER, PATENT LAW 284 (3d ed. 2009); ROGER E. SCHECHTER & JOHN R. THOMAS, PRINCIPLES OF PATENT LAW 187 (2004).
 12. See, e.g., *Ultramercial, Inc. v. Hulu, Inc.*, 722 F.3d 1335, 1344–45 (Fed. Cir. 2013); *CLS Bank Int’l v. Alice Corp. Pty.*, 717 F.3d 1269, 1280–81 (Fed. Cir. 2013) (en banc) (Lourie, J., concurring), *aff’d*, 573 U.S. 208, 216 (2014); *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1346 n.4 (Fed. Cir. 2010) (en banc); *In re Nuijten*, 500 F.3d 1346, 1368–69 (Fed. Cir. 2007) (Linn, J. concurring in part and dissenting in part); *Hercules Inc. v. Exxon Corp.*, 497 F. Supp. 661, 680–81 (D. Del. 1980).
 13. See *American Axle & Mfg. v. Neapco Holdings LLC*, 967 F.3d 1285, 1297, 1301–02, 1308–09 (Fed. Cir. 2020) (including extensive debate between the majority and dissent regarding the *Morse* decision and its applicability in this case).
 14. See *Alice*, 573 U.S. at 2354 (2014); *Mayo Collaborative Servs. v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 70–71 (2012); *Lab’y Corp. v. Metabolite Laboratories, Inc.*, 548 U.S. 124, 126 (2006) (Breyer, J., dissenting); see also *Bilski v. Kappos*, 561 U.S. 593, 649 (2010); *Diamond v. Diehr*, 450 U.S. 175, 187–88 (1981); *Parker v. Flook*, 437 U.S. 584, 592 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 68 (1972).

and function of how an inventor claimed in a patent what was one’s invention. Second, once this legal context is established, it then fails to account for how Chief Justice Taney did not follow this settled legal practice in patent law in the Antebellum Era, even given the evolving, embryonic nature of U.S. patent law in the early nineteenth century. In sum, there is a profound misunderstanding of the denouement of the “Telegraphic War in the West” in Chief Justice Taney’s *Morse* opinion in 1854.¹⁵

In reviewing rediscovered primary source materials, including the Supreme Court’s case record for *Morse*, this article places Chief Justice Taney’s *Morse* opinion within its proper historical and legal context. First, it describes the conventional wisdom that Morse was a would-be monopolist who attempted to aggrandize to himself telecommunications technologies far beyond the electro-magnetic telegraph he invented in the 1830s. Second, it details the early nineteenth-century legal practice in patent law in which patent claims secured the essential “principle” of an invention, as distinguished from the peripheral claims today that define the boundaries of the property right in an invention. Once this legal context is established, it is clear that Morse’s patents on the electro-magnetic telegraph followed this legal practice in securing the principle of his invention. This article identifies this as “principle claiming,” as opposed to the anachronistic label of “central claiming” used by lawyers today. Third, it identifies how principle claims were asserted in patent infringement cases in the Antebellum Era, and how Morse again followed these practices. Finally, the Article concludes by identifying the legal, historical, and political evidence, including related telegraph patent cases decided by Supreme Court Justices and other patent cases, such as *Winans v. Denmead*,¹⁶ in showing how Chief Justice Taney departed from legal norms in invalidating Claim Eight of Morse’s patent. The historical and legal record suggests that judicial opportunism, not inventor opportunism, may be the real lesson of *Morse*.

I. MORSE TODAY: SAMUEL MORSE AS TELECOMMUNICATIONS MONOPOLIST

Morse is more famous today for his invention of a telegraphic transmission code—the dots and dashes known as Morse Code—than for his invention of the electro-magnetic telegraph. The simplicity of both Morse Code and the components comprising his electro-magnetic telegraph were innovative achievements that complemented each other,

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15. STEVEN P. BROWN, JOHN MCKINLEY AND THE ANTEBELLUM SUPREME COURT: CIRCUIT RIDING IN THE OLD SOUTHWEST 215 (2012). The lawsuit against O’Reilly was filed in Kentucky, which, in the 1840s, was a western state in the fledgling United States.
16. 56 U.S. (15 How.) 330 (1854).

producing the first functional and successful telegraphic system for transmitting information over long distances. The fruits of Morse’s inventive labors were an advance over competing telegraph systems consisting of either complicated machines that malfunctioned or complicated signaling systems that were slow and prone to errors, none of which were desirable features for a long-distance communications system.¹⁷ What Morse invented and what he described and claimed in his patent as his invention are not necessarily the same thing, and this is the crux of *Morse* and the narrative today—Morse’s failure was one of law and policy, not of his rightful claim as the inventor of the electro-magnetic telegraph he developed in his tenement in New York City in the 1830s.

Chief Justice Taney is clear in *Morse* that the problem is Claim Eight in Morse’s patent. Chief Justice Taney affirms in a single sentence Morse’s first seven claims,¹⁸ including Claim Five, which covered Morse’s invention of the binary, dot-and-dash communication language eponymously identified as Morse Code. It is Claim Eight that becomes the subject of Chief Justice Taney’s focus in *Morse*. It is the only claim that he quotes in the opinion:

Eighth. I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims; the essence of my invention being the use of the motive power of the electric or galvanic current, which I call electro-magnetism, however developed for marking or printing intelligible characters, signs, or letters, at any distances, being a new

17. See The Comm. on Sci. and the Arts, *Report on Prof. Morse’s Electro-Magnetic Telegraph*, 25 J. FRANKLIN INST. 106, 108 (1938) (“[T]he idea of using electro-magnetism for telegraphic purposes has presented itself to several different individuals, and . . . it may be difficult to settle among them the question of originality. . . . But the plan of Professor Morse is, so far as the committee are informed, entirely different from any of those devised by other individuals, all of which act by giving different *directions* to magnetic needles, and would therefore require several circuits of wires between all the stations. . . . The advantages [are] . . . that the signals may be given at night and in rains, snow, and fogs, when other telegraphs fail.”); *The English and American Telegraphs*, N.Y. OBSERVER & CHRON., June 7, 1845, at 92 (“The Telegraph (Wheatstone’s) is really as pretty a failure as I ever saw. Positively it requires *an hour* for them to transmit a sentence which you could transmit in [sic] *in five minutes*. The Telegraph works by the deflection of two needles, and they deflect so slowly, that the letters can scarcely be read at all. They use five wires, each composed of three smaller ones twisted together. Now I cannot perceive what is gained by this. In my opinion there is a loss.”).

18. O’Reilly v. Morse, 56 U.S. (15 How.) 62, 112 (1854) (“We perceive no well-founded objection . . . to his right to a patent for the first seven inventions set forth in the specification of his claims.”).

application of that power of which I claim to be the first inventor or discoverer.¹⁹

Chief Justice Taney’s negative reaction is palpable. “It is impossible to misunderstand the extent of this claim,” he writes.²⁰ He further explains:

[Morse] shuts the door against inventions of other persons For he says he does not confine his claim to the machinery or parts of machinery, which he specifies; but claims for himself a monopoly in its use, however developed, for the purpose of printing at a distance. . . . The court is of opinion that the claim is too broad, and not warranted by law.²¹

His condemnation of Morse as a would-be monopolist whose too-broad Claim Eight encompassed within his legal control more than what he had invented has been the patent law equivalent of the face that launched a thousand ships. It is the foundation for the rule in patent eligibility doctrine that inventors may not receive a patent on an abstract idea,²² which has been applied in recent years in hundreds of cases in which hundreds of patent claims have been invalidated.²³

Some judges and scholars argue that *Morse* was not applying the legal rule prohibiting the patenting of abstract ideas. Rather, they contend that Chief Justice Taney’s concern about a claim being “too broad” meant that Morse did not effectively describe and teach others how to make and use all of the inventions covered by Claim Eight.²⁴

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19. *Id.* (quoting U.S. Reissue Patent No. 117 (issued June 13, 1848)).
20. *Id.*
21. *Id.* at 113.
22. *See* *Athena Diagnostics, Inc. v. Mayo Collaborative Servs.*, 927 F.3d 1333, 1341 (Fed. Cir. 2019) (Dyk, J., concurring in the denial of petition for rehearing en banc) (referring to the Supreme Court’s opinion in *Morse* as “the foundation of the Court’s jurisprudence on patent eligibility”); *see also* *Mayo Collaborative Servs. v. Prometheus Laboratories, Inc.*, 566 U.S. 66, 85 (2012) (“The Court has repeatedly emphasized . . . a concern that patent law not inhibit further discovery by improperly tying up the future use of laws of nature.” (citing *Morse*, 56 U.S. at 113)); OREN BRACHA, *OWNING IDEAS: THE INTELLECTUAL ORIGINS OF AMERICAN INTELLECTUAL PROPERTY, 1790–1909*, at 284 (2016) (referencing “[t]he celebrated *Morse* decision, the epitome of the great maxim of unpatentability of natural principles”).
23. *See* Robert Sachs, *Alice: Benevolent Despot or Tyrant? Analyzing Five Years of Case Law Since Alice v. CLS Bank: Part I*, IPWATCHDOG (Aug. 29, 2019), <https://www.ipwatchdog.com/2019/08/29/alice-benevolent-despot-or-tyrant-analyzing-five-years-of-case-law-since-alice-v-cls-bank-part-i/id=112722/> [https://perma.cc/AQ58-QSYH].
24. *Morse*, 56 U.S. at 113; *see, e.g.*, KIEFF ET AL., *supra* note 10, at 155–56 (labeling *O’Reilly v. Morse* as an enablement case).

This separate view of *Morse* is a distinction without a difference. Regardless whether *Morse* is viewed as precedent for enablement doctrine or patentable eligibility doctrine, the major premise is the same: the case was correctly decided. All agree that Morse was attempting to monopolize in his patent the field of electronic telecommunications far beyond what he had actually invented himself.

The conventional wisdom about *Morse*—Morse as monopolist—is usually framed in one of two ways. On the one hand, some claim that Morse’s “eighth claim would have covered analog and digital data transmissions, telephonic and satellite communications—indeed, *electronic communications of all types*.”²⁵ Professors Christina Bohannan and Herbert Hovenkamp proclaim that “Morse was trying to commandeer all future technologies for accomplishing something.”²⁶ On the other hand, some scholars reject exaggerated allegations about the scope of Claim Eight, if only because the express terms used in Claim Eight limit it to only telecommunications technologies that produce “marking or printing intelligible characters, signs, or letters.”²⁷ Accordingly, Claim Eight would not cover telephones, radio, microwave, or wireless transmissions that produce only auditory sig-

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25. Mark F. Grady & Jay I. Alexander, *Patent Law and Rent Dissipation*, 78 VA. L. REV. 305, 323 (1992) (emphasis added). This assertion about the scope of Morse’s patent is ubiquitous in legal scholarship. See, e.g., Tun-Jen Chiang, *Defining Patent Scope by the Novelty of the Idea*, 89 WASH. U. L. REV. 1211, 1252 (2012) (“Samuel Morse did not invent the idea of using electric current in telegraphs, and his claim to that was denied.”); Krysta Kauble, *Patenting Everything Under the Sun: Invoking the First Amendment to Limit the Use of Gene Patents*, 58 UCLA L. REV. 1123, 1167 (2011) (“In effect, awarding Morse a patent over electromagnetic waves could have stalled any innovation based on the telegraph for twenty years, possibly delaying the invention of the telephone, cellular telephone, text messaging and so on—unless Morse altruistically granted other scientists the ability to research electromagnetic waves.”); Nicholas Robinson, *Patenting the Tax Code: Monopolizing Basic Tax Strategy*, 5 BUFF. INTEL. PROP. L.J. 50, 62 (2007) (stating that Morse’s patent would “have granted him a monopoly on virtually all electronic communication”); Jay Dratler, Jr., *Alice in Wonderland Meets the U.S. Patent System*, 38 AKRON L. REV. 299, 321 (2005) (“Morse’s eighth claim would have covered, among other things, telephone, radio, television, microwave, wireless, and Internet communication”); Robert P. Merges & Richard R. Nelson, *On the Complex Economics of Patent Scope*, 90 COLUM. L. REV. 839, 850 (1990) (“In essence, Morse declared ownership of all methods of communicating at a distance using electromagnetic waves.”); Justin Hughes, *The Philosophy of Intellectual Property*, 77 GEO. L.J. 287, 320 (1988) (noting that Morse attempted to “monopolize the general idea of using galvanic current for long-distance communications”).
26. Christina Bohannan & Herbert Hovenkamp, *IP and Antitrust: Reformation and Harm*, 51 B.C. L. REV. 905, 954 (2010).
27. U.S. Reissue Patent No. 117 (issued June 13, 1848).

nals.²⁸ But they still conclude that Morse’s patent would cover fax machines, email, text messages, and other modern telecommunications technologies that produce written results, and which Morse certainly did not invent.²⁹ Thus, both arguments accept to varying degrees Chief Justice Taney’s characterization in *Morse* of the unjustified, unlimited breadth of Claim Eight.

Both arguments about the scope of Morse’s Claim Eight are mistaken. Since lawyers and judges have had access to only Chief Justice Taney’s *Morse* opinion, it is an understandable mistake. Even courts in the late nineteenth century adopted the same mistaken interpretation given their own limited access to only the *Morse* opinion.³⁰

28. See MERGES & DUFFY, *supra* note 6, at 112 (quoting Claim 8).

29. See, e.g., BRACHA, *supra* note 22, at 268 (Morse’s Claim 8 “would ensnare telegraph designs significantly different from Morse’s . . . Here was an attempt to patent a ‘principle,’ if there ever was one.”); Sean B. Seymore, *The Teaching Function of Patents*, 85 NOTRE DAME L. REV. 621, 660 (2010) (asserting that “text messaging . . . clearly falls within the scope of Morse’s claim”); Michael Risch, *A Surprisingly Useful Requirement*, 19 GEO. MASON L. REV. 57, 104 (2011) (stating that Morse “claimed all forms of printed communication by any electromagnetic signal”); Jacob Adam Schroeder, *Written Description: Protecting the Quid Pro Quo Since 1793*, 21 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 63, 73 (2010) (footnote omitted) (“In *O’Reilly*, after Samuel Morse invented the telegraph, he attempted to claim the exclusive right not only to his own invention, but to all devices using electricity to print characters at a distance. This was, in fact, the scope of claim 8 of his patent.”); William Michael Schuster, *Predictability and Patentable Processes: The Federal Circuit’s In Re Bilski Decision and Its Effect on the Incentive to Invent*, 11 COLUM. SCI. & TECH. L. REV. 1, 6–7 (2009) (“[A]ny future invention that used electromagnetism to communicate characters or symbols would fall within the ambit of Morse’s eighth claim.”); Shawn McDonald, *Patenting Floppy Disks, or How the Federal Circuit’s Acquiescence has Filled the Void Left by Legislative Inaction*, 3 VA. J.L. & TECH. 9, para. 17 (1998) (“Yet, because a fax machine electro-magnetically transmits text over a distance it would infringe Morse’s claim 8.”); Pamela Samuelson, *Benson Revisited: The Case Against Patent Protection for Algorithms and Other Computer Program-Related Inventions*, 39 EMORY L.J. 1025, 1056 n.100 (1990) (“His famous eighth claim was for *all* uses of electromagnetism to communicate intelligible characters at a distance”); see also *CLS Bank Int’l v. Alice Corp. Pty.*, 717 F.3d 1269, 1280–81 (Fed. Cir. 2013) (en banc) (Newman, J., concurring in part and dissenting in part) (stating that “Samuel Morse’s broadest claim was rejected for undue breadth because it was directed to ‘the use of the motive power of the electric or galvanic current . . . for making or printing intelligible characters, letters or signs, at any distances’” (alteration in original) (quoting *Morse*, 56 U.S. at 86)).

30. See, e.g., *Roberts v. Dickey*, 20 F. Cas. 880, 885 (C.C.W.D. Pa. 1871) (No. 11,899) (repeating the conventional wisdom that Morse was aggrandizing to himself control over technologies that he did not invent).

They are correct, though, as a matter of patent policy: Morse could not legitimately claim, either morally or legally, exclusive control over modern email or fax technologies based on his invention in the 1830s of a machine that made only tic marks using electricity and magnetism. No person should receive a patent covering something that one has not invented.³¹ From the beginning of the U.S. patent system, this has been a foundational legal requirement that has distinguished property rights in inventions from monopoly grants in commercial enterprises.³² Thus, when Chief Justice Taney decries Claim Eight as “too broad” and that it “shuts the door against inventions of other persons,”³³ he is applying a core policy in patent law.

To understand why the *Morse* opinion was not necessarily an exemplar of this patent policy, one must first understand the nature of patents, patent law, and patent litigation in the Antebellum Era, which differed fundamentally from how patents are drafted by modern lawyers and interpreted by courts today. Given these differences in both law and the practices of legal elites, revisiting this historical context can feel like the equivalent of visiting a foreign country despite it still being a description of U.S. law, institutions, and norms. In fact, this is what makes the *Morse* anachronism possible, because the use of the same language can make it appear that earlier jurists, commentators, and

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31. *See* *Bedford v. Hunt*, 3 F. Cas. 37, 37 (C.C.D. Mass. 1817) (No. 1,217) (Story, Circuit Justice) (“No person is entitled to a patent under the act of congress unless he has invented some new and useful art, machine, manufacture, or composition of matter, not known or used before.”).
32. *See, e.g.,* *Birdsall v. McDonald*, 3 F. Cas. 441, 444 (C.C.N.D. Ohio 1874) (No. 1,434) (Swayne, Circuit Justice) (“Inventors are a meritorious class of men. They are not monopolists in the odious sense of that term. They take nothing from the public. They contribute largely to its wealth and comfort. Patent laws are founded on the policy of giving to them remuneration for the fruits, enjoyed by others, of their labor and their genius. Their patents are their title deeds, and they should be construed in a fair and liberal spirit, to accomplish the purpose of the laws under which they are issued.”); *Allen v. Hunter*, 1 F. Cas. 476, 477 (C.C.D. Ohio 1855) (No. 225) (McLean, Circuit Justice) (“Patentees are not monopolists. . . . No exclusive right can be granted for anything which the patentee has not invented or discovered. . . . [T]he law repudiates a monopoly. The right of the patentee entirely rests on his invention or discovery of that which is useful, and which was not known before. And the law gives him the exclusive use of the thing invented or discovered, for a few years, as a compensation for ‘his ingenuity, labor, and expense in producing it.’”); *Ames v. Howard*, 1 F. Cas. 755, 756 (C.C.D. Mass. 1833) (No. 326) (Story, Circuit Justice) (“Patents for inventions are not to be treated as mere monopolies odious in the eyes of the law, and therefore not to be favored; nor are they to be construed with the utmost rigor, as strictissimi juris. . . . Hence it has always been the course of the American courts . . . to construe these patents fairly and liberally, and not to subject them to any over-nice and critical refinements.”).
33. *Morse*, 56 U.S. at 113.

lawyers are applying the same legal concepts as today. But they were not. It is time to recover what *Morse* meant in yesteryear, which is not what it means today.

II. A CLAIMED PRINCIPLE IN ANTEBELLUM PATENTS AND IN *MORSE*

Chief Justice Taney’s laser-like focus on Claim Eight—to the exclusion of both the prior seven claims and the written description—seems correct to modern patent lawyers and scholars because this is the basic method of asserting and interpreting claims in patent infringement cases today.³⁴ This was not the practice among judges, lawyers, or commentators in the Antebellum Era. In fact, it was contrary to U.S. patent law at that time to construe an individual patent claim in isolation from the rest of the patent document, including the other patent claims and the specification.³⁵ This Part explains claiming practices in Antebellum Era patent law and how *Morse* followed these legal rules and practices in his patents. This historical and legal context is necessary to understand both *Morse*’s patent and his litigation against O’Reilly.

34. *See* *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1454 (Fed. Cir. 1998) (en banc) (“An infringement analysis involves two steps. First, the court determines the scope and meaning of the patent claims asserted, and then the properly construed claims are compared to the allegedly infringing device.” (citations omitted)); *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 980 (Fed. Cir. 1995) (en banc) (“The written description part of the specification itself does not delimit the right to exclude. That is the function and purpose of claims.”), *aff’d*, 517 U.S. 370 (1996).

35. *See* *Brooks v. Fiske*, 56 U.S. (15 How.) 212, 215 (1854) (“The claim, or summing up, however, is not to be taken alone, but in connection with the specification and drawings; the whole instrument is to be construed together.”); GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF PATENTS FOR USEFUL INVENTIONS 322 (2d ed. 1854) (stating that an infringement “is a copy of the thing described in the specification of the patentee, either without variation, or with only such variations as are consistent with its being, in substance, the same thing”); William Redin Woodward, *Definiteness and Particularity in Patent Claims*, 46 MICH. L. REV. 755, 760 (1948) (“[T]he courts for a long time did not regard the particular formulations chosen by the inventor to express his claim and distinguish his invention from the prior art as the definitive measure of the scope of the patent. Rather, the whole patent document, including the claims as a guide, was to be viewed to ascertain the scope and nature of the invention and to determine whether the invention was embodied in the defendant’s practices or devices . . .”).

A. *Claiming the Principle of an Invention in Early U.S. Patent Law*

Today, patent claims define the “metes and bounds” of the property right.³⁶ These are now known as peripheral claims. In suing someone for patent infringement, patent owners today identify the specific point of trespass by the defendant—the individual claim or claims.³⁷ Courts thus compare this specific claim to the accused infringing product or process to determine if patent infringement has occurred. This basic methodology in construing individual patent claims in patent infringement cases presupposes the modern practice of peripheral claiming in patents.

In the Antebellum Era, however, the nature and function of a patent, including its claims, was to secure “the principle” of an invention, not the boundaries of the property right in the invention.³⁸ Today, lawyers call this “central claiming,” to distinguish it from the modern practice of peripheral claiming.³⁹ This label is an anachronism. “Central claiming” was not the term used by lawyers, courts, or commentators in the Antebellum Era. We should use the term they used: patents secure *the principle* of an invention.

Accordingly, patent claims in the early nineteenth century set forth the essence or principle of the novel, useful invention that was justly secured by the patent system.⁴⁰ The patent statutes mandated that inventors do this. The 1836 Patent Act, repeating the same language from the 1793 Patent Act, required that the patent specification, including the claims, contain “a written description of his invention or discovery, . . . [in which] he shall fully explain *the principle* and . . . that *principle* or character by which it may be distinguished from other inventions.”⁴¹ Inventors and their lawyers followed the letter of the

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36. See Adam Mossoff, *The Trespass Fallacy in Patent Law*, 65 FLA. L. REV. 1687, 1693 (2013) (discussing judicial practice of referring to patent claims as the “metes and bounds” of the property right).
37. See *id.* (discussing how courts refer to patent infringement as a “trespass”).
38. See Michael Risch, *America’s First Patents*, 64 FLA. L. REV. 1279, 1296 (2012) (“Most early cases stating that ‘principles’ are not patentable were not patentable subject matter opinions; instead, they were attempts to determine what the patent covered.”).
39. See JANICE M. MUELLER, *PATENT LAW* 87 (5th ed. 2016) (“The development of claiming practice in the United States reflects a shift from a historical *central claiming* regime to the current system of *peripheral claiming*.”).
40. See *Stephenson v. Hoyt*, 22 F. Cas. 1303, 1305 (C.C.D.C. 1854) (No. 13,376) (Morsell, Circuit Judge) (“Whatever that principle is, he has certainly a right to be protected in the enjoyment of it after it has become secured to him by a patent.”).
41. Patent Act of 1836, ch. 357, § 6, 5 Stat. 117, 119 (repealed 1870) (emphases added); *accord* Patent Act of 1793, ch. 11, § 3, 1 Stat. 318, 321–22 (repealed 1836).

law.⁴² Unsurprisingly, judges applied this statutory mandate in construing patents and in instructing juries on liability for infringement (or in finding infringement when they sat in equity if the patent owner requested an injunction).⁴³ This historical and legal context in early U.S. patent law should be acknowledged and respected; thus, we should refer to these early claiming practices as *principle claiming*.

The legal practice in claiming the “principle” of an invention in early American patents—a legal term of art that was differentiated from an abstract principle or law of nature that was unpatentable⁴⁴—was well established by the time *Morse* was decided in 1854. Justice George T. Curtis’s famous 1849 patent law treatise devoted over sixty pages to explaining the distinction between a patentable “principle” and an unpatentable abstract principle.⁴⁵ Another treatise published in 1853 instructed inventors and patent lawyers on how to draft a patent to secure “the principle” of the invention, explaining that a broad claim is entirely proper when “the invention is new in principle” such “that the claim may be made as large as possible, so as to prevent any adaptations of the principle by different machinery.”⁴⁶ In discussing the novelty requirement, this treatise states that “[t]he person who suggests the

42. See, e.g., U.S. Patent No. X1865 (granted Jan. 12, 1813) (“The characteristic principle . . . is . . . that temper given to steel for a proper spring.”).

43. See, e.g., *Page v. Ferry*, 18 F. Cas. 979, 984–85 (C.C.E.D. Mich. 1857) (No. 10,662) (“What is the principle of the improvement invented by the plaintiff? . . . If a defendant adopts a different mode of carrying the same principle into effect, . . . there is an identity of principle . . . [I]t suffices if the principle has been pirated.”); *Blanchard v. Beers*, 3 F. Cas. 617, 617–18 (C.C.D. Conn. 1852) (No. 1,506) (Nelson, Circuit Justice) (instructing a jury that “in his specification, the patentee explains the principle embodied in his machine, in other words, the novel characteristics or inventive elements of the machine”); CURTIS, *supra* note 35, at 321 (“Learned judges have often laid it down that, where two things are the same in principle, the one is an infringement upon the other.”).

44. See *Barrett v. Hall*, 2 F. Cas. 914, 923 (C.C.D. Mass. 1818) (No. 1,047) (Story, Circuit Justice) (“In the minds of some men, a principle means an elementary truth, or power . . . No one, however, in the least acquainted with law, would for a moment contend, that a principle in this sense is the subject of a patent . . . The true legal meaning of the principle of a machine, with reference to the patent act, is the peculiar structure or constituent parts of such machine.”); *Whittemore v. Cutter*, 29 F. Cas. 1123, 1124 (C.C.D. Mass. 1813) (No. 17,601) (Story, Circuit Justice) (“By the principles of a machine, (as these words are used in the statute) is not meant the original elementary principles of motion, which philosophy and science have discovered, but the modus operandi, the peculiar device or manner of producing any given effect.”).

45. See CURTIS, *supra* note 35, at 84–124.

46. JOHN PAXTON NORMAN, A TREATISE ON THE LAW AND PRACTICE RELATING TO LETTERS PATENT FOR INVENTIONS 74–75 (1853).

principle is the first and true inventor.”⁴⁷ Of course, it also recognized as bedrock patent law that “[a] patent cannot be obtained for an abstract philosophical principle.”⁴⁸

It is impossible to understand either Morse’s patents on his electro-magnetic telegraph, Morse’s litigation against O’Reilly, or Chief Justice Taney’s *Morse* opinion without first situating these legal documents and practices within these legal norms of early U.S. patent law. At this time, a patent secured the principle of an invention—as evidenced by the written description and the claims—and defendants were accused in court of infringing this principle. Thus, early nineteenth-century courts construed the “principle” of the invention as represented by the entire patent and applied this principle to the allegedly infringing product or process.⁴⁹ To wit, modern patent lawyers and judges must strip away the anachronism that infects the current citations and discussions of *Morse*. When modern judges focus on individual claims asserted by lawyers in infringement actions, this is predicated on peripheral claiming practices today. Morse’s patents and his litigation against O’Reilly were predicated on the legal rules and practices of principle claiming—confirming that what Chief Justice Taney does in *Morse* in focusing only on Claim Eight was not legally valid.

*B. Morse Used Principle Claiming in His Patents
to Secure His Invention*

Morse first conceived of his electro-magnetic telegraph during an ocean voyage from Paris to New York City in 1832.⁵⁰ He perfected his invention throughout the 1830s with the first of his many patents on electro-magnetic telegraphy issuing on June 20, 1840.⁵¹ His electro-magnetic telegraph represented a seminal breakthrough given its

47. *Id.* at 47.

48. *Id.* at 8. Norman also identifies that this can be asserted as an affirmative defense: “That the invention is not a manufacture within the statute. This seems the proper plea to raise the objection so often made unsuccessfully, that the patent is for a principle.” *Id.* at 167 (citations omitted).

49. *See, e.g.*, *Wyeth v. Stone*, 30 F. Cas. 723 (C.C.D. Mass. 1840) (No. 18,107) (Story, Circuit Justice) (surveying the entire patent and evaluating its two claims explicitly by reference to the specification in assessing its validity).

50. *See* 2 SAMUEL F.B. MORSE: HIS LETTERS AND JOURNALS 6–8 (Edward Lind Morse ed., 1914) (depicting three sketches from Morse’s notebook from the 1832 voyage); *see also* Deposition of R.C. Morse, Case Record at 255, *O’Reilly v. Morse*, 56 U.S. (15 How.) 62 (1854) (No. 224) (“Samuel F.B. Morse, then returning home from a three years residence in Europe. . . . informed us that he had made, during his voyage, an important invention which had occupied almost all his attention on ship-board . . . and showed us his sketchbook I distinctly recollect my surprise and delight at the announcement of this brilliant invention.”).

51. *See* U.S. Patent No. 1,647 (issued June 20, 1840).

simplicity in both design and function—it was the epitome of the engineer’s “elegant solution.” Other telegraph systems independently developed at around the same time that Morse invented and perfected his telegraph failed because of their excessive complexity in both mechanical design and in their signaling codes.⁵² It was only Morse who fully embraced the simplicity of a single circuit powered by a battery that activated an electro-magnet, moving a magnetized armature to mark out the dots and dashes of a binary code on a strip of paper.⁵³

His first patent, U.S. Patent No. 1,647, details all of these elements of his electro-magnetic telegraph system. It contains a lengthy description of the invention and it concludes with nine claims that comprise what Morse refers to as “my invention.”⁵⁴ Morse’s claims set forth the various components and processes of his electro-magnetic telegraph, such as Morse Code (Claim 3), the handle for alternately activating/deactivating the electrical circuit (Claim 4), and the combination of the electro-magnet, the electrical circuit, and the recording machinery for “transmitting intelligence by signs and sounds” (Claim 8).

The now-infamous Claim Eight, though, did not exist in 1840. Morse created Claim Eight in a second reissue patent (Reissue Patent No. 117) that he received from the Patent Office on June 13, 1848.⁵⁵

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52. *See supra* note 17 and accompanying text; *see also Galvanic Telegraph*, N.Y. OBSERVER & CHRON., Oct. 28, 1837 (describing the complicated circuitry and elaborate recoding system used by a competing telegraph created by an English inventor, Charles Wheatstone, and concluding that the “most perfect code of signals, beyond question, is that of Professor Morse”); TOM STANDAGE, *THE VICTORIAN INTERNET: THE REMARKABLE STORY OF THE TELEGRAPH AND THE NINETEENTH CENTURY’S ON-LINE PIONEERS* 36 (1998) (depicting illustration of complicated telegraph invented by William Fothergill Cooke and Charles Wheatstone in England); LEWIS COE, *THE TELEGRAPH: A HISTORY OF MORSE’S INVENTION AND ITS PREDECESSORS IN THE UNITED STATES 14–19* (1993) (comparing and contrasting “simple” Morse telegraph with “complicated” or “delicate” telegraphs invented by Wheatstone, House and Bain).
53. *See* DAVID HOCHFELDER, *THE TELEGRAPH IN AMERICA, 1832–1920*, at 74–76 (2012) (describing the efficiencies achieved by Morse’s transmission code in permitting compression of information); KEVIN G. WILSON, *DEREGULATING TELECOMMUNICATIONS: U.S. AND CANADIAN TELECOMMUNICATIONS, 1840–1997*, at 10 (2000) (“The genius of the Morse system was its simplicity and reliability A key component of the system was the code developed by Morse to convert the letters of the alphabet into dots and dashes (short and long electrical signals).”).
54. ‘647 Patent.
55. U.S. Reissue Patent No. 117 (issued June 13, 1848). This replaced U.S. Reissue Patent No. 79 (issued Jan. 15, 1846). The ability of patent owners to obtain corrected, “reissue” patents was well established in patent law by the 1830s, having been an administrative practice adopted by the Patent Commissioner decades earlier, affirmed by the Supreme Court in

(Reissue Patent 117 was the specific patent that Morse accused O’Reilly of infringing, and more on this shortly.) This was his second reissued patent on his primary invention, as he had previously received Reissue Patent No. 79, which was issued by the Patent Office on January 15, 1846. Reissue patents were the result of a patent owner surrendering a patent back to the Patent Office for correction for defects of expression or style that had an unintended substantive effect of impairing the full scope of the property right secured to the patent owner.⁵⁶ A patent owner was prohibited from expanding the scope of the patent in a reissue patent; the function of a reissue patent was solely to correct only formal defects.⁵⁷ As Morse explained in his complaint against O’Reilly, he had received the two reissue patents “on account of defects in the specifications which formed parts of the two patents issued.”⁵⁸

All three patents were before the U.S. Supreme Court in *Morse*, as they were entered into evidence and formed the basis of depositions and legal disputation throughout the litigation between Morse and O’Reilly from the complaint filed in the Circuit Court of the District of Kentucky in August 1848 all the way up through the denouement of the case in 1854.⁵⁹ The significance of the inclusion of all the patents is that they reaffirm that Morse followed the basic tenets of principle claiming, as was the legal practice of the time.

Grant v. Raymond, 31 U.S. (6 Pet.) 218, 244 (1832), and ultimately codified by Congress in the Patent Act of 1836, ch. 357, § 13, 5 Stat. 117, 122 (repealed 1870).

56. See Kendall J. Dood, *Pursuing the Essence of Inventions: Reissuing Patents in the 19th Century*, 32 *TECH. & CULTURE* 999, 1001–02 (1991).
57. See Cahart v. Austin, 4 F. Cas. 997, 1000 (C.C.D.N.H. 1865) (No. 2,288) (Clifford, Circuit Justice) (stating that the reissue right “was intended to remedy that evil” in which patents “had frequently been adjudged invalid . . . from the insufficiency of the specification,” and thus it was not for the purpose “that the patent may be rendered more elastic or expansive”); Adam Mossoff, *Who Cares What Thomas Jefferson Thought About Patents? Reevaluating the Patent “Privilege” in Historical Context*, 92 *CORNELL L. REV.* 953, 1001–03 (2007) (describing the rise of the reissue right by administrative fiat at the Patent Office, its validation by the Supreme Court in 1832, and the doctrinal limits imposed on it).
58. Bill of Complaint, Case Record at 4, *O’Reilly v. Morse*, 56 U.S. (15 How.) 62 (1854) (No. 224). The right of patent-owners to obtain a “reissue patent” was first established by the Patent Office without authorization under the patent statutes. Mossoff, *supra* note 57, at 1002. When challenged, it was upheld in a unanimous decision in *Grant v. Raymond*, 31 U.S. at 244 (Marshall, C.J.). This is just one example of how patents were secured by early American courts as civil rights in fundamental property rights, which were expansively and liberally construed in favor of patentees. See Mossoff, *supra* note 57, at 1002–04.
59. See Case Record at 64–87, *Morse*, 56 U.S. 62 (No. 224).

In the opening paragraphs of Reissue Patent 79, for instance, Morse stated that the patent sets forth “a full, clear, and exact description of the *principle* or character” of the “invention I denominate the ‘American Electro-Magnetic Telegraph.’”⁶⁰ (It is important to remember that, before peripheral claiming, principle claims were considered part of the full specification that described the invention.) Even more importantly, in both Reissue Patent 79 and Reissue Patent 117, Morse expressly *disclaims* “the principle” of his invention adopted in Chief Justice Taney’s construction of Claim Eight as encompassing all electro-magnetic telegraphy that produces written results at a distance. In Reissue Patent 79, Morse wrote that “I do not claim the use of the galvanic current or currents of electricity for the purpose of telegraphic communication.”⁶¹ Similarly, in Reissue Patent 117, the actual patent at issue in *Morse*, he stated right before listing his claims: “Having thus fully described my invention, I wish it to be understood that I do not claim the use of the galvanic current or currents of electricity for the purpose of telegraphic communications generally[.]”⁶² Following principle claiming practice at the time, a court must have read this disclaimer in construing the meaning of the claims that followed.

Claim One in Reissue Patent 79 was clear about what Morse considered to be the principle of his invention: “What I specifically claim as my invention and improvement is . . . making use of the motive power of magnetism when developed by the action of such [galvanic] current or currents, as a means of operating or giving motion to machinery.”⁶³ Morse concluded the lengthy and verbose Claim One with the following summary statement:

I therefore characterize my invention as the first recording or printing telegraph by means of electro-magnetism. There are various known modes of producing motions by electro-magnetism, but none of these have hitherto been applied to actuate or give motion to printing or recording machinery, which is the chief point of my invention and improvement.⁶⁴

60. U.S. Reissue Patent No. 79 (emphasis added).

61. *Id.* He knew that he could not make this claim because he knew of experimental work in telegraphy using electricity before his invention, such as Dr. Joseph Henry’s experiments at Princeton University in the late 1820s in transmitting electricity along great lengths of copper wire that resulted in an electro-magnet ringing a bell. See ALBERT E. MOYER, JOSEPH HENRY: THE RISE OF AN AMERICAN SCIENTIST 67–70 (1997).

62. U.S. Reissue Patent No. 117 (issued June 13, 1848).

63. 79 Reissue Patent; Case Record at 68, *Morse*, 56 U.S. 62 (No. 224).

64. 79 Reissue Patent; Case Record at 68, *Morse*, 56 U.S. 62 (No. 224).

In simple terms: Morse’s invention used electricity to activate an electro-magnet, which then caused a metal armature on a machine to move, striking a strip of paper and making tic marks on this piece of paper (in the form of the dot-and-dash language identified as Morse Code). This was the invention he conceived and perfected as a practical technology in the 1830s.⁶⁵

The claims in Reissue Patent 117 similarly set forth the components and processes that comprise the principle of “the first recording or printing telegraph by means of electro-magnetism” (as he writes in a portion of the lengthy and generalized Claim One).⁶⁶ The structure of Morse’s claims in Reissue Patent 117 is completely alien to modern claiming practices. Claim Two through Claim Seven describe the specific components or processes comprising his electro-magnetic telegraph, such as the mechanical device that marks out the Morse Code (Claim Two), the circuit that provides on-and-off pulses of electricity to the electro-magnet (Claim Three), Morse Code (Claim Five), and so on. In sum, Morse structured his eight claims in Reissue Patent 117 such that he bookended his claims to the specific machinery, circuits and transmission code comprising one embodiment of his invention (Claims Two through Seven) with two general claims to the pioneering technology of his electro-magnetic telegraph as such (Claim One and Claim Eight). This structure of claims makes sense only if the function of claims is to set forth the principle of the novel and useful invention.

The function of these claims in securing the principle of his invention is confirmed by Morse and his business associates testifying on this point in the litigation before the trial court in Kentucky. In an affidavit filed by Leonard Gale, a patent examiner, he stated: “the essence or spirit of the invention patented by Samuel F.B. Morse . . . consist[s] in a principle carried out in practice,” but, he warned, it must be remembered that “the term principle, as used here, cannot be used abstractly, but must be considered in connexion [sic] with a result, an end, or a practical application.”⁶⁷ Both Gale and another affiant, Charles Page, Chief Examiner at the Patent Office, stated that they believed that the “patentable principle” in Morse’s invention is the use of an electro-magnet or “inferior electro-magnetic contrivances” to operate machinery for the printing of signals.⁶⁸ This is the “essence of

65. See *supra* notes 50–54 and accompanying text; see also RICHARD R. JOHN, NETWORK NATION: INVENTING AMERICAN TELECOMMUNICATIONS, CHPT. 2 (2010); SILVERMAN, *supra* note 3, at 148–50.

66. 117 Reissue Patent.

67. Affidavit of Leonard D. Gale, Case Record at 121, *Morse*, 56 U.S. 62 (No. 224).

68. Affidavit of Charles G. Page, Case Record at 127, *Morse*, 56 U.S. 62 (No. 224); see also Affidavit of Leonard D. Gale, Case Record at 122, *Morse*, 56 U.S. 62 (No. 224).

the invention” secured to Morse, and, according to Gale, “is contained in the first and last claims” in Reissue Patent No. 117—in Claim One and Claim Eight.⁶⁹

In addition to Reissue Patent 117 and the preceding patents on the electro-magnetic telegraph infringed by O’Reilly, Morse’s patents on his other telegraph inventions further confirm he was following principle claiming practices in Reissue Patent 117, including in the ill-fated Claim Eight. In fact, Morse was drawn into another legal dispute concerning whether Alexander Bain could receive a patent for an electro-chemical telegraph given these other patents issued to Morse.⁷⁰ Bain’s and Morse’s patents on their respective inventions of an electro-chemical telegraph are important for two reasons.

First, Morse’s additional patents would have been unnecessary if Claim Eight had the unbounded scope attributed to it by Chief Justice Taney. In 1846, Morse applied for a *new* patent (and later received another reissue patent) for his invention of an electro-chemical telegraph.⁷¹ When Morse obtained Reissue Patent 118 on this electro-chemical telegraph on June 13, 1848, he already had received Reissue Patent 117 with the ill-fated Claim Eight. If Claim Eight in Reissue Patent 117 covered *all* telecommunications processes that produced written characters at a distance, which would include the use of chemical processes to make these marks, then Morse would not have incurred the additional expenses in both time and money in securing his invention of an electro-chemical telegraph with two entirely separate patents (Patent 4,453 and Reissue Patent 118). In sum, consistent with his principle claims and his express disclaimers in his patents on his electro-magnetic telegraph, Morse obtained separate patents for his invention of an electro-chemical telegraph.

Second, and even more important, Reissue Patent 118 on the electro-chemical telegraph contained even stronger disclaimers than those found in Morse’s patents on the electro-magnetic telegraph. Since this patent secured the principle of using electricity to produce written

69. Affidavit of Leonard D. Gale, Case Record at 121–22, *Morse*, 56 U.S. 62 (No. 224).

70. *See Bain v. Morse*, 2 F. Cas. 394, 403 (C.C.D.C. 1849) (No. 754). When Bain filed an appeal in federal court contesting the administrative decision by the Patent Office rejecting his patent application given Morse’s patents on this telegraph technology, his lawsuit was deemed to be an Article III equivalent of an interference action. As a result, Morse was listed as a defendant in the case. *See id.* Once more, Morse was required to collect and prepare evidence on his inventive activities reaching back to the 1830s. In *Bain*, Judge William Cranch held that both Morse’s and Bain’s inventions were sufficiently distinct in their technical details and processes that they were not the same invention; thus, there was no interference, and each could receive their respective patents. *See id.* at 405, 407.

71. *See* U.S. Patent No. 4,453 (issued Apr. 11, 1846).

marks *without an electro-magnet*, Morse stated bluntly in Reissue Patent 118 that “I do not, therefore, claim to be the inventor of telegraphs generally.”⁷² He further stated: “I do not, therefore, claim to have first applied electricity to telegraphing for the purpose of showing evanescent signs or signals.”⁷³ This contradicts the central allegation in *Morse*—that Morse was aggrandizing to himself in Claim Eight *all* electrical telecommunications that produce written marks.⁷⁴ As with all of Morse’s other patents, Reissue Patent 118 was placed into the court’s records by Morse and thus was before Chief Justice Taney and the other Justices on the Supreme Court.⁷⁵

III. A CLAIMED PRINCIPLE IN ANTEBELLUM PATENT LITIGATION AND IN *MORSE*

A. *Infringement of a Principle in Antebellum Era Patent Cases*

Given principle claiming in early nineteenth-century patent law, patent owners like Morse did not assert that defendants violated a specific claim in their patents. Morse’s complaint against O’Reilly, filed in the Circuit Court of the District of Kentucky on August 14, 1848, does not identify a single patent claim violated by O’Reilly.⁷⁶ Instead, Morse followed legal practices at the time in alleging that O’Reilly and his co-defendants “use and employ instruments, apparatus, and means, which are in the material, substantial, and essential parts thereof, like to and upon *the principle* and plan of the said several improvements so patented by your orator, Morse All of which is in violation of the said several letters patent”⁷⁷

The nature and function of principle claims meant that all patent infringement cases in the early nineteenth century represented what patent lawyers today call *equivalents infringement*, which is distinct from the core case of patent infringement known today as *literal infringement*.⁷⁸ Today, equivalents infringement is derivative or secondary to literal infringement, but, in the Antebellum Era, there was no literal infringement. Professors John Duffy and Robert Merges point out that the “exception to the modern rule [of literal infringement]—

72. U.S. Reissue Patent No. 118, Case Record at 81, *Morse*, 56 U.S. 62 (No. 224).

73. *Id.*

74. *See supra* note 29–30 and accompanying text.

75. *See* Case Record at 80, *Morse*, 56 U.S. 62 (No. 224).

76. Bill of Complaint, Case Record at 2–20, *Morse*, 56 U.S. 62 (No. 224).

77. Bill of Complaint, Case Record at 11, *Morse*, 56 U.S. 62 (No. 224) (emphasis added).

78. *See* Mueller, *supra* note 39, at 615.

the doctrine of equivalents—is older than the rule itself.⁷⁹ The reason is straightforward: principle claiming, not peripheral claiming, was how early inventors described their invention in their patent. If Morse’s patent claims identified only the principle of his invention, then there were no peripheral claims defining the metes and bounds of his property right for O’Reilly to literally trespass.⁸⁰ This is why historical and legal context matters in both assessing and using historical patent decisions like *Morse*.

With principle claims, a patent owner accused a defendant of infringing the “substance of this invention” by making, using, or selling a product or service representing the “principle” secured by the patent.⁸¹ In patent infringement cases, courts considered whether the defendant violated the “substance” of the invention, looking past nonessential mechanical differences or other differences in form from the invention described and claimed in the patent.⁸² Moreover, courts did not limit patent owners to the specific mechanical elements and other modes of operation detailed in their specification or claims, as these were intended to be merely illustrative of the principle of the invention itself.⁸³

79. MERGES & DUFFY, *supra* note 6, at 811.

80. *See supra* notes 36–37 and accompanying text.

81. *See, e.g.*, *Foster v. Moore*, 9 F. Cas. 563, 567–68 (C.C.D. Mass. 1852) (No. 4,978) (Curtis, Circuit Justice) (stating that the “substance of this invention” secured to the patentee is not restricted to “the identical devices he employed, but by all other known substitutes,” but that the witnesses in this case failed to explain the “principle” that is either shared or contrasted between the patent and the allegedly infringing device); *Roberts v. Ward*, 20 F. Cas. 936, 936 (C.C.D. Mich. 1849) (No. 11,918) (McLean, Circuit Justice) (“The word principle, as applied to mechanics, is where two machines or things are made to operate, substantially in the same way, so as to produce a similar result, they are considered the same in principle.”).

82. *See Barrett v. Hall*, 2 F. Cas. 914, 923 (C.C.D. Mass. 1818) (No. 1,047) (Story, Circuit Justice) (“Now, the principles of two machines may be the same, although the form or proportions may be different. They may substantially employ the same power in the same way, though the external mechanism be apparently different.”); *see also* NORMAN, *supra* note 46, at 108 (“One man has invented the principle and another has adopted it, and though he may have carried it into effect by substituting one mechanical equivalent for another, still the jury should look to the substance, and not the mere form; and if it is in substance an infringement, they ought to find it to be so. If its principle is not the same, but really different, then the defendants cannot be said to have infringed the patent.”).

83. *See Gray v. James*, 10 F. Cas. 1015, 1016 (C.C.D. Pa. 1817) (No. 5,718) (Washington, Circuit Justice) (“What constitutes a difference in principle between two machines, is frequently a question of difficulty, more especially if the difference in form is considerable, and the machinery complicated. But we think it may safely be laid down as a general rule, that where the

These basic points of how early nineteenth-century courts construed patent claims and then applied claims to a defendant's product or process were exemplified in 1839 in *Ryan v. Goodwin*.⁸⁴ In this case, Justice Story, riding circuit, affirmed the validity of a patent on friction matches against several challenges to its validity asserted by the defendant, including the challenge that “the claim is too broad to support the patent” given that “the inventor has not confined his claim to the use of [a specific] chalk, but has extended it to the use of any other absorbent earths or earthy materials, which is too general.”⁸⁵ In rejecting this argument, Circuit Justice Story recognized that, first, the entire specification, including both the written description and the claims, are to be read together as an integrated legal document.⁸⁶ He then stated as a matter of well-established law that “it is observable, that the patent act of 1793 (chapter 55) does not limit the inventor to one single mode, or one single set of ingredients, to carry into effect his invention.”⁸⁷ Circuit Justice Story, one of the preeminent jurists in U.S. patent law, noted that the patent statutes expressly required only that “the inventor shall fully explain the principle, and the several modes, in which he has contemplated the application of that principle or character, by which it may be distinguished from other inventions.”⁸⁸

machines are substantially the same, and operate in the same manner, to produce the same result, they must be in principle the same.”).

84. 21 F. Cas. 110 (C.C.D. Mass. 1839) (No. 12,186) (Story, Circuit Justice).
85. *Id.* at 111–12.
86. *Id.* at 112.
87. *Id.* The *Ryan* opinion might appear to give support to Chief Justice Taney's interpretation of Claim Eight when Circuit Justice Story says that an inventor “may claim as many modes, as he pleases, provided always, that the claim is limited to such as he has invented, and as are substantially new.” *Id.* Given that Morse includes an expansive, introductory clause in Claim Eight, “I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims,” *supra* note 19, he is not limiting his claim to his new invention. But Circuit Justice Story begins his legal analysis in *Ryan* by stating the established legal rule that if there is “any ambiguity or uncertainty in any part of the specification,” this is not fatal under the law “if taking the whole together, the court can perceive the exact nature and extent of the claim made by the inventor, it is bound to adopt that interpretation, and to give it full effect.” *Ryan*, 21 F. Cas. at 112. Given the ambiguity in the opening clause of Claim Eight concerning what it covered, this required Chief Justice Taney to look to Morse's written description, in which Morse expressly disclaims the interpretation adopted by Chief Justice Taney. *See supra* notes 61–62 and accompanying text.
88. *Ryan*, 21 F. Cas. at 112; *see also id.* at 113 (“I do not know, that it has ever been decided, that, if the claim of an inventor for an invention of a compound states the ingredients truly, which the inventor uses to produce the intended effect, the suggestion, that other ingredients of a kindred

In sum, an inventor claimed the principle of an invention, and thus by logical necessity he asserted in a lawsuit only that a defendant infringed this principle.

B. Morse Sought to Secure the Principle of His Invention in His Lawsuit Against O’Reilly

Morse’s complaint in *Morse v. O’Reilly* followed these established legal doctrines in Antebellum Era patent law by asserting that O’Reilly infringed “the principle” of his patent.⁸⁹ This is unsurprising as a matter of law. It is also unsurprising simply as a practical matter, because O’Reilly defended himself by arguing that the electro-magnetic telegraph he used was substantially different from Morse’s patented electro-magnetic telegraph.

O’Reilly knew very well Morse’s patented electro-magnetic telegraph because he was originally a licensee of the Magnetic Telegraph Company, the company formed in 1845 on the basis of Morse’s patents to commercially develop telegraph networks in the U.S.⁹⁰ The business model of the Magnetic Telegraph Company was an early version of a franchise business model in which the company licensed territories in telegraph networks.⁹¹ O’Reilly received a territorial license to build and operate a telegraph line between Philadelphia and St. Louis.⁹² After

nature may be substituted for some part of them, has been held to avoid the patent in toto, so as to make it bad, for what is specifically stated.”).

89. See *supra* notes 76–77 and accompanying text (quoting Morse’s complaint).
90. Morse designated Amos Kendall as his patent agent to commercialize his electro-magnetic telegraph. See SILVERMAN, *supra* note 3, at 261. Kendall formed the Magnetic Telegraph Company, and he would later write to Morse that he had committed his “earthly all . . . in this enterprize, [sic] for which I have resigned all other business.” *Id.* at 261. An 1854 newspaper article recounted their relationship with more flourish: “Ten years ago Professor Morse was just erecting the first experimental line of Telegraphs Professor Morse, like all scientific benefactors, had exhausted his means, and had become as poor as Lazarus, and as lean and hungry-looking as any veritable Calvin Edson you ever saw. One day . . . Amos Kendall approached him . . . , [and] he gave the dilapidated Postmaster General an interest in his Telegraph patent, which has since made these two shadows of a shade corpulent with wealth.” *Never Despair*, LOUDON FREE PRESS, May 16, 1854, at 1.
91. See WILSON, *supra* note 53, at 10 (“Morse and his partners exploited the patent through the operations of the Magnetic Telegraph Company, but they also licensed the patent for use by other local telegraph companies in other regions of the country.”).
92. See *Contract Between Morse & O’Reilly*, Case Record at 90, 156–58, *O’Reilly v. Morse*, 56 U.S. (15 How.) 62 (1854) (No. 224). O’Reilly was also authorized to run a telegraph line from this primary telegraph line to “to the principal towns on the [Great] [L]akes,” and he was expressly prohibited from building or operating telegraph lines anywhere else. *Id.* at 156–58.

becoming embroiled in some bitter commercial and legal disputes with Morse’s business partners who were running the Magnetic Telegraph Company,⁹³ O’Reilly began constructing what he called “The People’s Line” between Louisville, Kentucky, and New Orleans, Louisiana, which was outside the scope of his license.⁹⁴ O’Reilly sought to evade legal liability by using an allegedly new telegraph, which he called the Columbia Telegraph.⁹⁵ Thus, O’Reilly, like most defendants in patent infringement lawsuits, argued that that he was not liable for infringing Morse’s patent given essential differences between the Columbia Telegraph and the telegraph described and claimed in Morse’s patents.

Numerous witnesses submitted affidavits or interrogatory responses on behalf of O’Reilly in which they ballyhooed two mechanical differences between the Columbia Telegraph used on The People’s Line and the electro-magnetic telegraph described and claimed in Morse’s patent.⁹⁶ The Columbian Telegraph used two electro-magnets and two batteries, as opposed to the single electro-magnet and a single battery set forth in Morse’s patent.⁹⁷ As one witness asserted, the “mode of application of electro-magnetism in the two instruments is essentially distinct.”⁹⁸

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93. The battle with O’Reilly began when Francis O.J. Smith, an assignee in 25% of Morse’s patent, and Amos Kendall, the patent agent and lawyer representing Morse’s commercial interests, began a commercial dispute with O’Reilly in 1846, which culminated in the filing of the first lawsuit against O’Reilly. *See Morse v. O’Reilly*, 17 F. Cas. 867, 867–68 (C.C.E.D. Pa. 1847) (No. 9,853). It was captioned with Morse’s name only because it was a purported patent infringement lawsuit, even though it was really a lawsuit brought by Smith and Kendall.
94. *See* Deposition of Thomas C. McAfee, Case Record at 311, *Morse*, 56 U.S. 62 (No. 224) (“In the early part of the year 1848, the deft., H. O’Rielly [sic], constructed a line of telegraph from Louisville, Kentucky, to Nashville, Tennessee This line of telegraph was called the ‘People’s Line.’”); Affidavit of Richard H. Woolfolk, Case Record at 475, *Morse*, 56 U.S. 62 (No. 224) (“I state that communication was opened on the ‘People’s line’ of telegraph from Louisville to Glasgow on Tuesday, February 22d, 1848.”).
95. This telegraph was made by Edmund F. Barnes and Samuel K. Zook. *See* Deposition of Samuel K. Zook, Case Record at 378, *Morse*, 56 U.S. 62 (No. 224) (“It is proper to say that this ‘Columbian Telegraph’ is the joint invention and the joint property of myself and said Barnes, and is called the instrument of Barnes & Zook.”). Both Barnes and Zook were employed by O’Reilly as telegraphers on The People’s Line. *See* Deposition of Edmund F. Barnes, Case Record at 366–67, *Morse*, 56 U.S. 62 (No. 224); Deposition of Samuel K. Zook, Case Record at 375, *Morse*, 56 U.S. 62 (No. 224).
96. *See* Case Record at 94–482, *Morse*, 56 U.S. 62 (No. 224).
97. *See, e.g.*, Deposition of Samuel K. Zook, Case Record at 376–77, *Morse*, 56 U.S. 62 (No. 224).
98. Deposition of Charles T. Smith, Case Record at 383–84, *Morse*, 56 U.S. 62 (No. 224); *see, e.g.*, Deposition of Samuel K. Zook, Case Record at 375–76, *Morse*, 56 U.S. 62 (No. 224); *see also* Deposition of John C. Cresson, Case

Morse’s own bevy of expert witnesses followed the legal doctrine of the time in emphasizing that Morse’s patented electro-magnetic telegraph and the Columbia Telegraph were essentially the same device in principle. They explained that the Columbia Telegraph “is a direct infringement of the essence of Morse’s patent and invention, as defined in his specification aforesaid, being the same application of the same power to the same end. The same form is used, the same result is produced, the same general process employed.”⁹⁹ The experts uniformly reported that “[t]here are formal differences between the instruments, but no essential difference or difference in principle.”¹⁰⁰ The deposition transcripts in *Morse* represent hundreds of pages (typed from the handwritten documents of the 1840s), and they consistently state and restate the legal rule that, if O’Reilly and his co-defendants were liable for patent infringement, it was because the Columbia Telegraph

Record at 391, *Morse*, 56 U.S. 62 (No. 224) (“I should consider the Columbian Telegraph a distinct instrument from that of Mr. Morse.”); Deposition of George W. Benedict, Case Record at 404, *Morse*, 56 U.S. 62 (No. 224) (“To my mind the two parts of the Columbian telegraph apparatus, namely, the register and the mutator, . . . and the combination of the register and mutator makes, as a whole, in my mind, a very different machine from the combination seen in the united action of Morse’s register and Morse’s receiving magnet.”); Affidavit of Anson Stager, Case Record at 472, *Morse*, 56 U.S. 62 (No. 224) (“[T]he form or structure, as well as the principle or mode of operation, of the said instruments or machines, are substantially and mainly different.”).

99. Deposition of James F. Foss, Case Record at 240, *Morse*, 56 U.S. 62 (No. 224). Patent lawyers will immediately recognize that this language comports exactly with the “triple identity” test (function-way-result) of the doctrine of equivalents. See *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 520 U.S. 17, 39–40 (1995).
100. Deposition of Jacob Walter, Case Record at 306, *Morse*, 56 U.S. 62 (No. 224); see also Deposition of Charles T. Chester, Case Record at 245, *Morse*, 56 U.S. 62 (No. 224) (stating that there is only “a slight difference in the mechanical structure” and that the “essential principles of the two produc[e] the same result”); Deposition of John Torry, Case Record at 289, *Morse*, 56 U.S. 62 (No. 224) (“It will at once be *perceptible* [sic], from the descriptions and drawings of the two instruments, that there is a difference in the arrangement and mechanical structure of Barnes and Zook’s instrument [the Columbia Telegraph]. It however produces the same result as the instrument of Morse, and by the same means, to wit, that of electro-magnetism.”); Deposition of Edward N. Kent, Case Record at 322, *Morse*, 56 U.S. 62 (No. 224) (“[T]he essential principles in Barnes and Zook’s instrument are precisely the same as in Morse’s, and that both produce the same results and upon the same principles; and the essential principles of Morse’s instrument, as patented, is involved in that of Barnes and Zook.”).

represented “the principle” of the invention described and claimed in Morse’s patent.¹⁰¹

Ultimately, Judge Monroe concluded that Morse’s patent was valid and he found O’Reilly and his associates to be liable for patent infringement. He issued a court order converting the preliminary injunction he had already issued several months earlier into a permanent injunction prohibiting any use of the Columbia Telegraph.¹⁰² Judge Monroe’s decision confirms the accepted legal practice among lawyers and judges in the Antebellum Era in construing and in applying the principle of an invention set forth in the entire specification of a patent—the written description and all the claims. Chief Justice Taney’s singular focus on Claim Eight in isolation from everything else in Morse’s patent was largely an unknown practice to inventors and lawyers in drafting patents, to lawyers in enforcing patents, and to judges in interpreting and applying patents.

101. The lengthy sixty-question interrogatories submitted by Morse’s attorneys asked such questions as whether “the essential principles of the instrument of [defendants] are the same as those of Morse’s instrument” (Question 26) and whether “the two instruments produce the same or different results upon the same or different principles” (Question 27). Case Record at 171, *Morse*, 56 U.S. 62 (No. 224). Similarly, O’Reilly defended himself with witnesses who testified as to how his infringing telegraph was “essentially different” from that of Morse’s telegraph. Deposition of Edmund F. Barnes, Case Record at 365, *Morse*, 56 U.S. 62 (No. 224); Deposition of Samuel K. Zook, Case Record at 375–76, *Morse*, 56 U.S. 62 (No. 224) (“I believe myself to be perfectly familiar with the operations of each [telegraph], and the principles governing them, and from I know of the two, I believe them to differ essentially.”).

In response, the witnesses’ testimony consistently reflected this norm of patent law in the Antebellum Era. *See* Deposition of Andrew Prosch, Case Record at 223, *Morse*, 56 U.S. 62 (No. 224) (stating that the Columbia Telegraph works “for the same purpose, producing the same effect” as Morse’s telegraph); Deposition of James F. Foss, Case Record at 238, *Morse*, 56 U.S. 62 (No. 224) (“I unhesitatingly express the opinion that the essential principles involved in the instrument of Barnes & Zook are the same as in those of Professor Morse. . . . They produce the same results upon the same principles, and not different.”); *Id.*, Case Record at 240 (“The same form is used, the same result is produced, the same general process employed.”); Deposition of Charles Chester, Case Record at 245, *Morse*, 56 U.S. 62 (No. 224) (“There is no difference in the nature of Barnes & Zook’s instruments from those of Morse. The essential principles of the two producing the same result, altho[ugh] there is a slight difference in the mechanical structure, but none which changes the nature and principles of Morse’s instruments.” (alteration in original)).

102. Decree, Case Record at 42, *Morse*, 56 U.S. 62 (No. 224).

C. *The Motivation and Meaning of Claim Eight in Morse’s Reissue Patent 117*

One might still maintain that the practice of principle claiming in patents and in patent litigation in the Antebellum Era is irrelevant to Claim Eight and its invalidation by Chief Justice Taney for one simple reason: Morse explicitly stated in Claim Eight that it stands alone. Morse wrote in the opening clause of Claim Eight: “I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims”¹⁰³ Regardless of whether one is a textualist or a purposivist in legal interpretation, this text is clear and unambiguous on its face. Or is it? Once again, the similarities in legal language from a bygone historical era can obscure significant differences in legal practices.

As noted earlier in describing how Morse followed principle claiming practices in his patents,¹⁰⁴ Reissue Patent 117 had eight claims. The claims are bookended by two generalized descriptions of the essence of his invention (Claims One and Eight) with the specific mechanical components and processes used in his electro-magnetic telegraph covered by the middle claims (Claims Two through Seven). Claim One is thus a broadly framed and generalized description of the essence of Morse’s his invention, but Claim One does not contain the fateful clause that introduces Claim Eight.

The lengthy and generalized descriptions in both Claim One and Claim Eight were not in the original Patent 1,647 that issued to Morse in 1840. Of course, the information was in his original patent: it was in the specification, not in the claims.¹⁰⁵ Inventors were prohibited from

103. U.S. Reissue Patent No. 117 (issued June 13, 1848).

104. *See supra* notes 54–75, and accompanying text.

105. The first paragraph of his original patent that issued in 1840 stated:

Be it known that I, the undersigned, Samuel F.B. Morse, of the city, county and State of New York, have invented a new and useful machine and system of signs for transmitting intelligence between distant points by the means of a new application and effect of electro-magnetism, in producing sounds and signs, or either, and also for recording permanently by the same means, and application, and effect of electro-magnetism any signs thus produced and representing intelligence, transmitted as before named between distant points A, and I denominated the said invention the American Electro-Magnetic Telegraph, of which the following is a full and exact description to wit.

Patent No. 1,647, *reprinted in* Schedule, Case Record at 53, *Morse*, 56 U.S. 62 (No. 224). Such language is the portent of Claim Eight, which Morse added to his Reissue Patent 117 in 1848. Similarly, Claim Seven in his original 1840 patent stated: “The mode and process of recording or marking permanently signs of intelligence transmitted between distant points, and simultaneously to different points, by the application and use of electro-

expanding the scope of their patents through the reissue process, which was solely for the purpose of correcting formal or stylistic defects that accidentally undermined the protection of the principle of the invention secured by a patent.¹⁰⁶

Why did Morse take language from the specification and convert it into a claim in Reissue Patent 117? We do not have a direct answer, at least none yet found in the extant historical record that we have reviewed thus far, such as the case record and some of Morse’s papers. We still can draw a reasonable inference from what we do know about the “Telegraphic War of the West”—Morse’s extensive litigation with O’Reilly, the wide-ranging fights in the court of public opinion, and the widespread litigation imposed on him by others with legal interests in his patents.¹⁰⁷

As Morse struggled over the years with O’Reilly’s and his supporters’ public attacks on him as a monopolist,¹⁰⁸ with the proliferating lawsuits throughout the country,¹⁰⁹ and with the expense and lost time of these lawsuits,¹¹⁰ he evidently believed that his original patent and his first reissue patent did not sufficiently protect the principle of his invention. O’Reilly even filed a protest with Congress demanding impeachment of Judge Monroe, charging the judge with

magnetism or galvanism, as described in the foregoing specification.” *Morse*, 56 U.S. at 78 (reprinting the content of the original patent).

106. See *Cahart v. Austin*, 4 F. Cas. 997, 1000 (C.C.D.N.H. 1865) (No. 2,288) (Clifford, Circuit Justice) (stating that the reissue right “was intended to remedy that evil” in which patents “had frequently been adjudged invalid . . . from the insufficiency of the specification,” and thus it was not for the purpose “that the patent may be rendered more elastic or expansive”); Mossoff, *supra* note 57, at 1001–02 (describing the rise of the reissue right by administrative fiat at the Patent Office, its validation by the Supreme Court in 1832, and the limits imposed on it).

107. See *supra* note 15 and accompanying text.

108. In one of his many public pamphlets, O’Reilly attacked Morse and his business associates for creating a “monopoly” that stood in the way of “*Equal Rights to all modes of Telegraphing.*” See SILVERMAN, *supra* note 3, at 285–86 (quoting *The Wired Party’s Song*). O’Reilly announced in this pamphlet: “We take the *strongest Anti-monopoly ground.*” *Id.* at 285. One newspaper in Kentucky accused Morse’s patent agent and lawyer, Amos Kendall, of being a “venomous reptile,” a “demented old man,” and one of “the blood-sucking calves that are hanging on the teats of Morse’s monopoly.” *Id.* at 291–92.

109. See *infra* notes 119–138 and accompanying text.

110. Morse would complain in a letter to his brother that “pirates” like O’Reilly and the lawsuits generally have meant that “all my time has been occupied in defense, in putting evidence into something like legal shape that I am the inventor of the Electro-Magnetic Telegraph!!” Letter from Samuel F.B. Morse to Sidney Morse (Apr. 19, 1848), in MORSE, *supra* note 50, at 283.

improprieties in his handling of the case.¹¹¹ O’Reilly further attempted to evade liability by moving the facilities for The People’s Line to a different judicial circuit—from Kentucky to Ohio—given that the injunction issued against him by Judge Monroe was in a federal court in Kentucky.¹¹² This precipitated more litigation for contempt proceedings.¹¹³ Throughout, Morse was repeatedly attacked in court and in the press as not being the first inventor of his electro-magnetic telegraph, at best, or having stolen the idea, at worst.¹¹⁴

As a result of the constant public attacks and the growing expense and inconvenience of dealing with O’Reilly’s strategic behavior, Morse sometimes overreacted and spoke more broadly about his contribution to electro-magnetic telegraphy. Thus, for example, he wrote in a letter in 1851: “*Telegraphic Speech by Electricity, as the principle of my whole invention.*”¹¹⁵ Statements like this in letters contradicted his express disclaimers in his patents, as well as were unsupported by the legal rules governing principle claiming, but these sentiments would prove grist for the mill leading up to Chief Justice Taney’s decision.

If read in isolation from the written description and other claims, one could think that Morse went too far with his language in Claim Eight, as exactly as Chief Justice Taney asserts in *Morse*. But principle claiming was well understood by inventors, lawyers, and judges at the time, and claims were not read in isolation from each other. Peripheral claiming had not yet developed; thus, claims were not construed and applied in isolation from other claims or from the specification. In the Antebellum Era, no lawyer drafted a patent claim in isolation from the written description. No judge construed patent claims in isolation from the written description.

This point is confirmed by the adjudication of Claim Eight as *valid* in many other infringement cases brought by Francis O.J. Smith,

111. CARL B. SWISHER, *THE TANEY PERIOD, 1836–64*, at 491–92 (1974).

112. *See* Contempt Order, Case Record at 514, *O’Reilly v. Morse*, 56 U.S. (15 How.) 62 (1854) (No. 224) for records of the contempt proceedings.

113. *See id.* at 513–14.

114. In his Amended Answer, O’Reilly added the claim that Morse stole his invention from Dr. Charles T. Jackson. *See* Amended Answer, Case Record at 35, *Morse*, 56 U.S. 62 (No. 224); Deposition of Charles T. Jackson, Case Record at 397–98, *Morse*, 56 U.S. 62 (No. 224); *see also* *Smith v. Clark*, 22 F. Cas. 487, 487 (C.C.D. Mass. 1850) (No. 13,027) (repeating argument that Morse got his invention from Dr. Jackson); SILVERMAN, *supra* note 3, at 315 (stating that in *Smith v. Downing*, 22 F. Cas. 511 (C.C.D. Mass. 1850) (No. 13,036), “Downing meant to fight back by contesting the validity of the patent, using the well-worn testimony of Dr. Charles Jackson” that Morse stole the invention from him).

115. Letter from Samuel F.B. Morse to George Gifford (Jan. 1, 1851), in SILVERMAN, *supra* note 3, at 312.

someone to whom Morse had assigned a 25% interest in his patent in 1838.¹¹⁶ Smith was notoriously obstreperous.¹¹⁷ Unlike Morse, who sued only O'Reilly and was later drawn into other legal contests without his prompting,¹¹⁸ Smith was very litigious.¹¹⁹ Smith eventually ended up in litigation with Morse,¹²⁰ and he remained true to his rancorous nature by attacking the validity of Morse's patent,¹²¹ going so far as to join forces with O'Reilly for a brief moment.¹²² Smith's reputation for being rash was well deserved. If he had been successful in attacking Morse's patent, his legal arguments were entirely self-defeating: If Smith invalidated Morse's patent, then he invalidated his own 25% interest in the patent as well.

Unlike Morse, Smith was willing to sue owners and operators of telegraphs that had been independently invented and were significantly different from Morse's electro-magnetic telegraph, such as an electro-magnetic telegraph patented in 1846 by Royal House.¹²³ O'Reilly himself bankrolled House and House ultimately conveyed his patent to O'Reilly, but it proved to be another impractical telegraph.¹²⁴ Thus, when Morse sued O'Reilly, he sued him for the Columbia Telegraph, and O'Reilly did not argue in his initial defenses that Morse's patent was too broad or covered an abstract idea.¹²⁵ But Smith was suing

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116. See Bill of Complaint, Case Record at 5, *Morse*, 56 U.S. 62 (No. 224).
117. See SILVERMAN, *supra* note 3, at 228 (stating that Smith was accused “of double-dealing and chicanery” and bestowed with the title of “Liar, Scoundrel, and Coward” even before he met Morse).
118. See *supra* note 70 and accompanying text (discussing the interference proceeding in *Morse v. Bain*).
119. A few of the patent infringement lawsuits he filed were *Smith v. Downing*, 22 F. Cas. 511 (C.C.D. Mass. 1850) (No. 13,036); *Smith v. Ely*, 22 F. Cas. 533 (C.C.D. Ohio 1849) (No. 13,043); *Smith v. Clark*, 22 F. Cas. 487 (C.C.D. Mass. 1850) (No. 13,027); and *Smith v. Seldon*, 22 F. Cas. 652 (C.C.N.D. N.Y. 1849) (No. 13,104).
120. *Smith v. Morse*, 76 U.S. (9 Wall.) 76 (1869).
121. See SILVERMAN, *supra* note 3, at 316–17. The House telegraph suffered from technical problems and was ultimately of no commercial value. See JOSHUA D. WOLFF, *WESTERN UNION AND THE CREATION OF THE AMERICAN CORPORATE ORDER, 1845–1893*, at 22 (2013).
122. See SILVERMAN, *supra* note 3, at 317.
123. See, e.g., *Clark*, 22 F. Cas. at 487 (“House's machine appears much unlike Morse's While Morse's is simple, that of House is so complicated as to require days of attention by mechanics to understand. . . . This is not the same system as Morse's . . .”).
124. See SILVERMAN, *supra* note 3, at 284.
125. See Answer, Case Record at 21–25, *O'Reilly v. Morse*, 56 U.S. (15 How.) 62 (1854) (No. 224) (asserting that Morse's patent was “null and void” on the basis of a slew of patentability requirements, including that he was

telegraph operators using disparate electro-magnetic telegraphs and defendants did start to raise this defense.

In one case, *Smith v. Ely*, the eighteenth answer by the defendant asserted that Morse’s patent in Claim Eight was too broad in claiming an abstract principle, which was not one of the categories of patentable inventions set forth in the patent statute.¹²⁶ Unfortunately, neither Smith nor the defendants submitted Morse’s patent into evidence by which the judge could read the claim and the written description. Thus, the judge was unable to assess the veracity of this argument by the defendants.¹²⁷

In *Smith v. Downing*, Smith sued another person using the House telegraph, and, as in *Ely*, the defendant alleged that Claim Eight of Morse’s patent was invalid for attempting to monopolize the abstract principle of telegraphy.¹²⁸ In considering this defense, Justice Levi Woodbury, riding circuit, reviewed the other claims in Morse’s patent, and quoted Morse’s explicit disclaimer that “I do not claim the use of the galvanic current, or current of electricity, for the purpose of telegraphic communications generally”¹²⁹ While acknowledging that Claim Eight by itself was a “broader claim [that] goes far beyond what we have already seen was . . . in the original patent,” he recognized that Morse does “disavow it” in the patent and thus he concluded that “I do not think it just to place a broader construction on his language than the whole subject matter, and description”¹³⁰

not the inventor of the telegraph, it was not a novel invention, and the specification did not properly describe the invention, among many others, but never asserting that any claim was too broad or covered an abstract idea).

126. See *Smith v. Ely*, 22 F. Cas. 533, 538 (C.C.D. Ohio 1849) (No. 13,044) (“And in the eighteenth plea after stating the above, the defendants aver that the thing so ‘patented and claimed, is not any art, machine, manufacture or composition of matter, or any improvement on any art, machine, manufacture or composition of matter,’ &c.”).

127. *Id.* (“The patent not being before us, as it would be, if offered in evidence, or copied into the declaration or plea, we cannot decide this question.”). The judge did not want to imply that he disagreed with defendant’s argument as such, which was a valid legal rule, stating that “[i]t may not, however, be improper to remark, that a [scientific] principle is not patentable. And ‘the motive power of the galvanic current, however developed to produce a given result,’ can no more be patented than the motive power of steam to propel boats, however applied.” *Id.*

128. See *Smith v. Downing*, 22 F. Cas. 511, 514 (C.C.D. Mass. 1850) (No. 13,036) (“As to the second objection, that [Claim Eight] would be seeking to cover, by a patent, a new principle, without reference to any mode or method of enforcing it, the patent laws are well settled never to permit it.”).

129. *Id.* at 513 (quoting U.S. Patent No. 117 (reissued June 13, 1848)).

130. *Id.* at 513.

While Circuit Justice Woodbury recognized that the “broader view” advanced by the defendant would likely make Claim Eight “void, both for claiming too much, and for claiming also the invention of a mere principle,” he rejected the defendant’s argument because “no fancied construction, traveling too far, on a new and doubtful ground, is to be adopted” in construing a patent.¹³¹

Later in his *Downing* opinion, Circuit Justice Woodbury surveyed the well-established legal distinction in Antebellum Era patent law between a patentable principle applied in a “useful art” and an unpatentable “abstract principle.”¹³² He reiterated his earlier conclusion that Morse’s claims, when read together with the specification, confirm that Morse properly patented the principle of his invention, and not an abstract principle.¹³³ *Downing* is notable because Circuit Justice Woodbury’s analysis of Claim Eight is exactly what one would expect a court to do given principle claiming rules and practices in early U.S. patent law. Unfortunately, Justice Woodbury died in 1851, the year before the Supreme Court held oral argument in O’Reilly’s appeal; *Morse* might have come out differently if Justice Woodbury had lived a few more years.¹³⁴

With judicial opinions issuing from separate, parallel lawsuits filed by Smith in other circuits, O’Reilly eventually adopted the argument he did not originally assert against Morse in the lawsuit filed in Kentucky—Morse was claiming an abstract principle in Claim Eight. After the district court’s decision in Morse’s favor and the award of the injunction in Kentucky, Morse and his business associates filed more lawsuits and sought injunctions in federal courts along the path of The People’s Line in Tennessee, Alabama, and Louisiana. Justice John McKinley, riding circuit, presided over these cases, and he similarly found O’Reilly liable for patent infringement and issued an injunction.¹³⁵ Yet, unlike in the Kentucky case, Circuit Justice McKinley now had to respond to O’Reilly’s new argument that Morse was attempting to patent an abstract principle.¹³⁶ He rejected this assertion, explain that Morse’s “patent is not for a principle. It is not for electricity or electro-magnetism, or their use for *all* purposes, or even *all telegraphic purposes*; but it is for the application of this power to a specific

131. *Id.*

132. *Id.* at 514.

133. *Id.* at 517–18.

134. See SWISHER, *supra* note 111, at 497 (discussing Justice Woodbury’s death the year before oral argument began in December 1852).

135. See Brown, *supra* note 15, at 216.

136. *Id.*

purpose.”¹³⁷ Circuit Justice McKinley pointed concluded that Morse’s “claims are not broader than his discovery and invention, and therefore his patent is valid.”¹³⁸ (In another turn of fate for Morse, Justice McKinley also died shortly before oral argument was held at the Supreme Court in 1852.¹³⁹) Morse’s patent, including Claim Eight, was thoroughly adjudicated and repeatedly affirmed as valid by Justices and judges following the rules and practices of principle claiming in the Antebellum Era.

Lastly, beyond the confines of the telegraph cases, other Supreme Court patent cases decided at the same time as *Morse* confirm that Morse’s language in Claim Eight was not unusual. In *Winans v. Denmead*,¹⁴⁰ decided the same year as *Morse*, the Supreme Court expressly recognized as legitimate the use of non-limiting language in claims. The *Winans* Court stated: “Patentees sometimes add to their claims an express declaration, to the effect that the claim extends to the thing patented, however its form or proportions may be varied. But this is unnecessary. The law so interprets the claim without the addition of these words.”¹⁴¹ Given the legal practice of principle claiming, it is a distinction without a difference for one patent to use the words that the “claim extends to the thing patented, however its form or properties may be varied” and for another patent to use the words “I do not propose to limit myself to the specific machinery or parts of machinery described in the foregoing specification and claims.” In the context of principle claiming, these sentences state the same proposition.

The doctrinal parallels between *Winans* and *Morse* are striking, especially given that *Winans* is another canonical case for the modern infringement doctrine of equivalents. In *Winans*, the inventor claimed as the “principle” of his invention a “conical” railway car for the “transportation of coal, and all other heavy articles in lumps.”¹⁴² The defendant built an octagonal railway car, but the Supreme Court held that it infringed the “principle” of the claimed invention of a conical railway car.¹⁴³ Justice Benjamin Curtis explained in his opinion for the Court that “the patentee, having described his invention, and shown its *principles*, and claimed it in that form which most perfectly em–

137. *Id.*

138. *Id.* For the remedy, Circuit Justice McKinley issued the injunction only for the jurisdiction in which he rode circuit, the Eighth Circuit. Thus, O’Reilly was enjoined only in Tennessee, and not in Alabama or Louisiana. *Id.*

139. *See Swisher, supra* note 111, at 498.

140. 56 U.S. (15 How.) 330 (1854).

141. *Id.* at 343.

142. *Id.* at 330–31 (quoting U.S. Patent No. 5,175 (issued June 26, 1847)).

143. *Id.* at 340.

bodies it, is, in contemplation of law, deemed to claim every form in which his invention may be copied, *unless he manifests an intention to disclaim some of those forms.*¹⁴⁴

In both *Morse* and *Winans*, the defendants’ infringing devices were different from the patented invention only in “form or proportions,”¹⁴⁵ and both were deemed to be essentially the same in principle. Morse even included an express disclaimer that he was not claiming to invent telegraphy by electricity as such, per the point made by Justice Curtis in *Winans* that patent owners can do this if they wish to impose a limit on the scope of their principle claim(s). The only difference between *Winans* and *Morse* is that Chief Justice Taney refused to acknowledge this express disclaimer in *Morse*, as other courts had already done, such as in *Downing*. The similarities between *Morse* and *Winans* were not lost on lawyers and judges at the time, as later cases expressly addressed the question of whether *Winans* overruled *Morse* (they ultimately held it did not).¹⁴⁶

In conclusion, the introductory clause of Claim Eight raised initial concerns for some judges in the many improper lawsuits filed by Smith. Given the overreach in Smith’s lawsuits, defendants understandably argued among many defenses that Claim Eight was overbroad. Yet, the judges in these cases and in Morse’s own cases all consistently recognized that Morse followed principle claiming practices and construed Claim Eight (with the fateful introductory clause) as valid when read within the context of his entire specification. Claim Eight properly described and secured the principle of Morse’s invention of an electro-magnetic telegraph. This is why courts consistently affirmed Claim Eight as valid—until Chief Justice Taney’s opinion in *Morse* construed Claim Eight in derogation of the legal practices and interpretative rules of principle claiming.

IV. JUDICIAL OPPORTUNISM IN *MORSE*, NOT INVENTOR OPPORTUNISM

The degree to which Chief Justice Taney’s opinion in *Morse* contradicted both the method of interpretation and substantive conclusions of many other courts concerning the validity of Claim Eight is striking. It is particularly surprising given Morse’s express disclaimers in his patents of the exact claim Chief Justice Taney accused him of

144. *Id.* at 343 (emphasis added).

145. *Id.*

146. See *Singer v. Walmsley*, 22 F. Cas. 207, 211 (C.C.D. Md. 1860) (“[T]he celebrated case of *Winans v. Denmead*, upon which great reliance has been placed by the learned counsel for the plaintiff . . . I do not understand it as overruling the doctrine in the case of *O’Reilly v. Morse*, but the court are declaring the rules by which you are to be guided on the question of infringement . . .” (citations omitted)).

making in Claim Eight—control over all electrical telegraphic communication at a distance. This suggests something else may have been motivating Chief Justice Taney. In contrast to other infamous decisions by Chief Justice Taney, there is no smoking gun that indicts his *Morse* opinion as animated by his policy preferences as opposed to the legal rules and practices of early U.S. patent law. There is, however, circumstantial evidence that raises a concern about opportunistic behavior by Chief Justice Taney in *Morse*. This calls into question the conventional wisdom today that *Morse* is a canonical case imposing a legitimate legal limit on strategic behavior by an inventor seeking to abuse the patent system in becoming a monopolist.

A. *Lack of Legal Support for Chief Justice Taney’s Opinion in Morse*

Chief Justice Taney’s opinion in *Morse* is not supported by Antebellum Era patent law. As noted earlier, the legal practice of principle claiming and the interpretation and application of principle claims in litigation contrasted sharply with what Chief Justice Taney did in *Morse*, especially in direct comparison to Circuit Justice Woodbury’s analysis of Claim Eight in *Downing*.¹⁴⁷ It is notable that none of these cases or the express disclaimers in Morse’s patents are found in Chief Justice Taney’s constricted analysis of Claim Eight. All of Morse’s patents and all of the immediate courts’ decisions were in the case record before the Supreme Court, and cases like *Downing* were printed in court reporters and equally well known. The absence of these highly relevant legal materials in *Morse*, all of which were being invoked in arguments by lawyers and judges alike in the Great Telegraph Case, is a significant omission.

Chief Justice Taney admittedly did cite some case law to support his argument about Claim Eight, but this precedent does not support him either. Significantly, he invoked an 1840 decision in *Wyeth v. Stone* by Justice Story, riding circuit,¹⁴⁸ stating that *Wyeth* was “directly on point.”¹⁴⁹ This was no small claim for legal support. Justice Story was recognized as a leading jurist in U.S. patent law given his preeminent role in shaping the early U.S. patent system through his numerous opinions in patent cases.¹⁵⁰

But *Wyeth* does not support Chief Justice Taney’s analysis of Claim Eight. In fact, it corroborates that Chief Justice Taney’s myopic focus on Claim Eight was an aberration in a time period when courts

147. See *supra* notes 128–134 and accompanying text.

148. 30 F. Cas. 723 (C.C.D. Mass. 1840) (No. 18,107) (Story, Circuit Justice).

149. O’Reilly v. Morse, 56 U.S. (15 How.) 62, 118 (1854).

150. See Adam Mossoff, *Statutes, Common Law Rights, and the Mistaken Classification of Patents as Public Rights*, 104 IOWA L. REV. 2591, 2611 (2019) (noting Justice Story’s preeminent role in creating U.S. patent law).

construed principle claims. Chief Justice Taney's reference to *Wyeth* is understandable because the result in this case was the same as in *Morse*: Justice Story held as “utterly void” one of two claims in a patent given his conclusion that it was too broad and encompassed an abstract principle.¹⁵¹ But Justice Story did not reach this conclusion by focusing only on the single disputed claim; rather, he analyzed *both claims* in the patent and he expressly addressed the inventor's additional language and examples in his specification.¹⁵² The outcome in *Wyeth* is similar to *Morse*, but the legal analysis is as different as night and day—it is the difference between peripheral claiming today and principle claiming in the Antebellum Era. If Justice Story had not passed away in 1845,¹⁵³ just as if Justice Woodbury and Justice McKinley had not passed away before oral argument in 1852, *Morse* might have been very different in both its analysis and result.

Winans, as discussed earlier, provides additional insights into Chief Justice Taney's views of how patents should be interpreted. As noted, *Winans* is significant, because it was decided the same year as *Morse*. *Winans* more than *Morse* reflected the legal practices of principle claiming by inventors who used “I'm not limited” language in their claims, just as *Morse* did in Claim Eight.¹⁵⁴

Winans provides an insight into what Chief Justice Taney thought of *Morse*'s lawsuit against O'Reilly: he likely believed that *Morse* should have lost his lawsuit against O'Reilly. In *Winans*, Chief Justice Taney joined Justice John Campbell's dissent.¹⁵⁵ In his dissent, Justice Campbell decried the problem of unbounded claim scope: “The claim of to-day is, that an octagonal car is an infringement of this patent [on a conical car]. Will this be the limit to that claim? . . . *What restraints does this patent impose in this branch of mechanic art?*”¹⁵⁶ This is the exact same concern expressed by Chief Justice Taney in *Morse* about “the extent of this claim” and that its lack of limits “shuts the door against inventions of other persons.”¹⁵⁷

Since Chief Justice Taney joined Justice Campbell's dissent in *Winans*, this suggests that he believed that *Morse* should have failed in his patent infringement lawsuit against O'Reilly. Just as in *Winans*,

151. *Wyeth*, 30 F. Cas. at 727.

152. *Id.* at 727–28.

153. See Craig Joyce, *Statesman of the Old Republic*, 84 MICH. L. REV. 846, 859 (1986) (noting that “[Justice Story] died . . . on September 10, 1845.”).

154. See *supra* notes 140–145 and accompanying text.

155. See *Winans v. Denmead*, 56 U.S. (15 How.) 330, 344–48 (1854) (Campbell, J., dissenting).

156. *Id.* at 347 (emphasis added).

157. *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 112–13 (1854).

Morse sued O’Reilly for making and using a similar, but not identical, electro-magnetic telegraph that infringed the principle of the invention described and claimed in Morse’s patent.¹⁵⁸ The lower courts found O’Reilly liable for making and using a substantially similar electro-magnetic telegraph.¹⁵⁹

If the equivalents-style argument for infringement of principle claims was the same in both *Winans* and *Morse*, why then did Chief Justice Taney strike down only Claim Eight, affirm the validity of Morse’s other seven patent claims, and affirm the liability of O’Reilly for patent infringement? Perhaps Chief Justice Taney could not keep a majority in making a broader argument that O’Reilly was not liable, as evidenced by the fact that he and Justice Campbell were in dissent in *Winans* that same year. This may explain the conclusory, single-sentence statement by Chief Justice Taney that the first seven claims in Morse’s patent are valid and infringed.¹⁶⁰ Why Chief Justice Taney still advanced the argument in *Morse* that Claim Eight represented “a monopoly in its use, however developed, for the purpose of printing at a distance” is the subject of the next section.¹⁶¹

*B. Chief Justice Taney’s Reputation for Policy-Driven
Judicial Decision-Making*

Chief Justice Taney has a well-established reputation for giving priority to his personal policy preferences as a Jacksonian Democrat over his judicial duty in construing and applying the law. The monopoly charges, as well as the public and legal attacks on Morse’s patent as retarding progress in telegraphy, might have found a willing ear in a committed Jacksonian Democrat like Chief Justice Taney.¹⁶² O’Reilly was not exactly subtle in adopting “The People’s Line” tradename in a time when the U.S. was still in the throes of the populism of Jacksonian Democracy.¹⁶³ A key political principle of Jacksonian Democracy was a deep-seated antipathy toward state-granted franchises and monopolies. For example, Chief Justice Taney’s famous decision in *Charles River Bridge v. Warren Bridge*¹⁶⁴ is widely regarded as “reflect[ing] the

158. *Id.* at 65; *see supra* notes 95–101 and accompanying text.

159. *Morse*, 56 U.S. at 63.

160. *See Morse*, 56 U.S. (15 How.) at 112 (“We perceive no well-founded objection . . . to his right to a patent for the first seven inventions set forth in the specification of his claims.”).

161. *Id.* at 113.

162. *See supra* note 108 (describing the attacks on Morse as a monopolist).

163. *See supra* note 94 and accompanying text.

164. 36 U.S. (11 Pet.) 420 (1837).

prevailing anti-monopoly sentiment that was one of the hallmarks of the Jacksonian period.”¹⁶⁵

Prominent proponents of Jacksonian Democracy condemned patents as unjust monopolies. William Leggett, a famous Jacksonian Democrat who was a newspaper editor and commentator, wrote widely read essays in which he vociferously “den[ied] that the author and inventor have any property in the fruits of their intellectual labor.”¹⁶⁶ In critiquing copyright law, Leggett argued that “the general welfare would be advanced by abolishing the principle of exclusive property in written compositions.”¹⁶⁷ He believed this criticism applied with equal force to patents.¹⁶⁸

To be fair, Leggett represented one strand of Jacksonian political ideology, and Chief Justice Taney was not an intellectual property abolitionist. In mundane patent cases in which core Jacksonian Democratic principles were not implicated, such as its fundamental commitment to economic populism, Chief Justice Taney applied the patent statutes and case law.¹⁶⁹ At least, he did so before *The Great Telegraph Case* came to the Taney Court in 1852 by an appeal from the owner of *The People’s Line* explicitly arguing that he was the victim of a rapacious monopolist.

Beyond the limits of patent law, of course, Chief Justice Taney has a well-deserved reputation for his “fervent” commitment to his political and policy preferences as a Jacksonian Democrat.¹⁷⁰ One prominent example was his actions as Attorney General in 1833 in violating federal law to implement President Jackson’s order to “kill” the U.S. Bank and

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165. Deborah A. Ballam, *The Evolution of the Government-Business Relationship in the United States: Colonial Times to Present*, 31 AM. BUS. L.J. 553, 592 (1994).
166. William Leggett, *The Rights of Authors*, PLAINDEALER, Feb. 11, 1837, reprinted in DEMOCRATICK EDITORIALS: ESSAYS IN JACKSONIAN POLITICAL ECONOMY BY WILLIAM LEGGETT 396, 403 (Lawrence H. White ed., 1984).
167. William Leggett, *Rights of Property in the Fruits of Intellectual Labor*, PLAINDEALER, Feb. 25, 1837, reprinted in DEMOCRATICK EDITORIALS, *supra* note 166, at 405.
168. See Leggett, *supra* note 166, at 401 (“The law of patents rests confessedly on the same principle as the law of copyright.”).
169. See, e.g., *Gayler v. Wilder*, 51 U.S. (10 How.) 477, 493 (1850) (applying the legal rule in patent law that “the discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use, which he may perfect and make absolute by proceeding in the manner which the law requires”).
170. See THE OXFORD COMPANION TO AMERICAN LAW 783 (Kermit L. Hall et al. eds., 2002) (discussing Taney’s “fervent” commitment to Jacksonian political principles).

transfer federal funds to state banks.¹⁷¹ Attorney General Taney and then-Postmaster General Amos Kendall—ironically, Morse’s patent agent, business partner, lawyer, and co-plaintiff in *The Great Telegraph Case*¹⁷²—were the only two cabinet officers who agreed to implement President Jackson’s illegal order to divest the U.S. Bank of funds and transfer the federal monies to state banks.¹⁷³

Three years later, President Jackson appointed Taney to the Supreme Court to fill Chief Justice Marshall’s seat.¹⁷⁴ Taney and other Justices appointed by President Jackson were more openly and “unabashedly political” than their preceding brethren.¹⁷⁵ Chief Justice Taney is notorious precisely for his policy-driven decision in *Dred Scott v. Sandford*.¹⁷⁶ *Dred Scott* is universally condemned as a case of “bad judicial politics.”¹⁷⁷

Chief Justice Taney demonstrated a willingness to enforce as law the anti-monopoly and populist principles of Jacksonian Democracy, not just its infamous racism.¹⁷⁸ Justice Story dissented in *Charles River Bridge*, detailing at length how Chief Justice Taney’s majority opinion

171. See HOWE, *supra* note 2, at 379–83, 441–42 (detailing President Jackson’s “attack on the Bank of the United States” and Taney’s explicit violation of federal law). These state banks were known as “pet banks” given their corruption and cronyism, and Taney was also a lawyer and stockholder of one particularly notorious pet bank. *Id.* at 388, 393.

172. See *supra* note 90 (discussing the relationship between Morse and Kendall).

173. HOWE, *supra* note 2, at 387. For this illegal act, effected and rationalized by Taney and Kendall, President Jackson was officially censured by the Senate for having “assumed upon himself authority and power not conferred by the Constitution and laws.” *Id.* at 389 (quoting the censure resolution, available in CONG. GLOBE, 23d Cong., 1st Sess. 271 (1834)). This is the only time a U.S. President has been officially censured by the Senate. *Id.*

174. *Id.* at 441.

175. R. KENT NEWMYER, *THE SUPREME COURT UNDER MARSHALL AND TANEY* 93 (2d ed. 2006).

176. 60 U.S. (19 How.) 393 (1857), *superseded by constitutional amendment*, U.S. CONST. amend. XIV.

177. DAVID P. CURRIE, *THE CONSTITUTION IN THE SUPREME COURT: THE FIRST HUNDRED YEARS, 1789–1888*, at 264 (1985) (describing *Dred Scott* as “bad judicial politics”); see also George Ticknor Curtis, *The Dred Scott Case: As Remembered by Justice Curtis’s Family*, 10 GREEN BAG 2D 213, 224–38 (2007) (describing extreme procedural irregularities by Chief Justice Taney in issuing his opinion, which was very controversial at the time).

178. See NEWMYER, *supra* note 175, at 94 (“As United States attorney general (1831–33) and secretary of the treasury (1833), [Taney] revealed an anti-monopolistic, state mercantilist, democratic bias that made him one of President Jackson’s closest advisers. He brought this bias to the chief justiceship . . .”).

was contrary to longstanding legal precedent.¹⁷⁹ Constitutional scholars today recognize that anti-monopoly decisions like *Charles River Bridge* “reflect Taney’s infusion of his own values into the Constitution, something that became notorious in *Dred Scott*.”¹⁸⁰ Another historian has observed in more delicate language that Chief Justice Taney and his fellow Jacksonian Justices had a clear “preference for expediency over doctrine” and thus they “shaped constitutional law to serve the political and economic imperatives of the new age.”¹⁸¹

Patent law was not immune from this new policy-driven jurisprudence of the “new age” of the Taney Court. In 1852 in *Bloomer v. McQuewan*,¹⁸² another foundational case for the exhaustion doctrine in patent law,¹⁸³ Chief Justice Taney expressly rewrote the patent statutes to define patents as state-granted franchises. The 1836 Patent Act defined patents in terms of the classic property rights of acquiring, using, and disposing of one’s possessions, as did all the prior patent statutes.¹⁸⁴ In *Bloomer*, Chief Justice Taney held that patents are “franchise[s]” that secure only “a right to exclude.”¹⁸⁵ This is now the modern definition of the property right in a patent,¹⁸⁶ but it was contrary to the explicit definition of patents as property rights in the statutes in force at the time. Patent law historian, Edward Walterscheid, states that Chief Justice Taney’s *Bloomer* opinion

179. *See Charles River Bridge v. Warren Bridge*, 36 U.S. (11 Pet.) 420, 583–607 (1837) (Story, J., dissenting).

180. John O. McGinnis, *The Once Famous Charles River Bridge Case*, LAW & LIBERTY (June 26, 2014), <http://www.libertylawsite.org/2014/06/26/the-once-famous-but-largely-forgotten-charles-river-bridge-case/> [<https://perma.cc/3V4V-UDQT>].

181. NEWMYER, *supra* note 175, at 113.

182. 55 U.S. (14 How.) 539 (1852).

183. *See Impression Prods., Inc. v. Lexmark Int’l, Inc.*, 137 S. Ct. 1523, 1531 (2017); *Quanta Comput., Inc. v. LG Elecs., Inc.*, 553 U.S. 617, 625 (2008).

184. *See Patent Act of 1836*, Pub. L. No. 24-357, § 11, 5 Stat. 117, 121 (1836) (repealed 1870) (providing that “every patent shall be assignable in law” and that this “conveyance of the exclusive right under any patent, to make and use, and to grant to others to make and use, the thing patented” must “be recorded in the Patent Office”); *Patent Act of 1793*, Pub. L. No. 2-11, § 1, 1 Stat. 318, 321 (1793) (repealed 1836) (providing that a patent secures “the full and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery”); *Patent Act of 1790*, Pub. L. No. 1-7, § 1, 1 Stat. 109, 110 (1790) (repealed 1793) (providing that a patent secures “the sole and exclusive right and liberty of making, constructing, using, and vending to others to be used, the said invention or discovery”).

185. *Bloomer*, 55 U.S. at 549.

186. *See 35 U.S.C. § 154* (2018) (defining a patent as securing only the “right to exclude”).

represented an “extraordinary holding which appeared on its face so contradictory to the statutory language.”¹⁸⁷

In sum, the flouting of well-established legal rules was not unusual for Chief Justice Taney in patent cases or in other areas of law. In *Morse*, he attacked Claim Eight as an attempt by Morse to monopolize an entire field of telecommunications and commerce. The conclusion reached in *Morse* comported well with Chief Justice Taney’s abhorrence of state-granted monopolies and his commitment to economic populism. Similar to his actions in so many other areas of law, he reached this result by ignoring established legal rules for interpreting principle claims in patents.

Notably, Amos Kendall, Morse’s primary business partner, was also a fervent Jacksonian Democrat who had joined with Taney in 1833 as cabinet officers in executing President Jackson’s illegal order to kill the U.S. Bank. Kendall, though, was apparently willing to set aside his political principles in favor of his financial interests in Morse’s patents and in the successful franchise business model he developed with the Magnetic Telegraph Company.¹⁸⁸ Perhaps because Chief Justice Taney remained in public service, his decisions in cases like *Morse*, *Bloomer*, and *Winans* suggest that he could not so easily abandon the political ideology that earned him his position on the Supreme Court.

CONCLUSION

Morse’s electro-magnetic telegraph was one of the many pioneering inventions that produced explosive growth in the U.S. innovation economy in the nineteenth century. Among lawyers, judges, and scholars today, Morse is instead known as a would-be monopolist who attempted to claim control over telecommunication technologies far beyond the limits of the electro-magnetic telegraph he invented in the 1830s. This conventional wisdom among legal elites is understandable because it is a byproduct of Chief Justice Taney’s opinion in *Morse*. Once *Morse* is situated within its proper historical and legal context, however, it becomes clear this view of Morse and his patented invention is deeply mistaken.

The nature of Morse’s patent, as well as his litigation practices in The Great Telegraph Case, reflected the well-settled and understood practices of drafting and asserting principle claims in early American patent law. Morse may have used some overreaching language if one

187. Edward C. Walterscheid, *Divergent Evolution of the Patent Power and the Copyright Power*, 9 MARQ. INTELL. PROP. L. REV. 307, 330 (2005).

188. See JOHN, *supra* note 65, at 65–77; WOLFF, *supra* note 121, at 20 (“After a political career as a Jacksonian opponent of state-sponsored monopoly—particularly the monstrous state-granted monopoly of the Bank of the United States—Kendall now became an ardent defender of the patent monopoly the state had granted Morse and his associates.”).

reads Claim Eight in isolation, treating it as a peripheral claim under modern patent doctrine, but this was not how inventors, lawyers, or judges drafted, interpreted, or applied patent claims in the Antebellum Era. It was arguably Chief Justice Taney who overreached in *Morse*, not Morse himself. It is only an accident for Chief Justice Taney that later developments in U.S. patent law, such as the evolution of peripheral claiming and the literal infringement doctrine, have made *Morse* appear to be more correct today than it was in 1854.