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DEFINING THE PATENT AND COPYRIGHT TERM: TERM LIMITS AND THE INTELLECTUAL PROPERTY CLAUSE

Edward C. Walterscheid*

The Congress shall have Power... To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries...¹

I. INTRODUCTION

In 1966 the Supreme Court declared that the patent provision of the Intellectual Property Clause “is both a grant of power and a limitation.”² The Court was speaking in the context of its view that the patent provision contains an inherent constitutional standard of invention, but the quoted language is of interest because the Intellectual Property Clause contains several grants of power and several limitations. Elsewhere, I have sought to explore the differing perspectives that have existed over time with regard to ascertaining just exactly what the grants of power are and what the limitations are.³

Here, I wish to explore the limitation set on the power of Congress to authorize issuance of patents and copyrights by the phrase “for limited times” as it appears in the Intellectual Property Clause.⁴ Inherent in this

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¹ U.S. CONST. art. I, § 8, cl. 8.
⁴ This is an example of what Merges and Reynolds call “internal limits on Congress’s power to create and extend intellectual property interests.” In their view, “[s]uch limits are ‘internal’ in the sense that they are the result of the very same constitutional provision giving rise to Congress’s power in the first place, rather than the result of ‘external’ provisions such as the Bill of Rights.” Robert Patrick Merges and Glenn Harlan Reynolds, The Proper Scope of the Patent and Copyright Power, 37 HARV. J. ON LEGIS. 45, 46 (2000).
phrase is the presumption that at some point in time the subject matter of both patents and copyrights are intended to go into the public domain, i.e., patents and copyrights do not—and cannot—create a perpetual property right in inventors and authors. What did the Framers intend by this phrase, and how has the Congress interpreted it over the more than two hundred years since the Constitution was ratified? To what extent, if any, is the phrase controlled and limited by the purpose of the Intellectual Property Clause, i.e., “to promote the Progress of Science and useful Arts”? Why has Congress authorized a copyright term that can in principle extend five times longer than the patent term? Perhaps more importantly, with its latest copyright term extension legislation, has Congress reached beyond the constitutional limit on the copyright term?

An exploration of term limits in the Intellectual Property Clause must begin with a closer look at the rationale for this most unusual clause.

II. A MOST UNUSUAL CLAUSE

In the eighteenth century, those who thought about such matters—and the delegates to the constitutional convention in general were certainly in that vein—took for granted that it was the duty of enlightened government “to promote the Progress of Science and [the] useful Arts.” But there is a tendency to forget that the constitutional power granted to Congress “to promote the Progress of Science and useful Arts” is unique among the congressional powers in that it alone specifies a mode for exercising the particular power, i.e., “by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.” No other constitutional grant of authority to Congress sets forth a specific means for exercising that authority.

It appears that this was deliberate and that other attempts to grant specific as opposed to general powers to Congress were rejected by the delegates.


6 U.S. CONST. art. I, § 8, cl. 8.

7 Id.
Jefferson, who was not a particular friend of the Intellectual Property Clause although he is often argued to have highly favored it, provided interesting, albeit indirect, evidence in this regard, when he recorded the following as the result of a dinner conversation on March 11, 1798:

Baldwin mentions at table the following fact. When the bank bill was under discussion in the House of Representatives, Judge Wilson came in, and was standing by Baldwin. Baldwin reminded him of the following fact which passed at the grand convention. Among the enumerated powers given to Congress was one to erect corporations. It was, on debate, struck out. Several particular powers were then proposed. Among others, Robert Morris proposed to give Congress a power to establish a national bank. . . . [This] was rejected, as was every other special power, except that of giving copyrights to authors, and patents to inventors; the general power of incorporating being whittled down to this shred. Wilson agreed to the fact.

Indeed, the Committee of Detail, which was responsible for preparing a working draft from which the delegates ultimately crafted the Constitution, deliberately avoided placing such details in the clauses being proposed. As Edmund Randolph explained it:

In the draught of a fundamental constitution, two things deserve attention:
1. To insert essential principles only, lest the operations of government should be clogged by rendering those provisions permanent and unalterable, which ought to be accommodated by time and events, and

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8 See, e.g., Edward C. Walterscheid, The Use and Abuse of History: The Supreme Court’s Interpretation of Thomas Jefferson’s Influence on the Patent Law, 39 IDEA 195 (1999) (stating that the views attributed to Jefferson were endorsed during his life); and Edward C. Walterscheid, Patents and the Jeffersonian Mythology, 29 JOHN MARSHALL L. REV. 269 (1995).
2. To use simple and precise language and general propositions, according to the example of the constitutions of the (several) states.  

It is precisely because the delegates hewed to these first principles that the Constitution has been such an enduring framework of governance for the United States.

Thus, the unusual fact that this particular detail exists in the Intellectual Property Clause suggests a key to why such a clause was included. Not only was it intended to provide a broad authority to promote the progress of science and the useful arts, but also as a means of ensuring authority to do so in a particular way, namely, by securing exclusive rights for limited times to authors and inventors in their respective writings and discoveries.  

Again, I emphasize that it is the only instance wherein the delegates prescribed a specific mode of accomplishing the particular authority granted.

That they should do so is interesting because there are a variety of ways of promoting the progress of science and useful arts which have nothing to do with the granting of exclusive rights for limited times in writings, inventions, and discoveries. Indeed, a strong movement would arise in Europe in the nineteenth century which would argue that granting exclusive rights was precisely the wrong way to encourage industrial innovation. Why then should the Constitution make specific reference to promoting the useful arts by securing exclusive rights in their inventions to inventors for limited times? The answer seems to have been predicated on the fact that they desired to follow the English practice of granting exclusive rights through the issuance of patents or something similar and were not at all certain that Congress would have the power to do so without an explicit grant of authority. This was also true with regard to copyrights.

The problem was that patents and copyrights were clearly perceived as monopolies, albeit desirable ones. In their discussion of the limited-term

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exclusive rights authorized by the Intellectual Property Clause, both Jefferson and Madison referred to them as monopolies. Indeed, the fact that they were looked on as monopolies was exactly the reason that Jefferson initially opposed the Intellectual Property Clause and was never particularly enthralled with it. He thought it better to grant no monopolies at all. Nonetheless, the delegates did not believe that Congress would have the power to grant any monopolies, even desirable ones, absent an express authority of this type. But in granting express authority to create patent and copyright monopolies, they sought to assure that the monopolies would not be open-ended but rather limited in time. Just what the temporal limitation should be has remained an open question.

But why would the Framers desire to perpetuate English institutions of this type? One straightforward reason was their familiarity with them. The issuance of patents and copyrights had long been known in England, and these limited-term monopolies were generally perceived to produce social good, both as an encouragement to the development of manufacturing and

13 See Letter from Thomas Jefferson to James Madison (July 31 1788), in 1 THE REPUBLIC OF LETTERS, 543, 545 (James Morton Smith ed., 1995) and Letter from Madison to Jefferson (October 17, 1788) 562, at 566.

14 See Smith, supra note 13, at 545. As Jefferson put it in his July 31, 1788 letter to Madison, "it is better...to abolish...Monopolies, in all cases, than not to do it in any." He acknowledged that precluding patent and copyright monopolies "lessens the incitements to ingenuity, which is spurred on by the hope of a monopoly for a limited time" but argued that "the benefit even of limited monopolies is too doubtful to be opposed to that of their general suppression."

15 Concerns about potential congressional power to create monopolies ran deep. See 2 AMERICAN MUSEUM 534-36 (Philadelphia, 1787). One of the reasons why Virginia delegate James Mason refused to sign the Constitution was that "under their own construction of the general clause at the end of the enumerated powers, the congress may grant monopolies in trade and commerce." This was also a concern of a number of the ratifying conventions. See Result of the Proceedings of the Convention of North Carolina, 4 AMERICAN MUSEUM 265, 268 (Philadelphia, 1788) (containing the convention's concerns that Congress should not be allowed to grant monopolies); Amendments to the New Constitution, recommended by New York, 2 AMERICAN MUSEUM at 155-156. See also Remarks on the amendments to the federal constitution proposed by the conventions of Massachusetts, New Hampshire, New York, Virginia, South and North Carolina, with the minorities of Pennsylvania and Maryland by the Rev. Nicholas Cottin, D.D., 6 AMERICAN MUSEUM at 303 (Philadelphia, 1788) (commenting that "monopolies are in general pernicious and therefore not adopted but in extraordinary cases"). At least two state constitutions had provisions strongly objecting to the creation of monopolies. According to the Maryland Constitution of 1776, § XXXIX, "monopolies are odious, contrary to the spirit of free government, and the principles of commerce; and ought not to be suffered." See III THE FEDERAL AND STATE CONSTITUTIONS 160 (F. Thorpe ed., 1909). Similarly, the North Carolina Constitution of 1776, § XXIII, stated "[t]hat perpetuities and monopolies are contrary to the genius of a free State, and ought not to be allowed." See V THE FEDERAL AND STATE CONSTITUTIONS at 2788. If they wanted to assure that Congress had authority to grant limited-term exclusive rights to authors and inventors, the delegates had good reason to believe that they had to say so expressly and explicitly.
as an aid to learning. But more than anything else, the rationale was pragmatic and economic. This approach to promoting the progress of science and useful arts would cost the new federal government the least to implement while at the same time providing a desired pecuniary incentive to both inventors and authors. This was a critical consideration for the new government that was contemplated to take over the state debts inherited from the Revolutionary War. From the perspective of delegates seeking to devise a form of governance for a fledgling, impecunious national government, granting limited-term exclusive rights in their works to authors and inventors seemed the perfect solution to encouraging the progress of science and useful arts with the least expense. 16 Although no contemporaneous American exposition of this pragmatic economic reality has been found, it had recently been set forth in England. 17

Purely and simply, the Framers desired to give Congress authority to engage in the patent and copyright practice that had long been followed in England, but with discretion to modify it to meet American circumstances. A fundamental aspect of that practice was that the exclusive right granted by either patent or copyright be limited in time. To understand what the Framers contemplated, it is thus necessary to review not only the extant English practice with respect to the patent and copyright terms authorized when the Constitution was drafted, but also how those terms came to be developed.

III. ENGLISH ANTECEDENTS

At the time the Framers met in convention in Philadelphia, the patenting of inventions and copyrighting of literary works had been practiced in England for several centuries. Indeed, the legal forms of letters patent in the

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16 As noted about the British patent system in 1967, but fully applicable to the circumstances existing in 1787 in the newly independent United States, such an approach "makes no attempt to reward the inventor directly: the reward is of [the inventor's] own making." See K. Boehm et al., I THE BRITISH PATENT SYSTEM 1 (Cambridge 1967).

17 In 1785, Jeremy Bentham, comparing rewards by bonus payments with rewards by "exclusive privileges," argued that the latter approach was "best proportioned, the most natural, and the least burdensome" in that "it produces an infinite effect, and it costs nothing." Jeremy Bentham, A Manual of Political Economy, 3 THE WORKS OF JEREMY BENTHAM 71 (Bowring ed., 1932), as cited in Fritz Machlup and Edith Penrose, The Patent Controversy in the Nineteenth Century, 10 J. Econ. Hist. 1, 20 (1950).
English context were not only time-honored but timeworn. Copyright law, and in particular the copyright term under common law, had been hotly debated in England in the decades preceding the drafting of the Constitution, and there seems to have been confusion on the part of the Framers as to exactly what the term of common law copyright was—or indeed whether such actually existed.

A. PATENT CUSTOM AND PRACTICE

It is not certain when the first English patents of monopoly were granted, but the English patent custom took root and flourished during the reign of Elizabeth I. Commencing in 1561 and continuing through 1600, she granted at least 55 patents of monopoly for industries and inventions. Unfortunately, she also granted “odious monopolies,” i.e., those in restraint of a known trade or industry. Moreover, at least certain of her grants of monopoly came to be used to control settled trades and thereby came to be perceived as “odious monopolies.”

Early in Elizabeth’s reign a concept developed that stated the crown had the duty and obligation to regulate trade and commerce in such a way as to favor the creation of new industries and trades. The crown was sufficiently pragmatic to realize that the costs and risks associated with the introduction of a new trade or industry required a substantial economic return to those taking such risks and incurring such expenses without at the same time resulting in a substantial cost to the state. In the impecunious and parsimonious...
ous nature of the times, the grant of a patent monopoly for a limited period held itself out as the most appropriate incentive to be offered by the crown.\textsuperscript{22}

It was perhaps inevitable that the granting of monopoly patents would produce significant problems. But it was not until November 1601 that Parliament began debating a bill entitled “An Act for the Explanation of the Common Law in Certain Cases of Letters Patent” and in so doing created a grave constitutional crisis. At issue was the power of the royal prerogative under which the patents, including those for the so-called “odious monopolies,” had issued. The last thing the crown wanted was parliamentary enactment in this regard. Accordingly, in a brilliant political move, Elizabeth agreed that if the bill was withdrawn, she would agree to submit her patent grants to “a Tryal according to law for the good of the people.”\textsuperscript{23}

Parliament quickly agreed, and, as a result, the common law would be called upon to settle a sensitive constitutional issue vital to the commerce of the country. The denouement came in 1602 in the celebrated case of\textit{Darcy v. Allin}, also known as\textit{The Case on Monopolies}. This case involved the monopoly patent on the importation, manufacture, or sale, in gross or retail, of playing cards in England which had existed in one form or another since 1576.

In the context of the patent law,\textit{Darcy v. Allin} is remembered not for the literal ruling therein, but rather for the opinions expressed on the monopoly right and the argument relating to invention and monopoly right. Monopoly was stated to be prima facie against the common law, the statute law, and the liberty of the subject because it damages not only those working in the trade but all other subjects of the realm as well by raising prices, reducing merchantability, and reducing employment.\textsuperscript{24} These were strong words, but a critical exception was admitted by counsel for Allin, namely,

\ldots the [j]udges have heretofore allowed of monopoly patents, which is, that where any man by his own charge and industry, or by his own wit or invention doth bring any new trade into the realm, or any engine tending to the

\textsuperscript{22} Also referred to as “Allen” or “Allein.” 74 Eng. Rep. 1131 (K.B. 1602).

\textsuperscript{23} SIR SIMONDS D’EWES, JOURNALS OF ALL THE PARLIAMENTS DURING THE REIGN OF QUEEN ELIZABETH 644-48 (London, 1682); see also WILLIAM COBBETT, I COBBETT’S PARLIAMENTARY HISTORY OF ENGLAND 925-30 (London 1806) (describing the Queen’s negotiations over patents).

\textsuperscript{24} 77 Eng. Rep. at 1263.
furtherance of a trade that never was used before: and that for the good of the realm: that in such cases the King may grant to him a monopoly patent for some reasonable time, until the subjects may learn the same, in consideration of the good that he doth by bringing his invention to the commonwealth (emphasis supplied): otherwise not.\textsuperscript{23}

In \textit{The Clothworkers of Ipswich},\textsuperscript{26} decided in 1615, the court would speak favorably of this exception. \textit{Darcy v. Allin} is of considerable interest in the context of the present work because it indicated that a monopoly patent for invention was proper, provided that the term of the patent was "for some reasonable time.\textsuperscript{27} The opinion also seemed rather to indicate rather clearly that this "reasonable time" was dependent upon the time it took until other "subjects may learn the same."\textsuperscript{28} \textit{The Clothworkers of Ipswich} added an additional premise, however, saying the following:

\begin{quote}
But if a man hath brought in a new invention and a new trade within the kingdom, in peril of his life, and consumption of his estate or stock, \&c. or if a man hath made a new discovery of any thing, in such cases the King of his grace and favour, in recompence of his costs and travail, may grant a charter unto him, that he only shall use such a trade or trafique for a certain time, because at first the people of the kingdom are ignorant, and have not the knowledge or skill to use it: but when that patent is expired, the King cannot make a new grant thereof: for when the trade is become common, and others have been bound apprentices in the same trade, there is no reason that such should be forbidden to use it.\textsuperscript{29}
\end{quote}

\begin{flushright}
\textsuperscript{23} 74 Eng. Rep. at 1139. \\
\textsuperscript{24} 78 Eng. Rep. at 147 (K.B. 1615). \\
\textsuperscript{25} 74 Eng. Rep. at 1139. \\
\textsuperscript{27} Id. \\
\textsuperscript{28} Id. \\
\textsuperscript{29} The Clothworkers of Ipswich, 78 Eng. Rep. at 148.
\end{flushright}
This suggested that the term of the patent involved two different considerations, one being the opportunity of the patentee to recover costs (and presumably some reasonable profit) and the other being the public benefit accrued by precluding an extension or renewal of the term after "the trade is become common, and others have been bound apprentices in the same trade. . .". As will be seen, the tension between these two premises would continue when the United States patent law came into being.

Thus by the early seventeenth century, it had been established at common law that under the royal prerogative the crown had discretion to issue monopoly patents for invention for limited periods. Two reasons were typically given for the monopoly grant: (a) to introduce new trade and industry into the realm, and (b) to serve as a means of recompensing the patentee for the costs and risks associated with the enterprise. Although an early British textbook on patent law states that prior to the Statute of Monopolies the term of the patent grant was twenty-one years, in reality it varied widely from as short as four years to as long as thirty-one years. In issuing monopoly patents, James I followed much the same practice as Elizabeth I with very much the same result—a hue and cry against the odious monopoly. He sought to defuse the situation in much the same way that she did, i.e., by promising to let the common law courts determine the validity of the monopoly grants. A critical distinction was that she was a popular queen whom he could never hope to emulate, and whereas her Parliaments expressed concern about the improper granting of monopoly patents, his became downright mutinous on the subject. What she effectively prevented, he ultimately caused—the legislation enacted in 1623 that became famous as the Statute of Monopolies.

Although the Statute declared as contrary to the law of the realm and utterly void all monopolies, grants, licenses, and letters patent of or for the sole buying, selling, making, working, or using of anything within the realm, it also contained a number of specified exceptions to this general mandate. One of these was contained in section 6 which stated that

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30 Id.
31 WILLIAM CARPMAEL, THE LAW OF PATENTS FOR INVENTIONS 12 (London 1852). Cf. BRUCE W. BUGBEE, GENESIS OF AMERICAN PATENT AND COPYRIGHT LAW 38, 175-76, n. 120 (1967) (explaining that toward the end of the reign of James I, twenty-one years was but the predominant term with others varying from eleven to thirty-one years).
32 Statute of Monopolies, 1623, 21 Jam., ch. 3 (Eng.).
(A)ny declaration before mentioned shall not extend to any letters patent and grants of privilege for the term of fourteen years or under, hereafter to be made, of the sole working or making of any manner of new manufactures within this realm, to the true and first inventor and inventors of such manufactures, which others at the time of making such letters patent and grants shall not use, so as also they be not contrary to the law, nor mischievous to the State... [t]he said fourteen years to be accounted from the date of the first letters patents, or grant of such privilege hereafter to be made, but that the same shall be of such force as they should be, if this Act had never been made, and of none other.  

This section would provide the only statutory basis for the English patent law for more than two hundred years.

The Statute gave the crown discretion to issue monopoly patents for invention for any term of fourteen years or less. As a practical matter, patents were thereafter issued with a term of fourteen years. There are several interesting aspects to this term limitation. Clearly, Parliament accepted the argument that monopoly patents for invention were in the public good, but it also determined that they should be for a finite term that was substantially less than the predominant term of twenty-one years for the patents of James I. In addition, the crown was given no authority to renew or extend the term of a patent. Implicit in the language authorizing monopoly patents for invention was the assumption that fourteen years would be sufficient to accomplish the purpose of the monopoly, regardless of whether it was to introduce and encourage the working of the invention within the realm or whether it was to recompense the inventor for expenses incurred and risks taken.

The extant historical record does not indicate exactly what the basis for the fourteen-year term was, but a contemporaneous exposition of the meaning to be attributed to section 6 was given by Lord Coke in his Institutes of the Laws of England, published in 1644. According to Coke, a valid patent for invention had to have seven specific properties, the first of

\[ \text{Id. at § 6.} \]

\[ \text{See sources cited supra note 31.} \]
which was that the term not exceed fourteen years. If these seven properties were present,

the reason wherefore such a privilege [i.e., that of the patent grant] is good in law is, because the inventor bringeth to & for the Commonwealth a new manufacture by his invention, cost and charges, and therefore it is reasonable, that he should have a privilege for his reward (and the encouragement of others in the like) for a convenient time....

Thus, Coke's first requisite property derives from the fact that a convenient time was determined to be not more than fourteen years.

The reason for this term is not found in the contemporaneous record, although it has been suggested that it was chosen because it was double the term of apprenticeship then set by statute in England. It is more likely that the term of not more than fourteen years was chosen as a compromise between those who wanted a shorter term and those who argued for something on the order of twenty-one years which was a frequent term of the royal patents issued by James I. In this regard, it should be noted that the bill which in much amended form became the Statute of Monopolies was originally drafted by Lord Coke. In its original form, it contained no exception for patents of invention to the general ban on monopolies. When a proviso was added excepting out patents for new inventions from the ban, it seems to have contained a condition that such patents could only be "for the term of eleven years or under." How this became fourteen years or less in the final bill is unclear, but it undoubtedly was a product of a process of negotiation between those favoring a longer term and those favoring a shorter one.

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36 Id.
37 See, e.g., Christine MacLeod, Inventing the Industrial Revolution: The English Patent System, 1660-1800 18 (1988); F.J. Federico, Origin and Early History of Patents, 11 J. Pat. Off. Soc'y 292, 304 (1929) (stating that the exact reason why the term of the patent grant was fixed at fourteen years is unknown, but speculating that this term may have been chosen to allow for the teaching of several generations of apprentices).
39 Id. at 131 n.200.
A prominent English commentator on the patent law states that "[t]he statutory limitation of the term of the grant to fourteen years . . . was avowedly based upon the consideration that the patent should not operate in restraint of trade." At the time, however, that was exactly what Lord Coke thought it would do, because in his view it would preclude one apprenticed in the new manufacture from the free practice of his trade once the apprenticeship was completed. As a consequence, he favored a term limitation of seven years. Regardless of the rationale for choosing the term of fourteen years, it is apparent that the intent was to permit the invention to go into use by the public once the term expired.

While it was clear that the Statute of Monopolies limited the authority of the sovereign to the grant of a term of no more than fourteen years, no such constraint was placed on Parliament. In the second half of the eighteenth century, it became increasingly common for patentees and their assignees to seek extensions of the patent term and to have Parliament enact special legislation to extend the term of particular patents. Indeed, assignees and licensees not infrequently sought to make term extension a condition of the assignment or license. To accomplish this, political connections and lobbying skill were required, as well as a fair sum of money.

Parliamentary term extensions varied in length but typically were on the order of four to seven years. The most famous British patent of the eighteenth century, issued to James Watt in 1769, received a twenty-five year parliamentary extension in 1775 so that its total term was thirty one years. This was an exceedingly long term by English standards, and it is useful to briefly explore how it came about and what justification was given for it.

Watt's invention of the separate condenser for a steam engine in 1765 seems to have been little influenced by the existence of the British patent custom. Watt invented in order to solve a perplexing and interesting technical problem and not for the purpose of enriching himself through

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41 COKE, supra note 35.
42 For example, the patentee in Liardet v. Johnson, a case renowned for being one of the earliest to require the specification to have an enabling disclosure teaching those skilled in the art how to make and use the invention, obtained a four-year parliamentary extension of his patent term in 1776. See John N. Adams & Gwen Averley, The Patent Specification: The Role of Liardet v. Johnson, 7 J. LEGAL HIST. 156, 162 (1986).
patent rights arising from his invention.43 But the commercial development of Watt's steam engine took more than a decade and many thousands of pounds to accomplish. That expenditure and the resultant successful economic development of the engine came about in no small measure because of the twenty-five year extension.

Watt had little personal funds and was required to borrow to finance his steam engine experiments. By the spring of 1768, he had accumulated a debt of over one thousand pounds. At that time, Watt entered into a partnership with Dr. John Roebuck whereby Roebuck agreed to pay off his debts and fund the cost of a patent in return for a two-thirds share in the patented invention.44 Roebuck appeared to have made the application for a patent a condition of his partnership with Watt.45 But Roebuck himself was soon in financial difficulty and contributed little more to the development of the engine than the sums he agreed upon in 1768. Watt was once again reduced to borrowing, and from 1770 to early 1774 spent little or no time on developing the engine.46

By early 1774, Roebuck was bankrupt and Matthew Boulton came to Watt's rescue.47 Of Roebuck's creditors, only Boulton placed any value on Watt's patent,48 and he was nothing if not entrepreneurial. He took over Roebuck's two-thirds share in the patent, entered into a partnership agreement with Watt to form the firm of Boulton & Watt, agreed to pay Watt a salary of 330 pounds a year plus expenses, and agreed to finance commercial development of the engine, estimated in 1775 to cost an additional 10,000 pounds.49 Boulton saw not only the value of Watt's patent but also the necessity of obtaining a long-term extension of it in order to make the partnership profitable. Indeed, the partnership agreement seemed heavily contingent on the grant of a term extension and was to last only as long as the extended term of the patent,50 which turned out to be until 1800.

44 *Id.* at 169.
45 *Id.* at 183.
46 *Id.* at 169.
47 *Id.*
48 Boulton's interest in the patent commenced even before it was issued. He and Dr. William Small had commented in detail on Watt's proposed specification in February 1769. See ERIC ROBINSON & A. E. MUSSON, JAMES WATT AND THE STEAM REVOLUTION: A DOCUMENTARY HISTORY 54-56 (1969).
49 *Id.*
Early in 1775, Watt surrendered his patent, and a bill was introduced in Parliament to extend the term of the patent for twenty five years. After hot debate in the Commons, Parliament passed the Fire Engine Act extending the term as requested. The Act stated the justification for the extension as follows:

AND WHEREAS, in order to manufacture these engines with the necessary accuracy, and so that they may be sold at moderate prices, a considerable sum of money must be previously expended in erecting mills, and other apparatus; and as several years, and repeated proofs, will be required before any considerable part of the publick can be fully convinced of the utility of the invention, and of their interest to adopt the same, the whole term granted by the said Letters Patent may probably elapse before the said JAMES WATT can receive an advantage adequate to his labour and invention:

AND WHEREAS, by furnishing mechanical powers at much less expense, and in more convenient forms, than has hitherto been done, his engines may be of great utility in facilitating the operations in many great works and manufactures of this kingdom; yet it will not be in the power of the said JAMES WATT to carry his invention into that complete execution which he wishes, and so as to render the same of the highest utility to the publick of which it is capable, unless the term granted by the said Letters Patent be prolonged. . . .

Note that the rationale set forth is twofold; first, that he can be adequately recompensed for "his labour and invention," and second, that he may render his invention "of the highest utility to the publick." In other words, there is both a private and a public justification.

51 Fire Engine Act, 1775, 15 Geo. 3, ch. 61 (Eng.). For the text of the Act, see ROBINSON & MUSSON, supra note 48, at 76-80.
52 Scherer, supra note 43, at 184; ROBINSON & MUSSON, supra note 48, at 78.
Nothing in the Act indicates why the extension was for twenty five years which was unusually long. But Boulton was a most effective parliamentary lobbyist\(^{53}\) who managed to direct the examining committee's attention to the fact that Parliament had extended the term of the Marquis of Worcester's steam engine patent for ninety-nine years and that of Captain Savory's steam engine patent for thirty-five years so that his request for a mere additional twenty-five years seemed quite reasonable.\(^{54}\) He carefully refrained from giving the committee any information on whether these earlier patents had been held valid and successfully enforced against infringers.\(^{55}\)

The desirability of giving Watt a thirty-one year patent term has been much debated from the eighteenth century to the present. Assuming that the estimate of 13,000 pounds required to bring the Watt engine to commercial fruition is accurate, then some extension of the term could be justified.\(^{56}\) Some extension was very likely necessary to encourage the substantial investment and effort necessary for commercial success. But even if "Watt's invention . . . has been generally recognized as the key-invention of the Industrial Revolution,\(^{57}\) that is not in and of itself any justification for extending the patent term to thirty-one years. Certainly it permitted both Watt and Boulton to leave handsome estates when they died.\(^{58}\) But was it to the advantage of the public? The evidence suggests that it was not, but rather that it serves as a "justification for the more modest patent terms now normally provided."\(^{59}\)

There were several major disadvantages of the long patent term. First, Boulton and Watt not surprisingly took advantage of it.\(^{60}\) They made a conscious decision not to license the separate use of the condenser. The net result was that those who sought licenses for complete engines paid a very

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\(^{53}\) ROBINSON & MUSSON, supra note 48, at 14-15.

\(^{54}\) Id. at 74-75.

\(^{55}\) As of 1775, only a few common law infringement actions had actually occurred, and patentees had not been favored in the outcomes. See H. I. DUTTON, THE PATENT SYSTEM AND INVENTIVE ACTIVITY DURING THE INDUSTRIAL REVOLUTION, 1750-1852, 71-79 (1984); JAMES OLDHAM, THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY 723-71 (1992).

\(^{56}\) Scherer, supra note 43, at 183 n.46 ("Most authors indicate that the investment would not have been recouped if the patent expired on schedule in 1783 and if no further revenues were obtained from then on").

\(^{57}\) ROBINSON & MUSSON, supra note 48, at 19.

\(^{58}\) Watt left an estate of about 60,000 pounds in 1819, and Boulton's estate approximated 150,000 pounds in 1809. Scherer, supra note 43, at 186 n.54.


\(^{60}\) Id. at 145.
high premium, or waited a very long time to obtain a Watt engine which was again quite expensive. If one obtained a proper license, all too often a competitor did not, so those who sought to comply with the patent were frequently at a distinct business disadvantage.

Secondly, while the long term gave Watt himself the opportunity to make and patent various improvements, at the same time it discouraged improvements in general. In particular, Watt was strongly opposed to high-pressure steam engines for safety reasons, and yet as would ultimately be demonstrated they were the wave of the future. His refusal to build a high-pressure engine incorporating his separate condenser and other patented improvements appears to have materially retarded the development of even more effective steam engines.

Over time, it seems Parliament became aware of these concerns. When Watt and Boulton petitioned Parliament in 1799 for a further extension of the term as well as for extension of the terms of the additional patents Watt had received in 1781, 1782, and 1784 (all of which had expired), they sought to justify the extensions on two grounds. First, the development of the steam engine had taken many years of costly experiments. Secondly, because of numerous infringements and legal actions, they had not been able to reap their just financial rewards. Parliament did not buy the argument and declined to act on the petition.

B. COPYRIGHT CUSTOM AND PRACTICE

The rise of copyright is inextricably intertwined with the development of printing. In England copyright began in the same way as patents of monopoly for invention did, as an adjunct of the royal prerogative. Printing was introduced in 1476, and as early as 1518 there is a record of royal grant for an exclusive privilege with respect to a printed book which protected the printer against reprinting within the kingdom or importation for a period of

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61 Id.
62 Id. at 145-47; cf. ROBINSON & MUSSON, supra note 48, at 19-21 (commenting that his refusal did not impede steam engine progress).
63 ROBINSON & MUSSON, supra note 48, at 209.
64 See, e.g., L. RAY PATTIERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE 20 (1968); BUGBEE, supra note 31, at 49; cf. RICHARD C. DE WOLF, AN OUTLINE OF COPYRIGHT LAW 2 (1925) (stating this occurred in 1474).
two years. This practice continued throughout the sixteenth century with Elizabeth I in particular using it as a means of rewarding her favorites at no expense to the crown. These patent grants of printing monopolies with respect to a particular work or class of works were given to printers as well as courtiers or other royal favorites who were obviously not printers in their own right, and who farmed out the privilege to printers, for an appropriate fee of course. Nowhere in these monopoly grants was there any recognition that the author might have property rights with respect to the work being printed.

In the same manner as other patents of monopoly, these printing monopolies came to be looked on with suspicion. They gradually came to be restricted to the printing of books over which the crown claimed control by virtue of its authority as head of both state and church. In particular, the rise of printed matter threatened the predominance of the sovereign in both the political and religious arenas. For the first time, a ready avenue was available for the wide dissemination of dissenting views with respect to the existing order. Therefore, it is not surprising that developing a mechanism for the control of printed matter became a matter of some urgency for the crown.

Early in the fifteenth century, a craft guild was formed of those who wrote text letters, and those who served as limners or illustrators, and those who bound and sold books. Thereafter, those who made or dealt in books and were associated with this guild came to be known as stationers. In the latter part of the century, the stationers naturally came to be those who bought from the printers the books which they bound and sold. Perhaps not

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65 There is nothing special about the term of two years. Indeed, in light of subsequent events, it was a remarkably short term for the privilege. Terms of seven and ten years for individual works came to be common; and lifetime grants for classes of works were frequently given. See Patterson, supra note 64, at 79.

66 See, e.g., John Feather, Publishing, Piracy and Politics: An Historical Study of Copyright in Britain 11-14 (1994); Bugbee, supra note 31, at 50; and De Wolf, supra note 64, at 2.

67 Nonetheless the Statute of Monopolies when it was enacted in 1623 expressly exempted printing patents from its ban on monopolies. Thus 21 Jam., ch. 3, § 10 (Eng.) states that the Statute does not extend to "any Letters Patents or Grants of Privilege heretofore made, or hereafter to be made, of, for, or concerning Printing."

68 Patterson states that in 1403 the Mayor and Aldermen of London granted a petition by such individuals to form a guild. Patterson, supra note 64, at 29.
surprisingly, the printing craft quickly came to be allied with that of the
stationers.69

In 1556, the crown chartered the company of stationers and granted to it
general supervision of the trades of printing, binding, publishing, and dealing
in books.70 In return for this right of supervision, the stationers agreed to
royal censorship, supervision, regulation, and licensing of books to be
printed. The stationers’ company quickly established a register which
recorded the works for which copying rights or privileges had been obtained.
Unless a printer or publisher had obtained a printing patent from the crown,
the work to be printed had to be registered with the stationers’ company.71

This system of registry would ultimately result in the unintended and
certainly unanticipated (at least by the crown) legal consequence of the
judicial determination of the common law right of copyright. By registra-
tion the printer or publisher got an essentially exclusive copying right which
for all intents and purposes gave an incontestable title to the work being
copied, i.e., printed. It gave substance to the idea of literary property which
came to be known as copyright. The copying right was protected by
imposition of penalties for infringement. It could be assigned, sold, settled,
given in trust, and had all the various attributes of property. Moreover, since
unlike the privilege granted by printing patents the registration almost never
carried a time limitation, it came to be regarded as a perpetual form of
property.72

During the seventeenth century, a variety of ordinances and parliamen-
tary acts were passed for the purposes of regulating printed material. While
in force these assured control of the stationers’ company over the printing,
publishing, and booksellers’ trades and permitted the registered copying
rights to be maintained as monopolies. They tacitly, if not specifically,
acknowledged a common law right of property in copyright.73 But the last
licensing act expired in 1694, and from then on until 1710 those holding

69 WILLIAM HOLDSWORTH, 6 A HISTORY OF ENGLISH LAW 362-63 (Methven & Co. Ltd. Sweet &
Maxwell Ltd. 2d ed. 1937) (1924); and PATTERSON, supra note 64, at 35-36.

70 See generally FEATHER, supra note 66, at 14-36 (discussing the stationer’s company and how it
operated); and PATTERSON, supra note 64, at 28-41. The content of this and the following paragraph is
taken generally from BUGBEE, supra note 31, at 50-51, and HOLDSWORTH, supra note 69, at 363-65.

71 BUGBEE, supra note 31, at 50-51; HOLDSWORTH, supra note 69, at 363-65.

72 BUGBEE, supra note 31, at 50-51; HOLDSWORTH, supra note 69, at 363-65.

73 See, e.g., BUGBEE, supra note 31, at 53, and HOLDSWORTH, supra note 69, at 367-77. Cf. Howard
exclusive copying rights from the stationers' company found themselves essentially in limbo. Furthermore, they were faced with a rising tide of opposition to the monopolies conferred by their exclusive copying rights. Thus, influential members of the book trade and the stationers' company pushed for new legislation. It was not until 1710 that they got it, but when they did so it was not what they had anticipated and hoped for.

The bill that would become the first English copyright statute, the Statute of Anne, was first introduced on January 11, 1710. It was entitled "A Bill for the Encouragement of Learning and for securing the property of Copies of Books to the rightful Owners thereof." As introduced, it contained no reference to any limitation on the term of protection for literary property. This lack of a term, coupled with the use of the word "securing" in the title, suggested an intent to create a permanent and perpetual property right, which of course was precisely what the booksellers so desperately wanted.

During debate in the House of Commons, there was considerable concern expressed that a perpetual or unlimited term would result in monopoly of the worst sort and an inevitable restraint of trade. As a result, the bill as passed by Commons set the term of protection at fourteen years for new books and twenty one years for books already in print. Rose is persuasive in suggesting that these terms were identical to those provided for patents for invention in the Statute of Monopolies and were likely copied therefrom. He notes that when printing patents and patents for invention first appeared, they were not different in kind and were treated similarly. If the bill truly intended to treat copyright by analogy with patents, then there was a clear implication that the right to copy was not property at all, but rather a privilege emanating from the royal prerogative. The issue would then become one of why a literary invention was different from a mechanical invention, i.e., why should authors be treated differently than inventors? This, of course, is an issue that continues to be debated to this day.

Given the decision to limit the term of copyright, it is perhaps not surprising that the title of the bill was changed in an effort to avoid any  

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74 8 Anne, ch. 19 (1710) (Eng.).

75  MARK ROSE, AUTHORS AND OWNERS: THE INVENTION OF COPYRIGHT 42-43 (1993). Cf. Feather's statement that the bill provided: "From a date to be determined, all existing copies shall be confirmed to their present owners for 21 years; new books will be protected for 14 years, with the possibility of a second 14-year term." FEATHER, supra note 66, at 58-59. Feather appears to have confused the bill as amended with the bill as introduced.

76  ROSE, supra note 75, at 45.
impression that an extant right was being confirmed, but rather to emphasize that a new right was being created. It then became “A Bill for the Encouragement of Learning by Vesting the Copies of Printed Books in the Authors, or Purchasers, of such Copies, during the Times therein Mentioned” and that, with minor grammatical changes, became the title of the Statute of Anne. Unfortunately, the term “securing” continued to appear in the preamble to the second section so that proponents of perpetual copyright would seize on the inconsistency in arguing their cause.77

Limiting the term of copyright was not a happy thought for the booksellers, and they immediately filed a petition with Parliament, wherein they stated:

But it is said, That it is sufficient for us to enjoy a Term of Years in our Sole Right of Printing. To this we answer, That if we have a Right for Ten Years, we have a Right for Ever. A Man’s having possess’d a Property for Ten or Twenty years, is in no other Instance allow’d, a Reason for another to take it from him,78 and we hope it will not in Ours.79

Perhaps as a sop to the booksellers, or perhaps because they felt the proposed copyright term of fourteen years was too short, the House of Lords amended the bill to provide for a single fourteen-year term of renewal if the author was still living at the end of the first term. This language became a part of the Statute of Anne.80

One of the more remarkable aspects of the Statute of Anne was that it was styled “An act for the encouragement of learning. . . .” Never before had copyright been declared to be for this purpose, either by the crown or by the stationers. Where, then, did this purpose originate? The preamble to the bill which became the Statute justified it by stating that piracy of printed works “is . . . a real discouragement to learning in generll [sic] which in all Civilized Nations ought to receive ye greatest Countenance and

77 Id. at 45-46.
78 In so stating, the booksellers conveniently ignored the fact that this was precisely what happened at the end of the term of a patent for invention when the invention went into the public domain.
79 ROSE, supra note 75, at 44.
80 8 Anne, ch. 19, § XI (Eng.).
Encouragement...81 The preamble to the Statute itself says merely that it is for the purpose of preventing piracy “and for the encouragement of learned men to compose and write useful books.”82 Nothing in the parliamentary debate indicates why the emphasis on the encouragement of learning came about. Moreover, the petitions presented to Parliament during the debates make “no reference to, or even tacit support of, the encouragement of learning.”83 Rose, however, states that the “priority given to the encouragement of learning” was a direct result of a series of articles published in 1709 by Daniel Defoe and Joseph Addison arguing that the rights of authors had to be protected.84 But irrespective of who was responsible for it, this justification for copyright quickly found favor with Parliament and would ultimately find its way into the Intellectual Property Clause.

Regardless of its title, more than anything else, the Statute of Anne was a trade-regulation statute, aimed at controlling and limiting the rampant monopolies then extant in the booksellers trade. Its purpose was to act “in the interest of society by preventing monopoly, and in the interest of the publisher by protecting public works from piracy.”85 Although there is nothing to indicate that Parliament literally intended it as such, it would ultimately come to be judicially interpreted as providing for an author’s right. It was in the context of this interpretation that it would serve as an antecedent, along with the Statute of Monopolies, for the Intellectual Property Clause.

One immediate consequence of the Statute was that “the traditional character of the stationers’ copyright was radically altered by the introduction of a limited term.” Not surprisingly, the stationers and the booksellers strongly argued against the concept of a limited term,86 and:

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81 See FEATHER, supra note 66, at 59 (quoting the Preamble to the Bill which became the Statute, 8 Anne, ch. 19 § VI (Eng.)). Whether printing piracy encouraged or discouraged learning was a matter of perspective, depending on whether one was a reader seeking access to low-cost books or an author and/or publisher seeking a return on investment in the writing.
82 MELVILLE B. NIMMER AND DAVID NIMMER, 8 NIMMER ON COPYRIGHT App. 7-5 (1999) (citing statute of Anne, 1710, 8 Anne, Ch. 19 (Eng.)).
83 FEATHER, supra note 66, at 60.
84 ROSE, supra note 75, at 42.
85 PATTERSON, supra note 64, at 14. In this context, Patterson used the phrase “public works” to mean only works that were published and not works that had entered the public domain.
86 See supra text accompanying note 78.
When the issue of limiting the term of protection arose, the booksellers objected that, if they had a property in their copies, they had it forever. This assertion rested on the claim that theirs was a common law right based on ancient trade practice. Thus the question of whether a limited term was compatible with a common law right was introduced.\textsuperscript{87}

But almost six decades would pass before a common law court would specifically be called upon to answer the twin questions of whether authors or their assigns retained a perpetual property right at common law in their writings after their publication and what effect the Statute of Anne had on any such property right.\textsuperscript{88} The case was \textit{Millar v. Taylor},\textsuperscript{89} decided in 1769. But before reviewing that case, it is useful to briefly review why these issues were before the court.

Simply put, the stationers’ company had acted so effectively to protect copyright over the long years that its registration system was in effect, that protection afforded by registration had come to be perceived as a form of property.\textsuperscript{90} Indeed, the power of the stationers to protect the rights afforded by registration had been recognized repeatedly by both crown ordinance and parliamentary act through almost all of the seventeenth century, such that there was arguably a good ground for holding that a right of copyright existed at common law.\textsuperscript{91}

The right to copy also arose from royal patents granting an exclusive right to print. These patents were dependent on the royal prerogative which

\textsuperscript{87} ROSE, supra note 75, at 45.

\textsuperscript{88} The issue was first clearly raised and argued in \textit{Tonson v. Collins}, 96 Eng. Rep. 169 (K.B. 1759). There were actually two hearings before the King’s Bench in this case, in 1759 and 1760, but the case was apparently dismissed as collusive (as indeed it was) without a final determination being made. ROSE, supra note 75, at 76-78; and FEATHER, supra note 66, at 83-86.

\textsuperscript{89} 98 Eng. Rep. 201 (K.B. 1769). As the official reporter put it, at issue was an “old and often-litigated question... [of which the case was]... the first determination which the question ever received, in this Court of King’s Bench.”

\textsuperscript{90} The content of this and the next two paragraphs is taken largely from HOLDSWORTH, supra note 69, at 378-79.

\textsuperscript{91} Indeed, a fundamental aspect of the definition of common law is that it is law predicated on custom and usage as well as court decision. However, in analyzing the Statute of Anne, Patterson argues that neither the custom and usage of the stationers’ company with respect to the registration right nor the express language of the Statute provide support for the view that a common law right to copyright came to exist in authors. PATTERSON, supra note 64, at 143-50. Abrams emphatically takes the same position. Abrams, supra note 73.
conferred a privilege and not a common law property right as such. The issue was further complicated by the fact that, as a practical matter, both the rights gained by registration and by patent were routinely sought to be protected in the early part of the seventeenth century by the courts of High Commission and Star Chamber,92 and in the latter part of the century by the remedies provided under the licensing acts. This recourse to other than common law remedies93 gave rise to the view that copyright was not so much a property right recognized at common law, as it was a right dependent upon royal grant exercised directly in favour of a patentee, or indirectly through the powers conferred by the crown upon the company.

During the seventeenth century, almost all the copyright cases reported turned on the rights of royal patentees. As a result, the right was treated rather straightforwardly by the courts as dependent on the royal grant. But the fact that there were no reported cases of common law actions for infringement of copyright prior to the Statute of Anne94 is not conclusive that such a remedy was not perceived to exist, but merely of the fact that more convenient remedies were available.

Be that as it may, by 1760 when Tonson v. Collins was argued but not decided,95 the debate on the meaning of copyright had become inextricably intertwined with more fundamental arguments concerning property itself. As has been nicely summarized:

The gradual exploration of the meaning of the concept of copyright was therefore caught up in a wider debate about

92 Both of which were crown [conciliar] courts and not common law courts.
93 It should be recalled that until a common law court actually held that a common law property right existed, no common law remedy could be applied. It would not be until the second half of the eighteenth century that a common law court would so hold. See Millar v. Taylor, 98 Eng. Rep. 201 (K.B. 1769) (holding that a common law property right existed). More pragmatically, as was pointed out in the petitions seeking parliamentary protection of copyright in the first decade of the eighteenth century, an action for damages was a wholly inadequate remedy, for by the common law, a book-seller can recover no more costs than he can prove damage; but it is impossible for him to prove the tenth, nay perhaps the hundredth part of the damages he suffers; because a thousand counterfeit copies may be dispersed into as many different lands, and he is not able to prove the sale of ten.

HOLDSWORTH, supra note 69, at n.377.
94 Holdsworth notes a common law opinion in the middle of the nineteenth century which states that "no record of an action on the case for infringement of copyright prior to the Statute of Anne has been found" but suggests that one or two cases are known to have been commenced without reported result. HOLDSWORTH, supra note 69, at n.379.
95 See supra note 88 (discussing Tonson v. Collins).
the nature of property itself. On the one hand, there was the prevalent view that property was a natural right, partially ceded to the state, which could be created and, having been created, existed in perpetuity. On the other, there was the view that all property derived from the Crown, and was therefore subject to the authority of the Crown and its agents, including laws made by the Crown-in-Parliament.6

However, the question remained: which concept of property would be controlling with respect to defining copyright?

The facts of Millar v. Taylor were straightforward. Millar had been assigned the copyright to a particular book, printed two thousand copies, and placed them on sale. Taylor, at the expiration of the statutory copyright term, proceeded to print and sell the same book. Millar argued at trial that

[t]here is a real property remaining in authors, after publication of their works; and . . . they only, or those who claim under them, have a right to multiply the copies of such their literary property, at their pleasure for sale . . . this right is a common law right, which always has existed, and does still exist, independent of and not taken away by the statute.97

A majority of the four judge panel, including Lord Mansfield, held that a perpetual property right based on common law existed. Mansfield dismissed the Statute of Anne with the remark that “[w]e are considering the common law, upon principles before and independent of that Act.”98 For the first time, he used the phrase “incorporeal substance” to describe the property right found in copyright. He went on to state that “it is just that an author should reap the pecuniary profits of his own ingenuity and labour; it is just that another should not use his name without his consent.”99

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96 Feather, supra note 66, at 86.
99 MacLeod, supra note 37, at 199 (quoting Millar v. Taylor, 98 Eng. Rep. 201, 252 (K.B. 1769)) (emphasis added). MacLeod argues that with no custom to guide him, Mansfield had turned to natural law. Id. Feather contended that Mansfield “took a firm historically based view that all the precedents,
Just or not, five years later in *Donaldson v. Becket*, the House of Lords decided that whatever may have been the case originally at common law, the Statute of Anne effectively limited the term for which copyright could be enforced at common law to a maximum of twenty-eight years. During the debate in *Donaldson* Lord Chief Justice De Grey could not accept the argument made by Mansfield in *Millar v. Taylor* that a perpetual property right should exist because it was just that it exist. According to De Grey, "[t]his idea of moral fitness is indeed an amiable principle and one cannot help wishing all claims derived from so pure a source might receive all possible encouragement." But "[b]eautiful as it may be in theory, to reduce it into the practice and execution of the common law would create intolerable confusion; it would make laws vain, and judges arbitrary." To this day, what was actually decided in *Donaldson* remains a subject of considerable dispute among scholars and commentators. On a very pragmatic level, the House of Lords did "no more than to declare that copyright henceforth would be limited in term." But there were other questions of significant interest raised by the case, to wit:

But on what basis did the peers make their determination? What understanding of the nature of copyright did they adopt? Were they persuaded that there never was a common-law right? Or did they believe that there was but that it ended with publication? Or that it was taken away by the statute?

One commentator suggests that although the law lords did indeed discuss the principles involved, they couched their holdings in terms of precedent and

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100 Also frequently referred to as "Beckett." 4 Burr. 2408 (1774); see also COBBETT, 17 PARL. HIST. ENG. at cols. 954-1003 (H.L. 1774).

101 INLOW, supra note 97, at 67 (quoting COBBETT, supra note 100, at 990).

102 ROSE, supra note 75, at 103.

103 Id. at 102.
not whether an inherent or natural law right ought to prevail. A second commentator in turn, argues that the lords "grounded their decision on the position that copyright had never existed as a right at common law." A third commentator says merely that: "In general, all agreed that the 1710 Act superseded whatever common law might have existed before that time."

Of more immediate interest for the purpose of the present work is the manner in which *Donaldson* was perceived in the following decades when the Constitution was drafted and American copyright law came into being. To understand this perception, it is useful to look at the facts of the case as well as how it was reported. Although not technically so, *Donaldson* was in effect an appeal of the determination in *Millar v. Taylor*. Millar had sold his copyright at issue in *Millar v. Taylor* to Becket who had had it pirated by Donaldson. Becket immediately obtained an injunction against Donaldson, and the latter appealed to the House of Lords.

The manner in which the House of Lords functioned at this time as a court of last resort has been set forth as follows:

In 1774 the House of Lords decided cases by a general vote of the peers, lawyers and laymen alike. Great weight was usually given to the opinions of the lawyers, but the practice of lay peers not being recognized when the House of Lords set as a court had not yet been instituted. In important cases such as *Donaldson v. Becket*, however, the twelve common-law judges of the realm—the judges of King’s Bench, Common Pleas, and the Exchequer—would be summoned to the House to hear the arguments of counsel and to give their advice on matters of law, after which the peers would debate the issue and vote.

This was exactly what occurred in *Donaldson*. The common law judges were asked to answer five specific questions posed by the peers, to wit:

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104 MACLEOD, supra note 37, at 199.
105 Abrams, supra note 73, at 1157.
106 FEATHER, supra note 66, at 92.
107 ROSE, supra note 75, at 95; FEATHER, supra note 66, at 89.
108 ROSE, supra note 75, at 97-98.
1. Whether at common law, the Author of any Literary composition had the sole first Right of printing and publishing the same for Sale, and could bring an Action against any Person for publishing the same, without his consent?

2. If the Author had such right originally, did the Law take it away upon his printing and publishing the said literary composition, or might any Person reprint and publish the said literary composition, for his own Benefit, against the Will of the Author?

3. If such Action would have laid at Common Law, is the same taken away by the Statute of Anne? Or is an Author precluded by such Statute from any Remedy, except on the foundation of such Statute?

4. Whether the Author of any literary Composition, or his assigns, had the sole Right of printing and publishing the same in perpetuity by the Common Law?

5. Whether this Right is in any way impeached, restrained or taken away by the 8th of Anne?¹⁰⁹

Eleven of the judges answered these questions. Mansfield, who was both a common law judge and a peer, declined to do so. However, because of the position he had taken in Millar v. Taylor, it was generally assumed that he would have answered them in a manner favoring a common law right in perpetuity.¹¹⁰

Perhaps it was to be expected that the judges would split in their views. On the first question of whether a common law right existed, eight voted affirmatively. On the second question as to whether publication adversely affected the right, seven answered affirmatively. On the third question, there is some confusion in the record. Both the Journal of the House of Lords and the standard historical references indicate that by a slim majority of six to five the judges were of the opinion that the Statute took away the author's right at common law. However, contemporary newspaper reports and other

¹⁰⁹ Feather, supra note 66, at 90-91.

¹¹⁰ See Rose, supra note 75, at 99 (noting that Mansfield's position in Miller v. Taylor supports this view).
accounts indicate the vote was six to five the other way, and that the clerk of the House made an error in tallying the votes.\footnote{\textit{Rose}, \textit{supra} note 75, at 98-99.}

Modern commentators give conflicting views on what these answers and the accompanying advisory opinions by the judges meant, although they would undoubtedly all agree with the statement that "[d]etermining the grounds for decision in \textit{Donaldson v. Becket} is no simple task."\footnote{\textit{Abrams}, \textit{supra} note 73, at 1156.} Thus, Patterson & Lindbergh indicate that based on these opinions, "American courts and commentators assumed that (and have since acted as if) the House of Lords had held that the author had a common law copyright."\footnote{L. \textsc{Ray} \textsc{Patterson} \& \textsc{Stanley} \textsc{W. Lindbergh}, \textsc{The Nature of Copyright} \textsc{37} (1991).} Abrams phrases it somewhat differently, saying that, based on the opinions, "\textit{Donaldson} has been consistently interpreted as holding that copyright was recognized by the common law, but was ‘impeached’ or preempted by the Statute of Anne."\footnote{\textit{Abrams}, \textit{supra} note 73, at 1156.} But, according to Feather: "the judges were rather more decisive than some of the more ambiguous responses might suggest. In general, all agreed that the 1710 Act superseded whatever common law might have existed before that time."\footnote{\textit{Feather}, \textit{supra} note 66, at 92.} Rose, however, has quite a different perspective, suggesting that "[h]ad Mansfield voted, the tally would have been a substantial seven to five in favor of the common law right surviving the statute."\footnote{\textit{Rose}, \textit{supra} note 75, at 99.}

All agree, however, that views expressed by the common law judges were advisory only and not binding in any way on the lords. The decision was by vote of the entire House, and "the floor debate appears to have been very important."\footnote{\textit{Id.}} But the content of that debate was not officially reported, because the reporters were constrained by law from reporting it.\footnote{\textit{Id.}} Thus, the most commonly cited report on the case, \textit{i.e.}, the fourth edition of Burrow’s Reports, makes no mention of the debate, but instead reports only the arguments of counsel, the advisory opinions of the common law judges, and the decision against the continuance of the injunction against Donaldson. The issue was further confused by the fact that Burrow appended his report
\footnote{As pointed out by Abrams, "At the time of the \textit{Donaldson} decision it was a contempt punishable by imprisonment to publish any statements made by a member of Parliament in the course of parliamentary business." \textit{Abrams}, \textit{supra} note 73, at 1159.}
on Donaldson v. Becket at the end of his much longer and much more detailed report on Millar v. Taylor. 119

There are three accounts extant, however, which do include statements made during the debate by the peers. 120 They indicate that five of them actually spoke, with four of them arguing against any common law copyright and one speaking in favor of such a right. For reasons known only to him, Mansfield declined to voice his opinions. When the issue came to a vote, the peers decisively supported a reversal of the Chancery decree upholding the injunction. 121 The literal effect was simply to reverse the ruling in Millar v. Taylor, but, as has been rather artfully stated, "when we ask what doctrine, precisely, the Lords preferred to that which had been cast aside, Clio (that coy muse) simply shrugs." 122

What was developed in the years after 1774 was the belief that Donaldson had established that there was indeed a common law property right in copyright, but one which had been merged into and could only be enforced in accordance with the Statute of Anne. 123 Be that as it may, based on

119 Abrams, supra note 73, at 1159-60.
120 Id.
121 The vote is commonly stated as twenty-two to eleven in favor of reversing the decree, based on the report by Cobbett. See Abrams, supra note 73, at 1164 (citing to 17 Parl. Hist. Eng. 953, 1003 (H.L. 1774)). Rose, while noting this report by Cobbett, states that "neither the Journal of the House nor the contemporary newspapers indicate a formal division of the House, and the Public Advertiser explicitly says there was no division (23 Feb. 1774)." He suggests that the decision was most likely rendered on a voice vote. ROSE, supra note 75, at 102.
123 ROSE, supra note 75, at 108-110; FEATHER, supra note 66, at 95. This was certainly the view set forth by Blackstone in 1775 and thereafter in his Commentaries on the Common Law, which would have been the primary source of information for Americans on recent English copyright development. The fourth, fifth, and sixth editions, published in 1770, 1773, and 1774, all contained the following footnote: "In the case of Millar v. Taylor . . . , it was determined (upon solemn argument and great consideration) by the opinion of three judges to one, that an exclusive copyright in authors subsists by the common law. . . ." In his seventh edition, published in 1775, and in all later editions, he added the following sentence: "But afterwards in the case of Donaldson v. Becket, before the House of Lords . . . it was held that no copyright subsists in authors, after the expiration of the several terms created by the statute of Queen Anne." Whicher, supra note 122, at 126 n.72. Because of the American Revolution, the seventh and subsequent editions were not widely circulated in the United States before the constitutional convention, but a reprint of the fourth edition published by Robert Bell in 1770-71, and reissued in 1774, did achieve wide circulation. It is on this basis that Whicher argues that the Framers were aware of the holding in Millar v. Taylor, but not that in Donaldson v. Becket. Id. at 135. Abrams, in turn, suggests that knowledge of Donaldson v. Becket was in fact available in the United States before 1787 and was, at least by implication, known to the Framers. Abrams, supra note 73, at 1177.
perspectives of common law property right in copyright, arguments would be made that there is no logical distinction between literary works and invention, in that both involve the use of the mental facility and the ideas derived from such should result in similar property rights. But the life of the law is not always logic. Thus, in Donaldson it was the lack of a common law property right in invention which provided a fixed point in the debate about common law property in copyright. Those who argued for such property in perpetuity deemed themselves obligated to distinguish between literary work and invention, whereas those who denied it found themselves arguing that the two were analogous. While two of the law lords were prepared to admit the possibility that “previous to the monopoly statute, there existed a common law right, equally to an inventor and the author of a book,” they argued that the only property right that existed after the Statute of Monopolies and once an invention was disclosed to the public was that granted by the crown for a limited time in the form of a patent.

With this in mind, Baron James Eyre opined that the “Exactitude... of the Resemblance between a Book and any other mechanical Invention” was clear:

There is the same Identity of intellectual Substance; the same spiritual Unity. In a mechanic Invention the Corporation of Parts, the Junction of Powers, tend to produce some one End. A literary Composition is an Assemblage of Ideas so judiciously arranged, as to enforce some one Truth, lay open some one Discovery, or exhibit some one Species of mental Improvement. A mechanic Invention, and a literary Composition, exactly agree in Point of Similarity; the one therefore is no more entitled to be the Object of Common Law Property than the other.

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124 Oliver Wendell Holmes, The Common Law 5 (M. Howe ed., 1963). Holmes actually wrote, “The life of the law has not been logic: it has been experience.”

125 The same point was made in Millar v. Taylor wherein Justice Yates, dissenting, argued that it was well-known that no common law property right existed in mechanical inventions once they were published. 98 Eng. Rep. at 218.

126 MacLeod, supra note 37, at 198 (citing Mutton, History of Birmingham at 93).

127 The Cases of the Appellants and Respondents in the Cause of Literary Property, Before the House of Lords, in The Literary Property Debate: Six Tracts 1764-1774 34 (Stephens Parks ed., 1974).
In his view it was plain that the Statute of Anne treated copyrights similarly to patents. Likewise, Lord Camden gave as his opinion that copyrights should not be distinguished from patents in that there was no real difference between authors and inventors, and both were beneficial to society. Because no common law claim could be made for inventors, none should be made for authors.128

Beginning with *Tonson v. Collins* and continuing through *Donaldson v. Becket*, the arguments have been summarized as follows:

First, the proponents of perpetual copyright asserted, the author's natural right to own his creation. Second, their opponents replied that ideas could not be treated as property and that copyright could only be regarded as a limited privilege of the same sort as a patent. Third, the proponents responded that the property claimed was neither the physical book nor the ideas communicated by it but something else, an entity consisting of the style and sentiment combined.129

As a practical matter, those who argued that a copyright was similar to a patent ultimately prevailed, but this was not immediately apparent in the young United States.

Unlike the situation with the patent term where Parliament not infrequently acted to extend the term, there seems to have been no instance in the eighteenth century after the Statute of Anne was enacted wherein Parliament ever sought to extend the term of a copyright beyond the maximum of twenty-eight years set by the Statute. In England in the eighteenth century there is nothing to indicate that the terms of patents or copyrights were in any way based on the life expectancy of the inventor or author. While the Statute of Anne granted an automatic right of renewal for an additional term, such could only occur if the author was still living at the end of the initial fourteen-year term.

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128 *Id.* at 53-54.
129 ROSE, *supra* note 75, at 91.
At the time the Framers drafted the Constitution in 1787 they were aware of more than merely the British patent and copyright practice which they desired to give Congress the power to emulate. Thus, they were fully cognizant that under the Articles of Confederation, Congress had no power with respect to either patents or copyrights. The problem resided in Article II thereof, which read: “Each State retains its sovereignty, freedom and independence, and every power, jurisdiction and right, which is not by this confederation expressly delegated to the United States, in Congress assembled.”

The use of the term “expressly” in Article II was what made it so supremely restrictive of the authority of the national government, i.e., “the United States, in Congress assembled.” For by the literal language of Article II, if a power, jurisdiction, or right was not expressly delegated to Congress, that authority could not be exercised by it. It was for this reason that the Continental Congress never attempted to legislate with respect to patents or copyrights or to grant any form of exclusive rights to inventors in their inventions or authors in their writings. The power to do so was simply not delegated to Congress by the Articles.

If the Continental Congress had no power to legislate with respect to or grant patents and copyrights, it could recommend that the individual states take action in such regard. While it never presented any recommendations concerning patents, it did resolve on May 2, 1783:

That it be recommended to the several states, to secure to the authors or publishers of any new books not hitherto printed, being citizens of the United States, and to their . . . executors, administrators and assigns, the copyright of such books for a certain time, not less than fourteen years from the first publication; and to secure to the said authors, if they shall survive the term first mentioned, and to their . . . executors, administrators and assigns, the copyright of such books for another term of time not less than

130 ARTICLES OF CONFEDERATION, art. II.
fourteen years, such copy or exclusive right of printing, publishing and vending the same, to be secured to the original authors, or publishers, or . . . their executors, administrators and assigns, by such laws and under restrictions as to the several states may seem proper.\textsuperscript{131}

Perhaps the most striking feature of this congressional resolution is that it recommends a floor of at least fourteen years for the term of the copyright but suggests no ceiling whatever. Apparently, insofar as the Continental Congress was concerned, there was no objection if a state wanted to issue a copyright in perpetuity; the concern was that the copyright term not be too short, rather than that it might be too long. This is a significant distinction from what would be incorporated into the Constitution four years later, namely, the power to enact laws securing to writers the exclusive right to their works “for limited times.”

The resolution says not a word about any justification for copyright. But a March 10, 1783 resolution creating the committee that proposed it stated the purpose of the committee to be “to consider the most proper means of cherishing genius and useful arts through the United States by securing to the authors or publishers of new books their property in such works.”\textsuperscript{132} The committee presented its recommendation resulting in the resolution to the states after “being persuaded that nothing is more properly a man’s own than the fruit of his study, and that the protection and security of literary property would greatly tend to encourage genius, to promote useful discoveries and to the general extension of arts and commerce.”\textsuperscript{133}

The committee language is of interest both for what it says and for what it does not say. It clearly seems to adopt the natural law view that writers have an inherent property right in their works. It also seems to confuse the role of copyrights and patents in assuming that copyright will in and of itself “promote useful discoveries.” But it says nothing about the promotion of learning, which was stated to be a primary purpose of copyright in the

\textsuperscript{131} Bugbee, supra note 31, at 113 (quoting XXIV Journals of the Continental Congress 326-27 (1928)).

\textsuperscript{132} Id. at 112 (citing Continental Congress Papers, No. 36, II, fols. 113-114).

\textsuperscript{133} Id. at 113 (citing XXIV Journals of the Continental Congress 326, n.211 (1928)). In light of his role in creating the Intellectual Property Clause four years later, it is of interest to note that James Madison was a member of this committee.
INTELLECTUAL PROPERTY TERM LIMITS

Statute of Anne. Nor does it make any reference to copyright being a common law property right.

The May 2, 1783 resolution is limited to copyright and says nothing about letters patent for invention. Yet the remarkable thing about the committee language quoted above is that if the phrase “literary property” were replaced with “property in invention,” it would have provided an equally admirable justification for a congressional recommendation that the states protect the rights of inventors “by such laws and under such restrictions as the several states may deem proper.” Obviously, this did not occur, possibly because of a mistaken belief that copyright would encourage discovery and protect property rights in invention. More likely, however, inventors had at this point in time made no concerted effort to seek protection of supposed property rights in their inventions, whereas “sundry papers and memorials from different persons on the subject of literary property” had been submitted to the Continental Congress by early 1783.134

Between the beginning of 1783 and the close of 1786 twelve states enacted general copyright statutes,135 although the suggestion has been made that these statutes apparently never became operative.136 As a practical matter, all the states adopting copyright statutes limited the term to either that set forth in the Statute of Anne or set a fixed term of twenty or twenty-one years. No state was disposed to view copyright as creating a perpetual property right.

The Massachusetts statute had an eloquent preamble which, by today’s standards, could fully as well have served as a justification for a patent statute.137 It read:

Whereas the Improvement of Knowledge, the Progress of Civilization, the public Weal of the Community, and the Advancement of Human Happiness, greatly depend on the Efforts of learned and ingenious Persons in the various Arts

134 Id. at 112 (quoting from XXIV JOURNALS OF THE CONTINENTAL CONGRESS 326 (1928)).
135 Id. at 117; see also PATTERSON, supra note 64, at 183-84. The state acts are reproduced in 8 NIMMER & NIMMER, supra note 82, at app. 7-1 - 7-40. Six of these enactments occurred in 1783, with three of them, those of Connecticut, Massachusetts, and Maryland, actually preceding the congressional resolution. Only Delaware failed to comply with the congressional recommendation.
136 PATTERSON, supra note 64, at 181. I have been unable to find a reference to any copyright issued under these state statutes.
137 But a word of caution is in order in that it is frequently misleading to seek to apply today’s standards and interpretations to language written in the eighteenth century.
and Sciences: As the principal Encouragement such Persons can have to make great and beneficial Exertions of this Nature must exist in the legal Security of the Fruits of their Study and Industry to themselves; and as such Security is one of the natural Rights of all Men, there being no Property more peculiarly a Man's own than that which is produced by the Labour of his mind.138

This same preamble was copied into the acts of Rhode Island and New Hampshire.139 The preamble to North Carolina's act expressed similar sentiments although more succinctly.140 But neither Massachusetts nor any other state enacted a general patent statute assuring the right of inventors to obtain exclusive rights in their inventions for some limited period of time.

One state, however, did address the issue, but did so in the context of its copyright statute. In 1784, South Carolina enacted a copyright law which contained the following clause: “The Inventors of useful machines shall have a like exclusive privilege of making or vending their machines for the like term of fourteen years, under the same privileges and restrictions hereby granted to, and imposed on, the authors of books.”141 It is unclear whether the fourteen-year term was taken from the Statute of Monopolies or from the Statute of Anne.142

Whereas the general legislative enactments, with the exception of that of South Carolina, were limited to copyright, after the end of the Revolutionary War various states began to grant patents to inventors for their

138 BUGBEE, supra note 31, at 114 (quoting ACTS AND LAWS OF THE COMMONWEALTH OF MASSACHUSETTS 236 (1781-83)); 8 NIMMER & NIMMER, supra note 82, at app. 7-15.

139 PATTERSON, supra note 64, at 187.

140 It read:

Whereas Nothing is more Strictly a Man's own than the Fruit of his Study, and it is proper that Men should be encouraged to pursue useful Knowledge by the Hope of Reward; and as the Security of literary Property must greatly tend to encourage Genius, to promote useful Discoveries and to the general Extension of Arts and Commerce... .

PATTERSON, supra note 64, at 187; see also BUGBEE, supra note 31, at 119 (quoting LAWS OF THE STATE OF NORTH CAROLINA 563-64 (J. Iredell ed., 1791)). This language closely followed that of the congressional committee in 1783. See supra text accompanying note 133 (quoting the similar language of the congressional committee).

141 BUGBEE, supra note 31, at 93; see also 8 NIMMER & NIMMER, supra note 82, at app. 7-29.

142 But as has been earlier suggested, the initial fourteen-year term of the Statute of Anne was likely taken from the patent term authorized by the Statute of Monopolies. See supra text accompanying note 75 (describing a bill on the patent term).
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inventions through private laws and acts.\textsuperscript{143} It is difficult to know exactly how many state patents were actually granted, but the number is unlikely to have exceeded forty.\textsuperscript{144} The terms of these state patents varied from five years to twenty-one years, with the term increasingly being fourteen years, apparently patterned after the British practice.\textsuperscript{145} Clearly, the states had determined to limit the term of any patent grant in much the same fashion as had occurred in Great Britain and for many of the same reasons.

In 1787 the Framers were undoubtedly aware of both the state enactments concerning copyright and the state practices regarding the issuance of patents. These practices and enactments, along with the British practice, were part of the immediate backdrop to the constitutional convention. As evidenced by the ultimate content of the Intellectual Property Clause, they were quite prepared to give Congress power to act with respect to patents and copyrights, but at least initially this deference was not high on their list of priorities.\textsuperscript{146} It was not until August 18, 1787 that the proposals which would ultimately be transformed into the Intellectual Property Clause were presented to the convention.

\textsuperscript{143} The term "patents" is used as a convenient shorthand for what was actually occurring. It must be understood that the granting of limited-term exclusive rights did not usually result in the issuance of anything called a "patent." Only after the enactment of federal patent legislation would private acts or laws granting such rights begin to be referred to as patents. Thus, early state patentees always referred to their state grants as their "laws" or "acts" rather than as their patents.

\textsuperscript{144} Bugbee, the best extant source, lists some twenty-three state patents as having been granted between 1779 and 1791. He lists no state patents after 1791, but does indicate that several states continued to issue patents into the early nineteenth century. BUGBEE, supra note 31, at 85-103. Bugbee, however, limits his coverage to so-called patents of invention and excludes patents of importation, even though during this period novelty was not precluded merely because the subject matter of the grant had been previously known and practiced elsewhere. Inlow suggests that it was only in Connecticut and Massachusetts that patents of importation continued to be granted. INLOW, supra note 97, at 43. Federico refers to some twenty-two state patents, but they are not necessarily the same as those discussed by Bugbee. P.J. Federico, State Patents, 13 J. PAT. OFF. SOC'Y 166, 166-72 (1931). Westcott, however, lists nine Pennsylvania patents alone. T. WESTCOTT, LIFE OF JOHN FITCH n.173 (1878). At least one more Pennsylvania patent should be included because Westcott fails to mention the patent to Henry Guest referenced by Bugbee. See BUGBEE, supra note 31, at 85-87 (noting the patent granted to Guest for the sole right to make and sell blubber in New Jersey).

\textsuperscript{145} Only one patent, issued in Pennsylvania, is known to have had a term as long as twenty-one years. Depending on the state, most terms were for five years, seven years, ten years, fourteen years, and in a few instances for fifteen years. BUGBEE, supra note 31, at 85-103.

On that date, the Journal of the Convention lists twenty additional powers “proposed to be vested in the Legislature of the United States,” which include the following:

To secure to literary authors their copy rights for a limited time; To encourage, by proper premiums and provisions, the advancement of useful knowledge and discoveries; To grant patents for useful inventions; To secure to authors exclusive rights for a certain time; [and] To establish public institutions, rewards, and immunities for the promotion of agriculture, commerce, trades, and manufactures. 147

Madison’s Notes indicate that he and Charles Pinckney presented these proposals. 148

Several aspects of the proposals relating to patents and copyrights are of interest. First of all, the reference to “patents” clearly indicates an intent to give Congress power to emulate and follow the British practice of granting limited-term exclusive rights to inventors in their inventions. 149 Secondly, unlike in the context of copyright, there is no specific reference to either “a limited time” or “a certain time” as the term of a patent. The reason for this is that, unlike the case with copyright, there was no uncertainty as to whether the patent term was limited. The Statute of Monopolies clearly indicated that it was limited, 150 and there was thus no need to specifically require a limited time as long as there was a specific reference to “patent.”

148 JAMES MADISON, NOTES ON DEBATES IN THE FEDERAL CONVENTION OF 1787 477-78 (1966). Madison’s notes indicate that on August 18:

Mr. Madison submitted in order to be referred to the Committee of detail the following powers as proper to be added to those of the General Legislature . . . To secure to literary authors their copy rights for a limited time . . . To encourage by premiums & provisions, the advancement of useful knowledge and discoveries . . .

These propositions were referred to the Committee of detail which had prepared the Report and at the same time the following which were moved by Mr. Pinkney [sic]: in both cases unanimously[.] To grant patents for useful inventions [;] To secure to Authors exclusive rights for a certain time [; and] To establish public institutions, rewards and immunities for the promotion of agriculture, commerce, trades and manufactures . . .

149 See supra note 143. Recall that the state practice in this respect did not refer to these limited-term exclusive rights as “patents.”
150 See supra text accompanying note 32.
But it was unclear to the Framers whether there was in fact a perpetual common law property right in copyright or whether the Statute of Anne had limited the copyright term as set forth therein. What is clear is that both Pinckney and Madison did not want a perpetual copyright term but rather wanted something along the lines set forth in the Statute of Anne, that is to say, a limited term.\(^1\)

There is nothing to indicate how the August 18th proposals by Madison and Pinckney were transmogrified into the Intellectual Property Clause. Madison obviously knew, but never said, although it is quite likely that he authored it.\(^2\) To aid in understanding the clause, it is useful to turn to its grammatical form because the aesthetics of the form may have, in no small measure, influenced the actual language used. The clause is generally taken as an example of the balanced style of composition much favored in the eighteenth century,\(^3\) and generally viewed as “a consolidation of two proposals which got packaged together.”\(^4\) The manner in which the term “respectively” is used in the clause lends credence to this interpretation.\(^5\)

What is common to a balanced composition of the clause are the terms “promote,” “progress,” “securing,” and “limited times.” The usual interpretation is that Congress is given two separate powers involving the common use of these terms. In this view, it is given power (1) “to promote the progress of science . . . by securing for limited times to authors . . . the exclusive right to their . . . writings,” and (2) “to promote the progress of . . . useful arts by securing for limited times to . . . inventors the exclusive right to their . . .

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\(^1\) See supra text accompanying note 131. In Madison’s case, this would seem to have been a departure from views he apparently held as a member of the committee that proposed the congressional resolution of May 2, 1783 which contemplated no upper limit on the term of copyright.

\(^2\) See Walterscheid, supra note 146, at 50-51. Madison was a member of the Committee of Eleven which proposed the Intellectual Property Clause and Pinckney was not.

\(^3\) For various discussions of this balanced style of composition in the context of the clause, see, e.g., Arthur H. Seidel, The Constitution and a Standard of Patentability, 48 J. PAT. OFF. SOC’Y 5, 9 (1966); Giles S. Rich, The Principles of Patentability, 42 J. PAT. OFF. SOC’Y 75, 77-78 (1960); Karl B. Lutz, Patents and Science: A Clarification of the Patent Clause of the U.S. Constitution, 32 J. PAT. OFF. SOC’Y 83, 84 (1950); R.I. Coulter, The Field of the Statutory Useful Arts, 34 J. PAT. OFF. SOC’Y 487, 491 (1952); and De Wolf, supra note 64, at 15.

\(^4\) Rich, supra note 153, at 78.

\(^5\) But it is not the only one possible. Prager, while acknowledging that “respectively” may indeed serve “to correlate ‘writings’ with ‘science’ and ‘discoveries’ with ‘useful arts,’” also suggests that it may mean instead or in addition “that each new creation be considered individually and with precision and that it be distinguished from the work of contemporaries and predecessors.” Frank D. Prager, Historical Background and Foundation of American Patent Law, 5 AM. J. LEGAL HIST. 317 (1961).
discoveries." The balanced composition of the clause explains why the terms "patents" and "copyrights" do not appear therein.

A careful comparison of the actual language of the clause with the proposals submitted August 18th by Madison and Pinckney suggests that the conventional wisdom is wrong, and that the clause is actually a consolidation and incorporation of three separate and distinct proposals presented by Madison and Pinckney. The reference to securing to authors for limited times an exclusive right to their writings incorporates the essentially identical proposals first from Madison to secure to literary authors their copyrights for a limited time and second from Pinckney to secure to authors exclusive rights for limited times. The reference to securing to inventors for limited times an exclusive right to their discoveries incorporates Pinckney's proposal to grant patents for useful inventions. This much is generally accepted. What is not generally recognized is that the clause incorporates a third proposal, namely, Madison's proposal to encourage by premiums and provisions the advancement of useful knowledge and discoveries. This is closely similar to the actual language used, i.e., to promote the progress of science and useful arts. Clearly, this proposal by Madison is much broader in scope than the proposals to provide for patents and copyrights, and the incorporation of language closely analogous to it in the clause suggests that

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156 S.R. NO. 1979, 82d Cong. (1952) reprinted in 1952 U.S.C.C.A.N. 2394, 2396; H.R. REP. 1923, 82d Cong., (1952). See also In re Bergy, 596 F.2d 952, 958, 201 U.S.P.Q. (BNA) 352, 359 (C.C.P.A. 1979) ("Scholars who have studied this provision, its origins, and its subsequent history have, from time to time, pointed out that it is really two grants of power rolled into one; first, to establish a copyright system and, second, to establish a patent system"). The legislative history of the 1952 Patent Act describes the clause as two provisions merged into one. The purpose of the first provision is to promote the progress of science by securing for limited times to authors the exclusive right to their writings, the word "science" in this connection having the meaning of knowledge in general. The other provision is that Congress has the power to promote the progress of the useful arts by securing for limited times to inventors the exclusive right to their discoveries.

157 To use them would literally have destroyed the balanced composition. But compare Pollack's argument that the Framers deliberately refused to use the terms "patents" and "copyrights" because they did not want to limit or tie the clause to the technical meaning of these two terms. See Malla Pollack, Unconstitutional Inconstabiliy: The Intersection of the Intellectual Property and Commerce Clauses of the Constitution: Beyond a Critique of Shakespeare Co. v. Silstar Corp., 18 SEATTLE U. L. REV. 259, 290 (1995).

158 The deletion of "premiums & provisions" did nothing to change the broad import of this grant of power.
the Framers viewed the clause as providing more than merely power to grant patents and copyrights.159

The final draft of the Constitution appears on its face to have a last minute correction indicating a change of heart by the Framers concerning the meaning of “for limited times” in the Intellectual Property Clause. As originally written in the September 17th draft the clause contained the phrase “for a limited time.” This was corrected by drawing a line through the “a” and adding an “s” to “time” by a caret with the “s” above it. The impression is left from the document itself that this change was intended to give Congress authority to extend the term of the grant beyond that originally set.160 A look at the language of the clause as initially proposed on September 5th and incorporated into the Constitution on September 12th indicates, however, that the change was made to correct a typographical error in the final draft and to render the language consistent with that which had been earlier approved. Thus, no attempt was made to broaden the meaning of “limited time” at the close of the proceedings, even though the final draft may give such an impression.161

Although nothing in the contemporaneous record indicates why the Framers adopted the phrase “for limited times,” it can only be assumed that their intent was to give Congress some flexibility in setting both the patent and copyright term, while at the same time assuring that neither the patent grant nor the copyright grant could be in perpetuity. They likely took it for granted that Congress would set the term of the exclusive right along the lines followed in the British practice with respect to both patents and copyrights.162 In any case, they determined that ultimately the subject matter of both the patent grant and the copyright grant must become a part of the public domain.

The Framers must be presumed to have been aware of the British practice of granting patent term extensions and of the term renewal for copyright

159 See Walterscheid, supra note 11. I have elsewhere suggested that the clause is inartfully phrased and that it should be read as: “The Congress shall have power . . . to promote the progress of science and useful arts (including) by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”
160 George Ramsey, The Historical Background of Patents, 18 J. PAT. OFF. SOC’Y 6, 14 (1936).
161 Walterscheid, supra note 146, at 53-54.
162 As Joseph Story put it: “It was doubtless to [their] knowledge of the common law and statutable rights of authors and inventors, that we are to attribute this constitutional provision [i.e., the Intellectual Property Clause].” JOSPEH STORY, III COMMENTARIES ON THE CONSTITUTION OF THE UNITED STATES § 1147 (Fred B. Rothman & Co. 1991) (1833).
authorized in the Statute of Anne. It can safely be assumed that by using the phrase “for limited times” they contemplated that Congress should have similar authority. Thomas Jefferson certainly assumed this to be the case and did not like it at all. Thus, in August 1789 he informed Madison that he preferred a provision in the proposed Bill of Rights stating: “Monopolies may be allowed to persons for their own productions in literature and their own inventions in the arts for a term not exceeding—years but for no longer term and no other purpose.” Such language would clearly have precluded term extension and term renewal. Jefferson also assumed that Congress had discretion in setting the term of patents and copyrights. Thus only a month later in September 1789, for reasons peculiarly his own, he asked Madison to seek to have the patent and copyright term in the new United States law be longer than that set forth in the contemporaneous British practice “by securing the exclusive right for 19. instead of 14. years.”

V. POWERS AND LIMITATIONS

The phrase “for limited times” is clearly a limitation on the power to grant exclusive rights to authors and inventors in their writings and discoveries. There is clearly some term of the grant beyond which Congress cannot constitutionally proceed. But what is it and how is it to be determined? The Supreme Court has addressed the meaning to be given to “for limited times” only in an indirect sense. In 1829 in Pennock v. Dialogue, Justice Story referred to this language, saying: “It contemplates . . . that this exclusive right shall exist but for a limited period, and that the period shall be subject to the discretion of [C]ongress.” In more recent times, the Court has stated that “Congress may not create patent monopolies of unlimited duration. . . .”

Nonetheless, the discretion afforded to Congress with respect to the patent and copyright term is not unbounded, and Justice Story does not
provide support for any view that courts may not interpret the meaning to be given to "for limited times." In *Pennock*, he made the following point:

The words of our statute are not identical with those of the statute of James, but it can scarcely admit of doubt, that they must have been within the contemplation of those by whom it was framed, as well as the construction which had been put upon them by Lord Coke.

Although these words refer to the language of the patent statute, there is little doubt but that they are fully applicable to the language of at least the patent provision of the Intellectual Property Clause. It is thus useful to recall what Lord Coke had to say about the patent term as set forth in the Statute of Monopolies. He argued that the patent privilege was proper as long as it was for "a convenient time" which he perceived as the time required to bring a "new manufacture" into free practice in the realm. Simply put, in interpreting the patent term Story agreed with Coke that it should be interpreted as providing a term adequate to encourage the social progress at the root of the patent system but no longer.

In his Commentaries, published four years after his *Pennock* opinion, Story made the point clear with regard to both the patent and the copyright term by his statement that short terms are beneficial in that they "admit the people at large, after a short interval, to the full possession and enjoyment of all writings and inventions without restraint" (emphasis added).

In the context of the copyright provision, the Supreme Court in 1975 in *Twentieth Century Music Corp. v. Aiken* emphasized that:

The limited scope of the copyright holder's statutory monopoly, like the limited copyright duration required by

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168 Justice Story was referring to the Patent Act of 1793.
169 The statute of James is The Statute of Monopolies.
171 See supra text accompanying note 36.
172 See supra text accompanying notes 40-41.
173 Coke could not—and did not—speak to the copyright system because that system had yet to be created by the Statute of Anne.
the Constitution, reflects a balance of competing claims upon the public interest: Creative work is to be encouraged and rewarded, but private motivation must ultimately serve the cause of promoting broad public availability of literature, music, and the other arts.\textsuperscript{175}

In so stating, the Court noted that Lord Mansfield's statement of the problem, now more than 200 years ago, bears repeating:

\[\text{W}e\ must\ take\ care\ to\ guard\ against\ two\ extremes\ equally\ prejudicial;\ the\ one,\ that\ men\ of\ ability,\ who\ have\ employed\ their\ time\ for\ the\ service\ of\ the\ community,\ may\ not\ be\ deprived\ of\ their\ just\ merits,\ and\ the\ reward\ of\ their\ ingenuity\ and\ labour;\ the\ other,\ that\ the\ world\ may\ not\ be\ deprived\ of\ improvements,\ nor\ the\ progress\ of\ the\ arts\ be\ retarded.\textsuperscript{176}\]

The views expressed by the Court in \textit{Aiken} are remarkable in several respects. First of all, they accept the ideas that were becoming prevalent in England at the time the Constitution was drafted, namely, that there are two separate and competing rationales for both the patent and the copyright systems and that the patent and copyright terms are derived from a balancing of the tensions between these two competing justifications. The first justification, which emphasizes the public interest, may broadly be called the "social benefits" rationale, and the second, which emphasizes the interest of the inventor or author, can be divided into two categories, the "inherent property right" rationale and the "reward for genius" rationale. Secondly, the Court assumed without any citation of authority that these competing rationales were also the justifications for—and indeed the purposes of—the Intellectual Property Clause.

In so doing, the Court made no reference whatever to the language of the clause taken as a whole. Even a cursory look indicates that its purpose is "to promote the progress of science and useful arts." Nothing in it states that creating a property right or rewarding genius is its purpose. Yet from the

\textsuperscript{175} Twentieth Century Music Corp. v. Aiken, 422 U.S. 151, 156, 186 U.S.P.Q. (BNA) 65, 67 (1975).
\textsuperscript{176} \textit{id}. at 156 n.6 (citing Sayre v. Moore, \textit{quoted in Cary v. Longman}, 102 Eng. Rep. 138, 139 n.(b) (K.B. 1801)).
earliest days of the republic this has been assumed to be a purpose, if not the primary purpose, of the clause. Such an assumption, however, appears to confuse the means with the end and appears at odds with the literal language of the clause. Thus, the purpose is clearly stated to provide benefits for society by promoting the progress of science and useful arts. No other purpose is set forth. A means for achieving the stated purpose is expressly stated to be creation of limited-term exclusive rights in authors and inventors. While this means may also be viewed as an incentive or reward for the creations of genius, i.e., inventions or writings, the clause does not in any way state that providing such incentive or reward is the purpose of the grant of authority to Congress.177

Be that as it may, in the context of defining a constitutional boundary for the term of patents and copyrights, which justification for the limited-term exclusive right is accepted as paramount in no small measure determines what length of term will be considered to be constitutionally acceptable. Thus, e.g., if the “social benefits” rationale is considered more important, then “limited times” should be interpreted to be that length of term which provides an appropriate incentive to authors and inventors “to promote the progress of science and useful arts” but is not so long that this purpose ceases to be met or is actually deterred. In this view, ultimate removal of the writing or invention into the public domain is the more critical factor, and long copyright and patent terms will be considered constitutionally suspect. Alternatively, if “reward for genius” is considered the more important rationale, then there is a pronounced tendency to lengthen the term of patents and copyrights to better assure that the “reward” will actually occur. Long terms will not be constitutionally suspect, and the property interest of authors and inventors becomes more important than the public interest in promoting the progress of science and useful arts.

A basic issue in determining the upper bounds of constitutionally permissible patent and copyright terms is the extent, if any, to which the stated purposes of the Intellectual Property Clause act as a limitation on the discretion of Congress to set patent and copyright terms. While not specifically addressing this issue, certain commentators have argued that the statement of purpose in the clause does not create any limitation on the

177 The Court has expressly rejected an argument that the purpose of the clause is to secure and protect an inherent property right of authors in their writings. Wheaton v. Peters, 33 U.S. (8 Pet.) 591, 654-668 (1834).
power of Congress to act with respect to patents and copyrights. Thus, e.g., Nimmer and Nimmer in the copyright context state "the phrase ‘To promote the progress of science and useful arts . . . ’ must be read as largely in the nature of a preamble, indicating the purpose of the power but not in limitation of its exercise." The only authority cited for this view is Jacobson v. Massachusetts, wherein the Supreme Court stated only that the Preamble to the Constitution itself "has never been regarded as the source of any substantive power conferred on the Government of the United States or on any of its Departments." But the Intellectual Property Clause is in fact a substantive grant of power to Congress, and the introductory portion thereof may not be read out of it and rendered meaningless.

In the patent context, Burchfiel has presented a similar argument, contending that in interpreting several other enumerated congressional powers the Supreme Court has rejected the view that a statement of purpose should be construed to express an implied limit on congressional exercise of the power. But in each example he cites, the Court has not held that the statement of purpose places no restriction on the exercise of the particular congressional power. Rather in each instance, the Court adopted an expansive definition of purpose, rather than holding that the purpose places no limitation on the exercise of the particular power.

Moreover, from early in the republic the Court has accepted the view that a statement of purpose is highly relevant in construing the nature and extent of powers granted to Congress. Thus, e.g., in 1824 in Gibbons v. Ogden Chief Justice Marshall stated:

As men, whose intentions require no concealment, generally employ the words which most directly and aptly express the ideas they intend to convey, the enlightened patriots who framed our constitution, and the people who adopted it, must be understood to have employed words in their natural sense, and to have intended what they have said. If, from the imperfection of human language, there should be serious doubts respecting the extent of any given power, it is a well

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178 NIMMER & NIMMER, supra note 82, at § 1.02(A) (1997).
settled rule, that the objects for which it was given, especially when the objects are expressed in the instrument itself, should have great influence in the construction. . . . We know of no rule for construing the extent of such powers, other than is given by the language of the instrument which confers them, taken in connection with the purposes for which they were conferred. 181

In the context of the Intellectual Property Clause these views have particular significance, for they clearly indicate that a statement of purpose or objects set forth in the clause itself “should have great influence” on the interpretation of the clause. Phrased somewhat differently, the statement of purposes, i.e., “to promote the progress of science and useful arts,” constitutes a limitation on the power of Congress granted by the clause which must be taken into account in interpreting it.

Indeed, the Supreme Court has expressly recognized this in the patent context and implicitly in the copyright context. Thus, in 1966 in *Graham v. John Deere Co.* the Court relied heavily on the introductory language of the clause to support its view that there is a constitutional standard of invention that must be met for there to be patentability. It began by noting that the qualified authority given to Congress with regard to the issuance of patents “is limited to the promotion of advances in the ‘useful arts,’ ” and went on to state that “Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose.” According to the Court, “‘promot[ing] the Progress of . . . useful Arts’ . . . is the standard expressed in the Constitution and it may not be ignored.” 182

The import of this is that, with regard to patents, the Court has most emphatically stated that the introductory language is a limitation which sets forth a constitutional standard that Congress may not ignore. This is as true with respect to the patent term as it is with respect to the nature and type of invention that may be protected. Simply put, there is a term beyond which the progress of useful arts is no longer promoted and beyond which such progress may actually be said to be hindered. At that point the discretion of Congress to set the patent term becomes constitutionally limited. The Court made this point implicitly in *Aiken* by noting the competition or tension

that exists between the public interest and the interest of authors when it comes to issuance of copyrights. At some copyright term, the public interest must predominate over that of the author, and Congress does not have constitutional authority to grant a longer term.

Despite the views expressed by the Supreme Court in Gibbons, Graham, and Aiken, several circuit courts have declined to treat the introductory language of the clause as a limitation on congressional power regarding copyrights.183 Although they were not addressing the specific issue of whether the introductory language containing the statement of purposes acts as a limitation on the power of Congress in setting the copyright term, the language they used is sufficiently broad as to indicate they would hold that it is not a restriction or limitation on the length of the copyright term.184

VI. DELINEATING THE TERM OF THE GRANT

I have suggested that the extent to which the phrase “for limited times” is viewed as setting constitutional limits on the length of the copyright and patent term depends in no small degree on whether the “social benefits” or “rewards for genius” rationale is considered more important as a justification for the Intellectual Property Clause.185 The only justification for the clause given by any Framer was that set forth by Madison in The Federalist No. 43. Therein he stated:

The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law. The right to useful inventions seems with equal reason to belong to inventors. The public good fully coincides in both cases with the claims of individuals. The States cannot separately make effective

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184 This is to be contrasted with the express congressional view at the beginning of the twentieth century that the introductory language of the Intellectual Property Clause does indeed limit the power of Congress regarding copyright. See infra text accompanying note 280.
185 See supra text accompanying note 177.
provision in either of the cases, and most of them have anticipated the decision on this point by laws passed at the instance of Congress.¹⁸⁶

Unfortunately, this language sheds little light or no light on what the Framers contemplated by “for limited times.”¹⁸⁷

The ordering of the language used by Madison rather strongly suggests that a major—if not the primary—justification for the clause was to assure that Congress would in fact have authority to legislatively protect property rights of authors in their writings and inventors in their discoveries.¹⁸⁸ But Abrams argues that “[t]he stress on the ‘utility’ of the power and the ‘public good’ reinforces the notion of public interest as a justification for the copyright system” and presumably the patent system as well.¹⁸⁹ Perhaps the most intriguing comment by Madison from the perspective of this work is his statement that: “The public interest fully coincides in both cases with the claims of individuals.” This, however, would seem to be true only if the term of the grant is such as to comply with both the public interest in having the subject matter of the grant go into the public domain at some defined time not detrimental to the public, and the interest of the grantee in having a property interest created for some length of time which would insure a good rate of return on his time and investment. As a matter of their own pragmatic interests, the grantees would always want the term of the grant to be as long as possible, without reference to the public interest. If there was to be a true “coincidence” of interest, it would have to be predicated on some form of balancing the divergent interests of the public and those of the grantees. Madison, however, made no attempt to address this issue.

The initial statutory terms of the copyright and patent grants were simply copied from the existing British law, both because this was the easiest thing to do, and because Congress had no basis on which to make any determina-

¹⁸⁶ The Federalist No. 43, supra note 19, at 303-04.
¹⁸⁷ I have elsewhere suggested that as a justification for the Intellectual Property Clause this language was both misleading and disingenuous. See Walterscheid, supra note 3; and Walterscheid, Inherent or Created Rights: Early Views on the Intellectual Property Clause, 19 Hamline L. Rev. 81, 92-98 (1995).
¹⁸⁸ Whether the authority contemplated was for the purpose of creating property rights in authors and inventors or was instead for the purpose of assuring protection of existing property rights was a matter of considerable dispute for the next few decades, and the meaning of Madison’s language in The Federalist No. 43 would be hotly argued. See Walterscheid, supra note 187, at 81.
¹⁸⁹ Abrams, supra note 73, at 1176.
tion that American conditions were sufficiently different from British conditions as to justify the setting of different lengths of the terms. But the constitutional language did not preclude term extension or renewal and in the case of copyright the statute early on expressly provided for term renewal. I turn now to the factors which have influenced the length of the patent and copyright term from 1790 to the present.

A. THE PATENT TERM

Before specifically addressing how the patent term has been delineated, it is useful to review perceptions on the nature of the patent grant during the nineteenth century, because those perceptions influenced how the term should be treated both legislatively and judicially. More often than not the issue was perceived as one of whether patents were to be treated as monopolies. The Framers clearly viewed these limited-term exclusive rights as monopolies, albeit of a desirable and acceptable type. Indeed, this was precisely why they deemed it necessary to ensure that the exclusive right was granted only "for limited times."190

Nonetheless, there would soon be fierce arguments—which have continued to this day—as to whether the "exclusive right[s]" authorized by the Intellectual Property Clause are in fact monopolies. Those who argued that they were monopolies tended to favor more restrictive interpretations of the patent law, while those who contended that they were not monopolies generally did so for the purpose of advocating a more liberal interpretation of this law. Those who argued that they were monopolies more often than not contended that this law was intended to favor the public interest whereas those who avoided the use of the term "monopoly" generally argued that an important purpose of this law was to reward inventors for their efforts.

As William Robinson would point out in his massive patent treatise published in 1890, "[t]he question whether a patent privilege is a monopoly is not merely a question of words."191 He noted that:

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190 The exchange of correspondence between Madison and Jefferson shortly after the drafting of the Constitution renders abundantly clear that patents and copyrights were contemporaneously viewed as monopolies. See supra text accompanying notes 13 and 14.

191 WILLIAM C. ROBINSON, I THE LAW OF PATENTS FOR USEFUL INVENTIONS 18 (Boston, Little, Brown 1890).
In legislative bodies, which recognize the patent-right as a monopoly, the interests of the public will naturally be preferred to those of the inventor; legislation on the subject will be cautious and conservative; and the powers conferred upon the patentee will be subordinated to the free enjoyment by all other citizens of every privilege that is not inconsistent with the protection to which his inventive skill and genius are entitled. In courts where the same theory prevails such rules will be followed as tend to limit the monopoly of the inventor to the exact letter of his grant, and hold him to a strict compliance with all its conditions as an essential requisite of validity.

In the context of the present work, this view suggests that attempts to extend the term of the grant beyond that expressly set by statute or to create a greater statutory term will be looked on with suspicion at best and refused in most instances.

But Robinson went on to point out that if a patent is not treated as a monopoly, it is considered favorably by the law, with the following consequences:

Being intended principally, if not entirely, for the benefit of the grantee, and conflicting with no public interest either actual or possible, the law construes it liberally in order to secure to the grantee all the advantage which the grantor might have proposed to bestow upon him. And hence, where legislators and the courts adopt this theory of the exclusive privilege created by a patent, and lose sight of its true character as a monopoly, legislative acts in favor of the inventor will be sweeping and extravagant, and the decisions of the courts will sustain him in claims which seriously abridge the rights of others, and will afford him a protection and redress far beyond that which justice and the public interest demand.

\[192\] Id. at 19-20.

\[193\] Id. at 20.
Although using extravagant language, Robinson made clear that whether a patent was actually treated as a monopoly, as opposed to simply being called one, depended in no small measure on whether the intent of the grant was perceived to be primarily for the benefit of the public or primarily for the benefit of the patentee.\footnote{As Robinson put it: “That the purpose of the patent law is to benefit the inventor is one principle. That the purpose of the law is to secure to the public the advantages of the invention by compensating the inventor for its disclosure, is an entirely different principle.” \textit{Id.} at 33.}

Robinson’s basic premise was that in the absence of some defined property right set by society an idea once communicated to the public is freely available for use by the public, and an inventor has no right or power to restrain its use by the public.\footnote{\textit{Id.} at 38. Although Robinson made no reference to it, Jefferson had articulately and persuasively argued much the same point in 1813. \textit{See} Letter from Thomas Jefferson to Isaac McPherson (Aug. 13, 1813), in \textit{13 The Writings of Thomas Jefferson} 333-34 (A.A. Lipscomb ed., Washington 1903).} By granting a right or power to restrain the use of an invention by the public, a patent, Robinson contended,

\[\ldots\] is a true restriction of pre-existing public rights. It may not, and ordinarily it does not, take away from the people the actual enjoyment of any benefit which they already had in their possession, but it does prohibit their immediate exercise of that perpetual and natural right by virtue of which every new discovery, when openly practised or proclaimed, becomes at once the possession and property of all.\footnote{\textit{William C. Robinson, I The Law of Patents for Useful Inventions} 42-43 (Boston, Little, Brown 1890).}

While patents may be granted to stimulate inventive activity and to reward inventors, “[t]he duty which the state owes to the people to obtain for them, at the earliest moment, the practical use of every valuable invention in the industrial arts is, however, a higher and more imperative duty than any which it owes to the inventor.”\footnote{\textit{Id.} at 57.} In other words, the term of a patent is limited to that required to actually “promote the progress of \ldots useful arts,” and there is no proper basis for making it any longer.\footnote{A modern commentator, Carolyn Cooper, makes the same point, saying: From the point of view of a society intending to encourage invention by rewarding inventors, it is important that the reward be sufficient for such encouragement, but}
The purpose of the patent system is to encourage invention is one that was prevalent in the first half of the nineteenth century, but one which has been largely discredited today. Nonetheless, her point that the patent system ought to give “the inventor the minimum actual reward consistent with continued credibility”199 is a valid one. The length of the patent term is certainly a critical factor in making this determination.

With this introduction, it is appropriate to turn now to what Congress has actually done concerning the patent term. The first patent statute, the Patent Act of 1790, authorized the issuance of a patent “for any term not exceeding fourteen years.”200 This was exactly equivalent although not identical to the language of the Statute of Monopolies.201 The patent board authorized under the Act of 1790 to issue patents202 determined a standard term of fourteen years.203 It quickly became apparent that having high government officials responsible for issuing patents was an inefficient and ineffective way to proceed, particularly in view of the fact that these officials had to determine whether the invention was deemed “sufficiently useful and important” to warrant a patent, and less than three years later Congress opted for a registration system under which a patent would automatically issue if the fees were paid and the ministerial requirements met. This Patent Act of 1793 also provided “for a term not exceeding fourteen years,”204 but the Secretary of State, who was responsible for seeing that the ministerial...
requirements were met, quickly established a standard term of fourteen years which would be the term during the forty-three years that the Act of 1793 remained in effect.

The language of the Acts of 1790 and 1793 seemed literally to indicate that no patent could have a term in excess of fourteen years. Congress, however, would interpret the statutory language as placing a limitation on the executive branch from issuing a patent with a term of more than fourteen years, but not on the ability of Congress to extend or renew the term of an issued patent beyond fourteen years as it saw fit. The issue of congressional authority in this regard was for all intents and purposes moot until 1804 when the first patents issued under the Act of 1790 expired.

The issue was brought to the attention of Congress by Oliver Evans, who in 1791 obtained the third United States patent for his invention concerning improvements in the milling of flour. His improvements constituted a major advance in the art of milling. Not only did they materially increase the efficiency of the milling process and thereby lower costs, they also produced a more uniform and cleaner product. Although his improvements were slow to catch on, by 1804 many millers were licensing his invention and many others were infringing on his patent.

Evans, like most inventors of his time, thought that the fourteen-year term of a federal patent was too short, and that, at the very minimum, each patent holder should have an automatic right of renewal for some period of time. On December 21, 1804 he became the first patentee to formally petition Congress for an extension of his patent right when he sought a seven-year extension "without injuring those who have already purchased the right of using it." Much to his surprise and dismay, Congress failed to act on this petition. On January 22, 1805, the House Committee on

205 In light of what had been established in the copyright law, there was certainly some justification for this view. See infra text accompanying note 264. For contemporaneous views of other inventors in this regard, see, e.g., Thomas Greene Pessenden, Essay on the Law of Patents for New Inventions 214 (Boston, D. Mallory & Co., 1810). See also Joseph Barnes, Treatise on Justice, Policy, and Utility of Establishing an Effectual System of Promoting the Progress of Useful Arts, by Assuring Property in the Products of Genius 6 (Philadelphia, 1792); and New England Association of Inventors and Patrons of Useful Arts, Remarks on the Rights of Inventors 11-12 (Boston, 1807).

206 It is unclear why he waited until the eleventh hour to seek this extension, but he seems to have assumed, quite incorrectly, that Congress would routinely give him the requested extension. See Greville Bathie et al., Oliver Evans: A Chronicle of Early American Engineering 101 (1935).
Commerce and Manufactures recommended the term extension but also recognized that this was the first of what were likely to become frequent requests. Accordingly, it recommended that the patent law be amended to allow for term extensions. A bill was prepared which would have accomplished both of these purposes, but on February 6th the House rejected it. It would not be until 1832 that Congress would pass any general legislation pertaining to term extension.

Evans tried again in the next session of Congress, even though his patent had now expired, but was again unsuccessful. He now changed his strategy and on December 13, 1806, presented a more general petition seeking modification of the patent law to extend the statutory term of patents. Therein he had the temerity to propose a much more extreme position, namely, that inventors, their heirs, and assigns be granted the patent right forever. A week later, he wrote to President Jefferson stating that: "To represent the patentees petition to Congress for redress, I am making my last effort to draw the attention to the oppressed and aggrieved state of the inventive genius of this country...." He hoped that Jefferson would look favorably upon this letter, because "one word from you would promote it more than all my feeble exertions." That word was not forthcoming, however, and Congress did nothing.

But Jefferson did belatedly respond to this letter. On May 2, 1807, he set forth his perspective as follows:

207 See 8 ANNALS OF CONG. 1002-1003 (Gales and Seaton eds. 1805); see also AMERICAN STATE PAPERS (MISCELLANEOUS) NO. 186 (1805).
208 See 8 ANNALS OF CONG. at 1180-81.
209 See infra text accompanying note 233.
210 His second petition is reproduced in 9 ANNALS OF CONG. 965-968 (Gales and Seaton, eds., 1805); see also AMERICAN STATE PAPERS (MISCELLANEOUS) NO. 196 (1805).
211 It carried the resounding title of ADDRESS OF THE ADVOCATE OF THE PATENTEES, INVENTORS OF USEFUL IMPROVEMENTS IN THE ARTS AND SCIENCES; PETITIONERS TO CONGRESS FOR REDRESS OF GRIEVANCE... IN DEFENSE OF MENTAL PROPERTY (Washington 1806).
212 Recognizing that this position was indeed extreme, he was willing to concede that there might be good reasons for limiting the term to "say for and during the life of the inventor, and his heirs and assigns, to the third generation; or for fifty years certain, to him, his heirs, and assigns, and for and during his own life, if he survived the term of fifty years." He closed with the rather remarkable statement that "[t]he measure has been strongly recommended not only by our beloved Washington, but by many other great and enlightened statesmen." ADDRESS, supra note 210, at 10 and 16. I have been unable to find anything that indicates that Washington ever took any position on the term of the patent grant.
213 BATHE ET AL., supra note 206, at 127.
Certainly an inventor ought to be allowed a right to the benefit of his invention for some certain time. It is equally certain it ought not be perpetual; for to embarrass society with monopolies for every utensil existing, & in all the details of life, would be more injurious to them than had the supposed inventors never existed: because the natural understanding of its members would have suggested the same things or others as good. How long the term should be is the difficult question. Our legislators have copied the English estimate of the term; perhaps without sufficiently considering how much longer, in a country so much more sparsely settled, it takes for an invention to become known & used to an extent profitable to the inventor.214

Here Jefferson comes out solidly against any perpetual right in an inventor, although he does leave open the possibility of changing the original patent term to make it longer.215 He clearly recognizes both a societal interest and the interest of the inventor in a “profitable” return. He also accepts that the delineation of the patent term of necessity must seek to reconcile the conflict inherent in these two interests.

Perhaps in response to this letter, Evans now expressed himself most forcibly on the shortness of the patent term. His purpose, he said, was to draw the attention of his “fellow-citizens, to the most ruinous error that the supreme legislature of my country has committed, vis: The laws do not protect the inventors of useful improvements in the arts, in the exclusive enjoyment of the fruits of their labour, for a sufficient length of time, nor afford them any adequate compensation, but makes them common to all at the end of 14 years; a time barely sufficient to mature (in this country) any useful improvement.” In his view, “the inventor is deluded by the name of


215 He did not favor term extension or patent renewal. See supra text accompanying note 163. Moreover, there is nothing in this language to indicate that he actually questioned the fourteen-year patent term as being too short. Rather, it suggests merely that he was prepared to consider the possibility. He never made any attempt as President to have the patent term extended. Bedini’s contention that Jefferson “questioned whether the standard period of fourteen years for which the law protected each invention was sufficient in a nation that was as large and as sparsely settled as the United States” reads considerably more into these comments than is justified by their content and context. See SILVIO O. BEDINI, THOMAS JEFFERSON, STATESMAN OF SCIENCE 207 (1990).
a patent” because after making great efforts to mature and introduce his invention into use and “just as he begins to receive compensation his patent expires, his sanguine hopes are all blasted, he finds himself ruined, and conceives that he has been robbed by law.” He concluded that “a patent in this country is not yet worth the expense of obtaining it.”

While Evans was seeking to have his patent term extended, he was also litigating an infringement action that had been commenced prior to the expiration of the term. The action did not come to trial until October 1807, when Justice Bushrod Washington, in his capacity as circuit judge, invalidated the patent on the ground that it failed to fully recite the suggestions and allegation of that portion of the invention known as the hopperboy in Evans’ original petition for patent. Evans was stunned, because the content of the patent had been defined by the patent board, and he had had no control over the description set forth therein. Nonetheless, Evans immediately took advantage of this turn of events and petitioned Congress, protesting the inequity of having the patent invalidated through no fault or action of his. Congress agreed, and it passed a special act authorizing renewal of the patent for a term of fourteen years. Jefferson signed it into law on January 21, 1808, late in his administration.

By authorizing a new renewal patent three years after the original patent had expired, the special act created a major contretemps. A fundamental premise of the patent law, and one inherent in the “for limited times” portion of the Intellectual Property Clause, is that once a patent expires, the public has a right to freely use the invention. Clearly during the intervening three years anyone, including those who had earlier licensed the patent rights, now had the right to use the invention free of charge. Could Congress constitutionally remove from the public domain that which had been in it for three years and renew the exclusive right for an additional term of fourteen years?

217 Evans v. Chambers, 8 F. Cas. 837 (C.C.D.Pa. 1807) (No. 4,555).
218 The description of the invention set forth in the patent was actually prepared by a clerk in the State Department and approved by the patent board. Many years later in Hogg v. Emerson, 47 U.S. (6 How.) 437 (1848), the Supreme Court would rule that a patent could not be invalidated because of a failure of government officials to properly perform their ministerial functions.
219 See 10 ANNALS OF CONG. 80, 83, 86, 1384, and 1409 (Joseph Gales ed., 1852). See also No. 231, AMERICAN STATE PAPERS (Miscellaneous) (10th Cong., 1st Sess.).
220 Act for the Relief of Oliver Evans, 6 Stat. 70 (1808).
Evans would have been well advised to voluntarily limit the scope of his patent rights to those who installed his patented improvements after the date of the renewal patent. He chose instead to take a hard line and sought license fees or damages from anyone using the patented improvements, regardless of when they were installed. The result was extensive litigation.

In 1813 Jefferson, now in retirement, took the opportunity to set forth his views on what he termed the "retrospection" given to the Act for the Relief of Oliver Evans that authorized the renewal patent. He strongly disagreed with the judicial interpretations by the circuit courts for Pennsylvania and Maryland that this Act was not an *ex post facto* law repugnant to the Constitution, and that Evans was legally authorized to claim royalties under the renewed patent for machinery installed during the three-year period when his improvements were in the public domain, but only from the date that infringing millers had received notice of the issuance of the new patent.\(^221\) While recognizing that the constitutional prohibition on *ex post facto* laws applied literally only to criminal cases, Jefferson nonetheless contended that "they are equally unjust in civil as in criminal cases, and the omission of a caution which would have been right, does not justify the doing of what is wrong." In his view, the retrospective construction was "abiding the natural right," and any such laws "should be restrained by vigorous constructions within their narrowest limits."\(^222\) Two years later, the Supreme Court would disagree and uphold the views expressed by the circuit courts.\(^223\)

Interestingly, no one, including Jefferson, seems to have argued that Congress did not have constitutional authority to remove the subject matter of an invention from the public domain once it had clearly entered the public domain. As Justice Story in his capacity as circuit judge would put it in 1839:

> The power is general, to grant to inventors; and it rests in the sound discretion of congress to say, when and for what length of time and under what circumstances the patent for

\(^221\) See Evans v. Weiss, 8 F. Cas. 888 (C.C.D. Pa. 1809) (No. 4,572); Evans v. Robinson, 8 F. Cas. 886 (C.C.D. Md. 1813) (No. 4,571).

\(^222\) Letter from Thomas Jefferson to Isaac McPherson (Aug. 13, 1813) in *The Writings of Thomas Jefferson*, supra note 195, at 327.

\(^223\) Evans v. Jordan, 13 U.S. (9 Cranch) 199, 203-204 (1815).
an invention shall be granted. There is no restriction, which limits the power of Congress to enact, [only to] where the invention has not been known or used by the public.224

Justice Story thus seemed to emphatically deny that the Intellectual Property Clause placed any limitation on the power of Congress to remove an invention from the public domain. This is to be contrasted with the view expressed by the Supreme Court in 1966 and again in 1989 that the clause precludes Congress from authorizing “the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already [publicly] available.”225

The saga of Evans’ renewal patent is instructive in several respects. First of all, it indicates an early reluctance by Congress to statutorily authorize any general form of term extension or renewal for patents, despite the fact that it had done this for copyrights.226 Secondly, it demonstrates an ambivalence concerning term extension or renewal. Finally, it suggests that Congress would predicate any term extension or renewal on whether the inventor was perceived to have received a fair profit or reward for his inventive effort.227

Sometime after he left the presidency in 1817, Madison expressed the view that while there could be no objection to a temporary patent monopoly, it was important that it be temporary. Although he did not expressly so state, it is apparent that he opposed term extensions, because, as he put it, inventions “grow so much out of preceding ones that there is the less merit in the authors: and because for the same reason, the discovery might be expected in a short time from other hands.”228 In 1833 Justice Story wrote that the Intellectual Property Clause was beneficial “to the public, as it

226 See infra text accompanying note 265.
227 There was nothing to preclude an argument that term extension or renewal was required in order to assure adequate investment in commercializing the invention which presumably was in the public interest under a social benefit rationale. Indeed, this was the argument chiefly relied upon by Watt in obtaining his term extension in 1775. See supra text accompanying notes 42-52. As a practical matter, however, arguments for term extension or renewal in the United States would usually be predicated on the contention that the inventor had not been adequately compensated, rather than that more time was needed to assure investment in developing and commercializing the invention.
228 Elizabeth Fleet, Madison’s “Detached Memoranda,” 3 Wm. & Mary Q. 534, 551 (1946).
would promote the progress of science and the useful arts, and admit the people at large, after a short interval, to the full possession and enjoyment of all writings and inventions without restraint." But his judicial holdings appeared to belie this language, because he was perfectly prepared to find that Congress had authority not only to extend the "short interval," but to take from the public domain and give back to the inventor an exclusive right in an invention that had entered into the public domain.

During this period, Congress exhibited no interest whatever in either statutorily extending the term of the patent grant or providing for a statutory right of renewal. Quite possibly because of the furor that the renewal of the Evans patent had caused, Congress thereafter exhibited considerable caution in granting term extensions, and between 1808 and 1836 only six additional term extensions were granted. Gradually inventors came to accept this, although they never came to like it. Finally, in response to numerous petitions for extension or renewal, Congress in 1832 statutorily established the conditions under which it would consider such petitions.

This statute clearly indicated that the basis for any extension or renewal would be whether the inventor was considered to have received an adequate monetary compensation for his inventive effort. Thus, the petition for renewal or extension was required to "be accompanied by a statement of the ascertained value of the discovery, invention, or improvement, and of the receipts and expenditures of the patentee, so as to exhibit the profit or loss arising therefrom." It did not give any assurance that the petition for extension or renewal would be granted. In any case, extension or renewal still necessitated a special act of Congress.

In 1836 Congress completely revised the patent law, changing the system from one of registration to one of examination and creating both the modern patent office and the beginnings of the modern examination process. The statutory term of the Act of 1793 was retained, i.e., "a term not exceeding
fourteen years," but an administrative mechanism for term extension for seven years was added which did not require a private act of Congress. Instead, the statutory language stated

... the Secretary of State, the Commissioner of the Patent Office, and the Solicitor of the Treasury shall constitute a board to hear and decide upon the evidence produced before them both for and against extension. ... The patentee shall furnish to said board a statement, in writing, under oath, of the ascertained value of the invention, and of his receipts and expenditures, sufficiently in detail to exhibit a true and faithful account of loss and profit in any manner accruing to him from and by reason of said invention. And if, upon a hearing of the matter, it shall appear to the full and entire satisfaction of said board, having due regard to the public interest therein, that it is just and proper that the term of the patent should be extended, by reason of the patentee, without neglect or fault on his part, having failed to obtain, from the use and sale of his invention, a reasonable remuneration for the time, ingenuity, and expense bestowed upon the same, and the introduction thereof into use, it shall be the duty of the Commissioner to renew and extend the patent, by making a certificate thereon of such extension, for the term of seven years from and after the expiration of the first term; which certificate, with a certificate of said board of their judgment and opinion as aforesaid, shall be entered on record in the Patent Office; and thereupon the said patent shall have the same effect in law as though it had been originally granted for the term of twenty-one years.

Although lip service was paid to the public interest, the clear import of this statutory language was that whether the patentee was perceived to have received “reasonable remuneration” during the original term would be

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236 Id. at § 18. This language was not in the original bill that became the Patent Act of 1836 but was added by Senate amendment. See Wilson v. Rousseau, 45 U.S. (4 How.) 646, 701 (1846) (Woodbury, J., dissenting).
determinative as to whether an extension would be granted. How or on what basis the board was to determine what was reasonable was not stated. Nonetheless, during the following decade, some ten term extensions were granted under this language.\textsuperscript{237}

The meaning to be given to this term-extension language was addressed by the Supreme Court in 1846 in \textit{Wilson v. Rousseau.}\textsuperscript{238} At issue was a patent issued to William Woodworth in 1828. Shortly after the patent issued Woodworth had assigned all rights to it to several other parties. In 1839 Woodworth died, and in 1842 the administrator of his estate sought and obtained a seven-year extension of the patent. At issue in \textit{Wilson} was whether the term of a patent could be extended after the patentee died, and, if so, whether the term extension would adhere to the benefit of the assignees. A divided Court answered both questions affirmatively.

Justice Nelson, speaking for the majority, stated:

\begin{quote}
The statute is not founded upon the idea of conferring a mere personal reward and gratuity upon the individual, as a mark of distinction for a great public service, which would terminate with his death; but of awarding to him an enlarged interest and right of property in the invention itself, with a view to secure to him, with greater certainty, a fair and reasonable remuneration. And to the extent of this further right of property, thus secured, whatever that may be, it is of the same description and character as that held and enjoyed under the patent for the first term. In its nature, therefore, it continues, and is to be dealt with, after the decease of the patentee, the same as an interest under the first, and passes, with other rights of property belonging to him, to the personal representatives, as part of the effects of the estate.\textsuperscript{239}
\end{quote}

\textsuperscript{237} \textit{Wilson}, 45 U.S. at 708.

\textsuperscript{238} \textit{Id.}

\textsuperscript{239} \textit{Id. at} 675. Prager argues that “the government's power to grant reissues and renewals to the inventor's heir seemed questionable.” Frank D. Prager, \textit{The Changing Views of Justice Story on the Construction of Patents}, 4 AM. J. LEGAL HIST. 1, 18 (1960). The difficulty arose from the fact that Section 18 pertaining to term extension spoke only of the patentee and not of his or her “heirs, assigns, or administrators” as did several other sections of the statute. But the Court simply dismissed this as irrelevant. \textit{Wilson}, 45 U.S. at 676-78.
The several dissents had no difficulty with a term extension occurring after the death of the patentee, but rather strongly opposed the holding that the term extension accrued to the benefit of assignees under the original term of the patent.\textsuperscript{240}

Having provided an administrative mechanism for term extension, it might reasonably be supposed that Congress would now cease to consider petitions for this purpose. For the next decade, with limited exception this seems to have been exactly what occurred. In 1844, e.g., the House Committee on Patents received a petition from Stephen McCormick seeking extension of his patent "on the grounds that lawsuits and the failure of the public to accept his patented reaper had prevented his receipt of adequate compensation."\textsuperscript{241} The petition was adversely reported because the Patent Appeals Board had denied the request\textsuperscript{242} and the committee would not feel at liberty to report a bill for his relief, believing that it would be unwise to establish a precedent, that numerous persons, who now have and may hereafter obtain patents, if their expectations of profit are not fully realized, might, by applying to Congress, have their exclusive right prolonged from time to time, until their invention should fully remunerate them for their time and trouble.\textsuperscript{243}

These words were prophetic for what was soon to occur. Beginning in 1848, in the 30th and 31st Congresses some twenty bills of this nature were given do-pass recommendations, but only a few actually resulted in term extensions or renewals.\textsuperscript{244} But private legislation of this type did result in

\textsuperscript{240} See, e.g., Wilson, 45 U.S. at 693-709 (Woodbury, J., dissenting) (suggesting the primary concern was that assignees under the original term of the patent had paid no consideration for the added benefit obtained by the term extension). But in the case of Woodworth, although not expressly stated in the record, it is apparent that Woodworth's son, as administrator of his estate, received a significant added consideration from the assignees for seeking and obtaining the term extension. The argument was also made that future assignees of various patents would pay added consideration in the hopes that a term extension would be obtained.

\textsuperscript{241} Benagh, supra note 232, at 8 (citing to H.R. REP. NO. 431 (1844)).

\textsuperscript{242} The Act of 1836 provided for an administrative appeal from any adverse act or decision of the Commissioner of Patents affecting patent rights.

\textsuperscript{243} Benagh, supra note 232, at 8.

\textsuperscript{244} Id. at 8 and 9.
two full term renewals to Thomas Blanchard, giving him a patent with an ultimate term of forty-two years, which appears to be the longest term ever accorded to any United States patent. Blanchard seems to have succeeded in this effort by a combination of astute lobbying and arguments that he had not been adequately compensated for his invention, a dubious proposition at best. In 1879, however, the House Committee on Patents became much more hostile to arguments for term extension based on the assertion that patentees had failed to receive adequate remuneration for their inventive efforts. In that year it took the position that term extension should be determined "solely in its effect on the public interests." Thereafter, the number of petitions for term extension predicated on personal or financial considerations dropped rapidly. The last favorable report to extend the term of a patent based on inadequate compensation to the patentee was issued in 1916. As Benagh reports, "[t]here was a period in the mid-19th century when the Congress attempted to assure adequate compensation to every inventor with the device of private legislation, but the concept of guaranteed income proved to be too time-consuming and open to frivolous claims." It also paid short shrift to the public interest inherent in the Intellectual Property Clause.

In 1870 the patent statutes were substantially revised. The Patent Act of 1870 extended the term of patents to seventeen years. It retained the term-extension provisions of the Act of 1836, but with an important proviso, namely, that a seven-year term extension could only be sought for patents issued prior to March 2, 1861. Four years later, the Act of 1870 was repealed and its provisions incorporated into the Revised Statutes. Because

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245 Blanchard received his patent for an irregular wood-turning lathe in 1819. It was renewed by Act of Congress, 6 Stat. 589, in June 1834, five months after the original patent had expired. Even though the subject matter of the patent had gone into the public domain, Justice Story upheld the validity of the renewal patent. See supra text accompanying note 224. In 1848 Blanchard succeeded in having the patent renewed for a third full term. 9 Stat. 683. For a discussion of Blanchard's patent management and litigation under it, see COOPER, supra note 198, at 39-56.

246 I have been unable to find any other U.S. patent with a term extending beyond twenty-eight years.

247 Benagh, supra note 232, at 9 (quoting from H.R. 195, 45th Cong. 3rd Sess. (1879)).

248 Benagh, supra note 232, at 10.

249 Id. at 14.


251 Id. at § 63.

252 Revised Statutes of 1874, Ch. 1, 18 Stat. 945, §§ 4886-4936 (June 22, 1874). The seventeen-year term was now set by § 4884 of the Revised Statutes and the seven-year term extension provision now appeared at § 4924 of the Revised Statutes.
the term-extension section stated that no renewal could be issued after the expiration of the original term, this provision had an effective sunset provision of March 2, 1875 built into it. It is likely that Congress perceived the creation of a seventeen-year term as being sufficient to remove the need for any administrative extension process.\textsuperscript{253} It is also apparent that Congress was now questioning its earlier assumption that a primary role of the patent system was to reward inventors as opposed to promoting the public interest.\textsuperscript{254}

Another major revision of the patent law occurred with the Patent Act of 1952.\textsuperscript{255} This Act retained the seventeen-year term, but made no provision for term extension.\textsuperscript{256} Within several decades there would be a significant lobbying effort for term-extension legislation, not in the context of rewarding patentees but rather in the context of extending the term of a patent wherein regulatory review and approval of the patented product or process delayed its commercial availability after the patent term had commenced.\textsuperscript{257} The purpose of the proposed term extension was to in essence make up for the period while the product or process was patented but could not be sold or used because of lack of regulatory approval. In 1984 Congress enacted two forms of such extension.\textsuperscript{258} Subsequently, any such term extension has been limited to a period not exceeding five years.\textsuperscript{259}

Patent harmonization came upon the scene in the 1990s, and a part of this process was conforming the term of United States patents to that set by international treaty. Certain changes in United States law were required when the United States became a signatory to the General Agreement on Tariffs and Trades (GATT), specifically by the agreement known as the Trade Related Aspects of Intellectual Property Rights. These changes were

\begin{footnotes}
\textsuperscript{253} To the extent that a patentee could show genuine hardship, he or she could still resort to private patent legislation to obtain a term extension. But, as has been indicated, Congress rather quickly became reluctant to enact such private legislation.

\textsuperscript{254} See supra text accompanying note 247.


\textsuperscript{256} Id. at § 154.

\textsuperscript{257} See, e.g., James J. Wheaton, \textit{Generic Competition and Pharmaceutical Innovation: The Drug Price Competition and Patent Term Restoration Act of 1984}, 35 CATH. U. L. REV. 433, 435 (1986) ("For years, the brand-name pharmaceutical industry lobbied Congress to enact patent extension legislation, claiming the lengthy drug approval process had eroded the effective patent protection for new drug products far below the seventeen-year grant contemplated by the federal patent statute").


\end{footnotes}
made in 1994 through the Uruguay Rounds Agreement Act (URAA). The patent term is now defined as:

beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific reference to an earlier filed application or applications under section 120, 121 or 365(c) of this title [Title 35], from the date on which the earliest such application was filed.

The URAA also set forth certain circumstances for extending the term because of delays in the issuance of the patent. Thus, under United States law as it now exists, term extension of up to five years may be obtained for delays in the issuing of the patent, and term extension of up to five years for regulatory delay is also possible. Conceptually, this means that a term extension of up to ten years is possible if both rationales are accepted, but in most instances a term extension because of delay in the issuance of the patent will offset the consequences of regulatory delay. As a consequence, it would be a most unusual circumstance to have a patent term extending more than twenty-five years from the date the application was filed.

Although patent extensions for drugs are rare, the extraordinary profits derived from certain patented drugs have caused their manufacturers to spend literally millions of dollars and engage in strenuous lobbying efforts to obtain patent extensions through private congressional acts. They have also on occasion sought to attach patent extensions to totally unrelated bills and to have the patent statutes modified to better protect their business interests by making patent extensions easier to obtain. Such activities make very good pragmatic business sense, but they are constitutionally

262 The mechanics of both types of extension are now spelled out in 35 U.S.C. § 156 (1994).
suspect in that they do absolutely nothing to promote the progress of science and useful arts.

B. THE COPYRIGHT TERM

Just as with the patent term, Congress initially opted to use the British term for copyright. Thus, the Copyright Act of 1790 was patterned after the Statute of Anne and provided an initial term of fourteen years with a right of renewal for another fourteen years, provided that an author was living at the expiration of the first term. But in the next two centuries the copyright term would be extended much more than the patent term. For much of that period the copyright term would also provide express mechanisms for term extension.

During the nineteenth century almost two hundred copyright bills were introduced, and some twenty of these were enacted into law in some form or another. The only one to actually change the statutory term of copyright became law in 1831. It extended the initial term to twenty-eight years "from the time of recording of the title thereof" and authorized a living widow or children of a deceased author to seek a renewal for fourteen years. The rationale for doubling the initial term has received almost no discussion in the literature, and it is not entirely clear why the extension occurred.

In the 1834 case of Wheaton v. Peters, the Supreme Court issued a copyright opinion that had a great deal of relevance to the interpretation to be given to "for limited times" in the Intellectual Property Clause. Simply

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264 Copyright Act of May 31, 1790, § 1, 1 Stat. 124.
265 Express statutory provision for term renewal should arguably have precluded any term renewal or extension by private act or indeed the issuance of copyright by private act. Although rare, private copyright acts have occurred. At the end of the nineteenth century, only nine such acts had been passed by Congress. The only other such act in the twentieth century was Priv. L. No. 92-60, 85 Stat. 857 (1971). See United Christian Scientists v. Christian Science Bard of Directors, First Church of Christ, Scientist, 829 F.2d 1152, 1169, 4 U.S.P.Q.2d (BNA) 1177, 1189 (D.C. Cir. 1987) (noting the rarity of private copyright legislation).
266 PATTERSON, supra note 64, at 213.
267 For a listing of these statutory enactments, see 8 NIMMER & NIMMER, supra note 82, at app. 7-45 to 7-95.
268 Copyright Act of Feb. 3, 1831, §§ 1 and 2, 4 Stat. 36.
269 Patterson, for example, simply notes it without providing any explanation of why it occurred. See PATTERSON, supra note 64, at 201.
270 33 U.S. (8 Pet.) 591 (1834).
put, one of the questions raised and decided was whether in the United States an author has a common law copyright in perpetuity after publication occurs. It is immediately apparent that if such a copyright were held to exist then the phrase “for limited times” in the clause is meaningless, at least in the copyright context. The justices split four to two on the issue.

Patterson summarizes the relevant issues and opinions as follows:

Subsidiary to this point were the questions of whether a federal common law existed; whether the common-law copyright existed in England; and whether, assuming its existence, Pennsylvania incorporated the common-law copyright in its common law. The majority held that no federal common law existed; the dissenters took the position that this was irrelevant to the case, as the law of Pennsylvania applied. As to the existence of the common-law copyright in England, the majority thought this was much in doubt, and the dissenters argued that it existed without question. The majority did not think that Pennsylvania, assuming the existence of a common-law copyright in England, had incorporated that right into its common law; and the dissenters took the opposite view. 271

What Patterson failed to note is that the case also involved an interpretation of the meaning of “securing” as it appears in the clause.

As a part of the argument in favor of a perpetual common law right, it was contended that “securing” in the clause “clearly indicates an intention, not to originate a right, but to protect one already in existence.” 272 Not so, said the majority, because the meaning of the term must be determined in the context of “the words and sentences with which it stands connected.” 273 In this light, “securing” could not mean the protection of an acknowledged legal right because “[i]t refers to inventors, as well as authors, and it has never been pretended by any one, either in this country or in England, that an inventor has a perpetual right, at common law, to sell the thing invented.” 274

271 Patterson, supra note 64, at 208.
272 33 U.S. at 661.
273 Id.
274 Id.
In other words, any right to copyright under the Intellectual Property Clause was a created rather than an inherent right.\textsuperscript{275} According to the dissent, however, any such analysis is in the nature of a \textit{non sequitur}, because the "article [i.e., the clause] is to be construed distributively, and must have been so understood."\textsuperscript{276}

Ever since \textit{Wheaton v. Peters}, copyright in published works has been understood to be a creature of statute. The statute in turn must conform to the mandate of the Intellectual Property Clause that the exclusive right be secured for limited times. A point that has been largely ignored by both Congress and the judiciary is that the majority opinion in \textit{Wheaton v. Peters} suggested that the rights of inventors and the rights of authors were similar and ought to be treated similarly.\textsuperscript{277} This does not mean that the terms of copyright and patent should be identical, but it does support the view that disproportionate differences in the terms of these two property rights are constitutionally suspect.

The Copyright Act of 1909 maintained the initial term of twenty-eight years but provided that the term should run "from the date of first publication," and extended the renewal term to twenty-eight years.\textsuperscript{278} This was at a time when the patent term had been set at seventeen years; there was no statutory basis for extension of the patent term, and Congress was exhibiting extreme reluctance to extend patent terms by private act.\textsuperscript{279} As a consequence, it was now routinely possible to obtain a copyright term that was typically more than three times the length of the patent term.

The House report accompanying the 1909 Act is of considerable interest because of its discussion of the constitutional aspects of copyright law.\textsuperscript{280} It points out that the Intellectual Property Clause limits the power of Congress

\begin{itemize}
\item \textsuperscript{275} For a detailed discussion on this point, see Walterscheid, \textit{supra} note 187.
\item \textsuperscript{276} 33 U.S. at 684.
\item \textsuperscript{277} Justice McLean, for the majority, stated:
\begin{quote}
In what respect does the right of an author differ from that of an individual who has invented a most useful and valuable machine? In the production of this, his mind has been as intensely engaged, as long, and, perhaps, as usefully to the public, as any distinguished author in the composition of his book. The result of their labours may be equally beneficial to society, and in their respective spheres, they may be alike distinguished for mental vigour.
\end{quote}

33 U.S. at 657-58.
\item \textsuperscript{278} Act of Mar. 4, 1909, ch. 320, §§ 23-24, 35 Stat. 1075.
\item \textsuperscript{279} See \textit{supra} text accompanying notes 250-54.
\item \textsuperscript{280} H.R. REP. NO. 60-2222 (1909), reprintedin \textit{8 NIMMER & NIMMER, supra} note 82, at app. 13-1 to 13-31.
\end{itemize}
by several conditions, one of which is that "[t]he object of all legislation must be . . . to promote science and the useful arts." Accordingly, "the spirit of any act which Congress is authorized to pass must be one which will promote the progress of science and the useful arts, and unless it is designed to accomplish this result and is believed, in fact, to accomplish this result, it would be beyond the power of Congress." This is to be contrasted with the view of some modern commentators and several circuit courts that the introductory language of the Intellectual Property Clause is not limiting in any way on the authority of Congress.

The report went on to emphasize that copyright is "[n]ot primarily for the benefit of the author, but primarily for the benefit of the public . . . ." Thus, "[i]n enacting a copyright law Congress must consider . . . two questions: First, how much will the legislation stimulate the producer and so benefit the public; and, second, how much will the monopoly granted be detrimental to the public." Any such legislation must confer "a benefit upon the public that outweighs the evils of the temporary monopoly."

Although it was argued that there should be a single term of life plus fifty years, the report rejected this proposal on the ground that it was distinctly advantageous to the author to have a right of renewal. According to the report the doubling of the renewal term to twenty-eight years, taken together with the original term of twenty-eight years, "ought to be long enough to give the author the exclusive right to his work for such a period that there would be no probability of its being taken away from him in his old age, when, perhaps, he needs it the most." The relevance of such an argument to the constitutional purpose of copyright was not stated, nor was there any indication as to why authors were thought deserving of an original term plus a renewal term that was more than three times longer than that statutorily authorized for patents. One is left with the question of why authors needed to be statutorily protected in their old age but inventors did not.

During the 1960's there was a renewed effort for a major revision of the copyright law, including modifying and lengthening the term. Pending this

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281 Id. at app. 13-10.
282 See supra notes 178 and 180 and accompanying text; supra note 183 and accompanying text.
284 The report gives no indication of the basis for this argument, but it likely was predicated on to other nations had set such a term for copyright.
285 Id. at app. 13-21 to 13-22.
revision, Congress passed a number of laws effectively extending the renewal terms of copyrights subsisting after September 19, 1962 or prior to December 31, 1971 until December 31, 1976. In 1976 the long-anticipated revision occurred, and with it another broadening of the copyright term. Effective as of January 1, 1978, a unitary term for copyright beginning at the date of the work’s creation and continuing for the life of the author plus fifty years after his or her death was established. But for anonymous or pseudonymous works or works made for hire, a unitary term of seventy-five years from the date of first publication or one-hundred years from the date of creation, whichever expires first, was created. The 1976 Act also extended the renewal term for works statutorily copyrighted prior to January 1, 1978 to forty-seven years, thus providing a total term of seventy-five years for such copyrights. The result of this was that the copyright term was now almost always at least three times that of the patent term, and could on occasion be four times or more that of the patent term.

What were the rationales for these changes in the copyright term? The legislative history is set forth in essentially identical language in the House and Senate reports. A remarkable aspect of these reports is that, unlike the 1909 House report, they make absolutely no mention of the limitations imposed on the power of Congress by the Intellectual Property Clause. Specifically, the issue of whether there is a constitutional problem with a copyright term of life-plus-fifty years is never raised, much less addressed. The legislative history emphasizes that “authors and their representatives stressed that the adoption of a life-plus-50 term was by far their most important legislative goal in copyright law revision” and that the Register of Copyrights regards such a term as the foundation of the revisions.

Seven rationales are set forth which have been summarized as follows:

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290 H.R. REP. NO. 94-1476 (1976), reprinted in 8 NIMMER & NIMMER, supra note 82, at app. 4-2 to 4-216; S.22 reprinted in 8 NIMMER & NIMMER, supra note 82, at 4A-2 — 4A-255.
291 Id. at app. 4-132.
1. The 56-year term under the 1909 Act was not long enough to assure an author and his dependents a fair economic return, given the substantial increase in life expectancy.

2. The growth in communication media has substantially lengthened the commercial life of a great many works, particularly serious works which may not initially be recognized by the public.

3. The public does not benefit from a shorter term, but rather the user groups derive a windfall, as the prices the public pays for a work often remain the same after the work enters the public domain.

4. A system based upon the life of the author avoids confusion and uncertainty, because the date of death is clearer and more definite than the date of publication, and it means that all of a given author’s works will enter the public domain at the same time instead of seriatim as under a term based on publication.

5. The renewal system is avoided with its highly technical requirements which often cause inadvertent loss of copyright.

6. A statutory term of life-plus-50 years is no more than a fair recompense for those who under the 1909 Act owned common law copyrights which continued in perpetuity as long as a work remained unpublished.

7. A majority of the world’s countries have a term of life plus fifty. To adopt the same term expedites international commerce in literary properties, and opens the way for membership in the Berne Convention.

Even a cursory look at these rationales reveals a congressional view that, rather than being for the public benefit as stated in the Intellectual Property Clause, copyright is intended (a) almost entirely for the benefit of an author, and (b) for the purpose of expediting international trade.

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292 3 Nimmer & Nimmer, supra note 82, at 9-8, § 9.01[A][2].
INTELLECTUAL PROPERTY TERM LIMITS

Twelve years later, the House took a very different approach in its report on the Berne Convention Implementation Act of 1988. Now the constitutional purpose was very much in evidence:

Sound copyright legislation is necessarily subject to other considerations in addition to the fact that a writing be created and that the exclusive right be protected only for a limited term. Congress must weigh the public costs and benefits derived from protecting a particular interest. "The constitutional purpose of copyright is to facilitate the flow of ideas in the interest of learning." . . .

[T]he primary objective of our copyright laws is not to reward the author, but rather to secure for the public the benefits from the creations of authors. Moreover, the view expressed in the 1909 House report that copyright is "[n]ot primarily for the benefit of the author, but primarily for the benefit of the public" was now quoted with approval.

It was perhaps inevitable that the strong commercial interest in certain copyrights would result in extensive efforts in recent years to extend the term of these copyrights. The result has been the Sonny Bono Copyright Term Extension Act of 1998 which provides that "[a]ny copyright still in its renewal term at the time the Sonny Bono . . . Act becomes effective shall have a copyright term of 95 years from the date copyright was originally secured." Recall that the 1976 Act authorized renewal of copyrights existing prior to January 1, 1978 to provide for a total term of seventy-five years. The net effect of this was that in the next decade some highly profitable copyrights would expire and the works would go into the public domain in the absence of further term extension. Not now. Instead, the

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294 Id. at app. 32-22.
295 Id.
297 See supra text accompanying note 289.
298 Among the works that would have entered the public domain were the Disney characters Mickey Mouse, Pluto, Goofy, and Donald Duck; music written by George and Ira Gershwin, Cole Porter, Irving Berlin, Hoagy Carmichael and a host of others; and early novels of Ernest Hemingway and William Faulkner. See Teresa Ou, From Wheaton v. Peters to Eldred v. Reno: An Originalist Interpretation of the
industries controlling these copyrights will continue to obtain major royalties for the use of the works covered by them for twenty years longer than they had any reasonable basis to expect, other than their lobbying skills.

The Sonny Bono Act has not gone unchallenged, however. It is the subject of ongoing litigation in a case styled [*Eldred v. Reno*](http://cyber.law.harvard.edu/eldredvreno/legal.html). Among other things, the Act is argued to be unconstitutional as a violation of the Intellectual Property Clause. On October 27, 1999, the district court for the District of Columbia held that the Sonny Bono Act is not unconstitutional and granted judgment to the government on the pleadings. This decision is now on appeal. It is quite possible that the ultimate appellate determination will be made by the Supreme Court. If so, for the first time the Court will have to address directly what is meant by the phrase “for limited times” in the Intellectual Property Clause.

**VII. TERM LIMITS AND THE INTELLECTUAL PROPERTY CLAUSE**

In the last few decades there has been increasing discussion by various commentators concerning the patent and, in particular, the copyright term. Much of this discussion has been engendered by the substantial increases in the copyright term that have occurred in the last twenty-five years. While the length of the statutory patent and copyright terms have both increased in the two centuries since the first patent and copyright statutes were enacted in 1790, the increase in the copyright term has been quite disproportionate to the increase in the patent term. A simple comparison shows the extraordinary disparity in treatment between the two terms. Thus, in 1790 both the patent and the copyright statutory term were set at fourteen years. At the beginning of the new millennium, the statutory patent term is twenty years and the statutory copyright term is life in being plus seventy years (or for certain works, if the life of the author cannot be

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300 See, e.g., ROBERT L. BARD & LEWIS KURLANTZICK, COPYRIGHT DURATION: DURATION, TERM EXTENSION, THE EUROPEAN UNION, AND THE MAKING OF COPYRIGHT POLICY (1999) (providing a detailed bibliography of books and articles addressing various issues relevant to both the patent and the copyright term).
ascertained, for ninety-five years after publication or one-hundred-and-twenty years after creation, whichever is shorter). Thus, in two centuries the statutory patent term has increased by 43% but the statutory copyright term has increased by almost 580%. Where they were once the same, the copyright term now is typically between four and five times longer than the patent term.

This extraordinary disparity in terms raises the question of the extent to which the language of the Intellectual Property Clause sets a constitutional limit on the terms of patents and copyrights and whether that limit has been reached or exceeded in the case of copyright. This, of course, is one of the issues that hopefully will be decided in the appeal of *Eldred v. Reno.* In granting judgment to the government on the pleadings, the district court in that case gave short shrift to arguments that the copyright terms provided by the Sonny Bono Act violate the Intellectual Property Clause. In its view, "the 'limited times' period is 'subject to the discretion of Congress,'" and that discretion is not limited by the introductory language of the clause. As will now be shown, the district court erred significantly in its treatment of the constitutional standard under the Intellectual Property Clause.

Any judicial determination as to the meaning to be given to the phrase "for limited times" in the Intellectual Property Clause cannot look at the phrase in isolation. Rather, it must be interpreted in the context of the language of the clause taken as a whole. As the Supreme Court made clear in *Wheaton v. Peters* with regard to copyright, the meaning of a word

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*301* Using as a baseline ninety-five years for the copyright term.

*302* 74 F. Supp. 2d 1, 3, 53 U.S.P.Q.2d (BNA) 1217, 1219 (D.C. Cir. 1999). The issue of whether an ultimate copyright term of 140 years violated the Intellectual Property Clause was raised but not reached in *United Christian Scientists v. First Church of Christ, Scientist,* 829 F.2d 1152, 4 U.S.P.Q.2d (BNA) 1177 (D.C. Cir. 1987). But the court did make the following points:

> The copyright Congress conferred upon First Church through Private Law 92-60 is, however, far from ordinary . . . [and] is exceptional in scope and duration. Even if not construed as a copyright in perpetuity, it purports to confer rights of unprecedented duration: the term of protection for the 1906 edition of *Science and Health,* which would have expired in 1981 if treated under the general copyright laws, is now until 2046; and numerous editions of *Science and Health* which . . . were in the public domain because their copyrights had expired [or were] . . . never copyrighted, are now subject to the long-term copyright First Church derived from Private Law 92-60. Scant authority, if any, exists for such a dramatic departure from copyright practice.

*Id.* at 1169-70.


*304* *Id.* at 3 n.6 (citing Schnapper v. Foley, 667 F.2d 102, 112 (D.C. Cir. 1981)).
or phrase in the clause must be determined in the context of the "words and sentences with which it stands connected." Moreover, the Court observed as early as 1824 in *Gibbons v. Ogden* that the objects for which a congressional power is given "especially when those objects are expressed in the instrument itself, should have great influence in the construction." As the Court put it, the extent of congressional powers is to be construed by the language of the instrument which confers them taken together with the purposes for which they are conferred.

The purposes or objects of the Intellectual Property Clause are *not* "to secure for limited times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." The grant of exclusive rights for limited times is simply a means authorized in the clause to accomplish the stated objects, *i.e.*, "To promote the Progress of Science and useful Arts." All too frequently both Congress and the judiciary have confused the two. If the objects of the clause were merely to secure exclusive rights for limited times, Congress would indeed have very broad and almost unbounded discretion to set the term of both patents and copyrights. But Justice Story's statement in *Pennock v. Dialogue* in 1829 that the term of the exclusive patent right "shall be subject to the discretion of Congress" cannot be read as giving Congress unbounded discretion, for he was fully cognizant that congressional discretion is bounded by the stated objects of the Intellectual Property Clause.

As Bard & Krulantzick have phrased it:

> Without doubt Congress has considerable latitude in deciding how to comply with the Constitution's injunction that protection be for 'limited times.' At some point, though, an ever-lengthening term crosses a line beyond which the constitutional provision's prescription about

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33 U.S. (8 Pet.) 591, 661 (1834).
22 U.S. (9 Wheat.) 1, 189 (1824).
*Id.* at 189.
27 U.S. (2 Pet.), 1, 16-17 (1829).
*Nowhere* is this more clearly indicated than in his Commentaries on the United States Constitution published four years after *Pennock* wherein he emphasized that short patent and copyright terms are beneficial in that they "admit the people at large, after a short interval, to the full possession and enjoyment of all writings and inventions without restraint." *STORY, supra* note 162, at § 1147 (emphasis added).
'limited times' and its underlying purposes are mocked as the term becomes limited in form and name only.310

There are thus some terms beyond which the stated objects of promoting science and the useful arts not only are no longer met but may actually be negated.

Moreover, the district court in Eldred v. Reno ignored highly relevant modern language of the Supreme Court in 1966 in Graham v. John Deere Co.311 on the subject of congressional discretion in interpreting the limitations set forth in the Intellectual Property Clause. The Court began its discussion by noting that the clause does not set forth any absolute authority for Congress but instead only a "qualified authority."312 It went on to state that "Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose."313 It then emphasized that "'promot[ing] the Progress of . . . useful Arts' . . . is the standard expressed in the Constitution and it may not be ignored."314 Finally, it concluded that "[w]ithin the limits of the constitutional grant, the Congress may, of course, implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim."315 In other words, congressional discretion is bounded by the limits of the constitutional grant." Precisely the same limitations apply to the copyright power.

Why then did the district court rule that the introductory language of the Intellectual Property Clause, i.e., "to promote the Progress of Science and useful Arts," does not limit the discretionary power of Congress with regard to setting the term of copyright? In so ruling, it viewed the phrase "for limited times" in complete isolation and ignored the contrary language of the Supreme Court in Wheaton v. Peters,316 Gibbons v. Ogden,317 and Graham.

310 BARD & KURLANTZICK, supra note 300, at 75.
312 Id. at 5.
313 Id. at 5-6.
314 Id. at 6 (emphasis in original).
315 Id. (emphasis added).
316 33 U.S. (8 Pet.) 591 (1834).
Instead it relied on a D.C. Circuit opinion, *Schnapper v. Foley*, having nothing whatever to do with interpreting the phrase “for limited times.”

*Schnapper v. Foley* involved the question of whether a federally commissioned work could be copyrighted. The argument was presented “that the purposive language of the Copyright Clause constitutes a substantive limit on Congress’s legislative power, and that it only refers to the need to provide economic incentives in the form of royalties.” In rejecting this argument, the D.C. Circuit noted that the appellant had failed to cite any relevant authority for the view that the purposive language is a limitation on congressional power. It went on to adopt the views expressed by the Fifth Circuit, to wit:

> Congress has authority to make any law that is ‘necessary and proper’ for the execution of its enumerated Article I powers, . . . including its copyright power, and the courts [sic] role in judging whether Congress has exceeded its Article I powers is limited. The courts will not find that Congress has exceeded its power so long as the means adopted by Congress for achieving a constitutional end are ‘appropriate’ and ‘plainly adapted’ to achieving that end. *McCulloch v. Maryland* . . . . It is by the lenient standard of *McCulloch* that we must judge whether Congress has exceeded its constitutional powers in enacting an all-inclusive copyright statute.

It concluded that “we cannot accept . . . that the introductory language of the Copyright Clause constitutes a limit on congressional power.”

The difficulty with such a view is that not only is it inconsistent with the views expressed by the Supreme Court in *Gibbons, Wheaton*, and *Graham*, but it literally reads the introductory language out of the Intellectual Property Clause and instead treats it as: “To secure for limited times to Authors and Inventors the exclusive Right to their respective Writings and

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318 *Eldred*, 74 F. Supp. 2d at 2 n.6 (citing *Schnapper*, 667 F.2d at 112).
319 667 F.2d at 111.
320 *Schnapper*, 667 F.2d at 112.
311 *Id.* at 112 (citing Mitchell Brothers Film Group v. Cinema Adult Theater, 604 F.2d 852, 860, 203 U.S.P.Q. (BNA) 1041, 1048 (5th Cir. 1979)).
321 667 F.2d at 112.
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Discoveries.” But that is not the language of the clause. The “limited standard of McCulloch” does not contemplate that the express language of the Intellectual Property Clause can be ignored in the cavalier fashion of the Fifth and D.C. Circuits. The Supreme Court has made the point abundantly clear in recent times by emphasizing that: “The primary objective of copyright is not to reward the labor of authors, but ‘[t]o promote the Progress of Science and useful Arts.’”323

While acknowledging this to be the case,324 Congress has not seen fit, at least in the copyright context, to address the introductory language as any form of restriction or limitation on its discretion to set the term of the grant. Yet implicit in the introductory language is the presumption that beyond some term not only is the progress of science, i.e., education and learning, not met, but rather it may actually be inhibited. But the rationales presently set forth for the statutory copyright term simply do not address this point. Perhaps nowhere is this more evident than when those rationales are applied to the statutory patent term. Indeed, with but one exception Congress has never applied those rationales to the patent term.325 But if as pointed out in Wheaton v. Peters, the rights of authors and inventors are similar and ought to be treated similarly,326 then the patent and copyright terms ought to be comparable rather than exhibiting their present remarkable disparity.

Neither Congress nor the courts now suggest that the patent system has as a purpose, much less a primary purpose, to reward inventors for their creative efforts. Rather, the modern view is that “[t]he patent law is directed to the public purposes of fostering technological progress, investment in research and development, capital formation, entrepreneurship, innovation, national strength, and international competitiveness.”327 Contrast this with the congressional view that a primary rationale for extending the copyright


324 Nimmer & Nimmer, supra note 82.

325 The sole exception is the argument for harmonization which has been applied with respect to both the patent and the copyright term.

326 322 U.S. 591, 657 (1834).

term is to assure authors and their dependents “a fair economic return.” In continuing to expand the term of copyright, Congress has totally ignored the public benefit purposes set forth in the introduction to the Intellectual Property Clause, and instead viewed copyright as primarily for the benefit of authors. Yet as recently as 1991 the Supreme Court has emphasized that “the primary objective of copyright is not to reward the labor of authors” but to benefit the public through “promot[ing] the Progress of Science and useful Arts.”

If the present statutory patent term of twenty years is presumed “to promote the Progress of Science and useful Arts,” what then is the constitutional justification for a copyright term that is typically four to five times longer? What is so different about the works of authors that requires a term so much longer than is deemed necessary to meet the constitutional objects with regard to the discoveries of inventors? Congress has chosen to address neither of these issues. Rather, in setting the copyright term, it has chosen to simply ignore the constitutional issues raised by the objects of the Intellectual Property Clause. Those objects are for the purpose of promoting the public interest by enhancing the intellectual public domain rather than restricting it. If under the Intellectual Property Clause there is indeed a balance between the public interest and the interest of individual authors and inventors, as both the Supreme Court and Congress state there is, then the time has come for the courts to delineate the constitutional factors which affect such a balance and to determine whether the present copyright term is in accord with those factors.

328 Nimmer & Nimmer, supra note 82. Ou, supra note 298, at 4 (discussing comments by Senator Hatch in the Congressional Record). According to Hatch, the issue of copyright term extension in 1995 was one of “whether the current term of copyright adequately protects the interests of authors.” He further stated that an extension of the copyright term beyond that provided by the Copyright Act of 1976 would allow “authors to reap the full benefits to which they are entitled from the exploitation of their creative works.” See 141 Cong. Rec. S3390 (1995) (containing Senate debate of Copyright Extension Act of 1995).

329 Feist, 499 U.S. at 340.