Some Ghosts of The Law

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SOME GHOSTS OF THE LAW

At many points in the slow development of the law, ghosts have appeared, often conjured up by judicial timidity at meeting a serious issue face to face, sometimes engendered by lack of experience with practical affairs. To a degree, courts are often like a row of upended bricks, in that the pushing over of one at the beginning of the row topples the rest in succession. That is, the courts have too often found it easier to follow a precedent of doubtful basis than to re-examine the premises. As legalistic theories develop it may take a generation, or a century, or more, to lay one of these ghosts. Sometimes that process is by judicial about-face, sometimes by statutory enactment when an abuse has become quite clear.

For example, one of the oldest was the rule that a husband would not be allowed to testify against his wife, or *vice versa*. Its origin is lost in the mists of the early development of the common law in England. It is only in our time, and by statutory enactment, that that has been changed, and the change is not yet complete in all jurisdictions. Whether a supposed public policy had a share in its birth I do not know; but obviously public policy based upon common sense has exorcised that particular evil spirit.

A more modern instance is the "fellow servant doctrine," in which the courts in England about a century ago, and in this country not much later, began to hold as a matter based upon principle that an employee can not recover against his master for injury occasioned by the negligence of a fellow servant. Lord Abinger, in the *Priestley* case in England, seems to have based his decision upon the alarming extent to which the liability of the employer would be carried if the opposite principle were adopted. This now seems a strange mental reaction for one of high position in the country in which insurance originated, and at a time when almost every substantial liability was susceptible of protection by insurance. In this country the earliest case seems to be the *Murray case*

in South Carolina, in 1841; and soon came the *Farwell case* in Massachusetts. After that the doctrine spread like a prairie fire, particularly in cases where railroad employees were injured by fellow servants. All the early decisions seem to reflect the fear of the courts that the economic loss to employers would be too great if liability were imposed. But in the South Carolina case some of the judges dissented, and one of them, O'Neall, pointed out that the liability involved fell under the general rule that a principal is liable for the negligence of his agent, and that the question of policy on which the majority rested "would be worth inquiring into with great care in the legislature; but in a court, I think we have nothing to do with the policy of a case, the law is our guide." The view of the majority became settled and practically invariable in this country, until public agitation, led by Theodore Roosevelt, caused statutory enactments that have reversed the judicial policy, and of course there followed protection of the employer by liability insurance.

A third example—one that gave rise to much perplexity for many years was the doctrine in *Swift* v. *Tyson,* 16 Peters 1, that Federal Courts exercising jurisdiction on the ground of diversity of citizenship need not, in matters of substantive law, apply the non-statutory law of the State as declared by its highest Court, but were free to exercise an independent judgment on the common law as applied to the issues of the case. From that time this was sustained, notwithstanding occasional vigorous dissents in the Supreme Court, as by Mr. Justice Field in *Baltimore & Ohio R.R. Co.* v. *Bough,* 149 U.S. 401, and by Mr. Justice Holmes in the *Kuhn case,* 215 U. S., and in the *Black & White Taxicab case,* 276 U.S. This ghost has been laid by the Supreme Court's pronouncement in *Erie R. R. Co.* v. *Tompkins,* 304 U. S. 64.

In the law of patents we have become so accustomed to the application of a test of "patentability" based upon an inference as to what one of average skill in the calling would or would not have done, that few stop to consider whether the test has a basis in the statutory law. If it has,

then all questions of its probable or possible change are for Congres to consider. If it has no statutory basis, then the "man skilled in the art" is a ghost foisted on us by the courts and, as one of the most distinguished patent judges of our time once remarked of him, "He is the son of a sea-cook who gives us all the trouble in these patent cases."

I assure you that a careful study of the statutes now existing, and an examination of their antecedents back to the Statute of 1790, finds no basis for this creature's existence. The language of what is now Section 31, 35 U. S. C. A., or Sec. 4886 R. S., has not changed in any important particular for a hundred and fifty years. The Act of April 10, 1790, provided for the grant of a patent to any one setting forth that he had invented or discovered "any useful art, manufacture, engine, machine, or device, or any . . . improvement therein, not before known or used." The Act of 1793 made the language a little more clear by saying that the patent should be granted to any one who would allege that he had invented "any new and useful art, machine, manufacture, or composition of matter, or any new or useful improvement on any art, machine, manufacture, or composition of matter, not known or used before."

In passing, I may remark that there was in the Act of 1793 the only negative test, I believe, in any of the patent statutes enacted at any time. It provided "that simply changing the form or the proportions of any machine or composition of matter, in any degree, shall not be deemed a discovery." This came before Chief Justice Marshall, sitting at Circuit in *Davis* v. *Palmer,* 7 Fed. Cas. 154, and he said, at page 159:

> "In construing this provision the word 'simply' has, we think, great influence. It is not every change of form and proportion which is declared to be no discovery, but that which is simply a change of form or proportion, and nothing more. If, by changing the form and proportion, a new effect is produced, there is not simply a change of form and proportion, but a

change of principle also. In every case, therefore, the question must be submitted to the jury, whether the change of form and proportion, has produced a different effect."

So the great Chief Justice, notwithstanding an apparent limitation in the statute, used his fine powers of intellect to avoid undue restriction, in order to carry out the beneficial purpose of the statute as a whole.

The Act of 1836 adopted the language now appearing in the existing statute as to the requisites of a patent. It has remained substantially unchanged through the consolidated Patent Act of 1870 and still governs the Patent Office and the courts.

While our patent statute is based upon the Constitutional provision to which I shall come presently, it is nevertheless true that the genius of the law of patents, like that of much else of our law, came from England. There the exception to the statute of monopolies that granted letters patent for new manufacture was for the encouragement of those who would devise for themselves or bring from abroad, manufactures not yet known in England and whose introduction would give employment to additional people. Limited monopolies as a reward to these was made for the upbuilding of the country. That being the underlying purpose of our patent law, as I think it is, the only criteria of a legal grant are novelty and utility. Those are the exact tests of the patent statute, and have been for a hundred and fifty years.

It is interesting to note that Mr. Justice Story, in *Earle* v. *Sawyer,* decided in the Circuit Court in 1825, 8 Fed. Cas. 254, enlarged upon the requirements of novelty and utility and their effects. He indicated that the degree of mental effort involved has nothing to do with the question of patentability. This view of Story's was reiterated in several decisions, for example in *Whitney* v. *Emmett,* 29 Fed. Cas. 1074, at page 1083.

The doctrine that something beyond ordinary skill is necessary, seems to have originated in the door knob

case, *Hotchkiss* v. *Greenwood,* decided in the Supreme Court in 1850, 11 How. 248. It was decided in the lower court by Mr. Justice MacLean, 12 Fed. Cas. 553, and his view was rather along the line of the subsequent pronouncement of the majority in the Supreme Court. The improvement there consisted in making door knobs of clay or porcelain. Justice MacLean had charged the jury in the court below that if the knob of clay was simply a substitution of one material for another, the metal spindle and shank being the same as previously in common use, and the mode of connecting them by dove-tail to the knob being also the same, the patent was invalid because it was only the work of an ordinary mechanic. This view the Supreme Court adopted. However, Mr. Justice Woodbury dissented vigorously in the Supreme Court, and upon fundamental grounds for which he quoted much then existing authority,—including the opinions of Justice Story at Circuit. Justice Woodbury called attention to the text of the statute by saying, "All which the Act of Congress itself requires is that the invention be for 'any new and useful improvement'." The dissentient also prophesied that the prevailing opinion would raise difficulties, as of course it has for the past ninety years. It has been the view of commentators of authority like Benjamin R. Curtis, in his Treatise on the Law of Patents, that the Hotchkiss case involved really a question of double use, in the sense of being a new use of an old material, and so was really not necessary to determine the question the court decided.

However that may be, in later cases the Supreme Court has left no doubt of its belief that the patent statute requires or implies this third test, and not merely novelty and utility. For example in *Dunbar* v. *Meyers,* decided in 1876, 94 U. S. at page 197, in referring to the Hotchkiss case, the court said that unless "more ingenuity and skill were required in applying the said improvement than are possessed by an *ordinary mechanic* . . . there is an *absence of that degree of skill and ingenuity* which constitutes the essential element of every invention." That

doctrine has grown so strong now that the courts, in deciding patent cases, sometimes spend more time in speculating about what are proper tests of the existence or non-existence of something beyond the "expected skill of the calling," than they do in getting a complete apprehension of the improvement itself.

Curiously, too, the settled law is that *any* utility whatever, however remote from practical application, will satisfy that requirement of the statute; which is quite in contrast with the distance a patentee now has to go beyond "the expected skill of the calling".

The text of the statute is: "any person who has invented or discovered." Apparently much is supposed to turn upon the word "inventor" or the word "invention," as having an esoteric meaning. The Constitution, Article I, Section 8, Clause 8, provides: "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." I doubt if the framers had any notion that "inventor" connotes a person of more than the ordinary intellect or ingenuity, any more than that an author should be one of greater talent than that of a compiler. Centainly by etymology an inventor is only one who finds out. Webster defines him as one who "invents, a contriver, especially one who contrives something new or original, of a scientific or mechanical nature." An invention is defined by the lexicographer to be either the act of finding out, or discovering, or contriving, or else "that which is invented; as a contrivance, plan, or device, especially an original contrivance or apparatus."

Certainly the word "inventor" in the Constitution has no claim to greater dignity than the word "author." From the latter word in the same context with "inventors" has been derived the series of copyright statutes and the body of law interpreting them. Yet here it has been decided that no talent or genius is necessarily involved in making a "writing" that is subject of copyright. Novelty is all. Directories, chromolithographs for

advertising a circus, photographs whose sole novelty resides in a pose: these and other things that involve no claim to talent or genius are either specified in the copyright act by name, or found to be within its protection.

Why would it not be better to lay this ghost of the patent law? He is much more personable,—if one may be permitted to speak that way of a wraith,—than any of the others whom I have mentioned, for he requires the court in each case where he appears, to create either the man of genius who may have been responsible for the improvement *sub judice,* or the routineer in the industry that is *pro hac vice,* under the judicial microscope, who, the court concludes, ought to have created the improvement before him, although he did not.

I am wondering whether, in this particular juncture of our national existence, when so much effort is being given to the breaking of idols long worshipped by the courts, some great judicial iconoclast may not rise in his might and smash this fetish of our profession. If it were smashed, might not the lot of the lawyers and that of their clients be much simpler and safer than now? Today if a practitioner is asked for his opinion on a case where there is no anticipation but much of what one disgusted judge called, after reviewing it, "prior rot", he can only speculate on what the Court's mental reaction will be as to the status of the "journeyman" or "ordinary artisan" in the inventive picture created by the trial. Alas, it is too true that nowadays he can generally predict that no matter what the patent is, or what its accomplishments, some way will be found in the courts to defeat it. But suppose the patent were to stand upon the statute as written: then the counsellor asked for his opinion could state definitely that if the thing is new and useful, the patent is valid. Then the only remaining question would be: Does the defendant use it? Here the position of the invention in the art would have the same importance as it does now. If the inherent novelty were but trifling, a defendant could easily,—as now and heretofore,—avoid it. If the step forward had been a long one, a corresponding

breadth of construction would be given the patent. Thus the law itself would be much simplified, parties could act with much greater certainty than at present, and the courts would be freed from the specter that has troubled them almost beyond endurance.

In the end would we not come closer to the ideal expressed more than a hundred years ago by Jeremy Bentham, the great expounder of the true principles of legislation and their relation to the moral code? In his "Rationale of Rewards" he discussed the temporary monopoly of an invention in the following words:

> "It is an instance of a reward peculiarly adapted to the nature of the service, and adapts itself with the utmost nicety to those rules of proportion to which it is most difficult for reward, artificially instituted by the legislature, to conform. If confined, as it ought to be, to the precise point in which the originality of the invention consists, it is conferred with the least possible waste of expense. It causes a service to be rendered, which, without it, a man would not have a motive for rendering; and that only by forbidding others from doing that which, were it not for that service, it would not have been possible for them to have done. Even with regard to such inventions, for such there will be, where others besides him who possesses the reward have scent of the inventions, it is still of use by stimulating all parties and setting them to strive which shall first bring the discovery to bear. With all this it unites every property that can be wished for in a reward. It is variable, equable, commensurable, characteristic, exemplary, frugal, promotive of perseverance, subservient to compensation, popular and reasonable."

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