

PATENT-INFRINGEMENT SUITS AND THE RIGHT TO A JURY TRIAL

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This Article analyzes whether the Seventh Amendment affords a right to a jury trial in suits in which the owner of a patent seeks only equitable relief against an accused infringer. The existence of jury rights carries important consequences for litigants. Like many issues involving application of the Constitution, the availability and scope of the right to a jury depends on eighteenth-century English legal history. Current doctrine holds that litigants in

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equity had no right to a jury in patent cases in England c.1791 and therefore that litigants today who seek only injunctive relief possess no such right either. But as we demonstrate here, the relevant historical record shows the contrary, and thus many litigants have a constitutional right to a jury where the courts presently deny them. We reach our conclusion after undertaking the most comprehensive treatment of the subject to date, which includes marshaling hundreds of eighteenth-century records (mostly in manuscript) from the National Archives of the United Kingdom and elsewhere.

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INTRODUCTION

When it comes to determining the existence and extent of constitutional rights, English legal history matters.¹ This is especially true given that originalism now commands a supermajority on the Court. Perhaps more than ever before, courts require the assistance of legal historians to locate, interpret, and discuss English sources from the late

1. *E.g.*, *Crawford v. Washington*, 541 U.S. 36, 43–47 (2004) (Sixth Amendment); *Gamble v. United States*, 139 S. Ct. 1960, 1969–74 (2019) (Fifth Amendment); *N.Y. State Rifle & Pistol Ass’n v. Bruen*, 142 S. Ct. 2111, 2138–42 (2022) (Second Amendment); *Dobbs v. Jackson Women’s Health Org.*, 142 S. Ct. 2228, 2249–51 (2022) (Fourteenth Amendment).

eighteenth century. Our Article offers that assistance in an area that has been neglected by legal historians: whether the Seventh Amendment affords a right to a jury trial in suits in which the owner of a patent seeks only equitable relief against an accused infringer. Although certainly not as far reaching or life changing as other rights, it is nonetheless a constitutional right and one of substantial importance to those affected by it.² As Judge Nies stated in 1995: “No more important nor contentious an issue arises in patent law jurisprudence than the appropriate role of juries in patent litigation.”³

It has been over twenty-five years since the Court last assessed the scope of the constitutional right to a jury in a patent-infringement case.⁴ More remarkable, that decision has been its only direct pronouncement on the matter in the 230 years that patent infringement has been actionable.⁵ Before 1938, the division of trial courts into law and equity sides alleviated some of the need to address certain jury rights. The Seventh Amendment requires juries in “Suits at common law”;⁶ law courts always offered juries; and early juries tried nearly all infringement and validity issues. During the mid-to-late nineteenth century, courts also empowered judges to litigate infringement suits wholly in equity, without sharing responsibility with the law side, meaning that many cases employed bench trials instead.⁷ Although that doctrine implicated the constitutional right—the central point of this Article—litigants did not assert the right before the Court. “Many” juryless cases became most cases, and then nearly all cases. In 1940, after the merger of law and equity in 1938, only 2.5% of the patent

2. *Dimick v. Schiedt*, 293 U.S. 474, 486 (1935) (“Maintenance of the jury as a fact-finding body is of such importance and occupies so firm a place in our history and jurisprudence that any seeming curtailment of the right to a jury trial should be scrutinized with the utmost care.”).

3. *In re Lockwood*, 50 F.3d 966, 980–81 (Fed. Cir. 1995) (Nies, J., joined by Archer, C.J. & Plager, J., dissenting from denial of rehearing en banc); see also Kathleen M. O’Malley, *Foreword: Trial by Jury: Why It Works and Why It Matters*, 68 AM. U. L. REV. 1095 (2019).

4. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 372 (1996).

5. Act of Apr. 10, 1790, ch. 7, §§ 1, 4, 1 Stat. 109, 110, 111 (first federal patent act).

6. U.S. CONST. amend. VII.

7. Christopher Beauchamp, *The First Patent Litigation Explosion*, 125 YALE L.J. 848, 912–23 (2016) (tracing the shift of nineteenth-century American patent cases from law to equity).

cases that went to trial were heard by juries. And by 1970, the figure remained the same, with judges adjudicating 97.4% of trials.⁸

That is no longer the case. Many litigants now prefer juries whenever the Constitution says they can demand them, and they always can when the patentee seeks damages at trial (with or without injunctive relief). In the last ten years, juries tried 52.7% of all patent trials, and in the ten-year period before that, 66.4%.⁹ Empirical work offers one explanation for the move—juries are more likely than judges to find a patent valid, infringed, and willfully infringed.¹⁰ Patentees are thus the ones most inclined to ask for a jury. But sometimes both parties demand one, and other times the accused infringer alone wants one.¹¹ This strategic choice rests in the eyes of the beholder, based on a variety of factors and perceived advantages and disadvantages of a jury.¹² The key doctrinal question is whether the Seventh Amendment entitles one side to force a jury on the other.

The desire for juries has revived the question of whether litigants can be refused a jury trial entirely when a patentee seeks only equitable relief, *viz.*, an injunction. Twenty years ago, the Federal Circuit held that there was no right to a jury under that scenario.¹³ It did so again a few years later.¹⁴ In the first case, the accused infringer sought a jury, in the second, the patentee sought one.¹⁵ In ruling as it did, the court applied the historical test that currently governs the Seventh

8. Kimberly A. Moore, *Judges, Juries, and Patent Cases—An Empirical Peek Inside the Black Box*, 99 MICH. L. REV. 365, 366 & n.6 (2000).

9. See Table C-4 of Federal Judicial Caseload Statistics, 2001–2021, <https://www.uscourts.gov/statistics-reports/analysis-reports/federal-judicial-caseload-statistics>; see also Moore, *supra* note 8, at 367 (providing a chart of patent trial data from 1940 to 2000).

10. John R. Allison & Mark A. Lemley, *Empirical Evidence on the Validity of Litigated Patents*, 26 AIPLA Q.J. 185, 212–16 (1998); Moore, *supra* note 8, at 368, 380; Kimberly A. Moore, *Populism and Patents*, 82 N.Y.U. L. REV. 69, 110–11 (2007); Mark A. Lemley, Jamie Kendall & Clint Martin, *Rush to Judgment? Trial Length and Outcomes in Patent Cases*, 41 AIPLA Q.J. 169, 174–77 (2013).

11. Kimberly A. Moore, *Jury Demands: Who's Asking*, 17 BERKELEY TECH. L.J. 847, 855–59 (2002) (finding that 43% of accused infringers demand a jury; but also noting the limitations of the data given that defendants can rely on a plaintiff's demand under Rule 38 of the Federal Rules of Civil Procedure).

12. Philippe Signore, *On the Role of Juries in Patent Litigation* (pt. 1), 83 J. PAT. & TRADEMARK OFF. SOC'Y 791, 824–29 (2001) (summarizing pros and cons of jury trials).

13. *Tegal Corp. v. Tokyo Electron Am., Inc.*, 257 F.3d 1331, 1341 (Fed. Cir. 2001).

14. *In re Tech. Licensing Corp.*, 423 F.3d 1286, 1289–90 (Fed. Cir. 2005) (*per curiam*).

15. *Tegal*, 257 F.3d at 1338; *Tech. Licensing*, 423 F.3d at 1287.

Amendment. Distilled to its essence, that test obliges courts to uncover whether juries in England *c.*1791 would have tried the same sort of claim that a litigant contends requires a jury today.¹⁶ Citing no decisions from England or the relevant period, the Federal Circuit concluded that patent-infringement suits seeking equitable relief alone in eighteenth-century England would have been adjudicated wholly in a court of equity.¹⁷ That meant no right to a jury trial at all.

The doctrine has had a profound effect on infringement suits brought in generic-drug cases, where injunctions are typically the only available remedy.¹⁸ But it also affects other cases where a patentee cannot prove damages, does not wish to seek damages against a particular defendant or class of defendants, or simply does not want to expose itself to intrusive damages discovery. For their part, accused infringers cannot directly control a patentee's prayer for relief so as to ensure or avoid a jury trial (and they are also unable under current law to force a jury trial on invalidity by seeking declaratory relief on that point).¹⁹

The parties on the losing end on jury rights in the Federal Circuit asked the Court to grant certiorari, but it declined.²⁰ And there the issue has sat. No commentator has questioned or buttressed the doctrine with eighteenth-century authorities.²¹ The lone voice against it has been Judge Newman in dissents.²²

This Article undertakes the historical investigation that has thus far been lacking and draws on research collected over the last fifteen years.

16. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 376–78 (1996).

17. *Tegal*, 257 F.3d at 1340.

18. *E.g.*, *In re Apotex, Inc.*, 49 F. App'x 902, 902–03 (Fed. Cir. 2002).

19. *Tech. Licensing*, 423 F.3d at 1290–91 (holding separately that there is no constitutional right to a jury on invalidity when an accused infringer seeks declaratory relief on that issue); *see also* *Agfa Corp. v. Creo Prods. Inc.*, 451 F.3d 1366, 1373–75 (Fed. Cir. 2006).

20. *Tokyo Electron Am., Inc. v. Tegal Corp.*, 535 U.S. 927, 927 (2002); *Tech. Licensing Corp. v. U.S. Dist. Ct.*, 547 U.S. 1178, 1178–79 (2006).

21. A few commentators have written on this issue, arguing that there is no right to a jury trial, but they either do not engage with eighteenth-century English authorities or do so only superficially. *E.g.*, Brian D. Coggio & Sandra A. Bresnick, *The Right to a Jury Trial in Actions Under the Waxman-Hatch Act*, 52 *FOOD & DRUG L.J.* 259, 266–70 (1997); Brian D. Coggio & Timothy E. DeMasi, *The Right to a Jury Trial in Actions for Patent Infringement and Suits for Declaratory Judgment*, 13 *FORDHAM INTELL. PROP. MEDIA & ENT. L.J.* 205, 206–30 (2002); 5 ERIC E. BENSON, *PATENT LAW PERSPECTIVES* § 7.6[2][a], Lexis (database updated Dec. 2022) (the portion on jury rights was largely written by Martin Adelman).

22. *E.g.*, *Tech. Licensing*, 423 F.3d at 1294–96 (Newman, J., dissenting).

We reviewed manuscript records of infringement lawsuits stored in the National Archives of the United Kingdom, along with a host of other manuscript sources from various repositories in England and the United States. The historical record demonstrates that in c.1791, defendants in equity suits had a right to a jury trial on a patent's validity, and on infringement if that was contested alongside validity. Plaintiffs had a right to a jury trial on validity, infringement, or both, regardless of whether the defendant contested validity. Consequently, litigants have a broader jury right than current doctrine allows. Either the Court or the Federal Circuit should revisit the matter to consider aligning the doctrine with English history.

Part I describes the Court's approach to deciding Seventh Amendment issues generally and examines how American courts have over the years resolved jury-trial issues in patent suits filed in equity. Part II turns to England and briefly describes patents in the eighteenth century, the records we consulted, and the superior courts. Part III forms the bulk of the Article and focuses on the Court of Chancery—the principal equity court and the venue for nearly all patent-infringement disputes filed in equity. We lay out the court's basic procedures and the relief available there, before discussing why litigants had a right to adjudicate certain liability issues in a patent-infringement dispute with a jury before the court could grant final equitable relief. Lastly, Part IV revisits the chief American authorities on the subject and discusses the modern implications of our findings. Here, we also propose an alternative method by which some patentees could conceivably ensure a jury trial without relying as much on eighteenth-century history—by seeking nominal damages.

I. THE HISTORICAL TEST AND ITS APPLICATION

A. *General Principles*

The right preserved by the Seventh Amendment “is the right which existed under the English common law when the Amendment was adopted” in 1791.²³ Thus, the right to a jury trial depends largely, and sometimes exclusively, on English historical practice. This historical

23. *Balt. & Carolina Line, Inc. v. Redman*, 295 U.S. 654, 657 (1935); *accord* *Liberty Oil Co. v. Condon Nat'l Bank*, 260 U.S. 235, 243 (1922); *United States v. Wonson*, 28 F. Cas. 745, 750 (C.C.D. Mass. 1812) (No. 16,750) (Story, J.); *see also* U.S. CONST. amend. VII (“In Suits at common law, where the value in controversy shall exceed twenty dollars, the right of trial by jury shall be preserved . . .”).

inquiry comprises a two-step test in which courts must compare the modern-day claim, remedy sought, and specific issue to be tried by a jury, with the equivalent matters under the practice of the law and equity courts in England *c.*1791.²⁴ Whereas courts of law adjudicated contested factual claims with the use of a jury, equity courts operated without one (unless they saw a reason to send a suit to law for a jury).

In the first step, courts must ask whether they are “dealing with a cause of action that either was tried at law at the time of the founding or is at least analogous to one that was.”²⁵ This first entails reviewing the nature of the claim, which might alone provide the answer if, for example, the claim arises from a right originally created and enforced wholly in equity. But because the nature of a claim is not always clear—perhaps because the modern claim has no clear eighteenth-century analogue, or because plaintiffs could bring the claim at law or in equity—courts examine the remedy sought.²⁶ This often pushes the needle to one side because, in the late eighteenth century at least, some remedies were available in equity alone, such as injunctive relief, while others like statutory penalties were available solely at law. An ambiguous claim seeking both legal and equitable relief must be treated as one that would have been adjudicated at law.²⁷

Our Article focuses on this first step and addresses a scenario that the Court has yet to confront squarely—namely, cases where only equitable relief is sought but litigants in equity in the eighteenth

24. The Court’s Seventh Amendment jurisprudence within Article III courts is not a model of clarity. This represents our attempt to distill the Court’s current approach. For some cogent critiques of the historical test as the jurisprudence has evolved, see, e.g., Fleming James, Jr., *Right to a Jury Trial in Civil Actions*, 72 *YALE L.J.* 655 (1963); Charles W. Wolfram, *The Constitutional History of the Seventh Amendment*, 57 *MINN. L. REV.* 639 (1973); Martin H. Redish, *Seventh Amendment Right to Jury Trial: A Study in the Irrationality of Rational Decision Making*, 70 *NW. U. L. REV.* 486 (1975); Margaret L. Moses, *What the Jury Must Hear: The Supreme Court’s Evolving Seventh Amendment Jurisprudence*, 68 *GEO. WASH. L. REV.* 183 (2000); Suja A. Thomas, *A Limitation on Congress: “In Suits at common law,”* 71 *OHIO ST. L.J.* 1073 (2010); Renée Lettow Lerner, *The Failure of Originalism in Preserving Constitutional Rights to Civil Jury Trial*, 22 *WM. & MARY BILL OF RTS. J.* 811 (2014); Samuel L. Bray, *Equity, Law, and the Seventh Amendment*, 100 *TEX. L. REV.* 467 (2022).

25. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 376 (1996).

26. *Chauffeurs Local No. 391 v. Terry*, 494 U.S. 558, 565, 573 (1990); *Felmer v. Columbia Pictures Television, Inc.*, 523 U.S. 340, 348–50 (1998).

27. *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 510–11 (1959); *Curtis v. Loether*, 415 U.S. 189, 196 n.11 (1974); *accord Tights, Inc. v. Stanley*, 441 F.2d 336, 344 (4th Cir. 1971) (pre-Federal Circuit patent case).

century would have had a right to have certain liability issues tried at law with a jury before the court could decree equitable relief.²⁸

The second step applies if a court concludes that the modern-day cause of action would have been brought at law in the eighteenth century and thus tried with a jury. Examining the division of labor during and after a trial, this step inquires whether the particular issue sought to be tried by a jury, or an “analogous” one, was “decided by judge or by jury . . . at the time the Seventh Amendment was adopted.”²⁹ If the historical record provides a “clear answer”—in the form of an “established practice” showing that courts left the issue to juries or that judges alone decided the matter—the history controls and the inquiry ends.³⁰ When the history is unclear, however, courts are first tasked with considering American precedents that characterize the issue as one for the judge or jury, typically by labeling it as one of law or fact.³¹ “[F]unctional considerations” also play a role, meaning that courts must consider the judicial actor best suited to decide the issue, along with the value of a ruling from a judge over a verdict from a jury.³²

28. Notably, some of the Court’s earliest thinking in this area appears to have focused more on the nature of the right at issue than the remedy. In *Parsons v. Bedford*, the Court stated that the Seventh Amendment applied to “suits in which *legal* rights were to be ascertained and determined, in contradistinction to those where equitable rights alone were recognized, and equitable remedies were administered.” 28 U.S. (3 Pet.) 433, 447 (1830).

29. *City of Monterey v. Del Monte Dunes at Monterey, Ltd.*, 526 U.S. 687, 718 (1999); accord *Markman*, 517 U.S. at 378.

30. *Markman*, 517 U.S. at 377, 378, 380.

31. *Id.* at 377–78, 384–88, 384 n.10.

32. *Id.* at 388–91; accord *City of Monterey*, 526 U.S. at 718–21. The requirement that the “value in controversy shall exceed” twenty dollars does not appear to be much of a hurdle today, given the paltry amount. Moreover, in patent-infringement suits that seek equitable relief alone, nothing prevents a party from alleging in a pleading or arguing before a court that the value in controversy exceeds twenty dollars for purposes of the Seventh Amendment. *Cf. Hunt v. Wash. State Apple Advert. Comm’n*, 432 U.S. 333, 347 (1977) (“In actions seeking declaratory or injunctive relief, it is well established that the amount in controversy [for subject-matter jurisdiction] is measured by the value of the object of the litigation.”). The Federal Circuit also allows ongoing royalties in lieu of a final injunction—a form of equitable monetary relief. *Paice LLC v. Toyota Motor Corp.*, 504 F.3d 1293, 1313–16 (Fed. Cir. 2007). For more on the value in controversy, see *infra* text accompanying notes 331–336.

B. Patent Cases

A few outliers aside, no one doubts that a patent-infringement action seeking damages alone would have only been tried at law in England *c.*1791, and thus that a case in the same position today offers a right to a jury on all issues triable under step two of the Court's historical test.³³ In *Markman v. Westview Instruments, Inc.*, the parties and the Court assumed as much when the latter ruled that all aspects of disputed claim construction are matters for the judge.³⁴ The Court quickly cleared the first step because the petition for review noted that the patentee sought damages.³⁵ Thus, the Court said that patent cases were "tried at law in the 18th century, and there is no dispute that infringement cases today must be tried to a jury."³⁶ Under the second step, the Court found that the historical record showed no established practice of juries construing claims or the like *c.*1791. It thus looked to its precedents and functional considerations to conclude that judges were better suited than juries to interpret claims.³⁷

The equity side of the ledger is much more complicated. The American jurisprudence falls into two categories: (1) cases where the patentee seeks equitable and legal relief, and (2) cases where the

33. Mark Lemley and a few judges have argued that because patent rights are public franchises litigants may possess no rights to a jury on validity in cases filed in Article III courts. Mark A. Lemley, *Why Do Juries Decide if Patents Are Valid?*, 99 VA. L. REV. 1673, 1679, 1723 (2013); Petition for a Writ of Certiorari at 15, *Nichia Corp. v. Everlight Elecs. Co.*, 139 S. Ct. 183 (2018) (No. 17-1707), 2018 WL 3141455, at *15; *In re Lockwood*, 50 F.3d 966, 981–83 (Fed. Cir. 1995) (Nies, J., joined by Archer, C.J. & Plager, J., dissenting from denial of rehearing en banc). But the Court appears to have previously rejected the core of that argument in another context. *Curtis v. Loether*, 415 U.S. 189, 195 (1974) ("[When Congress does not] entrust enforcement of statutory rights to an administrative process [and instead] . . . provides for enforcement of statutory rights in an ordinary civil action in the district courts [of Article III], . . . a jury trial must be available if the action involves rights and remedies of the sort typically enforced in an action at law."); *Pernell v. Southall Realty*, 416 U.S. 363, 370, 383 (1974) ("[When] Congress . . . has provided that actions . . . be brought as ordinary civil actions[, rather than as claims in administrative tribunals,] . . . and where the action involves rights and remedies recognized at common law, it must preserve to parties their right to a jury trial.").

34. *Markman*, 517 U.S. at 390–91.

35. Petition for a Writ of Certiorari at i, *Markman*, 517 U.S. 370 (No. 95-26), 1995 WL 17063340, at *i ("In a patent infringement action for damages, is there a right to a jury trial under the Seventh Amendment of the United States Constitution of genuine factual disputes about the meaning of a patent?").

36. *Markman*, 517 U.S. at 377.

37. *Id.* at 372.

patentee seeks only equitable relief. The way courts treated these scenarios changed over time. Both involve what became known as the equity clean-up doctrine. That doctrine stated that once a court had jurisdiction over a suit in equity, the court could, without any need to send the case to its law side for a jury trial, adjudicate rights that otherwise would be resolved at law, and sometimes even dispense remedies that were otherwise legal.³⁸

As we discuss below, for many years courts held that a patentee who sought damages and an injunction had no right to a jury trial on any issue in an infringement case. That began to change in the 1950s at the urging of litigants, partly due to the Patent Act of 1952³⁹ and partly to the Court rescinding the clean-up doctrine in cases outside of patent law. *Markman*, in fact, involved a patentee who sought damages *and* injunctive relief,⁴⁰ and yet neither the parties nor the Court thought twice in assuming that the patentee's case cleared the first step of the Court's historical test. Additionally, litigants have disputed whether cases seeking equitable relief alone, namely, an injunction, confer a right to a jury. Across the years, the cases have said yes, then no, then yes, and then no. The final word on the subject came from the Federal Circuit twenty years ago.

Sullivan v. Redfield in 1825 exemplifies the early view on these issues.⁴¹ There, Justice Thompson stated that in cases properly filed in equity, the validity of an invention patent was something on which the parties had a right to a jury, and thus the court was obligated to send the parties to the court's law side for trial:

Whether the complainant's patent is good and valid so as ultimately to secure to him the right he claims, is not a question for decision upon the equity side of this court. That is a question which belongs to a court of law, in which the parties have a right of trial by a jury. The equity jurisdiction exercised by the court over patents for inventions is merely in aid of the common law, and in order to give

38. See generally A. Leo Levin, *Equitable Clean-Up and the Jury: A Suggested Orientation*, 100 U. PA. L. REV. 320 (1951).

39. Act of July 19, 1952, ch. 950, 66 Stat. 792.

40. Brief of Appellants at 15, *Markman v. Westview Instruments, Inc.*, 52 F.3d 967 (Fed. Cir. 1995) (No. 92-1049), 1992 WL 12014692, at *15.

41. *Sullivan v. Redfield*, 23 F. Cas. 357 (C.C.D.N.Y. 1825) (No. 13,597).

more complete effect to the provisions of the statute under which the patent is granted.⁴²

As we demonstrate later, Justice Thompson's understanding of equity practice in patent cases comported with the English practice of *c.*1791 and of his own time.

But a different line of thinking gained traction in patent cases after the Patent Act of 1836.⁴³ Justices riding circuit, and then the Court, concluded that judges sitting in equity could adjudicate all matters relating to liability, including the validity of the patent. This followed because traditional equitable practices (as they viewed them) permitted as much,⁴⁴ and because the patent statutes (the 1836 Act⁴⁵ and the 1870 Act⁴⁶) allowed it as well.⁴⁷ In 1856, Justice Grier encapsulated the point by stating that equity courts did *not* exercise their power “merely as ancillary to a court of law.”⁴⁸ It was the other way around—when a

42. *Id.* at 359; *accord* *Rogers v. Abbot*, 20 F. Cas. 1107, 1107 (C.C.E.D. Pa. 1825) (No. 12,004) (Washington, J.); *Ogle v. Ege*, 18 F. Cas. 619, 620 (C.C.D. Pa. 1826) (No. 10,462) (Washington, J.); WILLARD PHILLIPS, *THE LAW OF PATENTS FOR INVENTIONS* 452 (Boston, 1837) (“The proceeding is ancillary, merely, to the action at law for damages; which may be commenced before, or at the same time with, or after the bill for an injunction.”); GEORGE TICKNOR CURTIS, *A TREATISE ON THE LAW OF PATENTS* § 340, at 383–84 (Boston, 1849) (“A denial in the answer, as to the validity of the patent, or the fact of infringement, will be sufficient to entitle the defendant to further investigation in an action at law . . .”); *accord* 3 WILLIAM C. ROBINSON, *THE LAW OF PATENTS FOR USEFUL INVENTIONS* § 1082, at 391–92 (Boston, 1890) (describing early American views on equitable jurisdiction in patent cases).

43. *Beauchamp*, *supra* note 7, at 914, 916–18 (noting among other things how George Ticknor Curtis had to rewrite a section of his treatise on patent law in 1867, see CURTIS, *supra* note 42, to reflect the shift in American authorities); see also Adam Mossoff, *The Injunction Function: How and Why Courts Secure Property Rights in Patents*, 96 NOTRE DAME L. REV. 1581, 1598–99 (2021).

44. *Motte v. Bennett*, 17 F. Cas. 909, 910–14 (C.C.D.S.C. 1849) (No. 9,884) (Wayne, J.); *Goodyear v. Day*, 10 F. Cas. 678, 683 (C.C.D.N.J. 1852) (No. 5,569) (Grier, J.).

45. Act of July 4, 1836, ch. 357, 5 Stat. 117.

46. Act of July 8, 1870, ch. 230, 16 Stat. 198.

47. *Sickles v. Gloucester Mfg. Co.*, 22 F. Cas. 94, 95–96 (C.C.D.N.J. 1856) (No. 12,841) (Grier, J.); *Blank v. Mfg. Co.*, 3 F. Cas. 685, 686 (C.C.D. Del. 1856) (No. 1,532) (Grier, J.); *Cochrane v. Deener*, 94 U.S. 780, 782–84 (1877); *Root v. Ry. Co.*, 105 U.S. 189, 205 (1882).

48. *Blank*, 3 F. Cas. at 686; *Sickles*, 22 F. Cas. at 96; see also *Sanders v. Logan*, 21 F. Cas. 321, 323 (C.C.W.D. Pa. 1861) (No. 12,295) (Grier, J.) (“The circuit courts . . . do not merely act as ancillary to a court of law, and therefore do not require the patentee to establish his legal right in a court of law and by the verdict of a jury.”); *accord* *Goodyear v. Providence Rubber Co.*, 10 F. Cas. 712, 717 (C.C.D.R.I. 1864) (No. 5,583)

court acquired equitable jurisdiction in a patent case, law played second fiddle to equity (if it played at all). For its part, the Court expressed the equitable clean-up doctrine as follows: a court could “determine directly and for itself, . . . all questions incidental to the exercise of its jurisdiction, notwithstanding they may be questions affecting legal rights and legal titles.”⁴⁹ The doctrine was trans-substantive and thus functioned outside of patent law as well.⁵⁰

In 1849, Justice Wayne rebuffed a Seventh Amendment challenge to this doctrine in patent cases. As he saw it, equity courts had a concurrent jurisdiction with law courts (so long as the plaintiff had no adequate remedy at law—the test for equitable jurisdiction). Accordingly, defendants in equity had no right to demand that the validity of a patent be tested at law. He acknowledged that, at the founding of the United States, the Court of Chancery in England did send validity to law to be tried, but he viewed that power as wholly discretionary.⁵¹

In 1881 and 1882, the Court appeared to concur on the constitutional point in a roundabout way. First, in *Barton v. Barbour*, the Court ruled that one could not sue a receiver in a personal-injury action for damages in federal court—where a right to a jury would attach—without leave of the state court that appointed the receiver.⁵² Responding to an argument that this deprived the plaintiff of her right to a jury under the Seventh Amendment, the Court discussed in dictum the lack of the right in equity cases generally. Citing patent cases as an example, the Court stated that it was “now the constant practice of courts of equity” to adjudicate validity and other issues of fact themselves.⁵³ Second, in *Root v. Railway Co.*, which was a patent case filed in equity that the defendant argued belonged jurisdictionally on the law side, the Court appeared to make the inadequate-remedy-at-law

(Clifford, J.); *Hoffheins v. Brandt*, 12 F. Cas. 290, 290–91 (C.C.D. Md. 1867) (No. 6,575).

49. *Root*, 105 U.S. at 205.

50. *E.g.*, FED. EQ. R. 23 (1912) (“If in a suit in equity a matter ordinarily determinable at law arises, such matter shall be determined in that suit according to the principles applicable, without sending the case or question to the law side of the court.”).

51. *Motte v. Bennett*, 17 F. Cas. 909, 910–15 (C.C.D.S.C. 1849) (No. 9,884) (Wayne, J.).

52. *Barton v. Barbour*, 104 U.S. 126, 128, 131, 136–37 (1881).

53. *Id.* at 133–34 (“The jurisdiction of a court of equity to try such issues [in patent cases] according to its own course of practice is too well settled to be shaken.”).

requirement the main sentry enforcing the Seventh Amendment.⁵⁴ Yet, the specific issue decided there was whether trial courts could exercise equity jurisdiction when a patentee sued an accused infringer for an accounting of his profits only and no injunction.⁵⁵

The equity clean-up doctrine swept more into equity than just liability issues; it also pulled in damages after 1870. Before the 1870 Act, the remedy available at law was the plaintiff's damages, and in equity injunctive relief and the defendant's profits.⁵⁶ Congress found the compensatory remedy in equity inadequate because some infringers

54. *Root*, 105 U.S. at 206, 212–13.

55. *Id.* at 190, 216–17 (affirming trial court's decision to dismiss the suit because the plaintiff had a remedy at law). In practice, the inadequacy test was more of a lap dog than a sheep dog, as it rarely pushed infringement suits to law. *Root* was atypical because the patent expired before the complaint was filed, and so the plaintiff sought only retrospective relief. *Id.* at 189. When a plaintiff prayed for an injunction to stop prospective infringements, which was the usual course, equity jurisdiction was almost unassailable. Damage awards at law covered past wrongs only, and thus the remedy against recidivists required additional actions against them. It was this prospect that made the legal remedy inadequate and that gave the equity side of federal courts the jurisdiction and opportunity to enjoin the defendant once and for all. *See generally* H. Tomás Gómez-Arostegui & Sean Bottomley, *The Traditional Burdens for Final Injunctions in Patent Cases c. 1789 and Some Modern Implications*, 71 CASE W. RESV. L. REV. 403, 420–26, 434–35 (2020); Mossoff, *supra* note 43, at 1599–1601.

Today, the inadequate-remedy-at-law requirement does not function effectively to preserve the right to a jury trial, even when a court concludes that the plaintiff has an adequate remedy at law. The analysis comes too late to do so (at least on liability). At the time of the *Root* decision, if a defendant who had been sued in equity wished to go to law, she could demur on jurisdictional grounds at the outset of the federal case. If successful, the court would dismiss the suit so that it could be refiled at law where the parties would receive a jury trial. Nowadays, after the merger of law and equity procedure in 1938, trial courts in equity-only cases regularly apply the inadequacy test at the final remedy stage of the suit and only after already ruling on liability in favor of the patentee during a bench trial. If the trial judge concludes that she must deny final injunctive relief because the patentee has an adequate remedy at law—as many judges do today, see Christopher B. Seaman, *Permanent Injunctions in Patent Litigation After eBay: An Empirical Study*, 101 IOWA L. REV. 1949, 1994 (2016), including sometimes erroneously, see Gómez-Arostegui & Bottomley, *supra*, at 441–42—then the right to a jury on liability has already been lost. The court does not scrap all the work undertaken at the bench trial in order to start over with a jury to re-adjudicate liability, despite what arguably constitutes a violation of the Seventh Amendment under *Root*. And if the plaintiff decides in a subsequent action to sue the same defendant for damages for any new, unjoined infringements, much of that action will be collaterally estopped by the bench-trial findings. *See generally* Parklane Hosiery Co. v. Shore, 439 U.S. 322, 333–35 (1979).

56. *Elizabeth v. Pavement Co.*, 97 U.S. 126, 138 (1878).

generated negligible or no profits,⁵⁷ and so the 1870 Act empowered equity courts to award damages as well. Tracking the dual sides of the courts at the time, one section of the Act provided that actions at law offered damages,⁵⁸ and another provided that equity suits offered injunctive relief, defendants' profits, and plaintiffs' damages.⁵⁹ In *Root*, the Court called the new damages provision on the equity side a remedy that was, though the same as the remedy on the law side, merely "incident[al] to the right to an account" of profits, which in turn was "incidental to some other equity," such as an injunction.⁶⁰

In light of this characterization, lower courts interpreted the 1870 Act and its progeny to deny a party a right to a jury trial on damages when the plaintiff sued in equity for both injunctive relief and damages (in addition to denying it on liability).⁶¹ That is, courts were not obligated to send damages to their law sides for a jury trial. As the Court stated in another context, the Seventh Amendment did not apply to "cases where recovery of money damages is an incident to equitable relief even though damages might have been recovered in an action at law."⁶² The merger of law and equity procedure in 1938, now administered in a single court system, did not change this approach. Although cases were no longer filed "at law" or "in equity," lower courts ruled that the only way to ensure a jury trial on *any issue* in a patent case was by seeking damages alone.⁶³

57. 3 ROBINSON, *supra* note 42, § 1154, at 528–30.

58. Act of July 8, 1870, ch. 230, § 59, 16 Stat. 198, 207.

59. *Id.* § 55, 16 Stat. at 206.

60. *Root*, 105 U.S. at 202, 215–16. The Court interpreted the damages provision in section 55 to mean that damages were available insofar as they exceeded the defendant's profits, which of course might be zero. *Marsh v. Seymour*, 97 U.S. 348, 359–60 (1878); *Root*, 105 U.S. at 212.

61. *E.g.*, *Filer & Stowell Co. v. Diamond Iron Works*, 270 F. 489, 492 (7th Cir. 1921).

62. *NLRB v. Jones & Laughlin Steel Corp.*, 301 U.S. 1, 48 (1937); *accord* *Porter v. Warner Holding Co.*, 328 U.S. 395, 399 (1946) ("[W]here . . . the equitable jurisdiction of the court has properly been invoked for injunctive purposes, the court has the power to decide all relevant matters . . . and to award complete relief even though the decree includes that which might be conferred by a court of law.").

63. *E.g.*, *Bellavance v. Plastic-Craft Novelty Co.*, 30 F. Supp. 37, 38–39 (D. Mass. 1939); *Comfy Mfg. Co. v. Dyer-Gruen-Jackson, Inc.*, 2 F.R.D. 293, 293–94 (E.D. Pa. 1942); *Bereslavsky v. Caffey*, 161 F.2d 499, 500 (2d Cir. 1947); *Bereslavsky v. Kloeb*, 162 F.2d 862, 863–64 (6th Cir. 1947); *Davies v. Allied Indus. Prods., Inc.*, 100 F. Supp. 109, 109–10 (N.D. Ill. 1951).

The Patent Act of 1952 removed the pre-merger artifacts of previous statutes. Treating patent infringement as a consolidated “civil action,” just as the Rules of Civil Procedure did, Congress provided for injunctive relief in one section of the Act, and damages in another.⁶⁴ A few blips aside,⁶⁵ courts thought that the change made a difference, and that an infringement action that sought damages and injunctive relief should no longer be characterized as one in which the legal relief was incidental to the equitable relief. Thus, so long as a patentee sought damages at trial, there would be a right to a jury, even if also seeking injunctive relief.⁶⁶

Also driving the change was the Court’s rejection in 1959 of how the equity clean-up doctrine affected jury rights under the Seventh Amendment. The Court summed up the change in *Curtis v. Loether* in 1974, a case involving a single claim brought under the Civil Rights Act of 1968:

[A question arose] as to whether the action should be viewed as one for damages and injunctive relief, or as one for damages alone, for purposes of analyzing the jury trial issue [It makes no difference]. [I]f [a] legal claim [for damages] is joined with an equitable claim [for injunctive relief], the right to jury trial on the legal claim, including all issues common to both claims, remains

64. Act of July 19, 1952, ch. 950, §§ 281 (“civil action”), 283 (injunctions), 284 (damages), 66 Stat. 792, 812–13; FED. R. CIV. P. 2 (“There is one form of action—the civil action.”). On the death of the defendants’ profits as a remedy, see Caprice L. Roberts, *The Case for Restitution and Unjust Enrichment Remedies in Patent Law*, 14 LEWIS & CLARK L. REV. 653, 656–68 (2010).

65. *E.g.*, *Etablissements Neyrpic v. Elmer C. Gardner, Inc.*, 175 F. Supp. 355, 358–60 (S.D. Tex. 1959); *Railex Corp. v. Joseph Guss & Sons, Inc.*, 40 F.R.D. 119, 123 (D.D.C. 1966). The blip is somewhat understandable given a note in the 1952 Act. 35 U.S.C. § 281 Reviser’s Note (1952) (“[T]here would be, of course, a right to a jury trial when no injunction is sought.”).

66. *E.g.*, *Nat’l Dryer Mfg. Corp. v. Dryer Co. of Am.*, 130 F. Supp. 912, 913 (E.D. Pa. 1955); *Inland Steel Prods. Co. v. MPH Mfg. Corp.*, 25 F.R.D. 238, 246 (N.D. Ill. 1959); *Thermo-Stitch, Inc. v. Chemi-Cord Processing Corp.*, 294 F.2d 486, 490–91 (5th Cir. 1961); *AMF Tuboscope, Inc. v. Cunningham*, 352 F.2d 150, 153–55 (10th Cir. 1965); *Kennedy v. Lakso Co.*, 414 F.2d 1249, 1251–53 (3d Cir. 1969); *Tights, Inc. v. Stanley*, 441 F.2d 336, 344 (4th Cir. 1971); *Windsurfing Int’l, Inc. v. Ostermann*, 534 F. Supp. 581, 585 (S.D.N.Y. 1982). But when a patentee sought only equitable relief the parties had no right to a jury trial. *E.g.*, *Filmon Process Corp. v. Sirica*, 379 F.2d 449, 451–52 (D.C. Cir. 1967).

intact. The right cannot be abridged by characterizing the legal claim as “incidental” to the equitable relief sought.⁶⁷

Later, the Court noted in a case under the Clean Water Act that equity clean-up was particularly inapt when a statute authorized legal and equitable relief in separate statutory sections.⁶⁸ Certainly, in that instance, praying for equitable relief and legal damages would not destroy the jury right that one might otherwise have if they had sought damages alone.

As settled as law-only cases had always been, and equity-only and mixed cases had become, litigants revisited equity-only cases after 1995. Many of the disputes involved claims brought under the Hatch-Waxman Act,⁶⁹ which regulates the manufacture of generic drugs and often only permits injunctive relief. Patentees would seek injunctive relief alone, and typically accused infringers counterclaimed for declaratory relief of invalidity and non-infringement. Some trial courts ruled that a jury trial on validity and infringement was required.⁷⁰ This move was largely prompted by an unpublished disposition from the Federal Circuit in which it held the same thing.⁷¹ Other courts held there was no right.⁷²

The Federal Circuit has since addressed the issue in two cases. It first ruled in 2001 that a defendant, and by implication a plaintiff, is not entitled to a jury trial in an infringement suit when the plaintiff seeks

67. *Curtis v. Loether*, 415 U.S. 189, 196 n.11 (1974) (citing *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 509–11 (1959); *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 469–73 (1963)); *accord* *Ross v. Bernard*, 396 U.S. 531, 538 (1970) (noting that “legal claims are not magically converted into equitable issues by their presentation to a court of equity in a derivative suit”).

68. *Tull v. United States*, 481 U.S. 412, 424–25 (1987).

69. Drug Price Competition and Patent Term Restoration (Hatch-Waxman) Act of 1984, Pub. L. No. 98-417, § 202, 98 Stat. 1585, 1603 (codified in relevant part at 35 U.S.C. § 271(e)).

70. *E.g.*, *Hoechst Marion Roussel, Inc. v. Par Pharm., Inc.*, No. 95-3673, 1996 WL 468593, at *4 (D.N.J. Apr. 26, 1996); *Zeneca Ltd. v. Pharmachemie B.V.*, No. 96-12413-RCL, 1998 WL 1013126, at *1 (D. Mass. Oct. 8, 1998); *Warner-Lambert Co. v. Purepac Pharm. Co.*, No. 98-2739, 2001 WL 883232, at *1–4 (D.N.J. Mar. 30, 2001); *see also* *Minn. Auto., Inc. v. Stromberg Hydraulic Brake & Coupling Co.*, No. 4-69-Civ-313, 1970 WL 10104, at *1 (D. Minn. Sept. 14, 1970).

71. *In re SGS-Thomson Microelecs., Inc.*, 60 F.3d 839, at *1–2 (Fed. Cir. 1995), *cert. denied*, 516 U.S. 931 (1995).

72. *E.g.*, *Glaxo Wellcome Inc. v. Geneva Pharms. Inc.*, No. 94-CV-1921, 1997 WL 842429, at *1–2 (D.N.J. July 15, 1997); *Bayer AG v. Schein Pharm., Inc.*, No. 99-2181, 2000 U.S. Dist. LEXIS 20718, at *4–5, *9–10 (D.N.J. Feb. 23, 2000); *Pfizer Inc. v. Novopharm Ltd.*, No. 00-C-1475, 2001 WL 477163, at *4 (N.D. Ill. May 3, 2001).

equitable relief alone and the defendant raises an affirmative defense of invalidity.⁷³ The court stated that in light of the relief sought, it was “clear that [the plaintiff] would have needed, in eighteenth century England, to bring its case in a court of equity.”⁷⁴ Therefore, it ruled, there was “no doubt that neither party had a right to a jury.”⁷⁵ The court extended the ruling in 2005 to where the plaintiff sought declaratory relief of invalidity and non-infringement, and the patentee counterclaimed for infringement, sought equitable relief alone, and demanded a jury trial.⁷⁶ The court reiterated that the patentee’s “decision to seek only an injunction meant that it lost its right to a jury on the related invalidity claims.”⁷⁷ The court further held that a claim for declaratory relief of invalidity did not trigger a jury right on that issue, believing the claim had no eighteenth-century analogue.⁷⁸ The losing parties in both cases asked the Court to grant certiorari on the jury issues, but it declined.⁷⁹

Although not stated expressly in these two decisions, the Federal Circuit fell back on the notion first espoused by Justice Wayne in 1849, and later assumed by others, that parties in patent cases *c.*1791 had no right in an equity suit to have the validity of a patent tried at law. Though aware that the English Court of Chancery could send a dispute to law, the Federal Circuit concluded based on mid-to-late nineteenth-century American authorities that in “18th-century England, if a claim was in the court of equity, the equity court had the discretion to submit a claim to a jury but was never required to submit any issue to a jury.”⁸⁰

73. *Tegal Corp. v. Tokyo Electron Am., Inc.*, 257 F.3d 1331, 1341 (Fed. Cir. 2001).

74. *Id.* at 1340.

75. *Id.* at 1341.

76. *In re Tech. Licensing Corp.*, 423 F.3d 1286, 1286–87 (Fed. Cir. 2005) (*per curiam*).

77. *Id.* at 1289–90 (overruling *In re SGS-Thomson Microelecs., Inc.*, 60 F.3d 839, 839 (Fed. Cir. 1995), *sub silentio*); *see also In re Impax Labs., Inc.*, 171 F. App’x 839, 840 (Fed. Cir. 2006).

78. *Tech. Licensing*, 423 F.3d at 1290. Specifically, the court ruled that the closest eighteenth-century analogue at common law—an action to revoke a patent with a writ of *scire facias*—could only succeed when a proponent proved fraud, not simply invalidity. *Id.* (citing *In re Lockwood*, 50 F.3d 966, 974 n.9 (Fed. Cir. 1995), *vacated* 515 U.S. 1182 (1995)).

79. *Tokyo Electron Am., Inc. v. Tegal Corp.*, 535 U.S. 927, 927 (2002); *Tech. Licensing Corp. v. U.S. Dist. Ct.*, 547 U.S. 1178, 1178–79 (2006).

80. *AIA Am., Inc. v. Avid Radiopharms.*, 866 F.3d 1369, 1373–74 (Fed. Cir. 2017) (citing *Garsed v. Beall*, 92 U.S. 684, 695 (1876)); *accord Lockwood*, 50 F.3d at 976 (citing *Root v. Ry. Co.*, 105 U.S. 189, 205–06 (1882)), *vacated* 515 U.S. 1182 (1995).

Judge Newman has twice offered a different take on this point, one being in a dissent to the 2005 case.⁸¹ Reading the few relevant authorities available to her, she concluded that in *c.*1791 English equity courts were obligated to send patent validity issues to law, at least when the defendant contested validity.⁸²

Judge Newman is correct. We turn now to the eighteenth century to show why.

II. PATENT LITIGATION IN EIGHTEENTH-CENTURY ENGLAND

In the eighteenth century, the Crown could grant privileges by letters patent for many reasons. The patent rolls in the National Archives of the United Kingdom are replete with a variety of grants that passed under the Great Seal of England. These grants resulted in “letters patent,” written on parchment, that issued to patentees with the Great Seal appended thereto. Most well known today, of course, are patents for inventions. The right of the King to grant exclusive rights to inventors was already long standing by the eighteenth century. As a prerogative function of the Crown, it was derived from and constrained by the common law.⁸³

The Statute of Monopolies, enacted on May 29, 1624,⁸⁴ did not create patents of invention, a statutory claim, or statutory remedies for patent infringement. Rather, the statute was largely declaratory of the common law and further constrained the Crown’s ability to issue patents.⁸⁵ Patents of invention could last for no more than fourteen years and issue only to the “true and first Inventor” of a “new

81. *Tech. Licensing*, 423 F.3d at 1294–95 (Newman, J., dissenting).

82. *Id.*; *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 1011–13 (Fed. Cir. 1995) (Newman, J., dissenting).

83. *E.g.*, ACA DNP: MS 9, f. 48^v (Str. Ch. Feb. 1, 1608/9) (marginal note) (“Whosoever bringeth any new invention to the Commonwealth, the King may priviledge &c for some years, till he [the patentee] have made up his charges, and the common law is so, & so adjudged.”); *accord* *Taylors de Ipswich v. Sherring*, 1 Rolle 4, 4–5, *sub nom.* *Clothworkers of Ipswich Case*, Godb. 252, 254 (K.B. 1614).

84. Statute, 1624, 21 Jac. 1 c. 3; 3 H.L. JOUR. 425 (May 29, 1624) (royal assent). The provisions of the statute that are relevant here went into effect retroactively as of the start of the Parliamentary session on Feb. 12, 1623/4. *See* HANDBOOK, *supra* note *, at 108 (describing retroactive application of statutes); HANDBOOK OF BRITISH CHRONOLOGY 574 (E.B. Fryde, D.E. Greenway, S. Porter & I. Roy eds., 3d ed. 1996) (date of the relevant Parliamentary session).

85. *See, e.g.*, *Millar v. Taylor*, 4 Burr. 2303, 2323 (K.B. 1769) (Willes, J.) (“Patentees for new Inventions are left, by that Statute, to the Common Law, and the Remedies which follow the Nature of their Right.”).

Manufacture[] within this Realme,” which, at the time of issuing the patent, had not already been put in “use” in the realm by another.⁸⁶

The conventional wisdom for many years was that there was not very much patent-infringement litigation in the eighteenth century,⁸⁷ and the Court assumed that any “patent litigation had remained within the jurisdiction of the Privy Council until 1752 and hence without the option of a jury trial.”⁸⁸ Jim Oldham disabused us of the first notion thirty years ago when he delved deeply into the trial notes of Lord Mansfield of the King’s Bench.⁸⁹ And yet to glean insight into English patent practice *c.*1791, lawyers, judges, and most academics still largely rely on a small set of published eighteenth-century case reports, along with nineteenth-century English and American authorities, some from as late as ninety years after 1791. This is understandable. Courts, litigants, and academics are typically unaware that many records survive from the period, and of those who are aware, they have neither the time nor the resources to investigate them fully.

We have consulted numerous muniments of eighteenth-century practice, regardless of whether in print or manuscript. Naturally, we concentrate on sources that were extant in 1791, but we have also reviewed later sources because they sometimes discuss or reflect earlier practice. The Court has previously consulted post-ratification sources as confirmation or corroboration of pre-ratification sources.⁹⁰ We are mindful that the Court has yet to settle in the Seventh Amendment context whether “actual English common-law practice” trumps the

86. Statute, 1624, 21 Jac. 1 c. 3, § 6.

87. *E.g.*, Edward C. Walterscheid, *The Early Evolution of the United States Patent Law: Antecedents* (pt. 3), 77 J. PAT. & TRADEMARK OFF. SOC’Y 771, 775–76 (1995).

88. *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 381 (1996) (citing Walterscheid, *supra* note 87, at 771–76).

89. 1 JAMES OLDHAM, *THE MANSFIELD MANUSCRIPTS AND THE GROWTH OF ENGLISH LAW IN THE EIGHTEENTH CENTURY* 723–71 (1992); *accord* James Oldham, *The Seventh Amendment Right to Jury Trial: Late-Eighteenth-Century Practice Reconsidered*, in *HUMAN RIGHTS AND LEGAL HISTORY* 225, 228–29 & n.16 (Katherine O’Donovan & Gerry R. Rubin eds., 2000); *see also* John Adams, *Intellectual Property Cases in Lord Mansfield’s Court Notebooks*, 8 J. LEGAL HIST. 18, 19–21 (1987) (identifying the same patent cases but not transcribing the trial notes); Sean Bottomley, *Patent Cases in the Court of Chancery, 1714–58*, 35 J. LEGAL HIST. 27, 32–41 (2014) (identifying a large number of patent-of-invention suits in Chancery in the eighteenth century).

90. *E.g.*, *District of Columbia v. Heller*, 554 U.S. 570, 605–10 (2008) (Second Amendment); *Gamble v. United States*, 139 S. Ct. 1960, 1975–76 (2019) (Fifth Amendment); *N.Y. State Rifle & Pistol Ass’n v. Bruen*, 142 S. Ct. 2111, 2136–37 (2022) (Second Amendment).

Framers' "assumptions about what that practice was."⁹¹ Nor has it resolved the related question of whether a proponent of a historical practice must demonstrate that the Framers were aware of the English practice (or conceivably could have been), or whether the burden lies with an opponent to show the contrary. Quite recently, the Court was willing to presume that the Framers were aware of a practice reflected in manuscript records,⁹² and it has elsewhere cited reports of eighteenth-century decisions that did not appear in print until long after 1800.⁹³

Our sources fall into several categories. First are the official records and files of the courts in question. These are stored in the National Archives in Kew, England and include documents generated by court personnel or submitted to them by litigants. They are essential to

91. *Markman*, 517 U.S. at 376 n.3.

92. *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, 138 S. Ct. 1365, 1377 (2018). In concluding that the Privy Council had the authority to revoke invention patents in the late eighteenth century, the Court did not acknowledge published sources that were readily accessible to the Framers and that suggested the Council had no such power, *e.g.*, Statute, 1624, 21 Jac. 1 c. 3, § 2; EDWARD COKE, THE THIRD PART OF THE INSTITUTES OF THE LAWS OF ENGLAND 183 (London, 1644), and that stated patent revocations occurred via a writ of *scire facias* at law, *e.g.*, EDWARD COKE, THE FOURTH PART OF THE INSTITUTES OF THE LAWS OF ENGLAND 79–80, 88 (London, 1644); 3 WILLIAM BLACKSTONE, COMMENTARIES ON THE LAWS OF ENGLAND 47, 260–61 (Oxford, 1768). Additionally, the Court cited no pre-ratification authorities as evidence of the Council's actual practices apart from the manuscript registers (*i.e.*, journals) of that body. *Oil States*, 138 S. Ct. at 1377. The Court then assumed that the "practice of the Privy Council . . . was well understood at the founding," and further stated that the parties had cited nothing to "suggest that the Framers were not aware of this common practice[,] [n]or is there any reason to think they excluded this practice during their deliberations" on Article III or the Patent Clause. *Id.*

Incidentally, the twist in *Oil States*, unknown to the Court, was that the Council's registers were not public records, nor did they circulate like other manuscripts in the Inns of Court. Thus, there was little hope in *Oil States* of supporting the fiction that the Framers (who had been rebels to boot) would or could have been directly aware of the registers' contents. So secret were the Council registers that John Reeves, formerly one of the King's Printers and the author of HISTORY OF THE ENGLISH LAW (2d ed. London, 1787), abandoned a plan to write a treatise about the Council's jurisdiction. Letter of John Reeves, Dec. 2, 1810, PCI/2648 (noting that the registers had "hitherto been kept a secret from the Public," that the Council had thought its proceedings "not fit to become matter of general information," and lamenting how very little was known about the proceedings of the Council).

93. *E.g.*, *Markman*, 517 U.S. at 377, 379–80; *cf. Gamble*, 139 S. Ct. at 1971–72 (citing Ridgeway's reports, which was not published until 1794, when interpreting the Fifth Amendment).

understanding eighteenth-century practices and to confirming or correcting other sources, including those that appear in print. In addition to consulting the printed nominate reports of arguments in cases, we have consulted manuscript reports. These reports reside in the Inns of Court and libraries in England and the United States, and they too supplement or correct what appears elsewhere.⁹⁴ We have also considered newspaper reports, treatises, bill books, and correspondence discussing patent cases with counsel and others.

In the eighteenth century, the owner of an invention patent, aggrieved by infringement, had several options when choosing a forum for litigation. These were the four superior courts of England: the King's Bench, Common Pleas, Exchequer, and Chancery.⁹⁵ The King's Bench and Common Pleas were the principal common-law courts in England and heard most cases filed at law. The Exchequer and

94. See generally James Oldham, *Detecting Non-Fiction: Sleuthing Among Manuscript Case Reports for What Was Really Said*, in *LAW REPORTING IN BRITAIN* 133 (Chantal Stebbings ed., 1995); James Oldham, *The Indispensability of Manuscript Case Notes to Eighteenth-Century Barristers and Judges*, in *MAKING LEGAL HISTORY* 30 (Anthony Musson & Chantal Stebbings eds., 2012).

95. The Privy Council lacked the power to adjudicate infringement suits in the eighteenth century, and its registers contain no such disputes during that period. See PC2/77–156 (P.C. May 5, 1697 to Dec. 31, 1800). In 1641, Parliament prohibited the Council from adjudicating private-party disputes like an ordinary court. Statute, 1641, 16 Car. 1 c. 10, §§ 1, 3; see also SIR MATTHEW HALE, *THE PREROGATIVES OF THE KING* 106 (D.E.C. Yale ed., 1976) (c.1641–1660) (“[T]hey have not a power of determining interests or controversies.”); 1 SIR ROBERT CHAMBERS, *A COURSE OF LECTURES ON THE ENGLISH LAW* 210 (Thomas M. Curley ed., 1986) (c.1767–1773) (“[T]he judicial power of the Council was totally abrogated . . .”). And in 1680, the Council confirmed that it possessed no power to adjudicate a printing-patent dispute, though it appears parties could consent to submit their cases to the Council. *King's Printers v. Univ. of Oxford*, PC2/68, pp. 356–57, OUA SEP/P/16, no. 8 (P.C. 1679/80); see also Letter of [John Wallis], May 19, 1692, BL Add. MS 36081, ff. 186, 186 (discussing printing-patent disputes from c.1636 that were heard at the “Counsel-Table, . . . which did at that time use to exercise a greater Power, in determining Rights, than at this time [in 1692]: their Power having been since retrenched by Act of Parliament”). Although a clause in every invention patent reserved to the Council the power to revoke the patent, that clause said nothing about empowering the Council to hear infringement disputes. Scholars who have suggested or stated that the Council retained jurisdiction to adjudicate invention-infringement disputes in the early-to-mid eighteenth century are mistaken. E.g., E. Wyndham Hulme, *Privy Council Law and Practice of Letters Patent for Invention from the Restoration to 1794* (pt. 2), 33 *L.Q. REV.* 180, 193–94 (1917), cited in CHRISTINE MACLEOD, *INVENTING THE INDUSTRIAL REVOLUTION* 58–60 (1988), cited in John M. Golden & Thomas H. Lee, *Congressional Power, Public Rights, and Non-Article III Adjudication*, 98 *NOTRE DAME L. REV.* 1113, 1160, 1169 (2023).

Chancery were composite courts that each maintained a law and equity side.⁹⁶ Because the Exchequer originated as a law court and regularly conducted business on its law side,⁹⁷ jurists often referred to it as the third court of common law. The same was less likely to be said of the Chancery, despite its dual nature. Unlike the Exchequer, nearly all of the Chancery's actual adjudication of cases occurred on its equity side. This is why when judges and lawyers speak of the Chancery today, it is almost always with its role as a court of equity in mind.

III. ENFORCEMENT IN THE COURT OF CHANCERY

We focus on the Chancery because it was the principal equity court in England, and the Supreme Court has always preferred looking to its practice.⁹⁸ The Chancery also heard many more patent cases than the equity side of the Exchequer—although we still incorporate the latter in our discussion here. Patent-infringement suits in the Chancery become most visible after the Restoration in 1660, and increasingly so as the number of issued patents increased.⁹⁹

One reason to file in Chancery was to obtain injunctive relief and, unless waived by the plaintiff, an award of the defendant's profits. A plaintiff would also sue in equity to obtain discovery that otherwise would be unavailable at law. Throughout the eighteenth century, parties at law generally had no recourse to compulsory discovery.¹⁰⁰ Nor could a litigant or anyone interested in the case testify in an action at law. This was because the parties had an actual interest in the outcome and were deemed incompetent witnesses.¹⁰¹ The opposite was

96. See generally H. Tomás Gómez-Arostegui, *The Untold Story of the First Copyright Suit Under the Statute of Anne in 1710*, 25 BERKELEY TECH. L.J. 1247, 1332–35 (2010).

97. See generally PHILIP BURTON, PRACTICE OF THE OFFICE OF PLEAS IN THE COURT OF EXCHEQUER (London, 1791); W.H. BRYSON, THE EQUITY SIDE OF THE EXCHEQUER 4, 9–33 (1975).

98. See, e.g., Rule, 2 U.S. (2 Dall.) 411, 413–14 (1792); *Root v. Ry. Co.*, 105 U.S. 189, 207 (1882); *Grupo Mexicano de Desarrollo, S.A. v. All. Bond Fund, Inc.*, 527 U.S. 308, 318 (1999).

99. Bottomley, *supra* note 89, at 36–37.

100. Parties in actions at law could agree to exchange discovery, including in patent cases. E.g., *Cartwright v. Toplis*, KB125/180, p. 325 (K.B. Nov. 28, 1793) (agreeing to make available for inspection machines or models “at any time previous to the Tryal of this Cause”).

101. JOHN TRUSLER, A CONCISE VIEW OF THE COMMON AND STATUTE LAW OF ENGLAND 246 (London, 1781) (“[N]o one can be witness in his own cause.”); Letter of Joseph Black to James Watt Sr., Jan. 23, 1769, *printed in* PARTNERS IN SCIENCE: LETTERS OF JAMES

true in Chancery. Unless excused by the court, defendants were obligated to submit a sworn answer in response to an equity suit, and that answer, along with other proofs obtained through discovery, could be used in equity. A defendant's answer could also sometimes be used at law,¹⁰² though most other testimonial discovery obtained in equity was inadmissible. The expectation was that, unless unavailable,¹⁰³ witnesses would re-testify in open court during any trial.

Even when not directly admissible at law, discovery from equity could still be very useful. It would reveal knowledgeable witnesses, their likely testimony, and the arguments defendants would likely raise—all in advance of a trial at law. Writing to a friend in 1796, James Watt noted the value of discovery in his patent case: “The proceedings in chancery have done this service[,] that it has obliged our opponent to bring forward the greater part of his evidence.”¹⁰⁴ And a decade earlier, John Madocks had advised Watt's solicitor of a more specific use—discovering how an opponent's technology functioned:

[Mr. Watt] will by a Bill [in equity] have the benefit of a discovery upon the oath of the Defendants of the principles upon which their Machines are constructed & of the Manner in which they are combined, in order to be able to compare them with Mr. Watts Invention.¹⁰⁵

WATT AND JOSEPH BLACK 16–17 (Eric Robinson & Douglas McKie eds., 1970) (“[One cannot] be admitted as witnesses if you [a]re claimers of the Patent—or Parties[.]”).

102. JOHN IMPEY, *THE NEW INSTRUCTOR CLERICALIS, STATING THE AUTHORITY, JURISDICTION, AND MODERN PRACTICE OF THE COURT OF KING'S BENCH* 345 (5th ed. London, 1791). *E.g.*, *Davies v. Porter* (K.B. 1775), in *MORNING POST*, Dec. 9, 1775, at 2 (reading Davies's Chancery answer during the trial); Ambrose Weston, Solicitor's Bill Book, Birm. MS 3219/4/228, p. 23 (1796) (“Attending at the Six Clerks Office to order Close Office Copies of the Bill and Answer in [our] Chancery Suit to be read at the [patent-infringement] Trial[.]”).

103. *Fry v. Wood*, 1 Atk. 445, 445, 1 West temp. Hard. 73, 73 (Ch. 1737); *Matthews v. King*, BL Hargrave MS 471, ff. 34^r, 34^v–35^v, BL Add. MS 36012, pp. 213, 213 (Ch. 1752).

104. Letter of James Watt Sr. to John Robison, Oct. 11, 1796, *printed in* PARTNERS IN SCIENCE, *supra* note 101, at 229, 230; *see also, e.g.*, A View of the Objections which have been, at Various Times, urged against Mr Watt's Specification, Birm. MS 3147/2/42, no. 10 (*c.*1796) (collecting points made in Chancery answers in anticipation of a trial in the Common Pleas).

105. Opinion Letter of John Madocks, K.C., Apr. 13, 1785, Birm. MS 3147/2/51, no. 6; *accord* Letter of James Watt to Thomas Wilson, Feb. 21, 1791, CRO MS AD1583/5/9 (making a similar observation); *Morris v. Unwin*, C33/436, ff. 281^v–283^v (Ch. 1771) (recounting an order from 1767 in which the Chancery had instructed the

The sections that follow begin by introducing proceedings in Chancery and the relief available in patent-infringement suits. We then turn to the crux of the inquiry and the bulk of our Article. Marshalling authorities from the long eighteenth century, we demonstrate that the Chancery was obligated to refer patent validity to law when the defendant put validity in issue and the plaintiff had not already adjudicated the case against the defendant at law. Infringement would also be decided at law if contested alongside validity. The Chancery could not ignore the results of an action and adjudicate and adopt its own view of validity and infringement.

A. Basic Procedures and Relief

Patent-infringement suits in the Chancery were initiated by an unsworn bill of complaint. Bills were always filed on parchment and began with the plaintiff identifying himself, his profession, and place of residence. The complaint also laid out the terms of the patent,¹⁰⁶ any assignment of the patent to the plaintiff (if he was not the original grantee),¹⁰⁷ and any extension of the patent term granted by an act of Parliament.¹⁰⁸ Having set forth the basis of the right, plaintiffs would then recite how the defendant and his confederates had infringed the patent. The bills then universally asked for three things. First, they requested a discovery of various matters. Second, they prayed for an injunction to restrain the defendant from making or selling the plaintiff's invention or any other item that imitated, resembled, or counterfeited the invention. And third, they always sought a writ of subpoena or letters missive summoning the defendant to appear and answer the allegations laid out in the complaint. By the early-eighteenth century, bills also began requesting an accounting and disgorgement of the defendant's profits,¹⁰⁹ which coincides with a

parties in an infringement suit to "produce to each other & their Witnesses respectively their Machines & work the same upon reasonable Notice a fortnight before" a trial at law and that "they should produce the same at the said Tryal").

106. *E.g.*, *Tomlyn v. Stephens*, C5/43/113 (Ch. 1662).

107. *E.g.*, *Morris v. Oldham*, C12/379/15, no. 3 (Ch. 1766).

108. *E.g.*, *Liardet v. Johnson*, C12/1346/22, no. 1 (Ch. 1777).

109. *E.g.*, *Stoughton v. Wilkinson*, C11/46/38, no. 1 (Ch. 1722).

similar development in copyright cases.¹¹⁰ Plaintiffs could also indicate a desire or present intent to try their rights at law.¹¹¹

Plaintiffs typically stated that they had exhibited their bills in equity because they had no remedy or no “Adequate Relief”¹¹² at law. The bill in *Bell v. Heath* reveals more about what was really meant by the phrase. There, the plaintiff stated that

by the Strict Rules of the Common Law [he has no] . . . means to restrain the [defendants] . . . from making & selling [the infringing wares] . . . but has remedy only by way of Action to recover damages for the Injury done to him which must be repeated as often as the said [defendants] . . . shall think proper to disturb your Orator in the exercise of his said Invention[,] neither can your Orator compell a discovery . . . except in a Court of Equity . . .¹¹³

110. H. Tomás Gómez-Arostegui, *Equitable Infringement Remedies Before 1800*, in RESEARCH HANDBOOK ON THE HISTORY OF COPYRIGHT LAW 195, 220–25 (Isabella Alexander & H. Tomás Gómez-Arostegui eds., 2016).

111. *E.g.*, *Tennant v. Slater*, C12/251/26, no. 1 (Ch. 1799); *see also* JOHN MITFORD, A TREATISE ON THE PLEADINGS IN SUITS IN THE COURT OF CHANCERY BY ENGLISH BILL 124–25 (2d ed. London, 1787) (“[It] is frequently . . . made a part of the prayer of the bill, that the right, if disputed and capable of trial in a court of common law, may be there tried and determined . . . ; the final object of the bill being a perpetual injunction to restrain the infringement . . .”).

112. *Morris*, C12/379/15, no. 3; *see also, e.g.*, *Ferrars v. Warren*, C6/342/72, no. 1 (Ch. 1705/6); *Bridges v. Fowler*, C11/2134/8, no. 1 (Ch. 1750); *Zomer v. Gapper*, C12/749/21, no. 1 (Ch. 1754); *Dominiceti v. Kelly*, C12/1611/30, no. 1 (Ch. 1770); *Jesson v. Croft*, C12/2103/24 (Ch. 1776); *Arkwright v. Nightingale*, C12/136/3, no. 1 (Ch. 1785); *Hayne v. Frost*, E112/1903, no. 48 (Exch. 1787).

113. *Bell v. Heath*, C11/1532/1, no. 1 (Ch. 1736). For other bills expressly noting that the suit had been brought in equity because only equity courts could enjoin patent infringement, *see, e.g.*, *Darby v. Moor*, C11/1721/15, no. 1 (Ch. 1716); *Houseman v. Moore*, C12/2052/13 (Ch. 1764); *Merlin v. Celson*, C12/2119/49, no. 1 (Ch. 1779). Incidentally, we should note for the sake of completeness that it is technically incorrect to state that a court of law could never issue an injunctive order in a patent case. The King’s Bench could enjoin a defendant by consent of the parties when an action had been amicably withdrawn due to a settlement or reference to arbitration. This occurred in 1764, for example, in an action alleging infringement of a patent for refracting telescopes:

It is Ordered by the Court by and with the Consent of the Plaintiff and the Defendants[,] their Council[,] and Attornies that the last Juryman sworn and Impannelled in this Cause be withdrawn out of the Pannell[, thereby terminating the trial,] [a]nd that the . . . Defendant Watkins is not to sell any more such [telescope] Glasses without the License and Consent of the Plaintiff Dollond during the Continuance of the Patent[.]

Subpoenas would issue as a matter of course, summoning the defendant to appear and submit a sworn answer or otherwise respond. The answer was the principal way of obtaining information from a defendant. Starting in the mid-eighteenth century, most bills were worded such that their allegations functioned as interrogatories to which the defendants would have to respond in their answers. A defendant could also file a demurrer or plea. A demurrer assumed the facts alleged in the bill were true but claimed they were somehow insufficient to warrant an answer, while a plea presented additional facts not present in the bill in order to posit, again, that there was nothing for the defendant to answer. The parties might later conduct additional discovery—chiefly through “depositions” (meaning, oral answers provided on oath and memorialized in writing by a court agent in response to interrogatories)—after which the parties could set the cause down for a “hearing.” The hearing in Chancery was its equivalent of a bench trial.

Generally speaking, at the start of the hearing, one of the junior counsel for the plaintiff would “open” the bill, briefly summarizing the grievance, followed by a junior counsel for the defendant “opening” the answer to highlight the points the defendant had put in issue for the hearing. The senior counsel for the plaintiff would then introduce the case in earnest, and briefly touch on the written proofs he intended to rely upon. Those pertinent proofs would then be read, which typically included sworn answers of defendants, depositions of non-parties, and documentary evidence. Oral testimony (*viva voce*) was generally not permitted. Defense counsel would then have their proofs received and read. The court would usually issue its ruling on the spot, subject to being written up as a decree.¹¹⁴ The court did not usually lay out findings of fact and conclusions of law, nor did the decree recapitulate all of the counsel’s contentions. Rather, the majority of a decree summarized the key parts of the bill and answers, and identified

Dollond v. Watkins, KB125/158 (K.B. Nov. 22, 1764) (*nisi prius* order July 12, 1764). This narrow exception aside, it is correct to state that the law courts would not enjoin as a *remedy*.

114. 2 WILLIAM BOHUN, THE PRACTISING ATTORNEY AND SOLICITOR 107–08 (3d ed. Savoy, 1732); CHARLES BARTON, AN HISTORICAL TREATISE OF A SUIT IN EQUITY 187–88 (London, 1796).

other proofs, with the actual decretal order taking only one or a few sentences.¹¹⁵

Hearings in invention suits were usually relatively simple affairs in the eighteenth century because the parties understood that the hearing typically served solely as a way station to an action at law or a terminus after having already adjudicated liability at law—a point we will discuss in the section that follows. Contemporaneous minutes of these hearings, taken by a deputy registrar while sitting in court, demonstrate their relative simplicity. The following minutes are from a hearing during which the court sent the plaintiff to law:

Bicknell *pro Querente* [opens the bill:] [T]he end of the Bill is for an Injunction to restrain the Defendant from making the Water Engines in question and for an account

Evans *pro Defendente* opens his Answer

Chute *pro Querente*

The Defendants 2d Answer — read¹¹⁶

The Defendants 3d Answer — read

The Defendants 1st Answer — read

Browne *pro Defendente*

The Letters Patent granted to the Plaintiff — read

Curia[:] Let the Plaintiffs Bill be retained for twelve months and the Plaintiff be at liberty to bring an Action [at law] for his demand as he shall be advised [by his counsel] and reserve the Consideration of all further directions in the mean time¹¹⁷

The Chancery could grant four types of injunctions during its proceedings. The procedure for obtaining them tracks those in copyright suits, which one of us has discussed in detail elsewhere.¹¹⁸ Briefly, (1) an injunction until answer lasted until the defendant filed a “full

115. See Order of Nov. 28, 1743, in JOHN BEAMES, *THE GENERAL ORDERS OF THE HIGH COURT OF CHANCERY* 369, 381 (London, 1815) (imposing limitations on decrees); HENRY WILMOT SETON, *FORMS OF DECREES IN EQUITY*, at vi–ix, 6–7 (London, 1830) (discussing decrees).

116. Note, this did not necessarily mean that the whole answer was read.

117. *Newsham v. Gray*, C37/1401 (Ch. Dec. 1, 1740). For even simpler hearings where no evidence was considered, see, e.g., *Kay v. Mills*, C37/1519 (Ch. May 26, 1747); *Sage v. Harrison*, C37/1570 (Ch. July 25, 1750). For the minutes of comparatively more elaborate hearings in copyright-infringement suits, see, e.g., *Gay v. Walker*, *sub nom.* *Baller v. Walker*, C37/1354 (Ch. Dec. 6, 1737); *Blackwell v. Harper*, C37/1389 (Ch. Dec. 8, 1740); *Manby v. Owen*, C37/1726 (Ch. July 7, 1758); *Macklin v. Richardson*, C37/1937 (Ch. Dec. 5, 1770).

118. Gómez-Arostegui, *supra* note 110, at 196–220.

and perfect” answer—that is to say, an answer that responded to all the material allegations of the bill.¹¹⁹ As Lord Hardwicke noted in 1750, “[i]n cases . . . of a new invention by letters patent, a bill may be filed for infringing that right; and before [the defendant] answer[s,] . . . on filing the bill and [an] affidavit[,] . . . [an injunction until answer] may be granted.”¹²⁰ If a defendant submitted a suitable answer, the Chancery would give the plaintiff an opportunity to show cause on the merits¹²¹ why it should convert the aforesaid injunction into (2) an injunction that would last until the hearing of the cause.¹²² A plaintiff could also wait to move until after the defendant had answered, and thereby first seek an injunction until the hearing.¹²³ During the hearing, or sometimes beforehand,¹²⁴ the Chancery might also grant or continue (3) an injunction while the case was adjudicated at law. And lastly, at the conclusion of the case the court might decree (4) a perpetual (*i.e.*, final) injunction.¹²⁵

Alongside this final injunction, the court could also decree that the defendant deliver up any infringing items for destruction, disgorge any profits earned from the infringement, and pay the costs of the suit.¹²⁶

119. *E.g.*, *Dwight v. Wedgwood*, C33/281, f. 498^r (Ch. 1694); *Lofting v. Thompson*, C33/306, ff. 6^v–7^r (Ch. 1706); *Turlington v. Wolley*, C33/388, ff. 207^v–208^r (Ch. 1747); *Sage v. Harrison*, C33/392, f. 13^v (Ch. 1748); *Wedgwood v. Neale*, C33/436, f. 16^v (Ch. 1770); *Wilkinson v. Getley*, C33/450, ff. 389^r–390^r (Ch. 1778); *Boulton v. Oxnam*, C33/489, ff. 714^v–715^r (Ch. 1795); *see also, e.g.*, *Else v. Lacey*, E127/47, no. 430 (Exch. Hil. 1784).

120. *Dean and Chapter of Durham v. Sapp*, *sub nom.* *Anonymous*, 1 Ves. Sr. 476, 476 (Ch. 1750); *see also* *A.G. v. Walker*, LL Parker Exchequer 1693–1745 MS 1, pp. 144, 148, Bodl. Viner MS 43, ff. 17^r, 17^v (Exch. 1739) (arg.) (“Injunctions so have been granted on patents for printing Bills producing the patents and [an] Affidavit that the[] [defendants] are printing”; “So on Patents for a new Invention”); *Lowther v. Stamper*, 3 Atk. 496, 496 (Ch. 1747) (arg.) (“[In] the case of bills brought by the proprietors of new inventions . . . on the filing of the bill, the court on affidavit and certificate [of the bill being filed] will grant an injunction.”).

121. *E.g.*, *Davison v. Dutch*, C33/347, f. 376^v (Ch. 1727).

122. *E.g.*, *Merlin v. Celson*, C33/454, f. 397^v (Ch. 1780).

123. *E.g.*, *Dwight v. Garner*, C33/281, f. 898^v (Ch. 1694).

124. *E.g.*, *Dwight v. Chandler*, C33/279, ff. 1013^v–1014^r (Ch. 1693); *Liardet v. Johnson*, C33/448, f. 411^r (Ch. 1777); *Boulton v. Hornblower*, C33/492, f. 425^r (Ch. 1796).

125. *E.g.*, *Stoughton v. Wilkinson*, C33/342, ff. 118^v–119^r (Ch. 1723/4); *Liardet v. Johnson*, C33/454, ff. 527^v–530^r (Ch. 1780); *see also* *Gómez-Arostegui & Bottomley*, *supra* note 55, at 415–18.

126. *E.g.*, *Morris v. Unwin*, C33/436, ff. 281^v–283^v (Ch. 1771); *Morris v. Unwin*, C33/438, f. 146^{r-v} (Ch. 1772).

The process of assessing the profits fell to a master in Chancery, who would perform the accounting after the hearing of the cause. Additional discovery, beyond what was produced for the preceding hearing, could also occur, particularly given that masters were permitted to assess the defendant's profits down to the time of the proceedings before him, rather than being limited to the profits earned before filing the complaint.¹²⁷ The defendant might also already be obligated by court order to keep an account of his profits while the case was adjudicated at law.¹²⁸ Any master's report on the subject would have to be adopted by the Chancery.

B. Obligated to Refer Validity Issues to Law

As a general matter, and without limiting ourselves to invention cases, the Chancery regularly adjudicated equity suits without having to refer the dispute to law, particularly when the facts were not strongly controverted, and a legal right or title was not involved or not contested. Not infrequently, this occurred with copyright-infringement suits.¹²⁹ But suits involving invention patents were special, and the court's ability to adjudicate them fully was limited. This restriction stemmed most directly from section 2 of the Statute of Monopolies in 1624, which required the validity of patents to be tried by and according to the common laws of the realm:

And be it further declared and enacted . . . [t]hat all Monopolies and . . . lettres patentes . . . and the force and validitie of them and every of them ought to be, and shalbe for ever hereafter examyned

127. Gómez-Arostegui, *supra* note 110, at 225–27; 1 JOSEPH HARRISON & JOHN GRIFFITH WILLIAMS, *THE ACCOMPLISH'D PRACTISER IN THE HIGH COURT OF CHANCERY* 458 (7th ed. London, 1790).

128. *E.g.*, *Liardet*, C33/448, f. 411^r.

129. For copyright-infringement suits that resulted in a decree without the litigants going to law at any point, see, e.g., *Knaplock v. Curll*, C33/339, f. 12^{r-v}, C78/1934, no. 2, Bodl. Viner MS 38, f. 143^r, 2 Eq. Ab. 523 (Ch. 1722); *Gay v. Walker*, *sub nom.* Case of Gay, 2 Eq. Ab. 522, *sub nom.* *Baller v. Watson*, C33/369, ff. 315^v–316^v, BL Add. MS 36046, ff. 18–19 (Ch. 1737); *Manby v. Owen*, C33/410, f. 396^{r-v} (Ch. 1758); *Millar v. Taylor*, C33/426, f. 60^{r-v} (Ch. 1765); *Nicoll v. Simpson*, C33/430, ff. 251^v–252^v (Ch. 1768); *Macklin v. Richardson*, C33/436, ff. 35^v–36^f, Amb. 694 (Ch. 1770); *Becket v. Donaldson*, C33/439, ff. 26^r–27^r (Ch. 1772); *Mason v. Murray*, C33/452, ff. 486^r–487^r (Ch. 1779). For more on equity fact finding, see John H. Langbein, *Fact Finding in the English Court of Chancery: A Rebuttal*, 83 YALE L.J. 1620 (1974).

heard tried and determined by and accordinge to the Common Lawes of this Realme & not otherwise.¹³⁰

The chief architect of the statute, Sir Edward Coke,¹³¹ explained that section 2 was designed in part to ensure that the equity side of the Court of Chancery did not adjudicate patents. Patents had to be “examined, heard, tried, and determined in the Courts of the Common law according to the Common law, and not at the Councill Table [*i.e.*, Privy Council], Star=Chamber, Chancery, . . . or any other Court of like nature.”¹³² As a major motivation for enacting this section, Coke noted that monopolists had often taken their claims to the latter tribunals.¹³³ Although the statute also enacted that any declaration “before mentioned” in the statute shall not extend to certain types of grants—*viz.*, invention patents, trading patents, printing patents, and mining patents¹³⁴—that did not exclude inventions or the other preferred grants from the strictures of section 2, as some scholars have

130. Statute, 1624, 21 Jac. 1 c. 3, § 2. Common-law courts had previously reviewed Crown grants of exclusive rights, most famously in the case of *Darcy v. Allen* in 1603. *Darcy v. Allen*, 11 Co. Rep. 84b, 88b, Noy 173, 174, Moore K.B. 671, 675 (K.B. 1603) (reviewing on a demurrer a 21-year patent for importing and making playing cards); Jacob I. Corré, *The Argument, Decision, and Reports of Darcy v. Allen*, 45 EMORY L.J. 1261 (1996). And for certain types of Crown grants, at least, the King’s Bench (with Coke, C.J., presiding) declared common-law jurisdiction to be exclusive before 1624. *E.g.*, *Warner v. Suckerman*, 3 Bulst. 119, 120 (K.B. 1615) (Doddridge, J.) (prohibiting the Court of Duchy Chamber, an equity court, from reviewing the validity of a patent granting tithes: “They are not there [in the Duchy] to judge upon the validity of these Letters Patents; whether these Letters Patents be good or not, this is to be determined by the Common Law, and not to be there tried in point of equity.”). On the general principle that equity could not decide legal title, see COKE, FOURTH PART, *supra* note 92, at 85.

131. PHILLIP JOHNSON, *PRIVATISED LAW REFORM: A HISTORY OF PATENT LAW THROUGH PRIVATE LEGISLATION, 1620–1907*, at 42–48 (2018) (discussing Coke’s role).

132. COKE, THIRD PART, *supra* note 92, at 183, *cited in, e.g.*, 17 CHARLES VINER, *A GENERAL ABRIDGMENT OF LAW AND EQUITY* 215 (Aldershot, 1743); 1 WILLIAM HAWKINS, *A TREATISE OF THE PLEAS OF THE CROWN* 232 (5th ed. London, 1771); THOMAS WOOD, *AN INSTITUTE OF THE LAWS OF ENGLAND* 429 (10th ed. London, 1772).

133. COKE, THIRD PART, *supra* note 92, at 183 (especially the Star Chamber); *cf. also* PROCEEDINGS IN PARLIAMENT 1624: THE HOUSE OF COMMONS (Philip Baker ed., 2015–2018), <https://www.british-history.ac.uk/no-series/proceedings-1624-parl> (Diary of Edward Nicholas, Feb. 26, 1623/4, f. 25^v) (John Glanville) (“That heretofore, when a man would speak against a patent of monopoly, it must be before a council table and there have a perpetual imparlance and could not have the trial of it by the common law, and this was the cause of the preferring of this bill.”).

134. Statute, 1624, 21 Jac. 1 c. 3, §§ 5, 6, 9, 10, 11.

wondered.¹³⁵ Rather, that language was, according to Coke, simply meant to exempt invention patents and other excepted grants from the principal clause in section 1 declaring that all monopolies were void, and from the treble-damages penalty available under section 4 to aggrieved persons who sued the holders of monopolies for damages.¹³⁶

As we demonstrate in the sections below, section 2 meant that if a defendant in a Chancery suit challenged the validity of an invention patent, the Chancery was obligated to refer the case to a law court—*viz.*, the King’s Bench or Common Pleas. This would not prevent the Chancery from entertaining the case; it only meant that at some stage in the litigation, and before a final decree in Chancery, the case would have to go to law. There, the validity of the patent would be tested, and infringement too, if that was also called into question. In the meantime, while awaiting the result, the Chancery might preliminarily

135. *E.g.*, Walterscheid, *supra* note 87, at 771–73; Caleb Nelson, *Vested Rights, “Franchises,” and the Separation of Powers*, 169 U. PA. L. REV. 1429, 1489 (2021).

136. PROCEEDINGS, *supra* note 133 (Diary of John Pym, Apr. 19, 1624, f. 71^v) (Edward Coke) (“[T]he subject is at his choice whether he will sue generally at the common law or *contra formam statuti* [for abuse of a monopoly], and the defendant by the saving shall be exempted from the penalty.”); 1 H.C. JOUR. 770 (Apr. 19, 1624) (Edward Coke) (provisos “[n]ot meant to make them good, but to keep them out of the Penalty of this Law”); PROCEEDINGS, *supra* note 133 (H.C. Manuscript Jour., May 13, 1624, f. 199^v) (Edward Coke) (“The excepted monopolies to be in the same state they were before, and, for the trial of them at the common law, said they would take it into consideration.”); COKE, THIRD PART, *supra* note 92, at 184 (stating that the section 6 proviso only “except[ed] and exempt[ed] . . . [inventions] out of the Purvien [*i.e.*, principal provision], and penalty of this Law”); *id.* at 185–87; *see also* PROCEEDINGS, *supra* note 133 (Diary of John Lowther, Apr. 13, 1624, f. 63^v) (“[provisos] meant to save them out of the . . . penalty, and to leave them as they were and make them no better”); *Stationers v. Seymour*, SCA MS Notes, Series II, box 1 (C.P. 1677) (arg.) (“[I]t onely exempts the patentees from the penalties but makes the patentees neither better nor worse than before[.]”); GILES JACOB, *THE COMMON LAW COMMON-PLAC’D* 265 (2d ed. Savoy, 1733) (“By Statute, all Monopolies . . . are declared void; and Persons grieved by putting them in Use, shall recover treble Damages, &c. But this doth not extend to Inventors of new Manufactures, who have Patents or Grants for Terms of Years; nor to any Grant to Corporations or Companies of Trade; Grants . . . for Printing . . . &c.”). Section 2 of the statute had a shaky start. *See* Sean Bottomley, *Mansell v Bunger (1626)*, in *LANDMARK CASES IN INTELLECTUAL PROPERTY LAW* 1, 4, 13–19 (Jose Bellido ed., 2017). But for an early instance of the Chancery ordering a party (in this instance, a defendant) in a printing-patent suit to file an action “at the Common lawe where the valyditie of the said Patent will then aptlie come in question,” while enjoining the defendant in the meantime, *see Stationers v. Symcocke*, C33/162, f. 207^v, C78/295, no. 4 (Ch. 1631) (the case had an atypical posture, with the defendant being the actual grantee of the patent); *Le Stationers London v. Simcox*, Toth. 147, 147 (Ch. 1631) (“[T]he Court establisheth Possession untill Eviction at law against a Patent[.]”).

enjoin the defendant. A plaintiff could also ensure a jury trial on validity and infringement, regardless of whether the defendant planned to contest validity or not, by adjudicating an action at law against the defendant before filing suit in equity.

1. *Not Going to Law at All*

Let us first quickly dispatch the uncommon scenario where the plaintiff was not obligated to go to law because the defendant admitted the validity of the patent and only contested infringement. The Chancery could adjudicate infringement and decree relief, as *Stoughton v. Wilkinson* demonstrates. Filed in 1722,¹³⁷ the plaintiffs possessed a patent for a restorative elixir, which the Crown had granted to the plaintiffs' father in 1712. The bill alleged that the defendants were making and vending the same medicine or an imitation thereof, and prayed that the Chancery enjoin the defendants and order them to account for the profits earned from their infringement.¹³⁸ The answer admitted that the plaintiffs' father invented the elixir mentioned in the patent, that the plaintiffs were well entitled to the patent, and that they enjoyed the sole use and benefit of the invention exclusive of all others. But the defendants denied that they infringed and claimed that the elixir they sold was based on their own recipe.¹³⁹

The plaintiffs requested an injunction until the hearing of the cause, which Lord Macclesfield granted, allowing the defendants to sell some bottles they had on hand, but preventing them from making any more.¹⁴⁰ Due in part to the death of one of the plaintiffs, it took eighteen months for the cause to be heard in Chancery. During that time, the court never sent the plaintiffs to law, nor did they seek to go to law. Instead, the Chancery adjudicated infringement and decreed relief. The decree noted the defendants' admissions on validity,¹⁴¹ and then found for the plaintiffs over the defendants' denial that they used, imitated, or counterfeited the invention.¹⁴² The court enjoined the defendants "from making & Selling any more of their said Elixir or any

137. *Stoughton v. Wilkinson*, C11/46/38, no. 1 (Ch. 1722).

138. *Id.*

139. *Stoughton v. Wilkinson*, C11/46/38, no. 2 (Ch. 1722).

140. *Stoughton v. Wilkinson*, C33/338, f. 352^{r-v} (Ch. 1722).

141. *Stoughton v. Wilkinson*, C33/342, ff. 118^v-119^r (Ch. 1723/4) ("[Defendants] admitt the plaintiffs are well intitled to the said Patent & all advantage arising thereby . . .").

142. *Stoughton v. Wilkinson*, C37/1099 (Ch. Jan. 31, 1723/4) (Talbot arg.) ("[O]ur Elixires is quite different from the plaintiffs . . .").

other Elixir in imitation of the plaintiffs Elixir during the continuance of the time mentioned in the plaintiffs Patent,” and awarded the plaintiffs the “Costs of this Suite.”¹⁴³

Stoughton is the only pre-1800, fully litigated equity case known to us where the defendant clearly conceded an invention patent’s validity from the outset.¹⁴⁴ The other invention suits discussed below contested validity in one way or another, at one time or another, and often infringement too.

One last suit requires mention here. In *Hills v. Lee*,¹⁴⁵ the Lord Chancellor perpetually enjoined the defendants within only five days of the complaint being filed and without any hearing of the cause or the parties having previously gone to law. The plaintiffs were the King’s Printers and held the patent to print the statutes of the realm, the Bible, and the Book of Common Prayer. The defendants imported Bibles and statute books printed in Holland. With the books sitting at the customhouse waiting to be released to the defendants, counsel for the King’s Printers initially asked only that the defendants be enjoined from taking them out until answer. Nevertheless, after finding during the argument that the statute books contained mistakes, the court ordered that the customhouse never release them, and it further enjoined the defendants from ever importing any more statute books because the “Printing of the Laws was [a] Matter of State, and concerned the State.”¹⁴⁶ Notably, the court ruled that the Bibles, allegedly imported in violation of the patent, would be subject to the

143. *Stoughton*, C33/342, ff. 118^v–119^r.

144. For a printing-patent suit conceding validity, contesting infringement, and resulting in a decree after the hearing without the plaintiff having gone to law at any point, see *Baskett v. Parsons*, C33/329, ff. 418^v–419^r (Ch. 1718), *conf’d on reh’g* C33/331, ff. 349^v–350^r (Ch. 1719). Lord Chancellor Parker (later created Lord Macclesfield before *Stoughton*) noted that “[t]he Patent to the Plaintiff for the sole Printing & selling of Bibles in England is admitted to be good.” *Baskett v. Parsons*, Bodl. Viner MS 38, f. 81^{r-v} (Ch. 1719).

145. *Hills v. Lee*, C10/207/37, no. 1 (Ch. 1681).

146. *Hills v. Lee*, *sub nom.* Company of Stationers Case, 2 Chan. Cas. 76, 76 (Ch. 1681) (Lord Nottingham, L.C.); *see also* *Hills v. Lee*, *sub nom.* *Newcombe v. Lee*, C33/258, f. 116^v, C37/346 (Ch. Nov. 28, 1681) (Lord Nottingham, L.C.) (“[T]he matre is of great concerne to the publique to have the Statutes of this Nation printed in a fforeign Nation which by some Leaves now produced in Court appeared to be full of Errors.”).

“ordinary Course” of the court, and they in fact were.¹⁴⁷ One of us has previously noted that the court’s order on the statute books might be unique, and given the special circumstances that attended it, it is hard to see its precedential value, if any.¹⁴⁸ Moreover, it is unclear whether the defendants actually challenged the validity of the portion of the patent that covered the statutes of the realm.

2. *Going to Law First*

Although it was common for a patentee to file suit in equity first, and then take the case to law—in order to ensure he could first take advantage of discovery and possibly an interim injunction—the opposite could occur.¹⁴⁹ A plaintiff might commence an action at law against the defendant and then file in equity soon after,¹⁵⁰ or a plaintiff might wait to sue in equity until after he obtained a favorable verdict¹⁵¹ or a post-verdict judgment at law.¹⁵² (A verdict was not final without a judgment).¹⁵³ Remarkably, an old manuscript note, perhaps from the mid-seventeenth century, suggests that the Chancery at one time required a prior verdict at law against the defendant in question, and likely a judgment on that verdict, before filing in equity:

147. *Hills*, 2 Chan. Cas. at 76; see also *Hills v. Lee*, *sub nom.* *Newcombe v. Lee*, C33/258, f. 80^v (Ch. 1681) (enjoining defendants during the same argument only until answer on allegedly infringing Bibles), *sub nom.* *Newcombe v. Wright*, C33/258, f. 96^r (Ch. 1681) (later enjoining other defendants until answer), *sub nom.* *Hills v. Wright*, C33/259, ff. 313^v–314^r (Ch. 1682/3) (during the hearing in Chancery, ordering the King’s Printers to law to validate their Bible rights), KB27/2028, rot. 98 (K.B. judg. Hil. 1683/4) (judgment in favor of the Bible portion of the patent following argument on a demurrer), C33/261, ff. 282^v–283^r (Ch. 1683/4) (perpetually enjoining the defendant Wright from infringing the Bible patent).

148. Gómez-Arostegui, *supra* note 110, at 214.

149. See also *infra* text accompanying note 199.

150. *E.g.*, *Horton v. Maltby*, CP36/15, p. 208 (C.P. Pas. 1783), C12/1366/35, no. 1 (Ch. 1783).

151. *E.g.*, *Morris v. Oldham*, KB122/337, rot. 513 (K.B. verdict Trin. 1766), C12/379/15, no. 3 (Ch. 1766).

152. *E.g.*, *Dollond v. Watkins*, KB122/320, rot. 111 (K.B. bill Mich. 1763), KB139/98, f. 23^v (K.B. judg. 1764), C12/1956/19, no. 1 (Ch. 1765); *cf. also* *Rowntree v. Loat*, CP36/17, p. 51 (C.P. Trin. 1800), in *ALBION AND EVENING ADVERTISER*, Nov. 5, 1800, at 4 (“[T]his action was brought . . . for an invasion of his right as patentee of the said invention . . . [and] to ascertain his sole right, before a Court of Law, to the invention, as preparatory to bringing an action before the Court of Chancery, to recover damages [*i.e.*, defendant’s profits] for the violation of his right of patent.”; plaintiff took a nonsuit and never filed in equity).

153. See [HENRY BATHURST], *THE THEORY OF EVIDENCE* 21 (London, 1761).

If one, who has letters patent for an invention, files a bill for an injunction to restrain another from pirating his invention, he must state by his bill that he has brought his action at law, and so established his right by a good verdict, or a demurrer to his bill for want of equity shall be sustained.¹⁵⁴

Insofar as this rule may have been a requirement at one time in invention suits, it disappeared by the late seventeenth century. For one, the need for discovery in aid of an action at law had become well accepted by the 1680s, if not earlier, leading the Chancery to overrule demurrers that objected at least in part to discovery in copyright,¹⁵⁵ trading-patent,¹⁵⁶ and printing-patent cases.¹⁵⁷ In 1693, the Chancery took the same step in an invention suit, overruling a demurrer in *Dwight v. Chandler*, where the defendant had argued that the common law and Statute of Monopolies prohibited the court from first entertaining the suit.¹⁵⁸ Notably, nine years earlier, in a printing-patent

154. “Old MS,” *printed in* 2 Coop. temp. Cott. 61 (undated); *see also generally* Mayor of York v. Pilkington, 1 Atk. 282, 284 (Ch. 1737/8) (Lord Hardwicke, L.C.) (describing a general rule about going to law first to establish a legal right before filing in equity); Lord Tenham v. Herbert, 2 Atk. 483, 483 (Ch. 1742) (Lord Hardwicke, L.C.) (“Undoubtedly there are some [classes of] cases, in which a man may, by a bill of this kind, come into this court first; and there are others where he ought first to establish his right at law.”).

155. *E.g.*, Herringman v. Clerke, C33/257, f. 608^v (Ch. 1682), *conf’d on reh’g* C33/259, ff. 278^v–279^r (Ch. 1682/3); *see also* Horne v. Baker, HLS MS 1169(b), pp. 154, 155 (Ch. 1710) (Lord Cowper, L.C.) (“[T]his Court will oblige a Discovery so far as what will entitle the plaintiff to an Action at Law[.]”). Copyrights were not subject to the Statute of Monopolies.

156. *E.g.*, East India Co. v. Sandys, C37/366 (Ch. Jan. 27, 1682/3) (Collins arg.) (“[T]he Q[uestion] is whether this Court will support a patten before . . . the validity of yt be tryed at Law[.]”), *id.* (Sawyer, A.G., arg.) (“[W]ee cannot try the validity of the pattents without their Answer.”), C33/259, f. 402^v, C37/371 (Ch. Jan. 27, 1682/3) (North, L.K.) (overruling demurrer, ordering defendant to answer (unsworn), declaring that “the validity of the patent was proper to be tryed at Common Law,” and ordering before the hearing, with the consent of the parties, that the plaintiff bring an action on the case “to trye the validity of the patten”), *conf’d on reh’g* C33/263, f. 486^v (Ch. 1685); *see also* East India Co. v. Sandys, 1 Vern. 127, 129 (Ch. 1682/3) (North, L.K.) (“I must in this Case be govern’d by Law, and . . . till [the patent] is determined there, I do not see how I can grant an Injunction.”).

157. *E.g.*, Stationers v. Lee, C37/346 (Ch. Nov. 15, 1681) (Winnington arg.) (“[T]he Question is whether . . . this Court will direct any discovery before the tittle in Law be decided[.]”), C33/258, f. 25^r, LI Maynard MS 23, f. 233^v, 2 Chan. Cas. 66, 66 (Ch. 1681) (Lord Nottingham, L.C.) (yes, overruling demurrer).

158. *Dwight v. Chandler*, C5/107/13, no. 1, C33/279, f. 764^r (Ch. 1693). The same argument was dusted off ninety years later by a defendant’s counsel and rejected in

suit in 1684, Lord Keeper Guilford had acknowledged the use of discovery,¹⁵⁹ while addressing the Statute of Monopolies and sending the parties to law at the hearing of the cause:

I held [1.] that the Question, whether this [the King's Printers' patent] were a lawfull priveledg[,] could onely be tryed in the 3 Courts of law, by the Statute against Monopolys. 2. If it shall be adjudged lawfull then this Court may Enjoyne the wrong doers from Continuing their wrong, & likewise Compell the defendants to account upon oath there being a Certain profit . . . The defendants insisting that the plaintiffs had no sole priveledg but onely a licence to print, the plaintiffs were to trye the point in an action *super* [on the] case at law, & if they Recovered then to Resort back to th[is] Court.¹⁶⁰

Also influencing the Chancery was the notion that an interlocutory injunction might be appropriate at some stage of a dispute against a defendant, including while a patentee adjudicated his right at law. The same cases from the 1680s that allowed discovery were sometimes reluctant to grant injunctions while a case was pending at law.¹⁶¹ But the court in *Dwight*, for example, granted such an injunction.¹⁶²

In the 1740s, Lord Hardwicke offered his own justification for the shift, noting that anticipatory bills and at least some interlocutory injunctions were proper for two reasons. First, the “right of the

Horton v. Maltby, C12/1366/35, no. 2, C33/459, f. 625^r (Ch. 1783). Defendants had demurred to the whole bill, insisting the plaintiff “ought to establish his right to the premises at law” before the suit in equity could be filed. *Horton v. Maltby*, LI Misc. MS 112, pp. 10, 10 (Ch. 1783). The ruling is reported briefly under the erroneous name *Hicks v. Raincock*, 2 Dick. 647 (Ch. 1783).

159. *Hills v. Univ. of Oxford*, C33/263, ff. 766^v–767^r, 1 Vern. 275, 275–76 (Ch. 1684) (Lord Guilford, L.K.) (acknowledging discovery, sending suit to law at the hearing, and denying interlocutory injunction).

160. *Hills v. Univ. of Oxford*, BL Add. MS 32519, ff. 61^v, 61^v–62^r (Ch. 1684) (personal notes of Lord Guilford, L.K.).

161. *E.g.*, *Sandys*, 1 Vern. at 129; *Hills*, C33/263, ff. 766^v–767^r, 1 Vern. at 275–76; *see also* *Whitchurch v. Hide*, 2 Atk. 391, 391 (Ch. 1742) (Lord Hardwicke, L.C.) (apprehending that the Chancery early on “did not immediately grant an injunction . . . [and instead waited] till the letters patent had been first established at law”); *Baskett v. Univ. of Cambridge*, LI Coxe MS 54, pp. 267, 277 (K.B. 1749) (arg.) (making the same observation).

162. *Dwight v. Chandler*, C33/279, ff. 1013^v–1014^r (Ch. 1693); *cf. also* *Stationers v. Partridge*, HLS MS 1109, pp. 77, 77 (Ch. 1709/10) (Lord Cowper, L.C.) (continuing an injunction in a printing-patent case until the hearing of the cause and stating that the “Injunction ought to continue & they enjoy their antient possession till the Law is turned against them”).

plaintiff . . . to the sole property appeared upon record” in the patent rolls of the Chancery.¹⁶³ “Record” was a term of art signifying a legal document that was incontrovertibly authentic. Second, unlike other exclusive rights condemned by the Statute of Monopolies, there was no “general Presumption” that invention patents were unlawful.¹⁶⁴ Quite the opposite, the Statute of Monopolies endorsed invention patents: “[I]t is a Common Ordinary Case, & the Act of Parliament has established the [general] Right thereof.”¹⁶⁵ Consequently, Lord Hardwicke said, one “may bring [a] Bill without going first to law . . . in Cases of patents for printing, or where a new Invention.”¹⁶⁶ Mentioning a procedure we examine in the next section, he stated that he could simply refer a challenged patent to law at the hearing.¹⁶⁷

3. *Timing of Referral to Law*

Where a plaintiff had not already brought and adjudicated an action at law against a defendant on her own initiative, the Chancery would refer the dispute to law if the defendant challenged the validity of the patent. The timing of the referral varied, but the default course was to send the parties to law at the hearing of the cause.¹⁶⁸ In other words, during its hearing, the Chancery would ascertain that the defendant questioned the patent’s validity and, therefore, that the case would have to go to law.¹⁶⁹ Alternatively, the parties could consent to go to

163. *Lowther v. Stamper*, 3 Atk. 496, 496 (Ch. 1747); *accord* *Dean and Chapter of Durham v. Sapp*, *sub nom.* *Anonymous*, 1 Ves. Sr. 476, 476 (Ch. 1750) (Lord Hardwicke, L.C.); MITFORD, *supra* note 111, at 129 (“In cases of this sort it is not necessary to establish a right at law before filing a bill where the right appears on record, as under letters patent for a new invention . . .”).

164. *Whitchurch v. Hyde*, BL Add. MS 36019, pp. 155, 156 (Ch. 1742); *see also* *Whitchurch v. Hyde*, BL Add. MS 36016, pp. 95, 97 (Ch. 1742) (Lord Hardwicke, L.C.) (“[N]o Presumption lyes . . . [against] New Inventions &c.”).

165. *Whitchurch*, BL Add. MS 36019, p. 156; *accord* *Blanchard v. Hill*, LI Hill MS 5, pp. 93, 95, 2 Atk. 484, 485 (Ch. 1742) (Lord Hardwicke, L.C.).

166. *Whitchurch v. Hyde*, LI Misc. MS 384, bk L, no. 87 (Ch. 1742).

167. *Whitchurch v. Hyde*, LI Hill MS 17, pp. 357, 357, LI Hill MS 3, pp. 152, 152 (Ch. 1742) (“[I]t would be easy if there was any doubt to direct a trial at the hearing.”).

168. *See* *Grierson v. Jackson*, 1 Ridg. L. & S. 304, 311 (Ch. Ir. 1794) (Lord FitzGibbon, L.C.) (“That must be done upon the hearing of the cause, unless both parties consent.”); *accord* *Ryder v. Bentham*, 1 Ves. Sr. 543, 544 (Ch. 1750) (Lord Hardwicke, L.C.); *Fishmonger’s Co. v. East India Co.*, 1 Dick. 163, 164 (Ch. 1752) (Lord Hardwicke, L.C.).

169. *E.g.*, *Newsham v. Gray*, C33/376, f. 336^{r-v} (Ch. 1740); *Sage v. Harrison*, C33/394, f. 638^{r-v} (Ch. 1749); *accord* *Whitchurch v. Hyde*, LI Misc. MS 174, pp. 95, 97

law before the hearing. This latter approach was sometimes called going to law “on motion” because it could ensue when a plaintiff moved for an interlocutory injunction.¹⁷⁰ For example, a plaintiff might go to law after attempting to convince the court to convert an injunction granted until answer into an injunction lasting until the hearing.¹⁷¹ The parties might also agree at the outset of the suit to go to law, subject to the defendant putting in an answer, such that the initial motion would result in an injunction designed to last while the case was pending at law.¹⁷² It seems likely that in these instances the parties were prepared to proceed to law without the need for additional discovery beyond a defendant’s answer, and thus rather than waiting until the hearing to be sent to law, the parties would agree to go much earlier. Additionally, a defendant might not feel the need to give the Chancery a better view of the evidence at the hearing in an attempt to avoid an injunction while at law.¹⁷³

In another context, the Solicitor General for England, Alexander Wedderburn, noted in 1772 that referring cases to law before the hearing was a welcome development:

Courts of Equity have for many years past adopted a practice, which has been extremely beneficial to the suitors; where they see the

(Ch. 1742) (Lord Hardwicke, L.C.) (“[In patent-of-invention cases], the Court leaves it to the hearing to see if any Question or Doubt arises on the Plaintiff’s Right.”).

170. *See, e.g.*, *Stationers v. Partridge*, HLS MS 1109, pp. 77, 77 (Ch. 1709/10) (Lord Cowper, L.C.) (noting that rather than waiting until the hearing to go to law, “[w]here parties have been consenting[,] there have been issues directed [to law] on motion”).

171. *E.g.*, *Boulton v. Hornblower*, C33/492, f. 425^r (Ch. 1796).

172. *E.g.*, *Liardet v. Johnson*, C33/448, f. 411^r (Ch. 1777).

173. Note that a general election principle stated that a plaintiff should not “proceed both at Law and in Equity for one and the same Demand at one and the same Time.” *Barker v. Dumeres*, Barn. C. 277, 278 (Ch. 1740) (Lord Hardwicke, L.C.). A plaintiff who filed first in equity and then filed at law before the hearing without a defendant’s consent, or who filed at law first and filed in equity very soon after, *see, e.g., supra* note 150, ran the risk of the defendant complaining in Chancery that he was vexed with simultaneous proceedings. But we are aware of only one invention suit in which the defendant raised this objection. *See Turlington v. Dalby*, C33/390, f. 369^r (Ch. 1748). Obtaining the defendant’s consent before the hearing, or going to law at the hearing, sidestepped the rule. *See* 3 EDWARD WYNNE, *EUNOMUS* 285–88 (2d ed. London, 1785) (discussing the general rule and some exceptions). The principle also did not strictly apply to plaintiffs who obtained a favorable verdict and judgment at law before filing in equity, nor did a plea appear to bar such a plaintiff in a subsequent patent-infringement suit in equity. Under any scenario, a double recovery was unlikely, given that actions at law nearly always purposely pursued nominal damages only. *See infra* text accompanying notes 196–199.

dispute between the parties is a meer question at law, and must be ultimately determined there, instead of putting the parties to the expence of a diffuse examination of witnesses [through depositions] in equity, they have by interlocutory orders . . . [sent the parties to law before the hearing] and reserved consideration of all further directions till after the verdict.¹⁷⁴

4. *Manner of Referral to Law*

Generally speaking, and again without limiting ourselves to invention cases, there were four ways in which the Chancery could refer a dispute to law. Two dealt with purely legal issues, and the other two applied to cases raising a factual dispute. Only the last was routine in invention-infringement suits before 1800.

First, if the disputed issue was strictly legal, the court could order the plaintiff to file an action in the King's Bench or Common Pleas upon tailored facts and further order the parties to descend their pleadings to an issue of law via a demurrer. This would put the legal question before the law court without requiring a jury trial. The judges would hear argument at the bar on the demurrer, and the case would then return to the Chancery for further proceedings.¹⁷⁵ A second method served the same purpose and largely supplanted the first in the eighteenth century. The court could send strictly legal issues to the King's Bench or Common Pleas on a "case stated," meaning a statement of facts stipulated by the parties and settled with the assistance (if needed) of a master in Chancery. The court receiving the request would hear argument on the stipulated "case"—without the need for the plaintiff to file an action at law or the need for a jury trial—and issue a "certificate" that answered the questions of law that the Chancery had submitted. The case would then return to equity for further proceedings.¹⁷⁶

Neither of these methods appears to have been employed in invention suits before 1800. No cases in the nominate reports use these procedures, nor have we discovered any manuscript cases utilizing them. They were used, however, in cases involving the validity of trading and printing patents, as those typically did not involve factual issues relating to the validity of the patent, and the defendant would

174. Earl of Pomfret v. Smith, 6 Bro. P.C. (1st ed.) 493, 501 (H.L. 1772).

175. Gómez-Arostegui, *supra* note 110, at 211.

176. *Id.* at 211–12.

often admit infringement.¹⁷⁷ Additionally, it appears that certain narrow questions of law—such as the legal effect of the terms of a patent—did not have to be referred to law at all.¹⁷⁸ It also seems that the Chancery was not obligated to send a validity question of pure law to the law courts when a prior decision at law already decided it, even if that prior decision involved different parties.¹⁷⁹

Take, for example, a suit brought by the King's Printers, who owned the patent to print the Bible,¹⁸⁰ and a suit brought by the Company of Stationers, which owned the patent to print the Psalms.¹⁸¹ The plaintiffs in each case argued that the validity of their patents had already been upheld as a matter of law in a prior, single *qui tam* action brought to enforce both patents.¹⁸² With only a question of law at issue, they argued that they should not be required to validate their patents at law again.¹⁸³ The defendant in both cases pushed back successfully, arguing that it was not clear that the parties had argued over the validity of the patents in the *qui tam* action.¹⁸⁴ Moreover, several other similar prior actions did not actually involve Bibles or the Psalms. Ultimately, the court sent both suits to law.¹⁸⁵

If the case in Chancery raised a factual dispute, the court could take two approaches to send it to law. The first was to direct a “feigned

177. *E.g.*, *East India Co. v. Sandys*, C33/259, f. 402^v (Ch. 1682/3), 2 Show K.B. 366 (K.B. 1684/5); *Hills v. Lee*, *sub nom.* *Hills v. Wright*, C33/259, ff. 313^v–314^f (Ch. 1682/3), KB27/2028, rot. 98 (K.B. judg. Hil. 1683/4); *Stationers v. Lee*, *sub nom.* *Stationers v. Wright*, C33/259, ff. 313^v–314^f (Ch. 1682/3), KB27/2028, rot. 101 (K.B. judg. Hil. 1683/4); *Stationers v. Partridge*, C33/316, f. 525^{r-v} (Ch. 1710/11), 10 Mod. 105 (Q.B. 1712); *Baskett v. Bentham*, BL Add. MS 36054, f. 72^v (Ch. 1743/4), *sub nom.* *Baskett v. Univ. of Cambridge*, 1 Bl. R. 105 (K.B. 1758); *Stationers v. Carnan*, C33/442, ff. 188^r–189^r (Ch. 1774), 2 Bl. R. 1004 (K.B. 1775).

178. *Univs. of Oxford and Cambridge v. Richardson* (Ch. 1802) (Lord Eldon, L.C.), in *JUDGMENTS AND EXTRACTS FROM PLEADINGS; THE UNIVERSITIES OF OXFORD AND CAMBRIDGE VERSUS RICHARDSONS* 18 (c.1822), NRS CS236/B/24/2, no. 3.

179. *East India Co. v. Evans*, 1 Vern. 305, 307–08, C33/263, f. 275^v (Ch. 1684/5).

180. *Hills v. Lee*, C10/207/37, no. 1 (Ch. 1681).

181. *Stationers v. Lee*, C5/560/41, no. 1 (Ch. 1681).

182. *See Mayo v. Jekyll*, KB27/1934/1, rot. 446 (K.B. judg. 1671/2) (record of the *qui tam* action).

183. *Hills v. Lee*, *sub nom.* *Hills v. Wright*, C33/259, f. 422^v (Ch. 1682/3); *Stationers v. Lee*, 2 Show. K.B. 258, 259, *sub nom.* *Stationers v. Wright*, C33/260, f. 362^r (Ch. 1682/3).

184. *Hills v. Lee*, *sub nom.* *Hills v. Wright*, C33/259, f. 400^{r-v} (Ch. 1682/3); *Stationers v. Lee*, *sub nom.* *Stationers v. Wright*, C33/260, f. 254^f (Ch. 1682/3).

185. *Hills v. Lee*, *sub nom.* *Hills v. Wright*, C33/259, ff. 313^v–314^f (Ch. 1682/3); *Stationers v. Lee*, *sub nom.* *Stationers v. Wright*, C33/259, ff. 313^v–314^f (Ch. 1682/3).

issue.” Not cast as an ordinary action at law, the parties would instead draft pleadings alleging that a fictional wager for a certain amount had been made between them over whether the fact in issue existed or not.¹⁸⁶ The jury would try the issue, and the presiding trial judge from one of the common-law courts would report the verdict to the Chancery.¹⁸⁷ Usually, no judgment would be entered in the plea rolls of the law court, and the costs incurred there would fall within the ambit of an award of costs in Chancery.¹⁸⁸ Often called “directing an issue,” this procedure was most useful when there were few factual issues to be tried.¹⁸⁹ But generally speaking, the Chancery utilized this method in “matters of *equity*” to try a doubtful fact and “inform the conscience of the Court, and not to try the right of the parties, as where the matter in issue is a *legal* title.”¹⁹⁰ We have yet to encounter an invention-infringement suit where the Chancery employed this method before 1800, though that is not to say it was impossible.¹⁹¹

The other method of dealing with cases involving factual disputes was to “retain” the bill and give the plaintiff “liberty” to bring an action

186. 3 BLACKSTONE, *supra* note 92, at 452; IMPEY, *supra* note 102, at 641–42. For examples of feigned-issue pleadings in non-patent cases, see *id.* at 642–44; JOHN LILLY, MODERN ENTRIES 45–46, 65–66 (2d ed. Savoy, 1741). The law courts could also order “feigned issues,” but that was an internal procedure and irrespective of equity. *E.g.*, *Herbert v. Williamson*, 1 Wils. K.B. 324, 324–25 (K.B. 1752); *Hoskins v. Lord Berkeley*, 4 T.R. 402, 402 (K.B. 1791).

187. 3 BLACKSTONE, *supra* note 92, at 452; JOHN WYATT, THE PRACTICAL REGISTER IN CHANCERY 263 (London, 1800).

188. BATHURST, *supra* note 153, at 21; 1 JOHN WENTWORTH, A COMPLETE SYSTEM OF PLEADING 133 (London, 1797); Notes of Cases in Equity, BL Hargrave MS 495, f. 15, BL Hargrave MS 476, f. 145^r (c.18th cent.) (“[W]here an *Issue* is directed[,] a Court of Equity exercises the same discretion over the Costs, at Law, as it does over the rest of the Costs in Equity But generally it will give the Costs [taxed by the relevant official] at Law, on an Issue, according to the Verdict.”) (emphasis added).

189. See generally *Gyles v. Wilcox*, Barn. C. 368, 369–70 (Ch. 1740/1) (Lord Hardwicke, L.C.) (copyright case) (“Where the Matter indeed consists of a single Fact, or of two or three Facts, the Court does take that Method to determine them”).

190. *Coker v. Farewell*, 1 Swanst. 390, 391–92 n.(a) (Ch. 1729) (Jekyll, M.R.) (emphasis added); accord *Stace v. Mabbot*, 2 Ves. Sr. 552, 553 (Ch. 1754) (Lord Hardwicke, L.C.); *Smith v. Earl of Pomfret*, 2 Dick. 437, 437–38 (Ch. 1770) (reg.); *Fowkes v. Chadd*, 2 Dick. 576, 576–77 (Ch. 1780) (Lord Thurlow, L.C.).

191. In a case where the Chancery was left to adjudicate infringement only, such as where a defendant conceded validity, we have no doubt the court could send infringement to law on an issue if it wished. The court might also send an issue to law to help it determine whether a defendant had breached a final injunction in a patent-infringement suit. See *Liardet v. Johnson*, GT Eldon MS, Notes of Cases 1779, pp. 34, 48 (Ch. 1780) (Eyre, B.); see also *infra* text accompanying note 249.

in the King's Bench or Common Pleas—the expectation being that the parties would descend the pleadings at law to a triable “general issue.” As we will show shortly, it appears from the actual referrals known to us that this was the route taken in invention-infringement suits before 1800 to determine validity (if that alone was contested) or validity and infringement (if both were contested). Although framed as granting the plaintiff “liberty” to file, that term is misleading. Failure to try the action at law within a certain amount of time, typically designated as twelve months, could lead to the Chancery dismissing the suit in its own court.¹⁹² In 1770, John Dickens, by then a Deputy Registrar of the Court of Chancery for fourteen years, explained how directing an issue differed from retaining the bill and giving the plaintiff liberty to file an action:

[An issue] is in order to satisfy the conscience of the Court[.] The latter [is] to ascertain the party's right to come here [in Chancery] [I]n the last instance, this Court hath nothing to do with the trial, or the verdict; the verdict is the authority for this Court to go by; if it be wrong, the party aggrieved, should have applied to the Court at law for a new trial[.]¹⁹³

At law, the plaintiff would file an action for trespass on the case, and the defendant would plead “not guilty,” which triggered the general issue and a jury trial. This general denial placed upon the jury the responsibility to resolve all contested facts. As a barrister in 1780 remarked: “everything must be proved” in an action.¹⁹⁴ In patent cases, a defendant might, for example, dispute infringement alongside validity. Additionally, it was possible for the King's Bench or Common Pleas to address questions of law raised by the case, whether anticipated or not by the Chancery. The law court would enter any judgment sought in its own record, and the costs incurred at law would

192. Gómez-Arostegui, *supra* note 110, at 213.

193. *Smith*, 2 Dick. at 437–38; *accord Fowkes*, 2 Dick. at 576–77 (Lord Thurlow, L.C.) (when a bill is retained with liberty for the plaintiff to bring an action to establish his right, it is not to satisfy the conscience of the court); *Walton v. Law*, 6 Ves. Jr. 150, 151 (Ch. 1801) (Grant, M.R.) (liberty to file used when “it is necessary to establish the right at law in order to found the equitable relief”). Precedent books in the library of the Chancery registrars, compiled during the eighteenth and early nineteenth centuries, contain separate headings for this procedure. *E.g.*, *Chancery Precedents*, C27/8, ff. 5^v–6^v (“Bill retained to bring Action at Law”); *Chancery Precedents*, C27/11, f. 18^r (“Bill retained with Liberty to bring Actions at Law”).

194. *Liardet*, GT Eldon MS, p. 38 (Douglas arg.); *accord id.* at 47 (Eyre, B.) (“All Questions [a]re open upon the Action.”).

be awarded there.¹⁹⁵ As with the other methods, the case might then return to the Chancery. Apart from being referred, this did not differ from an independent infringement action.

Notably, while establishing their claims at law, patentees were not obligated to prove or seek any damages at trial. To be sure, plaintiffs would always include an allegation of damage in their declarations (*i.e.*, complaints),¹⁹⁶ but they typically did so without any desire to pursue damages at all.¹⁹⁷ Thus, plaintiffs commonly said nothing on the subject at trial and received the standard nominal award of one shilling.¹⁹⁸ Dispensing with actual damages was common, even in cases

195. Notes of Cases in Equity, BL Hargrave MS 495, f. 15, BL Hargrave MS 476, f. 144^v (*c.*18th cent.) (“[W]here an *Action* is directed to be brought by a Court of Equity, it leaves the party prevailing, to take Costs according to the rule of Law.”) (emphasis added).

196. *E.g.*, *Arkwright v. Mordaunt*, KB122/461, rot. 2207 (K.B. bill Pas. 1781) (“To the Damage of the said [plaintiff] of ffive thousand Pounds[.]”); *see also, e.g.*, *Horton v. Harvey*, KB122/461, rot. 1828 (K.B. bill Pas. 1781) (£10,000); *Else v. Lacy*, CP41/141 (C.P. writ Mich. 1783) (£10,000); *Arkwright v. Nightingale*, CP40/3768, rot. 720 (C.P. writ Pas. 1784) (£10,000); *Claus v. Longman*, CP41/144 (C.P. writ Pas. 1785) (£1,000); *Argand v. Neale*, CP41/145 (C.P. writ Hil. 1786) (£2,000); *Boulton v. Hornblower*, CP40/3818, rot. 567 (C.P. writ Mich. 1796) (£10,000). The superior courts had a jurisdictional floor of 40 shillings, what we today call an amount-in-controversy requirement, beneath which litigation ordinarily occurred in the county courts. *See Welsh v. Troyte*, 2 H. Bl. 29, 29–30 (K.B. 1792); EDWARD COKE, *THE SECOND PART OF THE INSTITUTES OF THE LAWE OF ENGLAND* 311–12 (London, 1642).

197. EDWARD HOLROYD, *A PRACTICAL TREATISE OF THE LAW OF PATENTS FOR INVENTIONS* 173–74 (London, 1830) (“In general, . . . damages are not asked, and, in such a case, if the verdict be in the plaintiff’s favour, nominal damages only are given.”).

198. For examples of referred actions and independent actions involving nominal damages, see Trial Transcript, *Arkwright v. Nightingale*, DRO D7573/BOX/F/18, p. 38 (C.P. 1785) (Lord Loughborough, C.J.) (“[T]he question before you now is upon the mere right, [the defendant having admitted infringement during opening statements,] and if you are of opinion in favour of the plaintiff upon the result of the cause, you will give a verdict for the plaintiff with one shilling damages[;] a future invasion of this right would entitle Mr. Arkwright to an action for damages, but in the present case they are not asked.”); *Claus v. Longman* (C.P. 1785), *in* WHITEHALL EVENING POST, June 21–23, 1785, at 4 (“The object of the suit was not for damages, but merely to the patentee’s right to his invention, and to prove that the defendants had basely infringed on his patent”); *Bramah v. Hardcastle* (K.B. 1789), *in* TIMES, July 23, 1789, at 3 (Lord Kenyon, C.J.) (“The plaintiff must shew that [his invention is novel] . . . and that it was invaded before he can recover If [the jury find] a verdict for the plaintiff, nominal damages would be sufficient, as he only wished to have his right completely established.”); Trial Transcript, *Boulton v. Hornblower*, Birm. MS 3219/4/227, no. 12, pp. 247–48 (C.P. 1796) (Eyre, C.J.) (instructing the jury that it

where the patentee had no plans to go to or return to Chancery to obtain an injunction and an award of profits against the same defendant. The verdict and judgment would buttress existing and future licenses for practicing the invention, while signaling to others to beware. The judgment could also help one obtain interlocutory injunctions in future suits against different defendants. Not surprisingly, some counsel advised their patent clients to skip equity (at least initially) because it was a “preferable mode [to file at law], as being less expensive and more expeditious, provided a sufficient knowledge can be got and Evidence secured.”¹⁹⁹

The section that follows provides examples of the last method of referral in invention cases: retention and liberty to file an action.

was to determine “whether the specification has satisfactorily been made” and “enquire whether [the] Patent has been infringed . . . I do not see that they mean to ask for more than nominal damages to assert the right of the Proprietors as they have not gone into Evidence of any particular specifick damages.”), *sub nom.* *Watt v. Maberley* (C.P. 1796), *in* WHITEHALL EVENING POST, Dec. 17–20, 1796, at 2 (“This was an [action] . . . to recover from the Defendants nominal damages for the infringement of a Patent . . . The object of the action was to sustain the right of the Plaintiff to his Patent.”); *Huddart v. Grimstone* (K.B. 1803), *in* MORNING POST, Dec. 24, 1803, at 3 (“The Jury returned a Verdict of *Nominal Damages*, and 40s. Costs, which establishes the Patent.”); *Brunton v. Hawks* (K.B. 1820), *in* OBSERVER, June 5, 1820, at 1 (“The Jury found for the plaintiff upon all the points, namely, that the specification was sufficient, the chain-cable and anchor new and beneficial, and that the defendants had infringed the chain-cable. Nominal damages alone were sought for in this action, the question of right being all that was to be tried, as the defendants were in account, under a previous suit in Chancery, for the profits they had made by the use of the invention.”); *Losh v. Hague*, 1 Web. P.C. 202, 203 (Exch. 1838) (Lord Abinger, C.B.) (“[T]his action is brought by the plaintiff . . . to recover nominal damages for the purpose of vindicating his right to a patent which he claims, and which he says the defendant has infringed.”); *Galloway v. Bleaden*, 1 Web. P.C. 521, 529 (C.P. 1839) (Tindal, C.J.) (“If you find it for the plaintiffs, it will be only nominal damages; the question is not here for any [lost] profits, but simply to decide the right between the parties.”).

199. Opinion Letter of Thomas Plumer, Sept. 20, 1791, Birm. MS 3147/2/34, no. 3; *accord* REPORT FROM THE SELECT COMMITTEE ON THE LAW RELATIVE TO PATENTS FOR INVENTIONS 33 (1829) (testimony of John Farey) (“It facilitates the obtaining of evidence to apply to the Court of Chancery; but if he has got good evidence he had much better come to a court of common law at once, without going first to Chancery.”); *Butlin v. Masters*, 2 Ph. 290, 293 (Ch. 1847) (Lord Cottenham, L.C.) (“I cannot but observe that, if in this and similar cases, whether of patent rights or others, depending upon a legal right, the parties went to law at once, where they must ultimately go, instead of coming here in the first instance, where the jurisdiction is merely ancillary to the legal right, a great deal of expense might be saved.”).

5. *Examples—Retention and Liberty to File an Action at Law*

An early instance of directing an action in an invention suit occurred in *Dwight v. Chandler*, the case from 1693 mentioned previously.²⁰⁰ The defendants demurred to the complaint on the ground that the common law and Statute of Monopolies required that the validity of a patent be adjudged at law before any suit in equity.²⁰¹ Lord Keeper Somers refused to dismiss the suit outright,²⁰² and before the hearing of the cause instead granted an interlocutory injunction and sent the plaintiff to law to try the patent: “It is . . . ordered that the plaintiff be at liberty to bring his action against the defendants for making and vending the [allegedly infringing wares] . . . and do try the same the first Sitting in the next terme [*i.e.*, Michaelmas 1693]”²⁰³ The proceeding was later described as follows:

[At the defendant’s] request a tryall at Law was directed by this honorable Court to try the vallidity of the said Letters patents which tryall was had accordingly in his Majestys Court of Common Pleas at Westminster . . . [on Nov. 29, 1693] when a verdict was given for [the plaintiff] . . . against the [defendant] . . . in affirmance of the said Letters patents and of . . . [the plaintiff’s] right and title under the same²⁰⁴

When litigation became more common in the eighteenth century, as more invention patents issued, the Chancery continued to refer cases. In *Newsham v. Gray*, for example, an inventor sued an alleged infringer in the hopes of obtaining a perpetual injunction.²⁰⁵ The defendant denied novelty and infringement.²⁰⁶ At the hearing of the cause, Justice Parker of the Court of Common Pleas, who was sitting in place of the Master of the Rolls, ordered that the bill be retained for twelve months and that the plaintiff be “at liberty to bring an Action

200. See *supra* text accompanying notes 158–162.

201. *Dwight v. Chandler*, C5/107/13, no. 1 (Ch. 1693) (pleading the statute and stating that “the force and validity of the said Letters Patents[,] . . . upon which the whole Equity of the matters in question doth depend[,] . . . by the Lawes and Statutes of this Realme are and ought to be examined heard tryed and determined by and according to the Common Law”).

202. *Dwight v. Chandler*, C33/279, f. 764^r (Ch. 1693) (overruling demurrer). Plaintiffs’ counsel argued: “[W]ee say tis a new Invention and wee are solely intituled to it for 14teene [years] by our Letters Pattents.” *Dwight v. Chandler*, C37/571 (Ch. July 21, 1693) (Ward, A.G., arg.).

203. *Dwight v. Chandler*, C33/279, ff. 1013^v–1014^r (Ch. 1693).

204. *Dwight v. Talbot*, C8/538/23, no. 1 (Ch. 1695).

205. *Newsham v. Gray*, C11/2454/26, no. 1 (Ch. 1737).

206. *Newsham v. Gray*, C11/2454/26, no. 2 (Ch. 1737).

for his Demand as he shall be Advised.”²⁰⁷ During a trial in the King’s Bench, the plaintiff was nonsuited. On learning of the failed action, Lord Chancellor Hardwicke examined the King’s Bench *postea* and dismissed the Chancery suit with costs.²⁰⁸

In *Kay v. Mills*, the defendant also challenged the validity of a patent and insisted that the “Right of the plaintiffs to the said Inventions shall not be Established without a previous Tryall of the validity of the said patent at Common Law.”²⁰⁹ At the hearing, Baron Clarke of the Court of Exchequer sat in Chancery in Lord Hardwicke’s absence. He retained the bill for twelve months and ordered that the plaintiffs were in the meantime “at liberty to bring an action . . . against any one or more of the Defendants touching the Mattres Complained of,” and that any defendants not named in the action were, by their consent, to also be “bound by the Event of the Tryall of such Action . . . as to the Validity of the said letters Patent.”²¹⁰ The year went without plaintiffs filing an action, so the Chancery dismissed the suit with costs for the defendants.²¹¹

The equity side of the Court of Exchequer took the same approach. In *Stanyforth v. Wright*, the plaintiff held a patent for making plows and sued for a perpetual injunction.²¹² During the hearing of the cause, the defendants “insisted that the Legality of the patent should be tried at Law before a perpetual Injunction ought to be granted.”²¹³ They cited *Bell v. Heath*,²¹⁴ which Lord Hardwicke had sent to law in 1737 and

207. *Newsham v. Gray*, C33/376, f. 336^{r-v} (Ch. 1740).

208. *Newsham v. Gray*, C33/378, ff. 190^v–191^r, BL Hargrave MS 468, pp. 64, 64, BL Add. MS 36052, pp. 9, 12, 2 Atk. 286, 286–87 (Ch. 1742). The King’s Bench pleadings are not enrolled, but the issue was entered. *Newsham v. Gray*, KB168/10, p. 13 (K.B. Trin. 1741).

209. *Kay v. Mills*, C33/387, ff. 697^v–698^v (Ch. 1747).

210. *Id.*

211. *Kay v. Mills*, C33/389, f. 450^{r-v} (Ch. 1748) (Lord Hardwicke, L.C.); *see also, e.g.*, *Sage v. Harrison*, C33/394, f. 638^{r-v} (Ch. 1749) (Lord Hardwicke, L.C.) (hearing decree) (retaining the bill for twelve months, ordering that the “plaintiffe in the mean time be at liberty to proceed to a Tryall at Law against the Defendant in an action on the Case for a Breach or Infringement of the priviledge Granted to him by the letters patent,” reserving consideration of “all further direction till after such Tryal shall be had,” and noting that failure to comply would result in the bill being “Dismissed out of this Court with Costs”).

212. *Stanyforth v. Wright*, E112/1199, no. 1807 (Exch. 1740).

213. *Stanyforth v. Wright*, *sub nom.* *Stanyforth v. Steel*, LL Parker MS, Legal Cases 1740–1744, p. 59 (Exch. 1741/2).

214. *See supra* text accompanying note 113.

which resulted in a nonsuit at trial, claiming he had said in that case that patents were easily obtained and that he “could never Grant an Injunction against the usage till the Right had been Established at Law.”²¹⁵ Citing the Statute of Monopolies and Coke’s *Institutes*, Baron Abney concurred and stated that the court would retain the bill for a year “with Liberty for the plaintiff to proceed at Law.”²¹⁶ The other Barons agreed and ordered that the case would be “Continued . . . to be further heard after such Actions shall be tried.”²¹⁷ Notably, Baron Abney further stated that he would “never Establish any Monopolies without the [clearest] Proof . . . that it was a new Invention, till the patent had the Sanction of a Jury.”²¹⁸

Stanyforth duly filed an action for trespass on the case against one of the defendants.²¹⁹ With Chief Justice Lee presiding, the jury returned a verdict for the defendant. The case returned to the Exchequer, where the Barons read the “Record of the said Action” in the King’s Bench and noted that the plaintiff “hath failed in her Action at Law touching the mattres in Question.”²²⁰ Consequently, the Barons dismissed the suit against all the defendants.²²¹

Next is a series of filings starting in 1766 that showcase the same plaintiffs obtaining a verdict against some defendants before filing suit in equity, being sent in equity to law before the hearing against other defendants, and then being sent to law at the hearing against yet other defendants. In 1766, Thomas and John Morris filed infringement actions in the King’s Bench against Robert Oldham and James Hall.²²² After obtaining favorable verdicts, the plaintiffs filed a Chancery bill against Oldham and Hall and many other defendants, including Samuel Unwin Sr., Samuel Unwin Jr., William Unwin, Matthew

215. *Stanyforth*, LL Parker MS, p. 60.

216. *Id.*

217. *Stanyforth v. Wright*, *sub nom.* *Stanyforth v. Walker*, E126/26, Hil. no. 10, E162/11 (Exch. Feb. 11, 1741/2).

218. *Stanyforth*, LL Parker MS, p. 60.

219. *Stanyforth v. Walker*, KB122/193, rot. 419 (K.B. bill Pas. 1742). She abandoned a second action against another defendant. *Staniforth v. Steele*, KB125/147 (K.B. Feb. 11, 1742/3).

220. *Stanyforth v. Wright*, *sub nom.* *Stanyforth v. Walker*, E126/27, Mich. no. 6, E162/11 (Exch. Nov. 17, 1743).

221. *Stanyforth*, E126/27, Mich. no. 6.

222. *Morris v. Oldham*, KB122/337, rot. 513 (K.B. bill Pas. 1766); *Morris v. Hall*, KB122/337, rot. 514 (K.B. bill Pas. 1766); *see also* *Morris v. Oldham* (K.B. 1766), *in* 1 OLDHAM, *supra* note 89, at 740–41 (Lord Mansfield’s trial notes).

Mayfield, Arthur Else, and Josiah Branson.²²³ Two weeks later, the King's Bench entered judgment in both its cases.²²⁴ In their bill, the Morrisises suggested that the Chancery admit the verdicts against all the defendants, not just Oldham and Hall.²²⁵ But the Unwins and Mayfield objected before the hearing of the cause—because they were not parties to the prior actions—and thus insisted that the plaintiffs file separate actions against them. The Chancery therefore ordered the Morrisises to do so.²²⁶

This led to them filing an action in the King's Bench against Mayfield and the Unwins, obtaining a favorable verdict and judgment,²²⁷ and eventually returning to Chancery for the hearing of the cause.²²⁸ Dissatisfied with the trial, the Unwins and Mayfield “humbly hope[d]” the verdict would not conclude the matter in Chancery, particularly as to whether they had infringed the plaintiffs' patent.²²⁹ They should not be bound by the verdict, they posited, because it came from sending the parties to law on an action by petition, rather than by directing an issue at the hearing of the cause.²³⁰ Yet, the verdict did conclude the matter. Lord Apsley reviewed the plaintiffs' patent, the order sending the plaintiffs to law, and the *postea* in the King's Bench, and he then decreed a final injunction, delivery up, and a

223. *Morris v. Oldham*, C12/379/15, no. 3 (Ch. 1766).

224. *Morris v. Oldham*, KB139/98, f. 93^v (K.B. judg. 1766); *Morris v. Hall*, KB139/98, f. 93^v (K.B. judg. 1766).

225. *Morris*, C12/379/15, no. 3.

226. See *Morris v. Oldham*, LI Hill MS 20, pp. 222, 224–25 (Ch. 1771) (describing an earlier petition and order from March 1767 sending plaintiffs to law); cf. also generally BATHURST, *supra* note 153, at 18 (“As to Verdicts the Rule is, That no Verdict shall be given in Evidence, but between such who are Parties or Privies to it.”); *Russell v. Barnsley*, 2 Coop. temp. Cott. 58, 58 (Ch. 1834) (Shadwell, V.C.) (noting that a patentee would have to “undertake to bring an action [at law] against the defendant, notwithstanding the pendency of actions against other parties in which the validity of the patent must be decided”).

227. *Morris v. Mayfield*, KB122/343, rot. 1080 (K.B. bill Pas. 1767), KB139/98, f. 124^v (K.B. judg. 1768) (suing all defendants in a single action).

228. The plaintiffs never brought their dispute against Oldham and Hall to a hearing. We suspect it had become unnecessary due to a settlement and penal bond between the parties—a deal that was offered to other defendants. See *Morris v. Unwin*, C12/379/15, no. 8 (Ch. 1768).

229. *Morris v. Unwin*, C12/379/15, nos. 6–7 (Ch. 1768).

230. *Morris v. Unwin*, C33/436, ff. 281^v–283^v (Ch. 1771).

disgorgement of profits.²³¹ Notably, the time between the verdict and judgment at law (July 1767 & Jan. 25, 1768) and the hearing in Chancery (Feb. 5, 1771) was considerable, but that made no difference. The verdict adjudicating liability sufficed to enjoin them over three years later.

At the same hearing, the court learned, likely for the first time, that Else and Branson contested liability as well. Else denied validity and infringement, while Branson was neutral on the former and denied the latter.²³² The court therefore issued its standard order that it would retain the bill for “12 Months & that the Plaintiffs in the mean time to be at Liberty to bring an Action on the Patent in the Court of King’s Bench in Middlesex against the said Defendants Else & Braunson,” with failing to proceed to trial on time meaning the court would dismiss the suit.²³³ John Morris duly filed an action against each defendant and won verdicts and judgments in both.²³⁴ Not long after, he returned to the Chancery for a hearing on the equity reserved, where, like their predecessors, the defendants attempted to express their dissatisfaction with the trial.²³⁵ It was to no avail. Lord Apsley simply read his prior decree, the King’s Bench *postea*, and then decreed a final injunction, delivery up, and a disgorgement of profits.²³⁶

231. *Id.*; *Morris v. Unwin*, C37/1939, C37/1941 (Ch. Feb. 5, 1771); *cf. generally Meadows v. Dutchess of Kingston*, Amb. 756, 761 (Ch. 1775) (Lord Apsley, L.C.) (stating in another context that “I lay it down as a general rule, that wherever a matter comes to be tried in a collateral way, the decree, sentence, or judgment of any other Court, having competent jurisdiction, shall be received as conclusive evidence of the matter so determined”).

232. *Morris v. Unwin*, C12/379/15, nos. 8 & 5 (Ch. 1768). Branson’s position is a bit unclear on validity, as he admitted the existence of the patent and that it was “in full force.” *Id.* no. 5. But stating that the patent was currently in force was not the same as admitting its validity.

233. *Morris*, C33/436, ff. 281^v–283^v.

234. *Morris v. Else*, KB122/367, rot. 1137 (K.B. bill Pas. 1771), KB139/99, f. 61^v (K.B. judg. 1771); *Morris v. Branson*, KB122/367, rot. 1138 (K.B. bill Pas. 1771), KB139/99, f. 61^v (K.B. judg. 1771).

235. *See* Affidavit of Josiah Branson, *Morris v. Branson*, C31/181, no. 439 (Ch. Oct. 30, 1771); Affidavit of John Burgess, *Morris v. Branson*, C31/181, no. 440 (Ch. Oct. 30, 1771); Affidavit of Arthur Else & Joseph Warsopp, *Morris v. Else*, C31/181, no. 441 (Ch. Oct. 31, 1771). These affidavits, filed at a time between the verdict and the judgment at law, were not read at the hearing of the cause in Chancery and are not mentioned in any of the court’s orders.

236. *Morris v. Unwin*, C33/438, f. 146^{r-v}, C37/1955, C37/1957 (Ch. Jan. 25, 1772) (against Else and Branson).

The practice of referring cases to law before the hearing was later repeated in our last case, *Liardet v. Johnson*, an infringement suit in the Chancery that involved a patent for stucco cement.²³⁷ There, the parties sought to go to law two weeks after the suit was filed because the defendants “insisted that the Invention was not novel & that the Specifications in the Patent were not sufficient & that therefore the Patent was void.”²³⁸ The defendants also contended that their cement differed materially from the patented cement.²³⁹

Lord Chancellor Bathurst (f.k.a. Lord Apsley) granted an injunction “until further Order,” with the plaintiffs “undertaking to bring an Action at Law & proceed to Trial thereon without Delay as soon as the defendants shall have fully answered the plaintiffs’ Bill.”²⁴⁰ The plaintiffs obtained a verdict (Feb. 21, 1778) against one of the Chancery defendants, John Johnson, and then another verdict (July 18, 1778) after the King’s Bench granted Johnson a new trial.²⁴¹ In granting the new trial, Lord Mansfield said that the court was not convinced that “on the first Trial the Cause had been so compleatly discussed and understood as to be a ground for a perpetual Injunction.”²⁴² After judgment in the King’s Bench (Mar. 9, 1779),²⁴³ the case returned to the Chancery in July 1780 for a perpetual injunction and an accounting at the hearing of the cause. Baron Eyre of the Court of Exchequer, who was sitting in place of the absent Lord Chancellor Thurlow, said the following about the course of procedure in invention suits:

The Ordinary relief in the Case of a Patent is an Injunction, and an Account [of the defendant’s profits]. When the *Right* is disputed, the Court expects that to be ascertained by a Trial at Law. If such Trial

237. *Liardet v. Johnson*, C12/1346/22, no. 1 (Ch. 1777).

238. *Liardet v. Johnson*, GT Eldon MS, Notes of Cases 1779, pp. 34, 34 (Ch. 1780) (discussing Affidavit of John Johnson, *Liardet v. Johnson*, C31/205, no. 90 (Ch. June 11, 1777)).

239. *Liardet*, C31/205, no. 90.

240. *Liardet v. Johnson*, C33/448, f. 411^r (Ch. 1777); *see also Liardet*, GT Eldon MS, p. 34 (“The Court . . . retained the bill with Liberty for the Plaintiff to bring Actions at Law[.]”). The order is noticed in a Chancery registrar’s precedent book. Chancery Precedents, C27/9, f. 85^v (c. late 18th cent.).

241. *Liardet v. Johnson* (K.B. 1778), *in* MORNING POST, Feb. 23, 1778, at 2 (first trial); *Liardet v. Johnson*, KB125/165 (K.B. June 1, 1778) (order granting new trial); *Liardet v. Johnson* (K.B. 1778), *in* MORNING POST, July 20, 1778, at 2 (second trial).

242. *Liardet v. Johnson*, LI Hill MS 20, pp. 227, 232–33 (Ch. 1780).

243. *Liardet v. Johnson*, KB139/100, f. 77^v (K.B. judg. 1779).

has been had & a Verdict found for the Plaintiff before the Bill is brought, the only Question here is the Invasion.²⁴⁴

The ordinary relief in Case of Rights upon Patents is [an] Injunction & an Account. [Equity] [s]eldom refuse[s] [to grant an] Injunction till [the] hearing. If [a] Question arises whether there is Infringement or Novelty of Invention, they refer those Questions to Law. If before [the] Party comes here having established [the right,] the only Question then is whether there is Infringement[.]²⁴⁵

Baron Eyre further said that if the plaintiffs had not gone to law, the case would have been dismissed “for want of the Right being established at Law.”²⁴⁶ He ultimately granted a final injunction against Johnson, stating that because the plaintiffs had succeeded at law, “they [we]re intitled to tie [the defendant] up.”²⁴⁷ The fact there was a two-year gap between the verdict in the second trial and the hearing did not affect the decision. But Baron Eyre did acknowledge the defendant’s argument that it would be “impossible [for him] . . . to know whether, in any Cements he might [now] be disposed to Use, he did or did not interfere with the Plaintiffs [specification] and infringe the Injunction.”²⁴⁸ Should the plaintiffs contend there was a breach of the injunction, Baron Eyre said, the defendant would have the opportunity to litigate the alleged transgression in equity, where the

244. *Liardet*, LI Hill MS 20, pp. 240–41.

245. *Liardet*, GT Eldon MS, p. 46. In the last sentence of both excerpts, Baron Eyre is probably referring to a case where a jury adjudicates validity alone because the parties agreed at law to make that the only question there. That certainly happened during some trials, including at the first trial in *Liardet*, see *Liardet v. Johnson* (K.B. 1778), in 1 OLDHAM, *supra* note 89, at 748, 751, 754, 756–57 (trial and post-trial notes of first trial); JAMES OLDHAM, ENGLISH COMMON LAW IN THE AGE OF MANSFIELD 202 n.64 (2004), but not at the second, where the jury also took up infringement, see *Liardet v. Johnson* (K.B. 1778), in PUBLIC ADVERTISER, July 21, 1778, at 2. Sixty years later, a law reporter thought that Baron Eyre was referring to something else when he printed the LI Hill MS report of the case in 1843 as an appendix to *Thomas v. Jones*, 1 Y. & C. Ch. Cas. 510, 527 (Ch. 1842). He altered the last sentence to read: “If such trial has been had and a verdict found for the plaintiff, before the bill is brought, the only question is how is the invasion to be prevented.” *Id.* at 532 (emphasis added).

246. *Liardet*, GT Eldon MS, p. 46.

247. *Liardet*, LI Hill MS 20, p. 243; see also *Liardet*, GT Eldon MS, p. 35 (Eyre, B.) (“It is I think decided by the Verdicts that Johnson has infringed the Patent.”). The plaintiffs withdrew their request for an accounting.

248. *Liardet*, LI Hill MS 20, p. 240; see also *id.* at 244.

court might send the case to law on an issue.²⁴⁹ The court dismissed the suit as to another defendant who had not been sued at law.²⁵⁰

* * *

The requirement to send validity issues to law persisted through the turn of the century and beyond. In 1791, John Scott, the Solicitor General for England, advised Ambrose Weston, solicitor to James Watt, that going to law would ensue even if a defendant admitted infringement:

[A] Court of Equity in my Opinion will not grant [a final] injunction, supposing the Defendant in effect shall admit it to be the same Machine [as Mr. Watt's], without trying at law the validity of the Specification, and such other points as a person bringing an Action in support of a Patent is usually required to prove. If they deny the use of the same Machine, that fact must also be tried.²⁵¹

Later, when Scott was appointed as Lord Chancellor Eldon, he and other Chancellors continued to enforce the requirement.²⁵² It appears

249. *Liardet*, GT Eldon MS, p. 48. Alleged breaches of injunctions in invention cases were handled initially and sometimes exclusively in Chancery. *E.g.*, *Morris v. Unwin*, C33/440, f. 91^r (Ch. 1772); *Boulton v. Bull*, C33/489, f. 520^v (Ch. 1795); *see also, e.g.*, *Else v. Lacey*, E127/47, no. 299 (Exch. Pas. 1784).

250. *Liardet v. Johnson*, C33/454, ff. 527^r–530^r (Ch. 1780) (with costs); *see also* *Horton v. Maltby*, LI Hill MS 18, pp. 148, 149 (Ch. 1783) (Ainge arg.):

[T]he usual way of proceeding in these [invention] Cases [i]s to get an [interim] Injunction on Affidavit—then by Consent of both parties upon coming in of the Answer[, and before the hearing in Chancery,] the Court sends them to Law—If plaintiff prevail[s], he comes back here, & has his Account [of profits] &c.

251. Opinion Letter of John Scott, S.G., Oct. 27, 1791, Birm. MS 3147/2/34. Note that Scott attended the hearing in *Liardet v. Johnson*. The GT Eldon MS cited above was his own.

252. *E.g.*, *Beaumont v. George*, 27 Reper. of Arts 252, 256 (Ch. 1815) (Lord Eldon, L.C.) (“The question was simply whether the patents were good or not, and that was plainly a question of law,” meaning for the law courts, and sending to law); *Walker v. Congreve*, 29 Reper. of Arts 311, 377, 382 (Ch. 1816) (Lord Eldon, L.C.) (stating that “on the validity of his patent I will deliver no opinion,” and sending to law); *Hill v. Thompson*, 3 Meriv. 622, 625 (Ch. 1817) (Lord Eldon, L.C.) (“I cannot but entertain a doubt, whether the improvement . . . [is] a new invention; but that is not for me to decide,” and sending to law); *Brunton v. Hawks* (Ch. 1819), in *MORNING HERALD*, July 20, 1819, at 3 (Lord Eldon, L.C.) (stating that “[t]his Court does not take upon it to express any opinion as to the validity or the invalidity of the patent,” and sending to law); *Beeston v. Ford* (Ch. 1829), in *MORNING CHRON.*, Dec. 23, 1829, at 1 (Lord Lyndhurst, L.C.) (noting that he doubted the patent was valid, but that “[t]his was not, however, his province to decide,” and sending to law); *Russell v. Barnsley*, 1 Web. P.C.

it was not until two patent cases in 1839 and 1841 that judges in Chancery stated that going to law was not necessarily a matter of right but merely and always one of discretion. Importantly, several American courts relied on these two cases, as we discuss later.

In the 1839 case, the plaintiffs waited four years after filing two bills, and until the hearing of the cause, to first seek injunctive relief. They argued they were still entitled to establish the validity of their patent at law and, assuming they succeeded, return for injunctive relief.²⁵³ The Master of the Rolls refused to retain the bills while the plaintiffs tried

472, 472–73 (Ch. 1834) (Shadwell, V.C.) (“I do not myself recollect a case in which, where the defendant has stated his wish . . . to try the question at law, that the court has refused to give him that opportunity . . . [A]nd if the plaintiff wishes to have the question tried at law, he must have liberty to do so.”); *Bickford v. Skewes*, 17 L.J.R. 188, 188 (Ch. 1839) (Lord Cottenham, L.C.) (“In matters of this kind, an [interim] injunction is granted or refused by the Court as the case may be, until the right has been established at law.”); GEORGE COOPER, A TREATISE ON PLEADING ON THE EQUITY-SIDE OF THE HIGH COURT OF CHANCERY 155 (London, 1809) (“[I]t is certain that [in patent cases] the court will not, at the hearing, by its decree, establish such exclusive right in a plaintiff, unless it is either admitted by the defendant’s answer, or established at law”); JOHN DAVIES, A COLLECTION OF THE MOST IMPORTANT CASES RESPECTING PATENTS OF INVENTION ix (London, 1816) (“[T]he Court of Chancery never decides upon the validity of a patent, the practice there being nothing more than to grant an injunction, at the prayer of the patentee, against any person infringing his patent, and to order an account of profits; but if any question arises upon the validity of the patent, the novelty of the invention, or the sufficiency of the specification, it is uniformly referred to a court of law.”); 2 JOSEPH CHITTY, TREATISE ON THE LAWS OF COMMERCE AND MANUFACTURES 210 (London, 1824) (same); ROBERT R. RANKIN, AN ANALYSIS OF THE LAW OF PATENTS 105 (London, 1824) (“The facts of validity and infringement, if disputed, must be tried at law; but, in the mean time, an injunction may be obtained.”); WILLIAM CARPMAEL, THE LAW OF PATENTS FOR INVENTIONS 50 (London, 1832) (“[B]y the statute of James I. the validity of patents should be tried and determined by the common law of the realm, consequently, a patent must not be considered void, unless it be declared so in a suit at law, expressly to try the validity of the grant”); SIDNEY BILLING & ALEXANDER PRINCE, THE LAW AND PRACTICE OF PATENTS 150 (London, 1845) (“The practice of the court is, never to grant an [interlocutory] injunction without annexing a condition, which is to try the cause some time within a given period.”); W.M. HINDMARCH, A TREATISE ON THE LAW RELATING TO PATENT PRIVILEGES 306–07 (London, 1846) (“[T]he privilege conferred by a patent is a legal right, which, according to the declaration contained in the Statute of Monopolies, ought only to be tried by the Common Law of the realm [T]he proceedings in [the] Court [of Chancery] can only be sustained for the purpose of protecting a patent right to which he can show, by the judgment of a Court of Law [against the defendant], that he has a legal title.”); THOMAS CAMPBELL FOSTER, A TREATISE ON THE WRIT OF SCIRE FACIAS 243 (London, 1851) (“By the Statute of Monopolies, such [patent-infringement] actions are to be tried by the common-law Courts of the realm and not otherwise.”).

253. *Bacon v. Spottiswoode & Jones*, 1 Beav. 382, 382–84 (Ch. 1839).

the patent, and dismissed the suits instead. They had waited too long to ask for an injunction and to go to law, both of which they should have done before the hearing, as had become usual.²⁵⁴ Lord Chancellor Cottenham affirmed on appeal, due to the plaintiffs' laches, leaving the plaintiffs to their remedy at law, where they had finally filed an action against the defendants.²⁵⁵ This was not, then, a dispute where a party was deprived of the ability to adjudicate the case at law; rather, equitable relief was denied on equitable grounds. Nevertheless, Lord Cottenham stated in dictum that the Chancery could, under certain conditions, grant a final injunction without the parties having gone to law, though he could not recall that ever having happened nor did he delineate the circumstances.²⁵⁶

In 1841, the same Master of the Rolls cited Lord Cottenham's decision and stated that it was "not the right of the parties in every case to have an action tried in a court of law, it is a question of convenience, and the court is to exercise a fair discretion."²⁵⁷

It is unclear whether either judge considered section 2 of the Statute of Monopolies, but the Master of the Rolls did note that defendants had the option of attacking the validity of a patent at law by filing a *scire facias* action—the equivalent today of a counterclaim for a declaration of invalidity. He thus implied that the Chancery would wait for the outcome of such a jury trial or alter any decree in equity according to the result of the trial. But he also acknowledged that a *scire facias* action

254. *Id.* at 388–90; *see also* Bacon v. Spottiswoode & Jones (Ch. 1839), in MORNING ADVERTISER, May 6, 1839, at 3 (Langdale, M.R.) (“[T]hey had adopted the very unusual means of allowing a considerable time to elapse before applying for this injunction.”); Bacon v. Spottiswoode, C33/890, f. 886^{r-v} (Ch. 1839); Bacon v. Jones, C33/890, f. 886^v (Ch. 1839).

255. Bacon v. Jones, C33/891, f. 1330^r, 4 My. & Cr. 433, 436–37 (Ch. 1839); ERA, July 28, 1839, at 4 (noting that the “plaintiff also instituted an action at law”).

256. Bacon, 4 My. & Cr. at 436–37 (stating only that the court would consider the “conduct and dealings of the parties, the frame of the pleadings, the nature of the patent-right, and of the evidence by which it is established”). He did not mention defendants who conceded validity, but it is not hard to imagine that he at least had that in mind, along with procedural waivers. He also appears to have called for genuine, non-frivolous challenges to warrant a jury trial. *Cf.* Marquis of Waterford v. Knight, 11 Cl. & F. 653, 658–59 (H.L. 1844) (Lord Cottenham).

257. Wilson v. Tindal, 1 Web. P.C. 730, 730 (Ch. 1841) (Langdale, M.R.). Despite believing the patent was valid, the court sent the case to law at the request of the defendant, soon after the bill was filed, and while enjoining the defendant in the meantime. *Id.*; Wilson v. Tindall, C33/914, ff. 177^r–181^r (Ch. 1841); ATLAS, Nov. 27, 1841, at 761 (“unquestionable validity”).

could not try infringement, and so referring invention cases to law was likely to remain the usual course.²⁵⁸

Any confusion brought on by this altered view²⁵⁹ ended in 1852 when Parliament effectively repealed section 2's applicability to the Court of Chancery. The nuisance of dividing adjudication between law and equity had become acute in all manner of suits, including patent cases. And so in a series of statutes Parliament began fusing the powers of both court systems.²⁶⁰ Parliament empowered the common-law courts to grant injunctions and accountings in patent actions;²⁶¹ authorized the Chancery to award damages and summon a jury;²⁶² obligated the Chancery to opine on the common law, rather than send a legal question to law for an opinion;²⁶³ and, most importantly for our purposes, permitted the Chancery in its discretion to determine the legal title or right of a party in instances where it normally would "decline to grant equitable Relief until the legal Title or Right . . . shall have been established in a Proceeding at Law."²⁶⁴ In 1862, Parliament largely obligated the Chancery to do the latter and decide every question of law or fact, otherwise cognizable in a court of law, relating to a legal right and where granting equitable relief depended on

258. *Wilson*, 1 Web. P.C. at 730.

259. *See, e.g.*, HINDMARCH, *supra* note 252, at 306–07, 311, 348–50, 356–57 (noting among other things that "the relief afforded to a patentee by the Court of Chancery, is only in aid of his legal title, and that the Court will not dispense with a trial at Law if required by a defendant"; but later quoting the recent remarks of the judges in *Bacon* and *Wilson* without fully reconciling them with past doctrine); CHARLES STEWART DREWRY, A SUPPLEMENT TO THE LAW AND PRACTICE OF INJUNCTIONS 43–44 (London, 1849) (suggesting that Lord Cottenham walked back his views in *Bacon*, citing *Harman v. Jones*, 1 Cr. & Ph. 299, 300–01 (Ch. 1841), and arguing that "the dictum in *Wilson v. Tindal* cannot be supported, and that it is of right in the parties [in a patent suit] to have a trial at law of some kind of the legal right").

260. *See generally* Michael Lobban, *Preparing for Fusion: Reforming the Nineteenth-Century Court of Chancery* (pts. 1 & 2), 22 LAW & HIST. REV. 389, 565 (2004).

261. Patent Law Amendment Act 1852, 15 & 16 Vict. c. 83, § 42.

262. Chancery Amendment (Lord Cairns's) Act 1858, 21 & 22 Vict. c. 27, §§ 3–5.

263. Chancery Amendment Act 1852, 15 & 16 Vict. c. 86, § 61 (referring to a case stated).

264. *Id.* § 62; *see also* FIRST REPORT OF HER MAJESTY'S COMMISSIONERS APPOINTED TO INQUIRE INTO THE PROCESS, PRACTICE, AND SYSTEM OF PLEADING IN THE COURT OF CHANCERY 24 (London, 1852) ("As regards to those cases in which the Court of Chancery declines to act until the plaintiff has established his right in an action, we think that the duty should be imposed on the Court of ascertaining and deciding the questions of law and of fact on which the plaintiff's right depends, using for that purpose where required its power of submitting any question of fact to a jury, by means of an issue.").

establishing that right.²⁶⁵ As commentators later noted, “[t]he effect of this legislation was to withdraw the trial of patent actions almost entirely from the Common Law Courts.”²⁶⁶ No constitutional provision like the Seventh Amendment hindered the move.

C. Patent Actions at Law Bound the Parties

As we have shown, once a case was decided at law, it could return to the Chancery. Typically, a party would set the cause down for a hearing on the “equity reserved.”²⁶⁷ A plaintiff might also arrive at the hearing having succeeded in an action against the defendant before filing suit in equity. Depending on the outcome at law, a final injunction, accounting of profits, taxation of costs, or dismissal might ensue. The historical record indicates the Chancery could not ignore the verdict in an action, adopt its own view of validity or infringement, and decree accordingly. Under some circumstances, to be sure, a new trial at law could be ordered, but the Chancery could only grant a new trial if it had sent the case to law by directing an issue. When the Chancery directed an action, which was the accepted course before 1800 when the legal right of a patent was in question, or the plaintiff had previously adjudicated an action at law on her own initiative, only the court that tried the case—either the King’s Bench or Common Pleas—had the power to order a new trial. And if the judges in that court were

265. Chancery Regulation (Sir John Rolt’s) Act 1862, 25 & 26 Vict. c. 42, §§ 1, 2.

266. ROGER WILLIAM WALLACE & JOHN BRUCE WILLIAMSON, *THE LAW AND PRACTICE RELATING TO LETTERS PATENT FOR INVENTIONS* 448 (1900); *see also* *Bovill v. Hitchcock*, (1867–1868) L.R. 3 Ch. App. 417, 417–18 (1868) (“[Counsel argued that before Lord Cairns’s Act and Rolt’s Act] a Defendant in a patent suit had an absolute right to require the Plaintiff to establish his patent at law . . . [Lord Cairns, L.J.]:—You need not cite cases in support of that undoubted rule.”); *see also generally* WILLIAM WILLIAMSON KERR, *A TREATISE ON THE LAW AND PRACTICE OF INJUNCTIONS IN EQUITY* 216–17 (London, 1867) (comparing the old and new practices of the Chancery on this point); 1 EDMUND ROBERT DANIELL, LEONARD FIELD, EDWARD CLENNELL DUNN & JOHN BIDDLE, *THE PRACTICE OF THE HIGH COURT OF CHANCERY* 939–40 (5th ed. London, 1871) (same).

267. Gómez-Arostegui, *supra* note 110, at 210–11. For some outcomes, such as where the plaintiff neglected to go to law despite being given liberty to do so, a hearing was unnecessary. *See generally* *Frank v. Carew*, BL Hargrave MS 383, p. 216, GT Hardwicke MS, 1743–1744, p. 216 (Ch. 1744); *e.g.*, *Kay v. Mills*, C33/389, f. 450^{r-v} (Ch. 1748).

satisfied with the verdict, that verdict would govern in Chancery.²⁶⁸ Even if an equity judge doubted the conclusiveness of a verdict in a patent case, it appears the most he would contemplate doing is send

268. *Smith v. Earl of Pomfret*, 2 Dick. 437, 437–48 (Ch. 1770) (reg.) (“[Following an action,] this Court hath nothing to do with the trial, or the verdict . . . if it be wrong, the party aggrieved, should have applied to the Court at law for a new trial”); *Fowkes v. Chadd*, 2 Dick. 576, 576–77 (Ch. 1780) (Lord Thurlow, L.C.) (“Where an action is to be brought, and tried, the title is a legal one, and till the plaintiff’s right or title is established, he hath no business here”; loser at law in a trespass action cannot subsequently move for a new trial in Chancery); *Stevens v. Praed*, 2 Ves. Jr. 519, 522 (Ch. 1795) (Arden, M.R.) (“[In an action,] I am not at liberty to consider what passed at Nisi Prius [*i.e.*, trial]”); *Ex parte Kensington, Coop.* G. 96, 96–97 (Ch. 1815) (Lord Eldon, L.C.) (“The constant and uniform Practice of this Court has been . . . that the Application for a new Trial should be made to the Court of Law which has tried the Action, till that Court is satisfied with the Verdict; though it is otherwise with an Issue, in which Case the Motion for a new Trial is to be made in the Court of *Chancery*.”); *Bootle v. Blundell*, 19 Ves. Jr. 494, 500, *Coop. G.* 136, 137 (Ch. 1815) (Lord Eldon, L.C.) (noting that when the Chancery sends a dispute to law on an action, “the review or propriety of which belongs to a Court of Law, the opinion of a Court of Law . . . is regarded as conclusive, whether the judgment is obtained upon a verdict, or in any other shape[;] but upon an issue directed this Court reserves to itself the review of all, that passes at Law”; “Upon an Action directed, the Verdict is final”); *Hill v. Thompson*, 3 Meriv. 622, 626–27 (Ch. 1817) (arg.) (arguing in a patent-infringement suit in Chancery that the verdict of the jury was “conclusive as to the matter of fact” adjudicated during the trial and that an application for an injunction afterward was “as of course, and such as the Court could not refuse, without taking upon itself to meddle with what was the exclusive province of a Court of Law”; opposing counsel appeared to agree in principle, but parried that the verdict was not yet final as they intended to move next term in the Common Pleas for a new trial); *Jones v. Carrington*, 1 C. & P. 497, 499 n.(b) (Ch. 1824) (“A verdict in an action is to bind the right of the parties”); *Russell v. Barnsley*, 1 Web. P.C. 472, 473 (Ch. 1834) (Shadwell, V.C.) (“[I]t does not at all follow, because it appears to me at present that the patent is good, that there may not be a different view of it taken by a court of law [T]he legal view of the thing is that which must ultimately bind this court [Counsel:] Of course I must admit the general principle”); *Kay v. Marshall*, 1 My. & Cr. 373, 388 (Ch. 1836) (Lord Cottenham, L.C.) (“[If] a plaintiff [in a patent-infringement dispute] comes here for equitable relief, after he has established his right at law against the defendant, the Court will not withhold its assistance because it may doubt or disapprove the decision at law.”); *Hope v. Hope*, 10 Beav. 581, 585–86 (Ch. 1847) (Lord Langdale, M.R.) (“The parties have wholly misconceived the nature of the proceeding, when they think that this Court can . . . look into the proceedings at law, further than the result of the action.”); *Smith v. Earl of Effingham*, 10 Beav. 589, 597, 599–600 (Ch. 1847) (Lord Langdale, M.R.) (“After the case is determined at law, the regular course is, to set down the cause in equity to be heard, as it is said, on the equity reserved, and on the hearing, the result of the proceeding at law is ordinarily held to be conclusive. No direction for a new trial is to be given here.”).

the case to law for another (albeit technically not a “new”) trial to have a jury adjudicate it again.

Many of these points arose in *Liardet v. Johnson*, which we have only just discussed.²⁶⁹ There, the Chancery had sent the parties to law on an action before the hearing of the cause. After the first trial, the defendant moved the King’s Bench for a new trial, received one, and lost once more. Knowing the King’s Bench was very unlikely to allow a third trial, he did not ask for one.²⁷⁰ Counsel also knew that, strictly speaking, they could not move the Chancery for a new trial because it had not sent the case to law on an issue. So when the plaintiffs set the cause down for a hearing to obtain a final injunction and accounting two years after the second trial, the defendant attempted to scuttle the verdict by submitting depositions of witnesses who testified at trial and a few who had not, his Chancery answer, and documents contesting validity and infringement.²⁷¹

Attempting to equate a patent-infringement action with an ejectment action, the defendant first hoped to convince the court to satisfy its own “conscience” by reviewing the merits of his evidence and to then send the case to law for a third jury trial by directing an issue.²⁷² Counsel then urged the court to utilize equity’s broad standard for new trials, which allowed the court to weigh the evidence, something the

269. See *supra* text accompanying notes 237–250.

270. *Liardet v. Johnson*, LI Hill MS 20, pp. 227, 233 (Ch. 1780); see generally TRUSLER, *supra* note 101, at 248 (“[O]n a second trial, if a new jury give a similar verdict, a third trial is seldom awarded.”).

271. *Liardet*, LI Hill MS 20, p. 236.

272. *Liardet v. Johnson*, GT Eldon MS, Notes of Cases 1779, pp. 34, 38 (Ch. 1780) (Madocks arg.) (“The Court ought to have Satisfaction in their own Minds that the [last] Verdict is right[.]”). Ejectment actions were the principal way to settle disputes over title to land, see 3 BLACKSTONE, *supra* note 92, at 200–06, but given their nature as fictitious possessory actions they could never conclusively determine title between two parties. That meant litigants with the will and the means could sue each other repeatedly at law to challenge the title via possession. See GILES JACOB, *THE STUDENTS COMPANION: OR, REASON OF THE LAW* 60–61 (3d ed. Savoy, 1743). The only way to stop the litigation was to file a complaint in Chancery. *E.g.*, *Leighton v. Leighton*, 1 P. Wms. 671, 673–74, 1 Str. 404, 404 (Ch. 1720). The Chancery would quiet the possession on behalf of one party by perpetually enjoining the other party from suing again after a sufficient number of ejectment verdicts indicated vexation and a satisfactory adjudication of the matter. See 3 RICHARD WOODDESON, *A SYSTEMATICAL VIEW OF THE LAWS OF ENGLAND* 416–17 (London, 1793); 1 GEORGE SPENCE, *THE EQUITABLE JURISDICTION OF THE COURT OF CHANCERY* 658 (London, 1846).

law courts would not do.²⁷³ They further argued that the Chancery would never decree a final injunction upon a verdict following an action, and that the court had to first send the case to law on an issue.²⁷⁴ If this latter argument sounds familiar, it is because two of the defendant's counsel in *Liardet* served as counsel in *Morris v. Unwin*, where Lord Apsley had previously rejected the same argument.²⁷⁵ Notably, despite throwing most everything into their argument, counsel were not so bold as to toss in the kitchen sink: that the Chancery could re-adjudicate validity and infringement on its own. Counsel of course had previously insisted that the plaintiffs "establish[] at Law the[ir] Sole and exclusive Right" and "in like manner establish[]" that the defendant infringed the right.²⁷⁶

Plaintiffs, for their part, saw the move for what it was, a backhanded attempt to obtain a new trial, which they argued the Chancery was not permitted to order.²⁷⁷ They did engage in the alternative with the new-trial standard used by law courts,²⁷⁸ pointing out, among other things, that "[t]here being a great deal of contradictory Evidence," there would in a court of law be "no ground for a new trial."²⁷⁹ In any case, they said, there was no need to direct an issue because the verdicts had already "establish[ed] the Patent & the Infringement of it" and the "Validity of [the] Patent" had been established "before [the] proper Tribunal."²⁸⁰ "[E]very fact alledged in the Declaration, & necessary to support the Action," they argued, "must be taken as proved & found

273. *Liardet*, GT Eldon MS, p. 39 (Kenyon arg.); compare Lord Faulconberg v. Peirce, Amb. 210, 210 (Ch. 1754); *Stace v. Mabbot*, 2 Ves. Sr. 552, 553–54 (Ch. 1754), with *Ashley v. Ashley*, 2 Str. 1142, 1142 (K.B. 1740); *Anonymous*, 1 Wils. K.B. 22, 22 (K.B. 1743); *Beardmore v. Carrington*, 2 Wils. K.B. 244, 249 (K.B. 1764); *Swain v. Hall*, 3 Wils. K.B. (3d ed.) 45, 47 (C.P. 1770).

274. *Liardet*, LI Hill MS 20, p. 236 (arg.) ("[W]ill always direct an issue first, before binding the parties forever."); *Liardet*, GT Eldon MS, p. 34 (Kenyon arg.) ("[T]he Defendant ought to have an opportunity of moving here [in Chancery] for a new Trial [on an issue] in Case he is dissatisfied with the Verdict that is to establish Plaintiffs right to [an] Injunction in this Court.").

275. See *supra* text accompanying note 230.

276. *Liardet v. Johnson*, C12/1346/22, no. 2 (Ch. 1777); accord *Liardet*, LI Hill MS 20, p. 239.

277. *Liardet*, LI Hill MS 20, p. 234 (arg.), GT Eldon MS, p. 40 (McDonald arg.).

278. *Liardet*, LI Hill MS 20, pp. 234–35.

279. *Liardet*, GT Eldon MS, p. 40 (McDonald arg.)

280. *Id.* at 36 (Thompson arg.).

by the Jury.”²⁸¹ Consequently, the only proof plaintiffs offered at the hearing was the record of the verdicts and the judgment in the King’s Bench.²⁸² They also urged the court to exclude the defendant’s evidence.²⁸³ As for the notion the court would not decree a final injunction without an issue, counsel parried: “That this Court won’t grant an Injunction on an Action is perfectly new to me [There is] [n]o difference except that you can’t move for a new Trial here [on an action].”²⁸⁴

Baron Eyre refused to return the case to law on an issue. He first ruled that the defendants were not estopped entirely from presenting any evidence at the hearing. “Strictly speaking,” he said, on “the same point and between the same parties, a Verdict is always Conclusive.”²⁸⁵ He noted that if the verdicts “had been given after the Hearing of the Cause they would have been Conclusive, but they were given before the Cause came on to be heard,”²⁸⁶ and that he would take under advisement the defendants’ argument that it made a difference. There was also, he said, “[m]ore [left] in the Cause than whether the Patent is good” and infringed—the “purpose of the bill [in equity] [wa]s a perpetual Injunction & an account.”²⁸⁷ Baron Eyre therefore admitted the defendants’ evidence, while warning that he might determine that it had no force or application in the cause.

Continuing the hearing the following day, Baron Eyre recounted the course of proceedings in invention suits, which entailed the parties going to law.²⁸⁸ He reiterated that a verdict would determine liability if it came after the court directed an action (or even an issue) during a

281. *Liardet*, LI Hill MS 20, p. 234 (arg.). For a similar point being made on writs of error, see *Sutton v. Johnstone*, 1 T.R. 493, 545 (Exch. Ch. 1786) (Lord Mansfield, C.J. & Lord Loughborough, C.J.) (“[On a writ of error,] [a]fter a verdict, the presumption is, that such parts of the declaration, without proof of which the plaintiff ought not to have had a verdict, were proved to the satisfaction of the jury.”); *Hornblower v. Boulton*, 8 T.R. 95, 101 (K.B. 1799) (Grose, J.) (making the same point in a patent-infringement case).

282. *Liardet*, LI Hill MS 20, p. 233; *Liardet v. Johnson*, C37/2077, C37/2116 (Ch. July 3–5, 1780).

283. *Liardet*, LI Hill MS 20, p. 236 (arg.), GT Eldon MS, pp. 36, 39 (McDonald arg.) (“No Case where the Court after a trial recommended by the Court has ever admitted Evidence afterwards [on liability].”).

284. *Liardet*, GT Eldon MS, p. 45 (Mansfield arg.).

285. *Liardet*, LI Hill MS 20, p. 239.

286. *Id.* at 239–40; *Liardet*, GT Eldon MS, p. 40.

287. *Liardet*, GT Eldon MS, p. 40.

288. *See supra* text accompanying notes 244–246.

hearing.²⁸⁹ And he ruled that the posture now was effectively no different: “It seems to me that the Case is now the same in substance. Indeed, I think the Method which was taken of postponing the Hearing ‘till after the Trial preferable.”²⁹⁰ Having reviewed the defendant’s evidence, Baron Eyre determined that it served solely to attack the second verdict.²⁹¹ Although he did not think that verdict was “so conclusive . . . that it could be pleaded” as an estoppel by record, and he apparently was more willing to review what happened at law on an action than the judges who normally sat in Chancery, he nevertheless concluded that he would not “inquire into the weight and Merits of the Evidence now laid before me.”²⁹² It “does not become me in a Court of Equity on a doubt of mine to impeach [the verdict],” he said, “I am not the proper Judge of the Question.”²⁹³ He did note, however, that “[i]f there had been extrinsic Evidence which went to shew any [equitable] ground for not granting the Injunction[,] the Case would [have] be[en] different.”²⁹⁴

IV. REFLECTIONS AND IMPLICATIONS

Recall that under the law as it currently stands, courts and commentators believe that if a patentee filed suit in equity in 1791 for injunctive relief the Chancellor would adjudicate the entire suit, even if the validity of the patent was disputed. Thus, neither party had a right

289. *Liardet*, LI Hill MS 20, p. 241 (“If the Cause had gone on to a hearing, the Court would either have directed an Action or an Issue, and then the subsequent decision would have been according to the event of the Trial.”); see also RANKIN, *supra* note 252, at 107 (suggesting that in patent cases directing even an issue on validity would be “conclusive” in equity).

290. *Liardet*, LI Hill MS 20, p. 242; accord *Liardet v. Johnson*, *cit.* LI Hill MS 20, p. 233 (K.B. 1778) (Lord Mansfield, C.J.) (noting that the action was “brought, in effect,” as if directed by the Chancery at the hearing); *Earl of Pomfret v. Smith*, *cit.* 2 Dick. 437, 438 (H.L. 1772) (Lord Mansfield, C.J.) (“[W]here the Court [of Chancery] makes an order *by consent* of the parties [to go to law via an action] in an early stage of the cause; it operates as if regularly brought to [the] hearing; but that it is otherwise if the order be made without consent”).

291. *Liardet*, LI Hill MS 20, p. 243 (“The Evidence which has been read only goes to the point of the Verdict.”)

292. *Id.*

293. *Id.*; *Liardet*, GT Eldon MS, pp. 47–48 (“This is Evidence attacking the very point of the Verdict. I should have very great difficulty in conceiving how this Verdict was obtained but I am not authorised to entertain doubts which perhaps [another trial might clear up] . . .”).

294. *Liardet*, LI Hill MS 20, p. 243.

to a jury.²⁹⁵ Although some of those decisions considered the prospect of the Chancery sending a dispute to law to have validity tested by a jury, they concluded, largely based on mid-to-late nineteenth-century American authorities, that in “18th-century England, if a claim was in the court of equity, the equity court had the discretion to submit a claim to a jury but was never required to submit any issue to a jury.”²⁹⁶ Nor have courts considered that a plaintiff *c.*1791 could commence an action at law to adjudicate liability before or after filing in equity, while desiring nominal damages only.

For their part, those earlier American authorities acknowledged that, in England, the Chancellor would send the parties to law when the defendant challenged the validity of the patent. But they viewed the referral as discretionary:

“But even there the rule is not absolute or universal; it is a practice founded more on convenience than necessity. It always rests on the sound discretion of the court. A trial at law is ordered by a chancellor to inform his conscience; not because either party may demand it as a right, or that a court of equity is incompetent to judge of questions of fact or of legal titles.”²⁹⁷

Relatedly, the aforesaid authorities opined that any verdict obtained at law on a directed issue was merely advisory, and thus one that the court could ignore and contrarily decree.²⁹⁸

Most of these American decisions, however, did not set out to describe eighteenth-century requirements. The Federal Equity Rules of 1842 instructed courts to consider equity procedure as it existed in 1842 in England as “just analogies” for how federal courts were to govern themselves, at least where not otherwise covered by the Federal Equity Rules or federal statutes.²⁹⁹ Thus, in considering American practice, federal courts relied on mid-nineteenth-century English

295. See *supra* text accompanying notes 73–80.

296. *AIA Am., Inc. v. Avid Radiopharms.*, 866 F.3d 1369, 1373–74 (Fed. Cir. 2017) (citing *Garsed v. Beall*, 92 U.S. 684, 695 (1876)); accord *In re Lockwood*, 50 F.3d 966, 976 (Fed. Cir. 1995) (citing *Root v. Ry. Co.*, 105 U.S. 189, 205–06 (1882)), *vacated* 515 U.S. 1182 (1995).

297. *Root*, 105 U.S. at 205–06 (quoting *Goodyear v. Day*, 10 F. Cas. 678, 683 (C.C.D.N.J. 1852) (No. 5,569) (Grier, J.)); accord *Goodyear v. Providence Rubber Co.*, 10 F. Cas. 712, 717 (C.C.D.R.I. 1864) (No. 5,583) (Clifford, J.) (referring to practice in the “parent country”).

298. *Garsed*, 92 U.S. at 695; *Providence Rubber*, 10 F. Cas. at 717–18 (Clifford, J.); see also *Allen v. Blunt*, 1 F. Cas. 448, 449 (C.C.D. Mass. 1845) (No. 216) (Story, J.).

299. FED. EQ. R. 90 (1842); JAMES LOVE HOPKINS, *THE NEW FEDERAL EQUITY RULES* 5–6 (1913).

authorities, like the cases we described previously,³⁰⁰ and the Patent Acts of 1836 and 1870.³⁰¹ Moreover, when speaking of the effect of sending a case to law in England, the aforesaid American authorities solely discussed the practice of directing issues.³⁰² In short, these mid-to-late nineteenth-century authorities, standing alone, are a poor substitute for the eighteenth-century sources canvassed here.³⁰³ Not surprisingly, *Sullivan v. Redfield* in 1825, which is closer in time, is most accurate.³⁰⁴

Only one American decision attempted to glean English practice at the founding. In 1849, Justice Wayne concluded that English practice stopped requiring an action at law in patent cases *c.* 1761.³⁰⁵ But he was misled by a single reported case and misapplied later English cases. Nor did he consider other accessible English authorities from the nineteenth century that stated otherwise.³⁰⁶

To start, it is true that in 1761, Charles Ambler in *Dodsley v. Kinnersley* reported that the Master of the Rolls, Thomas Clarke, said the following during the hearing in a copyright suit:

[T]here is no impropriety in the application to this Court. The method of proceeding in these cases has been changed. Formerly, in the case of a patentee, on opening the case, the party was sent to law to establish his right, and then came back for an account The old practice was like the case of agreements before Lord SOMERS' time: the party was sent to law, and if he recovered any thing by way of damages, this Court entertained the suit.³⁰⁷

300. See *supra* text accompanying notes 252–259; *Day*, 10 F. Cas. at 681–82 (citing *Bacon v. Jones*, 4 My. & Cr. 433 (Ch. 1839); *Wilson v. Tindal*, 1 Web. P.C. 730 (Ch. 1841)).

301. See *supra* notes 45–46.

302. Cf. *Watt v. Starke*, 101 U.S. 247, 250–52 (1880) (comparing issues and actions).

303. *Accord Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 47 n.6 (1989) (questioning the value of authorities that do not “so much as mention[] 18th-century English practice”); *Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 383 (1996) (questioning the value of mid-nineteenth century English patent cases in lieu of any authorities from the relevant period).

304. *Sullivan v. Redfield*, 23 F. Cas. 357, 359 (C.C.D.N.Y. 1825) (No. 13,597); see also *supra* text accompanying notes 41–42.

305. *Motte v. Bennett*, 17 F. Cas. 909, 911 (C.C.D.S.C. 1849) (No. 9,884); see also *supra* text accompanying notes 44–51.

306. See, e.g., *supra* note 252.

307. *Dodsley v. Kinnersley*, Amb. 403, 406 (Ch. 1761).

The report could be clearer, and perhaps this is an example of what led Ambler to earn a poor reputation as a reporter of decisions.³⁰⁸ Given what we know of the actual practice in patent cases during the period, it seems very unlikely that Clarke said that the Chancery could adjudicate an invention-patent suit in its entirety and without any obligation to send the case to law when the defendant contested the validity of the patent. Rather, the Master of the Rolls was very likely referring to the old practice where the Chancery would not entertain a suit at all until the patentee had first obtained a verdict at law, or the similarly old practice that the court would not, while entertaining the suit, grant an *interim* injunction without the patentee having first gone to law.³⁰⁹ That is, in fact, how a later editor of Ambler's reports interpreted Clarke's purported remarks.³¹⁰

Justice Wayne also cited several early nineteenth-century English authorities that were inapposite to the point he was trying to make—*viz.*, that the Chancery was never obligated to send a patent dispute to law before decreeing a final injunction. Chief among them were decisions from Lord Chancellor Eldon in which he confirmed that a plaintiff did not necessarily need to go to law to validate a patent before obtaining an *interlocutory* injunction. In settling the practice in his court, Lord Eldon set out the circumstances under which the court would or would not preliminarily enjoin a defendant while a patent was tried at law. In cases where a patent was relatively new and had not previously been upheld in an action against another person, the plaintiff would have to validate his patent at law without the aid of such an injunction. But where the patentee had exercised the patent for some time, and its validity had not been successfully challenged by another, the court afforded the patent a presumption of validity in equity and would thus ordinarily enjoin the defendant while the patent

308. JOHN WILLIAM WALLACE, *THE REPORTERS* 513 (4th ed. Boston, 1882) (“In many instances the language of the Judges was so erroneously reported that false ideas were given even of the points decided.”). Manuscript reports of the argument do not shed any light on this point. *E.g.*, *Dodsley v. Kinnersley*, LI Hill MS 2, p. 433, IT Misc. MS 196, p. 353 (Ch. 1761).

309. *See supra* text accompanying notes 154–162.

310. *Dodsley v. Kinnersley*, Amb. (2d ed.) 403, 406 n.6 (Ch. 1761) (1828 edition which added a footnote citing cases discussing the old practice just mentioned); *accord* *Grierson v. Jackson*, 1 Ridg. L. & S. 304, 304–05 (Ch. Ir. 1794) (Jameson arg.); 1 HENRY MADDOCK, *A TREATISE ON THE PRINCIPLES AND PRACTICE OF THE HIGH COURT OF CHANCERY* 137 (2d ed. London, 1820); 3 EDMUND ROBERT DANIELL, *A TREATISE ON THE PRACTICE OF THE HIGH COURT OF CHANCERY* 323–24 (London, 1841).

was tried at law.³¹¹ In either scenario, Lord Eldon assumed that the patent would be tested at law. As he explained to the House of Lords in 1804:

[T]he rule is this, that if, under a Patent, there is a colourable title, and if, under that fair colourable title, there is possession, (even if, upon discussion at Law the Patent shall turn out to be a bad Patent,) the Court of Chancery will protect by Injunction till the hearing, and till there has been such a Trial at Law as shall establish the right[.]³¹²

Ultimately, then, discarding the slips of Justice Wayne and later cases, the pertinent historical record contains enough reliable material to indicate whether litigants have a right to adjudicate validity or infringement with a jury before a court can grant final equitable relief. Take the prototypical case where a patentee sues for infringement, solely seeks equitable relief, and the alleged infringer asserts an invalidity defense. Here, the defendant has a right to a jury on validity, and if she also contests infringement, on that issue as well. That is because, in the eighteenth century, the plaintiff had to file an action at law against the defendant to validate the patent if the defendant insisted on it, and the infringement of the patent would be tried alongside validity if also put in issue. A defendant who today admits the validity of the patent, which we imagine is as unlikely as it was in the eighteenth century, has no right to a jury on any issue. As for the plaintiff's right in these equity suits, it is broader. A plaintiff has a right to a jury trial on validity, infringement, or both, because in the eighteenth century a plaintiff could file an action at law against the defendant even before her suit in equity. None of these actions at law had to pursue an award of actual damages at trial. A plaintiff could obtain a judgment of liability with nominal damages.

Neither party today has a right to a jury trial on any issues unique to equity in the case. In the eighteenth century, the task of awarding interim injunctions, final injunctions, and an accounting and disgorgement of an infringer's profits occurred solely in equity.

311. *E.g.*, *Univs. of Oxford and Cambridge v. Richardson*, 6 Ves. Jr. 689, 707 (Ch. 1802); *Harmer v. Plane*, 14 Ves. Jr. 130, 132 (Ch. 1807); *Cochrane v. Smethurst*, 2 Coop. temp. Cott. 57, 57 (Ch. 1816); *Hill v. Thompson*, 3 Meriv. 622, 624–26, 628 (Ch. 1817); *Hill v. Wilkinson*, 30 Reper. of Arts 382, 383, 2 Coop. temp. Cott. 57, 57 (Ch. 1817); *see also* *Curtis v. Cutts*, 8 L.J. (N.S.) 184, 186–87 (Ch. 1839) (Lord Cottenham, L.C.); *Elec. Tel. Co. v. Nott*, 2 Coop. temp. Cott. 41, 47–56 (Ch. 1847) (Lord Cottenham, L.C.).

312. *Richardson v. Univs. of Oxford and Cambridge* (H.L. 1804) (Lord Eldon, L.C.), *in* JUDGMENTS AND EXTRACTS, *supra* note 178, at 28.

Although a verdict and judgment at law finding an infringer liable directly affected the latter two issues, and could affect the first issue if the plaintiff obtained a judgment at law against the defendant before filing in equity, neither the judge at law nor the jury had the final word on whether to grant those forms of relief. Equitable grounds could delay equitable relief, and additional fact finding was handled procedurally according to equity.

To be sure, it might seem odd to have a defendant's right to a jury depend today on whether he has challenged the validity of the patent. But perhaps that is no stranger than having the right to a jury on liability depend on whether a plaintiff seeks damages, which is how the law currently stands in patent cases.

This brings us to our final point. One must wonder whether, in light of the historical practices outlined here, but depending less directly on them, patentees can ensure a right to a jury trial simply by expressly adding a claim for "nominal damages" to their complaints (alongside their requests for equitable relief). This would result in a mixed-relief case with a right to a jury trial on all common issues so triable under step two of the Court's historical Seventh Amendment test. Only a few arguments could stand in the way of this move, most of which are easily surmountable. But one potential hurdle does require additional guidance from the Court.

The first argument is that patentees cannot seek nominal damages in patent-infringement actions today—full stop. Nominal damages were historically available to plaintiffs in patent actions in the United States. And like in England, plaintiffs were entitled to them if they succeeded at law.³¹³ Though often a mere consolation for those who tried but failed to prove actual damages, nothing prevented plaintiffs from seeking nominal damages alone.³¹⁴ Stated another way, a request

313. *E.g.*, *Spaulding v. Tucker*, 22 F. Cas. 896, 898 (C.C.D. Cal. 1869) (No. 13,220) ("If you find for the plaintiff, he is at least entitled to nominal damages—one cent."); *United Nickel Co. v. Cent. Pac. R. Co.*, 36 F. 186, 189 (C.C.N.D. Cal. 1888) ("If there has been an infringement, plaintiff is entitled to nominal damages at least . . ."); *see also* *Whittemore v. Cutter*, 29 F. Cas. 1120, 1121 (C.C.D. Mass. 1813) (No. 17,600) (Story, J.) (rejecting the argument that "no action lies" for patent infringement "except for actual damage[s]").

314. *Merchant v. Lewis*, 17 F. Cas. 37, 37 (C.C.S.D. Ohio 1857) (No. 9,437) ("It happens, not unfrequently, that the owner of a patent is compelled, for the protection of his rights, to sue for an infringement, under circumstances in which he neither seeks to recover nor asserts a right to anything beyond mere nominal damages. This

for nominal damages sufficed to open the doors of the law side of the court for a jury trial.³¹⁵ In 1946, Congress addressed the long-standing concern about plaintiffs who sought but failed to prove their actual damages because of the difficulty of proving their lost profits or the existence of an established royalty.³¹⁶ As part of that process, it enacted that a successful patentee “shall be entitled to recover general damages which shall be due compensation . . . not less than a reasonable royalty.”³¹⁷ Today, the pertinent statute similarly states that “the court shall award the claimant damages adequate to compensate for the infringement, but in no event less than a reasonable royalty.”³¹⁸

Commentators have recently debated whether that language precludes awarding nominal damages to a plaintiff who sought substantial relief, particularly when the plaintiff fails to prove the basis for any reasonable royalty. Most have concluded that the statute does not prohibit nominal awards under those circumstances.³¹⁹ A plurality of the Court in 1964 also read the 1952 Act to permit nominals.³²⁰ Besides, a plaintiff who *voluntarily* seeks nominal damages is a different scenario, and we are unaware of any suggestion that this was identified as a “problem” for Congress to fix in 1946 or 1952. We would, in any case, expect more direct language in the statute if Congress intended to force a reasonable royalty on a plaintiff who did not want one, and

may be necessary for the establishment of his patent, and to prevent infringements.”); *e.g.*, *Johnson v. Root*, 13 F. Cas. 798, 806 (C.C.D. Mass. 1862) (No. 7,409) (“Nominal damages only were claimed . . .”).

315. 3 ROBINSON, *supra* note 42, § 953, at 141–42, § 1052, at 320.

316. Thomas F. Cotter, *Standing, Nominal Damages, and Nominal Damages “Workarounds” in Intellectual Property Law after TransUnion*, 56 U.C. DAVIS L. REV. 1085, 1096–1100 (2023).

317. 35 U.S.C. § 70 (1946).

318. 35 U.S.C. § 284. The “stated purpose [of § 284 of the 1952 Act] was merely ‘reorganization in language to clarify the statement of the statutes.’” *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 505 n.20 (1964) (plurality opinion) (quoting H.R. REP. NO. 82-1923, at 10, 29 (1952)).

319. Cotter, *supra* note 316, at 1093, 1118–20, 1136–37, 1142–46 (examining cases); *see also* Oskar Liivak, *When Nominal is Reasonable: Damages for the Unpracticed Patent*, 56 B.C. L. REV. 1031, 1034–35, 1058–59 (2015); Daniel Harris Brean, *Ending Unreasonable Royalties: Why Nominal Damages are Adequate to Compensate Patent Assertion Entities for Infringement*, 39 VT. L. REV. 867, 870, 889–96, 917–21 (2015). *But see* Michael Risch, *(Un)reasonable Royalties*, 98 B.U. L. REV. 187, 192, 255 (2018) (arguing that a nominal-damages award is not available in this situation); James Ryan, *A Short History of Patent Remedies*, 6 CYBARIS 150, 195 (2015) (assuming without analysis that nominal damages are no longer available).

320. *Aro Mfg.*, 377 U.S. at 493, 502, 504, 510 (plurality opinion).

in contravention of the long-standing doctrine permitting voluntary nominals.³²¹ Because that categorical exclusion is absent, it strongly indicates that nominals can be sought.³²²

The second possible hurdle—whether seeking nominal damages suffices to trigger and maintain Article III standing on the legal claim—remained an open question until recently. In 2012, Judge Posner doubted that a patentee could sue for nominal damages alone without running afoul of the Case or Controversy Clause, stating that a patentee should not be “permitted to force a trial in federal court[,] the sole outcome of which would be an award of \$1.”³²³ But the Court has now laid that line of thinking to rest, ruling that a request for nominal damages satisfies the redressability element of standing, regardless of whether plaintiffs “cannot or choose not to quantify [their] harm in economic terms.”³²⁴ Additionally, the Court has recently reaffirmed that the requirement of a concrete harm for standing can be satisfied by a statutory violation and intangible harm alone, so long as the plaintiff can identify a “close historical or common-law analogue for their asserted injury,” something “traditionally recognized as providing a basis for lawsuits in [English or] American courts.”³²⁵ As we have already shown, the violation of a

321. *Monessen Sw. Ry. Co. v. Morgan*, 486 U.S. 330, 336–39 (1988) (considering decisional law before a statutory enactment when assessing the availability of prejudgment interest); *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 580 U.S. 328, 339–40 (2017) (noting that Congress legislates against the backdrop of common-law principles); *see also* *Promega Corp. v. Life Techs. Corp.*, 875 F.3d 651, 659–60, 665–66 (Fed. Cir. 2017) (noting that patentees can waive their right to request reasonable royalties); *Finjan, Inc. v. Blue Coat Sys., Inc.*, 879 F.3d 1299, 1312 (Fed. Cir. 2018) (same).

322. Note that claims filed under § 271(e)(2) require a *commercial* manufacture, use, offer to sell, sale, or importation of a drug before any “damages or other monetary relief” can be recovered. 35 U.S.C. § 271(e)(4). The exclusive remedies provision of § 271(e)(4) appears explicit enough to preclude a nominals short cut for non-commercial Hatch-Waxman claims.

323. *Apple, Inc. v. Motorola, Inc.*, 869 F. Supp. 2d 901, 909 (N.D. Ill. 2012).

324. *Uzuegbunam v. Preczewski*, 141 S. Ct. 792, 802 (2021); *see also id.* (“[N]ominal damages provide the necessary redress for a completed violation of a legal right.”).

325. *TransUnion LLC v. Ramirez*, 141 S. Ct. 2190, 2204 (2021); *accord* *Spokeo, Inc. v. Robins*, 578 U.S. 330, 340–41 (2016) (“English or American courts.”); *Vt. Agency of Nat. Res. v. United States*, 529 U.S. 765, 774–78 (2000) (noting the importance of eighteenth-century practices in determining what qualifies as a justiciable case or controversy under Article III).

plaintiff's patent, without proof of actual damage, sufficed to support a claim in court at the time of the founding and beyond.³²⁶

But a potential barrier remains under Article III, one that has not yet squarely presented itself to the Court for adjudication. That is whether a defendant can unilaterally moot a claim for damages by depositing the full amount with the court or by paying it directly to the plaintiff without consent, and, if so, whether the defendant in doing so retains the right to challenge the liability issues that underlay that claim and support a plaintiff's remaining request for equitable relief. In 2016, the Court held that an unaccepted offer of judgment of complete relief under Rule 68 (or otherwise) does not moot a case,³²⁷ but it reserved the question of whether a deposit or payment of funds would suffice.³²⁸ Although several current justices have offered their takes on variations of the issues just mentioned,³²⁹ none has considered the alternative short-cut scenario we propose here. This is not the place to delve deeply into this topic, but we will note that eighteenth-century

326. See *supra* text accompanying notes 196–199, 313–314; accord *Cotter*, *supra* note 316, at 1147 n.258 (reaching the same conclusion based on American authorities).

327. *Campbell-Ewald Co. v. Gomez*, 577 U.S. 153, 161–66 (2016); FED. R. CIV. P. 68.

328. *Campbell-Ewald*, 577 U.S. at 166 (“We need not . . . decide whether [a case is mooted] if a defendant deposits the full amount of the plaintiff's individual claim in an account payable to the plaintiff, and the court then enters judgment for the plaintiff in that amount. That question is appropriately reserved for a case in which it is not hypothetical.”).

329. *Id.* at 169–71 (Thomas, J., concurring) (arguing that actually producing the relief sought by a plaintiff as part of a tender requires the defendant to admit liability); *id.* at 183 n.3 (Roberts, C.J., joined by Scalia & Alito, JJ., dissenting) (acknowledging the common-law rule requiring an admission of liability on tenders, but arguing that the Court's precedents do not require an admission); *Uzuegbunam*, 141 S. Ct. at 808 (Roberts, C.J., dissenting) (“Where a plaintiff asks only for a dollar, the defendant should be able to end the case by giving him a dollar, without the court needing to pass on the merits of the plaintiff's claims.”); *id.* at 802 (Kavanaugh, J., concurring) (agreeing with Roberts, C.J.); *Genesis Healthcare Corp. v. Symczyk*, 569 U.S. 66, 85 (2013) (Kagan, J., joined by Ginsburg, Breyer & Sotomayor, JJ., dissenting) (noting that a “court has discretion to halt a lawsuit by entering judgment for the plaintiff when the defendant unconditionally surrenders . . . [but cannot] when the supposed capitulation in fact fails to give the plaintiff all the law authorizes and she has sought”); *cf. also* *N.Y. State Rifle & Pistol Ass'n v. City of New York*, 140 S. Ct. 1525, 1535–36 (2020) (Alito, J., joined by Gorsuch & Thomas, JJ., dissenting) (arguing that nominal damages are “particularly important in vindicating constitutional interests” and that a “claim for nominal damages precludes mootness”). For appellate decisions tackling some of the broader issues, see, e.g., *Chen v. Allstate Ins. Co.*, 819 F.3d 1136, 1141–46 (9th Cir. 2016); *Conrad v. Boiron, Inc.*, 869 F.3d 536, 541–42 (7th Cir. 2017); *Radha Geismann, M.D., P.C. v. ZocDoc, Inc.*, 909 F.3d 534, 540–43 (2d Cir. 2018).

defendants could pay money into court for the benefit of a plaintiff, with the hope of resolving a claim or entire action before trial, but the procedure carried limits.³³⁰

The final hurdle relates most directly to the Seventh Amendment, which requires that the “value in controversy shall exceed twenty dollars.”³³¹ A few courts have held in other contexts, mostly § 1983 suits, and with very little analysis, that the Seventh Amendment requires that a plaintiff seek actual damages in an amount over twenty dollars.³³² And because an award of nominal damages is usually limited to one dollar,³³³ the argument goes, nominals alone can never support a right to a jury trial. Yet, the Amendment appears to be much more accommodating than that, and instead seems intent on endorsing cases that traditionally received only nominal damages, so long as the value of the thing or right being vindicated—not necessarily an amount demanded in actual damages—exceeded twenty dollars. Indeed, the Court has “long assumed,” for example, “that actions to recover land, like actions for damages to a person or property, are actions at law triable to a jury.”³³⁴ This includes disputes hoping to

330. For example, a defendant who hoped to contest whether he was liable on a claim at trial could not use the procedure because paying money into court was limited to cases where the “Dispute betwixt the Plaintiff and Defendant is only how much is due to the Plaintiff, and not whether any thing at all is due to him.” [ROBERT RICHARDSON], *THE ATTORNEY’S PRACTICE IN THE COURT OF KING’S BENCH* 85 (Savoy, 1739); *see also* JOHN HULLOCK, *THE LAW OF COSTS* 355 (London, 1792) (noting that it was used when “a defendant does not controvert a plaintiff’s right of action altogether, but merely the amount or *quantum* of his demand”). In the event the plaintiff nevertheless proceeded to trial, the court treated the payment of money into court as a defendant’s admission of liability on the pertinent claims. 1 GEORGE CROMPTON, *PRACTICE COMMON-PLACED* 148 (London, 1780) (“Payment of money in court by a defendant, is an acknowledgment that he is liable to the action.”); *accord* *Burrough v. Skinner*, 5 Burr. 2639, 2640 (K.B. 1770); *Cox v. Parry*, 1 T.R. 464, 465–66 (K.B. 1786); *Jenkins v. Tucker*, 1 H. Bl. 90, 93 (C.P. 1788); *Middleton v. Brewer, Peake* 15, 15–16 (K.B. 1790); *Baillie v. Cazelet*, 4 T.R. 579, 579–80 (K.B. 1792); *Gutteridge v. Smith*, 2 H. Bl. 374, 375–77 (C.P. 1794); *Bennett v. Francis*, 2 Bos. & P. 550, 555–57 (C.P. 1801).

331. U.S. CONST. amend. VII.

332. *E.g.*, *Burt v. Abel*, 585 F.2d 613, 616 n.7 (4th Cir. 1978); *Van Wie v. Pataki*, 267 F.3d 109, 115 n.4 (2d Cir. 2001); *see also* *Excelled Sheepskin & Leather Coat Corp. v. Or. Brewing Co.*, No. 12-CV-1416, 2016 WL 8458987, at *6 (S.D.N.Y. Aug. 12, 2016) (trademark case).

333. *Carey v. Piphus*, 435 U.S. 247, 267 (1978). *But see* *D.H. Pace Co. v. Aaron Overhead Door Atlanta LLC*, No. 1:17-CV-3430-MHC, 2021 WL 2819778, at *5 (N.D. Ga. May 24, 2021) (ruling that an award of nominal damages could exceed twenty dollars and need not be one dollar).

334. *Pernell v. Southall Realty*, 416 U.S. 363, 370 (1974).

settle title, like ejectment, where “both parties have a constitutional right to call for a jury.”³³⁵ We do not think it would be difficult to value the object of a patent case that seeks nominal damages and injunctive relief, or even nominals alone, as worth more than twenty dollars.³³⁶

CONCLUSION

When Ambrose Weston wrote the following words in 1785, he had no inkling of the importance that the right to a jury in England would have in the fledgling United States, let alone to an amendment to a constitution that had yet to be drafted. And that perhaps makes his observations an excellent closing conspectus:

[A]ny mode which shall tend to take the Administration of the Law as to Patents, out of the hands of the ordinary Courts of Justice, will be likely to be unpopular and strongly opposed, and that not only from the general and indeed highly proper Attachment we have to our established forms of trial in our Courts of Judicature, more particularly by Jury; [b]ut also because it is enacted by the Statute of [Monopolies under King] James[,] which has always been a very much applauded Act[,] [t]hat all Letters Patent . . . shall be for ever examined heard tried and determined by and according to the Common Laws of this Realm and not otherwise.³³⁷

In light of the mounting dominance of originalism as the principal means of interpreting the Constitution, it is increasingly urgent that we clarify our understanding of English legal history, especially that of the late eighteenth century, and, where necessary, update it. The growing dissatisfaction with the operation of the patent laws, and the special importance of Seventh Amendment rights, led us to examine the circumstances under which litigants who seek equitable relief alone have a right to have patent cases tried with a jury. Courts have been inconsistent on the question, albeit with opinions coalescing on the view that litigants in patent cases *c.*1791 had no right to adjudicate the validity of a patent or infringement at law before a court would or could grant final equitable relief.

335. *Whitehead v. Shattuck*, 138 U.S. 146, 151 (1891); *cf.* *Scott v. Neely*, 140 U.S. 106, 110 (1891) (“All actions which seek to recover specific property, real or personal, with or without damages for its detention, or a money judgment for breach of a simple contract, or as damages for injury to person or property, are legal actions, and can be brought in the Federal courts only on their law side.”).

336. *See also supra* note 32.

337. Ambrose Weston, *Observations on Patents* (1785), Birm. MS 3147/2/26, no. 4 (remarks to a committee concerning potential legislative changes to patent law).

By contrast, our Article demonstrates that parties in equity in England *c.*1791 did have a right to a jury trial under many circumstances. Plaintiffs always held a right because they could elect to bring an action at law to have liability adjudged before bringing their suit in equity against the same defendant. Defendants in equity, in turn, had a right to a jury trial whenever they contested the validity of the patent; equity courts were obligated to refer such cases to law, where validity would be tried, and infringement too if also contested. Under either scenario, because invention patents were legal rights, a right that could only be adjudged at law, the Chancery was not free to ignore a verdict and judgment in an action, adjudicate its own view of the issues already tried at law, and decree final relief accordingly. Separately, and leaning less on eighteenth-century practice, it also appears that some patentees can ensure a jury trial by employing the short cut of simply seeking nominal damages alongside an injunction.

In sum, given the importance of the constitutional right, and the historical records presented here, either the Court or the Federal Circuit should consider revisiting the matter of jury-trial rights in ostensibly “pure” equity cases.