since the causes have been reinstated, delays have *taken place, which are detailed at great length, and are considered as amounting to a contempt of this court, by disregarding its *mandamus*.

We have only to say, that a judge must exercise his discretion in those intermediate proceedings which take place between the institution and trial of a suit; and if in the performance of this duty he acts oppressively, it is not to this court that application is to be made.

A *mandamus*, or a rule to show cause why a *mandamus* should not issue, is asked in the case in which a verdict has been given, for the purpose of ordering the judge to enter up judgment upon the verdict. The affidavit itself shows that judgment is suspended for the purpose of considering a motion which has been made for a new trial. The verdict was given at the last term, and we understand it is not unusual in the state of New York, for a judge to hold a motion for a new trial under advisement till the succeeding term. There is then nothing extraordinary in the fact, that Judge CONKLIN should take time till the next term to decide on the motion for a new trial. This court entertains no doubt of his power to grant it.

We do not think, that an attachment ought to be awarded, nor do we think, that the present state of the case, in which a verdict has been rendered, would justify this court in directing a rule to show cause why a *mandamus* should not be issued. The motion is dismissed.

Motion dismissed.

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*591] *HENRY WHEATON and ROBERT DONALDSON, Appellants, *v.* RICHARD PETERS and JOHN GRIGG.

Copyright.

From the authorities cited in the opinion of the court, and others which might be referred to, the law appears to be well settled in England, that, since the statute of 8 Ann., the literary property of author in his works can only be asserted under the statute; and that notwithstanding the opinion of a majority of the judges in the great case of Millar *v.* Taylor was in favor of the common-law right, before the statute, it is still considered, in England, as a question by no means free from doubt. [1]

That an author, at common law, has a property in his *manuscript*, and may obtain redress against any one who deprives him of it, or, by obtaining a copy, endeavors to realize a profit by its publication, cannot be doubted: but this is a very different right from that which asserts a perpetual and exclusive property in the future publication of the work, after the author shall have published it to the world.

The argument, that a literary man is a much entitled to the product of his labor as any other member of society, cannot be controverted; and the answer is, that he realizes this product in the sale of his works, when first published.

In what respect does the right of an author differ from that of an individual who has invented a most useful and valuable machine? In the production of this, his mind has been as intensely engaged, as long, and perhaps, as usefully to the public, as any distinguished author in the composition of his book; the result of their labors may be equally beneficial to society; and in their respective spheres, they may be alike distinguished for mental vigor. Does the common law give a perpetual right to the author, and withhold it from the inventor? And yet it has

[1] It appears to be settled, at least in this country, that though an author has an exclusive perpetual right in his unpublished manuscript, yet, when once published, his rights in the reproduction of copies, are solely dependent on the statutes. Jefferys *v.* Boosey, 4 H. L. Cas. 815; Bartlett *v.* Crittenden, 5 McLean 32; Clayton *v.* Stone, 2 Paine 395; Stowe *v.* Thomas, 2 Wall. Jr. C. C. 564; Boucicault *v.* Hart, 13 Bl. C. C. 47; Donnelley *v.* Ivers, 20 Id. 383; Dudley *v.* Mayhew, 3 N. Y. 9; Palmer *v.* De Witt, 47 Id. 532.

never been pretended, that the latter could hold, by the common law, any property in his invention, after he shall have sold it publicly. It would seem, therefore, that the existence of a principle which operates so unequally, may well be doubted; this is not a characteristic of the common law; it is said to be founded on principles of justice, and that all its rules must conform to sound reason.

That a man is entitled to the fruits of his own labors, must be admitted; but he can enjoy them only, except by statutory provision, under the rules of property which regulate society, and which define the rights of things in general.

It is clear, there can be no common law of the United States; the federal government is composed of twenty four sovereign and independent states, each of which may have its local usages, customs and common law; there is no principle which pervades the Union, and has the authority of law, that is not embodied in the constitution or laws of the Union; the common law could only be made a part of our system by legislative adoption.

When a common-law right is asserted, we look to the laws of the state in which the controversy originated.

When the ancestors of the citizens of the United States emigrated to this *country, they [*592 brought with them, to a limited extent, the English common law, as part of their heritage. No one will contend, that the common law, as it existed in England, has ever been in force, in all its provisions, in any state in this Union; it was adopted only so far as its principles were suited to the condition of the colonies; and from this circumstance, we see, what is the common law in one state, is not so considered in another. The judicial decisions, the usage and customs of the respective states, must determine how far the common law has been introduced and sanctioned in each.

If the common law, in all its provisions, has not been introduced into Pennsylvania, to what extent has it been adopted? Must not this court have some evidence on the subject? If no copyright of an author, in his work, has been heretofore asserted there, no custom or usage established, no judicial decisions been given; can the conclusion be justified, that, by the common law of Pennsylvania, an author has a perpetual property in the copyright of his works? These considerations might well lead the court to doubt the existence of this law; but there are others of a more conclusive character.

In the eighth section of the first article of the constitution of the United States, it is declared, that congress shall have power "to promote the progress of science and the useful arts, by securing, for a limited time, to authors and inventors, the exclusive right to their respective writings and inventions." The word "secure," as used in the condition, could not mean the protection of an acknowledged legal right; it refers to inventors, as well as authors: and it has never been pretended by any one, either in this country or in England, that an inventor has a perpetual right, at common law, to sell the thing invented.

It is presumed, that the copyright recognised in the act of congress, and which was intended to be protected by its provisions, was the property which an author has, by the common law, in his *manuscript*, which would be protected by a court of chancery; and this protection was given, as well to books published under the provisions of the law, as to manuscript copies.

Congress, by the act of 1790, instead of sanctioning an existing perpetual right in an author in his works, created the right secured for a limited time, by the provisions of that law.

The right of an author to a perpetual copyright, does not exist by the common law of Pennsylvania.

No one can deny, that where the legislature are about to vest an exclusive right in an author or in an inventor, they have the power to provide the conditions on which such right shall be enjoyed; and that no one can avail himself of such right, who does not substantially comply with the requisites of the law. This principle is familiar as it regards patent-rights; and it is the same in relation to the copyright of a book; if any difference should be made, as respects a strict conformity to the law, it would seem to be more reasonable, to make the requirement of the author rather than of the inventor.

The acts required by the laws of the United States, to be done by an author to secure his copyright, are in the order in which they must naturally transpire: first, the title of the book is to be deposited with the clerk, and the record he makes must be inserted in the first or second page; then the public notice in the newspapers is to be given; and within six months after the publication of the book, a copy must be deposited in the department of state.[1]

[1] The deposit in the clerk's office of the title-page of the book, prior to the sale of any copies of the work, is essential to a valid copyright. Baker *v.* Taylor, 2 Bl. C. C. 82.

*It has been said, these are unimportant acts; if they are indeed wholly unimportant, congress acted unwisely in requiring them to be done; but whether they are unimportant or not is not for the court to determine, but the legislature; and in what light they were considered by the legislature, the court can only know by their official acts. Judging of those acts by this rule, the court are not at liberty to say, they are unimportant, and may be dispensed with; they are acts which the law requires to be done; and may this court dispense with their performance?

The security of a copyright to an author, by the acts of congress, is not a technical grant on precedent and subsequent conditions; all the conditions are important; the law requires them to be performed, and, consequently, their performance is essential to a perfect title. On the performance of a part of them, the right vests; and this was essential to its protection under the statute; but other acts are to be done, unless congress have legislated in vain, to render this right perfect. The notice could not be published, until after the entry with the clerk; nor could the book be deposited with the secretary of state, until it was published; but they are acts not less important than those which are required to be done previously; they form a part of the title; and until they are performed, the title is not perfect.

Every requisite under both the acts of congress relative to copyrights, is essential to the title.

The acts of congress authorizing the appointment of a reporter of the decisions of the supreme court of the United States, require the delivery of eighty copies of each volume of the reports to the department of state; the delivery of these copies does not exonerate the reporter from the deposit of a copy in the department of state, required under the copyright act of congress of 1790; the eighty copies delivered under the reporter's act, are delivered for a different purpose, and cannot excuse the deposit of one volume as especially required by the copyright acts.

No reporter of the decisions of the supreme court has, nor can he have, any copyright in the written opinions delivered by the court; and the judges of the court cannot confer on any reporter any such right.[1]

So is the delivery to the clerk, of a copy of the book, within three months after publication. Struve *v.* Schwedler, 4 Id. 23. So is the delivery of two copies of the work to the librarian of congress, under § 4956 of the revised statutes. Parkinson *v.* Laselle, 3 Sawyer 330; Merrell *v.* Tice, 104 U. S. 557. And so is a notice to the public, by printing in the place designated, the fact of the entry, in the form prescribed by the statute. Jollie *v.* Jacques, 1 Bl. C. C. 620. But where the work consists of a number of volumes, it has been held sufficient to insert the record in the page next following the title-page of the first volume. Dwight *v.* Appleton, 1 N. Y. Leg. Obs. 195; So, it has been held, that a mistake in the printed notices of the year of the entry, as 1867 instead of 1866, will not vitiate. Myers *v.* Callaghan, 10 Biss. 139. And that words of description, added to the title filed in the clerk's office, may be changed in the published work, without invalidating the copyright. Daly *v.* Palmer, 6 Bl. C. C. 256. S. P. Donnelley *v.* Ivers, 20 Id. 381. Until all the things required by the statute have been performed, the copyright is not secured; but by taking the incipient step, a right is acquired, which chancery will protect, until the other acts may be done. Pulte *v.* Derby, 5 McLean 332. And see Chase *v.* Sanborn, 4 Cliff. 306; Osgood *v.* Allen, 1 Holmes 192.

[1] It appears to be settled, at this day, that reports of legal decisions are as much the subject of copyright as any other literary work. Hodges *v.* Welsh, 2 Ir. Eq. 266. And that a state reporter is entitled to a copyright in whatever is the work of his own mind and hand. Myers *v.* Callaghan, 10 Biss. 139. This includes the syllabus or marginal notes of the cases and points decided, the abstract of the record and evidence, and the notes of the argument of counsel. Little *v.* Gould, 2 Bl. C. C. 165, 362. And accordingly, it has been held to be a piracy, to reprint *verbatim*, in the form of a digest, the head-notes of a series of reports, without the consent of the reporter, in whom the copyright is vested. Sweet *v.* Benning, 16 C. B. 459. So also, it is unlawful to collect together, and reprint from the reports, all the cases upon a particular subject, though the collection and classification may be new, and with the addition of several previously unpublished decisions, and notes. Hodges *v.* Welsh, 2 Ir. Eq. 266. Where, however, as in New Hampshire, the judges of the superior court are required by law, to prepare the head-notes to their own opinions, the reporter has no copyright in the volumes which he edits. Chase *v.* Sanborn, 4 Cliff. 306. In New York, where the state reporter, for an adequate salary secured by law, is required to report every cause argued and determined in the court of

Wheaton v. Peters.

APPEAL from the Circuit Court for the Eastern District of Pennsylvania. The case, as stated in the opinion of the court, was as follows :

"The complainants, in their bill, state, that Henry Wheaton is the author of twelve books or volumes of the reports of cases argued and adjudged in the supreme court of the United States, and commonly known as 'Wheaton's Reports ;' which contain a connected and complete series of the decisions of said court, from the year 1816 until the year 1827. That before the first volume was published, the said Wheaton sold and transferred his copyright in the said volume to Matthew Carey, of Philadelphia ; who, before the publication, deposited a printed copy of the title page of the volume in the clerk's office of the district court of the eastern district of Pennsylvania where he *resided. That the same was recorded by the said clerk, [*594
according to law, and that a copy of the said record was caused by said Carey to be inserted at full length in the page immediately following the title of said book. And the complainants further state, that they have been informed and believe, that all things which are necessary and requisite to be done in and by the provisions of the acts of congress of the United States, passed the 31st day of May 1790, and the 29th day of April 1802, for the purpose of securing to authors and proprietors the copyrights of books, and for other purposes, in order to entitle the said Carey to the benefit of the said acts, have been done.

"It is further stated, that said Carey afterwards conveyed the copyright in the said volume to Matthew Carey, Henry C. Carey and Isaac Lea, trading under the firm of Matthew Carey & Sons ; and that said firm, in the year 1821, transferred the said copyright to the complainant, Robert Donaldson. That this purchase was made by an arrangement with the said Henry Wheaton, with the expectation of a renewal of the right of the said Henry Wheaton under the provisions of the said acts of congress ; of which renewal he, the said Robert Donaldson, was to have the benefit, until the first and second editions of the said volume which he, the said Donaldson, was to publish, should be sold. That at the time the purchase was made from Carey & Sons, a purchase was also made of the residue of the first edition of the first volume, which they had on hand ; and in the year 1827, he published another edition of said volume, apart of which still remains unsold.

"The bill further states, that for the purpose of continuing to the said Henry Wheaton the exclusive right, under the provisions of the said acts of congress, to the copy of the said volume, for the further term of fourteen years, after the expiration of the term of fourteen years from the recording of the title of the said volume in the clerk's office as aforesaid, the said Robert Donaldson, as the agent of Wheaton, within six months before the expiration of the said first term of fourteen years, deposited a printed copy of the title of the said volume in the clerk's office of the district court of the

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appeals, which that court shall direct him to report, and where it is provided, that no copyright shall be taken out for said reports, but that the notes and references made by the reporter may be copyrighted, it is extremely doubtful, whether this last provision extends to the narrative of the case, which is part of the report proper, and in no sense of the word, a portion of the reporter's notes and references. This point was not noticed by Judge NELSON, in deciding the case of Little *v.* Gould, 2 Bl. C. C. 362. See the remarks of Judge DRUMMOND, in Myers *v.* Callaghan, 10 Biss. 142.

southern district of New York, where the said Wheaton then resided; and caused the said title to be a second time recorded in the said clerk's office; and also caused a copy of the said record to be a second time published *595] *in a newspaper printed in the said city of New York, for the space of four weeks, and delivered a copy of the said book to the secretary of state of the United States; and that all things were done agreeably to the provisions of the said act of congress of May 31st, 1790, and within six months before the expiration of the said term of fourteen years.

"The same allegations are made as to all the other volumes which have been published; that the entry was made in the clerk's office and notice given by publication in a newspaper, before the publication of each volume; and that a copy of each volume was deposited in the department of state.

"The complainants charge, that the defendants have lately published and sold, or caused to be sold, a volume called 'Condensed Reports of Cases in the Supreme Court of the United States,' containing the whole series of the decisions of the court, from its organization to the commencement of Peters's reports, at January term 1827. That this volume contains, without any material abbreviation or alteration, all the reports of cases in the said first volume of Wheaton's reports, and that the publication and sale thereof is a direct violation of the complainants' rights; and an injunction, &c., is prayed.

"The defendants in their answer deny that their publication was an infringement of the complainants' copyright, if any they had; and further deny that they had any such right, they not having complied with all the requisites to the vesting of such right under the acts of congress."

The bill of the complainants was dismissed by the decree of the circuit court; and they appealed to this court.(*a*)

The case was argued by *Paine* and *Webster*, for the appellants; and by *Ingersoll*, by a printed argument, and *Sergeant*, for the defendants.

Paine, for the appellants, contended:—

1. An author was entitled, at common law, to a perpetual property in *596] the copy of his works, and in the profits of their *publication; and to recover damages for its injury, by an action on the case; and to the protection of a court of equity. The laws of all countries recognise an author's property in his productions. In England, beyond all question, an author had, at common law, the sole and exclusive property in his copy. This was decided in *Millar* v. *Taylor*, 4 Burr. 2303. This property was placed by its defenders, and they finally prevailed, upon the foundation of natural right; recognised by the laws, ordinances, usages and judicial decisions of the kingdom, from the first introduction of printing.

The opponents of literary property insisted, that an author had no natural right to his copy; and resorting to those laws which are supposed to have governed property before the social compact, they maintained, that because the copy was incapable of possession, it was impossible to have property in it. Mr. Justice YATES, the great opponent of literary property,

(*a*) The case was decided in the circuit court by Judge HOPKINSON, Mr. Justice BALDWIN having been absent on the argument and decision thereof. The opinion of Judge HOPKINSON is inserted in the Appendix, No. II.

and who has probably said all that ever was or can be said against it, urges that it is impossible to appropriate ideas more than the light or air (4 Burr. 2357, 2365); forgetting that books are not made up of ideas alone, but are, and necessarily must be, clothed in a language, and embodied in a form, which give them an individuality and identity, that make them more distinguishable than any other personal property can be. A watch, a table, a guinea, it might be difficult to identify; but a book never. He cited 2 Bl. Com. and Christian's notes, to show the nature of literary property. The court are referred to the able opinions of WILLES, J., ASTON, J., and Lord MANSFIELD, in *Millar* v. *Taylor*, 4 Burr. 2310, 2335, 2395. They agreed, not only that an author had a property at common law, but that it was perpetual, notwithstanding the statute of Anne.

Not long after that decision, however, the question as to the perpetuity of an author's property, was brought before the House of Lords; and it was there decided, that it was not perpetual, its duration being limited by the statute of Anne. Yet even upon this point, the twelve judges were equally divided (if we include Lord MANSFIELD, who did not vote, as he was a peer), and there were eleven out of twelve who maintained, that an author had a property at common law, in his copy. See *Donaldson* v. *Beckett*, 4 Burr. 2408; 2 Bro. P. C. 129.

*The decrees of the star-chamber show, that that court admitted and protected authors, as early as 1556. Maugham 12, 13. Ordinances of parliament, as early as 1641, recognise and protect the owner's property in his copy. These ordinances were several times repealed. Maugham 13, 14. In 1672 and 1679, acts of parliament were passed, prohibiting any person from printing, without the consent of the owner of the copy. Maugham 15, 18. In the reign of Charles II., there were several cases in the courts, in which the ownership of the copy by authors, is treated as the ancient common law; and in one case, that in Croke's reports, the right of the author was sustained, even against the claim of the king's prerogative to publish all law-books. Chief Justice HALE presided. Maugham 19; 4 Burr. 2316. In the reign of Anne, when the perpetual ownership of literary property was thus firmly established, the booksellers, annoyed by the piracy of unprincipled and irresponsible adventurers, applied to parliament for protection. A bill was accordingly brought in for the purpose, entitled "an act to secure the property of authors." In committee, its title was changed to that of "an act to vest authors with their copies, for the times therein mentioned." Maugham 20–27. And the act declared, that authors should have an exclusive right for twenty-one years, and no longer. In this shape it was passed. Notwithstanding the strong and explicit terms of the statute of Anne, both as to vesting the author with his right, and limiting its duration (terms not to be found in our act), the courts, by an uninterrupted series of decisions, from the passing of the statute down to the case of *Donaldson* v. *Beckett*, maintained, that an author still had his original perpetual common-law right and property; and we have seen, that had Lord MANSFIELD voted in that case, the twelve judges would have been equally divided. For a review of the common-law property of an author, and of the legislation upon the subject in England and the United States, he cited, American Jurist. 10, 61, &c. [*597

2. The common-law property of an author is not taken away by the con-

stitution of the United States. The states have not *surrendered to the Union their whole power over copyrights, but retain a power concurrent with the power of congress; so far, that an author may enjoy his common-law property, and be entitled to common-law remedies, independently of the acts of congress. It is one of those concurrent powers, where the power of the state ceases, only when it actually conflicts with the exercise of the powers of congress.

In the constitutional clause relating to the rights of authors and inventors, there are two subjects, distinct enough in themselves, and only united by the form of expression. This comprehensiveness of expression, we know, belongs to the constitution; and that the aim of its framers was brevity. The expression is not so important, for in that instrument we are to look for substance and intention. Although united in this clause, and for the same purpose of being secured by congress, the subjects of patents and of copyrights have little analogy. They are so widely different, that the one is property, the other a legalized monopoly. The one may be held and enjoyed, without injury to others; the other cannot, without great prejudice. The one is a natural right, the other in some measure against natural right. But because they both come from invention or mental labor, and in addition, because they are so joined in the constitution; we have become accustomed to regard them as in all respects alike, and equally dependent on the legislative favor for existence and protection. Upon this point, the counsel for the appellants argued at large, that the principles which applied to copyrights were different from those which regulated the property of inventions secured by a patent. That they were inserted in the clause of the constitution for brevity and comprehensiveness. That the framers of the constitution probably designed to give congress the complete and exclusive power over patents; but it did not follow from this, that the same was introduced in relation to copyrights.

It is important to examine the true rules of construction which are applicable to this clause in the constitution. This is the first instance in which this court has been called upon to pronounce, whether the power given in this clause is an exclusive or a concurrent power; or as to the extent of the *power conferred by it on congress. Consequently, the rules established as to the construction of that instrument, have all been in relation to other powers, and powers of a very different character. All the other powers in the constitution conferred on congress, or yielded by the states, are national or political, and for national and political purposes. This is the only instance of a power being conferred, unless incidentally, over private property. This is a power over private property, not incidental to a national power, but with an immediate, primary and single reference to the property. The rule of construction as to the grant of the political and national powers may not be suited to this. It has been held, as to them, that a rule of strict construction was not to be adopted.

*599]

But the question here is as to private right. And the question is, whether the constitution takes away a private right, or property at common-law? And why should we not apply the same rule of construction to such a constitutional provision, as we do to a statute, in derogation of common-law right? The rule is, that such statutes are to be construed strictly, because they abridge the right. The reason of the rule extends to the constitution,

whenever it is in derogation of common right. For this rule, see 10 Mod. 282 ; 4 Bac. Abr. 550, 650. Other common-law rules in relation to statutes affecting private rights or common-law rights, would seem to be peculiarly applicable to this clause of the constitution ; although they may not be generally referred to as guides in construing the constitution. These will be found in 1 Bl. Com. 87 ; 1 Inst. 111, 115 ; 1 Bl. Com. 89 ; Plowd. 206 ; 13 Mod. 118 ; Plowd. 113 ; 1 Bac. 11, 18, 38 ; Ibid. 3, 5 ; 2 Burr. 803, 805 ; Com. Dig. Action on Stat. C, G ; 1 Salk. 212 ; 19 Vin. Abr. Stat. E, 6 ; 1 Story's Com. 436, 384, 387, 397, 411, 401 ; *Martin* v. *Hunter*, 1 Wheat. 326, 410.

With these general guides of construction, it is inquired, whether the power granted to congress by the constitution transfers the whole subject of property of authors to the exclusive authority and control of congress? so that the property of an author ceases to exist at all, without the legislation of congress ; or whether it leaves the author in the enjoyment of his *pro- [*600
perty, as he had it before the adoption of the constitution ; and merely attempts to improve what was supposed to be an imperfect enjoyment, by authorizing congress to secure it? This is not the question whether the power is concurrent or exclusive. If the author's common-law property is not taken away, nor made wholly dependent upon the legislation of congress ; but if congress possess the mere partial power to secure it, then the property remains as at common law, subject to state legislation, and the auxiliary legislation of congress. The question now is simply as to a right of property. If we take the rules above cited from Mr. Justice STORY'S Commentaries, as guides of interpretation ; can there be a question as to the nature of the delegation of power, or its extent or amount? The delegation is to secure exclusive rights—not to grant property or confirm property, or grant rights or confirm or establish rights, but to secure rights.

We are willing to admit, that this language is broad enough, and is adapted, to transfer to congress the whole legislation and control over patents. There is, at common law, no property in them ; there is not even a legal right entitled to protection. They have a moral or equitable right, but unknown to the law. Congress, therefore, when authorized to secure their rights, are authorized to do everything ; and full power over the subject is delegated to them. But it does not follow, that because congress are authorized to create *de novo*, and to secure the right to patents, by mere force of the word *secure*, that they are, therefore, authorized, by force of that word, to create *de novo*, and then secure copyrights. For a very different process would then take place in relation to the two things. In creating patents, they take nothing away ; they deprive the inventor of no property ; he had nothing, and they gave him all, merely by securing. But if by the word *secure*, they are authorized to give an author all that he is afterwards to possess, the operation affects a total deprivation of his common-law property. So that to allow the word "secure," to confer the same power over copyrights, as over rights to inventions, is to make it a word of a totally different meaning and import in the one case, from the other. The language is not broad enough, nor is it adapted to the taking *away [*601
of property or pre-existing rights. We are, therefore, to reject the argument, that a copyright must exist and be held solely under the constitution ; because patent-rights must be.

What is there, then, in the delegation of the power to *secure* an author's

exclusive rights, which should be construed to deprive him of his property, and make him dependent wholly on the security provided? Are not the words, in themselves, plain and clear? and is not the sense arising from them distinct and perfect? and if so, is interpretation admissible? and if not, is not the question settled? For it never can be pretended, that the naked words, authorizing congress to secure rights, take away or affect the property in which those rights exist. There would seem to be nothing, therefore, in the plain meaning of the word *secure*, which should alter, affect or take away an author's property in his writings. Indeed, it seems too plain, to admit of argument, that when the constitution authorizes congress to secure an acknowledged pre-existing right, and does not authorize them to grant it; it is an express declaration, that it subsists, and is to subsist, independently of their power.

3. But it may be said, that all the author can ask or have, is security for his rights, and that this is all he had at common law; and that the constitutional clause does not take away his security, nor any part of it, but only transfers to congress the power and duty to secure him, which before belonged to the states. We answer, that if this construction is derived from the import of the words themselves, it is strained beyond all bounds allowed by the rules of construction. There is the strongest reason to believe, from the language of the constitution, that those who framed it, adopted it with a particular view to preserve the common-law right to copyrights untouched. If this clause in the constitution is to be construed as taking away the author's common-law right, it deprives him of a part of the security he had at common law; and does more than merely transfer to congress a power and duty which before belonged to the states. It is, then, asked, whether the word *secure* can be found to possess any such meaning as to take away, and diminish and disturb, either by the common-law or constitutional rules of construction.

*602] *The meaning of the clause of the constitution, when tried by the usual rules of interpretation, is shown to be as contended by the appellants. 19 Viner's Abr. 510, E, 6; 2 Inst. 2; Plowd. 113; 1 Chit. Pl. 144; *Almy* v. *Harris*, 5 Johns. 175; *Farmers' Turnpike Road* v. *Coventry*, 10 Ibid. 389. Chief Justice MARSHALL (12 Wheat. 653–4) lays great stress on the framers of the constitution having been acquainted with the principles of the common law, and acting in reference to them. Most of them were able lawyers; and certainly, able lawyers drew up and revised the instrument. Are we, then, to believe, that if they had any design to take away the common-law right, or to authorize congress to take it away, or to impair it, they would, knowing the rules of construction cited, and like common-law maxims, have used the language they have? There is the strongest reason to believe, from the language, it was adopted for the purpose of preserving it, and to reserve from congress any power over it. This probability arises, almost irresistibly, from the language used; and under the circumstances that it was used.

The case of *Donaldson* v. *Beckett* was decided in the house of lords, in 1774. This case, and all the law on this subject, discussed and decided by it, must have been known to the lawyers of the convention. The opinion of the judges in the case of *Millar* v. *Taylor*, must also have been familiar to them. From the statute of Anne, then, down to 1774, there had been in

England a continual contest about the words of that statute, and whether it was a statute to secure a right already existing. It agitated the literary world especially, because it belonged to them ; and it agitated the courts. Cases of unequalled importance arose out of, and were decided upon the use of these words. YATES, J., calls the case of *Millar* v. *Taylor*, a case of "great expectation." This case occurred in 1769, and immediately followed the still greater case of *Donaldson* v. *Beckett*, in which the twelve judges gave each an opinion in the house of lords. These cases, therefore, occurred and were reported a few years before the adoption of the constitution. Had the convention designed to take away, or to authorize congress to take away, the common-law property, they would *have used the words *vest*, or *grant ;* and would have carefully avoided the word *secure*. [*603

But what reason can be discovered why the framers of the constitution should wish, or intend, to take away, or authorize congress to take away. the common-law right. What was the mischief they had in view ? Will it be said, that the public have rights as well as they author ; and that it is impolitic to allow a perpetual right ? Suppose, we grant it. Yet, what has the constitution to do with a mischief like this ? It does not require a national power to cure it. The states were fully adequate to provide a remedy themselves. And the states gave congress no powers, which they could as well exercise themselves. Will it be pretended, that the states could not regulate, limit or take away the right, within their own territories ; and that it was necessary to empower congress to do it ? Will it be said, that it was designed to take from the states their power over copyright, lest, if a state were to protect the rights of authors, the citizens of other states might be curtailed of their rights within that state ? The answer is obvious. No person can have any rights opposed to the author's. He has the property, and it cannot stand in the way of another's property or rights. Besides, the objection goes to the whole of state legislation on any subject : for a state may, by it laws, curtail or affect the rights of citizens of other states, in other particulars, and why be so careful to prevent them in this ? As we have already shown, copyrights have, in these respects, none of the mischiefs attending them, which attend a right to inventions. There could be but one possible motive for making copyrights a national concern ; and that was, because the states might not, or could not, individually, afford them a just protection. From this single motive, what intention are we to infer ? That, and that only, apparent on the face of the constitution—an intention to secure the right. Why is it, however, that if the public good was had in view, by the framers of the constitution, and not the author's benefit singly, either as regards patents or copyrights, that they did not undertake to guard the citizens of the several states against the protection which the states might afford to inventions *introduced from abroad. For that, as well as [*604 for the printing of foreign books, a state might, if it chose, grant monopolies. But this, and other mischiefs to spring from state legislation, it was thought proper to provide against.

It is contended, that the case of copyrights is one within the concurrent powers of the United States, and the states. It is not within either of those kinds of exclusive powers enumerated in the Federalist (No. 34), but belongs to the other class of powers. What is the power here ? A power to *secure* the right of authors. And the question is, whether the states may not pro-

tect and enforce the common-law right, while the United States secure it. Is such a power totally and absolutely contradictory and repugnant? Is it not, on the contrary, perfectly consistent with the other? It is as consistent as a common-law remedy is with a statute remedy; it is the same thing. Both may exist and act in concert, and no conflict can occur, unless the state undertakes to deprive an author of what congress has secured to him. If that were a reason for taking away the state power, it would be a reason for depriving them of all power; for so long as they have power to legislate, they can pass laws to interrupt those of congress. It is impossible to imagine a case, where a power of congress could receive so little interruption from the legislation of the states; because this is a power primarily over private right, and not for national purposes; and it is the only one of the kind in the constitution. The opinions of this court have been uniform, that a concurrent power, in cases like this, might exist and be exercised by the states. See *Houston* v. *Moore*, 5 Wheat. 48–56; also Mr. Justice STORY's Commentaries, 421–433. It is believed, that if the states have resigned to congress their power, over copyrights, and have none remaining in themselves, yet that they have given the power to congress, with a qualification and limitation, and have confined it in their hands, as they had power to do, simply to securing the right of the author. If they have any power besides this, it is merely to abridge the period.

Next, have congress impaired the author's rights? That is, supposing the common-law remedies to be gone, and that *the author can have no remedy, unless he has published the record, and deposited the copy in the secretary of state's office. It is answered, that they have, most essentially. They have entirely changed, and unnecessarily, the whole title which an author had at common law, and the evidence on which it rested. They have taken from him the natural common-law title, and the evidence to support it; and have given him one of a most artificial and difficult character. And is not a man's title to property, his evidence of ownership, a part of the propetry itself—a part of its value? Is it not this which distinguishes real from personal estate, in some measure; and gives it a higher character? Suppose, a man were to lose his title deeds, or one of them, what would be the value of his property? What title had a man before the statute, and what has he now? Before the statute, it was sufficient for him to prove himself the author. This he could do by proof, *in pais*, in a thousand ways. The proof of this is easy and imperishable, because it is the natural proof. The name of the author on the book, possession and claim of title alone, or first publication, would be *primâ facie* sufficient evidence. And these are inherent, and inseparable from almost every case, as a part of its natural incidents. But suppose, he must, as is contended, prove a compliance with the requisites of the statutes. He is driven from all his safe and easy common-law proof. There can be no such thing as *primâ facie* evidence offered. Must he prove the publication for four successive weeks, forty-two years after it was made? Is he to keep a file of newspapers, and if he does, what proof has he of publication? How is he to prove the delivery of the volume? The law provides for no record. He must call a witness, and then he cannot be safe for forty-two years, unless he files a bill to perpetuate testimony. The evidence in the case establishes the difficulty of such proof. Can a statute, which thus loads a right with

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burdensome and needless regulations, and makes it wholly dependent on accidental mistake or omission, where it was free from them both, be said not to impair an author's common-law right of property? If, then, congress have not the power to impair the author's property, and if the requisites as to publication and delivery of *the copy, if made conditions precedent, do impair it; they are so far unconstitutional; and the appellants have a right to claim the benefit of the act without performing them. [*606

4. A citizen of one state has the same common-law property in his copy, in other states, as the citizens of these states can have; and the common-law property exists in the state of Pennsylvania; consequently, the complainants are entitled to a copyright at common law, in that state, and can have a remedy in the circuit court of the United States, for its violation, independently of the provisions of the act of congress; the citizenship of the parties given the state jurisdiction. The constitution of the United States provides, that "the citizens of each state shall be entitled to all privileges and immunities of citizens of the several states." The constitution, by this provision, designed to make, and does in fact make us one nation, living under the same laws. It designed to give to all the citizens of the United States, not merely the benefits and privileges secured to them by national laws, but the benefits of all the laws of all the states and the privileges conferred by them. Under this provision, a citizen of New York has all the privileges of the laws of Pennsylvania, whatever they may be. It is this provision which makes us one nation, and this only. It is this alone which gives to all the citizens of the United States, uniform and equal civil rights throughout all the territories of the nation. Other constitutional provisions secure political advantages; but without this, we should be a mere league, and not a nation. We should be several distinct nations. Vattel says (p. 159, lib. 1, ch. 19), "the whole a country possessed by a nation, and subject to its laws, forms, as we have said, its territories, and it is a common country of all the individuals of the nation." In this sense of a nation, this provision of the constitution makes us one; and makes all the states the common country of all the individuals of the nation.

An author, then, who is a citizen of one of the states, is entitled to have his property in his copy protected in every other state, according to the laws of such state; without the aid of any national law. The question is, do the laws of the state give an author a property in his copy; for if they do, who *shall say, he is not entitled to enjoy his property under such laws, as much as any other kind of property? Has not a citizen of New York a right to hold lands, or any other kind of property, under the laws of Pennsylvania? And if that state were to attempt to deprive him of the same rights as her own citizens enjoy, would it not be a violation of this clause of the constitution? The truth is, a citizen of New York is, so far as all his civil rights and privileges are concerned, a citizen of Pennsylvania. See Mr. Justice STORY's Commentaries, 674–5. [*607

An author's copyright at common law exists in Pennsylvania. The American colonists brought hither, as their birthright and inheritance, the common law, so far as it was applicable to their situation. Judge CHASE, in *United States* v. *Worrall*, 2 Dall. 384. Chief Justice MCKEAN, in 1 Dall. 67, says, the common law has always been in force in Pennsylvania. Statutes made before the settlement of the province have no force, unless

convenient, and adapted to the circumstances of the country; all made since, have no force, unless the colonies are named. See also page 74. There never was a statute in Pennsylvania relative to copyright; and the statute of Anne was passed after the settlement of that state: the common law, therefore, prevails there.

5. The publication of the record in the newspapers, and the delivery of the copy to the secretary of state, are not made conditions precedent at all, by the acts of congress, or if at all, only as to the right to the security provided by the acts. A non-observance of the statutory directions in these particulars, does not deprive the author of the ordinary remedies by an action on the case and bill in equity. Besides, the publication of the record, and delivery of the copy, were, at most, intended only as a means of notice of the author's right; and actual notice in this case, abundantly shown, dispenses with those modes of constructive notice.

After stating the particular provisions of the act of 1790, the counsel proceeded to argue, that, on the proper construction of the act, the publication of the record, or the delivery of the copy, is not in any way connected with the right; and the delivery of the copy has nothing to do, even with the penalties *and forfeitures imposed by it. The provisions of the act are, in some respects, similar to those of the statute of Anne; and it must have been drawn with reference to it. Congress, by this law, did not think proper to impose all the penalties which are found in the act of Anne; because they were engaged in discharging their constitutional power of *securing* the author's right. The copy to the secretary of state is a mere donation from the author. Congress give him no equivalent for it. The clerk is paid for the record; and what do government give the author for the copy, but security? Have they a right to sell the security; to put a price on the exercise of their constitutional powers? What right does the constitution give them to require a donation from the author? And will it be believed, that they intended to forfeit his property, if he did not furnish it? The month which may elapse after the right attaches, and before publication, and the six months before depositing the copy, show, that these things are not conditions precedent.

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Natural rights are generally known by their own incidents. Property always carries with it its own *indicia* of ownership; and literary property not less than any other. The super-addition of record evidence, the highest known to law, and all that is required of ownership of real estate, was probably deemed sufficient by congress; and they, therefore, required no other of the right of an author. It would be a fair presumption, that when they had required enough, they would not go on to require a superfluity. But the publication of the record and delivery of the copy have been held, by a very numerous, learned and able court, on full argument (the court of errors in Connecticut, composed of the twelve judges), to be only directory; and to have nothing to do with the author's right. *Nicholas* v. *Ruggles*, 3 Day 145.

But it is said, that although the publication and delivery of the copy, are not conditions precedent, by the act of 1790, they are made so by the act of 1802; and that this has been decided in the case of *Ewer* v. *Coxe*, 4 W. C. C. 487, as to the publication of the record. The counsel then proceeded to comment on the decision of Mr. Justice WASHINGTON, in the

case referred to; denying that *the language said by him to be contained in the first section of the act of 1802, was contained in it; and asserting that the meaning of the words used in the section, had been strained by the judge. He contended, that the act of 1802, was not intended to operate on the provisions of the preceding law, but only to refer to them as established by that law. There is no enacting language in the latter law; and without enacting language, it can be no enactment. It is the duty of this court, before it allows property to be sacrificed, even if the words of an act are clear and free from doubt, on their face, to look carefully at the intention of the legislature, to look at the spirit of the law and its consequences, and at the old law, the mischief and the remedy. The counsel then went into an examination of both the statutes, for the purpose of showing, that, applying these principles, the construction of those acts should be such as was maintained by the appellants. In the course of this examination, he cited, 19 Vin. Abr. 510, E, 6; Plowd. 111; 2 Inst. 200; 1 Bl. Com. 87; *University* v. *Beyer*, 16 East 316; *Postmaster-General* v. *Early*, 12 Wheat. 148.

The act of 1802 does not make the publication and delivery conditions precedent, because it is impossible they should be so. The first act vests the right, on recording the title. It then gives two months to publish the record, and six months to deliver the copy. A condition precedent is an act to be done precedently; and it is impossible to publish the record, until the record is first made, and the right attaches on making the record. The act of 1802 declares, that the author, "before he shall be entitled to the benefit of the act" of 1790, shall, "in addition to the requisites," &c. Now what was the benefit of that act? It is entitled, an act to secure the author's right; and the power of congress is to secure the right, *i. e.*, an existing right. How does the act secure the right? Only by penalties and forfeitures. It gives no action on the case, no bill in equity; and if it had given them, it would have been, as to them, wholly inoperative, for no court had jurisdiction of them. What, then, was meant by, what, in fact, was, the "benefit of that act?" Certainly, the penalties and forfeitures—nothing else. We *claim the benefit of the act of 1819, which expressly gives a bill in equity, and the circuit court jurisdiction. [*610

It is in vain to say, that the acts in question are conditions precedent to the right. The right itself is recognised by the constitution and law, as an existing right; and the right is not given by the act, but is only secured by it. The security, as we have shown, is the penalties and forfeitures, which we do not now claim. The action on the case is a remedy founded on the right, and not on the statute, which gives none. And this bill is founded on the right, and on the act of 1819. We, therefore, get neither the right, nor remedy from the act of 1790; and what benefit do we claim from it? In support of the construction thus contended for, were cited, Rules of Construction found in 6 Bac. Abr. 379, Statute, I, pl. 1; 383, pl. 4, 5; 387, pl. 6; 391, pl. 10; 19 Vin. Abr. 519, Statute, E, 6, pl. 86; 520, pl. 96; 525, pl. 129; 524, pl. 119; 528, pl. 156; 5 Vin. Abr. Condition, 2, a. pl. 2, 3, 4, 5; 528, pl. 154, 158.

It is agreed, that the object of the requisites in the act is to give notice, and statutes, however strong their language or positive their enactments, which require things to be done for notice, are held not to apply; and that

their provisions need not be complied with, where actual notice is proved. Such are the registry acts, and other similar acts, which declare that instruments shall be absolutely void, if not recorded. *Le Nevé* v. *Le Nevé*, 2 Atk. 650; *Jackson* v. *Burgott*, 10 Johns. 460; *Jackson* v. *West*, Ibid. 466. It is fully shown by the evidence, that the defendant had notice; and a part of that evidence shows, that the claim of the appellant, Mr. Wheaton, was admitted. The rule is, that the provisions of the registry acts do not apply, except in cases of *bonâ fide* purchasers. What is a *bonâ fide* purchaser? A purchaser without notice; no matter what his property, or his attempt to get it, has cost him. Is Mr. Peters a *bonâ fide* purchaser?

It is objected, that the record of some volumes is taken out as author and proprietor. In answer, we say, it is the clerk's duty to make out the record; and we cannot be held to forfeit our property, because he has not done it correctly. *But the record is right. As author, and not having parted with the right, Mr. Wheaton was also proprietor. The act is adapted to a proprietor as well as author, and to enable a proprietor, who is not the author, to secure a copyright. In our case, Mr. Wheaton is described as author, and the super-addition of proprietor is mere surplusage.

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6. The directions of the acts of congress as to the application of the record and delivery of the copy to the secretary of state; and the renewal of the right of the first volume have been complied with; and the complainants have offered all the proof they are bound to offer of those facts. In support of these positions, the counsel referred to the evidence in the record. As to the delivery of copies to the secretary of state, he stated, that the law is silent as to any proof. It directs no memorandum of the deposit to be made. The presumption, therefore, is, that none is made. And, in fact, they did not begin to make any, until about the close of these volumes. It appears, that certificates were given, sometimes, latterly. But the law does not direct them, does not know them; and why should one take them? Would they be evidence of anything, if he had them? And Mr. Brent proves the greatest irregularity as regards certificates and memoranda. Mr. Carey proves the same thing.

But the law does say, that the secretary of state shall preserve the copies is his office. This, then, is the evidence required by law, that the volumes have always been in his office, since within six months of their publication. And this is proved by Mr. Brent's deposition. The volumes are and have been there. It is for them to show, that they were not placed there by us, under the law. How can we prove, by parol, facts which occurred from sixteen to seventeen years before the proof taken in this cause? The proof must be by parol; and such proof the law presumes to be out of men's power, after the lapse of six years. Without the copies having actually been found there, the law would presume that an act enjoined by law to be performed, was performed, after such a lapse of time. It would presume it, in favor of right and natural justice, against a wrongdoer. See *a case of presumption, even of the enrolment of articles of apprenticeship, against positive evidence to the contrary. *The King* v. *Inhabitants of Long Buckley*, 7 East 45.

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But we have proved, positively, by the evidence of Mr. Brent, that eighty copies of every volume were delivered, under the reporter's salary act, within the six months after application. The four acts of congress

allowing the reporter his salary, also provide, that he shall, within six months, deliver eighty copies to the secretary of state; one of which he is to keep and transmit to his successor in office, of course, to be preserved in the office. The fact is, that eighty-one copies were sent, but the law giving the salary, not requiring more than eighty, the papers in the department under these acts speak of but eighty; and all being sent to the department together, is the reason why there was no minute, or memorandum, or certificate, as in some cases under the copyright law. And is not this within the letter of the copyright law—the delivery of the eighty copies alone? And if we have complied with the letter of the law, ought it not to save us from a forfeiture of our property? Is it not within the spirit of the law? The judge in the court below insists it is for notice; the counsel insist it is for notice. And is it not as good notice, if it is there under one law, as under the other? But the judge who decided the case below says, that it is not required, under the salary law, to be kept in the office. It is submitted, that it is as much required to be kept there, under one law as another. At all events, the condition, if it be a condition precedent, is substantially performed by it; and this, as has been shown, is sufficient.

The copyright for the first volume of Wheaton's reports was renewed in New York, the place of residence of the author. This was done, before the publication of any volume of the Condensed reports, containing any of the matter in Wheaton's reports. Mr. Wheaton had not parted with his property in them; and by the third section of the act of 1790, it is required, that the title shall be deposited, and the record made in "the clerk's office of the district court where the author shall reside."

Law reports, like other books, are objects of literary property; *and Mr. Wheaton was the author of the reports in question in this case, and entitled to the copyright in them. The other complainant, Mr. Donaldson, has a limited property in the copy, by assignment from Mr. Wheaton. It was never doubted in England, that law reports were the subject of copyright. The only question was, whether the prerogative of the crown did not monopolize all law-books, so as to exclude an author's right. *Roper* v. *Streater*, Skin. 234; 4 Burr. 2316, 2403; *Tonson* v. *Walker*, 3 Swanst. 673; 3 Ves. 709; 2 Bro. P. C. 100. The prerogative right, however, is now abandoned, and has long been in England. Maugham, 101, says, "it is now treated as perfectly ridiculous." Godson says the same thing (Patents 322, 323). See 4 Burr. 2415, 2416, as to the reason of the prerogative. It there appears, the king introduced printing into England. [*613

It is not necessary, however, to produce cases, to prove a right so obvious, until cases are produced or principles established which show that it does not exist. There are necessarily but few cases, because the right has not been questioned. One fact is enough, without cases. We know the great price of law reports in England, and we know, of course, that but one person does publish, viz., the proprietor; that there are never contemporaneous editions of the same reports; that a single whole edition is exhausted before another is published, and sometimes lasts half a century. Why is this? Who prevents enterprise and cupidity from participating in this field? What can it be, except the copyright?

As to the objection that the matter of which the report is composed is not original; we answer, this is wholly unnecessary in copyright. There is

no analogy in that respect between copyrights and patents. A man who makes an Encyclopœdia may have a copyright, although he does not write a word of it. And in *Carey* v. *Kearsley*, 4 Esp. 168, where it was attempted to show that the survey in which the copyright was claimed, was made at the expense of the post-office, and that the copyright belonged to the post-office, Lord Ellenborough said, "I do not know that that will protect the defendant. At law, the first publisher, even though he has abused his trust *614] by *procuring the copy, has a right to it; and to an action against the person who publishes it without authority from him."

The salary of the reporter was never designed to be a compensation in full, and to deprive him of his copyright. Had such an effect been intended, or thought of, it would have been expressed. It stipulates an equivalent for the sum allowed him, or a greater part of it, viz., eighty copies. When congress, by the last reporter's act, reduced the price of the volume to five dollars, the copyright was considered. Mr. Wheaton published his first volume, without a salary. He had been appointed reporter by the court, and was looking to the profits of the copy as his only compensation. But it was found unequal to the labor and time, and in truth no compensation. In this state of things, to enable him to go on, congress give him $1000 (for which he gives them back eighty copies); and say nothing of its being an equivalent for his copyright. The copyright was established in England, and in this country, before the law was passed. And is established property to be taken away by implication? Does any one believe, that Mr. Wheaton would have spent half a year or more in making and publishing these reports, if he had supposed he had not the copyright? After deducting the eighty copies, the $1000 would not leave enough to pay the expenses of a gentleman in Washington during the term, and going and coming. Besides, he took steps to secure his copyright every year. It was considered a copyright book; congress saw this and knew it. Their laws with him were contracts, made under a full knowledge of existing facts. And shall it be said, when they made no exception of the copyright, and knew that he relied on it, that they intended to deprive him of it? It would have been a fraud unworthy of congress; as it would have been disgraceful to an individual. Other reporters in this country, in the state courts, who had salaries, had always secured their copyright (even Mr. Peters has secured his), and the right to do so was never doubted. Mr. Wheaton published the first volume without salary; consequently, this objection cannot apply to that.

As to the cases and abstracts, they are clearly Mr. Wheaton's own composition. He acquired the right to the opinions, by judge's gift. They *615] invited him to attend at his own expense, *and report the cases; and there was at least a tacit engagement on their part, to furnish him with such notes or written opinions as they might draw up. This needs no proof; it is the course of things, and is always done. The mere appointment proves all this. Was this engagement, this understanding, ever altered? Do not the judges of this court know that Mr. Wheaton believed he was acquiring a property in his reports? Did they not suppose, he would be entitled to it, if he took the necessary steps to secure it?

Were not the opinions of the judges their own to give away? Are opinions matter of record, as is pretended? Was such a thing ever heard of?

They cannot be matters of record, in the usual sense of the term; record is a word of determinate signification; and there is no law or custom to put opinions upon record, in the proper sense of that term. Nor were they ever put on record in this case; they were given to Mr. Wheaton, in the first instance. 1 Bl. Com. 71–2, shows that the reasons of the court are not matter of record. The copy in the opinions, as they were new, original and unpublished, must have belonged to some one. If to the judges, they gave it to Mr. Wheaton. That it did belong to them is evident; because they are bound by no law or custom to write out such elaborate opinions; they would have discharged their duty by delivering oral opinions. What right, then, can be public claim to the manuscript? The reporter's duty is to write or take down the opinions. If the court choose to aid him by giving him theirs, can any one complain? But we allege and prove that Mr. Wheaton was the author of the reports; that he published them. This is enough to entitle him to a copyright, until they prove that he is not; the burden of proof is on them. (See *Carey* v. *Kearsley*, 4 Esp. 168, already cited.)

It is contended, that it is against public policy, to allow reports to be copyrighted. And extravagant suppositions are made, as, that an author might destroy them, or never publish them, or put an unreasonable price on them. Is one to be divested of property, is a common rule of law to be overthrown, because the imagination of man can devise a danger which may arise, however improbable? And besides, in this case, the reporter would lose his salary; and in all cases, *he must lose his place, if he were guilty of any of such absurdities. As to enhancing the price, which [*616 is one of the evils apprehended, if the author were to do it unreasonably, he would lose his place; and he must always do it to his own injury, for he would lose his sales and profit. In England, the statute of 54 Geo. III., amending the statute of Anne, omits the provision in the statute of Anne intended to prevent too high a price. This shows that experience had proved that no such evil was to be apprehended. In Germany, where a free, perpetual copyright exists, books are cheaper than anywhere else in the world. (Maugham 14, 15.) Congress had power to apply the remedy, and they did apply it, when they thought proper, by fixing the price.

It is attempted to put judicial decisions on the same ground as statutes. It is the duty of legislators to promulgate their laws. It would be absurd, for a legislature to claim the copyright; and no one else can do it, for they are the authors, and cause them to be published without copyright. Statutes never were copyrighted; reports always have been. It is said, that one employed by congress to revise and publish the statutes, might as well claim a copyright as a reporter. The difference is, one is employed to act as a mere agent or servant, or clerk of the legislature, to prepare the laws to be properly promulgated. He is engaged to do what it is well understood never is copyrighted, and does not admit of copyright; there is a distinct understanding, a contract, that he is to do the work for his compensation, and not to claim a copyright. But a reporter is not an agent employed by congress; he is, and is understood to be, engaged for himself, as principal; and congress buy eighty copies, and add a salary to his profit from his copy. He was doing, before the act, what it was understood he could copyright, and what he did copyright; and the act does not intimate that there was to be any change; and he went on copyrighting, and they renewed his

salary, without any objection or stipulation. It is the bounden duty of government to promulgate its statutes in print, and they always do it. It is not considered a duty of government to report the decisions of court, and they, therefore, do not do it. The oral pronunciation of the judgments *617] *of courts is considered sufficient. Congress never employed a reporter, and they never gave any one any compensation, before Mr. Wheaton. Mr. Cranch reported without compensation, and relied upon his copyright; and Mr. Wheaton continued, with a full understanding that he was to report in the same way. Are the court prepared to deprive all the authors of reports in this country of their copyrights? Of property which they have labored to acquire, with the full belief, of all others as well as of themselves, that they were to be legally entitled to it?

8. The publication of the defendants is a violation of the complainants' rights. The *quo animo* of the publication is important. An abridgment was not contemplated; and the work was intended to be supplied at less cost. This is stated in the proposals annexed to the bill. The answer admits the decisions contained in the third Condensed reports to have been previously published in Wheaton's reports, and that it is intended to continue the publication of the same. It is denied in these papers, that Mr Wheaton could have a copyright; and if he could, that he has taken the necessary steps to secure it. The actual violation of the complainants' rights consists in having: first, printed the abstracts made by Mr. Wheaton; secondly, in taking the statements of the cases made by Mr. Wheaton, *verbatim*, from Wheaton's reports; thirdly, in having taken points and authorities, and, in some instances, the arguments, and in all cases oral opinions from Wheaton's reports, and for which, of course, no materials could be found elsewhere; fourthly, in having printed the whole of the opinions, which, it is not pretended, were found elsewhere. No resort was had to the records, for the statements of the cases. The Condensed reports are not a fair abridgment. *Butterworth* v. *Robinson*, 5 Ves. 709; 1 American Jurist 157; Maugham 129–36.

The appellees submitted the following points for the consideration of the court. 1. That the books styled "Wheaton's Reports," is not lawfully *618] the subject of exclusive literary property. *2. If the book of the reports of the complainants be susceptible of exclusive ownership, such ownership can be secured only by pursuing the provisions of certain acts of congress. 3. The provisions of the acts of congress have not been observed and complied with, by the complainants, or others, in their behalf. 4. Reports of the decisions of the supreme court, published by a reporter appointed under the authority of the acts of congress, are not within the provisions of the laws for the protection of copyrights. (*a*) 5. The entries of the copyrights by the appellant, claim more than Mr. Wheaton was, in

(*a*) As the court gave no opinion upon this point, and, as the reporter has been informed, did not consider it, when the case was disposed of, a great portion of the arguments upon it by the counsel for the appellees, has been omitted in this report. Should the case be brought again before the court, as it will be, in the event of the issue directed by the court being found for the appellants, this point will be urged to a decision.

fact or in law, entitled to, as "author," "proprietor," "author and proprietor," and were for his cause void. 6. The work styled Condensed reports, is not an illegal interference with the right, whatever it may be, in Wheaton's reports.

J. R. Ingersoll, for the defendants.—The defendants submit the following argument in answer to the complaint exhibited by the bill and testimony of the appellants. They propose to show: 1. That the book styled "Wheaton's Reports," is not lawfully the subject of exclusive literary property. 2. If the book of reports of the complainants be susceptible of exclusive ownership, such ownership can be secured only by pursuing the provisions of certain acts of congress. 3. The provisions of the acts of congress have not been observed and complied with, by the complainants or others in their behalf.

1. The character of the work in which the right to literary property is asserted by the complainants, is sufficiently described in their own bill. It consists, they say, of twelve *books of reports of the decisions of the supreme court of the United States. It was prepared in the due [*619 exercise of the appointment of Mr. Wheaton as reporter, which he derived from the court. The writings or *memoranda* of the decisions were furnished by the judges to Mr. Wheaton, who alone preserved the notes and opinions thus furnished to him, together with other materials compiled by himself; and having retained all these materials in his possession exclusively, he finally destroyed them. The work, agreeable to the description of it in the bill, is composed of "cases, arguments and decisions." However rich it may be in other materials, they are not made the subject of claim; nor is any interference with them alleged, or made in any degree the subject of complaint. The claim and complaint are confined to the *reports* properly so called. If the profession and the country are indebted to the individual exertions of the reporter for valuable notes, which may have been usefully inserted to increase his emoluments, or enlarge his literary reputation, they are not at all connected with the work as described and exclusively claimed in the proceedings before the court.

Reports are the means by which judicial determinations are disseminated, or rather they constitute the very dissemination itself. This is implied by their name; and it would necessarily be their nature and essence, by whatever name they might be called. The matter which they disseminate is, without a figure, the *law of the land.* Not, indeed, the actual production of the legislature; those are the rules which govern the action of the citizen. Bnt they are constantly in want of interpretation, and that is afforded by the judge. He is the "*lex loquens;*" his explanations of what is written are often more important than the mere naked written law itself; his expressions of the *customary law*, of that which finds no place upon the statute book, and is correctly known only through the medium of reports, are indispensable to the proper regulation of conduct in many of the most important transactions of civilized life. Accordingly, in all countries that are subject to the sovereignty of the laws, it is held, that their promulgation is as essential as their existence. Both descriptions of laws are within the principle; the source from which they spring makes no difference; whether legislative acts, or judicial constructions, or decrees, *knowl- [*620

edge of them is essential to the safety of all. A pregnant source of jurisdiction to the enlightened tribunal to which this case is now submitted, is altogether foreign to the enactments of the legislature. The extended principles of national law, and the rules which govern the maritime intercourse of individuals, are fairly and authoritatively known only as they are promulgated from this bench. It is, therefore, the true policy, influenced by the essential spirit of the government, that laws of every description should be universally diffused. To fetter or restrain their dissemination, must be to counteract this policy; to limit, or even to regulate it, would, in fact, produce the same effect. Nothing can be done, consistently with our free institutions, except to encourage and promote it. Everything which the legislature or the court has done upon the subject, is purely of that character and tendency.

The defendants contend, that to make "reports" the subject of exclusive ownership, would be directly to interfere with these fundamental principles and usages. They believe, that no man can be the exclusive proprietor of the decisions of courts or the enactments of the legislature; and that nothing in the light of property in either can be infringed. The two things being analogous, let the illustration of the one in controversy be derived from the one that is not. That a particular act of congress, or any number of acts of congress, could be made any man's exclusive property, has perhaps never been supposed. Yet the same labor is devoted to the construction of them —the same degree of talents is required for the due and proper composition of them. A particular individual receives them for publication, and the manuscripts may be said to belong to him; for "having retained such materials in his possession exclusively," so long as he had occasion for them, in every case it may probably be said, "he finally destroyed the same." This person is specially employed to publish the acts of congress. He does so, under an *appointment*, which has been deemed, by some learned judges, incompatible with the tenure of an office under one of the states. Where, then, does the parallel end? An individual may voluntarily publish an edition of the laws. But he does not, by such publication, make the *laws* his own. It is not necessary to determine, whether he has or has not exclusive property in the *peculiar combination, or in the additional matter which his edition may contain. He certainly does not, by either combination or addition, appropriate to himself that which is neither the one nor the other; and his combination being untouched, and his additions discarded, a stranger may surely use as he pleases, that which at first was public property, and is public property still. Those acts themselves are no more the property of the editors, than the hall in which they were enacted is the property of the members who passed the laws.

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If either statutes or decisions could be made private property, it would be in the power of an individual to shut out the light by which we guide our actions. If there be any effect derived from the assertion, that the judges furnished their decisions to the reporter, the gift would be both irrevocable and uncontrollable, even by the judges themselves. The desires of the court to benefit the public, and the wishes and necessities of the public to receive the benefit, might alike be frustrated by a perverse or parsimonious spirit. A particular case, or a whole series of cases, might be suppressed by a reporter endowed with different feelings from those of the highly

respectable complainant in this cause. It might become the interest of such a person to consign the whole edition to the flames, or to put it at inaccessible prices, or to suffer it to go out of print, before the country or the profession is half supplied. These are evils incident to every publication which can be secured by copyright. Mere individual works, whether literary or religious, the authors can undoubtedly thus control. During the "limited time" for which they are constitutionally secured in an exclusive enjoyment of them, there is no remedy. Their right is perfect during that period. A similar right must exist, if at all, in the publisher of reports. Can such a power be asserted, with all its consequences, over the decisions of the highest judicial tribunal of the land?

We are not to be told, that the interest of the proprietor would secure the country against so great an evil. The law endeavors to prevent the occurrence of any possible wrong, although it may not anticipate the precise mode of accomplishing it. But there are contingencies, readily conceivable, where the interest of a venal reporter might be promoted by the course suggested. A party might feel it to his own advantage, and *therefore, make it to the advantage of the reporter, to suppress a part, or the whole of the edition of his work. The law cannot and ought not to be made the prisoner or the slave of any individual. [*622

It is proper here to draw a distinction between *reports*, the immediate emanations from the sources of judicial authority, and mere *individual dissertations*, or *treatises*, or even *compilations*. These may be of great utility, but they are not the law. Exclude or destroy them, and the law and the knowledge of it still exists. The same fountains from which the authors of them drew, are accessible to others. These private works may be regarded as so many by-paths to the temple of justice, smoothed and straightened by individual labor, and laid out, for greater convenience, over private ground. The owner may close them at his pleasure, and no one can complain. But the entrance to the great temple itself, and the highway that leads to it, cannot be shut, without tyranny and oppression. It is not in the power of any department of the government to obstruct it.

The reports in England used to be printed with the express permission or allowance of the twelve judges prefixed. Probably, it would have been held a contempt of court to print them without. We are told, that four reporters were formerly appointed by the king "to commit to writing, and truly to deliver, as well the words spoken, as the judgments and reasons thereupon given," in the courts of Westminster. Preface to Cro. Jac. When Serjeant Henden *vouched for authority* Dalison's printed reports, Sir HENRY HOBART "demanded of him by what warrant those reports of Dalison's came in print." Preface to Cro. Car. Sir James Burrow rebelled against the habit of receiving a special allowance or recommendation from the judges, preparatory to publication, and actually published without any *allocatur*. His preface (p. 8), which explains all this, also has a reference to the *property of the reporter*. But that has, evidently, no allusion to copyright property, for it refers to a proceeding previous to the publication by the reporter: viz., a surreptitious publication by some other person, "and after the surreptitious edition has been stopped by an injunction, the book has been *published, with consent of the reporter, without leave or license, and no notice taken or complaint made of it." [*623

Reporting, however, in England, as it respects the common-law courts, at least, is a very different thing from reporting in this country. There, the reporter has, with regard to the decisions themselves, a labor to perform which requires experience, talents, industry and learning: and he receives nothing from the judges to aid him in his task. Here (with respect to the opinions), he does nothing more than transcribe, if he does so much. And having received the manuscripts from the judges, if he should not himself publish them, they are withheld from the public, to the infinite detriment of the whole nation.

The cases that have been decided in England have, as it should seem turned on a question of prerogative, and not of copyright. Such was the point in the *Company of Stationers* v. *Seymour*, 1 Mod. 256. "Matters of state, and things that concern the government, were never left to any man's liberty to print that would. And particularly, the sole printing of law-books, has been formerly granted in other reigns." The case in 1 Vern. 120 (*Anonymous*), was a motion by the *king's patentees* for an injunction to stop the sale of English bibles, printed beyond sea. The lord keeper then referred to the circumstance, that a patent to print law-books had been adjudged good in the house of lords. In the case of *Company of Stationers* v. *Parker*, Skin. 233, HOLT, arg., "agreed, that the king had power to grant the printing of books concerning religion or law, and admits it to be an interest, but not a sole interest." The court inclined for the defendant (who had pleaded the letters-patent of the king, which granted to the University of Oxford to print *omnes et omni modo libros* which are not prohibited to be printed, &c.), and they said, that "this is a prerogative of power which the king could not grant so, but that he might resume it, but otherwise it is of a grant of an interest." In *Gurney* v. *Longman*, 5 Ves. 506–7, Lord ERSKINE declared, that he granted the injunction (as to publishing the Trial of Lord Melville), "not upon anything like literary property, but upon this only, that these plaintiffs are in the *same situation, as to this particular subject, as the king's printer, exercising the right of the crown as to the prerogative copies." The cases of *Bell* v. *Walker*, 1 Bro. C. C. 451, and *Butterworth* v. *Robinson*, 5 Ves. 709, are not sufficiently developed, to show whether they turned upon copyright proprietorship, or a proprietorship derived from a prerogative grant.

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It cannot be contended, with any semblance of justice, that the mere *opinions* of the judges, communicated to Mr. Wheaton, as it is alleged they were, could be the subject of literary property. A book composed in part of those opinions, and in part of other matters, does not change the nature of the opinions themselves. An individual who thus mingles what cannot be exclusively enjoyed, with what can, does, upon familiar principles, rather forfeit the power over his own peculiar work, than throw the chain around that which is of itself as free as air. The intermixture, if it affect either description of materials, must render the whole unsusceptible of exclusive ownership. That which is public cannot, in its nature, be made private, but not *é contrà*. The lucubrations of the reporter assume the hue of the authoritative parts of his book, and must abide by the result of a connection so framed, and a color so worn. Whether a stranger could extract the original parts, in the face of a copyright, and publish them alone, it is not necessary to discuss. But upon the principles just asserted, he could give

additional dissemination to the whole, as he finds it connected together. And he could, it is conceived, unquestionably select what is justly public property, and leaving the merely private work of the reporter untouched, publish the rest with entire impunity.

2. Our second point is, that the exclusive ownership of an author can be obtained only by pursuing the provisions of the acts of congress. Upon this particular point, a moment's attention will be usefully given to the celebrated case of *Millar* v. *Taylor*, 4 Burr. 2303, and its companion, *Donaldson* v. *Beckett*, Ibid. 2408. Judgment of the court of king's bench having been entered for the plaintiff, in *Millar* v. *Taylor*, a decree of the court of chancery was founded upon it, in the case of *Donaldson* v. *Beckett and others*. This came before the house of lords on *an appeal, and the decree of the court of chancery (and of course, *Millar* v. *Taylor* along with it, in principle) was reversed, "the lord chancellor seconding Lord CAMDEN'S motion to reverse." Besides the influence of the decision itself, we have the force of these professional opinions, and that of a majority of the eleven judges, who gave their sentiments, that the existence of the statute deprived the author of any right of action which he may have had at the common law. The question of a common-law right has not been decided favorably to the author; and if it had been, the existence of a statute it thus recognised as superseding both the right and the remedy which may have previously existed. The marginal note of Sir James Burrow to *Millar* v. *Taylor*, 4 Burr. 2303, itself is, "authors have *not*, by common law, the sole and exclusive copyright in themselves or their assigns, in perpetuity, after having printed and published their compositions," &c. If, in England, the source and fountain of the common law, no such right exists, what can be alleged in favor of its existence in these United States? We contend, that there could be no such common-law right here, even if there were no statute; and that if they could be, it is incompatible with the provisions of the statute. All the arguments contained in the powerful and splendid opinion of Mr. Justice YATES in *Millar* v. *Taylor*, 4 Burr. 2354, are of irresistible force here. [*625

Feudal principles apply to real estate. The notions of personal property, of the common law, which is founded on natural law, depend materially on possession, and that of an adverse character, exclusive in its nature and pretensions. Throw it out for public use, and how can you limit or define that use? How can you attach *possession* to it at all, except of a subtile or imaginative character? If you may read, you may print. The possession is not more absolute and entire in the one case than the other. It is an artificial, and therefore, arbitrary rule, which draws the distinction; and in order to render it available, the lesson must be read in the statute, and the means must be resorted to which are there pointed out. Even in the face of a statute, backed by the constitution itself, let an inventor lose his possession, and his privilege is gone. The *decision of this court as to the patent for fire-hose, was to this effect. *Pennock* v. *Dialogue*, 2 Pet. 1. If the right secured by statute does not enable the owner to reclaim his lost possession, even when aided by the common law (if it be so), how can the common law, independently of all statutes, avail? Analogous rights, if such they may be called, are nothing without actual possession and use. Light and air, and a part of the great ocean, may be claimed and held, as [*626

long as necessary for the occupant ; but abandon the immediate occupation, and the exclusive power and exclusive possession are gone together.

These and similar reasons contribute to show the source of literary property everywhere. They justify the positive provisions, and manifest the wisdom of them which give existence to it among ourselves. It is not to be found in natural law or common law, and the deficiency is wisely and aptly supplied. The inconveniences to the public that would be the consequence of mere common-law assertion of the right would be endless. It would lead to perpetual strife. If the mere individual stamp of authorship would afford even a foundation for a claim, originality might be pretended to by numerous individuals, and a test of truth might not be obtained. If the real author give his work the official stamp of originality, before it goes forth into the world, most of the questions that would otherwise occur are anticipated. The source of exclusive ownership is, therefore, found in positive enactments, and not in any unwritten law.

What is the common law of the United States? To sustain a copyright, it must be a very different thing from what the sages of the American law have supposed. To construe existing laws and contracts, to aid in giving them effect, to furnish lucid definitions, sound principles and apt analogies, it is rich in the most important uses ; for all these, and various other purposes, it is indispensable. Most of the crimes prohibited by statute would be misunderstood, without its assistance ; all of the civil enactments would become obscure, if it did not shed its light in never-failing streams upon them. Yet it cannot originate a single punishment, or create a single crime. *627] It does not give any jurisdiction to the judge, or increase the *number or widen the extent of the subject on which he has authority to decide. When he has a duty to perform, it gives him wisdom and strength to perform it ; but the duty itself it cannot create, enlarge, diminish or destroy. This subject is well treated of by Mr. Du Ponceau in his Dissertation on the Nature and Extent of the Jurisdiction of the Courts of the United States. In his preface, page xi., he says, "the common law of the United States is no longer the source of power or jurisdiction, but the means or instrument through which it is exercised ; therefore, whatever meaning the words common-law jurisdiction may have in England, with us they have none ; in our legal phraseology, they may be said to be insensible." To them may be applied the language in which the common lawyer of old spoke of a title of the civil law : "*in ceux parolx n'y ad pas entendment.*" Again, preface, pages xiv., xv., "I contend, that in this country, no jurisdiction can arise," from the common law, as a source of power—"while," as a means for its exercise, "every lawful jurisdiction may be exercised through its instrumentality, and by means of its proper application."

The common law would be impracticable in its application to copyrights in the United States. It might vary in every state in the Union from the rest. What is the common law of New York or Pennsylvania? It is the common law of England, as it has been adopted or modified in those respective states. Each state then has, or may have, its own common law as a system, or as it applies to a particular subject of regulation or control. But copyrights, as recognised by the United States, must be uniform. There cannot, therefore, be a state common law for copyrights, for the want of necessary uniformity : and if the United States cannot derive it though the

states, they have it not at all. "This power," says Chancellor Kent (2 Com. 299), "was very properly confided to congress, for the states could not separately make effectual provision for the case."

The states themselves, at no time, ever treated this as a common-law right. Before the adoption of the federal constitution, accordingly, several of them are found to have made special provision by statute on the subject. New Hampshire, Massachusetts, Connecticut, New Jersey, Maryland and North Carolina, *each passed acts of assembly to secure to authors an [*628
exclusive enjoyment for a term of years. Why should they have secured a right already in full existence? They might have merely provided a penalty for an already perfect right. The periods for which an exclusive right is maintained are different in these provincial enactments. In Germany, this difficulty is cured, by rendering them perpetual in each department. But there is no common government in that country to which the subject can be referred.

This is a subject expressly ceded by the states to the general government; it is extinguished with regard to them in all its parts. Whatever power or control the states might have exercised is now gone, and all is vested in the United States. No common-law power, then, of any kind, in relation to copyrights, exists. Not in the states, for they have surrendered the whole subject to the federal government; not in the United States, for they exercise only the jurisdiction which is conferred by the constitution and the laws. Nor have they declined or omitted to fulfil the trust thus confided to them. If some powers are left unexercised (as in the case of bankruptcy), such omission cannot be asserted with regard to the protection of literary property; it is amply provided for. No assistance is needed from any other jurisdiction; no deficiency is even suggested to have been left to be supplied.

Mr. Du Ponceau, in his treatise already cited, page 101, asserts, "that when the federal courts are sitting in and for the states, they can, it is true, derive no jurisdiction from the common law; because the people of the United States, in framing their constitution, have thought proper to restrict them within certain limits; but that, whenever, by the constitution, or the laws made in pursuance of it, jurisdiction is given to them either over the person or subject-matter, they are bound to take the common law as their rule of decision, whenever other laws, national or local, are not applicable. Judge Chase, in the case of the *United States* v. *Worrall*, 2 Dall. 384, uses this comprehensive phrase, "in my opinion the United States, as a federal government, *have no common law!*" "If, indeed, the United States can be supposed for a moment to have a common law, it must, I presume, be that *of England; and yet it is impossible to trace when or how the [*629
system was adopted or introduced."

It would be most strange, if the double jurisdiction did exist. The constitution, and the statutes enacted in furtherance of its provisions, instead of providing or extending rights and remedies, would have greatly limited and restrained them; instead of doing as they were designed to do, much benefit to the author, they have done him much positive harm. He had already, according to the theory we are opposing, rights by the common law. These rights, if they were perfect in their nature, were unlimited on their extent. The patronage of American legislation then abridges the duration

of the right, if it does not curtail its enjoyment, by imposing restraints and prescribing preliminary forms. It does more, it draws a distinction between the stranger and the citizen or resident ; but the distinction, if it mean anything, is in favor of the former, and against the latter. The natural law, or common law, would be unlimited in the duration of the privilege which it would confer ; and the labor and skill exhibited in the composition, would secure the right. This would be an innate privilege of the foreigner. The statute law afterwards comes and confines the security to a term of years, and makes the way to obtain it intricate, or at least perplexed ! How does this consist with the language or the spirit of the eighth clause of the eighth section of the first article of the constitution ? That clause ordains, that congress shall have power "to *promote* the progress of science and useful arts, by securing for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." It would not be to promote, but to retard, that progress, if it possessed already a more active *stimulus*. There would be no occasion to secure for a limited time, if the exclusive right already existed in perpetuity.

The case of *Ewer* v. *Coxe*, 4 W. C. C. 487, is broad enough to cover all that is now contended for. Judge WASHINGTON having demonstrated the necessity of the proprietor's complying with the provisions of the act of congress, in order to obtain the benefit conferred by that act, declares, "if he has not that right, he can have no remedy of any kind." The right thus referred to was one purely under the statute. But it was the only available one *that could exist ; the only one that could carry with it, or be productive of any remedy. In order to sustain his claim at all, an author who has not complied with the provisions of the statute, must make out these several positions :—1. That a right and a remedy existed independently of the statute, and prior to it. 2. That the provision of redress by the statute does not take away a previous right. We have endeavored to show that the first of these positions is unsound, and if so, the second is altogether inapplicable.

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The language of the supreme court of New York (*Almy* v. *Harris*, 5 Johns. 175 ; see also *Scidmore* v. *Smith*, 13 Ibid. 322, and 1 Roll. Abr. 106, pl. 16), applied to a totally different matter, may be usefully quoted here. "If Harris had possessed a right at common law, to the exclusive enjoyment of this ferry, then, the statute giving a remedy in the affirmative, without a negative expressed or implied for a matter authorized by the common law, he might, notwithstanding the statute, have his remedy by action at the common law. 1 Com. Dig. Action on Statutes, C. But Harris had no exclusive right at the common law, nor any right but what he derived from the statute. Consequently, he can have no right since the statute, but those it gives ; and his remedy, therefore, must be under the statute, and the penalty only can be recovered." "But where a statute gives a right, and furnishes the remedy, that remedy must be pursued." *Gedney* v. *Inhabitants of Tewksbury*, 3 Mass. 309. And, "when a statute creates a new right, without prescribing a remedy, the common law will furnish an adequate remedy to give effect to the statute right. But when a statute has created a new right, and has also prescribed a remedy for the enjoyment of the right, he who claims the right must pursue the statute remedy." *Smith* v. *Drew*, 5 Mass. 515.

The same principles will make it necessary, in order to reach the rights which the statute creates, to pursue the means which it points out. Judge WASHINGTON, in *Ewer* v. *Coxe*, 4 W. C. C. 491, already cited, says, "that the author *must perform all that is pointed out, before he shall be entitled to the benefit of the act. It seems to me," says he, "that the act will admit of no other construction." [*631

The case of *Beckford* v. *Hood*, 7 T. R. 620, has been relied on to show that the directions of the English statute are not necessary preliminaries to the establishment of the right. The judges of the king's bench were construing a very different statute from ours. The second section of the act of 8 Ann., c. 19 (12 Statutes at Large 82), recites, that "whereas, many persons may, through ignorance, offend against this act, unless some provision be made whereby the property in every such book, &c., may be ascertained, &c." and then enacts, that "nothing in this act contained shall be construed to extend, to subject any bookseller, printer or other person whatsoever, to the forfeitures or penalties therein mentioned, for or by reason of the printing or reprinting of any book or books, without such consent as aforesaid, unless the title to the copy of such book or books hereafter published shall, before such publication, be entered in the register book of Stationers' Hall, &c." The corresponding cause of the act of congress of April 29th, 1802, runs thus: "that every person, &c., before he shall be entitled to the benefit of the act, &c., shall, in addition to the requisites, &c." The preliminary in the English statute is connected directly with the penalty. In ours, it is directly associated with the whole benefit of the act. The decision in *Beckford* v. *Hood* cannot affect the present case, even if it be sound. Of the soundness of it, there may be much doubt, when we find Lord HARDWICKE deciding, in *Blackwell* v. *Harper*, 2 Atk. 95, that "upon the act of 8 Ann., c. 19, the clause of registering with the Stationers' Company is relative to the penalty, and the property cannot vest without such entry." A further view is taken by Judge HOPKINSON of this decision in *Beckford* v. *Hood*, which is respectfully submitted as a conclusive reply. It will be found in his printed opinion.(*a*)

Let us look at the statutes themselves. The question here between us seems to be, whether the acts of congress merely provide a remedy, or also constitute a right? The act of 31st of May 1790, would have commenced with *its second section, if it had merely intended to suggest redress for the infringement of an existing right. This second section, however, is only a corollary or incident to the first, which provides, in compliance with what the constitution had authorized, security to authors which they did not in any shape enjoy before. There is nothing declaratory about it. "From and after the passing of this act, the author, &c., shall have the sole right, &c." The right is certainly prospective, and it is (we say) conditional. The right is to arise, at all events, subsequently to the passage of the act, and it is to commence "from the recording the title, &c., in the clerk's office, as is hereinafter directed." It would seem to be quite unnecessary thus gravely to confer in prospect a privilege already enjoyed, and to trammel it with conditions, if it was already unconditional. This is certainly no restraining statute. [*632

(*a*) See Appendix, II.

An argument has already been used, and it will not be formally repeated, that the ostensible or professed encouragement of learning, by securing, &c., during the times mentioned, would be a mere delusion; for the encouragement had been more liberal, the security not less perfect, and the right more comprehensive, because of unlimited extent, if they respectively had any anterior existence whatever. It is no less striking, that congress, who are supposed to be declaring the common law, and merely providing a precise penalty for the infraction of a right under it, could not, by any possible exercise of their power or authority, come up to the supposed common-law right; for the paramount authority of the constitution restrains the exercise of any encouragement to a limited time.

The act proceeds to mark out the preparatory step towards penalty or prohibition, viz., the legal acquisition of a copyright. (§ 1.) And how is the copyright to be legally acquired? Why, only by following the directions of the statute, *i. e.*, depositing the title in the clerk's office, publishing the record, and delivering a copy within six months to the secretary of state, to be preserved in his office. (§ 3.) Judge WASHINGTON was inclined to think, that some of these provisions were merely necessary to enable the author to sue for the forfeitures provided by the second section. But that would be quite an empty satisfaction. The copies forfeited by the invading party are to be destroyed; and the *penalty of fifty cents for every sheet in his possession, belongs one-half to the United States. The author is not much the better for this provision. He might have reserved all the damages for himself, independently of the act, if the right existed previously.

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It is not necessary to rely upon the construction of this act alone, if there be any doubt with regard to the true interpretation of it. The supplementary act, passed April 29th, 1802, is free from all difficulty. It is on this that Judge WASHINGTON relies. This last act provides, § 1, that the author, "before he shall be entitled to the benefit, &c., shall," in addition to the requisites enjoined in the third and fourth sections of said act, &c., "give information, by causing the copy of the record, &c., to be inserted at full length in the title-page, &c." It thus makes those clauses which had before been of doubtful name, *requisites*. It requires him to perform them, not as preliminary to forfeiture or penalty, which are only particular provisions of parts of the act, but as preliminary to the benefit of the act itself. He, therefore, in terms, is denied its advantages, unless he perform the conditions precedent. These, agreeable to a well-known rule, are to be construed strictly, and the party who omits to bring himself within them, can claim no right whatever. The statute becomes a unit; all its benefits are yielded or withheld, exactly as all its requisites have been fulfilled or disregarded.

Requisite is aptly defined by the American lexicographer, Noah Webster, to be "so needful that it cannot be dispensed with; something indispensable." An author must show that he has complied with these affirmative requisitions, or they will not be presumed for him. There are analogies which will fully sustain this position. Take the statute which regulates distresses for rent. Certain provisions are made which justify a landlord for acts which would otherwise amount to a trespass. But he must show that he has performed them strictly, or, as the law at first stood in England,

and does still in Pennsylvania, he is a trespasser *ab initio*, and the statute of Geo. II. only so far alters the rule, as to leave the party to his remedy by action on the *case, for the recovery of the actual damages that may have been sustained. If notice be required by statute, as, for [*634 example, preparatory to a suit against a magistrate for misconduct in office, not only is it never presumed, but nothing can supply his proof; not even knowledge of the design to sue, which might be substantially the same thing. In such case, knowledge is not notice.

There is nothing against our construction, in the principle which requires a strict interpretation of certain statutes. If the act be penal, we are not endeavoring to enforce the penalty. There is nothing penal as to the author claiming the copyright. All the penalties are against other persons. It is to be construed strictly, when it is to be enforced against *them*. He claims the benefit of his copyright, which is a grant to be obtained only on conditions precedent and well-defined. He attempts to enforce with rigor, if not the penal forfeitures, at least, the penal prohibitions of the law against the defendant, whom he alleges to be a wrongdoer. Against the defendant, thus, without (if it be without) bringing himself under the provisions of the law, the alleged proprietor denounces awful consequences. The defendant asks nothing—wants nothing, but to be let alone, until it can be shown that he has violated the rights of another.

Where is the difference between this act and the act respecting patents, as regards the right of the alleged owner? This court has said, that if a defendant sued for the infringement of a patent-right, "shows that the patentee has failed in any of these prerequisites on which the authority to issue the patent is made to depend, his defence is complete. He is entitled to the verdict of the jury and the judgment of the court." *Grant* v. *Raymond*, 6 Pet. 220.

3. There will be little difficulty in showing that the provisions of the acts of congress have not been complied with. The requisites are: 1st. The deposit of a printed copy of the title in the clerk's office of the district court where the author or proprietor resides. 2d. Within two months from the date thereof, the publishing of a copy of the record in one or more newspapers printed in the United States, for four weeks. *3d. Within six [*635 months, the delivery, &c., to the secretary of state of a copy to be preserved in his office.

With regard to the first volume, the bill is defective in not stating either of the two last requisites. The complainants are informed by M. Carey, and believe, that all things which are requisite and necessary to be done, &c., have been done! An inference or conclusion even of the party, would be a sorry substitute for the allegation and proof of the facts themselves. The court must have an opportunity to judge whether all things were done, &c.; and that they can have only when the things which were done are exhibited and proved. But here is double-distilled inference. The parties are informed of Matthew Carey's conjecture; and this is presented to the court as a substitute for proof; while H. C. Carey proves that Matthew Carey knew nothing about it, for all was left to him. It is extraordinary, if Mr. Carey really possessed any information on this subject, that he was not produced as a witness.

Upon the complainants' own allegation, their case must fail. But the

proof is scarcely less defective than the allegations of the bill. Henry C. Carey, the clerk of his father in 1816, states, that they were in the habit of advertising, and from the course of business, he does not doubt it was advertised, but he had no recollection of it. He has no recollection at all of a deposit of a copy in the office of the secretary of state. But he says, that the most probable way in which it was sent, was by Mr. Wheaton. In other words, that it was not sent by himself; and therefore, as to any proof from him, that it was not sent at all. Mr. Brent states, that the eighty copies of the volume of Wheaton's Reports, containing the decisions for February Term 1817, were delivered to the department of state on or before the 4th day of November 1817. This refers, of course, to the second volume, which contains the decisions of that term, and not the first, which is for the previous year. Subsequent volumes had been delivered in the same manner; all of them were received under the acts of congress, giving a salary to the reporter. He adds, that there has always been, according to his recollection, one or more complete sets of said reports, from the time of their publication, in the said department of state. But he is unable to recollect, or state more *particularly, when the same were first placed in said depart- *636] ment, or for what purpose. Both of these particulars, it is conceived, must be made out. The delivery must be within six months. The loose declaration that, according to his recollection, there has always been one or more sets, &c., from the time of publication, if it could have any force by itself, is done away by his acknowledged inability to recollect when they were first placed there. The object of the receipt of them, too, is directly the reverse of that prescribed by the copyright law; for, instead of being delivered to be preserved in the office, &c., they were, if delivered at all, merely a part of a general library, intended to be lent out and used. If delivered to be preserved, the presumption is, that the particular copy so left would be found. It will scarcely be contended, that the second edition of the first volume can cure the defects of the first. It can have no copyright existence by itself.

With regard to the subsequent volumes, the bill is scarcely less defective. The declaration of Robert Donaldson is vague and unsatisfactory. It could not be otherwise; he knew nothing of the subject. The result of the inquiries of the department of state, is evasively set forth; and were it otherwise, he must state the fact, and not the inquiry. The bill proceeds to insist, that the complainants would still be entitled to the benefits of the acts of congress, although they should be unable to prove that a copy was delivered, &c. We say, that such proof is a necessary preliminary.

The proof, with regard to these subsequent volumes, is equally defective. Of the second volume, there is no proof of publication. And of none of the volumes is there either allegation or proof of deposit, agreeable to the provisions of the law. The fourth volume wants publication. It began August 28th, and ended September 17th, instead of 25th. The seventh had but two publications in July, four in August, and one in September. The eighth had one publication in October, five in November, and two in December. Of the ninth, there is no evidence of publication at all. The tenth, eleventh and twelfth are all defective in publication.

*It is not necessary to dwell upon the facility with which proof *637] of delivery might have been preserved and exhibited, if it had been

made. The requisites of the law must be shown. But the certificate of Mr. Van Buren, with regard to the second edition of the first volume, is a specimen of what might have been, and would have been produced with regard to the whole, if the deposit had in fact been made.

In the absence of all right on the part of the complainants, not much difficulty is apprehended, from any supposed possession or enjoyment, by color of privilege. Judge WASHINGTON, in delivering his opinion in *Ewer* v. *Coxe*, disposes of this question to our hand. 4 W. C. C. 489. "I hold it to be beyond controversy," says he, "that if the plaintiff has no copyright in the work of which he claims to be the owner, a court of equity will not grant him an injunction. This was formerly the doctrine of the English court of chancery, and still is, as I conceive, notwithstanding Lord ELDON has, in some instances, granted an injunction and continued it to the hearing, under circumstances which rendered the title doubtful, if the plaintiff had possession under a color of title. But surely, if he has no title at all, or such a one as would enable him to recover at law, even that judge would, I presume, refuse an injunction." The authorities cited by Judge WASHINGTON, support the principle which he maintains. Against whom is this mere naked possession claimed? Not the defendant; for during the period when it has existed, he was only one of the mass of individuals who had not any particular concern in disturbing the complainants' colorable claims. It is, therefore, against the public, who cannot thus be baffled of their rights.

It is, however, a most extraordinary case, that would justify a perpetual injunction, without a trial at law. This is a proceeding which turns aside from the regular and proper mode of ascertaining title, and asks that the existence of it shall be definitely rested upon mere colorable claims. The complainants do not choose to bring their case to the proper test; but assuming as conclusive, what at the utmost is only *primâ facie* evidence in their favor, they propose to hang up for ever, in a state of presumption and doubt, that which is susceptible of a just and satisfactory settlement. All that the defendants *ask, in the dismissal of the bill, is, that their rights may not be prejudged. [*638

Sergeant, for the defendants.—The claim now asserted by the appellants, is to a perpetual right in Wheaton's reports, in Mr. Wheaton and his representatives and assigns. Such a right is necessarily exclusive. It goes beyond the right claimed to be secured under the copyright acts of congress. Such a claim should be clearly established It is asserted for the first time in a court of the United States. It has no precedent in the proceedings of the courts of England; for since the decision in that country, that the statute of Anne took away the alleged right of an author at common law, there can be found no precedent in that country, to sustain such a claim.

The Condensed reports, so far as it is now material to examine them, are made up of statements, which are to be found on the records, and of the opinions of the court. Mr. Wheaton's notes are not interfered with—nor are his reports of the arguments of counsel. These, it might be admitted, are his own; if he can have a property in any of the matters contained in the volumes published as a public officer. Mr. Wheaton's reports are made up as an officer of the court. The court appointed him, under the authority of

a law of the United States, and furnished him the materials for the volumes, not for his own sake, but for the benefit and use of the public; not for his own exclusive property, but for the free and unrestrained use of the citizens of the United States. In relation to the work, he was not an author, but as an officer, as a public agent, selected, authorized and paid for making up the reports of the decisions of the court. In the whole composition, under these views of the facts of the case, not a word in the reports belongs to him. It could not be the intention of the court to give him a perpetual right to the opinions delivered by them. No such purpose could have been entertained by congress, when the appointment of a reporter was directed. The objects of the law, and of the court, were to authorize, enforce and secure the publication of the proceedings and decisions of the court, for public information. Any argument, or course of argument, tending to *a different conclusion, must be wrong; because contrary to the design of his appointment. It is in derogation of common right. Let us see how the claim of the complainants is made out.

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I. The question whether the power to regulate copyrights under the constitution is exclusive, can never arise, until some state shall pass a law interfering with its exercise by congress. 3 Story's Com. 50. Until then, it must be a theoretical question. The law of New York, which was intended to secure exclusive rights in the navigation of the waters of that state by steam, was by this court decided to be unconstitutional. The court decided the case on other grounds, it is true, but still so decided. Up to the present moment, no state has asserted a right to interfere with the power of congress, under the constitution, to regulate copyright. There is no judicial decision which asserts or supposes any such right. There is not a trace, sign or symptom of any such right existing in the legislation, or judicial proceedings of any state. There is, therefore, no collision; no case for judgment; but the contrary is evident.

It is not necessary to inquire, whether states have the power, if they have not chosen to exercise or claim it. It is clear, that there was no such thing in any of the states, prior to the constitution, but by the invitation of congress, under the confederation. Fed. No. 43; 3 Story's Com. 49. Congress found the whole case unprovided for; and the laws made by some of the states, at their instance, and which have been referred to by the counsel for the appellants, ceased, when the constitution was adopted. But supposing that a concurrent power to regulate and secure copyright existed, in the states and the United States; a supposition of exceeding difficulty and doubt; and that the states may act, notwithstanding the exercise of the power by congress; it is for the states to choose whether they will do so or not. They have not so chosen—they leave it to congress. But there are many reasons for considering this power exclusive, as well as reasons which clearly show it ought to be exclusive.

1. It was originally taken up by congress as matter properly belonging to their cognisance. Early in the progress of the *government, the first law was passed; which was followed by other legislation, thus establishing the present regulations. This power did not exist in congress, under the confederation. None of the provisions in that compact applied to it; and it now rests upon the article in the constitution which gives congress the power to "promote the progress of science and the useful arts."

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The whole ground is admitted to have been vacant, on the establishment of the present government. It was a new power. Fed. No. 43 ; 3 Story's Com. 48 ; Rawle on the Const. ch. 9, p. 105–6 ; 2 Kent's Com. 306, &c.

2. The power could only be properly, beneficially and effectually exercised by congress. By vesting the power in the national legislature, the system became uniform and certain. Authors, but for this, would have been subjected to different provisions and conditions in every state ; thus materially affecting the value of all their rights. And the community, throughout the whole nation, were thus, after a certain interval, entitled to the benefits of the writings or compositions of those who availed themselves of the laws, passed under the constitutional provisions. 3 Story's Com. 48–9.

3. There is an absolute incompatibility between the existence of the power in the United States, and in the states. It has been repeatedly said, that the constitution has not occupied the whole ground. That it has provided for the author, and not for the public. But the true state of the case is directly the reverse of this. It has provided for the case of the author, only as instrumental to the provision for the public. The clause in the constitution gives congress the power, not to secure a copyright to the author ; but to "protect the progress of science and the useful arts, by securing for limited times to authors, &c., the exclusive right to their respective writings, &c." It is to be for a limited time, no longer. 3 Story's Com. 49.

4. The state of the law in England was known here, by the adjudications in the courts of that country. These adjudications stood in this way : 1st. That there was a common-law right before the statute of Anne. 2d. That there was no common-law right after that statute. According to those decisions, the effect of legislation was to take away the common-law right. Where the power of legislation over the subject was placed, there was the power over the whole matter.

*5. The same word "secure" is applied in the article in the constitution to inventions, as well as to the works of authors. In inventions, it is admitted, there was no common-law property. The use of the word "secure" cannot, therefore, presuppose an existing right. It would have the same effect, and be equally applicable to both. No benefit can, therefore, be derived from the use of the term ; however ingenious the argument which invokes it in aid of the pretensions of the complainants. See Act of 41 Geo. III. ; Maugham 36–7. [*641

6. The uniform construction, and the practice under it, have been such as is contended for by the defendants. It is true, there was an omission in the laws to give full power to the courts of the United States, in cases of copyrights. But the omission was to no great extent. There was no provision for jurisdiction, when the parties to a suit of which copyright was the subject, were citizens of the same state. *Binns* v. *Woodruff*, 4 W. C. C. 48. But that omission was supplied by the act of 1819. (3 U. S. Stat. 481.)

7. In what state, supposing an author to have a right at common-law, is the right to exist, and be protected. If there is a right of property, it must be governed by, and have the benefit of, all the rules which affect such property. It accompanies the owner everywhere. It is not his, because he is a

citizen of the United States; it derives no additional security from such citizenship. A stranger, who is an author—a foreigner has the same common-law right of proporty; and no foreign book can be printed here. Such has not been the understanding in England, from which the principles to sustain the right are derived. No common-law right extended to Ireland before the union. There, at all times, before the union, the works of authors, however secured under the statute of Anne, in England, were printed and published. If a common-law right existed, or was supposed to exist, we should have found, in the proceedings of the Irish courts, its establishment by judicial decisions.

But supposing it were otherwise, and that a right at common law does exist; upon the laws of what state do the complainants rely? Upon the law of Pennsylvania? In the circuit court, the right was claimed on the common law of the nation. In this court, it is asserted to rest upon the com-
*642] mon *law of a state; below, no intimation of such a thing was given. If any such right, under the common law of Pennsylvania, exists, we of Pennsylvania do not know it; strangers have discovered it, and claim the benefit of it, for the first time. Not a trace of its existence can be found in the whole history of that state; no authority from any of the laws, or the decisions of the courts, has been vouched. It is denied that it exists.

It is, then, assumed, without hesitation, that the right of action, whatever it is, which an author has for an infringement of his copyright, arises from the constitution and laws of the United States. The constitution gives congress the power "to promote the progress of science and the useful arts, by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." Art. I., § 8, ch. 8. Until secured by congress, he could have no right under the constitution. When secured, it must be to such extent, and upon such terms as congress may enact.

Some argument has been presented upon the word "securing," as admitting a pre-existing right. But there is no force in the suggestion. There must be a pre-existing state of things, out of which a right to apply to be secured arises. That right is brought into existence by the constitutional provision. It had no existence as a right incident to the fact of the author being a member of the community of the nation, until the constitutional provision. By the agreement of those who made the constitution, the right was brought into existence; and it was to be secured. The language, therefore, is accurate. It has already been observed, that the term "securing" is applied equally to inventions; yet no common-law right to inventions has been asserted. The federal judiciary, at all events, can have no cognisance of claims to copyright, but under the laws of the United States, made in pursuance of the constitution; and to the extent such laws may authorize them to go.

Thus understood, what is the right of an author? There is a difference between a patent and a copyright. A patent, in due form, is *primâ facie* evidence of the right of the inventor. It is, itself, *primâ facie* proof of all the prior acts required by the laws. It rests for its support upon the inven-
*643] tion. But *invention, without a patent, is nothing. A man, without a patent, could not ask the aid of the court to protect his claims. The patent is, therefore, evidence, *primâ facie*, of right. A copyright is quite a different thing. Its existence as a right, depends upon doing certain acts.

The doing of these is the foundation of the right. Their being done, is the only evidence of the right. If they are not done, no right, or even claim exists. These acts, therefore, as to copyright, are as a patent in the case of an invention. There is nothing that performs the office of a patent. The whole acts together establish the right. In the case of an invention, the patent being a *primâ facie* case of right, in the first instance, where the right of the inventor is disputed, it is sufficient to prove the patent, at law or in equity. In the case of a copyright, the title is made out *primâ facie*, at law and in equity, by stating and proving the acts which, by the provisions of the law, constitute the copyright. This distinction is a most material one, and to be always kept in mind. It goes to the root of the whole case. If anything has been omitted or neglected; if any of the requirements of the law, the performance of which are conditions upon which the right rests, and by which the right would be protected by the law, have been neglected; there is no title at all; no title in existence. Such a case is the same with that of an inventor coming into court without a patent; the court will not grant him an injunction. *Ewer* v. *Coxe*, 4 W. C. C. 487. There is nothing in such a case on which to engraft the doctrine of possession. It is only when a *primâ facie* title exists, one made out by showing a compliance with the law, that the doctrine of possession can be applied. *Ewer* v. *Coxe*, 4 W. C. C. 488.

This brings us to the first head of inquiry, which separates itself into two branches. 1. What are the requisites to a copyright, under the laws of congress? 2. Have these requisites been complied with?

1. Upon the first question, we have the light of a judicial decision, and there is no decision to the contrary. It is that of a judge of the highest and the most regarded judicial talents; *one whose opinions have always received the utmost respect. In *Ewer* v. *Coxe*, 4 W. C. C. 487, Judge [*644
Washington held, that to entitle the author of a book to a copyright, he must deposit a printed copy of the title of such book in the clerk's office; publish a copy of the record of his title within the period, and for the length of time, prescribed by the third section of the act of congress of 31st of May 1790; and deposit a copy of the book in the secretary of state's office, within six months after its publication. The requisites of the third and fourth sections of the act of congress of 1790, relative to copyrights, are not merely directory; but their performance is essential to vesting a title to the copyright secured by law. The act of congress of 29th April 1802, declares, that, in addition to the requisites enjoined in the third and fourth sections of the act of 1790, and before the person claiming a copyright shall be entitled to the benefits of the same act, he shall perform all the new requisites; and that he must perform the whole, before he shall be entitled to the benefits of the act. "It seems to me," says the judge, "that the act will admit of no other construction."

The argument upon the two acts taken together is plain and convincing. Act of 1790 (1 U. S. Stat. 124); Act of 1802 (2 Ibid. 171). The question, be it remembered, is, what are the requisites under the act of 1802? 1. When these acts were passed, the whole subject of copyrights was open for legislation. The object of congress was to carry into effect the provisions of the constitution, by establishing a mode of obtaining a copyright; the provisions of the laws have no other view. It is material and reasonable,

then to suppose, that whatever was directed to be done was a requirement. The acts to be performed, were to secure for a limited time to an author, the benefit of his writings; and these acts were directed for that purpose. It is impossible to distinguish, so that one of the acts shall be decreed material, and another not so. The whole, and each of the acts are pointed out in the law, and the most natural course is to deem them all materia.. They do all, in effect, constitute the conditions of the title; they constitute the title itself. *2. Upon the words of the act, it seems impossible *645] to raise a doubt; they are plain, clear, and require no explanation. The acts they require are of easy performance; the evidence that they have been performed, can always be obtained and preserved. The reason of requiring these acts is not here in question.

It is probably true, that when the act of 1790 was passed, congress had before them the statute of Anne, and the decisions of the English courts upon that statute, and on all the litigated questions of literary property, and of copyright. This is equally true of the act of 1802; and this must be considered in reading that act. But the reason of the requirement of the law is obvious. The author "shall deliver a copy to the secretary of state, to be preserved in his office." The copy to be delivered is not to constitute a part of the library of the secretary of state. The books deposited for copyright, never do form a part of the library of the department of state. They are, it is understood, always marked, "deposited for copyright," with the date of the deposit. The books so deposited are not lent out, or ought not to be. They are "to be preserved in the office" of the secretary of state. They are not delivered for the sake of the officer, nor are they like the copies delivered to the Stationers' Company, under the act of Anne.

Why does the law require a copy to be deposited in the office of the secretary of state? It is a material requirement. Why, it is asked, were models and drawings to be deposited in the patent-office, a part of the department of state? That is a kindred subject, and the reason is the same in one case as in the other. If a model, or a drawing of a machine or invention, is required to be deposited in the patent-office, the reasons and the objects of the requirement are, that the public may know what the invention is; and that, after the limited period shall have expired, they may have the use of it, according to the purpose of the provision in the constitution. A book or writing is required to be deposited for the same reason. The matter claimed as original is there to be preserved, in order that the extent and nature of the claim for the limited period may be known. The deposit of the title in the clerk's office, the *publication of the record in the *646] newspapers, give no information of the contents of the work; but the deposit of it in the secretary's office does this: and as it is "to be preserved" there at all times; there the extent of the author's claims can be always known.

The law enjoins on the secretary of state obligations which are consistent with those views of its purposes. It is made his duty to preserve the books deposited in his office. He is thus the trustee of the author and of the public. The court will not suppose this duty is ever neglected. It will always presume the injunctions of the law are complied with. As to the author, he has an easy mode of securing the evidence of his compliance with the law. To his rights, the preservation of the book deposited, is not essential.

He has done all that is required of him, by depositing the copy of his work; and the certificate of the secretary of state, which the secretary has power to give, will be evidence of the deposit.

An examination of the provisions of the act of 1802, must result in the conviction, that the construction contended for by the defendants is the true one. The act must be interpreted, not altered. It must be read in its own words, and according to the common meaning and use of the terms in which it is expressed. The first and second sections of the act are those upon which the construction is to be given; and no better language for the clear interpretation of them can be used than those used by Judge WASHINGTON, in *Ewer* v. *Coxe*.

It is of no importance to the case, whether, by the law of 1790, the acts to be done by an author were conditional or directory. They were enjoined—they were "requisites." The act of 1802 has so declared them, and without this they were clearly so; this cannot reasonably be denied. The construction conceded by Judge WASHINGTON, in *Ewer* v. *Coxe*, of the provisions of the act of 1790, is not satisfactory. Having ascertained to his complete satisfaction, that the act of 1802 left no room to doubt, that the acts imposed on an author, were conditions essential to his copyright; that venerable and learned judge did not consider it necessary to examine the provisions of the law of 1790, with the care and scrutiny he would have done, had the case rested on that law only.

The requirements of the law of 1790 are made of the party himself. It is in his power to perform them all. They are *all, and each of them, parts of a system having reference to the author and publisher. The [*647 act of depositing a copy in the office of the secretary of state, is one of the number of acts by which he evinces his intention to secure a copyright, and by which he executes his intention. Less than the whole does not suffice to prove the intention; less than the whole, is not a copyright. The publication in the newspapers is on the same footing. It will surely be admitted that was material. Yet they are both of the same character. There was no necessity for either, if not for both. Unless both were to be performed, both were nugatory; and the whole provisions of the law might have been a dead letter.

The law of 1802 places the question of construction of the act of 1790 out of doubt or controversy. It declares the acts stated in the law of 1790 to be requirements. He shall, in addition to the "requisites" "enjoined" in the third and fourth sections of the act of 1790, do certain things. Every word of the law must have effect. Each section contains one requisite, and no more; neither, therefore, can be rejected; all must have their full force. The second section is equally clear; it helps to construe the other. These, it will be seen, are words of enactment, not of recital; they make the law; they do not declare or expound it. Whatever the law may have been before 1802, it is now established. The decision in *Ewer* v. *Coxe*, in establishing the construction of the act of 1802, establishes that of both statutes.

Under these views of the law, founded on the fair and sound construction of their provisions, and supported by the decision in *Ewer* v. *Coxe*, copyright is the union of these acts, the "requirements" of the laws by an author. It is *nomen collectivum*, signifying all that confers and constitutes the right.

II. Such being the law, how stand the facts of the case? And now it must be conceded, that the proof of title, and compliance with the law, lies upon the complainant. He must state the facts distinctly in the bill, and he must prove them as stated. Most clearly, this is his duty, when he asks
*648] the extraordinary aid of a court of equity. *Nor can it be deemed unreasonable to require this. The proof of his title to copyright is of such a nature that it may easily be preserved, it may consist of an official certificate of the deposit of a copy of the work—of newspapers to prove the required publication. There is a want of such allegations in the bill, as well as of such proof.

Mr. Sergeant declined going into an examination of the bill and evidence in support of the positions he assumed; considering that they had been fully sustained by the argument of Mr. Ingersoll. He also referred, in support of these positions, to the opinion of the learned judge in the circuit court, by whom the case was decided.(*a*) Upon the point made by the counsel for the appellants, that the delivery of the eighty copies of the reports under the reporter's act, was a compliance with the requisite of copyright acts, o the deposit of a copy in the secretary of state's office; he also referred to the decision of Judge HOPKINSON.

The case, as exhibited on the record, and by the examination of it which has been submitted to the court, is one which has no claim to the relief sought by the complainants. Its principal features are repeated, to connect with them other matters deserving the consideration of the court. Mr. Wheaton undertook the preparation and publication of the reports of the decisions of the court, under the appointment of the court. He furnished nothing original from his own mind. All the contents of the reports were the fruits of the minds of others; supplied for the public use; at the public expense; or at the expense of others. There is not a thought of Mr. Wheaton's from the beginning to the end of the work. It was intended for the public, for their use and benefit; and should, therefore, be made as public as possible. In process of time, after the publication of the first volume of his reports, Mr. Wheaton became a public officer; with a salary for his labor as reporter, and obliged to perform the duties of the office. This provision for the reports, it has been said, in the course of the argument for the complainants,
*649] was obtained at the earnest solicitation of Mr. Wheaton. It, *therefore, became a contract on his part, for the sum allowed by the law, to prepare and publish the reports. (See act of 1823.) He became, like the clerk of the house of representatives, keeping the journals. The object of his appointment, the plain purpose of the law, was, to preserve a record of the proceedings and decisions of the court; the highest tribunal in the nation; and to give them circulation. If Mr. Wheaton could have a copyright, this object might be entirely defeated—his book might be a sealed book. Out of this public work, it becomes necessary to compile something less bulky and expensive. The usefulness of such a publication is admitted by all but those interested to deny it. Mr. Peters undertakes to prepare it, and he has completed the work. He announced his intention to do this, publicly; and fully explained his plan. No efforts were made to stay

(*a*) See Appendix, II.

this proceeding, until invited by him; and after he had completed the third volume of his work. If the further circulation of his book is stopped, it will be a public injury. Such a result will limit the knowledge of the law of the land, as determined and established by this court, to but a small portion of the community; while all are interested in knowing it.

But here a question arises, whether books of reports can be copyrighted in England or in the United States? There are no cases decided, in which the principle is established, that reports of the decisions of courts of law are the subjects of copyright. The case of *Streater* v. *Roper*, 4 Bac. Abr. Prerogative (Maugham 101, note) was reversed in parliament. By that decision the prerogative right, the right of the patentee, was established. No right, as author, was sustained by this case; but the contrary. It is true, that Maugham says, the prerogative claim is ridiculous; but it rests on a decision that it is the ancient law. In the case of *Butterworth* v. *Robinson*, 5 Ves. 509, it does not appear how the right was derived. By the decisions of the house of lords, no such right is maintained. No copyright, in any one author, is supported by those decisions. No one could report but by the authority of the chancellor; and this authority was exclusive; it prohibited all others from interfering. *Gurney* v. *Longman*, 13 Ves. 493. *The whole of this subject will be found to be examined in the compilations of Jeremy, Maugham and Godson. The law is not established, at least, it has not been so declared, that reports can be private property. Essentially, their contents are public property. The knowledge of the decisions of courts should not be confined. It is consistent with the views of this court, that copies of their opinions should be multiplied to any extent, and in any form required. Publicity is the very thing required. [*650

The reporter is a public officer, and his duty, by law, is, to publish. He has no liberty to keep back the matter which he collects and prepares, in the performance of his official duties. The act of 1817 (3 U. S. Stat. 376), regards him as a public officer. So, by the subsequent acts (Ibid. 606, 768; 4 Ibid. 205). The court, in 3 Pet. 397, at January term 1830, decided, that the reporter was the proper officer to give copies of the opinions of the court, when required. Could he refuse such copies? Could he refuse to give a copy of a report of a case, when asked for it, on the ground that it was his property, and only to be used by his consent, and for his benefit? The whole purpose of the reporter's act would be defeated, could this be done. That act makes him the officer to give publicity to the proceedings of the court; but upon this view of the matter, it has placed him in a situation to get possession of the official actions of the court; it has given access to the records of the court, and has placed him in a situation by which he has obtained all the materials to accomplish the plain and obvious intention of the law, for his private advantage, and that he may defeat and set at naught that intention. Such cannot be the law; this court will never sanction such pretensions.

The purpose of the appellants is to subject the defendants to all the evils of a violation of the copyright acts, by a proceeding which deprives them of the benefits of a trial by jury. Such a course will not receive the favor of this court. The facts upon which the rights of the complainants must rest, whatever may be the construction of the acts of congress, are not made out. All the essential facts to sustain their claims are denied; and certainly,

it will be admitted, the proof offered to sustain them by the complainants, is imperfect. Will the court, then, give its aid in such a case? Will they *651] reverse the *decision of the circuit court, and order a perpetual injunction? Will they not say to the complainants, If you have rights, go into a court of law and establish them?

Webster, in reply.—There was at one period no regular series of reports of the decisions of this court. Mr. Cranch's reports had been published so far as the sixth volume; the rest of the matter, which afterwards formed the remaining volumes, was in manuscript. In this state of things, Mr. Wheaton proposed a regular annual publication of the decisions, with good type, and to be neatly printed. It was found necessary that there should be some patronage from the legislature, there being so few persons who would purchase the reports. Mr. Wheaton applied to congress, personally solicited its aid, and made a case which prevailed. Congress passed a temporary law, which was renewed again and again. The successor of Mr. Wheaton has had the full benefit of the grant obtained by the personal exertions of Mr. Wheaton.

If the work of the appellee be an interference with the rights of the appellants, it is not a heedless one; it may not be an intentional interference, but the acts which constitute it are intentional. The defendant was well advised of the injury which the appellants foresaw; this is fully proved by the evidence. The publication of the defendant has materially injured the appellants. Many volumes of Wheaton's reports were on hand, unsold, at the time of the publication of the third volume of Condensed reports. The intention of the defendant was not to make an abridgment, but to make a substitute for the whole of the appellant's work. The reports of the appellant were the result of the joint action of congress and the reporter; they set the price. If congress had thought that the people should have them cheaper, they would have lowered the price. The defendant should not have run a risk in accommodating the public; they could judge for themselves.

The question before the court is one for the most enlarged and liberal consideration. Cases which are not in form, but are in substance, an *652] infringement of the author's rights, are to *be viewed, as respects the author, liberally. This spirit pervades all the adjudged cases. Has there been an indefensible use of the appellant's labors? In the Condensed reports there is the same matter as in the reports of the appellant, under the same names. Is this an abridgment? An abridgment, fairly done, is itself authorship, requires mind; and is not an infringement any more than another work on the same subject. In the English courts, there are frequently more reports than one of the same cases. These reports are distinct works. Abridgments are the efforts of different minds. The Condensed reports have none of the features of an abridgment, and the work is made up of the same cases, and no more than is contained in Wheaton's reports.

The attention of the court is called to certain facts. The laws of congress relating to the reporter's office do not bear on the question of copyright. There is no intimation in the statute of such an interference, or that the sum allowed the reporter is in lieu of copyright. The right in the

reporter to fix the price of the volumes, recognises a right to exclude others from publishing. He receives $1000, and gives eighty copies to the United States, of the value of $400. Would he give up the copyright for this sum; this modicum? The law was intended to secure to him the rights he possessed, and to add to them also.

Before the statute of Anne, the copyright of authors was acknowledged. In 1769, it underwent investigation in the courts. The statute of Anne was passed 1711. Pennsylvania was settled in 1682. The common law was carried to Pennsylvania on its settlement; and the statute of Anne did not change or affect it. The copyright of an author existed in the colonies, and exists in the United States; and particularly in Pennsylvania.

It has been said by the counsel for the defendants, that there is no legislation in the state of Pennsylvania, or judgment of her courts recognising the common-law right. Before the revolution, there were few books made; and there are no reports of the decisions of the courts, anterior to that event. The common law is a fountain of remedy, perennial and perpetual; by *its principles, protecting rights when they are infringed, and its principles existing, although not called into action. [*653
The import of the act of congress of 1790 is, that before its enactment, there were legal rights of authorship existing; it provides for existing property, not for property created by the statute; there is nothing for its provisions to stand upon, but the common law. That law is not one of grant or bounty; it recognises existing rights, which it secures. The aim of the statute was to benefit authors, and thereby the public.

The right of an author to the production of his mind is acknowledged everywhere. It is a prevailing feeling, and none can doubt that a man's book is his book—is his property. It may be true, that it is property which requires extraordinary legislative protection, and also limitation. Be it so. But the appellants are entitled to protection under the statute. It is a clear case. All the statutes should be taken together. The decision of Judge WASHINGTON in *Ewer* v. *Coxe*, was not appealed from; and the question is for the first time before this court.

Is the deposit of the copy in the office of the secretary of state a condition precedent or subsequent? There is no question but that it is the latter. There is no need of the deposit being made, until six months after publication. From and after the recording of the title, the right is secured, and the author may immediately bring his action for an infringement. Does this case stand differently from what it would, if the action had been brought within six months after recording the title page? *Ewer* v. *Coxe* says the book must be deposited, before the right arises; the statute says differently.

By the act of 1790, there were certain requisites, not pre-requisites, enjoined on an author. Does the law of 1802 make the requisites of the act of 1790 pre-requisites? There are conclusive reasons against this. It was the intention of the law to add to, but not to change the character of the law of 1790. If this was otherwise, there was a direct repeal of the second section of that law, by which an action is given upon filing the title page in the clerk's office. The act of 1802 is an addition to the first act, but not a repeal of it. This is the hinge of this case. The construction

*contended for will repeal the second section of the act of 1790, and will create a forfeiture.

What reason is there to doubt that the copies were deposited as required by the law? It is the ordinary course of trade to deliver them. Is it an unfair construction, to suppose, that the one copy required by the laws to be delivered, is included in the eighty copies delivered as reporter? Is there not a special provision in the case of the reporter, that he shall deliver eighty copies, while others deliver one copy. The same term of six months is required for the delivery in both.

McLean, Justice, delivered the opinion of the court.—After stating the case, he proceeded: Some of the questions which arise in this case are as novel, in this country, as they are interesting. But one case involving similar principles, except a decision by a state court, has occurred; and that was decided by the circuit court of the United States for the district of Pennsylvania, from whose decree no appeal was taken.

The right of the complainants must be first examined. If this right shall be sustained, as set forth in the bill, and the defendants shall be proved to have violated it, the court will be bound to give the appropriate redress.

The complainants assert their right on two grounds. First, under the common law. Secondly, under the acts of congress.

And they insist, in the first place, that an author was entitled, at common law, to a perpetual property in the copy of his works, and in the profits of their publication; and to recover damages for its injury, by an action on the case, and to the protection of a court of equity. In support of this proposition, the counsel for the complainants have indulged in a wide range of argument, and have shown great industry and ability. The limited time allowed for the preparation of this opinion, will not admit of an equally extended consideration of the subject by the court.

Perhaps, no topic in England has excited more discussion, among literary and talented men, than that of the literary property of authors. So engrossing was the subject, for a long time, as to leave few neutrals, among
*655] those who were distinguished *for their learning and ability. At length, the question, whether the copy of a book or literary composition belongs to the author at common law, was brought before the court of king's bench, in the great case of *Millar* v. *Taylor*, 4 Burr. 2303. This was a case of great expectation; and the four judges, in giving their opinions, *seriatim*, exhausted the argument on both sides. Two of the judges, and Lord Mansfield, held, that, by the common law, an author had a literary property in his works; and they sustained their opinion with very great ability. Mr. Justice Yates, in an opinion of great length, and with an ability, if equalled, certainly not surpassed, maintained the opposite ground. Previous to this case, injunctions had issued out of chancery to prevent the publication of certain works, at the instance of those who claimed a property in the copyright, but no decision had been given. And a case had been commenced, at law, between *Tonson* and *Collins*, on the same ground and was argued with great ability, more than once, and the court of king's bench were about to take the opinion of all the judges, when they discovered that the suit had been brought by collusion, to try the question, and it was dismissed. This question was brought before the house of lords, in the

case of *Donaldson* v. *Beckett and others*, reported in 4 Burr. 2408. Lord MANSFIELD, being a peer, through feelings of delicacy, declined giving any opinion. The eleven judges gave their opinions on the following points.

1st. Whether, at common law, an author of any book or literary composition, had the sole right of first printing, and publishing the same for sale; and might bring an action against any person who printed, published and sold the same, without his consent? On this question, there were eight judges in the affirmative, and three in the negative.

2d. If the author had such right, originally, did the law take it away, upon his printing and publishing such book or literary composition; and might any person, afterwards, reprint and sell, for his own benefit, such book or literary composition, against the will of the author? This question was answered in the affirmative, by four judges, and in the negative by seven.

3d. If such action would have lain, at common law, is it taken away by the statute of 8 Anne; and is an author, by *the said statute, precluded from every remedy, except on the foundation of the said statute, and on the terms of the conditions prescribed thereby? Six of the judges, to five, decided that the remedy must be under the statute. [*656

4th. Whether the author of any literary composition, and his assigns, had the sole right of printing and publishing the same in perpetuity, by the common law? Which question was decided in favor of the author, by seven judges to four.

5th. Whether this right is any way impeached, restrained or taken away, by the statute 8 Anne? Six to five judges, decided that the right is taken away by the statute. And the lord chancellor seconding Lord CAMDEN's motion to reverse, the decree was reversed.

It would appear from the points decided, that a majority of the judges were in favor of the common-law right of authors, but that the same had been taken away by the statute. The title and preamble of the statute 8 Ann., c. 19, is as follows: "An act for the encouragement of learning, by vesting the copies of printed books in the authors or purchasers of such copies, during the times therein mentioned." "Whereas printers, booksellers and other persons, have of late frequently taken the liberty of printing, reprinting and publishing, or causing to be printed, reprinted and published, books and other writings, without the consent of the authors or proprietors of such books and writings, to their very great detriment, and too often to the ruin of them and their families," &c.

In 7 T. R. 627, Lord KENYON says, "all arguments in the support of the rights of learned men in their works, must ever be heard with great favor by men of liberal minds to whom they are addressed. It was probably on that account, that when the great question of literary property was discussed, some judges of enlightened understanding went the length of maintaining, that the right of publication rested exclusively in the authors and those who claimed under them, for all time; but the other opinion finally prevailed, which established that the right was confined to the times limited by the act of parliament; and, that, I have no doubt, was the right decision." And in the case of the *University of Cambridge* v. *Pryer*, 16 East 319, Lord ELLENBOROUGH remarked, "it has been said, that *the statute of 8 Anne has three objects; but I cannot subdivide the two [*657

first ; I think it has only two. The counsel for the plaintiffs contended, that there was no right at common law ; and perhaps, there might not be ; but of that we have not particularly anything to do." From the above authorities, and others which might be referred to, if time permitted, the law appears to be well settled in England, that, since the statute of 8 Anne, the literary property of an author in his works can only be asserted under the statute. And that, notwithstanding the opinion of a majority of the judges in the great case of *Millar* v. *Taylor* was in favor of the common-law right, before the statute, it is still considered, in England, as a question by no means free from doubt.

That an author, at common law, has a property in his manuscript, and may obtain redress against any one who deprives him of it, or by improperly obtaining a copy, endeavors to realize a profit by its publication, cannot be doubted ; but this is a very different right from that which asserts a perpetual and exclusive property in the future publication of the work, after the author shall have published it to the world. The argument that a literary man is as much entitled to the product of his labor as any other member of society, cannot be controverted. And the answer is, that he realizes this product by the transfer of his manuscripts, or in the sale of his works, when first published. A book is valuable on account of the matter it contains, the ideas it communicates, the instruction or entertainment it affords. Does the author hold a perpetual property in these ? Is there an implied contract by every purchaser of his book, that he may realize whatever instruction or entertainment which the reading of it shall give, but shall not write out or print its contents ?

In what respect does the right of an author differ from that of an individual who has invented a most useful and valuable machine ? In the production of this, his mind has been as intensely engaged, as long, and, perhaps, as usefully to the public, as any distinguished author in the composition of his book. The result of their labors may be equally beneficial to *so-
*658] ciety, and in their respective spheres, they may be alike distinguished for mental vigor. Does the common law give a perpetual right to the author, and withhold it from the inventor ? And yet it has never been pretended, that the latter could hold, by the common law, any property in his invention, after he shall have sold it publicly. It would seem, therefore, that the existence of a principle may well be doubted, which operates so unequally. This is not a characteristic of the common law. It is said to be founded on principles of justice, and that all its rules must conform to sound reason. Does not the man who imitates the machine profit as much by the labor of another, as he who imitates or republishes a book ? Can there be a difference between the types and press with which one is formed, and the instruments used in the construction of the others ? That every man is entitled to the fruits of his own labor, must be admitted ; but he can enjoy them only, except by statutory provision, under the rules of property which regulate society, and which define the rights of things in general.

But if the common-law right of authors were shown to exist in England, does the same right exist, and to the same extent, in this country ? It is clear, there can be no common law of the United States. The federal government is composed of twenty-four sovereign and independent states ; each of which may have its local usages, customs and common law. There is no

principle which pervades the Union and has the authority of law, that is not embodied in the constitution or laws of the Union. The common law could be made a part of our federal system, only by legislative adoption. When, therefore, a common-law right is asserted, we must look to the state in which the controversy originated. And in the case under consideration, as the copyright was entered in the clerk's office of the district court of Pennsylvania, for the first volume of the book in controversy, and it was published in that state; we may inquire, whether the common law, as to copyrights, if any existed, was adopted in Pennsylvania.

It is insisted, that our ancestors, when they migrated to this *country, brought with them the English common law, as a part of [*659 their heritage. That this was the case, to a limited extent, is admitted. No one will contend, that the common law, as it existed in England, has ever been in force, in all its provisions, in any state in this Union. It was adopted, so far only as its principles were suited to the condition of the colonies; and from this circumstance we see, what is common law in one state, is not so considered in another. The judicial decisions, the usages and customs of the respective states, must determine, how far the common law has been introduced and sanctioned in each.

In the argument, it was insisted, that no presumption could be drawn against the existence of the common law, as to copyrights, in Pennsylvania, from the fact of its never having been asserted, until the commencement of this suit. It may be true, in general, that the failure to assert any particular right, may afford no evidence of the non-existence of such right. But the present case may well form an exception to this rule. If the common law, in all its provisions, has not been introduced into Pennsylvania, to what extent has it been adopted? Must not this court have some evidence on this subject. If no right, such as is set up by the complainants, has heretofore been asserted, no custom or usage established, no judicial decision been given, can the conclusion be justified, that, by the common law of Pennsylvania, an author has a perpetual property in the copyright of his works. These considerations might well lead the court to doubt the existence of this law in Pennsylvania; but there are others of a more conclusive character.

The question respecting the literary property of authors, was not made a subject of judicial investigation in England until 1760; and no decision was given until the case of *Millar* v. *Taylor* was decided in 1769. Long before this time, the colony of Pennsylvania was settled. What part of the common law did Penn and his associates bring with them from England? The literary property of authors, as now asserted, was then unknown in that country. Laws had been passed, regulating the publication of new works, under license. And the king, as the head of the church and the state, claimed the exclusive *right of publishing the acts of parliament, the [*660 book of common prayer, and a few other books. No such right at the common law had been recognised in England, when the colony of Penn was organized. Long afterwards, literary property became a subject of controversy, but the question was involved in great doubt and perplexity; and a little more than a century ago, it was decided by the highest judicial court in England, that the right of authors could not be asserted at common law, but under the statute. The statute of 8 Anne was passed in 1710. Can it be contended, that this common-law right, so involved in doubt as to divide the

most learned jurists of England, at a period in her history, as much distinguished by learning and talents as any other, was brought into the wilds of Pennsylvania by its first adventurers. Was it suited to their condition?

But there is another view, still more conclusive. In the eighth section of the first article of the constitution of the United States, it is declared, that congress shall have power "to promote the progress of science and useful arts, by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." And in pursuance of the power thus delegated, congress passed the act of the 30th of May 1790. This is entitled "an act for the encouragement of learning, by securing the copies of maps, charts and books, to the authors and proprietors of such copies, during the times therein mentioned." In the first section of this act, it is provided, "that from and after its passage, the author and authors of any map, chart, book or books, already printed within these United States, being a citizen, &c., who hath or have not transferred to any other person the copyright of such map, chart, book or books, &c., shall have the sole right and liberty of printing, reprinting, publishing and vending such map, book or books, for fourteen years."

In behalf of the common-law right, an argument has been drawn from the word *secure*, which is used in relation to this right, both in the constitution and in the acts of congress. This word, when used as a verb active, signifies to protect, insure, save, ascertain, &c. *The counsel for the complainants insist that the term, as used, clearly indicates an intention, not to originate a right, but to protect one already in existence.

*661]

There is no mode by which the meaning affixed to any word or sentence, by a deliberative body, can be so well ascertained, as by comparing it with the words and sentences with which it stands connected. By this rule, the word *secure*, as used in the constitution, could not mean the protection of an acknowledged legal right. It refers to inventors, as well as authors, and it has never been pretended by any one, either in this country or in England, that an inventor has a perpetual right, at common law, to sell the thing invented. And if the word *secure* is used in the constitution, in reference to a future right, was it not so used in the act of congress?

But, it is said, that part of the first section of the act of congress, which has been quoted, a copyright is not only recognised as existing, but that it may be assigned, as the rights of the assignee are protected, the same as those of the author. As before stated, an author has, by the common law a property in his manuscript; and there can be no doubt, that the rights of assignee of such manuscript would be protected by a court of chancery. This is presumed to be the copyright recognised in the act, and which was intended to be protected by its provisions. And this protection was given as well to books published under such circumstances, as to manuscript copies.

That congress, in passing the act of 1790, did not legislate in reference to existing rights, appears clear, from the provision that the author, &c., "shall have the sole right and liberty of printing," &c. Now, if this exclusive right existed at common law, and congress were about to adopt legislative provisions for its protection, would they have used this language? Could they have deemed it necessary to vest a right already vested. Such a presumption is refuted by the words above quoted, and their force is not lessened by any other part of the act. Congress, then, by this act, instead

or sanctioning an existing right, as contended for, created it. This seems to be the clear import of the law, connected with the circumstances under which it was enacted.

*From these considerations, it would seem, that if the right of the complainants can be sustained, it must be sustained under the acts [*662 of congress. Such was, probably, the opinion of the counsel who framed the bill, as the right is asserted under the statutes, and no particular reference is made to it as existing at common law. The claim, then, of the complainants, must be examined in reference to the statutes under which it is asserted.

There are but two statutes which have a bearing on this subject; one of them has already been named, and the other was passed the 29th of April 1802. The first section of the act of 1790 provides, that an author, or his assignee, "shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the term of fourteen years, from the recording of the title thereof in the clerk's office, as hereinafter directed: and that the author, &c., in books not published, &c., shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the like term of fourteen years, from the time of recording the title thereof in the clerk's office, as aforesaid. And at the expiration of the said term, the author, &c., shall have the same exclusive right continued to him, &c., for the further term of fourteen years: provided he or they shall cause the title thereof to be a second time recorded, and published in the same manner as is hereinafter directed, and that within six months before the expiration of the first term of fourteen years. The third section provides, that "no person shall be entitled to the benefit of this act, &c., unless he shall first deposit, &c., a printed copy of the title in the clerk's office, &c." "And such author or proprietor shall, within two months from the date thereof, cause a copy of said record to be published in one or more of the newspapers printed in the United States, for the space of four weeks." And the fourth section enacts, that "the author, &c., shall, within six months after the publishing thereof, deliver or cause to be delivered to the secretary of state, a copy of the same to be preserved in his office." The first section of the act of 1802 provides, that "every person who shall claim to be the author, &c., before he shall *be entitled to the benefit of the act entitled 'an act for the encouragement of learning, by securing the copies of maps, charts and books, [*663 to the authors and proprietors of such copies, during the time therein mentioned,' he shall, in addition to the requisites enjoined in the third and fourth sections of said act, if a book or books, give information by causing the copy of the record which by said act he is required to publish, to be inserted in the page of the book next to the title."

These are substantially the provisions by which the complainants' right must be tested. They claim under a renewal of the term, but this necessarily involves the validity of the right under the first as well as the second term. In the language of the statute, the "same exclusive right" is continued the second term that existed the first.

It will be observed, that a right accrues, under the act of 1790, from the time a copy of the title of the book is deposited in the clerk's office. But the act of 1802 adds another requisite to the accruing of the right, and that

is, that the record made by the clerk, shall be published in the page next to the title-page of the book. And it is argued with great earnestness and ability, that these are the only requisities to the perfection of the complainant's title. That the requisition of the third section, to give public notice in the newspapers, and that contained in the fourth, to deposit a copy in the department of state, are acts subsequent to the accruing of the right, and whether they are performed or not, cannot materially affect the title. The case is compared to a grant with conditions subsequent, which can never operate as a forfeiture of the title. It is said, also, that the object of the publication in the newspapers, and the deposit of the copy in the department of state was merely to give notice to the public; and that such acts, not being essential to the title, after so great a lapse of time, may well be presumed. That if neither act had been done, the right of the party having accrued, before either was required to be done, it must remain unshaken.

This right, as has been shown, does not exist at common law—it originated, if at all, under the acts of congress. No one can deny, that when the legislature are about to vest an exclusive right in an author or an inventor, they have the *power to prescribe the conditions on which such right shall be enjoyed; and that no one can avail himself of such right who does not substantially comply with the requisitions of the law. This principle is familiar, as it regards patent-rights; and it is the same in relation to the copyright of a book. If any difference shall be made, as it respects a strict conformity to the law, it would seem to be more reasonable, to make the requirement of the author, rather than the inventor. The papers of the latter are examined in the department of state, and require the sanction of the attorney-general; but the author takes every step on his own responsibility, unchecked by the scrutiny of sanction of any public functionary.

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The acts required to be done by an author, to secure his right, are in the order in which they must naturally transpire. First, the title of the book is to be deposited with the clerk, and the record he makes must be inserted in the first or second page; then the public notice in the newspapers is to be given; and within six months after the publication of the book, a copy must be deposited in the department of state. A right undoubtedly accrues, on the record being made with the clerk, and the printing of it as required; but what is the nature of that right. Is it perfect? If so, the other two requisities are wholly useless. How can the author be compelled either to give notice in the newspaper, or deposit a copy in the state department? The statute affixes no penalty for a failure to perform either of these acts; and it provides no means, by which it may be enforced.

But we are told, they are unimportant acts. If they are, indeed, wholly unimportant, congress acted unwisely in requiring them to be done. But whether they are important or not, is not for the court to determine, but the legislature; and in what light they were considered by the legislature, we can learn only by their official acts Judging then of these acts, by this rule, we are not at liberty to say they are unimportant, and may be dispensed with. They are acts which the law requires to be done, and may this court dispense with their performance?

But the inquiry is made, shall the non-performance of these subsequent conditions operate as a forfeiture of the right? *The answer is, that this is not a technical grant on precedent and subsequent condi-

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tions. All the conditions are important; the law requires them to be performed; and, consequently, their performance is essential to a perfect title. On the performance of a part of them, the right vests; and this was essential to its protection under the statute; but other acts are to be done, unless congress have legislated in vain, to render the right perfect. The notice could not be published, until after the entry with the clerk, nor could the book be deposited with the secretary of state, until it was published. But these are acts not less important than those which are required to be done previously. They form a part of the title, and until they are performed, the title is not perfect. The deposit of the book in the department of state, may be important to identify it, at any future period, should the copyright be contested, or an unfounded claim of authorship asserted.

But if doubts could be entertained, whether the notice and deposit of the book in the state department, were essential to the title, under the act of 1790; on which act my opinion is principally founded; though I consider it in connection with the other act; there is, in the opinion of three of the judges, no ground for doubt, under the act of 1802. The latter act declares that every author, &c., before he shall be entitled to the benefit of the former act, shall, "in addition to the requisitions enjoined in the third and fourth sections of said act, if a book, publish," &c. Is not this a clear exposition of the first act? Can an author claim the benefit of the act of 1790, without performing "the requisites enjoined in the third and fourth sections of it." If there be any meaning in language, the act of 1802, the three judges think, requires these requisites to be performed "in addition" to the one required by that act, before an author, &c. "shall be entitled to the benefit of the first act."

The rule by which conditions precedent and subsequent are construed, in a grant, can have no application to the case under consideration; as every requisite, in both acts, is essential to the title. A renewal of the term of fourteen years can only be obtained *by having the title-page recorded with the clerk, and the record published on the page next [*666 to that of the title, and public notice given within six months before the expiration of the first term.

In opposition to the construction of the above statutes, as now given, the counsel for the complainants referred to several decisions in England, on the construction of the statute of 8 Anne, and other statutes. In the case of *Beckford* v. *Hood*, 7 T. R. 620, the court of king's bench decided, "that an author, whose work is pirated, before the expiration of twenty-eight years from the first publication of it, may maintain an action on the case for damages, against the offending party, although the work was not entered at Stationers' Hall." But this entry was necessary only to subject the offender to certain penalties, provided in the statute of 8 Anne. The suit brought was not for the penalties, and consequently, the entry of the work at Stationers' Hall, was not made a question in the case. In the case of *Blackwell* v. *Harper*, 2 Atk. 95, Lord HARDWICKE is reported to have said, upon the act of 8 Ann., c. 19, "the clause of registering with the Stationers' Company, is relative to the penalty, and the property cannot vest without such entry;" for the words are, "that nothing in this act shall be construed to subject any bookseller, &c., to the forfeitures, &c., by reason of printing any book, &c., unless the title to the copy of such book, here-

after published, shall, before such publication, be entered in the register book of the Company of Stationers." The very language quoted by his lordship shows, that the entry was not necessary to an investiture of the title, but to the recovery of the penalties provided in the act against those who pirated the work. His lordship decided, in the same case, that "under an act of parliament, providing that a certain inventor shall have the sole right and liberty of printing and reprinting certain prints, for the term of fourteen years, and to commence from the day of first publishing thereof, which shall be truly engraved with the name of the proprietor on each plate, and printed on every such print or prints," the property in the prints vests absolutely in the engraver, though the day of publication is not mentioned.

*667] *The authority of this case is seriously questioned in the case of *Newton* v. *Cowie*, 4 Bing. 241. And it would seem, from the decision of Lord HARDWICKE, that he had doubts of the correctness of the decision, as he decreed an injunction, without by-gone profits. And Lord ALVANLEY, in the case of *Harrison* v. *Hogg*, cited in 4 Bing. 242, said "that he was glad he was relieved from deciding on the same act, as he was inclined to differ from Lord HARDWICKE."

By a reference to the English authorities, in the construction of statutes, somewhat analogous to those under which the complainants set up their right, it will be found, that the decisions often conflict with each other; but it is believed, that no settled construction has been given to any British statute, in all respects similar to those under consideration, which is at variance with the one now given. If, however, such an instance could be found, it would not lessen the confidence we feel in the correctness of the view which we have taken.

The act of congress under which Mr. Wheaton, one of the complainants, in his capacity of reporter, was required to deliver eighty copies of each volume of his reports to the department of state, and which were, probably, faithfully delivered, does not exonerate him from the deposit of a copy under the act of 1790. The eighty volumes were delivered for a different purpose; and cannot excuse the deposit of the one volume as specially required.

The construction of the acts of congress being settled, in the further investigation of the case, it would become necessary to look into the evidence and ascertain whether the complainants have not shown a substantial compliance with every legal requisite. But on reading the evidence, we entertain doubts, which induce us to remand the cause to the circuit court, where the facts can be ascertained by a jury. And the case is accordingly remanded to the circuit court, with directions to that court to order an issue of facts to be examined and tried by a jury, at the bar of said court, upon this point, viz., whether the said Wheaton, as author, or any other person, as proprietor, had complied with the requisites prescribed by the third and fourth sections of the said act of congress, passed the 31st day of May 1790, in regard to the volumes of Wheaton's reports in the said bill mentioned, or

*668] in *regard to one or more of them in the following particulars, viz., whether the said Wheaton, or proprietor, did, within two months from the date of the recording thereof in the clerk's office of the district court, cause a copy of the said record to be published in one or more of the newspapers printed in the resident states, for the space of four weeks; and

whether the said Wheaton, or proprietor, after the publishing thereof, did deliver or cause to be delivered to the secretary of state of the United States, a copy of the same, to be preserved in his office, according to the provisions of the said third and fourth sections of the said act. And if the said requisites have not been complied with in regard to all the said volumes, then the jury to find in particular in regard to what volumes they or either of them have been so complied with.

It may be proper to remark, that the court are unanimously of opinion, that no reporter has or can have any copyright in the written opinions delivered by this court; and that the judges thereof cannot confer on any reporter any such right.

THOMPSON, Justice. (*Dissenting.*)—It is matter of regret with me, at any time to dissent from an opinion pronounced by a majority of this court, and where my mind is left balancing, after a full examination of the case, my habitual respect for the opinion of my brethren may justify a surrender of my own. But where no such apology is left to me to rest upon, it becomes a duty to adhere to my own opinion; and I shall proceed to assign the reasons which have led me to a conclusion different from that at which a majority of the court has arrived.

It is unnecessary for me to state anything more with respect to the bill and answer, than barely to observe, that the complainants in the court below rest their claim, both upon the statutory and the common-law right. The bill charges, that all the provisions of the acts of congress have been complied with; that everything has been done which was required by those acts, in order to entitle them to the benefit thereof; and that if it were otherwise, the orator, Henry Wheaton, has, as the author of said reports, the property in the copy of the same, and the sole right to enjoy and dispose of the same.

*It would be improper, in the present stage of this cause, to examine the evidence which was before the court below, touching certain [*669
questions of fact which it is alleged are required by the acts of congress in order to entitle the complainants to the benefit of those acts, have been complied with. An issue has been directed to inquire into those matters. Nor is it deemed necessary to examine whether the publication of the Condensed reports by the defendants, is a violation of the complainants' copyright, if they have complied with all the requisites of the acts of congress. This would seem necessarily implied, by the ordering of the issue; for such inquiries would be useless, if the right secured under those acts has not been violated. I shall, therefore, confine myself to an examination of the common-law right, and the effect and operation of the acts of congress upon such right.

I think, I may assume as a proposition not to be questioned, that in England, prior to the statute of Anne, the right of an author to the benefit and profit of his work, is recognised by the common law. No case has been cited on the argument, and none has fallen under my observation, at all throwing in doubt this general proposition. Whenever the question has been there agitated, it has been in connection with the operation of the statute upon this right. The case of *Millar* v. *Taylor*, 4 Burr. 2303, decided in the year 1769, was the first determination in the court of king's bench

upon the common-law right of literary property. In that case, the broad question is stated and examined, whether the copy of a book or literary composition belongs to the author by the common law; and three of the judges, including Lord MANSFIELD, decided in the affirmative. Mr. Justice YATES dissented. But I am not aware, that upon this abstract question, a contrary decision has ever been made in England. This would seem to be sufficient to put at rest that general question, and render it unnecessary to go into a very particular examination of the reasons and grounds upon which the decision was founded. The elaborate examination bestowed upon the question by the judges in that case, has brought into view, on both sides of the question, the main arguments of which the point is susceptible. The great
*670] principle on which the author's right rests, is, that it is the *fruit or production of his own labor, and which may, by the labor of the faculties of the mind, establish a right of property, as well as by the faculties of the body; and it difficult to perceive any well-founded objection to such a claim of right. It is founded upon the soundest principles of justice, equity and public policy. Blackstone, in his Commentaries, 2d vol. 405, has succinctly stated the principle, that when a man, by the exertion of his rational powers, has produced an original work, he seems to have clearly a right to dispose of that identical work as he pleases; and any attempt to vary the disposition he has made of it, appears to be an invasion of that right. That the identity of a literary composition consists entirely in the sentiment and the language. The same conception, clothed in the same words, must necessarily be the same composition; and whatever method be taken to exhibit that composition to the ear or to the eye of another, by recital, by writing, or by printing, in any number of copies, or at any period of time, it is always the identical work of the author which is so exhibited; and no other man, it has been thought, can have a right to exhibit it, especially for profit, without the author's consent. The origin of this right is not probably to be satisfactorily ascertained, and indeed, if it could, it might be considered an objection to its existence as a common-law right; but from the time of the invention of printing, in the early part of the fifteenth century, such a right seems to have been recognised. The historical account of the recognition of the right, is to be collected from the discussions in *Millar* v. *Taylor*. The Stationers' Company was incorporated in the year 1556, and from that time to the year 1640, the crown exercised an unlimited authority over the press, which was enforced by the summary process of search, confiscation and imprisonment, given to the Stationers' Company, and executed by the then supreme jurisdiction of the star chamber.[1] In the year 1640, the star chamber was abolished; and the existence of copyrights, before that period, upon principles of usage, can only be looked for in the Stationers' Company, or the star chamber, or acts of state; and the evidence on this point, says Mr. Justice WILLES, is liable to little suspicion. It was indifferent to the views of government, whether the property of an innocent book licensed, was open or private property.

*671] *It was certainly against the power of the crown to allow it as private property, without being protected by any royal privilege. It

[1] A Knight of the county of Northumberland was fined in a great summ, in the starr chamber, because hee permitted a seditious booke, called "Martin Marprelate" to be printed in his house; 32 Eliz. Star Chamber Cases 29.

could be done only on principles of private justice, moral fitness and public convenience, which, when applied to a new subject, make common law, without a precedent ; much more, when received and approved by usage. And in this case of *Millar* v. *Taylor*, it was found by the special verdict, " that before the reign of her late majesty, Queen Anne, it was usual to purchase from authors the perpetual copyright of their books, and to assign the same, from hand to hand, for valuable consideration, and to make the same the subject of family settlements, for the provision of wives and children." This usage is evidence of the common law, and shows that the copyright was considered and treated as property, transferrible from party to party ; and property, too, of a permanent nature, suitable for family settlement and provisions.

Common law, says Lord COKE (1 Inst. 1–2), is sometimes called right, common right, common justice. And Lord MANSFIELD says, the common law is drawn from the principles of right and wrong, the fitness of things, convenience and policy. And it is upon these principles, that the copyright of authors is protected. After the year 1640, when the press became subject to license, the various ordinances and acts of parliament referred to in *Millar* v. *Taylor*, and collected in Maugham's treatise on the Law of Literary Property, p. 13–16, necessarily imply, and presuppose, the existence of a common-law right in the author.

The common law, says an eminent jurist, 2 Kent's Com. 471, includes those principles, usages and rules of action, applicable to the government and security of person and property which do not rest for their authority upon any express and positive declaration of the will of the legislature. A great proportion of the rules and maxims which constitute the immense code of the common law, grew into use by gradual adoption, and received, from time to time, the sanction of the courts of justice, without any legislative act or interference. It was the application of the dictates of natural justice, and of cultivated reason, to particular cases. In the just language of Sir MATTHEW HALE, the common law of England is not the product of the wisdom of some one man, or society of men, in any *one age, but of the wisdom, counsel, experience and observation of many ages of [*672 wise and observing men. And, in accordance with these sound principles, and as applicable to the subject of copyright, are the remarks of Mr. Christian, in his notes to Blackstone's Commentaries (2 Bl. Com. 406, and note). Nothing, says he, is more erroneous, than the practice of referring the origin of moral rights, and the system of natural equity, to the savage state, which is supposed to have preceded civilized establishments, in which literary composition, and, of consequence, the right to it, could have no existence. But the true mode of ascertaining a moral right, is to inquire whether it is such as the reason, the cultivated reason of mankind, must necessarily assent to. No proposition seems more conformable to that criterion, than that every one should enjoy the reward of his labor, the harvest where he has sown, or the fruit of the tree which he has planted. Whether literary property is *sui generis*, or under whatever denomination of rights it may be classed, it seems founded upon the same principle of general utility to society, which is the basis of all other moral rights and obligations. Thus considered, an author's copyright ought to be esteemed an invaluable right, established in sound reason and abstract morality.

It is unnecessary, for the purpose of showing my views upon this branch of the case, to add anything more. In my judgment, every principle of justice, equity, morality, fitness and sound policy concurs in protecting the literary labors of men, to the same extent that property acquired by manual labor is protected. The objections to the admission of the common-law right of authors, are generally admitted to be summed up, in all their force and strength, by Mr. Justice YATES, in the case of *Millar* v. *Taylor*. These objections may be classed under two heads: the one founded upon the nature of the property or subject-matter of the right claimed; and the other, on the presumed abandonment of the right by the author's publication.

The first appears to me to be too subtle and metaphysical to command the assent of any one, or to be adopted as the ground of deciding the question. It seems to be supposed, that the right claimed is to the ideas contained in the book. The claim, says Mr. Justice YATES, is to the style and ideas of the author's composition; and it is a well-established maxim, that *673] *nothing can be an object of property, which has not a corporal substance. The property claimed is all ideal; a set of ideas which have no bounds or marks whatever—nothing that is capable of a visible possession—nothing that can sustain any one of the qualities or incidents of property. Their whole existence is in the mind alone. Incapable of any other modes of acquisition and enjoyment than by mental possession or apprehension; safe and invulnerable from their own immateriality, no trespass can reach them, no tort affect them; no fraud or violence diminish or damage them. Yet these are the phantoms which the author would grasp and confine to himself; and these are what the defendant is charged with having robbed the plaintiff of. He asks, can sentiments themselves (apart from the paper on which they are contained) be taken in execution for a debt; or if the author commits treason or felony, or is outlawed, can the ideas be forfeited? Can sentiments be seized; or, by any act whatever, be vested in the crown? If they cannot be seized, the sole right of publishing them cannot be confined to the author. How strange and singular, says he, must this extraordinary kind of property be, which cannot be visibly possessed, forfeited or seized, nor is susceptible of any external injury, nor, consequently, of any specific or possible remedy. These, and many other similar declarations are made by Mr. Justice YATES, to illustrate his view of the nature of a copyright. And he seems to treat the question, as if the claim was to a mere idea, not embodied or exhibited in any tangible form or shape. No such pretension has ever been set up, that I am aware of, by any advocate of the right to literary property. And this view of it would hardly deserve a serious notice, had it not been taken by a distinguished judge. Lord MANSFIELD, in the case of *Millar* v. *Taylor*, in defining the nature of the right or copyright, says, "I use the word copy in the technical sense in which that name or term has been used for ages, to signify an incorporeal right to the sole printing and publishing of something intellectual, communicated by letters;" and this is the sense in which I understand the term copyright always to be used, when spoken of as property.

The other objection urged by Mr. Justice YATES, that the publication by the author is an abandonment of the exclusive *right, rests upon *674] more plausible grounds, but is equally destitute of solidity. This would seem, according to his view of the case, the main point in the cause.

The general question, he says, is, whether, after a voluntary and *general* publication of an author's work by himself, or by his authority, the author has a sole and perpetual property in that work, so as to give him a right to confine every subsequent publication to himself, or his assigns, for ever. And he lays down this general proposition: That the right of publication must for ever depend on the claimant's property in the thing to be published. Whilst the subject of publication continues his own exclusive property, he will so long have the sole and perpetual righth to publish it. But whenever that property ceases, or by any act or event becomes common, the right of publication will be equally common. The particular terms in which Mr. Justice YATES states his proposition, are worthy of notice. He puts the case upon its being a *general* publication, the meaning of which undoubtedly is, that the publication is without any restriction, expressed or implied, as to the use to be made of it by the party into whose hands it might come, by purchase or otherwise. Unless such was his meaning, the proposition, I presume, no one will contend, can be maintained. Suppose, an express contract made with a party who shall purchase a book, that he shall not republish it; this surely would be binding upon him. So, if the bookseller should give a like notice of the author's claim, and a purchase of a book made, without any express stipulation not to republish, the law would imply an assent to the condition. And any circumstances from which such an undertaking could be reasonably inferred, would lead to the same legal consequences. The nature of the property, and the general purposes for which it is published and sold, show the use which is to be made of it. The usual and common object which a person has in view in the purchase of a book is for the instruction, information or entertainment to be derived from it, and not for republication of the work. It is the use of it for these purposes which is implied in the sale and purchase. And this use is in subordination to the antecedent and higher right of the author; and comes strictly within the maxim, *sic utere *tuo ut alienum non lædas.* But the case is not left to rest on any implied notice of the author's claim, [*675 and the conditions on which he makes it public. This is contained on the title-page of the very book purchased, and cannot be presumed to escape the notice of the purchaser. It is there, in terms, announced, that the author claims the right of publication; and whoever purchases, therefore, does it with notice of such claim, and is bound to use it in subordination thereto. Mr. Justice YATES admits, that every man is entitled to the fruits of his own labor; but that he can be entitled to it only subject to the general rights of mankind, and the general rules of property; and that there must be a limitation to such right, otherwise the rights of others are infringed. The force of such limitation upon the right, is not readily perceived. If the right exist, it is a common-law right, growing out of the natural justice of the case; being the result of a man's own labor. He thinks the statute of Anne fixes a just limitation. But suppose, no statute had been passed on the subject; where would have been the limitation? The right existing, who would have authority to say where it should end? It must necessarily be without limitation, and it is no infringement of the rights of others. They enjoy it for the purpose intended, and according to the nature of the property. The purchaser of the book has a right to all the benefit resulting from the information or amusement he can derive from it. And

if, in consequence thereof, he can write a book on the same subject, he has a right so to do. But this is a very different use of the property, from the taking and publishing of the very language and sentiment of the author; which constitute the identity of his work. Mr. Justice YATES puts the effect of a publication, upon the ground of intent in the author. The act of publication, says he, when voluntarily done by the author, is virtually and necessarily a gift to the public. And he must be deemed to have so intended it. But no such intention can surely be inferred, when the contrary intention is inscribed upon the first page of the book, which cannot escape notice.

The case of *Percival* v. *Phipps*, 2 Ves. & Beam. 19, recognises the implied prohibition against publishing the work of another, arising from the very nature of the property. It was held, in that case, that private letters, having the character *of literary composition, were within the spirit of the act protecting literary property, and that by sending a letter, the writer did not give the receiver authority to publish it; and this is the doctrine of Lord HARDWICKE, in *Pope* v. *Curl*, 2 Atk. 342, where it is said, that familiar letters may form a literary composition, in which the author retains his copyright, and does not, by sending them to the person to whom they are addressed, authorize him, or a third person, to use them for the purpose of profit, by publishing them, against the interest and intention of the author. That by sending the letter, though he parts with the property of the paper, he does not part with the property of copyright in the composition.

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But how stands the case, with respect to the effect of publication by the author, according to Mr. Justice YATES's own rule. He says, "in all abandonments of such kind of property, two circumstances are necessary," an actual relinquishing of the possession, and an *intention* to relinquish it. That the author's name being inserted in the title-page is no reason against the abandonment; for many of our best and noblest authors have published their works from more generous views than pecuniary profit. Some have written for fame, and the benefit of mankind. That the omission of the author's name can make no difference; for, if the property be absolutely his, he has no occasion to add his name to the title-page. He cannot escape, it seems, from calling the copyright *property*, although a mere *idea;* and resorts again to his favorite theory, that it has no *indicia*, no distinguishing marks, to denote his proprietary interest therein; and hard, says he, would be the law, that should adjudge a man guilty of a crime, when he had no possibility of knowing that he was doing the least wrong to any individual. That he could not know who was the proprietor of these intellectual ideas, they not having any ear-marks upon them, or tokens of a particular proprietor.

If, as Mr. Justice YATES admits, it is a question of *intention* whether the author meant to abandon his work to the public, and relinquish all private or individual claims to it, no possible doubt can exist as to the conclusion in the present case. Would a jury hesitate a moment upon the question, under the evidence before the court? The right set up and stamped upon the title-page of the book, shuts the door against any *inference, that the publication was intended to be a gift to the public. Mr. Justice YATES admits, that so long as a literary composition is in manuscript, and remains

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under the sole dominion of the author, it is his exclusive property. It would seem, therefore, that the *idea*, when once reduced to writing, is susceptible of identity, and becomes the subject of property. But property, without the right to use it, is empty sound, says Mr. Justice ASTON, in *Millar* v. *Taylor*. And, indeed, it would seem a mere mockery for the law to recognise anything as property, which the owner could not use safely and securely for the purposes for which it was intended, unless interdicted by the principles of morality or public policy.

It is not necessary that I should go into any particular examination of the construction of the statute of Anne, or to what extent it may effect the common-law right of authors in England; because, as I shall hereafter show, that statute was never considered in force in Pennsylvania. The mere common-law right, uninfluenced by that statute, is alone drawn in question under this branch of the case. And the decision in the case of *Millar* v. *Taylor*, would seem to put that question at rest in England, at that day. Mr. Justice YATES, in aid of his opinion, relied much upon that statute; arguing that, from the title, which is an "act for the encouragement of learning, by *vesting* the copies of printed books in the authors or purchasers of such copies, during the times therein mentioned;" and from the provision in the act, that the sole right should be vested, &c. for twenty-one years, and no longer; the right was created, and limited by the act, and did not rest upon the common law. The other three judges, however, maintained, that an author's right was not derived from the statute, but that he had an original perpetual common-law right and property in his work, and that the statute was only cumulative, and giving additional remedies for a violation of the right. That the preamble in the act proceeds upon the ground of a right of property in the author having been violated; and that the act was intended as a confirmation of such right. And that, from the remedy enacted against the violation of the right being only temporary, it might be argued, that it afforded an implication, that there existed no right but what was *secured by the act. To guard against which, there is an express saving [*678 in the ninth section of the art. "Provided, that nothing in this act contained, shall extend, or be construed to extend, either to prejudice or confirm any right, that the said universities or any of them, or any person or persons, have or claim to have to the printing or reprinting, any book or copy already printed or hereafter to be printed." That the words *any* right, manifestly meant any *other* right, than the term secured by the act. It may be observed here, that whatever may be the just weight to be given to the term "vested," and the words "no longer," as used in the statute of Anne, and so much relied on by Mr. Justice YATES, have no application to our acts of congress; no such term or provision being used.

A writ of error was brought in this case of *Millar* v. *Taylor*, but afterwards abandoned, and the law was considered settled, until called in question in *Donaldson* v. *Beckett*, 4 Burr. 2408, which came before the house of lords, in the year 1774, upon an appeal from a decree of the court of chancery, founded upon the judgment in *Millar* v. *Taylor*. Upon this appeal, certain questions were propounded to the twelve judges. Lord MANSFIELD, however, gave no opinion, it being very unusual, as the reporter states, from reasons of delicacy, for a peer to support his own judgment upon appeal to the house of lords. This statement necessarily implies, however, that he

had not changed his opinion. There were, therefore, eleven judges who voted upon the questions. One of the questions propounded was: whether, at common law, an author of any book or literary composition, had the sole right of first printing and publishing the same for sale, and might bring an action against any person who printed, published and sold the same, without his consent? Upon this question, ten voted in the affirmative, and one in the negative. Another question was: if the author had such right originally, did the law take it away upon his printing and publishing such book or literary composition, and might any person, afterwards, reprint and sell, for his own benefit, such book or literary composition, against the will of the author? Upon this question, seven were in the negative, and four in the
*679] affirmative. *The vote upon these two questions settled the point, that, by the common law, the author of any literary composition, and his assigns, had the sole right of printing and publishing the same in perpetuity.

Another question propounded was: if an action would have lain, at common law, is it taken away by the statute of Anne? and is an author, by the said statute, precluded from every remedy, except on the foundation of the statute, and on the terms and conditions prescribed thereby? Upon this question, six voted in the affirmative, and five in the negative; and it will be perceived, that if Lord MANSFIELD had voted on this question, and in conformity with his opinion in *Millar* v. *Taylor*, the judges would have been equally divided.

That the law in England has not been considered as settled, in conformity with the vote on this last question, is very certain. For it is the constant practice, in chancery, to grant injunctions to restrain printers from publishing the works of others, which practice can only be sustained, on the ground that the penalties given by the statute, are not the only remedy that can be resorted to. In *Millar* v. *Taylor*, Lord MANSFIELD says, the whole jurisdiction exercised by the court of chancery, since 1710, the date of the statute of Anne, against pirates of copies, is an authority that authors had a property antecedent, to which the act gives a temporary additional security. It can stand upon no other foundation. And in the case of *Beckford* v. *Hood*, 7 T. R. 616, it was decided, that an author, whose work is pirated before the expiration of the time limited in the statute, may maintain an action on the case for damages, against the offending party. Lord KENYON says, the question is, whether the right of property being vested in authors for certain periods, the common-law remedy for a violation of it, does not attach within the time limited by the act of parliament? Within those periods, the act says, that the author shall have the sole right and liberty of printing, &c. Thus, the statute having vested that right in the author, the common law gives the remedy by action, in the case for violation of it; and that the meaning of the act in creating the penalties, was to give an accumulative remedy. And in this all the judges concurred. And Mr. Justice GROSE
*680] *observes, that in the great case of *Millar* v. *Taylor*, Mr. Justice YATES gave his opinion against the common-law right of authors; but he was decidedly of opinion, that an exclusive right of property was vested by the statute, for the time limited; and he says, that by the decision in the house of lords, of *Donaldson* v. *Beckett*, the common-law right of action is not considered as taken away by the statute of Anne, but that it

could not be exercised beyond the time limited by that statute: and it is worthy of notice, that this action on the case, for damages, was sustained, although the work was not entered at Stationers' Hall, nor the author's name affixed to the first publication. This, Lord KENYON observes, was to serve as a notice and warning to the public, that none might ignorantly incur the penalties and forfeitures given against such as pirate the works of others. But calling on a party who has injured the civil property of another, for a remedy in damages, cannot properly fall under the description of a forfeiture or penalty.

From this view of the law, as in stands in England, it is very clear, that, previous to the statute of Anne, the perpetual common-law right of authors, was undisputed. That after that statute, in the case of *Millar* v. *Taylor*, it was held, that this common-law right remained unaffected by the statute, which only gave a cumulative remedy. That the subsequent case of *Donaldson* v. *Beckett* limited the right to the times mentioned in the statute. But that for all violations of the right, during that time, all the common-law remedies continued, although no entry of the work at Stationers' Hall had been made, according to the provisions of the statute. Such entry being necessary, only for the purpose of subjecting the party violating the right, to the penalties given by the act.

I do not deem it necessary particularly to inquire, whether, as an abstract question, the same reasons do not exist for the protection of mechanical inventions, as the production of mental labor. The inquiry is not, whether it would have been wise to have recognised an exclusive right to the mechanical inventions. It is enough, when we are inquiring what the law is, and not what it ought to have been, to find that no such principle ever has been recognised by any judicial decision. The argument was urged with great earnestness by Mr. Justice YATES, in *Millar* v. *Taylor*, but repudiated by Lord MANSFIELD and the other *judges. With respect to copy- [*681
rights, however, the law has been considered otherwise; and the original common-law right fully established, though modified in some respects by the statute of Anne.

I shall proceed, now, to some notice of the light in which copyrights have been viewed in this country. It appears from the journals of the old congress (8 Journ. 257), that this question was brought before that body by sundry papers and memorials on the subject of literary property; and which were referred to a committee, of which Mr. Madison was one; and on the 27th of May 1783, the following resolution was reported and adopted. "Resolved, that it be recommended to the several states, to *secure* to the authors or publishers of any new books, not hitherto printed, being citizens of the United States, and to their executors, administrators and assigns, the copyright of such books, for a certain time, not less than fourteen years from the first publication; and to *secure* to the said authors, if they shall survive the term first mentioned, and to their executors, administrators and assigns, the copyright of such books for another term or time, not less than fourteen years; such copy or exclusive right of printing, publishing and vending the same, to be *secured* to the original authors or publishers, their executors, administrators and assigns, by such laws and such restrictions, as to the several states may seem proper." This right is here treated and dealt with as property already existing; and not as creating anything which had

previously no being. It is spoken of as something tangible, that might pass to executors and administrators, and transferable by assignment. And the recommendation to the state was, to pass laws to *secure* such a right.

It must be presumed, that congress understood the light in which this subject was viewed in the mother country. And it is deserving of notice, that Mr. Madison, one of the committee, afterwards wrote the number in the Federalist, where this subject is discussed; and where it is expressly asserted, that this has been adjudged in England to be a right at common law. And it is worthy of remark also, that no mention is here made of any right in mechanical inventions: and although the arts and sciences are connected in the same clause in the constitution *and placed under the
*682] legislative power of congress, it does not, by any means follow, that they were considered as standing on the same footing.

Several of the states had already passed laws on this subject; and many others, in compliance with the recommendation of congress, did the same. The state of Massachusetts, as early as March 1783, passed a law, entitled, "an act for the purpose of *securing* to authors, the exclusive right and benefit of publishing their literary productions for twenty-one years." The preamble to this act shows, in a strong and striking manner, the views entertained, at that day, in this enlightened state, of the value of this right. "Whereas, the improvement of knowledge, the progress of civilization, the public weal of the community, and the advancement of human happiness, greatly depend on the efforts of learned and ingenious persons, in the various arts and sciences; as the principal encouragement such persons can have, to make great and beneficial exertions of this nature, must exist in the legal security of the fruits of their study and industry to themselves; and as such security is one of the natural rights of all men, there being no *property* more peculiarly a man's own, than that which is produced by the labor of his mind: therefore, to encourage learned and ingenious persons to write useful books, for the benefit of mankind, be it enacted," &c. The act then proceeds to declare, that all books, treatises and other literary works &c., shall be the sole property of the author or authors, being subjects of the United States of America, their heirs and assigns, for the full and complete term of twenty-one years from the date of their first publication. And certain penalties are affixed to a violation of the right, with a proviso, that the act shall not be construed to extend in favor, or for the benefit, of any author, or subject of any other of the United States, until the state of which such author is a subject, shall have passed similar laws for securing to authors the exclusive right and benefit of publishing their literary productions. (1 Laws Mass. 94.) This act recognises in the fullest and most unqualified manner, the natural right which an author has to the productions and labor of his own mind. And it is worthy of notice, that the act does
*683] not recognise as a natural right, or in any manner *provide for the protections of mechanical inventions; thereby showing the distinction between mental and manual labor, in the view of that legislature, although it is now attempted to put them on the same footing.

The state of Connecticut had, previously, in the same year (January 1783), passed an act for the encouragement of literature and genius, containing the following preamble: "whereas, it is perfectly agreeable to the principles of natural justice and equity, that every author should be *secured*

in receiving the profits that may arise from the sale of his works; and such security may encourage men of learning and genius to publish their writings, which may do honor to their country, and service of mankind." Certain provisions are then made for the security of such right, which it is unnecessary here to be particularly noticed. There is a like proviso, as in the Massachusetts act, that the benefit of the law is not to extend to authors, inhabitants of, or residing in other states, until such states have passed laws. (Statutes of Conn. 474.) This law is also confined to literary productions, and in no manner extending to mechanical labors.

In the colony of New York, in the year 1786, a law, "to promote literature" was passed, "whereas, it is agreeable to the principles of natural equity and justice, that every author should be *secured* in receiving the profits that may arise from the sale of his works; and such security may encourage persons of learning and genius to publish their writings, which may do honor to their country, and service to mankind;" and then making provision, for securing to authors the sole right of printing, publishing and selling their works for fourteen years. With a proviso to the fourth section of the act, recognising a common-law right; but leaving it open and unaffected in cases not coming within the act, viz: "Provided, that nothing in this act shall extend to, affect, prejudice or confirm the rights which any person may have to the printing or publishing of any books or pamphlets, at common law, in cases not mentioned in this act."

The state of Virginia also, in the year 1785, passed a similar law, for *securing* to authors of literary works, an exclusive property therein, for a limited time. (1 Rev. Code 534.) Like *laws for the same purpose were passed by other states, which are not necessary here to be noticed; enough having been referred to, to show the light in which literary property was viewed in this country; and that such laws were passed, with a view to protect and secure a pre-existing right, founded on the eternal rules and principles of natural right and justice, and recognised by the common law.[1] [*684

But under the existing governments of the United States, before the adoption of the present constitution, adequate protection could not be given to authors, throughout the United States, by any general law. It depended on the legislatures of the several states; and this led to the provisions in the present constitution, giving to congress power "to promote the progress of science and the useful arts, by securing, for limited times, to authors and inventors, the exclusive right to their respective writings and discoveries." Const. art. 1, § 8.

It has been argued at the bar, that, as the promotion of the progress of science and the useful arts, is here united in the same clause in the constitution, the rights of authors and inventors were considered as standing on the same footing; but this, I thing, is a *non sequitur*. This article is to be

[1] See the Pennsylvania copyright act of 15th March 1784, P. L. 306, which does not appear to have been noticed, thought more extensive in its provisions than the act of the federal legislature. Possibly, this statute never went into operation, as the 7th section provides, that it shall not take effect until such time as all and every of the states in the Union shall have passed similar laws in conformity to the recommendation of congress. Nevertheless, many Pennsylvania books are extant, which were copyrighted in pursuance of this statute For one instance, see 4 Lloyd's Debates, 1788.

construed distributively, and must have been so understood; for when congress came to execute this power by legislation, the subjects are kept distinct, and very different provisions are made respecting them. All the laws relative to inventions, purport to be acts to promote the progress of the useful arts. They do not use any language which implies or pre-supposes any existing prior right to be secured; but clearly imply, that the whole exclusive right is created by the law, and ends with the expiration of the patent. The first law, passed in the year 1790 (1 U. S. Stat. 109), requires that the specification shall be so particular, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman, or other person skilled in the art or manufacture, to make, construct or use the same, to the end that the public may have the full benefit thereof, after the expiration of the patent term. This is the consideration demanded by the public, for the protection during the time mentioned in the patent; and the books furnish no case, that I am aware of, where an *action has been attempted to be sustained upon any supposed common-law right of the inventor. But the case is quite different with respect to copyrights. All the laws on this subject purport to be made for *securing* to authors and proprietors such copyright. They pre-suppose the existence of a right, which is to be secured, and not a right originally created by the act. The security provided by the act is for a limited time. But there is no intimation that, at the expiration of that time, the copy becomes common, as in the case of an invention. The right, at the expiration of the time limited in the acts of congress, is left to the common-law protection, without the additional security thrown around it by the statutes; and stands upon the same footing as it did before the statutes were passed. The protection for a limited time, by the aid of penalties against the violators of the right, proceeds upon the ground, that the author, within that time, can so multiply his work, and reap such profits therefrom, as to enable him to rest upon his common-law right, without the extraordinary aid of penal laws.

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In the Federalist, No. 43, written by Mr. Madison, who reported the resolution referred to, in the old congress, this clause in the constitution is under consideration, and the writer observes, "that the utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged in Great Britain, to be a right at common law. The right to useful inventions seems, with equal reason, to belong to the inventors. The public good fully coincides, in both cases, with the claims of individuals. The states cannot separately make effectual provision for either of the cases; and most of them have anticipated the decision of this point, by laws passed at the instance of congress." Although it is here said, that the right to useful inventions seems with equal reason to belong to the inventors, as the copyright to authors; yet it is not pretended, that the common law equally recognises them. But the contrary is necessarily implied, when it is expressly said, that the copyright has been adjudged to be a common-law right, but is silent as to inventors' rights.

The common-law right of authors is expressly recognised by Mr. Justice Story in his Commentaries. In noticing this *article in the constitution, he says, "this power did not exist under the confederation, and its utility does not seem to have been questioned. The copyright of

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authors in their works had, before the revolution, been decided in Great Britain to be a common-law right, and it was regulated and limited under statutes passed by parliament upon that subject." 3 Story's Com. 48. If these statutes do not affect the right, in the case now before the court, it remains and is to be viewed as a common-law right.

The judge in the court below, who decided this case, seems to place much reliance on what he considers a doubt, suggested by Chancellor KENT, as to the existence of the common-law right. Let us see, what he does say. "It was," says he, "for some time, the prevailing and better opinion in England, that authors had an exclusive copyright at common law, as permanent as the property of an estate; and that the statute of Anne, protecting by penalties, that right, for fourteen years, was only an additional sanction, and made in affirmance of the common law. This point came at last to be questioned, and it became the subject of a very serious ligitation in the court of king's bench. It was decided in *Millar* v. *Taylor*, 1769, that every author had a common-law right in perpetuity, independent of statute, to the exclusive printing and publishing his original compositions. The court was not unanimous, and the subsequent decision of the house of lords, in *Donaldson* v. *Beckett*, in February 1774, settled this very ligitated question against the opinion of the king's bench, by establishing, that the common-law right of action, if any existed, could not be exercised beyond the time limited by the statute of Anne (2 Com. 375, 2d ed.). It is here fully admitted, that by the decision in *Millar* v. *Taylor*, every author had a common-law right in perpetuity, to the publishing of his original composition. And, if it was intended to intimate, that the subsequent decision, in *Donaldson* v. *Beckett*, overruled this decision, as to the common-law right, I apprehend, this must be a mistake, according to the report of the case in 4 Burr. I understand the decision there was, by ten of the judges, that at common law, an author had the sole right of first printing and publishing his work, and by seven judges to four, that such right continued after his first publication. It is true, it *was decided by six to five of the judges, that the common-law right of action could not be exercised beyond the [*687 time limited by the statute of Anne. But with the construction of this statute, we have no concern, if it was not in force in Pennsylvania. The settlement of the common-law right is the material point, and that is admitted, by Chancellor KENT, to have been decided in favor of the author. There is certainly considerable obscurity in the report of this case, as to how far it has modified the common-law remedy; this arises, probably, from the manner in which the questions were propounded by the house of lords to the judges.

I do not perceive how it becomes necessary in this case, to decide the question, whether we have here any code of laws, known and regarded as the common law of the United States. This case presents a question respecting the right of property, and in such cases, the state laws form the rules of decision in the courts of the United States; and the case now before the court must be governed by the law of copyright in the state of Pennsylvania. The complainants, though citizens of New York, are entitled to the benefit of those laws, for the protection of their property; and have a right to prosecute their suit in the courts of the United States.

If, by the common law of England, an author has the copyright in his literary compositions, it becomes necessary to inquire, whether that law is in force in the state of Pennsylvania. It was very properly admitted by the court below, on the trial of this cause, that when the American colonies were first settled by our ancestors, it was held, as well by the settlers, as by the judges and lawyers of England, that they brought with them, as a birthright and inheritance, so much of the common law as was applicable to their local situation and change of circumstances; and that each colony judged for itself, what parts of the common law were applicable to its new condition. Mr. Justice STORY recognises the same principle in his Commentaries, vol. 1, 137–40. Englishmen, says he, removing to another country, must be deemed to carry with them those rights and privileges which belong to them in their native country; and that the plantations formed in this
*688] country were to be deemed a part of the ancient dominions, *and the subjects inhabiting them to belong to a common country, and to retain their former rights and privileges. That the universal principle has been (and the practice has conformed to it), that the common law is our birthright and inheritance, and that our ancestors brought hither with them, upon their immigration, all of it which was applicable to their situation. The whole structure of our present jurisprudence stands upon the original foundation of the common law. The old congress, in the year 1774, unanimously resolved, that the respective colonies are entitled to the common law of England. 1 Story's Com. 140, and note.

The colony of Pennsylvania was settled about the year 1682; at which period, and down to the time of the case of *Millar* v. *Taylor*, 1769, the whole course of the British government, as well in parliament, as in the star chamber and court of chancery, proceeded, in relation to the regulation of copyrights, upon the ground of an existing common-law right in authors; and which was so universally acknowledged, that it was not contested in a court of justice until that case; and then solemnly, and upon the most mature deliberation, decided to be a common-law right, notwithstanding the statute of Anne passed in the year 1710. And the subsequent decision of *Donaldson* v. *Beckett*, turned entirely upon the construction of that act, which it was supposed limited the remedy to the time prescribed in the act for the protection of the copyright. So that at the time of the settlement of Pennsylvania, and for nearly a century thereafter, the common-law right, with all the common-law remedies attached to it, was the received and acknowledged doctrine in England. And if the common law was brought into Pennsylvania, by the first settlers, the law of copyright formed a part of it, and was in force there, and has so continued ever since, not having been abolished or modified by any legislature in that state. But the existence of the common law in Pennsylvania, is not left to inference upon the general principles applicable to emigrants, before alluded to; there is positive legislation on the subject.

We find, as early as the year 1718, a law in that colony, with a recital, "whereas, King Charles II., by his royal charter to William Penn, for erecting this country into a province, did declare it to be his will and pleasure,
*689] that the laws for regulating *and governing of property, within the said province, as well for the descent and enjoyment of lands, as for the enjoyment and succession of goods and chattels, and likewise as to

felonies, should be and continue the same as they should be, for the time being, by the general course of the law in the kingdom of England, until the said laws shall be altered by the said William Penn, his heirs and assigns and by the free men of the said province, their delegates or deputies, or the greater part of them; and whereas, it is a settled point, that as the common law is the birthright of all English subjects, so it ought to be their rule in the British dominions. But acts of parliament have been adjudged not to extend to these plantations, unless they are particularly named as such; now, therefore," &c.; and certain statutes relating to crimes are adopted. And this question came under the consideration of the supreme court of that state, in the case of *Morris's Lessee* v. *Vanderen*, 1 Dall. 64, in the year 1782, and Chief Justice McKean, in pronouncing the judgment of the court, says, this state has had her government for above a hundred years, and it is the opinion of the court, that the common law of England has always been in force in Pennsylvania. That all statutes made in Great Britain, before the settlement of Pennsylvania, have no force here, unless they are convenient, and adapted to the circumstances of the country; and that all statutes made since the settlement of Pennsylvania, have no force here, unless the colonies are particularly named; and he adds, that the spirit of the act of 1718 supports this opinion.

With respect to English statutes which have been considered in force in Pennsylvania, we have the most satisfactory evidence, in the report of the judges of the supreme court of that state, made under an act of the legislature passed April 7th, 1807 (3 Binn. 395), by which the judges were required to examine, and report, which of the English statutes are in force in that commonwealth; and upon this subject the report states: "with respect to English statutes, enacted since the settlement of Pennsylvania, it has been assumed, as a principle, that they do not extend here, unless they have been recognised by our acts of assembly, or adopted by long-continued practice in courts of justice. Of the latter description, there are very few; and those, it is supposed, were introduced from a sense of their *evident utility. As English statutes, they had no obligatory force; but, from [*690 long practice, they may be considered as incorporated with the law of our country."

From this view of the law, I think, I have shown, that, by the common law of England, down, at least, to the decision in the case of *Donaldson* v. *Beckett*, an author was considered as having an exclusive right, in perpetuity, to his literary compositions. That this right, as a branch of the common law, was brought into Pennsylvania, with the first settlers, as early as the year 1682. That whatever effect and operation the statute of Anne may have been deemed to have had upon the common law, in England, that statute never having been in force in Pennsylvania, the common-law right remains unaffected by it. And with this view of the law, and the rights of an author, I proceed to consider the acts of congress which have been passed on this subject.

Observing, in the first place, that we are bound to presume that congress understood the nature and character of this claim of authors to the enjoyment of the fruits of their literary labors, and the ground upon which it rested. This is useful and necessary, to conduct us to a right understanding of their legislation. A knowledge of the mischief is necessary, to a just

and correct view of the remedy intended to be applied. But the knowledge of congress on this subject is not left open to presumption. The question, as to its being an exclusive and perpetual right, was brought directly to the view of congress. Three acts have been passed on this subject; and being not only *in pari materiâ*, but connected with each other by their very titles and objects, are to be construed together, and explained by each other. The last act on the subject was passed in the year 1831, and is entitled "an act to amend the several acts respecting copyrights, approved February 3d, 1831." And the report of the judiciary committee, to whom the subject was referred, shows in what point of light the subject was presented to congress.

"Your committee," says the report, "believe, that the just claims of authors, require from our legislation a *protection*, not less than what is proposed in the bill reported. From the first principles of proprietorship in
*691] property, an author has an exclusive *and perpetual right, in preference to any other, to the fruits of his labor. Though the nature of literary property is peculiar, it is not the less real and valuable. If labor and effort in producing what before was not possessed or known will give title, then the literary man has title, perfect and absolute, and should have his reward." The object of the law, and to which the attention of congress was specially drawn, was the *protection* of property, claimed and admitted to be exclusive and perpetual in the author.

It may be useful, preliminarily, to notice a few of the settled rules by which statutes are to be construed. In construing statutes, three points are to be regarded; the old law, the mischief, and the remedy; and the construction should be such, if possible, to suppress the mischief, and advance the remedy. 1 Bl. Com. 87; Bac. Abr. Stat. 1, pl. 31, 32. An affirmative statute does not abrogate the common law. If a thing is at common law, a statute cannot restrain it, unless it be in negative words. Plowd. 113; 2 Kent's Com. 462; 2 Mason 451; 1 Inst. 111, 115; 10 Mod. 118; Bac. Abr. Stat. 9. Where a statute gives a remedy, where there was one by the common law, and does not imply a negative of the common-law remedy, there will be two concurrent remedies. In such case, the statute remedy is cumulative. 2 Bac. 803, 805; 2 Inst. 200; Com. Dig., Action upon Statute 6.

Considering the common-law right of the author established, and with these rules of constructing statutes kept in view, I proceed to the consideration of the acts of congress.

The first law was passed in the year 1790 (1 U. S. Stat. 124), and is entitled, "an act for the encouragement of learning, by *securing* the copies of maps, charts and books, to the authors and proprietors of such copies, during the times therein mentioned." The first section declares, that the author of any book or books, already printed, being a citizen of the United States, and who hath not transferred the copyright to any other person, and any other person, being a citizen of the United States, &c., who hath purchased, or legally acquired the copyright of such book, in order to print, reprint, publish or vend the same, shall have the sole right and liberty of
*692] printing, reprinting publishing and *vending the same, for fourteen years from the recording of the title thereof in the clerk's office, as hereinafter directed. The like provision is made, with respect to books or

manuscripts, not printed, or thereafter composed. The title, and this section of the act, obviously consider and treat this copyright as property; something that is capable of being transferred; and the right of the assignee is protected equally with that of the author; and the object of the act, and all its provisions purport to be for *securing* the right. Protection is the avowed and real purpose for which it is passed. There is nothing here admitting the construction, that a new right is created. The provision in no way or manner deals with it as such. It in no manner limits or withdraws from the right, any protection it before had. It is a forced and unreasonable interpretation, and in violation of all the well-settled rules of construction, to consider it as restricting, limiting or abolishing any pre-existing right. Statutes are not presumed to make any alteration in the common law, further or otherwise than the act expressly declares. And therefore, when the act is general, the law presumes it did not intend to make any alteration; for if such was the intention, the legislature would have so expressed it. 11 Mod. 148; 19 Vin. 512, Stat. E, 6, pl. 12. And hence, the rule is laid down in Plowden, if a thing is at common law, a statute cannot restrain it, unless it be in negative words. It is, in every sense, an affirmative statute, and does not abrogate the common law.

The cumulative security or protection given by the statute, attaches from the recording of the title of the book in the clerk's office of the district court where the author or proprietor shall reside. If the statute should be considered as creating a new right, that right vests upon recording the title. This is the only pre-requisite, or condition precedent, to the vesting the right. Whatever it is that is given by the statute, and the other requirements in the third and fourth sections, of publishing in the newspaper within two months from the date of the record, and delivering a copy of the book to the secretary of state, within six months from the publication, cannot be construed as pre-requisites or conditions precedent to the vesting. These provisions cannot be considered in any other light than as directory. In no other view can these sections of the law be *made consistent with the provisions of the first section. The benefit of the act, so far [*693 as respects the exclusive right, takes effect from the time of recording the title in the clerk's office; but the publication in the newspaper may be made at any time within two months, and the copy delivered to the secretary of state within six months. What would be the situation of the author, if his copyright should be violated, before the expiration of the time allowed him for these purposes? Would he have no remedy? The second section declares in terms, that if any person, from and after the recording the title, shall, without the consent of the author or proprietor, print or reprint, &c., he thereby incurs the penalties given by the act. Both the right and the remedy, therefore, given by the act, attach on the recording of the title. And this construction is not at all affected by anything contained in the third section of the act; which declares, that no person shall be entitled to the benefit of this act, unless he shall have deposited a printed copy of the title in the clerk's office. This is in perfect harmony with the first and second sections; and although the requirement to publish a copy of the record in the newspaper is in the same section, it is in a separate and distinct clause, and no more required to be considered a pre-requisite, than if it was in a distinct section; and so it was considered by Mr. Justice WASHINGTON

in *Ewer* v. *Coxe*, 4 W. C. C. 490; and he also, in that case, considered the requirement in the fourth section, to deliver a copy to the secretary of state as directory, and not as a condition; and indeed, the result of his opinion was, that if the author's copyright depended upon the act of 1790, it would be complete, by a deposit of a copy of the title in the clerk's office. But that the act of 1802 not only added another requisite, viz., causing a copy of the record to be inserted at full length in the title page, but made the publication in the newspaper, and the delivery of a copy of the book to the secretary of state, pre-requisites, although not made so by the act of 1790. Mr. Justice WASHINGTON is fully supported in his construction of the act of 1790, by the case of *Nichols* v. *Ruggles*, 3 Day 145, decided in the supreme court of errors of the state of Connecticut, where it is held, that the provisions of the statute, which require the author to publish the title of his book in a newspaper, and to deliver a copy of the work to the *secretary of state, are merely directory, and constitute no part of the essential requisites for securing the copyright. This case was decided in the year 1808, and I do not find any reference to the act of 1802. This can only be accounted for, upon the supposition, that, in the opinion of the counsel and court, this act did not at all affect the construction of the act of 1790; for had it been supposed, that the act of 1802 made the publication in a newspaper, and a delivery of a copy of the work to the secretary of state, pre-requisites to the vesting of the copyright, it would necessarily have led to a different result on the motion for a new trial. Judge HOPKINSON, who tried the cause now before the court, thinks the act of 1790 will not admit of the construction given to it by Judge WASHINGTON; but that, under that act, the publication in a newspaper and delivery of a copy of the work to the secretary of state, are pre-requisites to the establishment of the right; and such I understand to be the opinion of a majority of this court, by which the construction of the act of 1790 by Judge WASHINGTON is overruled. I have already attempted to show that this construction of the act of 1790 cannot be sustained; nor do I think that the act of 1802 will aid that construction of the act of 1790, and in this I understand my brother MCLEAN concurs; so that upon this question, as to the effect of the act of 1802 upon the act of 1790, the court is equally divided, and the decision of the cause rests upon the act of 1790. A brief notice, however, of the act of 1802 (2 U. S. Stat. 171), may not be amiss.

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It purports, so far as it relates to the present question, to be a supplement to the act of 1790, and declares, that the author or proprietor of a book, before he shall be entitled to the benefit of that act, shall, in addition to the requisites enjoined in the third and fourth section of said act, give information, by causing a copy of the record, required to be published in a newspaper, to be inserted at full length in the title page or in the page immediately following the title page of the book. It is to be observed, that this purports to be a supplementary act, the office of which is only to add something to the original act, but not to alter or change the provisions which it already contains. It leaves the original act precisely as it was, and only superadds to its provisions, the matter of the supplement; and *both, when taken together, will receive the same construction as if originally incorporated in the same act. This is the natural and rational view of the matter. Suppose, this new requisite had been in the original act, how would it stand?

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If it was in a separate and distinct section, it would run thus: that the author, before he shall be entitled to the benefit of this act, shall insert at full length, in the title page of the book, a copy of the record of the title. This could not change the construction of the act as to the publication in the newspaper, or delivery of a copy of the book to the secretary of state. Nor could it have any such effect, if it followed immediately after the pre-requisite of depositing a printed copy of the title of the book in the clerk's office; and this would have been the natural place for the provision, if it had been inserted in the original act.

Judge WASHINGTON, in *Ewer* v. *Coxe*, says, that the supplemental act declares that the person seeking to obtain this right shall perform this new requisition, in addition to those prescribed in the third and fourth sections of the act of 1790, and that he must perform the whole, before he shall be entitled to the benefit of the act. I find no such declaration in the act. The second section, which relates to prints, does contain this declaration, but it has no application to books. If the act of 1802 is intended as a legislative construction of the act of 1790, and is clearly erroneous, it cannot be binding upon the court.

The act of 1831, being *in pari materia*, may be taken into consideration, in construing the previous acts which it purports to amend; and we find in this act only two pre-requisites imposed upon an author, to entitle him to the benefit of the act, viz., to deposit a printed copy of the title of the book in the clerk's office of the district court of the district wherein the author or proprietor shall reside, and to give information of the copyright being secured, by inserting on the title page, or the page immediately following, the entry therein directed, viz., "entered according to the act of congress," &c. And these being pre-requisites under the former laws, it is fairly to be concluded, that they were the only pre-requisites, and that the other requirements are merely directory; and if so, the complainants in the court below have shown all that the acts of *congress require to vest the copy- [*696
right. The title has been recorded in the clerk's office, and a copy of the record inserted in the title page of the book.

But if the complainants in the court below have not made out a complete right, under the acts of congress, there is no ground upon which the common-law remedy can be taken from them. If there be a common-law right, there certainly must be a common-law remedy. The statute contains nothing, in terms, having any reference to the common-law right; and if such is considered abrogated, limited or modified by the acts of congress, it must be by implication; and to so construe these acts, is in violation of the established rules of construction, that where a statute gives a remedy in the affirmative, without a negative expressed or implied, for a matter which was actionable at common law, the party may sue at common law, as well as upon the statute. 1 Chitty's Pl. 144. This is a well-settled principle, and fully recognised and adopted in the case of *Almy* v. *Harris*, 5 Johns. 175.

Whatever effect the statute of Anne may have had in England, as to limiting or abridging the common-law right there; no such effect, upon any sound rules of interpretation, can grow out of our acts of congress. There is a wide difference in the phraseology of the laws. The statute of Anne contains negative words. It declares, that the author shall have the sole right and liberty of printing, &c., for the time contained in the statute, and

no longer; and these are the words upon which the advocates for the limitation of the common-law right mainly rest; and it was, for a long time, considered by the ablest judges in England, that even these strong words did not limit or abridge the common-law right; and the question, at this day, is not considered free from doubt.

This act, and the construction which it had received in England, were well known and understood, when the act of congress was passed, and no such limitation is inserted or intended, or any matter at all repugnant to the continuance of the common-law right, in its full extent. These laws proceed on the ground that the common-law remedy was insufficient to protect the right; and provide additional security, by means of penalties, for the violation of it. Congress having before them the statute of Anne, and
*697] apprised of the doubt entertained in *England as to its effect upon the common-law right, if it had been intended to limit or abridge that right, some plain and explicit provision to that effect would doubtless have been made; and not having been made, is, to my mind, satisfactory evidence that no such effect was intended.

If the present action was to recover the penalties given by the statute, it might be incumbent on the appellants, to show that all the requirements in the acts of congress had been complied with. This would be resorting to the new statutory remedy, and the party must bring himself within the statute, in order to entitle him to that remedy. But admitting that the right depends upon the statute, and is limited to the time therein prescribed, the remedy by injunction continues during that time. This is admitted by Mr. Justice YATES, in *Millar* v. *Taylor*. The author, says he, has certainly a property in the copy of his book, during the term the statute has allowed; and whilst that term exists, it is like a lease, a grant, or any other common-law right; and will equally entitle him to all common-law remedies for the enjoyment of that right. He may, I should think, file an injunction bill to stop the printing. But I may say, with more positiveness, he might bring an action to recover satisfaction for the injury done, contrary to law, under the statute. And the same doctrine is laid down by the whole court, in *Beckford* v. *Hood*, 7 T. R. 620. Lord KENYON says, the statute vests the right in authors for certain periods; and within those periods, the act says, the author shall have the sole right and liberty of printing, &c.; and the statute having vested the right in the author, the common law gives the remedy by action on the case, for a violation of it; and that the act, by creating the penalties, meant to give a cumulative remedy.

The language in the statute of Anne, which is considered as vesting the right, is the same as in the act of congress. In the former, it is considered as necessarily implied in the declaration, that the author shall have the sole right, during such time, &c. And in the act of congress, there is the same declaration, that the author shall have the sole right of printing, &c., from the time of recording the title in the clerk's office. The right being thus vested at the time, draws after it the common-law remedy. And there is
*698] no more reason for *contending, that the remedy given by the statute, supersedes the common-law remedy, under the act of congress, than under the statute of Anne. The statute remedy is through the means of penalties, in both cases.

The term for which the copyright is secured in the case now before the

court, has not expired; and according to the admitted and settled doctrine in England, under the statute of Anne, the common-law remedy exists during that period. Upon the whole, in whatever light this case is viewed, whether as a common-law right, or depending on the act of congress, I think, the appellants are entitled to the remedy sought by the bill; and that the decree of the court below ought to be reversed, the injunction made perpetual, and an account taken according to the prayer in the bill, without directing an issue to try any matter of fact, touching the right.

Baldwin, Justice. (*Dissenting.*)—The bill of the complainants prays for an injunction, an account, and for general relief. The bill states, the answer does not deny, and the fact is admitted, that the complainants have been in the quiet, peaceable and unquestioned possession of a copyright to the twelve volumes of Wheaton's reports, from the time of their first publication till the publication of the third volume of Condensed reports, by the respondents, in February 1831, which possession has been had and continued under claim and color of title. The first volume of Mr. Wheaton's reports was entered for copyright in the office of the clerk of the district court of Pennsylvania, in December 1816, and a copy of the entry duly published on the title leaf; the succeeding volumes were entered in the same manner, in each successive year, till 1827, when Mr. Wheaton ceased to be the reporter of the supreme court.

In May and June 1830, the first volume was again entered in the clerk's office of the southern district of New York, in order to secure the copyright for a further term of fourteen years, and in October following, there was deposited in the department of state a copy of the book; the publication in the newspapers, according to law, was also made immediately after the entry with the clerk. In June 1828, Mr. Peters, one of the respondents, issued his proposals for condensing the reports of cases decided by the supreme court, in which he declared, that "it is not considered that the work now announced, and part of the materials for which are arranged, will interfere with the interests of those gentlemen who have preceded the reporter in the station he has the honor to hold." "The legal rights of the proprietors of those most able and valuable works will be carefully respected." "Nothing will be inserted in the contemplated publication but matters which are of public record, and which, from their very nature, cannot be the subject of literary property." There does not appear in the pleadings, exhibits or evidence in the case, any declaration of any intention by Mr. Peters to invade the legal rights of any former reporters, or any allegation that they had not complied with the requisites of the law, which were necessary to secure to them the benefits conferred; he seems to have viewed his publication as calculated to increase the demand for the original reports, as well as their reputation, and that the nature of his work would not interfere with the rights of those who were their proprietors. His first annunciation of a denial of any right in the complainants, appears to have been on or about the time of publishing the third volume of the Condensed reports, embracing Mr. Wheaton's first volume, which was in February 1831, after the complainants had made claim to a second term of copyright in that volume, by a second entry; Mr. Donaldson claiming as purchaser and proprietor for a valuable consideration; and Mr. Wheaton, claiming, as the author, all

the right not vested in Mr. Donaldson by purchase. They and those claiming under them had been left in the unmolested enjoyment of their claims, under color of right, till that time; since which, the respondents have denied to them any legal or equitable right of property in any of the volumes of reports originally published by Mr. Wheaton. It is not pretended, that these books of reports were not duly entered with the clerk of the district court, nor that a copy of such entry was not duly certified and published on the title leaf of each volume, according to the requisitions of law. The respondents oppose the prayer of the bill, solely on the ground, that there was no publication in the newspapers, when the first record was made, and that no copy of the books was deposited in the office of the secretary of state, as required by the third and fourth sections of the act of 1790; and also because the Condensed Reports do not violate any right of property in the complainants to the reports of the decisions of the supreme court, they not being the subject of copyright.

Conceding, for the present, that no publication or deposit has been proved to have been made, within the time required, the first question which arises is, whether there is any equity in the complainant's bill, which entitles him to any relief? The course and principles of equity, on applications for injunctions to prevent the violation of the rights of literary property, have been clearly defined and well settled by courts of chancery, in England and this country, and are enjoined on the observance of the courts of the United States, by the acts of congress of 1819 and 1831. The uniform rule of courts of equity is, to award an injunction in favor of a party claiming a copyright or a patent, by color of title, if he has been in the long-continued possession, and the injunction will be continued till the party contesting the right shall show that it is mere color. Though the right is doubtful, the court will not dissolve the injunction, at the hazard of the right being established at law. No terms will be imposed on the party applying for protection of his possession, nor will the court permit the possession to be changed, till, on a trial of the right at law, the author or proprietor fails to establish it. The length of time during which an author has been in the enjoyment of his copyright or invention, is very important. If his possession has been only of recent date, he will not be allowed an injunction, in a doubtful case of right, nor entitled to its continuance, unless he proceeds to establish his right at law; but where the possession has been of some duration, especially, where it has been long held and peaceably continued, it will be protected, though no proceeding is had at law. The cases on this subject are full and conclusive, in establishing the course and principles of courts of equity. (6 Ves. 707, 710; 14 Ibid. 132, 136; 3 Meriv. 628; 2 Russ. 401; Coop. Eq. 156; Eden 87, 205, 206; 9 Johns. 567, 570, 583, 589; 4 W. C. C. 260, 489; 1 Paine 449. s. p. 12 Wheat. 198–9.) The rules established in these cases, are of unquestioned authority, and cover the whole ground of the complainant's case as to all the volumes of Wheaton's reports, the last of which was entered for copyright in June 1827, nearly four years before any actual or threatened invasion of the quiet and exclusive enjoyment under color of title. No case has occurred, where such a possession has been held insufficient to entitle the party to an injunction, before any trial at law or suit for damages. The injunction will be perpetuated without any directions to bring an action. (8 Ves. 227; Mitf. Plead. 128–9.) It is in the discretion of the court, to order

a suit or an issue, or not, according to the circumstances of the case. (17 Ves. 424.) But the establishment of the legal right has never been held requisite, unless the copyright is recent, or the author has acquiesced for a long time after the infraction. These are cases peculiarly favored in courts of equity, especially, when purchasers for a valuable consideration, without notice of any dispute about, or doubts of, the right, are concerned. In *Morris* v. *Kelly*, the plaintiff claimed as a purchaser, though he could not prove that the assignment was in writing; but the chancellor said, "I shall assume that your title is regular, until they show the contrary" (1 Jac. & Walk. 481), and granted the injunction, although the court of king's bench had decided, that an assignee could not recover damages, unless the assignment was in writing. (3 M. & S. 7, 9.) In *Mawman* v. *Tegg*, the chancellor observed, "whether the title be a good legal title in them or not, is one question; but it appears to me, they have a complete equitable title, and if the defendants are to have the benefit of the delay which bringing the action may occasion, they ought to be directed to admit the legal title upon the trial of the action, because a court of law cannot try the equitable title." (2 Russ. 335.) The injunction was continued. So, an injunction will be awarded in favor of a purchaser, though it is doubtful whether the defendant's work is a piracy or a fair abridgment. (1 Bro. C. C. 451.) But an injunction will not be granted, in favor of an author, against one who publishes the book under a license from him, or a gift of the manuscript; nor against a party who has been led into the publication by the encouragement and acquiescence of the author. (Jacob 311.)

Adhering to the principle that time and acquiescence shall avail an author, whose long possession under a claim of copyright has been invaded, and entitle him to an injunction, without a trial of the legal right, courts of equity apply it in favor of defendants, when authors suffer time to run on the violation of their rights. "Where ten have been allowed to publish, the court will not restrain the eleventh." "A court of equity frequently refuses an injunction, where it acknowledges a right, when the conduct of the party has led to a state of things which occasions the application, and therefore, will refuse or dissolve an injunction, without saying in whom the right is (Jacob 18), or, when the copyright is admitted, if there has been a violation for fifteen years. (19 Ves. 447–8.)

After such a course of adjudication in equity, I may assume it as a settled rule, that in a case like this, no chancellor would inquire into the legal title of the complainants, but would direct it to be admitted, on an issue to ascertain the extent of the piracy. At all events, it is unprecedented, to refuse all relief, in a suit between a purchaser in quiet possession, claiming by law, on the one side, and on the other, a party who sets up no particular right of his own, but contents himself with a general denial of any right in the other. If the parties in the present case were reversed, and the respondents sought to enjoin the complainants from proceeding to assert their legal rights by suits at law, by actions for the penalties, under the act of 1790, or the destruction of the work which was an alleged piracy, the possession of Messrs. Wheaton and Donaldson would be a complete answer to a bill founded on the common right asserted by Messrs. Peters and Gregg. "An injunction for such a purpose, and under such circumstances, would be unprecedented. The common right must be first legally established, and

the defendants must be first duly ousted of their pretension and possession, by due course of law. (7 Johns. Ch. 165.)

An injunction will not be granted, to restrain a party who has been in possession for any length of time, who claims by a title adverse (7 Johns. Ch. 165), till the right is first settled at law. (6 Ibid. 20 ; 19 Ves. 44, 47–8; 1 Cox 182 ; 6 Ves. 51.) A plaintiff who states such a case, puts himself out of court as to the injunction. (4 Johns. Ch. 22.) It is a proper remedy to protect a possession, till it appears to be against right, but it is never used to disturb a possession under claim and color of right ; especially, a right asserted under an act of parliament. (1 Ves. sen. 476.) There are no cases in which courts of equity administer this remedy more liberally, than in favor of authors and inventors, whose rights are easily invaded, without a possibility of their exhibiting to a jury the whole extent of damage which they may have sustained by their invasion. (17 Ves. 424.) Hence has arisen the fixed rule of equity, that long possession, under claim and color of title, is sufficient to entitle an author or inventor to an injunction, without a decision as to the right ; the great object is, to protect possession, not merely the settled right. Possession is, in all cases, *primâ facie* evidence of a right of possession, and is never disturbed, at law or in equity, until better evidence appears in an adverse party. The evidence of possession varies according to the subject-matter ; the proprietor of a book can have no other evidence of possession or property, than that he has enjoyed the exclusive right of printing and selling it, without any attempt to question or disturb it. This is as much actual possession, as the occupation of land, or the use of a chattel, and gives him all right incident to possession as evidencing a title to property.

Among these rights, none is more undoubted than the remedy by injunction, till his possession is shown to be merely colorable. In resting their case on the legal objections to the copyright claimed by the complainants, the counsel for the respondents seemed to have overlooked these principles, which prevail in all courts of equity, as well as the express directions of the acts of congress, which authorize the federal courts "to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of authors or inventors, secured to them by any laws of the United States, on such terms and conditions as the said courts may deem fit and reasonable." (3 U. S. Stat. 481.) This is an express adoption of the rules by which possession by color and claim of title is protected by injunction, equally with possession by a perfect title acquired by a compliance with all the requisites and directions of the law. No court of equity has ever made any distinction between the two classes of cases, or has ever entered into the inquiry, whether the party has strictly followed the law, if in his bill he presents a case of apparent equity, of *primâ facie* right, accompanied by long possession, peaceable and uninterrupted, while the other party rests merely on his own common right, simply denying the right of the complainant. Nor can a court of the United States refuse an injunction, in such a case, without directly contravening all settled principles. The settled course of equity has also become statute law, leaving no discretion in the court, except to decide whether the case comes before them under such circumstances as bring it within the rules settled by adjudications in equity, and the terms on which the injunction shall be granted.

The acts of congress which secure to authors and inventors their property, superadded penalties in the one case, and treble damages in the other, to the ordinary remedies which are prescribed for the violation of the rights to real and personal property. This arises from the known inadequacy of the ordinary remedies which limit the right of the injured party to a recovery of the amount of actual injury he sustains by the violation of his right. To place the proprietors of literary property on a worse footing in courts of equity, than the owners of other property, would be not only subversive of all priciples of justice, but in direct repugnance to the spirit of the constitution and laws, which make authors and inventors the favorites of national legislation, and deem the violators of their rights public offenders. Literary piracy is an offence subjecting the violator to a penalty, accruing, one-half to the party injured, the other half to the United States. When such is the language and spirit of the laws of 1790, 1802 and 1831, that the violation of this right is deemed a public offence, as well as a private injury, I find a strong assurance that in the eye of equity, literary property is, at least, as sacred as any other; nor can I, for a moment, doubt, that the plain course of its courts, and high duty, is, to impart to it the fullest degree of protection which is afforded to property less exposed to invasion, and to guard from impending danger a class of suiters who, from the nature of their rights, and the mode of their violation, can have no remedy at law, which is at all efficient or adequate.

The present is one of the strongest cases which can occur. As to the first volume of Wheaton's reports, the complainants had been in the quiet enjoyment of the copyright, for the full term of fourteen years; the book had been entered a second time, and every direction of the acts of 1790 and 1802 had been literally and strictly complied with to the letter, before any actual or threatened invasion or denial of their right. The respondents do not deny, that the copyright has been duly secured for a second term of fourteen years, if it was so secured for the first; their whole case rests on their legal exceptions to the validity of their right during the first term. They do not allege the want of notice, or that they have interfered with the rights and possession of the complainants, through any mistake, ignorance or misapprehension, nor do they assert in themselves any exclusive right to the matter taken from Mr. Wheaton's reports, and inserted in their work, or that he had pirated from others what he claims as his own property. Still less do they pretend, that the omission on his part to make publication in the newspapers, or to deposit a copy in the office of the secretary of state, has led them into any error or mistake in relation to the pretentions or claims of Mr. Wheaton to the copyright. The prospectus of 1828 shows the most ample notice in fact. So far from evincing a disposition, or containing a threat, to violate the rights of property in the reports, or to injure their sale, it makes and repeats the assurance, that they will be respected, and the demand for the books enlarged; thus furnishing the most conclusive answer to any allegation of delay in applying for an injunction, or any tacit acquiescence in the violation of the rights of the complainants, which might otherwise have been made, if the prospectus of 1828 had avowed an intention of denying their right. The present suit was brought in about three months after this intention became manifested, by the publication of the third volume of the Condensed reports. So that no such possession in

the respondents, as would afford any objection to the relief sought, can be set up by them.

If this were a suit at law, to recover damages for the piracy of the matter contained in the first volume of Wheaton's reports, I could not doubt, that the court would instruct the jury, that it was too late to contest the copyright during the first fourteen years, after its peaceable enjoyment during the whole term, and that its renewal, after all the requisites enjoined on authors had been fully complied with, some months before an invasion by the defendants, was sufficient to entitle them to some damages. In a suit at law for pirating a book, the first publisher may recover damages, though he has obtained the materials improperly, and procured the copyright by abusing his trust; he has a right to the copy, and to an action against the person who publishes it without his authority. "It may be a ground in equity, as between the person entitled and the person who first published it, but it does not destroy the right of the latter to sue a person pirating that right." (4 Esp. 169.) A tenant who had been in possession of land for fourteen years, under a void lease, but who had received a valid one for a new term, and remained in possession, would, to all intents and purposes, be deemed in law to have been in the lawful possession, during the whole period of his occupation, as well against the lessor, as a stranger or trespasser. On an application to a court of equity, to protect his possession against an adverse pretension, it would not listen to a mere legal technical objections to the title, but would leave the party opposing the injunction to proceed at law to invalidate the right of the complainant; when this would be done, the injunction would be dissolved, of course. In a case of an invasion of the possession of literary property, the call for the interference of a court of equity is much more imperious than in any other, the prompt and summary remedy of injunction being the only adequate one. There is also a powerful reason, in favor of the most liberal allowance of the healing effects of time and acquiescence, in viewing mere legal or formal defects in copyrights and patents for inventions, growing out of the provisions of the acts of congress.

The fourth section of the act of 1802, imposes a penalty of one hundred dollars on any person who shall insert in any book, or impress upon it, that the same has been entered according to the act of congress, if they have not legally acquired the copyright of such book, to be recovered, one-half to the use of the person who may sue for it, and the other half to the use of the United States; provided the action be commenced within two years from the time the cause of action may have arisen. (2 U. S. Stat. 172.) The same provision is contained in the 11th section of the act of 1831. (4 Ibid. 438.) It is thus put in the power of any person to test, by due process of law, the validity of any copyright, before he makes any publication of any matter contained in a book already published with a claim of right under color of law; in the words of the decisions in equity, he can, by these means, "show the claim to be mere colorable," which being done by a recovery of the penalty, an effectual bar is interposed to any proceeding in equity by way of injunction. In the present case, such an action could have been commenced against Mr. Wheaton for the publication of the eleventh volume, at any time previous to the 20th July 1828, for the twelfth, at any time before the 25th June 1829, and for the republication of the first

volume, with the impress of right in a second edition, at any time before the 14th May 1832. If a party is disposed to contest or invade the right of another claiming a copyright of a book, in the mode pointed out by law, he comes into a court of equity with a bad grace, to disturb a long quiet and peaceable enjoyment of a right, by urging only the same objections which remain open to him for two years after the publication of any book, with the impress and claim of copyright, by a process of which he can avail himself at his pleasure, during the time prescribed by congress.

The adjudications in equity have not defined the time of possession which will entitle an author to a continued injunction against a violator of his rights, but I think the acts of congress which limit the suits for this penalty for claiming a copyright, when none has been secured by law, ought to be taken as fixing the longest period during which an opposing party ought to be permitted to make such objections to an injunction, as require a court of equity to examine into the validity of the title. For these reasons, I am clearly of opinion, that there is in the bill of the complainants, and in the case, as it now appears, such manifest equity, as entitles them to the relief prayed for, and that it is contrary to the whole course and best-settled principles of equity, to make that relief dependent on the result of an issue on the fact of publication in the newspapers, or the deposit of a copy in the department of state. These are matters which can, in no case, affect the equity of the claim to an injunction, under the circumstances of this controversy; they are sheer dry legal objections, mere forms affecting only the strict legal right, without impairing the strong equity arising from long and quiet enjoyment.

Should the complainants bring an action for damages, the defendants will have the full benefit of these objections. A court of law is the proper place in which to urge them, and, in my opinion, the only one where they can be available, after this lapse of time. No distinction is better established in equity, than that time and long possession are, in all cases, circumstances of powerful effect, especially, in cases of injunction. The course now taken by this court, not only confounds all distinction between cases of recent and long possession, in opposition to all authority, but by permitting the objections now urged to be available, after such long possession, establishes a universal rule, that an author is bound, after any lapse of time, to be prepared with proof of matters purely *in pais*, on the penalty of forfeiting, not only all his legal, but equitable, remedies for the violation of his right. As the case now stands, the complainants are put to the same proof of their right, as if their book was newly published; they are deprived of all the benefits which time and long possession give to all suitors in a court of equity, and are compelled, while suing there, to assume, in all respects, the attitude of suitors in a court of law, claiming damages. I am utterly mistaken in the first principles of the law of equity, if this comports with justice or good conscience.

The only ground for refusing an injunction in this case, which is examinable on this appeal, is, in my opinion, the allegation that the reports of Mr. Wheaton are not the subject of copyright. The opinions of the court are clearly not so, but the marginal notes, or syllabus of the cases and points decided, the abstract of the record and evidence, and the index to the several volumes, are as much literary property as any productions of the mind.

None require the exercise of more judgment and labor, and they add greatly to the value and utility of the reports, as, without them, they would compel the reader to examine the whole opinion, in order to ascertain the points decided, and the whole book must be searched, before the substance of its contents could be known. Nothing contributes so much to the correct understanding of the adjudications of a court, as a judiciously condensed view of the case in which it is rendered. These summaries, together with the notes and index, indicate the talent of the reporter, as well as relieve the bar and the judges of great labor. They are professional productions of the highest order, which deserve, in an eminent degree, the fulness of protection which the law can afford to literary property. In the present case, it is not denied, in the answer or the argument, that the marginal notes, the summaries and index of Mr. Wheaton, have been very freely copied in the Condensed reports, which, generally speaking, with the exception of the arguments of counsel, and the notes of Mr. Wheaton, at the end of the cases, are a transcript of his reports. There may be exceptions, but such is the general character of the respondent's works. So far, therefore, as it is a publication of what was the subject of copyright, in the reports of Mr. Wheaton, it is a violation of his right of property, the further progress of which ought to be enjoined, and an account of past profits decreed, on such principles as the court may deem equitable.

As, however, I have the misfortune to differ with the court on this part of the case, it is necessary to give my opinion on the other questions which have arisen, as to which I cannot concur in the conclusions to which the majority have arrived. These questions are : 1. The common-law right of authors in their production : 2. Whether, by the act of congress of 1790, the publication in the newspapers, and the deposit of a copy in the office of the secretary of state, are indispensable to vest a copyright. The evidence of there being at common law a right of literary property in the authors of books, after publication, is most plenary, both from the common consent and general understanding in the community—judicial and legislative authority. In *Tonson* v. *Collins*, the jury found a special verdict, "that before the reign of Queen Anne, it was usual to purchase from authors the perpetual copyright of their books, and to assign the same for valuable consideration, and to settle them in family settlements, for the provision of wives and children." (1 W. Bl. 301.) The same fact was found by another special verdict, in *Millar* v. *Taylor* (4 Burr. 2306) ; and Lord Mansfield stated another fact, clearly showing the general understanding that there was such property in authors. "There are many decrees which make these things *assets*." (1 W. Bl. 335.) The court of chancery has uniformly proceeded upon the common-law right. "They considered the act (the statute of Anne) not as creating a new offence, but as giving additional security to a proprietor grieved, and gave relief without regard to any of the provisions in the act, or whether the time was or was not expired." (4 Burr. 2407.) In *Millar* v. *Taylor* also, the court of king's bench solemnly affirmed the common-law right of authors. The defendant, after assigning errors in parliament, suffered a *non pros.* of his writ of error, and the commissioners, who acted in place of the lord chancellor, granted an injunction. (4 Burr. 2408.) A majority of the judges in *Donaldson* v. *Beckett*, affirmed the same principle, four years afterwards

(Ibid. 2417), and it was so considered in this country, as a settled point, before the adoption of the constitution. (Federalist, No. 43, p 241.) The second section of the statute of 8 Ann., c. 19, contains a clear and direct legislative affirmance of an existing right of property in books, after publication. "And whereas, many persons may, through ignorance, offend against this act, unless some provisions be made whereby the property in every such book as is intended by this act to be secured to the proprietor or proprietors thereof, may be ascertained," &c. (4 Ruff. 418.) The preamble of the act is in perfect accordance with this explicit declaration of its intention to secure a right of property existing in proprietors before its passage, and being in affirmance of common usage, which is but another word for common law, leaves no doubt of what the law was before its passage, as well as what it would still be in England, if it had not been held to abrogate the common-law right, and to confine the remedy of authors to cases where they have complied with the requisitions of the statute of Anne. It is not necessary to inquire into the construction which that statute has received in that country, further than as it may elucidate the construction of the acts of congress. The statute of Anne was passed after the settlement of Pennsylvania; it has never been re-enacted or adopted by usage, and is not in force as a part of its law. The rules established by the supreme court, relative to British statutes passed after the colonization, are conclusive on this point. (1 Dall. 67, 74; 3 Binn. 595–6.)

I, therefore, assume it as a point settled by common consent and judicial authority, that by the common law of England, before the American revolution, the author of a book had a property in it, which was protected against violation as much as land or a chattel; it was a right known and recognised, which passed by assignment or other conveyance; it passed to executors as the other estate of a decedent, and was, in his hands assets for the payment of debts, or distribution among the next of kin. There can be no higher evidence of property in anything else than that by common consent; it passes from hand to hand as such, under the sanction of law and the protection of courts and the legislature; the common law knows no distinction of right between one species of property and another; whatever is property is the right of the proprietor, who is entitled to protection in its exclusive enjoyment, by the rules of the common law, which afford a remedy for every violation of right.

It is a principle of universal recognition in the United States, that the common law of England, in relation to what is property, its rights, and the remedies prescribed for injuries to them, was also the common law of the colonies, from their first settlement, and so continued till the revolution. On some subjects, it was not suited to the condition of the colonists; and therefore, not adopted; or was so modified as to conform to local usage or legislation, but as respects the right of property, it was of universal adoption. The sixth article of the charter to Penn contained this provision, "That the laws for regulating and governing of property, within the said province, as well for the descent and enjoyment of lands, as for the enjoyment and succession of goods and chattels, and likewise as to felonies, should be and continue the same as they should be, for the time being, by the general course of the law in the kingdom of England, until the laws

should be altered by the said William Penn, his heirs and assigns, and by the freemen of the said province, their delegates and deputies, or the greater part of them." In the preamble to the act of 1718, is this declaration, "and whereas, it is a settled point, that the common law is the birthright of English subjects, so it ought to be their rule in the British dominions; but acts of parliament have been judged not to extend to these plantations, unless they are particularly named in such acts," &c. (1 Dall. Laws 130; 1 Sm. Laws 105, 110.) The act of 1777 declares, that "the common law, and such of the statute laws of England as have heretofore been in force in the said province, except as is hereafter excepted," shall be in force and binding on the inhabitants of the state. (1 Dall. Laws 722; 1 Sm. Laws 429–30, 432 note; 3 Binn. 595–6.) Such has been the policy of Pennsylvania, from its first settlement to the present time, in relation to the common law in general; but there is one principle of policy which seems to have been a favorite one with its founder and early settlers. In the first frame of government, adopted on the 25th April 1682, art. 12, it is declared, that the governor and provincial council shall erect and order all public schools, and encourage and reward the authors of important sciences and laudable inventions in said province. This was confirmed by the first of the laws agreed upon in England. The same provision was also contained in the frame of government of 2d February 1683, and in that of the 7th of November 1696. (2 Proud, Hist. of Penn., App'x, 11, 15, 24, 37.)

So far, therefore, from repudiating the protection of the literary property of authors, the settlers of that province extended it to inventors, not only adopting the common law as to one, but the principle of the statute of 21 James as to the other. I can look at these provisions in the frames of government in no other light than as most solemn declarations, that the whole course of the law of England, as it existed at the time of the charter, which protected the property of authors or inventors, was suited to the condition of the colonists, and formed a part of their system of jurisprudence. These declarations are a direct negative to the proposition that authors were on a worse footing in the colony than in the mother country, and, coupled with the adoption of the common law as a general rule of property, seem to me conclusive of the existence of the right of authors and proprietors, independently of any statute or act of assembly.

The courts of Pennsylvania have uniformly followed and furthered the policy of the colony, by a free and liberal construction of the acts of the proprietor and legislature, in the application of the rules and principles of the common law, by enforcing them in all cases as to which they have not been abrogated, assuming it as a settled principle, that the common law is the rule of right and remedy, till altered by usage or legislation. In 1782, the supreme court declared, that "the common law of England had always been in force in Pennsylvania. (1 Dall. 67.) Our ancestors, who came out, on the faith of the charter, brought with them the common law in general, although many of its principles lay dormant, until awakened by occasion, *dormit aliquando lex, moritur nunquam.*" The true proposition is, that the common law is general and fundamental, and unless where the common usage of the country has changed it, or it has been altered by acts of assembly, it is the inexhaustible fountain of justice, from which we draw our laws. (9 S. & R. 330, 339, 358.) The first settlers of Pennsylvania

brought with them the common law in general, except such parts thereof as were unfit for colonies. (11 S. & R. 273.) The same remark may be applied to all the states of the Union. I have referred particularly to Pennsylvania, as this cause was instituted in that state, and its decision must be governed by the law of the *forum*. That state, however, was not singular in her attachment to the common law, or in adopting and adhering to it, as the foundation of property and the rule for its government. The first congress of the revolution, in the name of all the assembled colonies, proclaimed in the Declaration of Rights, in October 1774, "that the respective colonies are entitled to the common law of England." (1 Journ. Cong. 28, ed. 1800.) This court has solemnly adjudged, that "we take it to be a clear principle, that the common law in force at the emigration of our ancestors, is deemed the birthright of the colonies, unless so far as it is inapplicable to their situation, or repugnant to their other rights and privileges." (9 Cranch 333.) The same learned judge, who delivered the opinion of the court in that case, thus expresses himself in another place: "When I speak here of the common law, I use the word in its largest sense, as including the whole system of English jurisprudence. (1 Gallis. 493.) The common law of one state, therefore, is not the common law of another, but the common law of England is the law of each state, so far as each state has adopted it, and it results from that position, connected with the judiciary act, that the common law will always apply to suits between citizen and citizen, whether they are instituted in a federal or state court." (2 Dall. 394.)

The whole action of the courts of the United States, is governed by the common law. The constitution, which provides, that "the judicial power shall extend to all cases in law and equity"—"to all cases of admiralty and maritime jurisdiction," refers, of necessity, to the common law, for the rules which ascertain what is a case at law, or a case in equity, as well as what cases are of admiralty or maritime jurisdiction, as neither the local common law, nor statutes of the states, point out the line which separates the several jurisdictions. The seventh amendment to the constitution of the United States, which declares, that "in suits at common law"—"no fact tried by a jury shall be otherwise re-examined in any court of the United States than according to the rules of the common law," is an authoritative declaration, that it is the guide for all courts. "At the adoption of the constitution, there were no states in the Union, the basis of whose jurisprudence was not essentially that of the common law, in its widest meaning, and probably, no states were contemplated in which it would not exist." (3 Pet. 446, 448.) The 13th section of the judiciary act gives the supreme court authority to issue certain writs "in cases warranted by the principles and usages of law." The 17th section gives the same power to circuit courts, "agreeably to the principles and usages of law." The 15th section empowers them to compel the production of boods, in cases and under circumstances where they might be compelled to produce the same "by the ordinary rules of proceeding in chancery." The 16th section prohibits suits in equity where plain remedy can be had at law. The 14th authorizes new trials for reasons for which new trials "have been usually granted in courts of law." (1 U. S. Stat. 81.) The circuit and supreme courts have often and uniformly decided, that the constitution and the judiciary act refer to cases at law, and in equity, to the common law, to the usages and principles of law, &c., as they have

been settled; not according to the rules and practice of state courts, but of those of common law and equity in the country whence we derive our jurisprudence. (3 Wheat. 221; 10 Ibid. 20, 56; 5 Cranch 222; 7 Wheat. 45; 1 Pet. 613; 4 Wheat. 116; 7 Ibid. 45; 2 Mason 270; 4 W. C. C. 205, 354.)

The 11th section of the judiciary act gives to the circuit court "original cognisance of all suits of a civil nature, at common law or in equity," &c. An action for damages for violating any right of property recognised by law, is a suit at common law; a bill praying for an injunction and account, is a suit in equity. The objection, then, to the sustaining a suit in either case, and administering the appropriate remedy, is narrowed to the single point—has the plaintiff a right at law or in equity? A circuit court sitting in Pennsylvania, is bound to make the laws of the state the rule of its decision. The unvarying course of the supreme court has been, to pay the same respect to the decisions of the highest law tribunals of a state, in the exposition of the statutes and local usuages or common law of a state, as to an act of assembly. (12 Wheat. 161–2; 4 Pet. 380; 5 Ibid. 154; 6 Wheat. 127; 11 Ibid. 367; 2 Pet. 525, 556.) If they do not reach the case, this and the circuit court resort to the common law of England, as the rule both of right, remedy, and the mode of its adminstration, as a general fundamental principle pervading the whole jurisprudence of the United States, and the action of its courts in all the branches of their respective jurisdictions.

The statutes of Pennsylvania have adopted the common law; the supreme court of the state has invariably expounded these statutes so as to embrace the whole system, except such parts as have been abrogated by statute or local usage. It has been clearly shown in the argument, that authors had, by the common law, a copyright in their books, which was recognised and protected as property. Nor is it pretended, that there is, or ever has been, any statute or common usage in Pennsylvania, which has abrogated, or in any way impaired, any right of property existing at common law, prior to the act of 1777, or any remedy for its violation. Both remain in all their force, unless this court shall adopt the proposition that the protection of literary property was unsuited to the condition of the colonies. As that was a matter of which the colonial and state legislature were the competent judges, and as they have not excluded this species of property from the pale of the law, I think, we are bound to follow the rule laid down by the supreme court of that state, when they decided, that the suffering a common recovery by a tenant for life, works a forfeiture of his estate, by the common law, and destroys all remainders upon it. "It lies upon those, then, who deny the existence of the law of forfeiture in Pennsylvania, to prove it." (9 S. & R. 334.) The reason applies with much more force to those who deny the existence of a common-law right of property in authors.

Whatever force may be given to the argument of novelty, in other states, it has none in that in which it has been often decided that common-law remedies may be applied, though they had never before been used. Thus, in 1809, an assize of nuisance was sustained, though none had ever been carried through a court, at any former period (2 Binn. 194), the court considering "it all along a living remedy, though dormant." (17 S. & R. 211.) No writ of *entry sur disseisin* had ever been brought before 1824, yet the supreme court held it to be an existing remedy. (11 S. & R. 272.) There is no decision of this court which is in hostility to any of the foregoing prin-

ciples; on the contrary, they harmonize with those of the courts of Pennsylvania. There has been, and yet is, a diversity of opinion on the question how far the courts of the United States possess a common-law *criminal* jurisdiction, independently of what is conferred on them by acts of congress. This court, however, in the case of *Coolidge* (1 Wheat. 416), considered the question as open to an argument; and no one who will read the very able opinion of the learned judge of the first circuit (1 Gallis. 488), can deny that it is worthy of the most serious consideration.

But no doubt has ever existed in relation to the common law, as to rights of property and civil remedies, being, by the constitution, the judiciary act, and the settled course of adjudications, the rule both of right and remedy, unless opposed to some local law. I am, therefore, wholly at a loss to know, on what ground a circuit court, sitting in Pennsylvania, in a suit in equity, between citizens of New York, complainants, and citizens of Pennsylvania, respondents, should not adopt the common law of England, which, since 1777, has the same force as statute law, in that state, as the test by which to decide upon the rights of the parties, and the remedy to which the one complaining is entitled by the course and principles of courts of equity. The common law gives him a right of property, as well as an appropriate remedy; no law or usage of the state has impaired it; the statute of 8 Anne has not been adopted, and is not in force; but the common law has been adopted, and it is yet in force, as a rule for the decision of the circuit courts, as well as of this, unless otherwise required by the constitution or laws of the United States. (1 U. S. Stat. 92.)

So far from any act of congress having impaired this common-law right, they seem to me to recognise its existence, and to have been intended to afford it additional security. In 1783, the congress recommended to the states the passage of laws to secure to the authors or publishers of any new books, not hitherto printed, and their executors, a copyright therein. (8 Journ. 189, 2d May.) The powers of the confederation were not competent to the object, but the new constitution having empowered congress to do it, the act of 1790 was passed to effect it.

The first section declares, that the author of a book already printed in the United States, or any other person, his executors, administrators or assigns, who had legally purchased or acquired the copyright thereof, should have the sole right of printing and selling it, for fourteen years from the recording the title in the office of the clerk of the district court, in the same manner as the author of an unpublished book or manuscript. This is a plain recognition of an existing property in a printed book; a declaratory act that it was capable of being transferred and assigned; that the property passed to executors or administrators; that it could be purchased, and a copyright legally acquired to reprint and sell the same, before the law was passed. It is a complete definition of literary property, distinctly giving its attributes and incidents; it is also a direct negative to the proposition, that the publication and sale of the book was either a dedication to the public, or gave to the purchaser the right of reprinting it. The security afforded by this act was not only retrospective, but unlimited as to time; a book published forty years before the passage of the law, was equally within the law as one recently published. The second section imposes the same penalties on persons who shall reprint a book, printed before the law,

as for printing an unpublished manuscript, or for reprinting a book, printed by the author, after the law had passed. This consideration is of the greater importance, when we advert to the history of the controversy concerning literary property. Mr. Justice YATES, while at the bar, admitted that, "an author had a property in his sentiments till he published them, and that he might sell, and give a title to publish them." (1 W. Bl. 333.) In his celebrated opinion, he lays down one position which he apprehends will not be disputed on either side. "While the subject of publication continues his own exclusive property, he will so long have the sole and perpetual right to publish it; but whenever that property ceases, or by any act or event becomes common, the right of publication will be equally common. (4 Burr. 2355.)

The great question was, whether publication made it common: it was as familiar to the profession in this country as in England, and to none more so than to the members of congress, as is most evident from the phraseology of the act. (Federalist, No. 43, p. 141.) In recognising the assignability of a copyright in books already printed, and its transmission to executors, the law is based on the facts found by the special jury in *Tonson* v. *Collins*, and in *Millar* v. *Taylor*, as well as that stated by Lord MANSFIELD, that a copyright was assets. This is a decisive expression of the sense of congress, that a copyright was property, after publication, or it could not have been assignable or transmissible. And it would be derogatory, as well to the wisdom, as to the justice of any legislature, to impute to them the intention of inflicting a heavy penalty on the publisher of a book, which was common property, giving one-half to the author or proprietor, with direction to him to destroy the sheets, and a forfeiture to him of all the books printed in contravention of this copyright.

If this right was a mere creature of the act of congress, if the purchaser of a book had the right to multiply copies at his pleasure, the power of congress to prescribe penalties and forfeitures for the benefit of an author or proprietor, who had no other than a common right of publication, might well be questioned; it would be clearly repugnant to justice and sound legislation, to make it penal to reprint a book in which no one had or could have property. But as there was a property at common law in printed books, congress protected it as effectually as one unpublished. When the law recognises a person as the "proprietor," there must be "property;" when he "purchases" or "assigns," there must be a subject-matter to purchase or assign; his executors can have no right which did not pass from him, and he "cannot legally acquire a copyright," when there is none to acquire.

The difference between the wording of the statute of Anne, and the act of 1790, presents another powerful reason to show that it did not take away any common-law right; the substitution of the word "securing," in place of "vesting," as in the statute of Anne, the omission of the words "no longer," which were deemed so important, must mean something. (See 4 Burr. 2389–90.) There is no provision which excludes the author from the enjoyment of his common-law right; the third section only excludes him from the benefit of the act, if he does not make the entry with the clerk; had it been intended to deny all right, to preclude the existence of any property in the book, it would have excluded him from the benefit of a copyright;

the same remark applies to the first section of the act of 1802. The second section of this act is strongly illustrative of the sense of congress. In providing for the protection of the authors and proprietors of prints, the law is wholly prospective to prints engraved after the passage; its omission of prints previously puplished, while printed books were put on the same footing as unpublished manuscripts, could not have been without a meaning, or a reference to the common-law right. There was no copyright in prints, in England, until 8 Geo. II., c. 13, gave one in prints engraved after the passage of that statute. (6 Ruff. 184.) As it was a mere statutory right in England, congress so considered it, and therefore, made no provision for prints previously published. (2 U. S. Stat. 171.) The act of 1819 makes a plain distinction between the case of an author and inventor—the word *granting*, referring to a right created in the inventor, and the word *confirming*, referring to a right secured to an author; the one word being a negative of a pre existing right, the other necessarily implying it. (3 U. S. Stat. 481.)

For these reasons, and in the absence of any clause in either the act of 1790 or 1802, which in terms, or by fair construction, contains or implies a denial of the common-law right, it seems to me, that the well-settled rule which has been applied in England to the statute 8 Anne, that an affirmative statute does not impair a common-law right, but is uniformly held to be merely cumulative as to the remedy, applies with greater force in this country, to leave the common-law right of authors unquestioned. (7 T. R. 627; 4 Bac. Abr. 641; 19 Vin. 511; Co. Litt. 111, 115; 17 S. & R. 92; 5 Day's Com. Dig. 330.)

The counsel of the respondents have relied much on the analogy between the case of authors and inventors, in order so establish the position, that as the latter had no rights at common law, therefore, there was none in authors. But admitting the full force of their reasoning, it only tends to prove what the common law ought to be as to inventors; it does not disprove the fact found by special juries as to copyrights being property, nor overrule the adjudications at law and in equity which formed the common law of England, and of these states, by adoption. If we adopt as a principle of law, the proposition, that because the common law did not recognise as property, that species of the result of mental labor, ingenuity, or combination of both, which is termed an improvement or invention in mechanics, it, therefore, does not recognise a property in a literary production, we open a wide field of innovation, which will unsettle the best-settled rules of property. On other subjects, it is deemed full evidence of the existing common law, that there has been on a point of question, one adjudication which has received general assent and acquiescence; much more so, when the course of the law has remained unquestioned, after solemn decisions. If authors had not a right of property by the common law, or if that part of the common law has not been adopted here, it becomes a matter of serious inquiry, what the public and the profession are to consider as evidence of the law, and the rules, as to right and remedy, by which other property is to be governed. If the judicial history of the law of copyright does not establish its existence, independent of statutes, in England, and if the acts of congress, passed professedly for the encouragement of learning, by securing the copyright of authors, is, by fair construction, an abrogation of the common-law right,

I am much mistaken, if the opinion of the majority of the court in this case does not, in its consequences, open a new epoch in the history of our jurisprudence. I, for one, must look to other than the accustomed sources of information, to find the common law, to new tests of its adoption here, and new rules of construing statutes, as well in their effect on the pre-existing law of property, as the settled principles by which their provisions are interpreted. There are none more ancient or sacred, than that the common law can be altered only by act of parliament (Litt. § 170; Co. Litt. 115, 116); that statutes and usages which derogate from its rules shall be construed strictly, and not be extended by equity beyond their words or necessary implication (1 Bl. Com. 79; Gilb. Dev. 153; Litt. § 169; Co. Litt. 33 *b*, 58 *b*, 113 *a*; 4 Dall. 64; 2 Binn. 284); and that a statute which gives an additional remedy, or inflicts new penalties and forfeitures for the violation of a right, leaves the injured party the option of appealing to the statute or common law for redress. (4 Burr. 2380–81, 2387; 7 T. R. 627; 4 Bac. Abr. 641, 645; 5 Day's Com. Dig. 331.) In the application of these principles to the acts of congress on copyright, there can be found no one provision, which either professes, or by implication can be construed, to alter the common law. Their titles and enactments are affirmative and remedial, for the security of the right of property in authors, and they carefully exclude the words in the statute of Anne, which have led to the construction it has received in England. Congress has not declared, that the copyright shall exist, and be secured for fourteen years "and *no longer*," as they would have done, if they had intended to limit the right to that term; the omission of these words is, therefore, powerful evidence in itself, that it was not intended to leave the law open to the construction which the statute of Anne had received; and this evidence becomes most conclusive, in the absence of any word, phrase or clause, which can be interpreted to imply any abrogation of the right existing at common law, which was the rule of property adopted from its first settlement by Pennsylvania, and so continues to this day, as the settled law of the state. By every principle of its jurisprudence, the party who alleges that the common-law rules of property of any description are not in force in that state, must, in the language of its supreme court, "prove it." The issue is thus thrown on the respondents, to show that the law of copyright was never adopted. In this they have utterly failed, for they have not offered a *scintilla* of proof of any local usage, of any judicial *dictum*, or a legislative declaration, that the law of literary property has not been adopted in that state, or that it was unsuited to the condition and policy of its inhabitants.

The adoption of the common law "in the general," as a system of civil jurisprudence for the government of property, necessarily throws the burden of proving the exception of any particular description of property on those who affirm the exception; if they fail in this, the general principle must prevail. If a different rule is applied in this case, the sixth article of the charter to Penn, the acts of assembly of 1718 and 1777, as well as the whole course of judicial opinions in the state, from its first settlement to this time, become annulled and reversed. On the other hand, if the established rule prevails, there is in Pennsylvania an ancient fixed rule of property, a law of the *forum*, which is repugnant to no law of the Union, and becomes imperative on the federal courts, as their rule of decision in the

present controversy, that is, the common law as adopted in Pennsylvania, and recognised as well by the constitution and the judiciary act, as by the repeated and solemn adjudications of this court; all in affirmance of the declaration of rights made by the first congress in 1774.

It remains to consider the question arising under the acts of congress on the subject of copyrights, which is, whether the complainants have complied with such of its requisitions as are indispensable to give them a right of property in the reports of Mr. Wheaton? It being admitted, that all the volumes were duly entered in the office of the clerk of the district court, and a copy of the entry printed on the title leaf, the only subject of inquiry is, whether any further acts were necessary to vest the title? Whether there is sufficient evidence of those acts having been done, will depend on the results of the issue of fact directed by the court, which it would be premature to examine at present.

It is an admitted principle of American jurisprudence, that where "English statutes have been adopted into our legislation, the known and settled construction of those statutes by courts of law, has been considered as silently incorporated into the acts, or has been received with all the weight of authority." Though the acts may not be identical with the British statutes, yet "the construction which the latter may have received, the principles and practice which have regulated grants under them, as they must have been known and are tacitly referred to in some of the provisions of our own statutes," afford materials to illustrate it. *Pennock* v. *Dialogue*, 2 Pet. 18.

In commenting on the act of 1793, as to patents for inventions, this court refers to the statute 21 Jac. I., and its construction by Lord Coke and Chief Justice Gibbs, and remarks, "but it can scarcely admit of a doubt, that they must have been within the contemplation of those by whom it (the act of 1793) was framed, as well as the construction which had been put upon them by Lord Coke." (2 Pet. 21.) No sound reason can be assigned, for not applying the same rule to the statute of Anne, and the act of 1790. As no case of copyright has heretofore come before this court, I cannot avail myself of its authority, on the identical question now presented, but cannot omit a reference to that of my predecessor in the circuit court. "In this respect, the act (of 1790) corresponds, and was probably intended to correspond, with the statute 8 Ann., c. 19, which, and the construction given to it in the cases of, &c., and some others, were, no doubt, within the view of the legislature which passed this act." (4 W. C. C. 490.) No one can doubt the fact, that the whole course of the law of England on the subject of copyright was well understood and fully considered by the congress of 1790, among whom were some of the most eminent jurists of that or any other time. The general scope, as well as the detailed provisions of their acts on inventions and copyrights, most manifestly show, that they took pattern from the statutes of James and Anne; while the difference between them evidently arose from the defects in those statutes, or the doubts which had arisen in their expositions.

Applying, then, the principle on which this court acted in the case of *Pennock* v. *Dialogue* to this, I proceed to inquire, what is necessary to secure a copyright, under the acts of 1790 and 1802? The answer is found in the laws. The first section of the act of 1790 declares, that the author

or proprietor "shall have the sole right of printing and reprinting such map, chart or book, for fourteen years from the recording the title thereof in the clerk's office as is hereinafter directed." (1 U. S. Stat. 124.) The third section declares, "that no person shall be entitled to the benefit of this act, unless he shall deposit a copy of the title in the clerk's office of the district court where the author or proprietor shall reside." The clerk is required to record the same in a book, and to give a copy to the author or proprietor, if he shall require it, under the seal of the court, in the form prescribed, and for a specified compensation. This is the only requisite expressly enjoined by the law, to give or secure the sole and exclusive right, for the first term of fourteen years; by the proviso in the first section, it is requisite, to secure the right for a second term, that the author or proprietor "shall cause the title of the book to be a second time recorded and published, in the same manner as is hereinafter directed, and that within six months before the expiration of the first term of fourteen years aforesaid." A distinct and separate direction is contained in the third section: "And such author or proprietor shall, within two months from the date thereof (the recording the title), cause a copy of the said record to be published in one or more newspapers printed in the United States, for the space of four weeks." The fourth section directs, that the "author or proprietor of any book shall, within six months after the publishing thereof, deliver or cause to be delivered, to the secretary of state, a copy of the same, to be preserved in his office." These are all the requisites prescribed by this law to the authors or proprietors of books, whether they are considered as conditions precedent to vesting the right, or as merely directions, which may be omitted without impairing the title.

Assuming, in this view of the case, that there is no copyright, independent of this act of congress, it is evident, that it commences only from the recording the title, the omission of which is fatal to the author's right, because the law has expressly declared it so; but as it does not declare the publishing in the papers to be indispensable for either the commencement of the right, or a continuance of it, for the full term, it could not have been so intended. Such a construction would be in direct contradiction to the express declaration, that the right shall be for the term "of fourteen years from the recording." It vested at that time, as a perfect continuing right of property, for a defined term, without any provision that it should cease or become forfeited by any act of omission whatever. The author was not required to make the publication, before his term commenced; it, therefore, can, by no possibility, be deemed to be a condition precedent, or a requisite indispensable to vest the title, in the first instance, to continue it during the two months allowed for publication, or the six months allowed for delivering the copy to the secretary of state. Thus far, there can be no doubt of the right, nor that, if these requisites are conditions, they are subsequent. Viewing them as such, the utmost legal result of their breach is, that the United States, as the grantors, may take advantage of it, in such mode as they may prescribe by law; but the respondents, who are strangers to the right, cannot avail themselves of it against the complainants, who are in possession under a claim of title, which is good as to all but the grantor, and good against him until he interferes to resume or terminate it. (Shep. Touch. 149; 7 Pet. 606.) To

authorize any other person to interfere with the enjoyment of the property, it must appear, that by the terms or fair interpretation of the law, the condition is made a limitation, which extinguishes the right, by legal operation, on the non-performance of the act, without anything done by the grantor. (Shep. Touch. 141 ; 2 Bl. Com. 155.) No act of congress contains such limitation, or uses words which can be so construed. When the intention of the legislature is, to make the performance of an act essential to the right, it not only declares it to be so, but prescribes that the author shall be furnished with such evidence of its having been done, as shall save him the necessity of proving it by the ordinary rules of evidence, as in recording a copy of the title with the clerk, who is bound to give a certificate thereof, under seal, in the form prescribed by the third section of the act of 1790. The third section of the patent law of 1793, makes the filing a specification in the office of the secretary of state essential to any right, a certified copy whereof shall be competent evidence in all courts, &c. (1 U. S. Stat. 321.) The omission to make a similar provision as to the other matters directed by the act of 1790, or to direct the secretary to make a record, and give a certificate of the delivery of the copy, which should be evidence, is a plain indication of the sense of congress ; and if it was not intended, that the law should be expounded according to the ordinary rules of interpretation, congress would have put all the requisites on the same footing.

The making the benefits of the acts dependent on the performance of some things, and not on others, is conclusive to show the meaning of the legislature. To make them all essential, by mere construction, when the law itself discriminates between what is necessary for the title, and what is merely directory for other purposes, is tantamount to an adjudication, that congress did not understand the legal effect of the provisions of the law ; it is making the fourth section a condition precedent to the continuance of the right, by adding to, and transferring to it, the words of the third section, which make the record of the title indispensable ; thus construing two distinct unconnected sections, as well as the distinct and separate sentences and directions of each, into one entire sentence, and converting mere directions into conditions, by the breach of which an author forfeits an existing right of property, which henceforth becomes common, and he is made liable to the penalties in the fourth section of the act of 1802. So, by the proviso in the first section of the act of 1790, the publication in the newspaper is made necessary to secure the copyright for a second term, in addition to the recording the title again, both of which must be done six months before the expiration of the first term. The effect of a proviso in a law, as a condition precedent to the vesting a right, a limitation, or an exception, as the case may be, operates so as to exclude the case to which it extends, unless the party who claims the benefit of the law, complies with the requisition of the proviso. (3 Day's Com. Dig. 89, A. 2 ; Shep. Touch. 121 ; Co. Litt. 146 *a*, 203 *b* ; 1 Pet. 636.) It is otherwise with a mere directory provision, unless the law declares it necessary to vest a right in the party. (9 Cranch 95 ; 6 Pet. 730.) Nothing, therefore, can more clearly show the meaning of congress, as to the publication of the record, than that it is made indispensable in the case of a renewed copyright, and only directed in case of an original one. Had the last clause in the third section been a proviso, it would have

been otherwise. (2 Co. 70 *b*, 71 *b*, 72 *a*, *b*.) The same rule applies, but with greater force, to the direction in the fourth section, to deposit a copy of the book in the department of state, because it is a direction wholly unconnected with the preceding section; neither is it necessary to entitle the author to the forfeitures and penalties prescribed by the second section. They are incurred by any violation of the copyright, after the recording and publishing the title "within the times limited and granted by this act," without any reference to the deposit of the copy in the office of state. When, therefore, we find that the author or proprietor is expressly authorized to recover the penalties and take advantage of the forfeitures for twenty-eight years, this court cannot limit it to six months, by interpolating the deposit as a condition to the right thus declared absolute; this would be judicial legislation, not construction. In deciding on the construction of state laws and acts of congress, whether their provisions are to be deemed essential to, or affecting a right created or secured by the law, or are merely directory to the officer or party who is to comply with them, this court has uniformly held that it depends on the words or necessary implication of the law itself. (5 Cranch 234; 3 Wheat. 594; 6 Ibid. 577; 9 Ibid. 736; 11 Ibid. 188, 190–1; 1 W. C. C. 11.) The result of these cases is the establishment of the proposition, that unless the act to be done is made essential to the vesting or validity of the right claimed, or the omission of its performance extinguishes one vested, its title is unimpaired, though the act is not performed. Such was the exposition of the patent law of 1793, by the learned judge of the first circuit. The inventor is required to take an oath "that he is the true inventor," &c., but it was decided, that the taking the oath was but a pre-requisite to the granting of the patent, and in no degree essential to its validity. It might as well be contended, that the patent was void, unless the thirty dollars required by the 11th section of the act had been previously paid." (1 Gallis. 433.)

Such, too, was the exposition which Judge Washington, in the circuit court of Pennsylvania, gave to the act of 1790. "But the condition upon which the proprietor is to be entitled to the benefit of the act, cannot, upon any grammatical construction, be extended to the requisition contained in the last sentence of this section, to publish a copy of the record of the title, within the time and the period prescribed. It is entirely a new sentence, and is as much disconnected from the condition expressed in the preceding part of the section, as if it had been contained in the fourth section, to which there is clearly no condition annexed. If, then, the title of an author to a copyright depended altogether upon this act, I should be of opinion, that it would be complete, provided he had deposited a printed copy of the title of the book in the clerk's office, as directed by the third section; and that the publication of a copy of the same would only be necessary to enable him to sue for the forfeitures created by the second section." (4 W. C. C. 490.) The supreme court of Connecticut have decided, that "the provisions of the statute, which require the author to publish the title of his book in a newspaper, and to deliver a copy of the work itself to the secretary of state, are merely directory, and constitute no part of the essential requisites for securing the copyright." (3 Day 158.) These adjudications were in accordance with the course of the English courts in the construction of the statute of Anne, c. 19, § 2, which directed the registry of the book in Stationers' Hall,

and also the fifth section, which required the deposit of nine copies of the book in the same place, for the use of certain libraries. It has uniformly been held, both at law and in equity, that these provisions were directory only, and not essential to the vesting the right, to enable the author to recover damages at law, or to have relief in equity. The right has been considered as vested absolutely during the term, though the directions of these two sections are not complied with. *Buller* v. *Walker*, cited in *Blackwell* v. *Harper*, 2 Atk. 94. "The registry is necessary only to entitle the author to the penalties." (s. c. Barnard. Ch. 211, 213 *a*; 7 T. R. 627; 16 East 322, 333; 4 Bing. 242–3; 1 Camp. 98. s. p. Eden on Inj. 193, 197; 1 W. Bl. 330, 338; 4 Burr. 2380; Jacob 311.) Such was the settled construction of the statute of Anne, in conformity with which the act of 1790 was evidently framed.

The statute (8 Geo. II., c. 13) gives a copyright in prints, for "fourteen years, to commence from the day of the first publishing thereof, which shall be truly engraved with the name of the proprietor on each plate, and printed on every such print or prints." (6 Ruff. 184.) Lord HARDWICKE, in 2 Atk. 94 (Barnard. Ch. 211), held, that the engraving the day of publication was not necessary to give the copyright, but was only directory. So did Lord ELLENBOROUGH, as to the plaintiff's name, in 1 Camp. 98. Lord ALVANLEY was inclined to a different opinion, yet he held a general allegation of a publication "on or about the 13th of May," to be sufficient to sustain a bill in equity. (2 Ves. jr. 324.) It has, however, been held necessary, to entitle an author to recover damages. (3 Wils. 60, 61; 5 T. R. 45; 7 Ibid. 522; 4 Bing. 239, &c.) But if the plaintiff omits to allege the day in his declaration, it is good after verdict. (7 T. R. 522.) The reason given for this construction is, that the right commences from the day of publication, and that this requisition is contained in the same clause which confers the right.

But no case has been adjudged, in which a literal compliance with the directions of the act has been held indispensable to the right. "It has never been stated on any print which has been published, who was the proprietor, nor in any one of the cases which have been decided in favor of engravers, has the word proprietor ever appeared upon the print;" the words on the print, "Newton del., Gladisin sculp., were held sufficient." The words of the act are "satisfied by the disclosure of the proprietor's name; this is a sufficient indication of the person who is to be applied to for leave to copy the print; coupled with the date, it shows how long the designer had the monopoly, and fully accomplished the two objects of the act. (4 Bing. 242.)

This uniform, unbroken current of authority, is not only in accordance with the settled rules of construing all statutes, which grant or secure rights of property, whether real, personal or literary, but the general policy of the law for the especial protection of the latter as a favored right.

(*a*) The learned judge who decided this case in the circuit court, considers the opinion of Lord HARDWICKE to have been otherwise; but this is owing to a mistake of the report of his opinion in 2 Atk. 95, of the word *property* for *penalty*. This is evident from the report of the same case in Barnardiston, 210, 213, in which the case is better reported. The words of his lordship are, "but that is only a provision that is necessary to be complied with, when the penalty of the act is taken advantage of;" in which he is followed by Judge WASHINGTON, in 4 W. C. C. 490, and by Lord ELDON, in Jacob 311, and all the cases at law.

Lord HARDWICKE denied that the statute of Anne created a monopoly, "and therefore, ought to receive strict construction. I am quite of a different opinion, and that it ought to receive a liberal construction; for it is very far from being a monopoly, as it is intended to secure the property of books in the authors themselves, or the purchasers of the copy, as some recompense for their pains and labor in such works as are of use in the learned world." (2 Atk. 143.) The same spirit prevails in courts of law. "Looking, therefore, at the subject-matter of the law, at the language employed by the legislature, and the practice which has been uniformly followed by engravers, we cannot hesitate to determine that the proprietors of these prints are entitled to the protection which is afforded by the statutes; a decision we have come to with satisfaction, seeing that they exercise a branch of art eminently useful, and which in no slight degree '*emollit mores nec sinet esse feros.*' They contribute also, by the same means, to the circulation of a knowledge of mechanics, so necessary to our manufactures, and so useful to the best interest of the country. (4 Bing. 245.)

I cannot overlook this weight of judicial authority in the construction of the act 1790, and the kindred statutes of England, without violating the words of the act of congress, the plain meaning of the legislature, the established rules and maxims for construing statutes, as well as the numerous adjudications upon them, which form, "according to the course and principles of courts of equity," the rule of our decision on bills of this description, by the express direction of the law of 1819.

Nor can I perceive in the act of 1802 any provision which can vary the construction of the former law; it merely prescribes an additional requisite essential to the right, which is, "to cause a copy of the record to be inserted in the title-page, or in the page immediately following." (2 U. S. Stat. 171, § 1.) It is not denied, that this has been done as to all the volumes of Wheaton's reports; but it is contended, that though the words of this section do not, in terms, make the publishing in a newspaper, or a deposit in the office of state, essential to the title, yet it is a legislative construction of the act of 1790, which this court is bound to adopt. The words are, that "before he shall be entitled to the benefit of the act (of 1790), he shall, in addition to the requisites enjoined in the third and fourth sections of said act, give information, by causing a copy of the record to be," &c. Had congress declared explicitly, that all the requisites enjoined were indispensable to the right, this court would have been bound by it, as a legislative act; but they have neither done this, nor used words which can be so interpreted, according to their true meaning. The intention of the legislature must be manifested in words, competent to make the law in future, expressing their sense as plainly as a declaratory act; and it must be expressed in terms capable of having that effect. "If this interpretation of the words should be too free for a judicial tribunal, yet if the legislature has made it, if congress has explained its own meaning too unequivocally to be mistaken, their courts may be justified in adopting that meaning." But if the language used indicates the opinion of the legislature of what the law was, rather than an intention to change it, their mistaken opinion concerning the law "does not make the law." (*Postmaster-General* v. *Early*, 12 Wheat. 148–50.) In that case, the question arose on the act of 1815, which directed, that the district court of the United States shall have

cognisance, concurrent with the courts and magistrates of the several states, and the circuit courts of the United States, of all suits, where they, or any of their officers, were plaintiffs: this court held, that these words gave jurisdiction to the circuit courts, though it did not exist before; thinking that it was plainly intended as a declaratory act, they felt justified in adopting their meaning. When such cautious language is used on a mere question of jurisdiction, I may safely assume it as a clear principle, that on a question of property, of a favored right, the act of 1802 will not be favorably or benignly construed against it, so as to throw impediments to its vesting or enjoyment, by equitable construction, refined implication, or an adoption of a mere legislative opinion, as a declaratory law. This would be in opposition to the principles laid down in the preceding case, and to all the canons of the law in the exposition of statutes; for the act of 1802 does not profess to prescribe for the future any other rule of construing the act of 1790, than what had prevailed before, or to make any provision essential to the right, which was in its terms only directory. The words amount to no more than a legislative opinion on the effect of a former law, which is not enough to even justify this court in adopting it, unless "congress has explained its meaning too unequivocally to be mistaken," that the act was intended to be a distinct, substantive, prospective law, plainly declaring and enacting a new rule for the future.

There is nothing of this kind in the act. "He shall, in addition to the requisites enjoined," &c. A requisite is merely a thing required, directed or enjoined. The meaning is the same, whether the one or the other mode of expression is used. The direction of a law is as imperative as a requisition or injunction. The question is not, what is a requisite, but for what purpose it is enjoined, to secure, grant or create a right of property, a remedy for its violation, or a right to recover the penalties and forfeitures prescribed by statute. Everything directed by the act of 1790 is a requisite enjoined: the recording the title to secure the copyright, the publishing in a newspaper to give the penalties and forfeitures, and the delivery to the secretary of state a copy "to be preserved in his office." The act of 1802 adds another, to give information by the publication of the record on the title leaf, before he shall be entitled to the benefit of the act; this is the whole effect of the first section, which is intended for no other purpose. Had it been intended to make the delivery of a copy to the secretary of state essential, either to the right of property, under the first section of the act of 1790, or to the penalties, &c., under the second, or to have enacted a declaratory law, making the act which was a requisite only for one purpose, an indispensable condition to any legal security to the copyright; the author would not have been left in the perfect enjoyment of his rights to all the penalties and forfeitures created for his benefit, by the second section of the act of 1790. Something would have been added, which would have made it the declared sense and enactment of congress, that he should enjoy nothing, unless he performed everything required; and that something must be made essential, by an an express provision, by legislation, or what is tantamount. This court is not justified in adopting as a declaratory act, a mere opinion of the legislature, inferred from the use of the words "requisites enjoined;" for such inference, if correct, is only an indication of a mistaken construction, which cannot make a law. A similar question arose on the 5th

section of the statute of Anne, which directed a deposit of nine copies of each book for certain libraries, which had been uniformly held to be merely directory, the right to the copies attaching, though they were not deposited in Stationers' Hall. The statute 41 Geo. III. provided, "that in addition to the nine copies now required by law to be delivered, &c., one other copy shall, in like manner, be delivered," &c. It was contended, that this was a legislative declaration of the construction of that section of the statute of Anne, which was binding on the court; but the king's bench refused to adopt it, as they deemed it an evident "misconstruction, not a positive interpretation of a former act, imposed by the legislature in a subsequent act; but by the provisions which the legislature have made, they seem to have apprehended that such was the construction of the statute of Anne." (16 East 318, 333.)[1] The established rules of law must lead to the same conclusion in the present case.

The question is, whether the act of 1802 either abrogates any right secured to authors by the act of 1790, imposes conditions upon the vesting of any right, not before conditional or limited, or makes it our duty so to construe the former law, as to make it conform to the construction which may seem agreeable to the opinion of the legislature as indicated in the latter. "Acts of parliament ought not, by any constrained construction out of the general words of a subsequent act, to be abrogated, but ought to be maintained and supported with a favorable and benign interpretation, to abrogate as little as may be." (11 Co. 63 *a*, *b*.) "A subsequent act, which may be reconciled with a former one, shall not be a repeal of it." (11 Co. 63 *b*; 1 Bl. Com. 89; 5 Com. Dig., by Day, 325.) "A later statute, general and affirmative, does not abrogate a former, which is particular." (6 Co. 19 *b*.) The bare recital in a statute is not sufficient to repeal the positive provisions of a former statute, without a clause of repeal. (2 T. R. 365.) The sense of words used in an explanatory act is not to be extended by equity, but their meaning, this being a legislative exposition of a former act, must be strictly adhered to. (4 Bac. Abr. 650.) Nor shall a statute be expounded by equity, to overthrow an estate, or to take away a right, *d fortiori*, to expose a party to a penalty. It is to be hoped, that the time is far distant when any court will extend the words of a penal statute beyond their plain uncontroverted meaning, for the purpose of forfeiting an existing right, or the infliction of fines and penalties.

It seems to me, therefore, to be the clear result of these cases, and rules of construction, that the first and second sections of the act of 1790, are in full force; that the right of property, and to the penalties and forfeitures, are neither abrogated or made dependent on the performance of any act not essential to the title by its terms, as judicially expounded, and that the act of 1802 is not declaratory of any new rule for the future, as a legislative act, save in the one additional requisite. Congress have given to it the same practical construction in the act of 1831. The only requisites which it enjoins upon the author are, that he shall record a copy of the title with the clerk of the district court, deposit a copy of the book in his office, and publish a copy of the record on the title leaf. He is not required or directed to make any publication in a newspaper, or to deposit a copy with the secre-

[1] S. P. Jollie *v.* Jaques, 1 Bl. C. C. 618.

tary of state. This is a fair ground of inference that these two requisites were never deemed by the legislature to be essential to the vesting the title, or they would have been retained. Indeed, when we look at the nature of these acts, there appears no reason why they should be so considered. A publication in any newspaper, printed anywhere in the United States for four weeks, would be a compliance with the law; it cannot be pretended, that this would answer any valuable purpose as notice, or for information, to warn any person from invading the copyright. The publishing the copy of the record on the title leaf, as directed by the act of 1802, was to "give information." It was effectual notice, for none who would look at the book would fail to see the impress of copyright on the title-page, or the next succeeding one; so that none could offend ignorantly. Whatever reasons, therefore, there might be for requiring a publication in a newspaper, when no other notice was required, they wholly ceased, when another more efficient notice was prescribed; the former was mere legal implied notice; the latter was a notice in fact, which no man could either overlook or mistake. This affords, to my mind, a conclusive reason why this act should be deemed merely directory, because if the publication was made, it was no notice in fact; if omitted, it injured no one, and the law of 1802 provided an effectual practical substitute, by notice in fact. The delivery of a copy of the book to the secretary of state could not operate as notice, or be of any importance to the public; the law directs no record of the delivery, nor any mark to be affixed to the book, to show that it was delivered in order to secure the copyright, nor could it be distinguished from the mass of books in the library of the department. Congress, no doubt, intended the fourth section of the act of 1790, as the parliament did the fifth section of the statute of Anne, but directed the delivery of only one copy of the book instead of nine, for which there was a sufficient reason, in the complaints of the printers and booksellers in England, of the heavy tax which was imposed on them for the benefit of the libraries of the universities and colleges, the extent of which may be seen in Maugham on Literary Property. In this particular, the act of 1831 is strongly indicative of the sense of the legislature, that the act was not essential to the right, for the author is now required only to deliver a copy to the clerk, who is directed to transmit it to the secretary of state.

This is the more apparent, when we connect this law with the decision of Judge WASHINGTON in *Ewer* v. *Coxe*, which was first published in 1829, and the decision of the supreme court of Connecticut in 1808, which must be presumed to have been well known to the members of the judiciary committee who framed this law. It will be observed, that the fourth section is left open to the same construction that is given in those cases to the third and fourth sections of the act of 1790, which is a legislative adoption of the rule laid down; the direction to the author to deliver the copy to the clerk, as well as to the clerk to transmit it to the secretary of state, are in distinct sentences, wholly unconnected with the preceding part of the sentence, making the record of the title essential to the copyright. On the other hand, the fifth section, which makes the publication on the title leaf an essential requisite, in express terms, is a plain legislative declaration, that the delivery of the copy of the book is not so—*expressio unius, est exclusio alterius*, is a universal maxim in the construction of statutes (6 Pet. 725), thus excluding all grounds for construing the act of 1831 as Judge

WASHINGTON had construed the act of 1802. Taking them in connection with the act of 1790, as laws *in pari materia*, I cannot believe, that it was ever intended by congress, that any publication in a paper, or delivery of the book, should be indispensable to the vesting, as well as enjoyment of the right. These directions are in themselves so entirely unimportant for any practical purpose, especially, in a case like present, where the respondents had the most ample notice in fact of the claim and possession of the copy-right by the complainants, that I can perceive no reasonable ground for any other conclusion. Admitting, to its full extent, the obligation of judges to follow the words of a law, however unreasonable, if they are explicit, and do not admit of construction, I cannot overlook general usage, or the reason and rule of the common law, in the construction of laws which are doubtful in their terms, or so construe them against common right or reason, as to make them work a wrong, or where a right is given by particular words, adjudge it to be taken away by subsequent general words. (1 Bl. Com. 91; 19 Vin. Abr. 511, 528; 5 Day's Com. Dig. 326, 330; 4 Bac. Abr. 644, 650.) If reason is to be at all applied to the acts of congress, if the elementary rules of the law are to be guides to the interpretation of the statutes, I am utterly at a loss to divine one, which can authorize the construction which the counsel for the respondents put upon the act of 1802. All semblance of reason for making the delivery of a copy to the secretary of state essential to a copyright in the reports of the decisions of this court, seems to me to disappear before the act of 1817, which requires the reporter to deposit eighty copies in the office. As a matter of notice to the respondents, or of any concern to the public, the difference between the delivery of eighty or eighty-one copies in the same office, is certainly extremely small; if the object of the law was, to have the book identified, it could as well be done by any one of the eighty copies delivered under the reporter's, as by the one delivered under the copyright act. The latter has no ear-mark by which it can be distinguished from the others; and surely it is testing the reason of the law by a very paltry standard, when an important right of property is made to depend on the question, whether a book was placed on the shelves of the library, or in the lumber-room of the department of state, under the one law or the other; in other words, whether it was done by Mr. Wheaton, the author, by Mr. Wheaton, the reporter, or by Mr. Donaldson, the purchaser. The book is where it ought to be, each copy has the impress of copyright on the title-leaf, and human wisdom cannot discover which copy is the one so essential to secure the right; nor has the law directed any mark to be put upon it, a record of the delivery to be made, or a certificate to be given to the author, as is directed in the recording the copy of the title; nor is any notice of the delivery directed to be published.

It is proved and admitted, that eighty copies of the last eleven volumes were deposited, under the act of 1817, in the department of state. Now, a very simple question arises, shall the omission to deliver the one additional copy, annul the right of a reporter to the interference of a court of equity for the protection of a quiet and peaceable possession and enjoyment of property claimed under color of law, during fourteen years, against a party who has acted in the fulness of actual notice. The spirit of the law forbids it. In England, the omnipotence of parliament is not potent enough to

induce its courts to enforce a law which is against common right and reason. The common law shall control and adjudge it void. (5 Day's Com. Dig. 331; 19 Vin. Abr. 512-13, pl. 15; 1 Bl. Com. 91; 8 Co. 118 *a.*) It is enough for the purposes of this case, that such effect be not caused by construction, as to make a law unreasonable, absurd or unjust, when its terms are not too explicit for explanation, or its mandate too imperative to be disregarded.

That the legislature shall never be *presumed* to exact anything as a condition to the vesting or enjoyment of a right, which is repugnant to to reason, justice or the settled rules of the common law, is a rule of universal application, on which this court has acted, against the express words of an act of congress. The 65th section of the collection act of 1799, authorizes the district court to continue a suit on a revenue bond, "until the next succeeding term, and no longer:" yet it has been twice decided, that "the legislature intended no more than to interdict the party from an imparlance, or any other means or contrivances for mere delay;" not to bar the party from any defence to the suit on the merits. "And certainly, we ought not, in common justice, to presume such an intention without the most express declarations." (6 Pet. 644.) I think the present a case which calls for the application of the same principle; there can be none presented for my consideration, in which there is less reason for extending the provisions of a law by equity, so as to defeat a right of property by construction, or in equity, or in which there are more cogent ones for the most liberal and benign interpretation of the laws enacted for its security.

When the law points an author to certain acts, on the performance of which his rights to its benefits are declared to depend, he has notice of his danger, and omits them at his peril; but he is thrown off his guard by a provision, merely directory, explanatory, or constructive of a former law, to which the legislature attach no legal consequence. It would be, in my opinion, an imputation on the faith of the legislature, to presume, that they intended to make anything indispensable to the title, which they had not declared to be so; the author, whose property would be deprived of security, under which it had been placed, might justly complain of the want of notice of his danger; and the duty of a court would seem to me a plain one, not to permit it to become extinct, unless the law compelled them to surrender the justice of the case to its positive commands. I can perceive, in the act of 1802, no such provisions, nor any words which can warrant the construction contended for; considering this and the act of 1790 as involving only a question of property.

But there is another view of the act of 1802, which is inseparably contected with the copyright. By the fourth section, a penalty of one hundred dollars is imposed on any person who publishes a book with the impress of copyright, if he has not legally acquired it. (2 U. S. Stat. 172.) This, then, is a penal law, by which a penalty has been incurred for the publication of every volume of Wheaton's reports, either in a first or second edition. If he has not secured the copyright according to law, the penalty attaches for claiming property in them, for "impressing thereon that the same has been entered according to act of congress, or words purporting the same, or that the copyright has been acquired." The same assertion in print, how

ever strongly the author may be convinced of its truth in law and fact, is made at the peril of a heavy penalty. The law is express: if he has not legally acquired the copyright, the penalty must be paid to a common informer and the United States. The author's copyright, and his money, share a common fate. If, "according to the course and principles of courts of equity," by which the relief asked for is to be granted or refused, we are bound or at liberty to so construe the laws concerning copyright, as to adjudge that the complainants are entitled to no relief, unless they prove, before a jury, the publication of the record of the title, and the delivery to the secretary, we, by the same decree, declare them liable to a penalty, if sued for in two years. So that whatever construction the acts of 1790 and 1802 shall receive on the question of property, becomes fastened on them as a question of a penal forfeiture, and must be made by the same rules.

The whole question then is, whether such laws shall be construed strictly, so as to save both property and a penalty, or liberally, benignly, and by equity, to forfeit a right, and subject the party to a penal action for claiming it; the controversy is narrowed to this point, and the rights of the litigant parties depend upon the rule by which such a statute must be expounded. The foregoing are the reasons on which I have come to the conclusion, that it must be so construed as to avoid all forfeitures and penalties not imposed or incurred by plain, express enactments, the consequence of which ought to be, a decree for an account, and a perpetuation of the injunction.

This cause came on to be heard, on the transcript of the record from the circuit court of the United States for the eastern district of Pennsylvania, and was argued by counsel: On consideration whereof, it is ordered, adjudged and decreed by this court, that the judgment and decree of the said circuit court in this cause be and the same is hereby reversed, and that this cause be and the same is hereby remanded to the said circuit court, with directions to that court, to order an issue of fact, to be examined and tried by a jury, at the bar of said court, upon this point, whether the said Wheaton, as author, or any other person, as proprietor, had complied with the requisites prescribed by the third and fourth sections of the said act of congress, passed the 31st day of May 1790, in regard to the volumes of Wheaton's reports, in the said bill mentioned, or in regard to one or more of them, in the following particulars, viz., whether the said Wheaton or proprietor did, within two months from the date of the recording thereof in the clerk's office of the district court, cause a copy of the said record to be published in one or more of the newspapers printed in the resident state,
*699] for four weeks; and whether the *said Wheaton, or the proprietor, after the publishing thereof, did deliver or cause to be delivered to the secretary of state of the United States, a copy of the same, to be preserved in his office, according to the provisions of the said third and fourth sections of the said act; and that such further proceedings be had therein, as to law and justice may appertain, and in conformity to the opinion of this court.