

ABSTRACT

O’Rielly v. Morse: Reevaluating a Foundational Patent Case in Historical Context

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Samuel Morse’s telegraph is a famous example of early American innovation, and his legal fight to protect his patent in the telegraph is equally famous. The Supreme Court’s 1853 decision in *O’Rielly v. Morse*, invalidating Claim 8 of Morse’s patent, is a foundational patent case: it is reprinted in almost all patent law casebooks, it is discussed in contemporary scholarship, and it is cited by modern courts as determinative precedent, appearing recently in the Federal Circuit’s decisions in *Ariad* and *Bilski*. Although scholars dispute whether *Morse* is a patentable subject matter or a written description case, everyone seems to agree that the decision was correct. This conventional wisdom, though, obscures something even more important: it is a profoundly anachronistic judgment, and it fails to account for the historical context in which Morse invented and patented the telegraph.

This paper reinserts historical context back into the modern assessment of Morse’s patent in two ways. As an important first step, it situates Morse’s patent within the context of antebellum patent doctrine, which is necessary because there are at least two significant differences from antebellum and modern patent law. First, the use of technical claims to define the periphery of an invention was neither legally mandated nor a norm of practice in antebellum patent law. Early inventors described and claimed only the “principle” of their inventions, disclosing the core contribution of their novel and useful inventions. Second, as a logical corollary of the absence of peripheral claiming, there was no formal distinction yet between literal and doctrine of equivalents infringement. Before the 1853 decision in *Winans v. Denmead*, which affirmed the doctrine of equivalents as a separate infringement doctrine, patent infringement cases focused only on whether an alleged infringing device reflected the “essential principle” of the patented invention. Unsurprisingly, these two issues were front and center in Morse’s lawsuit against Henry O’Rielly, as revealed in the pleadings, depositions, hearing testimony, and in the subsequent appeal in which O’Rielly achieved a pyrrhic victory in invalidating only Claim 8 of Morse’s patent on the telegraph.

Why did the *Morse* Court invalidate Claim 8, precipitating the historical myth that now exists concerning this case? The second contribution of this paper is the answer to this question, identifying a lacuna in the omnipresent modern references to historical patent law cases like *Morse*: the fundamental role of a judge’s view of patents in these historical court decisions. The majority opinion in the 5-4 split decision in *Morse* was authored by Chief Justice Roger Taney, a fervent Jacksonian Democrat who viewed patents suspiciously as governmental monopoly grants. Modern patent scholars have failed to recognize an important connection between Taney’s decision in *Morse* and his dissent in the same year in *Winans*, in which he rejected the equivalents infringement doctrine. Taney’s positions in *Morse* and *Winans*, among other cases, confirm his view of patents as limited monopoly privileges that should be construed narrowly against patentees as per longstanding common law doctrine. In fact, Morse ultimately would have lost his case if the dissent had prevailed in *Winans*, because O’Rielly’s “People’s Telegraph” did not literally infringe Morse’s patent.

Taney’s generally anti-patent views were certainly part of the policy debates in his day and they remain so today, but it is time to correct the historical myth that his *Morse* decision correctly reined in the hubris of a self-aggrandizing inventor. In its historical context, Morse’s now-infamous Claim 8 simply identified the “principle” of his pioneering invention, as distinguished from the more specific embodiments set forth in the other seven claims. As revealed in the full case report for *Morse* and in related primary sources in the historical record, the valid meaning and purpose of Claim 8 was well understood among lawyers, judges and commentators in the antebellum era.