WHEATON v. PETERS

Supreme Court of the United States, 1834
33 U.S. 591

Mr Justice M'LEAN 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 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 *Miller v. Taylor*, reported in 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 Yeates, 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, afterward, 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.

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 favour 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 favour 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 Anne, ch. 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 Term Rep. 627, Lord Kenyon says, "all arguments in the support of the rights of learned men in their works, must ever be heard with great favour 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 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 any thing 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 *Miller v. Taylor* was in favour 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 endeavours to realise 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 labour as any other member of society, cannot be controverted. And the answer is, that he realises 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 realise 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 labours may be equally beneficial to society, and in their respective spheres they may be alike distinguished for mental vigour. 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 labour 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 labour 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 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 copy-rights, 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 *Miller 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 book of common prayer, and a few other books.

No such right at the common law had been recognized 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 condusive.

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.

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 recognized 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 an assignee of such manuscript, would be protected by a court of chancery. This is presumed to be the copyright recognized 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 of 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 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, 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 requisites to the perfection of the complainants' 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 deposite 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 or sanction of any public functionary.

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 requisites 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 of 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 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 deposite 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 deposite 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 connexion 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 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 Term Rep. 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 Anne, 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, hereafter 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."

The authority of this case is seriously questioned in the case of *Newton v. Cowie*, 4 Bingham 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 Alvanly, 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 deposite of a copy under the act of 1790. The eighty volumes were delivered for a different purpose; and cannot excuse the deposite 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 cause 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 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.

[DISSENT of Mr. Justice THOMPSON omitted. Mr Justice BALDWIN also dissented from the opinion of the court.]

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 decree 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, or order an issue of facts 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 states, 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.