O'Reilly v. Morse

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ABSTRACT

Chief Justice Roger Taney's 1854 decision in *O'Reilly v. Morse* is a famous patent case today. Scholars and judges dispute what legal rule it best represents, but everyone agrees that it was correctly decided: In voiding Claim 8 of Samuel Morse's patent on the telegraph, Chief Justice Taney reined in a self-aggrandizing inventor who improperly tried to claim control over virtually all telecommunication technologies. This conventional wisdom, however, is profoundly mistaken. It fails to account for the historical context in which Morse invented, patented, commercialized and ultimately was swept up in a sea of litigation over his innovative telegraph.

This paper corrects this anachronism by reinserting the full historical context back into our understanding of Morse's patented innovation. In addition to confirming that today's inventive activities and commercialization practices (like licensing) are not new, it reveals significant differences between antebellum and modern patent law, such as the lack of peripheral claiming in the Antebellum Era. Instead of defining the legal boundary of the property right in an invention, early American inventors described in a patent only the core essence or "principle" of an invention. Accordingly, patent infringement lawsuits focused only on whether a defendant's product or service reflected the "essential principle" of the patented invention. Morse's infringement lawsuit against Henry O'Reilly exemplifies perfectly these important differences in the law.

This historical context makes clear that Chief Justice Taney's *Morse* opinion was not a sterling exemplar of patent law. As a fervent Jacksonian Democrat, Chief Justice Taney viewed patents as state-granted monopolies, and not as fundamental property rights properly secured against piracy in the marketplace. His personal bias against patents led him to ignore established patent practices and law in *Morse*, focusing on Claim 8 out of context and treating it in the same way a peripheral claim would be construed by a judge today. It is only a happy accident for Chief Justice Taney that his judicial activism in *Morse* comports with much later developments in patent law, such as peripheral claiming, which make his opinion appear correct to our modern eyes—unlike his similar twisting of established law in *Dred Scott* to reach a result dictated by his personal political preferences.