

# ARTICLE

## “A CURIOUS CHAPTER IN THE HISTORY OF JUDICATURE”: *WHEATON V. PETERS* AND THE REST OF THE STORY (OF COPYRIGHT IN THE NEW REPUBLIC)

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#### OVERTURE: THE CASE AND THE PLAYERS

In the wake of the American Revolution, a new nation arose on the western shores of the Atlantic Ocean, in conception distinct from any other that had gone before. Lacking a sovereign or a strong central government, it was in many ways a curious society, both culturally and politically. Literature and discovery, the foundations of progress, existed without protection under any single law embracing all thirteen former colonies that had become, in name if not yet in fact, these “United States.” America, in due course to be the greatest engine of expression and invention in the history of the globe, was unable to protect either effectively.

A fledgling Supreme Court, of no significance to the world at large but destined to be transformed over time into the most powerful judicial tribunal ever created, struggled into being. The decisions of that body were at first almost entirely unknown to the people whose future they would govern because there was no systematic and reliable reporting of the Court's opinions. The early Republic's most eminent jurists were uncertain even with respect to the ownership of the texts of their decisions: Who—the judges themselves, the lawyers who reported the decisions, or the people of the land—owned the judges' accounts of the law?

Such was the state of law, and of law reporting, in America in the aftermath of the Revolution and during the half century that followed, culminating in the Supreme Court's great decision in *Wheaton v. Peters* in 1834.<sup>1</sup>

The *dramatis personae* of *Wheaton* include many of the giants of early American law. But there were others, too, unremembered today, whose ambition and investment in the future of the country would preserve the first stirrings of our national jurisprudence and the great constitutional decisions of the Marshall Court for generations to come.

The list begins, in order of importance as history has remembered the players, with John Marshall, the Great Chief Justice himself, and Joseph Story, Marshall's colleague on the Supreme Court for a quarter century and the greatest legal scholar of the age. The supporting cast among the Justices includes Bushrod Washington—nephew of George Washington and inheritor of both Mount Vernon and the papers of the first American president—as well as lesser lights whose infirmities of mind and body, though important to the story that follows, now are long forgotten.

The lawyers, too, are distinguished: Daniel Webster, noted orator, powerful politician, and leading Supreme Court advocate; William Pinkney, uncrowned king of the Supreme Court bar; Richard Rush, Attorney General of the United States; and a host of others.

Also making an appearance are Noah Webster (of dictionary fame), various patriots and presidents, a future Secretary of the Treasury, and a judge whose uncle, Washington's successor as president, saved him from financial ruin by appointment to a Washington, D.C. court on which he would serve for fifty-four years.

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1. 33 U.S. (8 Pet.) 591 (1834).

But the leading actors of the piece—compared to whom all others, however famous, would play but cameo roles—are the true antagonists. Henry Wheaton was a protégé, friend, and roommate of Story during their Washington winters, savior of the Reports of the Supreme Court of the United States, distinguished diplomat, and preeminent expounder of international law in nineteenth-century America. Nonetheless, Wheaton's adversary, Richard Peters, Jr., fortunate offspring of a well-placed father, a second-rate lawyer but brilliant entrepreneur, would emerge the victor in the Supreme Court decision that bears his and Wheaton's names.

The saga of *Wheaton v. Peters* is a tale of inherent dramatic structure and significance, recounted accordingly below. Wheaton himself, writing years later, put the point succinctly: "The incidents attending this case, should they ever be given to the world, would form a curious chapter in the history of judicature and indeed of human nature."<sup>2</sup> This is that story.

#### TIME AND PLACE: INTELLECTUAL PROPERTY AND LAW IN ENGLAND AND EARLY AMERICA

##### A. *What Is Intellectual Property?*

The United States today, at the beginning of the Third Millennium, is in most ways a vastly different place from post-Revolutionary America. But some things never change. Then, as now, even the most knowledgeable among the citizenry, including lawyers not schooled in the subject, could explain only with difficulty, if at all, what "intellectual property" is.<sup>3</sup>

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2. Letter from Henry Wheaton to Levi Wheaton (Apr. 15, 1840), in Wheaton Papers (on file with the Pierpont Morgan Library, New York, N.Y.). Throughout this Article, all cited correspondence and other primary materials from the Morgan Library collection are used with the permission of the Morgan Library.

3. The World Intellectual Property Organization (WIPO) defines "intellectual property" as the rights owned in "creations of the mind: inventions, literary and artistic works, and symbols, names, images, and designs used in commerce." WIPO, *About Intellectual Property*, at <http://www.wipo.int/about-ip/en> (last visited Apr. 22, 2005). The term seems first to have achieved common currency in nineteenth-century Europe. It attained formal international recognition in 1893, when WIPO's predecessor organization, the United International Bureaux for the Protection of Intellectual Property (best known by its French acronym "BIRPI"), was formed by member states of the Paris Convention (patent law) and the Berne Convention (copyright law) to advance transnational protections for industrial property and works of literature and art. See WIPO, *WIPO Treaties—General Information*, at <http://www.wipo.int/treaties/en/general> (last visited Apr. 22, 2005). In the United States, the nomenclature "intellectual property" first appeared in a judicial decision, *Davoll v. Brown*, 7 F. Cas. 197, 199 (C.C.D. Mass. 1845) (No. 3662), but it gained general circulation only after WIPO's creation in 1970.

Suppose that today you buy a CD by your favorite hip-hop artist. Do you now own intellectual property? No, you do not. The physical object you purchased is “chattel property.” But there are two types of property it is *not*. Chattel property, while tangible, is also movable. It is thus not “real property,” such as the plot of land on which your house is located (or, indeed, the house affixed to that land). More importantly for present purposes, however, your CD is not an intangible product of the human mind, which is what “intellectual property” is.

The lyrics and the music on your CD, which are captured on your own disk and perhaps thousands of others, is intellectual property. The lyrics and the music are the subject of copyright law.<sup>4</sup> The design of the mechanical workings of the equipment (and perhaps also the process) that produced your disk may be intellectual property as well. Those are the subject of patent law. The rights accorded by those two bodies of law—the rights, for example, to reproduce and distribute copies of the CD and to manufacture, or to license others to manufacture, the machines that produce CDs<sup>5</sup>—are what make intellectual property valuable.<sup>6</sup>

No works of late eighteenth-century American hip-hop artists remain extant. But examples of intellectual property do. Noah Webster’s spelling and grammar texts, for instance, which he began publishing in 1783, today would be protected as “original works of authorship fixed in a [ ] tangible medium of expression”<sup>7</sup> under the law of copyright. The design of the printing press on which copies of those books were printed,

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The foregoing description, along with other matter in the present Part, will appear in revised form in Craig Joyce, *Intellectual Property Law: United States*, in *ENCYCLOPEDIA OF LEGAL HISTORY* (Stanley N. Katz ed., forthcoming Nov. 2005) and is adapted here by agreement between the Author and Oxford University Press.

4. Copyright holders own the exclusive right, for the duration of their copyrights, to reproduce the copyrighted work, prepare derivative works based upon it, distribute copies or phonorecords embodying the work, and perform or display the work under conditions specified in 17 U.S.C. § 106 (2000).

5. Patent holders own, for a limited period, “the right to exclude others from making, using, offering for sale, or selling” their inventions within, or importing them into, the United States. 35 U.S.C. § 154. If the subject of the patent is a process, the patent holder may preclude others from “using, offering for sale or selling throughout the United States, or importing into the [country], products made by that process.” *Id.*

6. Other branches of intellectual property law exist under federal and state law. These include trademark law, trade secret law, the right of publicity, and unfair competition law generally. Only copyright and patent law, however, are recognized in the U.S. Constitution. U.S. CONST. art. I, § 8, cl. 8.

7. 17 U.S.C. § 102.

assuming the design was “new,” “useful,” and “nonobvious,”<sup>8</sup> would be protected under patent law.

*B. English Antecedents*

The roots of American copyright law (the subject of the *Wheaton* case), like the roots of most other branches of post-Revolutionary law (including the law of patents),<sup>9</sup> lie in Merrie Olde England.

England at mid-millennium, however, was not a merry place. In 1476, William Caxton introduced the first printing press into England. In 1534, King Henry VIII split the Church of England from the Church of Rome and began shedding wives. By 1649, the Roundheads were rampant and King Charles I had been beheaded. Piety and the arts flourished, notwithstanding: The Bible saw many printings during the period, as did Shakespeare’s plays. But the literature of the day also included many tracts deemed heretical or treasonous by the Crown (whoever’s head happened to be wearing it).

Thus, control of the presses, and of those who operated them, became a matter of paramount concern in the conduct of government. That concern led directly to the beginnings of the law of copyright when, in 1556, the Crown partnered with the publishers (or “stationers”) of London—who purchased from authors of the day their manuscripts (or “copies”) for printing and vending—to control all trade in books. Later decrees and licensing acts sustained that system until 1694 when, with the Protestant Succession assured, the Crown’s purposes no longer required such devices of censorship.

In 1710, responding in part to entreaties by the publishers, Parliament enacted the Statute of Anne,<sup>10</sup> the first copyright legislation anywhere. That act, intended to avoid the prior evils of monopoly and censorship, temporarily grandparented the stationers’ rights in works already printed.<sup>11</sup> More importantly, however, the legislation vested in *authors themselves* the rights

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8. 35 U.S.C. §§ 101, 103.

9. Because the focus of *Wheaton*, and of this Article, is copyright law, related developments in patent law will appear occasionally hereafter in the text, but more often in the footnotes, as appropriate. The origins of American patent law, which had Continental European as well as English precursors, are discussed in Joyce, *supra* note 3, and in DONALD S. CHISUM ET AL., *PRINCIPLES OF PATENT LAW* 10–15 (3d ed. 2004).

10. 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, 1710, 8 Ann., c. 19 (Eng.) [hereinafter Statute of Anne].

11. *Id.*

to *print and sell* works new to the market, again subject to conditions specified in the statute and expiration after a term of years.<sup>12</sup>

In short, the Statute of Anne was designed primarily to encourage the creation of new works—and to subject all works, relatively quickly, to entry into what today we call the “public domain.” The stationers sought in court to reestablish their claim to *perpetual* protection, based on the natural rights of their assignors.<sup>13</sup> In 1774, however, on the eve of the American Revolution, the House of Lords, in *Donaldson v. Beckett*, determined copyright, at least as to published works, to be a creature of statutory grant alone.<sup>14</sup>

12. *Id.*

13. The famous Battle of the Booksellers—in which the stationers almost attained their goal of establishing these perpetual rights in *Millar v. Taylor*, 98 Eng. Rep. 201 (K.B. 1769), only to see that decision overturned by the House of Lords in *Donaldson v. Beckett*, 98 Eng. Rep. 257 (H.L. 1774)—is recounted in detail in LYMAN RAY PATTERSON, COPYRIGHT IN HISTORICAL PERSPECTIVE 158–79 (1968).

14. The text above acquiesces in the conventional taxonomy of copyright law, which assumes, in addition to the private copyright of the stationers, two types of public copyrights: for published works, *statutory copyright*, arising by virtue of positive law; and for unpublished works, what generally has been called *common law copyright*, arising by virtue of natural law.

Analytically, the concept of common law copyright is fraught with difficulty. The core concept of copyright law, from the stationers forward, has been the right to copy (and to vend). Today, although the law recognizes additional rights (including the rights to prepare derivative works and to perform and display works publicly), U.S. copyright remains “[a] federal right . . . conferring the exclusive right to *exploit the work* in specified ways.” J. THOMAS MCCARTHY ET AL., MCCARTHY’S DESK ENCYCLOPEDIA OF INTELLECTUAL PROPERTY 120 (3d ed. 2004) (emphasis added).

“Common law copyright,” on the other hand, at least prior to enactment of the Copyright Act of 1976, concerned the author’s proprietary interest in a work *prior to* publication, i.e., prior to duplicating, selling, or otherwise exploiting the work. Although the common law right sometimes was described as a right of first publication, that usage existed uncomfortably alongside the fact that the right, in effect, evaporated the moment the act of publication occurred, and with it any right to control copying of the work unless a *true* copyright (a federal statutory copyright) was obtained. See, e.g., L. Ray Patterson, *Free Speech, Copyright, and Fair Use*, 40 VAND. L. REV. 1 (1987). The right at common law, then, might be more properly described as the right to *prevent an unauthorized publication of a previously unpublished manuscript*, not as a copyright.

Historically, the notion of “common law copyright” likewise is suspect. Far from having existed from a moment in time to which the memory of humankind runneth not, the right was not asserted prior to 1710 (during the period governed by the stationers’ private right), nor indeed before 1731 (when grandparenting protection under the Statute of Anne for pre-1710 rights expired). Only after 1731 were authors’ perpetual rights in their works claimed by English booksellers for their own benefit as assignees of authors’ supposed rights, leading Lord Chief Justice DeGrey to observe witheringly in *Donaldson*:

The truth is [that] the idea of a common-law right in perpetuity was not taken up till after that failure in procuring a new statute for an enlargement of the term. If (say the parties concerned) the legislature will not do it for us, we will do it without their assistance; and then we begin to hear of this new doctrine, the common law right, which, upon the whole, I am of opinion, cannot

What remained to be done across the ocean in America was for the framers of American copyright law to assimilate and enact in barely a decade—starting with their first acts under the Articles of Confederation and concluding with ratification of the First Amendment in 1791—what it had taken two centuries for their English forebears to accomplish.<sup>15</sup>

### C. Confederation and Constitution

The Founding Generation, while determined to break politically from the Mother Country, had no need to revise wholesale the everyday law, including the law of intellectual property, already received on their shores. In the run-up to the Revolution, Edmund Burke, in his 1775 conciliatory speech in Parliament, described succinctly the colonists' interest in, and familiarity with, English law since its first importation a century and a half before:

In no country perhaps in the world is the law so general a study. . . . I have been told by an eminent Bookseller, that in no branch of his business, after tracts of popular devotion, were so many books as those on law exported to the Plantations. The Colonists have now fallen into a way of printing them for their own use. I hear they have sold nearly as many of Blackstone's Commentaries in America as in England.<sup>16</sup>

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be supported upon any rules or principles of the common law.

Donaldson v. Beckett, 17 PARL. HIST. ENG. 953, 991–92 (1774). In the end, the booksellers were rebuked. The most careful study of the many confusing reports of the case concludes that “the holding in *Donaldson v. Beckett* was clearly that the common law had not and did not recognize the existence of copyright.” Howard B. Abrams, *The Historic Foundation of American Copyright Law: Exploding the Myth of Common Law Copyright*, 29 WAYNE L. REV. 1119, 1164 (1983). If “common law copyright” never amounted to more than the right to control one's manuscript *pre-exploitation*, it would seem a “copyright” in name only, and then erroneously.

All the same, usage of the term with respect to rights in unpublished works was well established in the literature and the cases before 1978, when the present Copyright Act came into operation. Even that epochal shift of the moment when federal copyright arises—from the moment of general publication in compliance with statutory notice requirements to the moment of fixation of original expression—seems unlikely to bury the old terminology. Thus, references to “copyright” hereinafter are accompanied by the traditional (but perhaps technically inaccurate) qualifier “in published works.”

15. For a detailed recounting of the history summarized above (as well as the history through 1791 that follows), see generally L. Ray Patterson & Craig Joyce, *Copyright in 1791: An Essay Concerning the Founders' View of the Copyright Power Granted to Congress in Article I, Section 8, Clause 8 of the U.S. Constitution*, 52 EMORY L.J. 909 (2003).

16. EDWIN WOLF II, *THE BOOK CULTURE OF A COLONIAL AMERICAN CITY: PHILADELPHIA BOOKS, BOOKMEN, AND BOOKSELLERS* 131 (1988) (quoting Edmund Burke, Speech of Edmund Burke, Esq. on Moving His Resolution for Conciliation with the

Upon gaining independence, however, the new nation lacked entirely a central government sufficiently powerful, as Parliament had been in England, to enact intellectual property laws whose writ ran to all subordinate political jurisdictions throughout the land. Instead, prior to the Constitution, the newly formed states were, in every respect, the masters of the Continental Congress created by the post-Revolutionary Articles of Confederation.

Modeling English law, in 1783 Congress recommended that the states pass copyright legislation—a matter beyond its own powers. The enactments differed in many particulars, thereby depriving authors of a uniform right to protection throughout the nation. Experience quickly demonstrated, as James Madison would write in No. 43 of the *Federalist Papers*, that “[t]he States cannot separately make effectual provision for [copyrights].”<sup>17</sup>

Thus, in 1787, the Constitutional Convention, at the urging of Madison and others, unanimously approved a provision empowering a new U.S. Congress to do what its predecessor could not: enact uniform *national* laws to protect copyrights (and patents). The result was Article I, Section 8, Clause 8: “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.”<sup>18</sup> Thus was born the Copyright and Patent (or, as is often said in modern times, Intellectual Property) Clause<sup>19</sup> of the Constitution that governs us to this day.

The provision carefully circumvented the problems of the stationers’ copyright under the licensing acts and the state copyright statutes under the Articles of Confederation by empowering the national legislature to accord to authors (not publishers), for prescribed times (rather than in perpetuity), a well-established set of rights in original expressions of human intellect. Of course, the Copyright and Patent Clause did not itself prescribe the details of the rights that “Congress sh[ould] have Power” to create. That task was left to another day, after the

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Colonies (Mar. 22, 1775)).

17. Madison said the same of patents. See THE FEDERALIST NO. 43, at 239–40 (James Madison) (Clinton Rossiter ed., 1961).

18. U.S. CONST. art. I, § 8, cl. 8.

19. In eighteenth-century usage, “Science” referred to the products of authors and “useful Arts” referred to the works of inventors. See *Graham v. John Deere Co.*, 383 U.S. 1, 5–6 (1966) (discussing the phrase “useful Arts” in its relation to innovation and invention). Thus, the Copyright and Patent Clause enables Congress, should it adopt positive enactments, to promote the progress of “Science” by securing for “limited Times” to “Authors” the “exclusive Right” to their “Writings.”

Founders had secured the adoption of the proposed Constitution in 1788 and organized the first government thereunder in 1789.

*D. "Writings," "Discoveries," and Law Through 1787*

The first federal copyright and patent laws were enacted by Congress in 1790. Statutory revision of copyright law followed in 1801, 1819, and 1831 and of patent law in 1793 (and, subsequent to *Wheaton*, in 1836, when Congress laid the foundation for the modern patent system). These enactments, however, must be understood in the context of the developing national culture—and cultural industries—that gave rise to them. Indeed, the story of American creativity during the early years of the Republic amply justified the Framers' belief that intellectual property laws national in scope would indeed be accompanied by signal progress in the promotion of "Science and useful Arts."

"Discoveries" had not been unknown during the colonial period, but "Inventors" in America had enjoyed little encouragement under royal patent law. At least until the beginning of the seventeenth century, the Crown liberally awarded monopolistic grants, covering long established and publicly beneficial goods and industries, to English court favorites.<sup>20</sup> Even after the Statute of Monopolies (1624), the sovereign retained the power to grant "letters patent" (from the Latin term referring to an "open letter" by the Crown "to all to whom these presents shall come") to the favored few.

The Revolutionary Era gave impetus to invention (and manufacturing) in America.<sup>21</sup> Boycotts preceded the war; the war itself eliminated English competition; and independence brought new challenges, including the need to encourage export industries. Under the Articles of Confederation, however, increased conflicts among competing inventors claiming patents under grants from the separate states seemed inevitable.

"Writings," like "Discoveries," had advanced apace in the New World prior to 1776, ranging from the fiery sermons of colonial preachers, like Jonathan Edwards' *Sinners in the Hands of an Angry God* (1741), to the incendiary tracts of Revolutionary patriots, like Thomas Paine's *Common Sense* (1776). Jefferson, Madison, Washington, and their fellow Founders were all

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20. See *id.* (indicating that Article I, Section 8, Clause 8 of the U.S. Constitution was written in order to avoid such practices from taking shape in the United States).

21. See generally NEIL LONGLEY YORK, *MECHANICAL METAMORPHOSIS: TECHNOLOGICAL CHANGE IN REVOLUTIONARY AMERICA* (1985) (describing the rise of technology in the United States).

“Authors,” chronicling everything from the natural wonders of America in their personal writings to the creation of America’s new political landscape in their public pronouncements.

In the pantheon of post-1776 authors, however, Noah Webster occupies a unique place as “the father of [America’s] cultural independence.”<sup>22</sup> A one-time Connecticut schoolteacher and lawyer, his works—including *A Grammatical Institute of the English Language* (ultimately, a combination speller, grammar, and reader) and *American Dictionary of the English Language* (70,000 words, all prepared by Webster himself, working alone)—more than any other force in the Early Republic helped transform American English into a powerful engine of common nationhood. Along the way, too, Webster contributed in singular fashion to the development of copyright law in the United States.

Webster began work on his first spelling book in 1780. But the colonies’ recent political break from the Mother Country, which Webster fervently supported, meant as a practical matter that English copyright law no longer governed American publishing. Thus, in 1782, encouraged by the success of drafts of his pioneering work in the classroom and determined to protect it nationally, Webster journeyed to Philadelphia to buttonhole members of the Continental Congress for their support—only to be informed by such luminaries as Jefferson and Madison that the Articles of Confederation gave them no such authority.<sup>23</sup>

Congress did, however, on May 2, 1783, adopt its Resolution encouraging individual states to enact their own laws “secur[ing] to the authors or publishers of any new books not hitherto printed, being citizens of the United States . . . the copyright of such books” for a term of “not less than fourteen years,” renewable if the authors should survive the first term of protection, “by such laws and under [such] restrictions as to the several states may seem proper.”<sup>24</sup>

On October 2, 1783, the first edition of Webster’s little spelling book—the first work on *American*, as distinguished from

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22. The phrase is borrowed, with thanks, from Harlow Giles Unger’s superb book, on whose work the succeeding descriptions of Webster’s contributions are based. See HARLOW GILES UNGER, *NOAH WEBSTER: THE LIFE AND TIMES OF AN AMERICAN PATRIOT*, at xi (1998). As summarized by Unger, “[Webster’s] words reached American minds in every home and classroom and transformed the nation from a Babel of conflicting tongues—English, Dutch, French, German, and innumerable others—into the first nation on earth where generations of diverse people would speak and think in one language as one people.” *Id.*

23. *Id.* at 55.

24. 24 JOURNALS OF THE CONTINENTAL CONGRESS 1774–1789, at 326–27 (Gaillard Hunt ed., 1922).

*English*, spelling—emerged from the press. Compliance with the relevant “laws . . . and . . . restrictions” of his home state meant only that Webster obtained copyright protection in Connecticut.<sup>25</sup> Relying on friends in the North and ultimately a personal tour of dignitaries in the Middle States and the South, Webster hoped to assure the passage of copyright laws by every legislature.<sup>26</sup> In the end, all but Delaware agreed.<sup>27</sup> While by no means alone in his efforts, Webster and his advocacy played a critical part in securing at least limited copyright protection for American authors in the years preceding the adoption of the Federal Constitution.

By the time Madison, Washington (whom Webster had lobbied and charmed in Virginia on his Southern swing), and the other Framers gathered again at Philadelphia in 1787, Webster was in residence, waiting.<sup>28</sup> He had become fast friends with Franklin and dined regularly with the “Convention Gentlemen,” as he called them. On August 18, Madison proposed among other powers “proper to be added to those of the general legislature,” including authority to grant patents, the power “[t]o secure to literary authors their copyrights for a limited time.”<sup>29</sup> On September 17, the Convention ratified a charter for national government—the Constitution of the United States, including the Copyright and Patent Clause—which Webster compared in importance with the tablets of Mount Sinai.<sup>30</sup>

### *E. The 1790 Acts and Beyond*

By 1790, American authors and inventors already had been active, albeit in a vacuum of national law. Congress set about quickly to fill that void.

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25. See UNGER, *supra* note 22, at 58–59; Julien H. Collins III, *When in Doubt, Do Without: Licensing Public Performances by Nonprofit Camping or Volunteer Service Organizations Under Federal Copyright Law*, 75 WASH. U. L.Q. 1277, 1281 n.14 (1997) (noting that Connecticut “passed the first American copyright statute in 1783”).

26. See UNGER, *supra* note 22, chs. 3 (“Author”) & 4 (“Yankee Peddler”).

27. See Collins, *supra* note 25, at 1281 n.14.

28. See UNGER, *supra* note 22, ch. 5 (“Essayist”).

29. 5 JONATHAN ELLIOT, DEBATES ON THE ADOPTION OF THE FEDERAL CONSTITUTION 439–40 (J.B. Lippincott Co. 1941) (Jonathan Elliot ed., 1836). Madison’s suggestion of empowering Congress to establish a national university went nowhere (as did the corresponding portion of a similar tripartite proposal by Charles Pinckney). *Id.*

30. See UNGER, *supra* note 22, at 135–39 (commenting also on the widespread impact of Webster’s pamphlet *Examination into the Leading Principles of the Federal Constitution*, signed by Webster as “A Citizen of America” and dedicated to Benjamin Franklin). Unlike the more complex exposition of the Federalist Papers, Webster’s essay made the case for the proposed national government in plain language directed to the common citizen. *Id.* at 136.

The first federal patent statute,<sup>31</sup> enacted in 1790, laid to rest the specter of competing state patent grants throughout America by creating a uniform national patent system.<sup>32</sup> The Act empowered a three-person board (headed by then-Secretary of State Thomas Jefferson, the first U.S. “patent examiner”) to issue a grant for “any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used.”<sup>33</sup>

Invention in America flourished. The initial patent under the 1790 Act, issued to Samuel Hopkins for a method improving “the making of Pot ash and Pearl ash by a new Apparatus and Process,” followed quickly,<sup>34</sup> and within three years Eli Whitney had secured protection for the cotton gin that was to revolutionize agriculture in the American South. In 1793, however, perhaps cognizant of Jefferson’s workload in his day job, Congress substituted for examination by the Sage of Monticello a registration system making the issuance of patents basically a clerical function. That system continued in effect for more than forty years.<sup>35</sup>

Like patent law, copyright law received attention in the First Congress under the new national charter.<sup>36</sup> The initial bill, although introduced by Representative Benjamin Huntington of Webster’s home state of Connecticut on June 23, 1789 (the same day a draft bill by Webster appeared in print in New York),<sup>37</sup> was

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31. Act of Apr. 10, 1790, ch. 7, 1 Stat. 109 (repealed 1793) (promoting the progress of useful Arts).

32. See John F. Duffy, *Harmony and Diversity in Global Patent Law*, 17 BERKELEY TECH. L.J. 685, 691 (2002) (stating that the United States has had a uniform, national system for patent protection since 1790).

33. Act of Apr. 10, 1790, ch. 7.

34. Press Release, U.S. Patent and Trademark Office, The U.S. Patent System Celebrates 212 Years, at <http://www.uspto.gov/web/offices/com/speeches/02-26.htm> (Apr. 9, 2002).

35. By 1836, the flaws of the registration system—for the most part, duplicative, fraudulent, and worthless patents—became manifest. By the Act of July 4, 1836, Congress reinstated the examination requirement, subject, however, to administration by the predecessor of today’s Patent and Trademark Office. Act of July 4, 1836, ch. 357, §§ 1, 7, 5 Stat. 117, 117–20 (1856). With only occasional revision, this statutory structure remained unchanged until 1952.

36. The same Congress drafted the Bill of Rights, including the Free Press and Speech Clauses, and forwarded them to the states, which ratified them in 1791. Some (but not all) commentators infer that the Founding Generation, schooled in the lessons of English copyright, envisaged the Copyright Clause and the First Amendment as complementary parts of a coherent and consistent system of law capable of promoting and protecting creativity by encouraging the protection of new works, ensuring freedom of expression, strengthening trade in the marketplace of ideas, and securing the public domain. See generally Patterson & Joyce, *supra* note 15, at 911 n.4 (listing articles that discuss this debate).

37. See G. THOMAS TANSELLE, *Copyright Records and the Bibliographer*, in 22 STUDIES IN BIBLIOGRAPHY 77, 85–86 (1969); see also 1 WILLIAM F. PATRY, COPYRIGHT LAW

tabled until the second session of Congress. Outlining his goals for that session, President Washington proclaimed of intellectual property that “nothing . . . can better deserve your patronage, than the promotion of science and literature.”<sup>38</sup> Congress responded with the first Copyright Act, signed into law by Washington on May 31, 1790. It was titled “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.”<sup>39</sup>

Following the Statute of Anne, the Act provided the copyright holder an exclusive right to print and vend copies of a protected work for a term of fourteen years, with possible renewal for another fourteen years if the author lived out the first term, but subject to specified conditions to qualify for protection.<sup>40</sup> Congress made eligible for copyright both works already printed in the United States (thereby avoiding problems that might otherwise have arisen from formulating the grant as a term extension only for works then subject to state copyrights) and those afterwards published in America, thereby establishing the uniform schema that would obtain throughout the nation once all pre-1790 copyrights had expired.<sup>41</sup>

Within two weeks of the 1790 Act’s adoption, on June 14, 1790, John Barry’s *The Philadelphia Spelling Book, Arranged*

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AND PRACTICE 28 & n.81 (1994) (citing TANSSELLE, *supra*, and describing Huntington’s bill as “possibly based on” Webster’s draft).

38. George Washington, Address to the U.S. Senate (Jan. 8, 1790), in JOURNAL OF THE SECOND SESSION OF THE SENATE OF THE UNITED STATES OF AMERICA (1820), <http://memory.loc.gov/ammem/amlaw/lwsj.html>.

39. Act of May 31, 1790, ch. 15, 1 Stat. 124 (repealed 1831). Compare the Statute of Anne’s title: “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.” The 1790 Act added “maps” and “charts” (important to exploration of the new nation’s land and sea frontiers) to its English precursor’s specification of “books” as the subject matter of copyright protection, but otherwise the two titles are remarkably similar.

40. The qualifying conditions for protection—what ultimately became the “statutory formalities” of notice, deposit, and registration—would prove crucial in *Wheaton v. Peters*. While irrelevant to the decision in *Wheaton*, the 1790 Act also included a citizenship or residency requirement for protection, in effect authorizing the piracy of works published abroad by foreign authors by allowing them to be reprinted in the United States without penalty. This provision, although it may for a time have encouraged the publishing industry in America, exceeded the corresponding provision of the Statute of Anne. It would, however, remain part of U.S. law until enactment of the Chace Act, Act of Mar. 3, 1891, ch. 565, § 13, 26 Stat. 1106, 1110. For a reflection on this aspect of the 1790 Act, and on the relationship between culture and commerce in nineteenth-century America (with due attention to Webster’s activities), see generally Thomas Bender & David Sampliner, *Poets, Pirates, and the Creation of American Literature*, 29 N.Y.U. J. INT’L L. & POL. 255 (1996–1997).

41. See Act of May 31, 1790, ch. 15, § 1.

*Upon a Plan Entirely New*, having been duly registered with the clerk of the federal district court where the work was published, became the first work to obtain a federal copyright in the United States.<sup>42</sup> (Thereafter, the statute required publication of a copy of that record within two months of registration in one or more newspapers for four weeks, plus the deposit of a copy of the work in the office of the Secretary of State within six months of publication.) *An Explanation of the Magnetic Atlas*, by John Churchman, followed on June 17, and on June 22, *A Grammatical Institute of the English Language*, by Noah Webster, was entered into federal copyright.<sup>43</sup>

The 1790 Act remained the law, subject to two amending statutes, until the General Revision of 1831. The first amendment occurred in 1802 when Congress added "any historical or other print or prints," such as pictures, as protectible subject matter and provided that copyright owners, besides observing the formalities already prescribed, should include a notice of copyright on every copy of the work distributed to the public.<sup>44</sup> In 1819, Congress gave the federal district courts original jurisdiction over copyright (and patent) cases, even in matters not involving diversity of citizenship, and granted the circuit courts the power to issue injunctions to prevent infringements.<sup>45</sup>

The first third of the nineteenth century saw a surge of popular writings by American authors, including Washington Irving ("Rip Van Winkle" and "The Legend of Sleepy Hollow" in *The Sketch-Book*, 1819), James Fenimore Cooper (*The Last of the Mohicans*, 1826), and John James Audubon (*Birds of America*, four volumes, 1827–1838), as well as the rise of the great publishing houses in Philadelphia, Boston, and New York<sup>46</sup> that

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42. The three registrations referred to in this paragraph are cited in 1 PATRY, *supra* note 37, at 34 n.101.

43. Webster's punctilious observance of the statutory formalities was entirely in character. Uncertain during the summer of 1790 whether the Secretary of State's office remained located in New York City, the first federal capital, or Philadelphia, the second federal capital, see Act of July 16, 1790, ch.28, §§ 1, 5, 1 Stat. 130 (known as the "Residence Act," under which the Government relocated permanently to the District of Columbia in 1800), Webster took no chances with the deposit requirement. As recited in an October 14, 1790 note to Thomas Jefferson, the Secretary of State, he sent *two* copies of his work, one to each city, to comply with the statute and a *third* copy for Jefferson's personal use. 1 PATRY, *supra* note 37, at 31 n.93.

44. Act of Apr. 29, 1802, ch. 36, § 2, 2 Stat. 171 (repealed 1831).

45. Act of Feb. 15, 1819, ch. 19, 3 Stat. 481.

46. For a general narrative concerning these houses and their authors, see 1 JOHN TEBBEL, *A HISTORY OF BOOK PUBLISHING IN THE UNITED STATES: THE CREATION OF AN INDUSTRY 1630–1865* (1972).

would issue the mid-century works of Emerson, Hawthorne, Longfellow, Melville, Poe, Stowe, Thoreau, and Whitman, among many others.<sup>47</sup>

Noah Webster remained active throughout the period, his speller becoming the standard such work in classrooms throughout the United States and Webster himself a national icon. Before his death in 1843, the little spelling book he had once toured that nation to protect would see print in 385 editions<sup>48</sup>—the better to update the language, of course, but also a useful opportunity to obtain new copyrights.

By the 1820s, however, Webster's focus had turned to a different project—*An American Dictionary of the English Language*—through which he hoped to assure the financial future of his family.<sup>49</sup> But for how long? Under the 1790 Act, the term of copyright protection was only fourteen years. If, but only if, the author survived that term and then navigated the prescribed renewal process, he might obtain fourteen years more. For a labor of love intended to ensure standardized meanings for words throughout America, Webster considered the promised reward woefully insufficient. Nothing less than perpetual copyright protection seemed appropriate.

The quest for extended protection soon became a family affair. In 1826, Webster encouraged his cousin Daniel Webster, a member of the U.S. House of Representatives from Massachusetts, to initiate the effort to extend protection further.<sup>50</sup> The latter, then engrossed in a campaign for election to the Senate (and perhaps mindful of the “limited Times” language of the Copyright Clause), took no action.<sup>51</sup> By 1830, however, Noah's son-in-law, William W. Ellsworth of Connecticut, had been elected to the House and secured a seat on the Judiciary Committee, to which he introduced a bill to extend the initial term of copyright to twenty-eight years (mirroring contemporary British law).<sup>52</sup> The aged lexicographer, replicating a strategy he had employed nearly fifty years before in support of his first speller, journeyed to Washington, D.C. to lobby personally for the legislation.

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47. For commentary regarding the changing economic conditions for U.S. authors and publishers during this period, see Bender & Sampliner, *supra* note 40.

48. *Id.* at 256 & n.2 (citing JOSEPH J. ELLIS, *AFTER THE REVOLUTION: PROFILES OF EARLY AMERICAN CULTURE* 162, 172 (1979)).

49. See UNGER, *supra* note 22, chs. 9 (“Lexicographer”) & 10 (“Elder Statesman”).

50. *Id.* at 300–01.

51. *Id.* at 301.

52. *Id.* at 313.

The old trick worked one last time. The capital greeted Noah Webster as a national hero. On January 3, 1831, he delivered a lecture supporting copyright term extension in the House of Representatives' chamber. Four days later, the House approved the bill. By the end of January, with Daniel Webster as sponsor, it passed the Senate. Scarcely a month after Webster's triumphant lecture, President Andrew Jackson signed the legislation into law.<sup>53</sup>

The new Act made two critical changes in the duration of protection: it extended the first term of copyright to twenty-eight years both for new works and for works, like Webster's *Dictionary*, already published and copyrighted, and it accorded authors' widows and children the opportunity to renew protection—even if the author did not survive the twenty-eight-year first term—for an additional fourteen years.<sup>54</sup> Also, and more generally amending preexisting law, the 1831 Act expanded the range of subject matter eligible for copyright (adding musical compositions and engravings) and revised the statutory formalities for protection (eliminating the 1790 Act's requirement that for the original term, claims of copyright be published in newspapers; stipulating the deposit of copies to the local district court clerk within three months of publication; simplifying the form of notice to be placed on copies; and explicitly requiring the affixation of notice).

Thus, by the spring of 1831, both a national culture and the law protecting it had been well developed in the more than half century that had passed since the American Revolution. The stage was set for the great contest over the protection of law reports, and of literary property generally, that would culminate three years later in the Supreme Court's decision in *Wheaton v. Peters*.

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53. Act of Feb. 3, 1831, ch. 16, 4 Stat. 436.

54. UNGER, *supra* note 22, at 316. “This law will add much to the value of my property,” wrote Webster to his son-in-law, William Fowler, “and I cannot but hope I may now make dispositions of copyright which will make me comfortable during the remainder of my life, and secure to Mrs. Webster, if she should survive me, a decent independence.” *Id.* (quoting Letter from Noah Webster to William Chauncey Fowler (Jan. 29, 1831), in LETTERS OF NOAH WEBSTER 424, 424–25 (Harry R. Warfel ed., 1953) (noting also that “[the members of Congress] had learned in my books . . . and [were] ready to do me any kindness in their power”).

## ACT ONE: LAW REPORTING IN THE NEW REPUBLIC

*[The curtain rises.]*

A. *In the Beginning*

Suppose you throw a party, but only your second cousin twice removed and his disgruntled neighbor hear about the affair and manage to attend it. You lay on a lavish feast and resolve all of the partiers' disputes, but only they know what a fine time it was. No problem (except for the leftovers). You try again another day.

Suppose now you are the Supreme Court of the United States, charged not only with resolving disputes between the litigants before you but also with building, on that foundation, a national jurisprudence. You decide all of the cases, but nobody except the few in the courtroom that day hear you say what the law is. (Or if they do, they receive only the delayed, partial, and erroneous reports that happen to be printed in the local paper.) Big problem. You are not "Supreme."

Today, that situation is unimaginable. The decisions of the Supreme Court determine law regarding affirmative action, reproductive rights, the powers of the government in time of war, the outcome of a presidential election, and a host of other pressing issues throughout the country. Within moments of their announcement in the Court's Marble Palace on Capitol Hill in Washington, the opinions of the Supreme Court are available everywhere via the Internet, and in short order they are available in official bound volumes of *U.S. Reports*.

What assures such prompt, accurate, and complete dissemination of the Court's opinions?<sup>55</sup> Today, every opinion by every Justice is rendered in writing and promptly transmitted to the Court's Reporter of Decisions, whose high-ceilinged office sits amidst the Justices' chambers, near their ornate courtroom. Today, charged by law<sup>56</sup> with preparing the opinions of the Court for publication, the Reporter and a dozen-member staff, in conjunction with the various chambers, pore over every word to

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55. For further discussion of the Reporter of Decisions' role in American law, see Craig Joyce, *Introduction, The Torch Is Passed: In-Chambers Opinions and the Reporter of Decisions in Historical Perspective*, to 3 A COLLECTION OF IN CHAMBERS OPINIONS BY THE JUSTICES OF THE SUPREME COURT OF THE UNITED STATES, at vii, vii-xxiii (2004), which serves as a principal source in the narrative that follows.

56. 28 U.S.C. § 673 (2000). The remaining statutory officers of the Court are the Clerk, the Marshal, and the Librarian.

ensure each opinion’s strict fidelity to the intent of the Justices.<sup>57</sup> Today, because this process assures that the Court’s decisions will reach every corner of America, the Constitution of the United States and the statutes enacted to effect its purposes—both as construed by the Supreme Court—truly are the law of the land.

It was not always so. In 1783, when Noah Webster had to petition the several states individually in order to secure copyright in his little spelling book, there was little (verging on no) national law in America.<sup>58</sup> In 1787, when Washington, Madison, Hamilton, Franklin, and others assembled in Philadelphia to draft the Constitution, there was, as yet, no national government. And in 1790, when the newly appointed Supreme Court gathered for the first time in New York City, although there was (finally) a national judicial tribunal, no Reporter of Decisions stood ready to record its decisions for lower courts, the bar, or posterity.

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57. The Reporter also works closely with the Justices to ensure compliance with the Court’s complicated rules of style and prepares detailed syllabuses summarizing the opinions. For a more complete description of the present Reporter of Decisions’ functions, see Frank D. Wagner, *The Role of the Supreme Court Reporter in History*, 26 J. SUP. CT. HIST. 9, 9–14 (2001).

58. At the national level itself, the Articles of Confederation, first proposed during the Revolution, had entered into operation upon ratification by the last of the states in 1781. ARTICLES OF CONFEDERATION (1781), *reprinted in* 1 PROPOSED AMENDMENTS TO THE U.S. CONSTITUTION 1787–2001, at xix (John R. Vile ed., 2003). The central government, lacking an executive or a judiciary, consisted only of Congress, whose measures required approval by nine of the thirteen states to become effective. *Id.* art. X, *reprinted in* 1 PROPOSED AMENDMENTS TO THE U.S. CONSTITUTION, *supra*, at xxv. The permitted objects of its legislation were few and basic, such as making treaties and declaring war. *Id.* arts. VI, IX, *reprinted in* 1 PROPOSED AMENDMENTS TO THE U.S. CONSTITUTION, *supra*, at xxi–xxii. Mostly, Congress could *not* do what national governments do: for example, raise money by collecting taxes, regulate interstate commerce, pass intellectual property laws, or force the states to comply with the occasional law that Congress did pass.

Under the Articles, a self-described “firm league of friendship,” real power remained in the states. *Id.* art. III, *reprinted in* 1 PROPOSED AMENDMENTS TO THE U.S. CONSTITUTION, *supra*, at xix. Typically, the laws of the several states were similar—or even the same, insofar as the states had enacted “reception statutes” that adopted pre-revolutionary English law when consistent with local conditions. See Charles A. Bane, *From Holt and Mansfield to Story to Llewellyn and Mentschikoff: The Progressive Development of Commercial Law*, 37 MIAMI L. REV. 351, 363 (1983) (“The reception statutes were the mechanism for transferring the common law of England to the new United States.”). But laws thus received derived their authority from the states themselves, not from enactment by Congress, and operated territorially within the states, not across state boundaries throughout the whole nation. See Sarah Helene Duggin & Mary Beth Collins, *Natural Born in the USA: The Striking Unfairness and Dangerous Ambiguity of the Constitution’s Presidential Qualifications Clause and Why We Need to Fix It*, 85 B.U. L. REV. 53, 74 (2005) (discussing how “[r]eception statutes differed from colony to colony”).

Indeed, with one exception, there were in 1790 *no* judicial reports—federal, state, or colonial—anywhere in America.<sup>59</sup> The necessary prerequisite to the preeminence of the Nation's Court as we know it today—the Court of Marshall, Story, and their descendants on the Supreme Bench—was a system of reporting the Justices' decisions that had yet to be devised.<sup>60</sup>

### B. *The First Reporters*

What followed, almost by happenstance, was the creation of the series of volumes known now as *U.S. Reports*, but known then by the names of the first four Reporters (through the decision in the *Wheaton* case): Dallas, Cranch, Wheaton, and Peters.<sup>61</sup>

The breakthrough came when the Supreme Court, and the federal government generally, moved to Philadelphia in 1791.<sup>62</sup> There, a young lawyer named Alexander J. Dallas became,

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59. English law reports, from Littleton and Coke forward, were not unknown in colonial America. See generally Erwin C. Surrency, *Law Reports in the United States*, 25 AM. J. LEGAL HIST. 48 (1981). As long as the colonies remained yoked to England, there was little need to report the judgments of American courts. The first comprehensive volume to do so after independence was EPHRAIM KIRBY, REPORTS OF CASES ADJUDGED IN THE SUPERIOR COURT OF THE STATE OF CONNECTICUT FROM THE YEAR 1785, TO MAY 1788 WITH SOME DETERMINATIONS IN THE SUPREME COURT OF ERRORS (1789). Kirby's reports preceded Dallas's *Reports*, about which more is written below, by barely a year. See generally Alan V. Briceland, *Ephraim Kirby: Pioneer of American Law Reporting, 1789*, 16 AM. J. LEGAL HIST. 297 (1972).

60. For a complete list of the Reporters of Decisions and their terms of service, see Joyce, *supra* note 55, at vii. The volumes of the first seven Reporters, who with their publishers financed their own reports, bear their names. They are known to history, collectively, as the "nominative" Reporters. From 1875 on, Congress financed the reports, and the names of the Reporters themselves, now anonymous, ceased appearing on the spines. *Id.* at xx. The last decision in the last volume of the last nominative Reporter, John W. Wallace, *American Wood-Paper Co. v. Fibre Disintegrating Co.*, commonly would be cited today as 90 U.S. (23 Wall.) 566 (1874). The successor volume, William T. Otto's first, reporting the October 1875 Term, begins with *McComb v. Commissioners of Knox County, Ohio* and is cited more simply as 91 U.S. 1 (1875).

61. The story of the early Reporters is told in much greater detail in Craig Joyce, *The Rise of the Supreme Court Reporter: An Institutional Perspective on Marshall Court Ascendancy*, 83 MICH. L. REV. 1291 (1985), from which this Article and Joyce, *supra* note 55, are adapted. Primary sources are cited when appropriate. For entertaining biographies of Dallas, Cranch, Wheaton, and Peters, see MORRIS L. COHEN & SHARON HAMBY O'CONNOR, A GUIDE TO THE EARLY REPORTS OF THE SUPREME COURT OF THE UNITED STATES 11–76 (1995).

62. See *supra* note 43. The Court transacted little business, other than appointing a clerk and crier and admitting attorneys to the Court's bar, during its first two Terms in New York City, the temporary federal capital. The only activity during its third Term, held in Philadelphia after the government relocated there, was procedural. During the August 1791 Term, however, *West v. Barnes*, 2 U.S. (2 Dall.) 401 (1791) at last was called for argument, only to be dismissed on procedural grounds without an actual decision on the merits. See Joyce, *supra* note 61, at 1294.

unofficially and by self-appointment, the Supreme Court’s first Reporter. Born in Jamaica, Dallas had migrated to the United States after the Revolution. In due course, he would achieve success on the Philadelphia bar and serve as Secretary of the Treasury (and, briefly, of War) during Madison’s presidency.

Early on, however, Dallas endured lean years of practice. To supplement his income, he began publishing reports of local judicial decisions for use by fellow attorneys. The venture was entirely private, the Reporter acting without salary or commission from the relevant courts. His first volume, *Reports of cases ruled and adjudged in the courts of Pennsylvania, before and since the Revolution*, appeared in 1790. Three more volumes followed.<sup>63</sup>

Volume 1 of Dallas’s *Reports*, however, is unique. In the succeeding three volumes, Dallas included, for the convenience of his practitioner purchasers, the decisions of those “local” federal courts—including the district courts, the Circuit Court (what today is the Third Circuit Court of Appeals), and the Supreme Court—that were by then resident in Pennsylvania. The new nation’s highest court did not become resident, however, until the year after Dallas began publishing. Thus, alone in the entire series of *U.S. Reports*, 1 U.S. (1 Dall.) contains *not one* decision by the Supreme Court of the United States!

Dallas faced no easy task in reporting the work of that Court.<sup>64</sup> Except in the most important cases, the Justices often delivered opinions extemporaneously from only the most rudimentary of jottings. Dallas had to rely on his own notes from those sittings he could attend and on the notes of fellow attorneys

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63. Dallas’s first volume appeared with the express imprimatur of the judges of the state’s highest court, commending its author’s “Learning, Integrity and Abilities” and “approv[ing] and recommend[ing] the printing and publishing [of] his book.” 1 U.S. (1 Dall.) ii (1790). But practical support, in the form of an appropriation by the legislature to offset current expenses and perhaps establish a market in the state for future sales, never was forthcoming. Dallas pressed on, perhaps spurred by the prospect of increased sales from the inclusion in his second, third, and fourth volumes of the decisions of the federal courts newly located in Philadelphia since the publication of Volume 1. But that hope, too, proved vain. The “federal presence” in Dallas’s later volumes seems not to have increased their sales. Steady demand for Volume 1 of Dallas’s *Reports* resulted in a second printing of that volume in 1806. The three later volumes sold more slowly despite their author’s efforts to promote them nationally. Letter from Alexander J. Dallas to Mathew Carey (June 22, 1803), cited in RAYMOND WALTERS, JR., ALEXANDER JAMES DALLAS: LAWYER—POLITICIAN—FINANCIER 1759–1817, at 147 n.6 (1943) (annotated manuscript thesis in Butler Library, Columbia University, of work published in abbreviated book form by University of Pennsylvania Press).

64. For the authoritative source on details of the Court’s work during its first decade of existence, see THE DOCUMENTARY HISTORY OF THE SUPREME COURT OF THE UNITED STATES, 1789–1800 (Maeva Marcus et al. eds., 1985), which is an ongoing project.

(and, very occasionally, those of the Justices themselves) for the many he could not, thereby making the accuracy and completeness of his *Reports* problematic. Thanks to high printing expenses, they were costly as well.

The most serious complaint against Dallas's *Reports*, however, was their chronic tardiness. Five years elapsed between the last Supreme Court decision recorded in 2 *Dallas* and publication of that volume; and between Dallas's retirement as Reporter and the publication of 4 *Dallas*, his final volume, seven years passed. That delay so unnerved bench and bar that it prompted a plea by Dallas's successor that he be allowed to publish the missing cases in the first volume of his own reports: "It would certainly be interesting to the profession, and important to the stability of our national jurisprudence, that the chain of cases should be complete . . . ." <sup>65</sup>

Although Dallas eventually performed his duty, by 1800, when the Court and the government decamped for Washington City, his patience, and hopes for financial gain, were at an end. "I have found such miserable encouragement for my Reports," he wrote to a friend, "that I have determined to call them all in, and devote them to the rats in the State-House." <sup>66</sup>

William Cranch, the Supreme Court's second Reporter, was, like Dallas, a volunteer. Born in Massachusetts, he had relocated to the new federal capital to make his fortune as legal agent for a real estate speculation syndicate. Happily for Cranch, who was the son of Abigail Adams's sister and a Harvard classmate of John Quincy Adams, he survived the syndicate's spectacular collapse through appointment to public office by his well-placed uncle, Quincy's father, on the eve of the latter's forced retirement from the presidency.

In turn, Cranch's court survived extinction in the purge of Federalist judges engineered by John Adams's successor, Thomas Jefferson. In 1805, Cranch became Chief Judge of the District of Columbia Circuit Court, serving until his death in 1855. So high were Cranch's standards on the bench that he once agreed to admit to the bar a young lawyer of marginal attainments only after the latter promised not to practice in Washington but rather to remove to the "western country." <sup>67</sup> Ironically, years later

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65. Letter from William Cranch to Alexander J. Dallas (July 25, 1803), in George M. Dallas Papers (on file with the Historical Society of Pennsylvania, Philadelphia, Pa.).

66. Letter from Alexander J. Dallas to Jonathan Dayton (Oct. 18, 1802), in George M. Dallas Papers, *supra* note 65.

67. Eugene Wambaugh, *Salmon Portland Chase*, in 5 GREAT AMERICAN LAWYERS 344, 344 (William Draper Lewis ed., 1908).

and suitably seasoned, Salmon P. Chase would become the Supreme Court's sixth Chief Justice.<sup>68</sup>

Precisely how Cranch came to be Reporter is not known. The older histories occasionally refer to him as the first "regularly appointed" Reporter of the Court's decisions.<sup>69</sup> But no such entry appears in the minutes of the Court, nor had Congress or the Court provided for such an appointment by statute or rule.<sup>70</sup> Without doubt, the reports published by Cranch, like the volumes of his predecessor, remained at all times a private venture.<sup>71</sup> Thus, it seems most likely that Cranch, like Dallas, appointed himself to report the Court's decisions.<sup>72</sup>

Despite high hopes and laudable intentions, however, Cranch and his readers found Supreme Court reporting an exercise in disappointment. True, Cranch managed, as he had urged Dallas, to keep "the chain of cases . . . complete." And certainly he made every effort to please the profession by improving on the standard of his predecessor's volumes. While retaining the case tables, indices, and rudimentary notes introduced by Dallas, the new Reporter also pledged to provide

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68. *Id.* at 363.

69. *See, e.g.*, HAMPTON L. CARSON, *THE SUPREME COURT OF THE UNITED STATES: ITS HISTORY* 562 (1891).

70. Alexander B. Hagner, *William Cranch, 1769–1855*, in *3 GREAT AMERICAN LAWYERS* 85, 93 (William Draper Lewis ed., 1907).

71. *See infra* notes 112–20 (describing the protests of Cranch and Wheaton regarding the impact of Peters's *Condensed Reports* on the income of Peters's predecessors).

72. Apart from any financial considerations, Cranch seems to have been motivated to take on the burdens of reporting, at least in part, by a keen appreciation of the importance of the task. Witness the preface to his first volume:

Much of that *uncertainty of the law*, which is so frequently, and perhaps so justly, the subject of complaint in this country, may be attributed to the want of American reports.

. . . .

Uniformity . . . can not be expected where the judicial authority is shared among such a vast number of independent tribunals, unless the decisions of the various courts are made known to each other. Even in the same court, analogy of judgment can not be maintained if its adjudications are suffered to be forgotten. It is therefore much to be regretted that so few of the gentlemen of the bar have been willing to undertake the task of reporting.

. . . .

One of the effects, expected from the establishment of a national judiciary, was the uniformity of judicial decision; an attempt, therefore, to report the cases decided by the Supreme Court of the United States, can not need an apology . . . .

. . . .

If the fate of the present volume should not prove him totally inadequate to the task he has undertaken, it is [the Reporter's] intention to report the cases of succeeding terms.

5 U.S. (1 Cranch) iii–v (1804).

“faithful summar[ies] of the arguments of counsel.”<sup>73</sup> The result, as described by William Pinkney of Baltimore, the Supreme Court bar’s leading advocate, was merely “unprofitable and expensive prolixity.”<sup>74</sup> The greater length of Cranch’s *Reports* also worked against their success as a commercial venture by contributing to their cost. Eventually, the combined expense of a full set of Cranch’s volumes approached the then-exorbitant amount of fifty dollars.<sup>75</sup>

In other respects, Cranch’s deficiencies resembled his predecessor’s, specifically “painfully erroneous” reports of decisions<sup>76</sup> and repeated delays in the publication of his volumes.<sup>77</sup> Year after year, cases lay unreported, to the great dismay of the Court. Justice Story, newly appointed in 1811 and greatly concerned with the development of its jurisprudence as a tool of national power, complained of Cranch’s “extraordinary delay.”<sup>78</sup> Even Chief Justice John Marshall, upon receiving prepublication copies of Cranch’s final volumes after his departure as Reporter, directed his thanks to Cranch’s successor, apparently believing that Cranch himself had abandoned them.<sup>79</sup>

### C. *Wheaton’s Reportership*

By 1815, what Story termed the Court’s “disrelish” with Cranch’s work had reached the breaking point.<sup>80</sup> The bar concurred. Cranch had failed to place in print a single case decided since 1810. Richard Rush, Attorney General of the United States, whose many appearances before the Court required frequent reference to its precedents, despaired of seeing them and lamented that the Reporter “ought to be supplanted as some penalty for his inexcusable delays.”<sup>81</sup> But by whom?

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73. *Id.* at iv.

74. Letter from William Pinkney to Henry Wheaton (Sept. 3, 1818), in Wheaton Papers, *supra* note 2.

75. Justice Smith Thompson’s purchase of Volumes 7, 8, and 9 alone cost him sixteen dollars in 1818. Letter from W. Gould to Smith Thompson (Feb. 3, 1818), in Gilbert Livingston Papers (on file with the New York Public Library, New York, N.Y.).

76. Letter from Joseph Story to Richard Peters, Jr. (Dec. 18, 1829), in Peters Papers (on file with the Historical Society of Pennsylvania, Philadelphia, Pa.).

77. When published in 1816, Volume 7 of Cranch’s *Reports* included cases decided as early as 1810.

78. Letter from Joseph Story to Richard Rush (June 26, 1814), in Rush Family Papers (on file with the Princeton University Library, Princeton, N.J.).

79. Letter from John Marshall to Henry Wheaton (Oct. 27, 1816), in Wheaton Papers, *supra* note 2.

80. Letter from Joseph Story to Henry Wheaton (Sept. 15, 1816), in Wheaton Papers, *supra* note 2.

81. Letter from Richard Rush to Henry Wheaton (Apr. 6, 1815), in Wheaton Papers,

Story and Rush already knew the answer: an ambitious young New York lawyer and scholar named Henry Wheaton.<sup>82</sup> Wheaton had come to prominence during the War of 1812 owing to his ardent support of the Madison Administration and his early writings, particularly in admiralty matters and in comparative law. His *Digest of the Law of Maritime Captures and Prizes*, published in 1815, not only summarized, but also provided a full analysis of, the prize decisions of the tribunals of the United States and England and included a general exposition of the law of nations. In a paper delivered to the American Philosophical Society, Rush had expressed his "unequivocal opinion" of the *Digest's* merits.<sup>83</sup>

Story's enthusiasm for the *Digest*, which he had encouraged, and for developing federal admiralty (or maritime) law, which would deliver an enormous docket of commercial litigation to the federal courts, was no less pronounced: "[I]f a bucket of water were brought into [Story's] court with a corn cob floating in it, he would at once extend the admiralty jurisdiction of the United States over it."<sup>84</sup>

The selection of the Court's third Reporter seems to have occurred by informal agreement among the Justices themselves. As an inducement to procure his appointment, which he hoped might lead to greater fame in the profession and increased income through the production of his reports, Wheaton had submitted a plan proposing "regular annual publication" of the Justices' opinions, "with good type, and to be neatly printed."<sup>85</sup> Anxious to improve the accuracy and promptitude of the reports, the Justices apparently agreed to furnish to Wheaton any written opinions they might prepare, or notes they might make, in connection with their oral opinions.<sup>86</sup>

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*supra* note 2.

82. Wheaton was born in Providence, Rhode Island on November 27, 1785, and he died in Dorchester, Massachusetts, on March 11, 1848.

83. RICHARD RUSH, *AMERICAN JURISPRUDENCE* 50 (1815).

84. Note, *Extension of Federal Jurisdiction over State Canals*, 37 *AM. L. REV.* 911, 916 (1903).

85. ELIZABETH FEASTER BAKER, *HENRY WHEATON 1785-1848*, at 27 (1937) (quoting *REPORT OF THE COPYRIGHT CASE OF WHEATON VS. PETERS* 6 (1834)).

86. Bill in Equity for Appellants, *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), *microformed on* 4 *The Records and Briefs of the Supreme Court of the United States* 2, 2 (Scholarly Resources, Inc.) [hereinafter *Record*]; *see also* *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 614-15 (1834) (noting that Wheaton's counsel asserted that the Justices "invited [Wheaton] 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").

Wheaton immediately set about industriously discharging his new responsibilities through daily attendance at the Court's sittings. The demands of the Reportership, and conditions in the Federal City itself, drew him close to the tight circle of people with whom he worked most regularly: the Justices of the Court. Washington at the close of the War of 1812 remained a dusty and dismal place, "a picture of sprawling aimlessness, confusion, inconvenience, and utter discomfort."<sup>87</sup> The Justices themselves, enduring a self-imposed reclusive existence almost wholly divorced from the politics and society of the city, all lived and took their meals together in the same boarding house on Capitol Hill.<sup>88</sup>

There, Wheaton joined the Justices, quickly becoming Story's roommate or "chum."<sup>89</sup> Close both personally and professionally, they assembled a common library for use while in Washington.<sup>90</sup> Wheaton's relationships with the other Justices, while not nearly as familiar as with Story, seem in most instances to have been professionally cordial.<sup>91</sup>

The results of Wheaton's efforts to justify his appointment as Reporter were immediate and impressive. Within two months after the 1816 Term ended, he had completed his work in preparing the opinions, abstracts, and arguments of counsel for the press. Seven months elapsed before he could locate a bookseller who would publish the reports, albeit on terms barely palatable to Wheaton, and see them into print.<sup>92</sup> But by the time

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87. 3 ALBERT J. BEVERIDGE, *THE LIFE OF JOHN MARSHALL* 4 (1919).

88. JAMES STERLING YOUNG, *THE WASHINGTON COMMUNITY 1800-1828*, at 76-77 (1966); cf. G. Edward White, *The Working Life of the Marshall Court, 1815-1835*, 70 VA. L. REV. 1, 6 (1984) (noting that the Justices' correspondence suggests a more active social life than Young describes). For a highly enjoyable re-creation of a typical Term at the Court, see G. Edward White, *Imagining the Marshall Court*, Y.B. 1986: SUP. CT. HIST. SOC'Y 77 (1986).

89. See, e.g., Letter from Joseph Story to Henry Wheaton (Dec. 23, 1816), in Wheaton Papers, *supra* note 2 (responding to Wheaton's suggestion of the arrangement that "[n]othing could be more pleasant to me than to chum with you this winter; & we will so arrange it at all events").

90. See, e.g., Letter from Henry Wheaton to Joseph Story (Dec. 25, 1817), in Wheaton Papers, *supra* note 2 (indicating which volumes Wheaton would carry with him for the 1818 Term and requesting Story to extract cases from others that "Lord knows . . . will not be found at Washington"). At a later date, Wheaton collected funds from members of the bar to establish a Supreme Court library (although nothing came of the project until Peters's time). Letter from Richard Peters to Henry Wheaton (Apr. 30, 1827), in Peters Papers, *supra* note 76.

91. For example, in entrusting an opinion to the Reporter for the press, Bushrod Washington enjoined Wheaton warmly "to correct with freedom all errors in language." Letter from Bushrod Washington to Henry Wheaton (May 24, 1817), in Wheaton Papers, *supra* note 2.

92. As Peter Du Ponceau, Wheaton's agent in Philadelphia, succinctly advised him,

the Court arrived in Washington for its 1817 Term, the bench and the bar of the Supreme Court had in hand, for the first time in history, a published set of cases from the preceding Term. “The promptitude, with which the Reports follow the decisions,” wrote William Pinkney, “greatly enhances their value to us all” and “[t]he Profession [is] infinitely indebted to you.”<sup>93</sup> Later volumes appeared even more promptly, at worst within six months of the conclusion of the Term in which the last case had been decided.

Such promptitude was not without reward, albeit a paltry one. At the urging of the Court itself,<sup>94</sup> Congress consented to recognize the Reporter’s office and to appropriate a salary of \$1000, on condition that eighty copies of the reports be provided for government use.<sup>95</sup> Wheaton thus became the first official Reporter in the history of the Court, but with financial encouragement wholly insufficient to overcome his dependence on sales to the profession.

Wheaton pressed on, producing over the course of the twelve terms he served what has been called “the golden book of American law.”<sup>96</sup> In Wheaton’s *Reports* appear many of the greatest cases of the Marshall Court, including *Martin v. Hunter’s Lessee*, *McCulloch v. Maryland*, *Dartmouth College v.*

“Bookselling is at present a very bad business, & Booksellers are all out of spirits, & unwilling to undertake any original work.” Letter from Peter Du Ponceau to Henry Wheaton (June 13, 1816), in Wheaton Papers, *supra* note 2. After difficult negotiations, Wheaton accepted \$1200 in notes from Mathew Carey, a publisher not normally engaged in the law trade, actually selling to Carey the copyright in the volume—the only occasion on which he ever parted with the copyright in his *Reports*. See Joyce, *supra* note 61, at 1325–26, 1339–40. Wheaton’s first volume sold badly. In 1821, five years after printing 1000 copies with high hopes, Carey still had 200 of them lying about. Complainants’ Evidence, *viz.*, Evidence of Henry C. Carey, *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), *microformed on Record*, *supra* note 86, at 23, 23–24. Rather than “devote them to the rats in the State-House,” as Dallas had threatened, Carey sold the remaining copies, and assigned all of his interest under the contract to Robert Donaldson of New York, Wheaton’s publisher for Volumes 2 through 12. Complainants’ Evidence, *viz.*, Assignment of copy-right, Carey and others to Donaldson (Sept. 11, 1821), *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), *microformed on Record*, *supra* note 86, at 23, 23. Donaldson eventually would become Wheaton’s cocomplainant in *Wheaton v. Peters*.

93. Letter from William Pinkney to Henry Wheaton (Sept. 3, 1818), in Wheaton Papers, *supra* note 2. In Pinkney’s most notable argument, he prevailed in *McCulloch v. Maryland*, 17 U.S. (4 Wheat.) 316 (1819) (upholding the constitutionality of the Bank of the United States).

94. Letter from John Marshall to the Senate Judiciary Committee (Feb. 7, 1817), *reprinted in* 2 WILLIAM WINSLOW CROSSKEY, POLITICS AND THE CONSTITUTION IN THE HISTORY OF THE UNITED STATES app. G, at 1246, 1246 (1953).

95. Act of Mar. 3, 1817, ch. 63, § 1, 3 Stat. 376 (obsolete). While Wheaton was Reporter, Congress renewed the Act three times. Act of May 15, 1820, ch. 131, § 1, 3 Stat. 606 (obsolete); Act of Mar. 3, 1823, ch. 34, §§ 1–3, 3 Stat. 768 (expired 1826); Act of Feb. 22, 1827, ch. 18, §§ 1–3, 4 Stat. 205 (expired 1830).

96. German obituary (source unknown), in Wheaton Papers, *supra* note 2.

*Woodward*, *Sturges v. Crowninshield*, *Gibbons v. Ogden*, *Osborn v. Bank of the United States*, and *Ogden v. Saunders*. But there was more.

Under Wheaton, the fidelity of the *Reports* was paramount. Accuracy<sup>97</sup> and completeness,<sup>98</sup> like timeliness of publication, improved dramatically. In addition, Wheaton provided to purchasers a resource unimagined by his predecessors: extensive scholarly annotations intended to furnish readers a comprehensive view of entire areas of law, apropos the decisions of each Term.<sup>99</sup> Many of the annotations were prepared anonymously for Wheaton by Story, his Washington “chum.”

Unfortunately for Wheaton, his otherwise admirable scholarship, combined with such factors as generous margins and handsome bindings, contributed greatly to the expense of his *Reports*—and, accordingly, to the same slow sales that had afflicted Dallas and Cranch before him. Sporadic retainers to argue cases before the Court alone or with others (including Daniel Webster in *Ogden v. Saunders*<sup>100</sup>) and occasional but unsuccessful runs at appointment to the Court himself (in 1823

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97. “It is a duty which [the Reporter] owes to the Court, to the profession, and to his own reputation,” Wheaton wrote in a note appended to the last opinion in the last case of his last volume, “to maintain the fidelity of the Reports, which are received as authentic evidence of the proceedings and adjudications of this high tribunal.” *Ramsay v. Allegre*, 25 U.S. (12 Wheat.) 611, 642–43 (1827). Ironically, the note was occasioned by the only suggestion of consequential error during Wheaton’s entire Reportership, when an ongoing dispute between Wheaton and his patron Justice Story, on the one side, and Justice Johnson, who had opposed their expansive views of the scope of federal admiralty jurisdiction, on the other side, boiled over into the *Reports*. See Joyce, *supra* note 61, at 1330; see also G. EDWARD WHITE, *THE MARSHALL COURT AND CULTURAL CHANGE*, 1815–35, at 393 (1991) (vols. 3–4 of *THE OLIVER WENDELL HOLMES DEVISE: HISTORY OF THE SUPREME COURT OF THE UNITED STATES*).

98. Wheaton’s punctilious attendance at court assured a thorough record of decisions when it came time to prepare the *Reports* themselves. Nevertheless, he recognized that many decisions lacked precedential value and would take up precious space without appealing measurably to potential purchasers. Thus, his initial preface explained matter-of-factly that “discretion” had been exercised “in omitting to report cases turning on mere questions of fact, and from which no important principle, or general rule, could be extracted.” 14 U.S. (1 Wheat.) iv (1816). That practice continued in later volumes.

99. *Id.* at v–vi. Wheaton’s aim, as he explained in the preface to Volume 1, was “to collect the rules and grounds dispersed throughout the body of the same laws, in order to see more profoundly into the reason of such judgments and ruled cases,” with the expected result “that the uncertainty of law, which is the principal and most just challenge that is made to the laws of our nation at this time, will, by this new strength laid to the foundation, be somewhat the more settled and corrected.” *Id.* (quoting Lord Bacon). In all, the annotations (or appendix notes) to Wheaton’s twelve volumes run to 516 pages.

100. 25 U.S. (12 Wheat.) 213, 214 (1827). Webster and Wheaton’s arguments were rejected by the Court by a four to three vote. Regarding Wheaton’s other cases, see Joyce, *supra* note 61, at 1340–42, 1348–49.

and 1826<sup>101</sup>) provided additional frustrations. In 1827, Wheaton resigned as Reporter to accept a diplomatic posting to Denmark (thereby quadrupling his salary) and to hope for better things to come.<sup>102</sup>

In accepting Wheaton's resignation, Chief Justice Marshall wrote, "I can assure you of my real wish that the place you have resigned had been more eligible [i.e., remunerative], and had possessed sufficient attractions to retain you in it. I part with you with regret . . . ."<sup>103</sup> Sadly for Wheaton, whose plans for a happy retirement from the Court's employment contemplated continued income from sales of his *Reports*,<sup>104</sup> the greater sorrow would soon be his.

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101. See Joyce, *supra* note 61, at 1348–49.

102. Letter from Joseph Story to Sarah Story (Mar. 8, 1827), in Story Papers (on file with the University of Texas Library, Austin, Tex.). The post paid \$4500 a year, plus expenses. *Id.*

103. Letter from John Marshall to Henry Wheaton (June 21, 1827), in Wheaton Papers, *supra* note 2.

104. The structure of that expectation was somewhat complex, though real in Wheaton's mind. He had arrived in Washington convinced that his appointment as Reporter placed him "in the way to secure an honorable independence." Letter from Henry Wheaton to Jonathan Russell (May 11, 1816), in Wheaton Papers, *supra* note 2. Indeed, given the new Reporter's skill in executing his labors, friends predicted that the profits derived from his new position would "treble those of [his] predecessors." Letter from Charles J. Ingersoll to Henry Wheaton (Jan. 8, 1817), in Wheaton Papers, *supra* note 2.

All such estimates proved to be in error. From the first, see *supra* note 92, sales of Wheaton's volumes were slow, largely by reason of their high cost (which, as will appear in the following pages, his successor, Richard Peters, Jr., would exploit brilliantly in marketing his *Condensed Reports*).

The result was meager contracts with his publishers. Authors of more popular books could profit directly from purchases of their volumes. Chief Justice Marshall's biography of George Washington, for example, brought the author and the copyright holder, Bushrod Washington, a total of one dollar per copy sold. Letter from Bushrod Washington to Elizabeth Hamilton (Dec. 14, 1819), in Bartholf Collection of Hamilton and McLane Family Papers (on file with the Library of Congress, Washington, D.C.) (advising the widow of Alexander Hamilton regarding a contract for the publication of Hamilton's biography by Joseph Hopkinson).

Wheaton was never so fortunate. In order to see his first volume into print, he was forced to part with his copyright in it, receiving only \$1200 in return. See *supra* note 92. He managed to retain his copyrights in subsequent volumes, but only by giving his publisher an exclusive license to print a set number of copies. See, e.g., Memorandum of an Agreement between Cornelius S. Van Winkle and Charles Wiley, two New York booksellers, and Henry Wheaton (Apr. 28, 1817), *microformed on Record*, *supra* note 86, at 28, 28 (creating a license for 1000 copies, subsequently conveyed to Robert Donaldson). All told, such arrangements brought Wheaton, for his twelve years of labor as Reporter, \$9900. For further detail, see Joyce, *supra* note 61, at 1339–40.

Thus, Wheaton's hopes for further income from sales of his *Reports* depended critically on continued demand for those copies already in print and available for sale by Robert Donaldson, who by 1827 held both the copyright in Volume 1 and all rights under the exclusive licenses to Volumes 2 through 12. If that supply could be exhausted before Wheaton's own copyrights on the latter volumes expired, further income to him might follow. If, however, Peters's *Condensed Reports* destroyed the market for such sales,

*D. Peters's Reportership and Wheaton's Peril*

Wheaton's successor was Richard Peters, Jr.<sup>105</sup> The new Reporter's father, Richard Peters, Sr., had been a member of the Continental Congress and became U.S. District Judge for the District of Pennsylvania in 1792, remaining on the bench until his death in 1828. As District Judge, Peters, Sr. served on the Circuit Court with Justice Bushrod Washington, whose decisions on that court Peters, Jr. had edited. With Washington's support, the younger Peters apparently secured appointment to the Reportership by unanimous vote of the Justices.<sup>106</sup>

While not pretending to the intellectual stature of Dallas, Cranch, and Wheaton, nor destined to rival their accomplishments in other offices, Peters possessed one attribute his illustrious predecessors had all notably lacked: a keen business sense. He believed that the *Reports* could be made to pay, and his plan for publishing them resembled the man himself: brisk, practical, and determined to avoid unremunerative detours into esoteric scholarship.

Peters's publication plan had two components. The first concerned the traditional annual volumes of the *Reports*. In terms of the Court's opinions, the accuracy and completeness of the new *Reports* proved to be comparable to Wheaton's. Additionally, the new Reporter's Act of 1827,<sup>107</sup> requiring publication at a price not exceeding five dollars per volume within six months of the close of each sitting of the Court, assured timeliness and affordability. With respect to presentation and the Reporter's own contributions, however, Peters's *Reports* became the subject of much criticism.<sup>108</sup>

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Wheaton—and Donaldson—stood to lose everything.

105. See Joyce, *supra* note 61, at 1351. Richard Peters, Jr. was born in Philadelphia, Pennsylvania on August 4, 1779 (sometimes reported as August 17, 1780), and he died in Belmont, Pennsylvania on May 2, 1848. *Id.* at 1351 n.373, 1385.

106. See Letter from C.C. Biddle to Richard Peters, Jr. (Jan. 25, 1828), in Peters Papers, *supra* note 76 (congratulating Peters on his appointment).

107. Act of Feb. 22, 1827, ch. 18, 4 Stat. 205 (expired 1830). The status of the Reportership was uncertain from 1830 until a new version of the Act was adopted in 1842. Act of Aug. 26, 1842, ch. 202, § 2, 5 Stat. 524; Craig Joyce, *Wheaton v. Peters: The Untold History of the Early Reporters*, Y.B. 1985: SUP. CT. HIST. SOC'Y 35, 85 n.296 (1985).

108. Upon receiving his copy of Volume 1, Justice Story wrote immediately to the new Reporter to express his regret "that the text is so compact & small," a measure he supposed "unavoidable . . . to bring the work into a moderate compass" but nonetheless a respect in which he "greatly . . . preferred . . . [the] 12th of Wheaton." Letter from Joseph Story to Richard Peters, Jr. (June 26, 1828), in Peters Papers, *supra* note 76. In place of Wheaton's expansive scholarship explicating the jurisprudence of the Term, moreover, Peters offered only compressed abstracts (or headnotes) of the cases decided. This innovation received similarly unflattering reviews. Boston's *American Jurist and Law*

The second, more ambitious component of Peters’s plan to make the *Reports* pay is aptly described by the title of the project: *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*. Both the need for such a publication and Peters’s gift for exploiting it shine from the pages of his self-confident *Proposals* for the work, issued less than six months after assuming the Reporter’s office:

The Supreme Court of the United States has been organized for thirty-eight years, and its decisions form in themselves almost an entire code of laws. Many of the difficult and important questions of constitutional construction, and of the nature and extent of the powers reserved, granted, and claimed, under the constitution, have passed under the careful observation and judgment of the court. . . .

. . . [T]he law thus general, thus established, thus supreme, should be universally known. That there should be found but few copies of the reports of the cases decided in the Supreme Court of the United States in many large districts of our country . . . is asserted to be a frequent fact. . . . These things should not be.

It will not be denied that these circumstances are the consequences of the heavy expense which must be incurred by the purchase of the two [sic] volumes of the Reports of Mr. Dallas, the nine volumes of Mr. Cranch, and the twelve of Mr. Wheaton’s Reports; together twenty-three [sic] volumes—the cost of which exceeds one hundred and thirty dollars.

It is proposed to publish all the cases adjudged in the Supreme Court of the United States from 1790 to 1827, inclusive, in a form which will make the work authority in all judicial tribunals, and to complete the publication in not more than six volumes, the price of which shall not exceed thirty-six dollars.<sup>109</sup>

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*Magazine* wrote, “After studying a page or two of fine type, [the reader’s] mind is in a painful state of uncertainty as to the points actually decided by the court, and can only be relieved by examining the body of the decision.” *Peters’s Reports*, 3 AM. JURIST & L. MAG. 101, 103 (1830). In at least one instance, Peters had stated as the holding of a case a rule “directly the reverse of the opinion” handed down by Marshall. *Id.* at 109. “Indeed there is scarcely a single abstract in the volume which states the points in the case definitely and tersely, and which is not open to serious objections.” *Id.* at 108–09.

109. Exhibit A for Appellants, *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), *microformed on Record*, *supra* note 86, at 2, 9–11. Owning a full set of the reports of

There were trade-offs, to be sure. The type employed would be smaller than in the original volumes. The arguments of counsel that had appeared in the earlier reports were to be omitted entirely, as well as the scholarly notes contained in Wheaton's twelve volumes. Most significantly, in his zeal to present the cases in "abbreviated form," Peters intended to pare away concurring and dissenting opinions. The means might be draconian, but the aim was brilliantly appealing. At one stroke, Peters's *Condensed Reports* would supplant the entire market for all of his predecessors' volumes through slashing both bulk and expense by seventy-five percent.

Two sorts of reactions followed predictably. First, those deeply concerned with, but not financially interested in, disseminating broadly the reports of the Supreme Court (like the Justices themselves) rejoiced. Justice Story thought the "compressed Edition" contemplated by Peters "a most valuable present to the Profession."<sup>110</sup> Justice Washington lauded it as "a treasure" that would "liberally reward" the Reporter.<sup>111</sup>

What, on the other hand, of Dallas, Cranch, and Wheaton, Peters's predecessors in production of the Court's reports? Dallas had died in 1817, and the copyright in his volumes had expired. Cranch, still a sitting judge in the District of Columbia and still out of pocket \$1000 for the expenses of his final volumes, objected strongly.<sup>112</sup> Peters riposted that his project "will [not] injure the sale of your or Mr. Wheaton's Reports," but on the contrary would render them "more in demand."<sup>113</sup> More to the point, Peters averred, his reports "will not be obnoxious to the law protecting

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Dallas, Cranch, and Wheaton at \$130 was beyond the means of all but the most successful lawyers in major commercial centers. Comprehensive information concerning contemporary lawyers' income is difficult to obtain, but examples abound. Consider the following:

According to George W. Strong, his father, who practiced in upstate New York, earned \$217 during his first year at the bar (1826–27), but "in his third year of practice was evidently making good headway, for his receipts in 1829 amounted to \$670.00." Bartholomew F. Moore, who was admitted to the North Carolina bar in 1823, relates that his total income from the practice of law during his first seven years [i.e., through 1830] amounted to only \$700, or about \$100 per year.

2 ANTON-HERMANN CHROUST, *THE RISE OF THE LEGAL PROFESSION IN AMERICA* 88 (1965) (quoting G. STRONG, *LANDMARKS OF A LAWYER'S LIFETIME* 11 (1910)).

110. Letter from Joseph Story to Richard Peters, Jr. (June 26, 1828), *supra* note 108.

111. Letter from Bushrod Washington to Richard Peters, Jr. (July 21, 1828), *in* Peters Papers, *supra* note 76.

112. Letter from William Cranch to Richard Peters, Jr. (July 18, 1828), *in* Peters Papers, *supra* note 76.

113. Letter from Richard Peters, Jr. to William Cranch (Aug. 14, 1828), *in* Peters Papers, *supra* note 76.

literary property,”<sup>114</sup> for he planned to take from Cranch’s volumes nothing written by his predecessor himself: “My work will be a ‘Digest’ of the facts of the cases and the opinions of the Court—no more.”<sup>115</sup> Seeing the handwriting on the wall, Cranch ultimately settled with Peters in return for fifty copies of the *Condensed Reports*.<sup>116</sup>

Only Peters’s immediate predecessor, Henry Wheaton, remained. Wheaton had counted on future sales of his *Reports* to realize the fruit of his labors. Unfortunately for him, Peters’s “Digest” was anything but a digest. By reproducing the Court’s opinions in full, it might, if it proved popular with the practicing bar, eliminate entirely the need to consult Wheaton’s volumes.

Happily occupied with diplomacy in faraway Denmark, Wheaton seemed not to have appreciated, at first, the gravity of his peril. Surely, he wrote to Daniel Webster in late 1828 following the publication of Peters’s *Proposals*, “amicable remonstrances” would dissuade his successor from proceeding.<sup>117</sup> Nothing, however, would budge Peters from his chosen path. The first volume of the *Condensed Reports* went to press late in 1829. Having just lost his principal patron, Bushrod Washington, to death, Peters wasted no time in shoring up his support on the Court against any eventuality. He promised to dispatch a copy of his newest work immediately when printed to Justice Story<sup>118</sup>

114. *Id.*

115. *Id.*

116. Letter from Richard Peters, Jr. to Richard S. Coxe (Dec. 13, 1829), in Peters Papers, *supra* note 76.

117. Letter from Henry Wheaton to Daniel Webster (Nov. 25, 1828), in Wheaton Papers (on file with the Library of Congress, Washington, D.C.) (noting that his expectations for future printings of his reports “in order to realize the fruits of my labor . . . will be entirely defeated should Mr. Peters persist in his design”).

118. Letter from Richard Peters, Jr. to Joseph Story (Nov. 26, 1829), in Story Papers (on file with the Massachusetts Historical Society, Boston, Mass.). Story responded at once upon receipt of Volume 1, pronouncing himself “so much pleased” with the “plan & execution” of the work “that I shall take it with me to Washington for use during the next Session of the Supreme Court in lieu of the orig[inal] Reports.” Letter from Joseph Story to Richard Peters, Jr. (Dec. 10, 1829), in Peters Papers, *supra* note 76.

Indeed, Story’s enthusiasm for the *Condensed Reports*, as for all projects likely to increase the circulation of the Court’s decisions throughout the country, knew few bounds. He understood from the outset that Wheaton and Cranch had “scarcely reaped” the “fair reward” to which their labors entitled them; but, doubting that they ever would, he endorsed Peters’s project anyway. Letter from Joseph Story to Richard Peters, Jr. (June 26, 1828), *supra* note 108. He even approved Peters’s “proposed course of dropping the dissentient opinions” from his condensation, graciously announcing that “[s]o far as I am personally concerned I have no desire that my own should reappear.” Letter from Joseph Story to Richard Peters, Jr. (May 30, 1830), in Peters Papers, *supra* note 76. Ultimately, the “great value” of the *Condensed Reports* to him was that they “bring with[in] the compass of the most moderate means all the important decisions of the Supreme Court.” Letter from Joseph Story to Samuel E. Sewell (Sept. 13, 1830), in Phillips Papers (on file

and dedicated the work itself, “most respectfully and affectionately,” to Chief Justice Marshall.<sup>119</sup>

Peters’s *Condensed Reports* quickly became an enormous success. In February 1831, Volume 3 appeared in an edition of 1500, with more than 900 copies sold by advance subscription.<sup>120</sup> In addition to Cranch’s last two volumes, this latest installment of the *Condensed Reports* contained the first volume of Wheaton’s *Reports*.

In May 1831, on behalf of Wheaton and himself, Wheaton’s publisher, Robert Donaldson,<sup>121</sup> filed suit in the Circuit Court for the Eastern District of Pennsylvania against Peters and his publisher, John Grigg of Philadelphia.<sup>122</sup> Wrote Donaldson to

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with the Massachusetts Historical Society, Boston, Mass.).

Other members of the Court, to whom Peters had also provided complimentary copies, offered similar praise. *See, e.g.*, Letter from Smith Thompson to Richard Peters, Jr. (Dec. 19, 1829), in Peters Papers, *supra* note 76 (describing the work as “a highly useful book”). And, a step lower in the federal judiciary, District Judge Joseph Hopkinson of Philadelphia, a member of the Circuit Court for the Eastern District of Pennsylvania that would later issue the key trial court ruling in *Wheaton v. Peters*, observed in a letter to the publisher of the *Condensed Reports*, “The importance of a general circulation of the decisions of the highest judicial tribunal of our country to the uniformity and correctness of the judgment of inferior courts renders a work like the present, almost one of necessity.” Letter from Joseph Hopkinson to John Grigg (Dec. 1, 1829), in Hopkinson Papers (on file with the Historical Society of Pennsylvania, Philadelphia, Pa.).

119. 1 RICHARD PETERS, JR., 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, at iii (1830).

120. FREDERICK C. HICKS, MEN AND BOOKS FAMOUS IN THE LAW 208 (1921).

121. As recited earlier, *see supra* notes 92, 104, Donaldson held both the copyright in Wheaton’s first volume and the rights to first printings of Volumes 2 through 12. For all of the relevant contracts, see Record, *supra* note 86, at 23. The complainants thus held closely related interests: if Peters’s project destroyed the market for Wheaton’s *Reports*, Donaldson would be unable to sell his remaining copies of the first printings; if Donaldson’s supply of copies of the first printings could not be exhausted, Wheaton’s right to print further copies of the volumes to which he had retained the copyrights would be without value.

As Donaldson put the matter directly to Peters himself,

[T]he effect of [the *Condensed Reports*] would be to me literally ruinous on a large amount of property. . . . Likewise the injury that would be done to my absent friend Henry Wheaton, Esq., by such a publication and the result of which would be to deprive him and his family of the pecuniary reward due to his professional labours of 12 years.

Letter from Robert Donaldson to Richard Peters, Jr. (Sept. 25, 1828), in Peters Papers, *supra* note 76. Peters responded by sending Donaldson a copy of his reply to Cranch, Letter from Richard Peters, Jr. to William Cranch (Aug. 14, 1828), *supra* note 113, in which he had predicted piously that his own reports would serve only to whet the profession’s thirst for his predecessors’ volumes, Letter from Richard Peters, Jr. to Robert Donaldson (Sept. 26, 1828), in Peters Papers, *supra* note 76.

122. Joyce, *supra* note 61, at 1370. For a discussion of the claims themselves, see *infra* Act Two.

Wheaton, in demanding that the latter immediately engage counsel to protect their mutual interests, "[U]ntil an example is made of these literary Pirates there can be no security for the labours of authors and Publishers."<sup>123</sup> For two years, however, the matter remained mired in the Circuit Court, until that court ultimately ruled in favor of Peters and Grigg.<sup>124</sup>

In April 1833, Wheaton and Donaldson appealed.<sup>125</sup> But was it too late? Wheaton, absent on diplomatic missions abroad since the conclusion of his Reportership, had already lost the first round. The matter now would proceed to Wheaton's former employers at the Supreme Court, where Peters served by the Justices' sides in Wheaton's former place. "Peters is on the spot," wrote Wheaton's former New York law partner, Elijah Paine, "& alas, the face of a party does often turn a doubtful balance held by human judges."<sup>126</sup>

Wheaton now had no choice. His continued income from his *Reports*, his legacy to his family, and perhaps all remembrance of his name in the annals of American law, hung in the balance. The time for "amicable remonstrances" was past. His own presence "on the spot" was required. And so, in the middle of October, Wheaton set sail from Liverpool on a boisterous late-season passage across the Atlantic to take charge of his own case—and to help write the first great chapter in the jurisprudence of American intellectual property law.<sup>127</sup>

[*Exit west.*]

[CURTAIN. END OF ACT ONE.]

#### ENTR'ACTE:<sup>128</sup> THE ISSUES (AN OVERVIEW)

Wheaton's voyage home would require thirty-two days. While the players regroup in anticipation of the remaining scenes, which would reach their climax in the Supreme Court on

123. Letter from Robert Donaldson to Henry Wheaton (Aug. 11, 1828), in Wheaton Papers, *supra* note 2.

124. Joyce, *supra* note 61, at 1371.

125. Evidence of Defendant, Appeal, Wheaton v. Peters, 33 U.S. (8 Pet.) 591 (1834), *microformed on Record*, *supra* note 86, at 61, 61.

126. Letter from Elijah Paine to Henry Wheaton (Aug. 28, 1833), in Wheaton Papers, *supra* note 2.

127. BAKER, *supra* note 85, at 127.

128. Pronunciation: 'ä'(n) -"trakt, -"träkt, ä'(n)-'. Function: *noun*. Etymology: French, from *entre-* inter- + *acte* act. **1** : a dance, piece of music, or interlude performed between two acts of a play. **2** : the interval between two acts of a play. Merriam-Webster Online Dictionary, at <http://www.m-w.com/cgi-bin/dictionary?va=entr'acte> (last visited Apr. 15, 2005).

the morning of March 19, 1834, it seems well to recall certain aspects of the drama to date and to survey briefly the issues they raised for decision in the ensuing litigation.

If the Overture and Act One demonstrate anything, it is that the protection of intellectual property in England and America enjoyed a checkered and colorful history in the several centuries of its existence prior to *Wheaton v. Peters*. In England, patents had been the subject of royal monopolies, and copyright the subject of the stationers' regime and the licensing acts. Parliament had adopted the world's first copyright act in 1710. In 1774, the House of Lords had held definitively, as to published works, that the only protection available to authors and their assignees was statutory. In America, the Framers had acted swiftly in 1787—following the failure of the Articles of Confederation—to empower the new federal government created by the Constitution to act forcefully on intellectual property law, as on many other fronts. In 1790, Congress had enacted the first national copyright and patent statutes (and acted again on copyright law, the focus of *Wheaton*, with further legislation adopted in 1802, 1819, and 1831, barely three months before the filing of *Wheaton* and Donaldson's complaint). *Wheaton v. Peters* would react with this history principally on three issues.

#### A. *Statutory Right v. Natural Law*

The nature of copyright in England had been settled in 1774 by the House of Lords' great decision in *Donaldson v. Beckett*.<sup>129</sup> The principal question there was whether, after the Statute of Anne, copyright law, at least respecting works subjected to publication, had become solely a creature of statute, with all rights existing subject to constraints enacted by the legislature, or whether a common law entitlement, arising by virtue of an author's natural right in the product of her creations, had preexisted adoption of the Statute and then survived its enactment unfettered by the Statute's limitations (including with respect to duration).<sup>130</sup> In *Donaldson*, the House of Lords had adopted the statutory right (or positive law) theory of copyright law and thus assured that published works that did not qualify for copyright or exceeded the statutory term of protection would

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129. 98 Eng. Rep. 257 (H.L. 1774) (discussed *supra* in text accompanying note 14). For summaries of the facts, issues, and holdings in *Donaldson* and its predecessor case in the Court of King's Bench, *Millar v. Taylor*, 98 Eng. Rep. 201 (K.B. 1769), see Patterson & Joyce, *supra* note 15, at 923–28.

130. See Patterson & Joyce, *supra* note 15, at 925–26.

escape the claims of would-be proprietors and fall forever into the public domain, there to be enjoyed freely by all.<sup>131</sup>

In the United States, no such authoritative judicial determination with respect to the basis of copyright holders’ rights—including Wheaton and his publisher’s rights, if any, in Wheaton’s *Reports*—had yet been made.

### B. *The Importance of Statutory Formalities*

The Statute of Anne, the model for all early American copyright legislation, had prescribed certain statutory formalities<sup>132</sup>—including registration of the title of the book and deposit of a copy thereof with the Stationers’ Company—as prerequisites to copyright protection. Similarly, the Copyright Act of 1790 prescribed registration of a copyright claim with the local federal district court clerk and deposit of a copy of the work, within six months of publication, in the office of the Secretary of State. The 1802 Act added a new formality: the placement of a notice of copyright on every publicly distributed copy of the work. Finally, the 1831 Act revised the details of all three of the by-then established formalities, namely, registration, deposit, and notice.<sup>133</sup>

In seeking to protect his volumes of *Reports*, had Wheaton and his publisher complied scrupulously with the statutory formalities? If not, what became of their claimed copyrights in the contents of those volumes?

### C. *Owning the Law (Reports)*<sup>134</sup>

Neither the Statute of Anne nor any American enactment had spoken directly to one remaining question that would prove

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131. *Id.* at 927–28.

132. For a more detailed description of the Statute of Anne’s provisions, see *id.* at 916–23.

133. In addition to the summary of these acts provided earlier in the Article, fuller descriptions are available in 1 PATRY, *supra* note 37, at 30–39.

134. Neither Henry Wheaton nor any of his predecessors claimed explicitly to own “the law” itself, if “the law” means the holdings and rationales of the Justices’ opinions. For Wheaton’s own precise specification to his counsel of those aspects of the *Reports* (annotations, et cetera) in which he claimed personal authorship, see *infra* text accompanying notes 159–63. His analysis, however, leveraged that authorship, plus his reconstruction of opinions delivered from the bench with no written text by the Justices, into a claim of copyright that protected the contents of his twelve volumes of *Reports* in their entirety. If Wheaton’s monopoly rights under copyright extended, as he claimed, so far as to preclude his successor, Richard Peters, Jr., from copying any part of those volumes, in practice no one could obtain access to the Justices’ accounts of “the law” except by purchase of books, published or licensed by Wheaton, in which those accounts were to be found.

pivotal in *Wheaton v. Peters*. Even if, in the United States, copyright for published works was a creature solely of statute, and even if all of the formalities provided by such statutes had been observed punctiliously in the publication of Wheaton's *Reports*, that question remained. Peters had asserted (in his reply to Cranch's objections, later copied to Wheaton) that Peters's republication of opinions and underlying facts from his predecessors' volumes was "not . . . obnoxious to the law[] protecting literary property"<sup>135</sup> because the matter taken from the reports of Dallas, Cranch, and Wheaton was incapable of protection.

How could that be? Assuming, for the sake of argument, that Wheaton had satisfied all requirements prescribed by law for obtaining the protection afforded by statute, how could Peters's taking *not* offend the law of copyright? How could anyone *other* than Wheaton, who had obtained by gift from the Justices, in return for faithful service, such written opinions as they possessed and created all the remaining opinions himself from notes laboriously taken in the courtroom, not possess the exclusive right, promised by Constitution and statute alike, to print and vend the heart and soul of his *Reports*? In short, who owned the Justices' official accounts of American law?

#### ACT TWO: *WHEATON V. PETERS* IN THE COURTS

[*The second act curtain rises.*]

##### A. *The Proceedings Below*

Henry Wheaton arrived in Washington, D.C. in mid-January 1834 looking, in the words of his opponent, Richard Peters, Jr., "very mad."<sup>136</sup> He threw himself immediately into preparations for the argument of his case before the Supreme Court. The case had gotten there by a curious route.<sup>137</sup>

Wheaton and Donaldson's bill in equity, filed against Peters and Grigg in the Circuit Court for the Eastern District of Pennsylvania pursuant to the copyright revision act of 1819,<sup>138</sup>

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135. Letter from Richard Peters, Jr. to William Cranch (Aug. 14, 1828), *supra* note 113.

136. Letter from Richard Peters, Jr. to Thomas Sergeant (Jan. 15, 183[4]), in *Sergeant Papers* (on file with the Historical Society of Pennsylvania, Philadelphia, Pa.).

137. The proceedings in the Circuit Court, and also the Supreme Court, are discussed in *Abrams*, *supra* note 14, at 1178–85.

138. See Act of Feb. 15, 1819, ch. 19, 3 Stat. 481 (conferring jurisdiction in equity and law upon the federal circuit courts regarding intellectual property matters).

had sought an injunction to prevent the defendants from further printing or disseminating copies of Volume 3 of Peters’s *Condensed Reports*, plus an accounting of profits.<sup>139</sup> The bill alleged that Peters’s volume contained, “without any material abbreviation or alteration, all the reports of cases” in Volume 1 of Wheaton’s *Reports*.<sup>140</sup> In his answer, Peters denied that he had violated the complainants’ rights, contending that the statutory requirements for securing a federal copyright had not been met, that no right to common law copyright existed in the United States, and that, in any event, the contents of Wheaton’s *Reports*, insofar as they had been republished in the *Condensed Reports*, were incapable of supporting a copyright either under statute or at common law.<sup>141</sup>

Initially, the court issued the preliminary injunction sought by Wheaton and Donaldson.<sup>142</sup> In early 1832, Peters and Grigg moved to dissolve the injunction. The two judges constituting the court—Henry Baldwin (who had succeeded Bushrod Washington on the Supreme Court) and Joseph Hopkinson (who had succeeded Peters’s father on the District Court)—found themselves unable to agree on a disposition. Hopkinson favored dissolving the injunction; Baldwin advocated dismissing the motion. Accordingly, the injunction remained in force. Circumstances had changed, however, by the time the action came before the court for final hearing in December 1832. Baldwin, incapacitated by a “derangement of the mind”<sup>143</sup> of progressive severity, could not or would not sit. Hopkinson, refusing to defer the hearing “for a day,”<sup>144</sup> proceeded with the arguments. His opinion, dismissing the bill and dissolving the injunction, was entered on January 9, 1833.<sup>145</sup> In essence,

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139. Bill in Equity for Appellants, *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), *microformed on Record*, *supra* note 86, at 2, 4; BAKER, *supra* note 85, at 126.

140. Bill in Equity for Appellants, *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), *microformed on Record*, *supra* note 86, at 2, 6–7.

141. *Wheaton v. Peters*, 29 F. Cas. 862, 863 (C.C.E.D. Pa. 1832) (No. 17,486) (recounting the defenses raised in the answer to the complaint), *rev’d*, 33 U.S. (8 Pet.) 591 (1834); *see also* Separate Answer of Richard Peters, *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), *microformed on Record*, *supra* note 86, at 14, 14–18. Grigg’s separate answer contained substantially the same allegations. Separate Answer of John Grigg, *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), *microformed on Record*, *supra* note 86, at 18, 18–21.

142. The following account relies primarily on Elijah Paine’s report to Wheaton on the progress of the litigation. Letter from Elijah Paine to Henry Wheaton (Jan. 16, 1833), in *Wheaton Papers*, *supra* note 2.

143. *Id.*

144. *Id.*

145. *Wheaton*, 29 F. Cas. at 872, *reprinted in* *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 app. at 725, 741–42 (1834); *see* BAKER, *supra* note 85, at 127 (citing HICKS, *supra* note 120, at 209).

Hopkinson agreed with Peters and Grigg that the complainants had failed to accomplish the prerequisites for statutory copyright under the laws of the United States and that any claim to common law copyright, state or federal, had been precluded by the pertinent enactments of Congress.<sup>146</sup> The opinion did not address the issue of the copyrightability of the opinions and other matter taken by Peters from earlier reports.

In closing, Hopkinson observed, "I am conscious of the importance of the questions which have been discussed in this cause, to the parties and to the public; and it is a real satisfaction to me to know that my opinion may be, and I presume will be, reviewed by another tribunal."<sup>147</sup> Wheaton and Donaldson's appeal to the Supreme Court followed quickly.<sup>148</sup>

### B. *The Issues from Wheaton's Perspective*

Ultimately, the outcome of the controversy, once Hopkinson rendered his judgment in Peters's favor, lay in the viability of Peters's predecessor's justifications for the protection that he always had assumed attached to his *Reports*. We pause briefly, therefore, to review from Wheaton's perspective the critical issues of the case, as reflected in two extraordinary memoranda in Wheaton's own hand, written for his own counsel, Daniel Webster and Elijah Paine, upon Wheaton's arrival in Washington.<sup>149</sup>

In their efforts to predict and influence the resolution of the dispute by the Justices, Wheaton (and counsel on both sides)

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146. See *Wheaton*, 29 F. Cas. at 872; see also Act of Apr. 29, 1802, ch. 36, 2 Stat. 171 (repealed 1831); Act of May 31, 1790, ch. 15, 1 Stat. 124 (repealed 1831).

147. *Wheaton*, 29 F. Cas. at 872, reprinted in *Wheaton*, 33 U.S. (8 Pet.) at 742.

148. Evidence of Defendant, Appeal, *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), microformed on Record, *supra* note 86, at 61, 61; see also HICKS, *supra* note 120, at 209. Peters, for his part, proceeded with publication of the remaining three volumes of the *Condensed Reports*. Volume 6 appeared in January 1834, two months prior to argument of the appeal in the Supreme Court. HICKS, *supra* note 120, at 208–09.

149. Wheaton had sought to enlist Webster in July 1831. Letter from Henry Wheaton to Daniel Webster (July 22, 1831), in Daniel Webster Papers (on file with the Library of Congress, Washington, D.C.) ("Consider yourself as retained for me . . ."), quoted in BAKER, *supra* note 85, at 126. Paine, Wheaton's long-time friend and former partner from his New York City days, reinforced the invitation that December. Letter from Elijah Paine to Daniel Webster (Dec. 6, 1831), in Daniel Webster Papers (on file with the New Hampshire Historical Society, Concord, N.H.) ("This suit . . . will without any doubt be carried to Washington."), quoted in BAKER, *supra* note 85, at 347 n.5. The documents, prepared by Wheaton for counsel, are Wheaton's Pre-Argument Memorandum A to Daniel Webster (Jan. 1834) [hereinafter Wheaton's Pre-Argument Memorandum A], in *Wheaton Papers*, *supra* note 2, and Wheaton's Pre-Argument Memorandum B to Daniel Webster (Jan. 1834) [hereinafter Wheaton's Pre-Argument Memorandum B], in *Wheaton Papers*, *supra* note 2.

could draw on relatively little American case law and certainly no precedents of the Court itself. Of the handful of lower court cases on the law of copyright decided in the four decades since the founding of the national government,<sup>150</sup> only two were directly relevant. One, a state court case, had displayed a liberal attitude toward authorship by excusing certain prerequisites to statutory copyright as merely “directory,”<sup>151</sup> while the other, a circuit court decision by Justice Washington, had held any departure from the strict requirements of the Acts of 1790 and 1802 fatal to the author’s rights.<sup>152</sup> Neither case spoke to the question of Wheaton’s unique circumstances as Reporter.

Unquestionably, in Wheaton’s view, “a Reporter is an *Author*,”<sup>153</sup> his “exclusive right to the Copy”<sup>154</sup> in his *Reports* unaltered by either his appointment by the Justices or receipt of a paltry salary from Congress under the Reporter’s Act of 1817.<sup>155</sup> The true reward for Wheaton’s twelve years of labor was his expectation of continued revenue from purchases of the *Reports* themselves, which in turn rested on the promise of continued protection of the Reporter’s copyrights under the laws of the United States.<sup>156</sup>

Wheaton’s point—that the decisions of the Court as rendered by the *Reports* always had been regarded as subject to copyright by the Reporter—rested on a reasonable foundation. Historically, copyright law in America has served (in the words of the Copyright Clause itself) “[t]o promote the Progress of Science” by incentivizing authors financially.<sup>157</sup> Prior to publication of the

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150. In addition to the decisions relevant to the present discussion and described in the text, see also two little-known cases identified in Jane C. Ginsburg, *A Tale of Two Copyrights: Literary Property in Revolutionary France and America*, 64 TUL. L. REV. 991, 1004–05 & n.60 (1990): *Blunt v. Patten*, 3 F. Cas. 763, 764–65 (C.C.S.D.N.Y. 1828) (No. 1580) (discussing copyrights for navigation charts) and *Clayton v. Stone*, 5 F. Cas. 999, 1000, 1003 (C.C.S.D.N.Y. 1829) (No. 2872) (denying copyright protection for newspaper financial reports).

151. *Nichols v. Ruggles*, 3 Day 145, 158, 1808 WL 94, at \*8 (Conn. 1808) (concluding that publishing the title of a book in a newspaper and delivering a copy to the Secretary of State “constitute no part of the essential requisites for securing the copyright”).

152. *Ewer v. Coxe*, 8 F. Cas. 917, 919–20 (C.C.E.D. Pa. 1824) (No. 4584) (holding all of the statutory requirements under the 1790 and 1802 Acts, by virtue of their latter enactment, to be mandatory).

153. Wheaton’s Pre-Argument Memorandum A, *supra* note 149.

154. *Id.*

155. *Id.*; see Act of Mar. 3, 1817, ch. 63, § 1, 3 Stat. 376 (obsolete).

156. Wheaton’s Pre-Argument Memorandum A, *supra* note 149 (“[Wheaton] would much rather lose his Salary & keep his Copy Right.”).

157. See, e.g., *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 558 (1985) (stating that copyright law “supplies the economic incentive to create and disseminate” nonprotectible ideas and facts clothed in protectible expression).

*Condensed Reports*, scarcely anyone had questioned the wisdom of according to Wheaton and his predecessors the exclusive right to multiply copies of their volumes as a key incentive to their labors.<sup>158</sup> That assumption simply had not had occasion to be examined with a critical eye until challenged by Peters.

Wheaton faltered slightly, however, in describing for counsel precisely which aspects of his works constituted copyrightable authorship. “Mr. W. is unquestionably author,” he wrote, “of the Summaries of Points decided—of the Statements of the Cases prefixed—of the analytical Indexes at the end of each vol. All these Mr. P. has pirated.”<sup>159</sup> But what of the opinions themselves, the principal component of the *Condensed Reports*’ commercial appeal? Wheaton noted that “there [were] in every volume several Opinions delivered orally from the Bench, & taken down by Mr. W.”<sup>160</sup> Even so, it might be argued that the rationale for according such opinions copyright protection did not extend to the Court’s more significant opinions actually prepared by the Justices themselves.<sup>161</sup> To this objection, Wheaton suggested the following reply:

Supposing then Mr. W. has no Copy Right in the written opinions of the Judges—for argument’s sake,—it is enough if he has such Right in any substantial portion of his 12 vols., which Mr. Peters has copied, no matter how little mind it may have required to compose that portion, or how piddling the labour may have been.<sup>162</sup>

In effect, Wheaton found himself reduced to arguing that the *Reports*, because they included parts individually susceptible to copyright, constituted compilations entitled to protection in their entirety.<sup>163</sup>

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158. “Who would have undertaken the expense & risk of publishing an edition of [judicial reports],” Wheaton would later cry, if they “might be encountered the next day by a piratical edition?” Wheaton’s Pre-Argument Memorandum A, *supra* note 149. Certainly Justice Story, Wheaton’s mentor and friend, had harbored no doubts concerning the copyrightability of such reports. In response to Wheaton’s plea for assistance in finding a publisher for his first volume in 1816, Story had written: “I am fearful that at present there is not a bookseller in Boston who is able to print them, or give anything for the copy right.” Letter from Joseph Story to Henry Wheaton (May 25, 1816), in Wheaton Papers, *supra* note 2 (emphasis added).

159. Wheaton’s Pre-Argument Memorandum A, *supra* note 149.

160. *Id.*

161. See *infra* note 182 and accompanying text (discussing the divergent perspectives on the copyright availability of the Justices’ manuscript opinions and quoting Justice William Johnson as stating “our opinions I have never doubted were public property & not assignable by us”).

162. Wheaton’s Pre-Argument Memorandum A, *supra* note 149.

163. See *id.* Compare the preceding citation with the Copyright Act of 1976, which specifically approves the copyrightability of compilations, but provides that “[t]he

Similar difficulties confronted Wheaton in attempting to dispose of Peters’s remaining defenses to his claims. On the issue of his compliance with the statutory formalities imposed by the Copyright Acts of 1790 and 1802,<sup>164</sup> Wheaton assured his attorneys that each and every requirement had been fulfilled. He failed, however, to note or suggest solutions to chronic and potentially fatal evidentiary deficiencies concerning publication of the copyright claims in the public press (a requirement deleted by the 1831 Act but too late to help Wheaton in protecting volumes published earlier). Further, he attempted feebly to explain away his own inattention to depositing a copy of each volume of the *Reports* with the Secretary of State, pursuant to the Copyright Acts, with the argument that he considered furnishing eighty copies, as required under the Reporter’s Act, sufficient for both purposes.<sup>165</sup> In sum, Wheaton believed he had achieved substantial compliance with all of the statutory requirements; and in those instances when his observance had been less than punctilious, the requirements were “directory merely” and “not a condition, the noncompliance with which forfeits the right.”<sup>166</sup>

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copyright in a compilation . . . extends only to the material contributed by the author of such work [i.e., by the compiler], as distinguished from the preexisting material employed in the [compilation].” 17 U.S.C. § 103(b) (2000).

164. Taken together, the acts prescribed four steps to be followed by an author seeking to obtain a federal statutory copyright: (1) record the title of the work in the office of the clerk of the federal judicial district in which the author resided; (2) print a copy of the record thus procured on the title page, or following page, of the work; (3) within two months of recording the title, cause a copy of the record to appear in the public press for a period of four weeks; and (4) within six months of publication of the work itself, deliver a copy thereof for deposit at the Department of State. *See Ewer v. Coxe*, 8 F. Cas. 917, 919 (C.C.E.D. Pa. 1824) (No. 4584) (explaining the four steps created by the Copyright Acts of 1790 and 1802). Specifically, Peters claimed that Wheaton had failed to perform the third and fourth steps. *Wheaton v. Peters*, 29 F. Cas. 862, 863 (C.C.E.D. Pa. 1832) (No. 17,486), *rev’d*, 33 U.S. (8 Pet.) 591 (1834).

165. Carey, Donaldson’s predecessor as proprietor of the initial term of the copyright to Wheaton’s first volume, had attended to the statutory formalities concerning that volume. Complainants’ Evidence, *viz.*, Evidence of Henry C. Carey, *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), *microformed on Record*, *supra* note 86, at 23, 23–24. With respect to succeeding volumes, Wheaton himself had exercised considerable care to assure proper delivery of the eighty copies required to obtain payment of his salary. Complainants’ Evidence, *viz.*, Deposition of Daniel Brent, *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), *microformed on Record*, *supra* note 86, at 40, 40–42; Complainants’ Evidence, *viz.*, Certificates from Department of State of the deposit of 80 copies of each vol., *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591 (1834), *microformed on Record*, *supra* note 86, at 42, 42–48. None of the available evidence, however, suggests that Wheaton ever sought to insure a separate deposit of one copy of each of his volumes (making a total of eighty-one) for the purpose of securing his copyrights.

166. Wheaton’s Pre-Argument Memorandum B, *supra* note 149.

On the issue of a possible common law copyright subsisting apart from the right claimed under statute, Wheaton declined “to be drawn into the field of controversy whether the federal Courts have a common law jurisdiction, although it would be easy to show that they have.”<sup>167</sup> Instead, he considered it sufficient to “assume that the Acts of Congress were intended to secure my right of property existing independent of the Acts themselves.”<sup>168</sup> Being “remedial & protective” only, they should be given a “liberal construction.”<sup>169</sup> Thus, Wheaton considered himself entitled to an injunction to secure the enjoyment of “sacred rights,” whose origin (apart from statute) he was unwilling or unable to describe.<sup>170</sup>

Would such responses suffice to overturn Judge Hopkinson’s ruling in the court below?

### C. *The Arguments*

In the actual argument of the case on March 11–14, 1834, before Chief Justice Marshall and Justices Story, Duvall, McLean, Thompson, and Baldwin,<sup>171</sup> the propositions propounded in Wheaton’s memoranda metamorphosed significantly in the hands of Webster and Paine. Paine assumed, without really arguing, that proper notice of Wheaton’s copyright claims had been given in the press and asserted, without really proving, that in actuality eighty-one copies of the *Reports* (not simply the eighty copies required to obtain the Reporter’s salary) had been transmitted annually to the Department of State.<sup>172</sup> Wheaton was thus within the letter of the law, and most certainly within its spirit. The statutes at issue must not be construed in such a way as to impair an author’s right of property in copies of his work by loading down that right “with burthensome and needless regulations,” making the preservation of the right “wholly dependent on

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167. *Id.*

168. *Id.*

169. *Id.*

170. *Id.*

171. “Mr[.] Justice Johnson was absent, from indisposition, during the whole term.” 33 U.S. (8 Pet.) iii n.(a) (1834).

172. “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 . . . .” *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 612 (1834).

accidental mistake or omission.”<sup>173</sup> For the Framers of the Constitution had “adopted it with a particular view to preserve the common law right to copyrights untouched.”<sup>174</sup>

Unlike Wheaton, however, Paine located the origin of an author’s “acknowledged pre-existing right”<sup>175</sup> to profits derived from the multiplication of his work not in federal common law, but in the common law of Pennsylvania. Merely by adopting the Constitution, the states “ha[d] not surrendered to the union their whole power over copyrights, but [had] retain[ed] a power concurrent with the power of congress.”<sup>176</sup> For any violation of his common law right, Paine declared, an author might obtain “the ordinary remedies by an action on the case and bill in equity,”<sup>177</sup> either in state court or “in the circuit court of the United States . . . independently of the provisions of the act of congress.”<sup>178</sup> Thus, the federal copyright acts neither conferred the natural property right sued upon by Wheaton nor diminished in any way the ordinary remedies available to him to vindicate it. Instead, the Acts of 1790 and 1802 operated only to “secure” the author’s rights by adding to his remedies under state law the possibility of “penalties and forfeitures” to be enforced against infringing parties upon compliance by the author with the statutory formalities.<sup>179</sup> Wheaton had sought no such penalty or forfeiture.<sup>180</sup> Hence, any noncompliance with the Acts, even if conceded, could hardly deprive him of his right to obtain justice in the federal courts.

Paine reserved his greatest ingenuity, however, for the coda to his argument. Of the four supposed objects of Peters’s piracy,<sup>181</sup> only one really mattered. Unless Wheaton had somehow obtained copyrights in the manuscript opinions of the Justices in every significant decision handed down during his tenure as Reporter, the *Condensed Reports* had infringed no interest of any real value in the marketplace. Paine thought

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173. *Id.* at 605–06.

174. *Id.* at 601.

175. *Id.*

176. *Id.* at 597–98.

177. *Id.* at 607.

178. *Id.* at 606.

179. *Id.* at 609–10.

180. *Id.* at 610.

181. “[F]irst, . . . the abstracts made by Mr[.] Wheaton; secondly, . . . the statements of the cases . . . ; thirdly, . . . points and authorities, and, in some instances, the arguments, and in all cases oral opinions . . . ; [and] fourthly, . . . the whole of the [written] opinions” prepared by the Justices. *Id.* at 617.

the matter transcendently clear. Wheaton had acquired a copyrightable interest in all such opinions, he averred, “by judges’ gift”.<sup>182</sup>

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. . . .

The copy[right] 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 the public claim to the manuscript? The reporter’s duty is to write or take down the opinions. If

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182. *Id.* at 614–15. Peters seems to have anticipated, and in some measure feared, this argument, at least in the period following the publication of his first volumes of *Condensed Reports* and prior to the filing of Wheaton’s action. Unable to know in advance the disposition of the issues that would be decided finally by the Court in 1834, he hedged his bets regarding what he supposed to be the nonprotectibility of the Justices’ opinions. Writing to Justice McLean in early 1830, Peters observed that the *Condensed Reports* had excited among booksellers holding unsold copies of his predecessors’ volumes “no small degree of hostility,” which he apprehended might lead to “an attempt to *injure*” his own *Reports*. Letter from Richard Peters, Jr. to John McLean (May 24, 1830), in *Miscellaneous Papers* (on file with the New York State Library, Albany, N.Y.). Therefore, Peters wrote, “as I am under some doubt whether by the mere circumstance of my being *Reporter* I obtain a *property in the opinions* of the Court I have thought it a measure of prudence to obtain from each member of the Court a special assignment [of] the right to each opinion delivered by him.” *Id.* McLean, author of the Court’s opinion in *Wheaton v. Peters* four years later, responded with notable care:

A faithful report of the decisions of the Supreme Court of the United States, is of great importance to the public, & I should exceedingly regret, any interference with your rights as Reporter. *So far as I have any right in the opinions delivered by me*, at the late session of the Court, I hereby, freely and fully, transfer it to you.

Letter from John McLean to Richard Peters, Jr. (June 3, 1830), in *Peters Papers*, *supra* note 76 (emphasis added). Other members of the Court exercised similar caution. *E.g.*, Letter from Joseph Story to Richard Peters, Jr. (June 1, 1830), in *Peters Papers*, *supra* note 76 (assigning the copyright in his opinions “in as ample a manner as I now hold the same,” while reserving the right of Congress to authorize future publications by others); Letter from Henry Baldwin to Richard Peters, Jr. (June 8, 1830), in *Peters Papers*, *supra* note 76 (same). The prickly William Johnson, however, rejected Peters’s request *in toto*, on grounds that “our Opinions I have never doubted were public Property & not assignable by us.” Letter from William Johnson to Richard Peters, Jr. (June 5, 1830), in *Peters Papers*, *supra* note 76.

the court choose to aid him by giving him theirs, can any one complain?<sup>183</sup>

All this the Court had known in appointing Wheaton its Reporter and furnishing him the Justices’ opinions. Reporters had always been assumed to acquire copyrightable interests in this, the single most valuable component of their works.<sup>184</sup> To rule otherwise now would be to deprive not only Wheaton, but all other Reporters as well, of their familiar rights.<sup>185</sup> Such a result, as Paine foresaw clearly, would alter fundamentally the entrepreneurial underpinnings of court reporting throughout the country.

J.R. Ingersoll and Thomas Sergeant, on behalf of Peters, contradicted Paine’s argument on every point. Each recognized, however, that Wheaton’s case would stand or fall according to the Court’s disposition of Paine’s claim that the opinions of the Justices constituted copyrightable matter, the rights to which they had transferred to the Reporter. Said Sergeant,

The court appointed [Wheaton] 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.<sup>186</sup>

Ingersoll put the matter on an even higher plane, according equal dignity and an equal necessity of diffusion to enactments of Congress and decisions of the Court:

Reports are the means by which judicial determinations are disseminated, or rather they constitute the very dissemination itself. . . . The matter which they disseminate is, without a figure, the *law of the land*. Not indeed the actual productions of the legislature. Those are the rules which govern the action of the citizen. But 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

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183. *Wheaton*, 33 U.S. (8 Pet.) at 615.

184. *See id.* at 617 (“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.”).

185. *See id.* at 616–17 (imploing the Court to refrain from denying Reporters the copyrights they had long assumed to be inviolate under the law).

186. *Id.* at 638.

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. . . . 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.<sup>187</sup>

Webster's speech to the Court, concluding the arguments, briefly engaged the doctrinal points discussed by other counsel but sought primarily to reduce the case to its essential human dimension. There had come a point late in the Reportership of Wheaton's predecessor, Webster said, when the very continuance of the *Reports* had hung in the balance.<sup>188</sup> But for Wheaton's appearance on the scene, with the promise of "a regular annual publication of the decisions" of the Court, there might have been no dissemination whatsoever of future reports.<sup>189</sup> In order to supplement his income for the copyright to his *Reports*, "[i]t was found necessary that there should be some patronage from the legislature,"<sup>190</sup> that is, a salary for the Reporter. The Reporter's Act had been regularly renewed, and "[t]he successor of Mr[.] Wheaton has had the full benefit of the grant obtained by the personal exertions of Mr[.] Wheaton."<sup>191</sup> Lately, although "well advised" of Wheaton's rights, Peters had "materially injured" those interests by publication of the *Condensed Reports*.<sup>192</sup> In short, he had made "an indefensible use of [his predecessor's] labours," which the Court must now remedy by construing Wheaton's rights "liberally."<sup>193</sup>

#### D. *The Decision (and the Opinions)*

The reluctance of the Court in deciding so bitter a controversy between two of its own officers, past and present,

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187. *Id.* at 619–20.

188. *Id.* at 651.

189. *Id.*

190. *Id.*

191. *Id.*

192. *Id.*

193. *Id.* at 651–52.

with whom the Justices had lived and worked on intimate terms, can be imagined readily. That discomfort is reflected vividly in a series of extraordinary occurrences preceding and accompanying the announcement of the decision itself.

On the morning of March 18, 1834, Justice Story, acting in what the messenger assured Wheaton were the Justice's own words, "entirely on his own hook," summoned the Court's past and present Reporters to meet with him personally, in succession, in his chambers.<sup>194</sup> Upon arriving, Wheaton was greeted by Story "in his usual cordial manner" and handed a memorandum that Story had been "authorized by the Court to communicate to [each of the litigants]."<sup>195</sup> The memorandum, which Story likewise furnished to Peters, advised the parties that the decision of the Court, if handed down, would hold unanimously that no right of property did or could exist in the Justices' opinions and that they were without power to confer upon the Court's Reporters any copyright thereto.<sup>196</sup> Respecting the marginal notes and indices prepared by Wheaton, however, the Court had touched upon but not finally determined the litigants' rights, believing that matter to be "a fit subject for honourable compromise between the parties."<sup>197</sup>

Wheaton reacted angrily. Three weeks earlier, Peters had rejected his offer that "the whole Cause" be referred to arbitrators.<sup>198</sup> Story suggested that Wheaton might be operating under a supposition regarding the remaining issues in the case "that [his] rights were more extensive than they might turn out to be."<sup>199</sup> Wheaton then asked for and received leave to confer with Webster, who "unhesitatingly advised" him to reject the suggested compromise.<sup>200</sup> Wheaton's formal reply to the Court

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194. Wheaton's Post-Argument Memorandum (Mar. 18, 1834), *in* Wheaton Papers, *supra* note 2; Letter from Joseph Story to Henry Wheaton (Mar. 17, 1834), *in* Wheaton Papers, *supra* note 2.

195. Wheaton's Post-Argument Memorandum, *supra* note 194. Apparently, Story's particular contribution to the Court's design to force a resolution of the controversy short of final decision was his plan to broker the compromise personally in meetings with the parties.

196. Story's Post-Argument Memorandum, *in* Wheaton Papers, *supra* note 2. An undated copy of this memorandum was furnished by Story to Wheaton with a letter on March 25, 1834.

197. *Id.* The memorandum noted, however, that Justice Baldwin "decline[d] any expression of his views as to the suggestion" that the question be referred "to Gentlemen of the Bar or otherwise as a matter of equity & honour." *Id.*; *see also* Wheaton's Post-Argument Memorandum, *supra* note 194.

198. Wheaton's Post-Argument Memorandum, *supra* note 194.

199. *Id.*

200. *Id.*

after consultation with Webster, while restrained in tone, firmly insisted that “the merits of the Cause so fully & ably discussed” now be finally resolved.<sup>201</sup> Left with no choice, the Court proceeded to do as Wheaton had demanded at its conference later in the same day.

The necessity of resolving the difficult and highly charged issues presented by the case brought to a head many stresses already present among the Justices. The death of Bushrod Washington five years before, as Peters then observed to Story, had destroyed “[t]he triple column [of Marshall, Story, and Washington] on which the Court ha[d] rested for many years in balance.”<sup>202</sup> In the White House sat a President hostile to many of the doctrines theretofore promulgated by the Court, now busily installing new men in the old Justices’ places.<sup>203</sup> By 1832, Story lamented to Peters that the “dignity, character, & courtesy” of the Court had declined noticeably.<sup>204</sup>

Moreover, several members of the Court had begun to fall seriously ill. Chief Justice Marshall, appointed to the Court in 1801, suffered periodic bouts of infirmity.<sup>205</sup> William Johnson, appointed in 1804 and suffering from “severe and continued indisposition,” was unable to sit at all during the 1832 and 1834 Terms.<sup>206</sup> Gabriel Duvall, an 1811 appointee, by the 1830s was “sickly and deaf” and “something of an embarrassment to the Court.”<sup>207</sup> Henry Baldwin, although the Court’s most recent appointee in 1830, besides having most inconveniently absented himself from *Wheaton*’s final hearing in the Circuit Court, “grew increasingly eccentric and, on occasion, violent.”<sup>208</sup> Indeed, by the

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201. Letter from Henry Wheaton to the Supreme Court of the United States (Mar. 18, 1834), in *Wheaton Papers*, *supra* note 2. Wheaton’s reply also specifically noted his claims, which he supposed the Court had “omitted by accident to mention,” to his abstracts and statements of the facts and cases. *Id.*

202. Letter from Richard Peters, Jr. to Joseph Story (Nov. 26, 1829), *supra* note 118.

203. Interestingly, Andrew Jackson’s first two appointees, McLean (1829) and Baldwin (1830), split in *Wheaton v. Peters*, McLean writing for the majority (with Marshall, Story, and Duvall, holdovers from the Court’s “glory days”) and Baldwin dissenting (along with Thompson, a Monroe appointee).

204. Letter from Joseph Story to Richard Peters, Jr. (Mar. 31, 1832), in *Peters Papers*, *supra* note 76.

205. Compare Letter from Richard Peters, Jr. to Joseph Story (Sept. 29, 1831), in *Story Papers*, *supra* note 118 (describing the Chief Justice as “exceedingly emaciated” and in Philadelphia to see Dr. Physick and stating that his illness “is said to be fatal”), with Letter from Richard Peters, Jr. to Joseph Story (Dec. 5, 1831), in *Story Papers*, *supra* note 118 (referring to Marshall as “a well man!”).

206. 31 U.S. (6 Pet.) iii n.(a) (1832); 33 U.S. (8 Pet.) iii n.(a) (1834).

207. Richard E. Ellis, *Duvall, Gabriel*, in *THE OXFORD COMPANION TO THE SUPREME COURT OF THE UNITED STATES* 240, 241 (Kermit L. Hall ed., 1992).

208. Robert G. Seddig, *Baldwin, Henry*, in *THE OXFORD COMPANION TO THE SUPREME*

1834 Term, the Court, in some instances, could no longer muster the votes necessary to decide even major constitutional cases.<sup>209</sup>

The atmosphere at the Justices' conference late on March 18 no doubt was made more painful by the reopening of old wounds inflicted in prior discussions of the case at hand. In recounting the conference to Wheaton on the day following the Court's announcement of its decision,<sup>210</sup> Baldwin recalled that Story had accused him, at an earlier date, “of having granted an Injunction [on circuit] to prevent the publication of the Decisions of the Court.”<sup>211</sup> Perhaps to reduce the likelihood of such exchanges recurring, the conference decided without discussion (and adversely to the complainants) the question of Wheaton's supposed copyright under federal or state common law. On the statutory issues (also decided against Wheaton and Donaldson), discussion was allowed but kept so brief that the Justices left the conference unclear—as they would discover the next morning—precisely what the majority had concluded regarding the requisite formalities. Finally, while all of the conferees departed with an understanding that the matter must be remanded to the Circuit Court for further evidentiary proceedings, the majority was unwilling or unable to instruct Baldwin, who, with Hopkinson, would have to preside over the trial, concerning matters of law certain to arise there.<sup>212</sup>

Confusion at the conference presaged disaster on the day of decision. Just how deeply the matter had divided the Court became startlingly clear on the morning of March 19, 1834, when

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COURT OF THE UNITED STATES, *supra* note 207, at 59, 60. Baldwin missed the Supreme Court's entire 1833 Term and a portion of the 1834 Term as well, but not the Court's decision in *Wheaton*. 32 U.S. (7 Pet.) iii n.(a) (1833); *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 698 (1834) (Baldwin, J., dissenting).

209. See Peter G. Fish, *Disability of Justices*, in *THE OXFORD COMPANION TO THE SUPREME COURT OF THE UNITED STATES*, *supra* note 207, at 227, 227. In the consolidated cases of *Briscoe v. Commonwealth Bank* and *Mayor of New York v. Miln*, Marshall announced “[t]he practice of this court is not (except in cases of absolute necessity) to deliver any judgment in cases where constitutional questions are involved, unless four judges concur in opinion, thus making the decision that of a majority of the whole court.” Therefore, in the absence of Johnson and Duvall from the bench, Marshall directed that *Briscoe* and *Miln* “be reargued the next term.” 33 U.S. (8 Pet.) 118, 122 (1834).

210. All information in this paragraph, unless otherwise stated, is taken generally from Wheaton's Post-Decision Memorandum (Mar. 20, 1834), in *Wheaton Papers*, *supra* note 2.

211. Story's attitude toward the case may be conjectured further from his remark to Peters that he had been “surpri[s]ed at the appeal.” Letter from Joseph Story to Richard Peters, Jr. (Nov. 13, 1833), in *Peters Papers*, *supra* note 76.

212. In particular, Baldwin sought direction regarding how to instruct the jury with respect to the effect of lapse of time on Wheaton's assertions of actual, albeit unprovable, compliance with the statutory formalities.

the Justices convened to announce their opinions.<sup>213</sup> Story, the member of the Court previously closest to the two main litigants, missed the melee altogether. He had departed Washington on the 8:00 a.m. stage, leaving Justice McLean, in Wheaton's words, "to fire off the blunderbuss [Story] had loaded, but had not courage to discharge."<sup>214</sup>

The unfortunate McLean, on behalf of himself, Marshall, Story, and Duvall, began by reading the opinion of the Court.<sup>215</sup> It denied any claim by the complainants to copyright at common law, leaving their rights in published works—at least with respect to matter other than the opinions of the Justices—entirely dependent upon compliance with the 1790 and 1802 Acts of Congress.<sup>216</sup> While remanding for certain factual determinations on that question, the opinion also reflected considerable doubt (and apparently straddled considerable internal confusion within the majority) concerning which of the statutory formalities had to be, and might have been, satisfied.<sup>217</sup> Wheaton appeared "strongly excited during its reading," while Peters was "anxious but perfectly calm."<sup>218</sup> Immediately upon McLean's conclusion, Thompson delivered the "purport" of his own opinion—which, in a tradition dating back to the Court's first sessions forty years before, he had not yet written out in full but which adopted the main points of Paine and Webster's

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213. The information in the next three paragraphs is generally taken from Charles Sumner's account to Story, written in the courtroom itself on March 19, 1834 immediately after the incidents he describes. Letter from Charles Sumner to Joseph Story (Mar. 19, 1834), in *Story Papers* (on file with the Library of Congress, Washington, D.C.). Sumner also wrote a supplementary letter to Story on the same subject, dated March 20, 1834. See *infra* notes 227–37 and accompanying text.

214. Letter from Henry Wheaton to Catherine Wheaton (Mar. 21, 1834), in *Wheaton Papers*, *supra* note 2. Story would later confide to his friend Chancellor Kent of New York:

I am sorry for the controversy . . . [and] wish Congress would make some additional provisions on the subject, to protect authors, of whom I think no one more meritorious than Mr. Wheaton. You, as a Judge, have frequently had occasion to know how many bitter cups we are not at liberty to pass by.

Letter from Joseph Story to James Kent (May 17, 1834), *reprinted in* 2 *LIFE AND LETTERS OF JOSEPH STORY* 181, 182 (William W. Story ed., 1851).

215. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 654–68 (1834). The scene that followed no doubt owed its origin in part to the Court's failure during this period to circulate opinions among the Justices prior to reading them in the courtroom. For a description of contemporary practices in this regard, see *WHITE*, *supra* note 97, at 181–82. The problem may have been compounded by the breathtaking speed with which the Court routinely handed down its decisions. *Id.* at 181.

216. *Wheaton*, 33 U.S. (8 Pet.) at 660–62.

217. *Id.* at 662–67 (examining the statutory provisions and their relative importance).

218. Letter from Charles Sumner to Joseph Story (Mar. 19, 1834), *supra* note 213.

argument—“with much feeling.”<sup>219</sup> On the question of common law copyright, Thompson would have recognized Wheaton and Donaldson’s claims under the law of Pennsylvania;<sup>220</sup> with respect to protection under the applicable federal statutes, he asserted that “the Ct. were *equally* divided, so far as the operation of the St[atute] of 1802 went.”<sup>221</sup> Baldwin followed,<sup>222</sup> agreeing with Thompson on the statutory question and also dissenting “from another point of the opinion of the Ct.—viz. that the U. States *qua* U.S. had no common law” under which Wheaton might claim copyright.<sup>223</sup>

McLean then attempted an explanation of the Court’s holding on the statutory issues, claiming that his analysis “was based on the St[atute] of 1790” and that the matter “was all clearly stated in the opinion he had read.”<sup>224</sup> Thompson, “with intemperate warmth,” replied that “if [the analysis] had been clearly stated there w[ould] have been no need [for] explanation.”<sup>225</sup> At this juncture, Marshall “made a statement of the opinion of the Ct. on the debated point [that is, statutory construction] which was listened to with gr[ea]t attention.”<sup>226</sup> McLean, “with mingled pride & feeling checked by the proprieties of the place,”<sup>227</sup> at once “read the very words of the opinion & added that *this dialogue across from one to another* was very unpleasant.”<sup>228</sup> Thompson rejoined “in a perfect boil,”<sup>229</sup> while Baldwin, “by looks & motions & whispers,”<sup>230</sup> evidenced a “strong

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219. *Id.*

220. *Wheaton*, 33 U.S. (8 Pet.) at 687 (Thompson, J., dissenting).

221. Letter from Charles Sumner to Joseph Story (Mar. 19, 1834), *supra* note 213. In William Johnson’s absence from the bench, there were only six members of the Court sitting. Thompson did not disclose which majority Justice he believed disagreed with McLean on the point at issue. In any event, an equally divided vote would have resulted in affirming Hopkinson’s decision that the 1802 Act made the performance of all four of the statutory requirements mandatory.

222. *Id.* Baldwin apparently delivered a copy of his lengthy dissent to Peters too late for inclusion in the first edition of the *Reports* for the 1834 Term, thereby necessitating the unusual pagination of the opinion in later editions. The three opinions in the case are discussed at length, with helpful background concerning the doctrinal development of copyright law in America, in chapters 9 and 10 of PATTERSON, *supra* note 13.

223. Letter from Charles Sumner to Joseph Story (Mar. 19, 1834), *supra* note 213.

224. *Id.*

225. *Id.*

226. *Id.*

227. Letter from Charles Sumner to Joseph Story (Mar. 20, 1834), *in* Story Papers, *supra* note 213.

228. Letter from Charles Sumner to Joseph Story (Mar. 19, 1834), *supra* note 213.

229. Letter from Charles Sumner to Joseph Story (Mar. 20, 1834), *supra* note 227.

230. Letter from Charles Sumner to Joseph Story (Mar. 19, 1834), *supra* note 213.

passion at his back.”<sup>231</sup> The Chief Justice “then s[ai]d that unless he had thought that the opinion as read needed explanation, he sh[ould] not have made it.”<sup>232</sup> Looking “like the good man whom Virgil has described as able to still the tumult of a crowd, by his very appearance,”<sup>233</sup> Marshall then “stated in full” the holding of the majority on the point of statutory construction.<sup>234</sup> Through it all, Duvall sat “in utter unconsciousness of the strife around him,” thereby “add[ing] to the grotesqueness of the scene,” while “a large number of the bar” looked on “in anxiety & grief.”<sup>235</sup>

At length, calm prevailed, and the Justices concluded their business for the Term. Word of the unusual “altercation” in Court quickly spread to “*all Congress*,” where it was “magnified . . . ten times over.”<sup>236</sup> The profession at large, however, was not to be similarly titillated. Before quitting Washington late the same afternoon, Marshall admonished Peters that he “did not wish [him] to make any mention of the *differences* in his report of the case.”<sup>237</sup> Peters did as bidden.

Apart from the colorful events of the day, what, exactly, had the Court ruled? It is difficult, exactly, to say. The opinions in *Wheaton* are, to put the matter in modern terminology, a mess. Neither of the Court’s leading Justices, Marshall or Story, wrote a word (nor should that fact surprise, given their prior relationships with the Reporters). McLean’s opinion for the majority, and Thompson’s dissent, ramble, reflecting powerfully what McLean described as “[t]he limited time allowed for . . . preparation”<sup>238</sup>—five days following the close of argument! Baldwin’s own ponderous dissent, apparently prepared after the event,<sup>239</sup> received no comment in the two opinions contemporaneously filed and remains almost unknown, even to scholars, today.<sup>240</sup> None of the opinions, of course, had the benefit of bright young law clerks to assist the Justices or of modern word-processing to tighten and clarify content and expression.

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231. Letter from Charles Sumner to Joseph Story (Mar. 20, 1834), *supra* note 227.

232. Letter from Charles Sumner to Joseph Story (Mar. 19, 1834), *supra* note 213.

233. Letter from Charles Sumner to Joseph Story (Mar. 20, 1834), *supra* note 227.

234. Letter from Charles Sumner to Joseph Story (Mar. 19, 1834), *supra* note 213.

235. Letter from Charles Sumner to Joseph Story (Mar. 20, 1834), *supra* note 227.

236. *Id.*

237. *Id.*

238. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 654 (1834).

239. See *supra* note 222 (explaining the circumstances surrounding Baldwin’s dissent).

240. Quite apart from its omission from *U.S. Reports*, Baldwin’s opinion currently is unavailable in online databases such as Lexis or Westlaw.

On the question of an *author's right at common law*, the opposing philosophies do, indeed, receive clear statement. For McLean and the majority, Wheaton's claim to a copyright at common law, of unlimited duration, raised the specter of a monopoly on printed works that was inimical to the public interest:

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 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.<sup>241</sup>

Thus, while an author no doubt "is as much entitled to the product of his labour as any other member of society, . . . he realises this product by the transfer of his manuscripts, or in the sale of his works, when first published."<sup>242</sup> Thereafter, no copyright monopoly can exist beyond the limits of statutory law as enacted by Congress.

The dissenters, on the other hand, saw no objection to a claim of perpetual copyright on printed matter. As Thompson's opinion asserted,

The great principle on which the author's right rests, is, that it is the fruit or production of his own labour, and which may, by the labour of the faculties of the mind, establish a right of property, as well as by the faculties of the body; and it is 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.<sup>243</sup>

Therefore, "[i]f there be a common-law right," as Thompson deemed certain, "there certainly must be a common-law remedy" underlying the merely "cumulative security or protection" afforded statutorily by Congress.<sup>244</sup> For Thompson and for

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241. *Wheaton*, 33 U.S. (8 Pet.) at 657.

242. *Id.*

243. *Id.* at 669–70 (Thompson, J., dissenting).

244. *Id.* at 692, 696 (Thompson, J., dissenting). The late L. Ray Patterson of the University of Georgia, author of *Copyright in Historical Perspective* and leading copyright historian of our era, once observed,

The striking point about the premises of the majority and the dissenters is that they are polar, one proceeding from the interest of the public, the other from the interest of the individual creator. . . . [T]heir premises brought the justices to different conclusions as to how best to resolve the conflict between the public's interest in learning and the author's interest in his property. The majority,

Baldwin, because the author's fundamental right rested upon his creative act rather than any grant by Congress, no limitation on term applied.

While the philosophical distinction between the majority and the dissenters on the issue of author's rights was sharp, the "remembered holding" of *Wheaton* as a wholesale rejection of that principle with respect to published works overstates the clarity of the detailed analysis provided in the remainder of the opinions. The dissenters, Thompson and Baldwin, would have recognized such a right in favor of the complainants, although on different bases: Thompson, under the common law of Pennsylvania; Baldwin, under federal common law. McLean for the majority, however, recognized neither in the case at bar. The applicable state law, if any, was the law of the state in which the complainants' bill in equity had been filed. But no common law right of the sort claimed "ha[d] [t]heretofore been asserted," or by "custom or usage established," or by "judicial decision . . . given" in Pennsylvania.<sup>245</sup> Nor could such a right be recognized federally because there was "no common law of the United States."<sup>246</sup> The Copyright Act of 1790, "instead of sanctioning an existing right, . . . [had] created it."<sup>247</sup>

McLean's analysis of Pennsylvania law is a classic bootstrap argument. A natural right in favor of an entire class of persons would not cease to exist, always and everywhere, simply because no person had yet asserted the right in a Pennsylvania courtroom. Likewise, McLean's federal common law analysis is, at best, suspect. It seems doubtful that in 1834 either Story—who eight years later recognized federal common law in *Swift v. Tyson*<sup>248</sup>—or Marshall would have denied unequivocally the existence of such law. Nor is McLean's reading of the language of the 1790 Act compelling. Congress could well have "secure[d]" existing rights (a clearly plausible meaning to attribute to that term in both the Constitution and the Act) at the same time as it created new ones.

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viewing copyright as a monopoly, were content to protect the author's property for a limited period under the conditions prescribed by the statute. To do otherwise would be contrary to the public interest. The dissenters, on the other hand, seemed to think that the best way to protect the public interest would be to give unlimited protection to the author's property.

PATTERSON, *supra* note 13, at 211.

245. *Wheaton*, 33 U.S. (8 Pet.) at 659.

246. *Id.* at 658.

247. *Id.* at 661.

248. 41 U.S. (16 Pet.) 1, 9 (1842) (regarding a bill of lading).

No matter, practically speaking. On the question of common law rights, the complainants in *Wheaton* had lost 4–2. Once an author has published a work, the right must exist, if at all, by virtue of compliance with applicable statutory law.

The vote count respecting the proper application of the *statutory formalities* is less clear. McLean’s own view concerning the mandatory character of such formalities as a prerequisite to copyright protection<sup>249</sup> was “principally founded” on his reading of the 1790 Act. But “if doubts could be entertained”—McLean did not say by whom, although presumably their number did not include others in the majority—whether that enactment’s requirements of notice and State Department deposit “were essential to the title,” there was, “in the opinion of three of the judges”—apparently not including McLean himself—“no ground for doubt” with respect to the mandatory character of the newspaper publication commanded by the 1802 Act, in its own terms, “in addition to the requisitions enjoined” by the 1790 Act.<sup>250</sup>

Thompson was astonished. McLean’s construction of the 1790 Act itself “c[ould] not be sustained” under any rule of statutory interpretation; and “as to the effect of the act of 1802 upon the act of 1790, the court is *equally* divided.”<sup>251</sup> “Upon the whole,” he declared, and “in whatever light this case is viewed,”<sup>252</sup> the judgment below should be reversed. Baldwin, believing the congressional acts to be “merely directory, explanatory, or constructive”<sup>253</sup> in support of *Wheaton*’s preexisting common law copyright, concluded that *Wheaton* and *Donaldson*, while unable (absent further proof at trial) to avail themselves of any legal benefits added by statute, nonetheless were entitled to all remedies afforded them by equity, including injunctive relief and an accounting.<sup>254</sup>

Again, no matter. A bare majority of the Court seemingly had held the 1790 Act’s (and only the 1790 Act’s) formality requirements to be mandatory.<sup>255</sup> “The construction of the acts of

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249. “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.” *Wheaton*, 33 U.S. (8 Pet.) at 663–64.

250. *Id.* at 665 (emphasis added) (quoting the 1790 Act).

251. *Id.* at 694 (Thompson, J., dissenting) (emphasis added).

252. *Id.* at 698 (Thompson, J., dissenting).

253. *Id.* at 698*aa* (Baldwin, J., dissenting) (F. Brightly ed., 1883).

254. *Id.* at 698*bb* (Baldwin, J., dissenting) (F. Brightly ed., 1883).

255. The contretemps on the bench on the day of decision, and even Marshall’s

congress being settled,” wrote McLean, “in the further investigation of the case it would become necessary to look into the evidence” to ascertain whether Wheaton and Donaldson had shown “a substantial compliance with every legal requisite.”<sup>256</sup> The judgment and decree of the Circuit Court, accordingly, were reversed and remanded, subject to a mandate to try the case on those issues.<sup>257</sup> Only if the complainants could demonstrate their compliance with the statutory formalities at trial would they establish any rights as to Wheaton’s *Reports*.

With respect to what aspects of the *Reports*, however? McLean, for the majority, did not say. Nor did Thompson. Only Baldwin, in the single opinion in the case most favorable to the complainants, was explicit. Wheaton’s marginal notes, and the like, “are as much literary property as any productions of the mind,” he observed, and capable of protection under Wheaton’s copyrights, if any.<sup>258</sup> But “[t]he opinions of the court are clearly not so.”<sup>259</sup>

And there lay the rub. As Peters’s *Condensed Reports* by their very nature attested, the entire commercial value of Wheaton’s volumes resided in *owning the opinions*,<sup>260</sup> whatever other rights he might possess in such peripheral matter as syllabi of cases or scholarly annotations. Whether anything regarding the latter remained to be tried below, and whether the principles involved meant enough to Wheaton to pursue them,<sup>261</sup>

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explanation that day of the Court’s holding on the debated point of statutory construction, seem not to have settled the matter sufficiently for McLean to reduce it clearly to writing. Thompson could only sputter in dissent, “[S]uch I understand to be the opinion of a majority of this court, . . . that . . . the decision of the cause rests upon the act of 1790.” *Id.* at 694 (Thompson, J., dissenting). Dissenting from Thompson’s dissent, however, the relevant volume of the *Holmes Devise* declares, “On the mandatory nature . . . of the 1790 Act’s provisions . . . [McLean] did not have a majority . . .” WHITE, *supra* note 97, at 421.

256. *Wheaton*, 33 U.S. (8 Pet.) at 667.

257. *Id.* at 698 (Thompson, J., dissenting).

258. *Id.* at 698g (Baldwin, J., dissenting) (F. Brightly ed., 1883).

259. *Id.* (Baldwin, J., dissenting) (F. Brightly ed., 1883).

260. In *Gray v. Russell*, 10 F. Cas. 1035, 1039 (C.C.D. Mass. 1839) (No. 5728), Justice Story observed, “In the case of *Wheaton v. Peters*, . . . [i]t was not doubted by the court that Mr. Peters’ *Condensed Reports* would have been an infringement of Mr. Wheaton’s copyright, (supposing that copyright properly secured under the act,) if the opinions of the court had been, or could be, the proper subject of the private copyright by Mr. Wheaton.” *Id.*

261. Emotionally, if not financially, they did, to the respondents’ great dismay. The parties, at the time, regarded this disposition as a matter of considerable consequence. Peters sought vigorously—but unsuccessfully—to have the mandate amended and thereby avoid the inconvenience of a trial of the remaining factual questions, however trivial. *See, e.g.*, Letter from John Marshall to Richard Peters, Jr. (May 15, 1834), in Peters Papers, *supra* note 76 (one of several letters by various members of the Court rejecting Peters’s argument that the mandate did not accurately reflect McLean’s

the case was irretrievably lost when, in the concluding paragraph of his opinion, McLean announced,

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.<sup>262</sup>

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opinion). Wheaton returned to Denmark in June, *see* BAKER, *supra* note 85, at 132–33, but not before setting in progress through his Philadelphia attorneys the necessary work of gathering the evidence to be adduced at trial. *See, e.g.*, Letter from Charles Chauncey to Henry Wheaton (Apr. 11, 1834), *in* Wheaton Papers, *supra* note 2 (discussing the issues likely to be dealt with on appeal); Letter from John Cadwalader to Henry Wheaton (Apr. 24, 1834), *in* Wheaton Papers, *supra* note 2 (suggesting several issues that should be examined in preparation for appeal); Letter from Charles Chauncey to Henry Wheaton (Apr. 29, 1834), *in* Wheaton Papers, *supra* note 2 (notifying Wheaton of delay in setting date for remand hearing and suggesting the possibility of further evidentiary gathering); Letter from John Cadwalader to Henry Wheaton (June 10, 1834), *in* Wheaton Papers, *supra* note 2 (discussing the possibility of a compromise).

262. *Wheaton*, 33 U.S. (8 Pet.) at 668. In so holding, the Court, of course, broke from its own prior assumptions regarding the ownership of judicial opinions. *See supra* text accompanying notes 156–58. It appears also to have departed from the contemporary English understanding concerning such ownership. *See, e.g.*, *Butterworth v. Robinson*, 31 Eng. Rep. 817 (Ch. 1801) (assuming copyright in reports in action for injunction); *Saunders v. Smith*, 40 Eng. Rep. 1100 (Ch. 1838) (same); *Sweet v. Benning*, 139 Eng. Rep. 838 (Ex. Ch. 1855) (holding, in a case involving the piracy of abstracts of cases from the plaintiffs’ “weekly paper called ‘The Jurist,’ . . . consist[ing] principally of reports of decisions in the various superior courts of law and equity,” that the reports were copyrighted and, in the absence of a fair abridgment, had been infringed). Clearly, insofar as such cases reflect a view that *actual opinions of judges* as contained in reports of decisions are capable of protection, the *Wheaton* Court was of a different mind.

But why? Several explanations suggest themselves. First, the English cases seem to assume, as to the courts being reported, a predominance of oral opinions, with reporters assembling, from notes by gentlemen of the bar, approximations of the opinions actually delivered by the judges. Such practice, arguably, bespoke greater “authorship” by English reporters than occurred in the Supreme Court of the United States between 1816 and 1827. In earlier days, the Court had provided little written matter for the Reporters’ guidance in reconstructing oral opinions. During Wheaton’s tenure, however, written opinions prepared by the Justices themselves (albeit often after their announcement from the bench) had become more common practice and were furnished as a matter of course to the Reporter. *See supra* text accompanying notes 85–86. In addition, Wheaton’s personal attendance at the Court’s sessions produced reports markedly more faithful to the Justices’ own utterances and writings, *see supra* text accompanying notes 87–99, than in the days of Dallas and Cranch—reports, in short, much less subject to claims of “authorship” by the Reporter than were the volumes described in the nineteenth-century English cases cited above. For further comparative reflections on authorship and ownership in nineteenth-century law reports, *see* EATON S. DRONE, A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS IN GREAT BRITAIN AND THE UNITED STATES 159–63 (1879).

That said, the practical excellences of Henry Wheaton’s *Reports* can account only in part for the disparate treatment given law reports in nineteenth-century English and American courts. McLean’s opinion for a unanimous bench in *Wheaton* applied to *all* “written opinions delivered by this court,” *Wheaton*, 33 U.S. (8 Pet.) at 668, a rubric that embraced not only Wheaton’s volumes but also those of Dallas and Cranch, the “volunteers” who had preceded him, as well as his successor, Peters—and all the

On that point, there was no dispute by any Justice in any opinion.

In sum, on all the issues of law, Peters had triumphed. A tiny portion of the matter claimed by Wheaton as author might indeed be subject to copyright, protected by compliance with the applicable enactments of Congress, and infringed by Peters, pending further proof.<sup>263</sup> But the Court had made clear that copyright in the United States, at least respecting published works, was a creature of federal statute only. It had ruled that obedience to the formalities required by such statutes was a *sine qua non* of protection. And it had established, emphatically, that the opinions of the Court's members could not be owned by them or by any Reporter.

*Wheaton v. Peters* thus obliterated a presumption of intellectual property ownership long shared by Wheaton, his predecessors, and the Justices themselves that, if given the force of law, would have bestowed upon the Reporters exclusive title to those classic expressions of American law that constitute the Court's essential legacy to the nation. No doubt, Wheaton and Peters saw the matter in more narrow, immediate, and personal terms. The Court, however, saw further than they. In a case that saddened and pained the Justices themselves even as they rendered a decision indispensable to the progress of a national jurisprudence, the Court assured that henceforth American law should be owned by no one—and thus owned by all, for the benefit of all. In retrospect, in a nation dedicated to free speech,

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Reporters of Decisions to come.

Thus, one further explanation for the separate path taken by American courts, beginning with *Wheaton v. Peters*, suggests itself. Perhaps the true key to a fuller understanding of *Wheaton's* determination that law reports of decisions of the federal courts cannot be owned by anyone—not the judges, and not the reporters—lies in a recognition of the New Republic's comparatively robust commitment to free speech and press values and in an accompanying commitment (as yet more instinctive than doctrinal) to protecting and enhancing the public domain so as to provide ready access to the laws that governed its citizens' lives. For more on these matters, see text accompanying notes 292–98 *infra*; Patterson & Joyce, *supra* note 15, at 942–45, 949–50.

263. Who, however, would continue to buy copies of Wheaton's *Reports* with Peters's compendium of their truly valuable components—the opinions—available at a fraction of the cost? “Justice will never be done me,” Wheaton wrote. Had the Court not upheld Peters's duplicity in offering to the marketplace his *Condensed Reports* as a cheaper alternative to Wheaton's own, “I might have published new editions of each volume as the [copy]right successively expired, and should have been in the possession of a regular and annual income of at least 2,000 dollars from this source for many years to come. Such is the extent of the mischief done by the reckless partiality of prevaricating judges.” Letter from Henry Wheaton to Eliza Lyman (May 22, 1837), in *Wheaton Papers*, *supra* note 2, quoted in BAKER, *supra* note 85, at 130.

free press, and the widest possible dissemination and debate of facts and ideas, the outcome could not have been otherwise.<sup>264</sup>

[*Exeunt.*]

[CURTAIN. END OF ACT TWO.]

#### AFTER THE CURTAIN: THE LITIGATION AND THE PLAYERS

The decision in *Wheaton v. Peters* on March 19, 1834 (and subsequent issuance of the mandate) marked the end of the doctrinal drama in the case but not the end of the saga (or the proceedings) for the litigants themselves.

In terms of reporting at the Court, the Justices, stung by the results of lax prior practices concerning opinions, began to regularize their procedures. Already, on the last day of argument in *Wheaton*, they had adopted an order providing that upon publication of each volume of the *Reports*, the originals of such written opinions as had been prepared should be filed by the Reporter with the Clerk and preserved for posterity.<sup>265</sup> By a subsequent order, the Court required that opinions be first delivered to the Clerk for recording and then sent to the Reporter.<sup>266</sup> Under prior practice, physical copies of the opinions had been treated as the Reporters' personal property. Henceforth, both the copies of, and the law contained in, the Justices' opinions would be, unquestionably, public property.

As for the players in *Wheaton*, most of them returned to their normal duties, including the lawyers to their practices.<sup>267</sup>

On the Court, however, change was imminent. Chief Justice John Marshall had only a short time to live. Upon Marshall's death in 1835, Joseph Story wrote: “Great, good, and excellent man! . . . His gentleness, his affectionateness, his glorious virtues, his unblemished life, his exalted talents, leave him without a rival or a peer.”<sup>268</sup> Story himself, the self-described “last of the old race of Judges”<sup>269</sup> after Marshall's passing, would

264. See, e.g., Patterson & Joyce, *supra* note 15; *infra* text accompanying notes 293–98.

265. Rule No. 41, 33 U.S. (8 Pet.) vii (1834), reprinted in 42 U.S. (1 How.) xxxv (1843).

266. Rule No. 42 (1835), reprinted in 42 U.S. (1 How.) xxxv (1843).

267. For further information on the Supreme Court practices of Daniel Webster, William Pinkney, and others, see David C. Frederick, *Supreme Court Advocacy in the Early Nineteenth Century*, 30 J. SUP. CT. HIST. 1 (2005).

268. Letter from Joseph Story to Richard Peters, Jr. (June 19, 1835), reprinted in 2 LIFE AND LETTERS OF JOSEPH STORY, *supra* note 214, at 199, 199–200.

269. Letter from Joseph Story to Harriet Martineau (Apr. 7, 1837), reprinted in 2 LIFE AND LETTERS OF JOSEPH STORY, *supra* note 214, at 275, 277.

remain in harness for a decade until his own death in 1845, lamenting that his continuance on the bench in the midst of the younger Justices “accomplish[ed] no good, either for myself or for my country.”<sup>270</sup> Most of the rest of the *Wheaton* Court would be gone by then. Gabriel Duvall, the most infirm of the *Wheaton* Justices, resigned in 1835.<sup>271</sup> Smith Thompson, a transitional figure between the Marshall and Taney Courts, survived until 1843.<sup>272</sup> Henry Baldwin continued to aggravate fellow Justices through abrasive behavior until “[h]e died, penniless, of paralysis in 1844.”<sup>273</sup> John McLean proved the longest-lived of the *Wheaton* Justices, lasting to dissent in *Dred Scott v. Sandford* (1857) and then to receive mention as the Republican presidential candidate in the succeeding election. He died in 1861.<sup>274</sup>

Richard Peters, Jr. had the pleasure of memorializing *Wheaton v. Peters* in Volume 8 of his own *Reports*. For many in the bar, however, Peters’s efforts, particularly his garbled abstracts of the main points of cases, had always provided a benchmark for mediocrity.<sup>275</sup> In time, relations with the Court likewise became strained by perceptions of inaccuracy in the *Reports*.<sup>276</sup> The Court summarily dismissed Peters in 1843.<sup>277</sup>

Henry Wheaton returned to diplomatic service and to scholarship. Serving abroad under six presidents, he rose to U.S. minister plenipotentiary to Prussia and achieved membership in elite academic societies throughout Europe. In addition, his *Elements of International Law* (1836) earned him acclaim among contemporaries as the “chief modern expounder of the science of international law.”<sup>278</sup> The work passed through several editions in Wheaton’s lifetime, was translated into French, Italian, Spanish, Chinese, and Japanese, and, edited by others, remained influential

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270. Letter from Joseph Story to Ezekial Bacon (Apr. 12, 1845), reprinted in 2 LIFE AND LETTERS OF JOSEPH STORY, *supra* note 214, at 527, 528.

271. See Ellis, *supra* note 207, at 240–41.

272. Donald M. Roper, *Thompson, Smith*, in THE OXFORD COMPANION TO THE SUPREME COURT OF THE UNITED STATES, *supra* note 207, at 871, 871. Thompson is notable, if for no other reason, for having forced Marshall into his only constitutional dissent in *Ogden v. Saunders*, 25 U.S. (12 Wheat.) 213 (1827). *Id.*

273. See Seddig, *supra* note 208, at 60.

274. See Michael B. Dougan, *McLean, John*, in THE OXFORD COMPANION TO THE SUPREME COURT OF THE UNITED STATES, *supra* note 207, at 541, 542.

275. See *supra* note 108 and accompanying text (discussing critical reviews of Peters’s early volumes).

276. See COHEN & O’CONNOR, *supra* note 61, at 71–74.

277. See Craig Joyce, *Peters, Richard, Jr.*, in THE OXFORD COMPANION TO THE SUPREME COURT OF THE UNITED STATES, *supra* note 207, at 631, 631.

278. HICKS, *supra* note 120, at 215.

into the twentieth century.<sup>279</sup> A companion work, *History of the Law of Nations in Europe and America* (1845), helped cement his fame.<sup>280</sup>

The case itself, owing to the Court's remand, did not end for all purposes in 1834. The majority's disposition—although it had ruled for Peters on all key points of law—returned the matter to the Circuit Court for a trial by jury to determine whether, in fact, Wheaton had published proper newspaper notice of his claim and delivered the requisite copy of the work to the Secretary of State for each volume of his *Reports*.<sup>281</sup> The jury returned a verdict in Wheaton's favor in 1838.<sup>282</sup> The matter then dragged on interminably on its way back to the Supreme Court.<sup>283</sup> Before the appeal could be heard there, however, both of the principal protagonists died: Wheaton, on March 11, 1848, and Peters, less than two months later, on May 2, 1848. Ultimately, their estates settled the litigation, Peters's paying Wheaton's \$400, in 1850.<sup>284</sup>

#### THE REVIEWS: WHEATON AND ITS LEGACIES

In the end, *Wheaton v. Peters* is a "great case"<sup>285</sup> (indeed, the last great case decided by the Marshall Court) for none of the reasons usually associated with Marshall Court opinions. Its focus is not predominately constitutional, nor can it claim authorship by the Chief Justice himself or even by Justice Story. Rather, the "greatness" of the case lies in what it tells us about the Court itself—and in the critical doctrines of intellectual property law that it propounded or has come to represent.

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279. See John M. Raymond & Barbara J. Frischholz, *Lawyers Who Established International Law in the United States, 1776–1914*, 76 AM. J. INT'L L. 802, 818 (1982).

280. Although his fame today is less than theirs, Wheaton's place among the giants of nineteenth-century American law and diplomacy has received considerable note: "[I]n jurisprudence, Marshall and Kent and Story and Wheaton, by judicial opinion or by written text, laid the foundations of American public and private law . . ." 2 CAMBRIDGE HISTORY OF AMERICAN LITERATURE 71 (William Peterfield Trent et al. eds., 1918).

281. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 698–99 (1834) (Baldwin, J., dissenting).

282. Letter from John Cadwalader to Henry Wheaton (May 23, 1838), in *Wheaton Papers*, *supra* note 2 (explaining that the verdict was advisory only, however, to equity court).

283. The appeal in the case was finally perfected in 1846. Letter from John Cadwalader to William Lawrence (Sept. 24, 1846), in *Cadwalader Papers* (on file with the Historical Society of Pennsylvania, Philadelphia, Pa.). Lawrence was Wheaton's friend and future executor.

284. Letter from William Lawrence to Robert Wheaton (Feb. 18, 1850), in *Wheaton Papers*, *supra* note 2. Robert Wheaton was Henry Wheaton's son.

285. WHITE, *supra* note 97, at 421.

A. *Statutory Right v. Natural Law*

We know from the dissents in *Wheaton* that the question of the existence of common law copyright in *Wheaton's Reports* was decided negatively by a 4–2 vote. But from a reading of Justice McLean's opinion, the reasoning of the members of the majority appears to have been an unstable mix at best.

That said, U.S. law since *Wheaton* has proceeded on the assumption that copyright for published works arises only by virtue of federal statute and that authors (and their transferees) are accorded copyright for their works *only* instrumentally—that is, to encourage creativity in aid of the common welfare.<sup>286</sup> Congress, from time to time, does enact statutes creating new rights for authors under U.S. law.<sup>287</sup> But however just may be the case for such rights existing apart from statutory law, the reality in America is that today they do not exist until recognized in Title 17 of the *United States Code*.

B. *The Importance of Statutory Formalities*

While Justice McLean's own rendering of the vote count is no model of lucidity, he appears to have enjoyed a bare numerical majority in *Wheaton* for a reading that at least substantial compliance with the statutory formalities prescribed by applicable Acts of Congress (in the case at bar, the 1790 Act) was essential to perfecting title in copyrightable works.

Nonetheless, owing if nothing else to the posture of the matter as it had arrived at the Court, the case was remanded to the court below to determine whether the copyright claimants could demonstrate “a substantial compliance with every legal requisite.”<sup>288</sup> Arguably from this modest beginning,<sup>289</sup> U.S.

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286. See, e.g., *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (“The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’”).

287. The watershed event was U.S. adherence to the Berne Convention of the Protection of Literary and Artistic Works, effective March 1, 1989 by virtue of the Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, 102 Stat. 2853 (1988). The leading illustration of such authors' rights legislation, enacting what in Europe would be regarded as the *natural rights* of authors, is the Visual Artists Rights Act of 1990, Pub. L. No. 101-650, tit. VI, 104 Stat. 5089, 5128–33 (1990) (effective June 1, 1991).

288. *Wheaton v. Peters*, 33 U.S. (8 Pet.) 591, 667 (1834).

289. In fairness to the Court, one might instead plausibly lay the (credit or) blame at the feet of Congress, which passed both the 1790 and 1802 Acts at issue in *Wheaton* and subsequent legislation, which then became the duty of U.S. courts to construe. Of the 1831 Act (not material in *Wheaton* because *Wheaton's* final volume had been published in 1827), for example, the Supreme Court would later rule, “Undoubtedly, the [formalities]

copyright law embarked on a long national obsession with what became the “unholy trinity” of statutory formalities—notice, deposit, and registration—complete with often draconian penalties for failure to comply.<sup>290</sup> Not until the United States fully joined the world copyright community in the waning years of the twentieth century would the statutory formalities beast assume the role of largely toothless tiger that it occupies today.<sup>291</sup>

### C. *Owning the Law (Reports)*

No one who knew Henry Wheaton as Reporter, least of all the Justices with whom he served, could doubt his devotion to the advancement of the Supreme Court as an institution and the progress of national law in early America. All the same, Wheaton as Reporter (like Dallas and Cranch before him) had been motivated, too, by hope for at least a modest financial reward. The decision in the great case that bears his name dashed that hope forever. For all the words spilt in *Wheaton*, the truly critical question in the case was distilled in a single sentence at the end of McLean’s opinion that reads almost as an afterthought: Was copyright protection for the Justices’ opinions available under any U.S. law, federal or state, under any circumstances? McLean’s answer, for *all* of the Justices, unequivocally was no.

The afterlife of this pronouncement is clear, as indeed it had to be if public documents constituting the “law of the land”—opinions authored by judges; statutes authored by legislators; addresses, messages, regulations, and the like authored by Executive Department officials—were to be, as Ingersoll put the matter in his argument on behalf of Peters, “universally

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prescribed by the statute . . . are conditions precedent to the perfection of the copyright.” *Callaghan v. Myers*, 128 U.S. 617, 652 (1888).

290. The tale is told elsewhere in painful detail. *See generally, e.g.*, CRAIG JOYCE ET AL., COPYRIGHT LAW ch. 6 (6th ed. 2003) (detailing both the history of the formalities themselves and their relationship to the doctrines of limited and general publication). See also the following three studies (including the decisions and legislative revisions cited therein) prepared for the Subcommittee on Patents, Trademarks, and Copyrights of the Committee on the Judiciary, United States Senate (86th Cong., 1st Sess.) in anticipation of passage of the Copyright Act of 1976: VINCENT A. DOYLE ET AL., STUDY NO. 7: NOTICE OF COPYRIGHT (1957); BENJAMIN KAPLAN, STUDY NO. 17: THE REGISTRATION OF COPYRIGHT (1958); ELIZABETH K. DUNNE, STUDY NO. 20: DEPOSIT OF COPYRIGHTED WORKS (1960).

291. *See* Berne Convention Implementation Act of 1988, Pub. L. No. 100-568, §§ 7–9, 102 Stat. at 2557–59 (dealing with notice, deposit of copies or phonorecords, and registration). Even today, however, a few teeth remain: Registration is a prerequisite to suit for U.S. works and a precondition for awards of statutory damages and of attorney’s fees. *See* 17 U.S.C. § 101 (2000) (definition of “United States work”); § 411(a) (registration and infringement actions); § 412 (registration and availability of certain remedies for infringement); § 504(c) (statutory damages); § 505 (costs and attorney’s fees).

diffused.”<sup>292</sup> The principle now has been codified for “work[s] of the United States Government,”<sup>293</sup> and it has received general acceptance in the states as well.<sup>294</sup>

Of course, many questions concerning the law of copyright (and intellectual property law generally) remained unanswered in 1834. During the remainder of the nineteenth century, for example, and consistent with the pro-public domain values signaled in *Wheaton* (the denial of copyright protection for judicial opinions; the embrace of statutory copyright, to the exclusion of common law perpetual rights, for published works; and the beginnings of rigorous enforcement of formalities requirements that would place all noncompliant works in the public domain),<sup>295</sup> U.S. law would adopt other critical doctrines promoting the marketplace of ideas in America. Notable among these were the so-called idea-expression dichotomy<sup>296</sup> and the fair use defense,<sup>297</sup> which together are described in a leading recent Supreme Court decision as now constituting part of the

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292. *Wheaton*, 33 U.S. (8 Pet.) at 620.

293. 17 U.S.C. § 105.

294. See generally L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. REV. 719 (1989) (citing various cases). While there appear to be limits on the general principle as applied in the states with respect to documents (for example, agricultural extension service publications) created or adopted by state or local governments that are not “the law,” there is no doubt with respect to copyright protection for statutes, ordinances, judicial opinions and the like even below the federal level: There is no protection.

295. *Wheaton* makes no pronouncement regarding the “public domain” by name. The term itself would not appear in an opinion of the Court concerning intellectual property law until *Singer Manufacturing Co. v. June Manufacturing Co.*, 163 U.S. 169, 202 (1896) (or in statutory law until the 1909 Act). See generally Tyler T. Ochoa, *Origins and Meanings of the Public Domain*, 28 U. DAYTON L. REV. 215, 239–46 (2003). *Wheaton* represents a point in time when underlying public domain values were in place as part of the judicial consciousness, but when the Court behaved only instinctively concerning such matters. We should remember that the case constituted the Court’s first encounter with copyright and that its entire discussion of the copyrightability of opinions is contained in a single sentence at the end of McLean’s opinion. If the Court had, in 1834, possessed a coherent *theory* of the public domain, it would have stated that theory in *Wheaton*. Instead, the Court’s collective thoughts, if any, regarding the “public domain” in intellectual property were, at best, inchoate at that date. Thus, the case provides intimations of what was to come, but *only* that.

296. Copyright law protects expressions of ideas as a means of incentivizing their elaboration and dissemination, but not the underlying ideas themselves, which remain in the public domain for use by others. See 17 U.S.C. § 102(a); *Baker v. Selden*, 101 U.S. 99 (1879).

297. Copyright law provides limited opportunities for subsequent authors and the public itself to enjoy the use of others’ copyrighted works, in what would otherwise be infringing activity, to advance the general welfare. See 17 U.S.C. § 107; *Folsom v. Marsh*, 9 F. Cas. 342 (C.C.D. Mass. 1841) (No. 4901).

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“traditional contours of . . . protection” representing copyright’s “built-in First Amendment accommodations.”<sup>298</sup>

Those developments and others, however, lay in the future. *Wheaton v. Peters* marked the beginning, not the end, of the Supreme Court’s major decisions in the law of copyright. But what a beginning it was! In engaging Daniel Webster to argue the case before the Supreme Court, Wheaton’s friend Elijah Paine long ago observed, “This suit . . . will be more interesting than any reported case on copyrights, and . . . the future interest of all authors in this country will be greatly affected by its decision.”<sup>299</sup> In the long view of copyright history, he could not have been more right.

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298. Eldred v. Ashcroft, 537 U.S. 186, 219–21 (2003).

299. Letter from Elijah Paine to Daniel Webster (Dec. 6, 1831), *supra* note 149.