U.S. Supreme Court

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

Wheaton v. Peters

33 U.S. (8 Pet.) 591

Syllabus

Copyright. From the authorities cited in the opinion of the Court and others which might be referred to, the law appears to be well settled in England that since the statute of 3 Anne, the literary property of an author in his works can only be asserted under the statute, and that notwithstanding the opinion of a majority of the judges in the great case of *Miller v. Taylor* was in favor of the common law right before the statute, it is still considered in England as a question by no means free from doubt.

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

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

In what respect does the right of an author differ from that of an individual who has invented a most useful and valuable machine? In the production of this his mind has been as intensely engaged as long, and perhaps as usefully to the public, as any distinguished author in the composition of his book. The result of their labors may be equally beneficial to society, and in their respective spheres they may be alike distinguished for mental vigor. Does the common law give a perpetual right to the author, and withhold it from the inventor? And yet it has never been pretended that the latter could hold, by the common law, any property in his invention after he shall have sold it publicly. It would seem, therefore, that the existence of a principle which operates so unequally may well be doubted. This is not a characteristic of the common law. It is said to be founded on principles of justice, and that all its rules must conform to sound reason.

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

It is clear there can be no common law of the United States. The federal government is composed of twenty-four sovereign and independent states, each of which may have its

local usages, customs, and common law. There is no principle which pervades the union and has the authority of law that is not embodied in

the Constitution or laws of the union. The common law could be made a part

of our system by legislative adoption.

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

When the ancestors of the citizens of the United States emigrated to this

country, they brought with them, to a limited extent, the English common law as part of their heritage. No one will contend that the common law, as it existed in England, has ever been in force in all its provisions in any

state in this Union. It was adopted only so far as its principles were suited to the condition of the colonies, and from this circumstance we see what is the

common law in one state is not so considered in another. The judicial decisions, the usages and customs of the respective states, must determine how far the common law has been introduced and sanctioned in each.

If the common law in all its provisions has not been introduced into Pennsylvania, to what extent has it been adopted? Must not this Court have some evidence on the subject? If no copyright of an author, in his wont, has been heretofore asserted there, no custom or usage established, no judicial decisions been given, can the conclusion be justified that by the common law of Pennsylvania, an author has a perpetual property in the copyright of his works.

These considerations might well lead the court to doubt the existence of this law, but there are others of a more conclusive character.

In the eighth section of the first article of the Constitution of the United States it is declared that Congress shall have power

"to promote the progress of science and the useful arts by securing, for a limited time, to authors and inventors the exclusive right to their respective writings and inventions."

The word "secure," as used in the Constitution, could not mean the protection of an acknowledged legal right. It refers to inventors as well as authors, and it has never been pretended by anyone either in this country or in England that an inventor has a perpetual right at common law to sell the thing invented.

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

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

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

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

The acts required by the laws of the United States to be done by an author to secure his copyright are in the order in which they must naturally transpire. First the title of the book is to be deposited with the clerk and

"the record he makes must be inserted in the first or second page; then *the public notice in the newspapers is to be given, and within six months after the publication of the book, a copy must be deposited in the Department of State.* "

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

The security of a copyright to an author by the acts of Congress is not a technical grant of precedent and subsequent conditions. All the conditions are important; the law requires them to be performed, and consequently their performance is essential to a perfect title. On the performance of a part of them the right vests, and this was essential to its protection under the statute, but other acts to be done, unless Congress has legislated in vain, to render this right perfect. The notice could not be published until after the entry with the clerk; nor could the book be deposited with the Secretary of

State until it was published. But they are acts not less important than those which are required to be done previously They forma part of the title, and until they are performed, the title is not perfect.

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

The acts of Congress authorizing the appointment of a reporter of the decisions of the Supreme Court of the United States require the delivery of eighty copies of each volume of the reports to the Department of State. The delivery of these copies does not exonerate the reporter from the deposits of a copy in the Department of State, required under the Copyright Act of Congress of 1790. The eighty copies delivered under the reporter's act are delivered for a different purpose, and cannot excuse the deposit of one volume as especially required by the copyright acts.

No reporter of the decisions of the Supreme Court has, nor can he have, any copyright in the written opinions delivered by the Court, and the Judges of the Court cannot confer on any reporter any such right.

The case as stated in the opinion of the Court was as follows:

"The complainants in their bill state that Henry Wheaton is the author of twelve books or volumes of the reports of cases argued and adjudged in the Supreme Court of the United States, and commonly known as 'Wheaton's Reports,' which contain a connected and complete series of the decisions of said Court from the year 1816 until the year 1827. That before the first volume was published, the said Wheaton sold and transferred his copyright in the said volume to Matthew Carey of Philadelphia, who, before the publication, deposited a printed copy of the title page of the volume in the Clerk's Office of the District Court of the Eastern District of Pennsylvania, where he

resided. That the same was recorded by the said clerk according to law, and that a copy of the said record was caused by said Carey to be inserted at full length in the page immediately following the title of said book. And the complainants further state that they have been informed and believe that all things which are necessary and requisite to be done in and by the provisions of the Acts of Congress of the United States passed 31 May, 1790, and 29 April, 1802, for the purpose of securing to authors and proprietors the copyrights of books and for other purposes in order to entitle the said Carey to the benefit of the said acts have been done."

"It is further stated that said Carey afterwards conveyed the copyright in the said volume to Matthew Carey, Henry C. Carey, and Isaac Lea, trading under the firm of Matthew Carey & Sons, and that said firm, in the year 1821, transferred the said copyright to the complainant, Robert Donaldson. That this purchase was made by an arrangement with the said Henry Wheaton with the expectation of a renewal of the right of the said Henry

Wheaton under the provisions of the said acts of Congress, of which renewal he, the said Robert Donaldson, was to have the benefit until the first and second editions of the said volume which he, the said Donaldson, was to publish should be sold. That at the time the purchase was made from Carey & Sons, a purchase was also made of the residue of the first edition of the first volume, which they had on hand, and in the year 1827 he published another edition of said volume, a part of which still remains unsold."

"The bill further states that for the purpose of continuing to the said Henry Wheaton the exclusive right, under the provisions of the said acts of Congress, to the copy of the said volume for the further term of fourteen years, after the expiration of the term of fourteen years from the recording of the title of the said volume in the clerk's office as aforesaid, the said Robert Donaldson, as the agent of Wheaton within six months before the expiration of the said first term of fourteen years, deposited a printed copy of the title of the said volume in the Clerk's Office of the District Court of the Southern District of New York, where the said Wheaton then resided, and caused the said title to be a second time recorded in the said clerk's office, and also caused a copy of the said record to be a second time published

in a newspaper printed in the said City of New York for the space of four weeks, and delivered a copy of the said book to the Secretary of State of the United States, and that all things were done agreeably to the provision of the said Act of Congress of May 31, 1790, and within six months before the expiration of the said term of fourteen years."

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

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

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

The bill of the complainants was dismissed by the decree of the circuit court, and they appealed to this Court.