

No. 16-712

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IN THE  
**Supreme Court of the United States**

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OIL STATES SERVICES, LLC,  
*Petitioner,*

v.

GREENE'S ENERGY GROUP, LLC, ET AL.,  
*Respondents.*

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ON WRIT OF CERTIORARI TO  
THE UNITED STATES COURT OF APPEALS  
FOR THE FEDERAL CIRCUIT

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**BRIEF OF AMICI CURIAE  
ALLIACENSE LIMITED LLC  
IN SUPPORT OF PETITIONER**

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## INTEREST OF AMICUS

Alliacense Limited LLC is in the business of managing intellectual property assets of its clients including providing licensing and patent prosecution. Alliacense provided counsel to MCM Portfolio LLC in the IPR, the Federal Circuit appeal, and the ultimate petition to the Supreme Court in *MCM Portfolio LLC v. Hewlett-Packard*, No. 15-1330, *cert. denied*, October 11, 2016. Alliacense has continued interest in the issues presented by the present case.<sup>1</sup>

## SUMMARY OF ARGUMENT

Congress has no power to authorize the Patent Trial and Appeal Board (“PTAB”) to revoke patents for invalidity without trial by jury because prior to 1791, the year the Seventh Amendment<sup>2</sup> was ratified, inventors had a right to a trial by jury in an English court of law before their patents could be revoked for invalidity thereby giving such revocation actions a Seventh Amendment right to trial by jury. The common law remedy was known as a *scire facias*; the action was commenced either on the common-law side of Chancery or at King’s Bench, and was exclusively tried at King’s Bench and to a jury. The BIO and even this court in the past have assumed that because a *scire facias* normally was

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<sup>1</sup> All parties have consented to the filing of this brief. No counsel for any party authored this brief in whole or in part, and no entity, other than amici, or their counsel, made a monetary contribution to the preparation or submission of this brief.

<sup>2</sup> “In Suits at common law, ... the right of trial by jury shall be preserved....” Const. amend. VII (hereinafter “Seventh Amendment”).

returned in Chancery, that it was an equitable proceeding and that even if jury trials were conducted, they were only advisory, not binding. But is not true that the writ *scire facias* was a bill in equity. A *scire facias*, a common law writ that can be identified as such from its use of Latin, was instead returned on the law-side of Chancery; and the Chancellor at all times was acting with his ordinary, common law powers, not his extraordinary, equitable powers. We attach a copy in the appendix of pages 79 and 80 of Cokes 4<sup>th</sup> Institute (1644) for the court to easily verify the truth of the matter.

Inter partes review (IPR)<sup>3</sup> provides the same remedy, *revocation*,<sup>4</sup> and the same grounds, *invalidity* as do *scire facias*, albeit, limited only to the claims challenged.<sup>5</sup> Both are contested proceedings. Both begin with a petition by an interested party to the government. The common law proceeding was pursued in the name of the King, but the real party in interest was the petitioner who had to post a very large bond to pay the attorney's fees of the patent owner.

Because IPR does not provide a jury trial, the statute authorizing IPR is unconstitutional.

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<sup>3</sup> 35 U.S.C. §§ 311-319.

<sup>4</sup> 35 U.S.C. § 318(b) (Claims determined unpatentable cancelled by certificate). *Cf.*, 35 U.S.C. § 288 (Action may proceed on valid claims even if patent contains an invalid claim.) A modern patent varies from those at the time of the founding because they have multiple claims varying from one another in scope that narrower claims may be valid even though broader claims read on the prior art. By statute, an action may proceed even if a patent claims an invalid claim.

<sup>5</sup> Under *Tull v. United States*, 481 U.S. 412 (1987) the remedy (here, revocation) is the most important factor.

The unconstitutionality of IPR is not negated by any legitimate public rights analysis. Actions to determine “statutory” legal rights of the type determined prior to 1791 in England, and this includes *scire facias* actions to revoke patents for invalidity, are categorically excluded from a public rights analysis because they have a Seventh Amendment right.

This amicus describes the English court system, the procedures for revoking patents, and the relevant English history from 1624 to 1791. By 1791, the Privy Council had stopped revoking invention patents leaving only the legal remedy of *scire facias*. Parliament first attempted to limit the jurisdiction of the Privy Council in the 1624 Statute of Monopolies. But, in 1626, the first year of Charles I, the Privy Council stayed common law revocation proceedings. Only in 1753, did the Privy Council stop revoking invention patents, apparently at the behest of William Murray, later Lord Mansfield, who then was Solicitor General. *Rex v. Arkwright*, 1 Carp. P.C. 53, 1 WPC 64 (K.B. 1785), was one of the first patent revocation actions tried after 1753. We attach a copy of the case to demonstrate that the issues tried were validity based on prior art, prior invention and an inadequate specification, issues common to today. The case was tried at King’s Bench and to a jury. The patent was ordered revoked by Lord Mansfield after a petition for retrial was denied.

*Scire facias* actions were normally commenced on the law side of Chancery, but tried in King’s Bench. Because they were filed in Chancery, the government has argued that the actions were equitable (apparently not even knowing that Chancery had a law side) thereby providing no basis

for a Seventh Amendment right. They may further argue that the jury trials that did take place were only advisory as if the Chancellor was acting with his extraordinary (equitable-side) powers, as opposed to his ordinary (law-side) powers. However, we demonstrate that *scire facias* to revoke patents for invalidity were legal from filing to judgment. We further demonstrate that equity could not and did not revoke patents for invalidity since an adequate remedy at law was available.

## ARGUMENT

1. **Actions to revoke patents for invalidity have a Seventh Amendment right because such actions were tried exclusively in the common law courts of England prior to ratification of the Seventh Amendment in 1791.**
  - a. **The Seventh Amendment extends to patent revocation actions.**

This court first interpreted the *Seventh Amendment* in *Parsons v. Bedford*, 28 U.S. (3. Pet.) 433 (1830) “By common law, [the framers] meant what the constitution denominated in the third article “law;” not merely suits, which the common law recognized among its old and settled proceedings, but suits in which legal rights were to be ascertained and determined....” *Id.* at 446-447. The “thrust of the [Seventh] Amendment was to preserve the right to jury trial as it existed” in England “in 1791,” *Curtis v. Loether*, 415 U.S. 189, 193 (1974), “the date of the Amendment’s ratification by the original states,” *Baltimore & Carolina Line, Inc. v. Redman*, 295 U.S. 654 (1935). Under this formulation, *scire facias* actions, the exclusive remedy employed to revoke invention patents from

1780, fall squarely within the *Parsons/Curtis* analysis because such actions were filed at law, tried at law, determined the validity of a patent, and revoked patents that were invalid. Moreover, it is the remedy of revocation of the patent that is the most important feature of *scire facias* actions for Seventh Amendment purposes. *Tull v. United States*, 481 U.S. 412, 421 (1987).

**b. A proper public rights analysis for statutory rights must compare the statutory action to similar common law actions.**

The Federal Circuit in *MCM Portfolio LLC v. Hewlett-Packard Co.*, 812 F.3d 1284, 1290-1293 (Fed. Cir. 2015) and the government BIO both insert a public right's analysis before determining whether there is a violation of the Seventh Amendment. This form of argument never considers whether IPRs are truly comparable to common law *scire facias* actions, but rather assumes they are not comparable, even though IPR and *scire facias* provide the same remedy for the same legal grounds as *scire facias*. This faulty argument resulted, in *MCM Portfolio*, in a determination that it was constitutionally permissible to assign the trial of patent revocation to the USPTO where a jury trial is not available; thus effectively sweeping away the Seventh Amendment rights of patent owners. Any analysis that permits this is seriously flawed.

This court's public rights analysis has heretofore categorically excluded state common law claims as public rights. *See, e.g., Stern v. Marshall*, 564 U.S. 462, 131 S. Ct. 2594, 2609, 2611 (2011). A first reason such actions are excluded is that they were litigated in the courts of England prior to 1789. *Id.*

at 2611 citing *Murray's Lessee v. Hoboken Land & Improvement Co.*, 59 U.S. 272 (18 How.) 272 (1856). A second reason they are excluded is that, to the extent legal, they have a Seventh Amendment right. *Cf.*, *Granfinanciera, SA v. Nordberg*, 492 U.S. 33, 51-52 (1989).

- c. **Only novel types of statutory actions may be assigned to administrative tribunals; but IPR are identical to *scire facias* actions in both grounds and remedy.**

But when the right is created by federal statute and not by state common law, the public rights analysis requires that the statutory action involving that right be “novel” -- a type not known to common law. *Ibid.* When, as here, the grounds, patent validity, and the remedy, patent revocation, provided by IPR are the same as *scire facias* actions at common law, the public rights analysis must stop. The action must be tried in an Article III court and to a jury. *Ibid.*

## **2. English history of patent revocation actions: 1624-1791.**

- a. **The 1624 Statute of Monopolies required monopoly patent revocation actions be tried exclusively in the common law courts.**

Section I of the Statute of Monopolies, 21 Jac.1, c. 3 (1624), declared all prior “monopoly” patents void, listing exceptions in sections VI-IX. Section VI permitted patents for “new manufactures” to “the true and first inventor” that others at the time of the patent grant shall not use.” Section II declared that

only the common law courts could void patents.<sup>6</sup> (The *Case of Monopolies*,<sup>7</sup> had previously established authority of the common law courts to “declare void” monopoly patents.) As put by Webster,

[A]ll monopolies, &c., to be void by the common law, has provided by this that they shall be examined, heard, tried, and determined, in the courts of common law, according to the common law, and not at the council table, star chamber, chancery exchequer chamber, or any other court of like nature, but only according to the common laws of the realm, and not otherwise.

Edward Coke, *The Third Part of the Institutes* 182-183 (1644); Webster, Thomas. *Reports and Notes of Cases on Letters Patent for Inventions*. Vol. 1. T. Blenkarn, 1844 at 30.

**b. In 1626, Charles I stayed common law patent revocations and resumed exclusive Privy Council jurisdiction.**

Prior to the 1624 statute, only the crown or its Privy Council had voided patents. Their authority to do so was based on a revocation clause included in every monopoly patent from the time of Elizabeth.<sup>8</sup>

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<sup>6</sup> “[A]ll monopolies, and all ... patents ... shall be “examined, heard, tried and determined, by and according to the common laws of this realm, and not otherwise.”

<sup>7</sup> *Darcy v. Allen*, 11 Co. Rep. 84b. 77, 77 Eng. Rep. 1260, 1 WPC 1 (K. B. 1602). (*Darcy v. Allen* was an infringement suit. The plaintiff was denied a remedy because in the opinion of the court the patent was void.)

<sup>8</sup> Davies, D. Seaborne. “The early history of the patent specification.” *LQ Rev.* 50 (1934): 86, 260 (pts.1-2) at 102-103. The clause read in part,

The 1624 statute specified that only the common law courts could void patents – and that seemed to exclude the Privy Council (and the crown) from its traditional role.

In 1626, a glassmaker openly began to infringe a glassmaking patent held by Mansell, and indicated his intention to bring a *scire facias* to revoke it.<sup>9</sup> The Mansell patent had been excepted in Section VIII of the 1624 statute from general repeal of all prior patents because of its strategic importance.<sup>10</sup> Edward Coke had earlier reported that Mansell, a vice Admiral of England, was not the inventor of glassmaking, but of only the furnace that used sea coal. Lord Coke recommended that the patent be limited to the production of glass using sea coal.<sup>11</sup> 1

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[I]f on examination of the patent before the Privy Council, or a specified number of its members, before whom the patentee had been called, the grant was certified to be inconvenient or prejudicial to the realm, then on the signification of the pleasure of the Crown in that respect ... or upon a certificate to that effect made by the Privy Council ... the patent immediately, or at the end of a specified period of notice, was to be void and frustrate.

*Ibid.* Arkwright's patent, discussed below, included a revocation clause that also included prior use and prior invention as grounds for revocation.

<sup>9</sup> Walterscheid, Edward C. "The early Evolution of the United States patent law: antecedents (part 3)." *J. Pat. & Trademark Off. Soc'y* 77 (1995): 771 at 774.

<sup>10</sup> *See*, 1 WPC 32 (noting the exception, but commenting that Mansell was not the inventor).

<sup>11</sup> Coke's report on the Mansell patent indicates that monopoly patents for invention were investigated and were limited to the scope of the invention on pain of revocation. During the late 1700s, the English developed a caveat system

WPC 27. The patent, No. 22, was renewed in 1624 and limited to the use of sea or pit coal to make glass. 1 WPC 17-26. The patent also prohibited others from using timber to make glass. The crown was trying to reduce the use of timber, a strategic resource for building ships. *Id.* at 17.

After initially giving its approval for the *scire facias*, the Privy Council soon reconsidered: “They think it of dangerous consequences and far trenching upon the prerogative that patents granted on just grounds and of long continuance should be referred to the strict trial of common law, wherefore they order that all proceedings *at law* be stayed.”<sup>12</sup> Unstated, the revocation would have undermined England’s national security.

The Privy Council thereafter continued its prior practice of revoking patents on petition. English scholar Hulme, in his review of Privy Council records, reported dozens of such Privy Council proceedings in the late 1600s through 1753, most involving allegations of prior use or prior invention. Hulme, E. Wyndham, *Privy Council Law and Practice of Letters Patent for Invention from the Restoration to 1794*, 33 L.Q.R 63, 180 (1917) (2 Pts.).

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that was effectively an opposition system. Issue concerning novelty and invention were tried to a jury. Sean Bottomley, *The British Patent System During the Industrial Revolution 1700–1852*, at 35–39, 53–55 (2014).

<sup>12</sup> Walterscheid “The early Evolution of the United States patent law: antecedents (part 3)”, *supra*, at 774, quoting State Papers, Domestic, December 6, 1626. Charles I, an absolutist Monarch like his father, James VI and I, also began issuing monopoly patents that were in clear disregard of the limitations of the Statute. Fox, Harold George. *Monopolies and patents: a study of the History and future of the patent monopoly*. University of Toronto Press, 1947 at 127-145.

- c. In 1753, the Privy Council was presented with a constitutional problem when the common law courts challenged the ruling of the Privy Council in the matter of the James patent.

Hulme identifies the 1752 proceedings involving the James patent, No. 626, as a turning point between the old and new systems of patent law. One Baker had petitioned the Council to revoke the James patent on grounds that a Baron Schwanberg was the inventor of the claimed fever powder. Dr. James responded with an affidavit saying that the invention was for a pill and a powder of multiple compounds, making it immaterial if one of them was invented by the Baron. The matter was dismissed. Baker then brought an indictment for perjury against Dr. James and requested that the Privy Council order its clerk to produce the original affidavit of Dr. James. The Privy Council referred the matter to its Attorney General. *Id.* at 189-191. The advice was that the petitioner did not have a legal right to have the affidavit produced and the Baker petition was dismissed. *Ibid.* William Murry, later Lord Mansfield and a strong champion of the courts, was then Solicitor General. Hulme argued that the Council acted to settle a quarrel with Lord Mansfield regarding the constitutional authority of the Privy Council to try disputes regarding validity. Hulme, “*Privy Council Law and Practice of Letters Patent for Invention from the Restoration to 1794*,” *supra*, at 184.

**d. After the events of 1753, and at least from 1780, only the common law courts of England revoked patents for invalidity.**

Thereafter, and even considering that patents still contained boilerplate revocation clauses allowing the Privy Council to revoke patents for prior use or prior invention, every petition to the Council requesting revocation of an invention patent was dismissed, apparently with a “recommendation” that the patent owner bring an action at law that the validity of the patent might be tried.<sup>13</sup> The last Privy Council revocation occurred in 1779. The case involved a cannon making patent. The revocation occurred after a four-year delay that was intended to allow the patent owner to bring an action at law to try validity. He refused to bring the action, despite having already obtained an injunction. The revocation was based on national security, not validity. The council considered further delay to be prejudicial to the ability to conduct the war in the American colonies.<sup>14</sup>

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<sup>13</sup> E.g., the petition of 35 opticians for vacating Dollond’s patent, No. 721. *Id.* at 191. It is interesting to note that now the revocation clause inserted into patents included additional language not included in the revocation clause at the time of Elizabeth. The revocation clause in Arkwright’s patent, for example, allowed the Privy Council to revoke patents because “the said invention is not a new invention as to the public use and exercise thereof...; Or not invented and found out by the said [name of the inventor].” Compare, English patent boilerplate at the time of George III, at 31, with the grounds for the *scire facias* in *Rex v. Arkwright*, at 61, of Davies, John. *A Collection of the most important cases respecting Patents of Invention and the Rights of Patentees*. Reed, 1816.

<sup>14</sup> National security is well within the public rights exception to the right of trial in an Article III court. *See, Murray’s Lessee v. Hoboken Land & Improvement Co.*, 59 U.S.

The government shifted to the use of *scire facias* actions where trial would be to a jury. One of the first *scire facias* actions was *Rex v. Arkwright*, 1 Carp. P.C. 53, 1 WPC 64 (K.B. 1785).<sup>15</sup> The action was brought only after Arkwright had first sued nine competitors for infringement and lost because the court held his specification to be insufficient.<sup>16</sup> Several years elapsed. Arkwright then sued again and this time won.<sup>17</sup> That second judgment issued in February of 1785. But, while that second action was under way, the King, on petition to the Attorney

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(18 How.) 272, 285 (1856); citing *Luther v. Borden*, 48 U.S. (7 How.) 1 (1849); *Doe v. Braden*, 7 U.S. (16 How.) 635 (1854).

<sup>15</sup> Other cases prior to 1791 include *Rex v. Jacob*, 496 nb 169 (Middlesex, 6 Dec. 1782), MMSS I: 767; *Rex v. Else*, (1785) 1 CPC 104; 1 WPC 76 (K.B.); *Rex v. Eley*, (1790) Times (Lon.), Dec. 9, 1790, at 3.

<sup>16</sup> *Arkwright v. Mordaunt*, 1 WPC 56 (C.P. 1781).

<sup>17</sup> *Arkwright v. Nightingale*, 1 WPC 60 (C.P. 1785). Regarding the prior verdict adverse to Arkwright, the court said,

It has been said, that many persons have acted upon an idea that Mr. Arkwright had no right, he having failed to establish it when this cause underwent an examination in another place, in which the event was unfavourable to him. If the question at present were what damages Mr. Arkwright should have received for the invading that right, I would have allowed the parties to have gone into evidence to show to what extent persons have acted upon the faith of the former verdict; but the question now is upon the mere right, and if the result of this cause is in favour of the plaintiff, the verdict will be with one shilling damages. A future invasion of this right would entitle Mr. Arkwright to an action for damages, but in the present case they are not asked.

*Id.* at 61.

General, brought a *scire facias* in Chancery. Trial was at King's Bench and the verdict of invalidity was for the crown.<sup>18</sup> Lord Mansfield, on denying retrial, ordered the patent repealed.<sup>19</sup>

- e. ***Rex v. Arkwright*, a *scire facias* to revoke a patent for invalidity, was commenced on the law side of Chancery, tried at King's Bench and resulted in judgment by Chief Justice Mansfield of King's Bench ordering the patent cancelled.**

To preempt any potential argument that English patents and patent litigation of the late 1700s were unlike those of today, we discuss in some detail in *Rex v. Arkwright*, 1 Carp. P.C. 53, 1 WPC 64 (K.B. 1785).<sup>20</sup> (The appendix attaches Webster's report of the case. A-4.)

Per Thomas Webster, patents issuing from the end of Anne's reign included a proviso requiring the grantee to file a specification "particularly to describe and ascertain the nature of his invention,

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<sup>18</sup> *Rex v. Arkwright*, *supra*, 1 WPC at 64.

<sup>19</sup> Webster's report of the case is set forth in the appendix at A-4. To prevail, Arkwright had to prevail on all points, the Crown, any. *See, Rex v. Arkwright*, *supra*, 1 WPC at 73. At that time, if any of the claimed inventions was not novel, the entire patent was found invalid and voided. Arkwright claimed 10 different components to his machine, many of which were proven to be not his.

<sup>20</sup> For a discussion of the history surrounding the case, *see*, Hewish, J. "Rex vs Arkwright, 1785: A Judgment for Patents as Information," World Patent Information, Vol. 8, No. 1, 1986, pp. 33-37, where, it appears, a large group of rival cotton manufacturers banded together to petition for a writ to put an end to Arkwright's continued effort to enforce his patent despite his initial adverse ruling on validity.

and in what manner the same is to be performed.” 1 WPC at vi and 8. *See also*, Bottomley, Sean. *The British Patent System during the Industrial Revolution 1700–1852: From Privilege to Property*. Vol. 28. Cambridge University Press, 2014: 46-50 (describing a gradual adoption of the requirement dating from 1711). Thereafter, patents could be revoked for providing an insufficient specification. One of those so revoked was owned by Richard Arkwright.

The major problem with the Arkwright patent (on a cotton carding machine) was an insufficient specification. It described several components, but not a word as to how they cooperated. Evidence produced proved that some of the components that went into making the carding machine were in public use or the invention of others. The jury verdict was for the crown.

That the summary of law and facts and the court’s jury instructions show that the English had developed the fundamentals of modern patent law prior to 1791. The most important development thereafter is the statutory mandate for patent specifications to claim the invention and that a patent office examine “claims” before grant. (Patent) Act of 1836, Ch. 357, 5 Statutes at Large 117, § 7. While this development has led to a host of issues, such as claim construction, and other validity issues, courts today still decide the validity of a patent claim based on whether the invention claimed by a claim is new, whether the specification describes the claimed invention and whether it enables one of ordinary skill to make and use it.

**3. English Procedure for revoking patents at law.**

**a. The Court of Common Pleas, the Court of Exchequer and the King's Bench were the law courts of England.**

Lord Coke in Coke, Edward. *The Fourth Part of the Institutes of the Laws of England: Concerning the Jurisdiction of Courts* (1644), published at W. Clarke and Sons, 1817 (*4<sup>th</sup> Inst.*), describes the jurisdiction of the sundry courts in England, Scotland, Ireland and Wales. The table of contents lists well over 100 courts, but among these, only three were common law courts: The Court of Common Pleas, the Court of Exchequer and the Court of King's Bench – the latter having a division located in Chancery. The Court of Common Pleas tried cases between parties other than the King. *4<sup>th</sup> Inst., supra*, at 99. Exchequer was concerned with the King's revenue. *4<sup>th</sup> Inst., supra*, at 112. King's Bench tried cases where the King was a party. *4<sup>th</sup> Inst., supra*, at 71.

**b. *Scire facias* actions were filed on the law side of Chancery and tried at King's Bench.**

The index of the *4<sup>th</sup> Inst.* States that “A *scire facias* to repeal a patent may be brought in either King's Bench or in the Chancery.” Pages 72 (King's Bench), 79 and 88 (Chancery) are referenced. “A *scire fac.* repeal a patent of the King may be brought in this court.” *4<sup>th</sup> Inst.*, at 72. The *scire facias*, if filed in Chancery, was filed on its law side and not on its equitable side. *4<sup>th</sup> Inst.*, at 79. The Chancellor, the sole judge of Chancery, considered the writ with his ordinary (law) powers as opposed to his extraordinary (equitable) powers. *4<sup>th</sup> Inst.*, at 88.

Coke states that the grounds for *scire facias* are double patenting, false suggestion, and contrary to law. *Ibid.* In the case of double patenting, the first patentee may bring a suit against the second. In the latter two cases, the king is the party. *4<sup>th</sup> Inst.*, at 88.<sup>21</sup> An aggrieved subject petitioned the King to repeal the patent. “Where a patent is granted to the prejudice of a subject, the king of right is to permit him upon his petition to use his name for the repeal of it.” 1 WPC 41, quoting from *Sir Oliver Butler’s Case*, H. 31 & 32 Car. 2, 2 Vent. 344., 2 Ventr. 344; *4<sup>th</sup> Inst.*, *supra*, at n. 3.<sup>22</sup>

The procedures described by Lord Coke are also described in *Rex v. Arkwright*, 1 WPC 64 at 64-65. Webster’s note states that proceedings of this type

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<sup>21</sup> Coke writes,

This writ *scire facias* to repeal letters patents doth lye in this ordinary court of justice and three cases. The first, when the king by his letters patents doth grant by several letters patents one and the same thing to several people, the former patentee shall have a *scire facias* to repeal the second patent. Secondly, when the king granteth any thing that is grantable upon false suggestion, the king by his prerogative *jure regio* may have a *scire facias* to repeal his own grant. Thirdly, when the king doth grant any thing, which by law he cannot grant, he *jure regis* (for advancement of justice and right) may have a *scire facias* to repeal his own letters patents.

*4<sup>th</sup> Inst.*, Cap. 8 at 88.

<sup>22</sup> This court similarly held that only the government might bring an action for the repeal of a patent. *Mowry v. Whitney*, 81 U.S. (14 Wall.) 434, 439 (1871) (“[W]e are of opinion that no one but the government, either in its own name or the name of its appropriate officer ... can institute judicial proceedings for the purpose of vacating or rescinding the patent which the government has issued to an individual.”).

originated in the Petty Bag Office. (The Petty Bag Office was where the records of patents issued by the crown were kept. *U.S. v. American Bell Tel. Co.*, 128 U.S. 315, 360 (1888).) A draft writ is “taken to the Atty. Gen., who thereupon may grant his fiat, upon the prosecutor and to sureties entering to a bond of a £1000, conditioned to pay the defendant his costs, taxed as between attorney and client.” *Rex v. Arkwright*, 1 WPC at 64.

As mentioned, a *scire facias* normally commenced on the common-law side of Chancery. That side was a separate court, a division of King’s Bench. It was entitled *coram domino rege in cancelleria, et additio probat minoritatem*, translated: King’s Bench division in Chancery. *4<sup>th</sup> Inst.* at 79. Because Chancery had no facilities to conduct jury trials, the Chancellor transferred the record to King’s Bench in Westminster Hall. As Coke notes at pages 79-80 of the *4<sup>th</sup> Inst.*, this court and the court of King’s Bench were considered a single court for the purposes of trying cases. Appendix A-1 is a copy of pages 79-80 from an 1817 version of the *4<sup>th</sup> Inst.*<sup>23</sup> As showed by the Arkwright case, the proceedings terminated with King’s Bench ordering the patent repealed.

**4. Because there was an adequate remedy at law, the Chancellor had no jurisdiction to revoke a patent using his (extraordinary) equitable powers.**

Even though *scire facias* actions to repeal patents for invalidity provided a complete and adequate remedy at law, the government briefs heretofore,

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<sup>23</sup> A judgment that the patent was void was returned to Chancery where the Chancellor would cancel it. *Rex v. Arkwright, supra*, 1 WPC at 65.

and some of this Court's opinions, have expressed the view that patent revocation actions may be determined by the Chancellor acting in his *equitable* capacity. See e.g., *U.S. v. Stone*, 69 U.S. (2 Wall.) 525, 535 (1864); *Mowry v. Whitney*, 81 U.S. (14 Wall.) 434, 440 (1871) (citing *Stone*), *U.S. v. American Bell Telephone*, 128 U.S. 315, 359-361, 364-365 (1888).<sup>24</sup> In England, this was "constitutionally" not possible. One of the compacts between the commons and the King limited equity to disputes where there was no adequate remedy at law:

In the parliament holden 13 R. 2. the commons petitioned to the king, ... That no person should appear upon a writ *De quibusdam certis de causis*,<sup>25</sup> before the chancelor or any other of the councell, where recovery is therefore given by the common law: whereunto the King's answer is, The king willeth as his progenitors have done, saving his regalty.<sup>26</sup>

Coke, *4<sup>th</sup> Inst.*, Cap. 8 at 82. Parliament agreed to the same principle.

1. Rot. par. 2 R. 2. nu. 18. the high court of parliament relieveth but such as cannot have remedy but in parliament. The

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<sup>24</sup> This court said Chancellor was acting with his "ordinary" powers when using his equitable powers. This potentially causes confusion because Coke referred to the use of the Chancellor's *ordinary* powers as being those of a *common-law* judge, his *equitable* powers being *extraordinary*. *4th Inst.* at 79.

<sup>25</sup> Subpoena to testify.

<sup>26</sup> Spelling unchanged except for the substitution of "s" for "f" as appropriate.

parliament for matters determinable at the common law doth remit the parties.

...

3. Whereas matters of fact by the common law are triable by a jury of twelve men, this court should draw the matter *ad aliud examine*, that is, to judge upon deposition of witnesses, which should be but evidence to a jury in actions real, personal, or mixed.

This court of equity proceeding by English bill is no court of record, and therefore it can bind but the person only, and neither the state of the defendants lands, nor property of his goods or chattels.

*Id.* at 84. To the same effect is the Statute of Monopolies. As explained by Lord Coke, its limitation of revocation actions to the common law courts was intended, among other things, to limit the jurisdiction of Chancery from considering patent validity. Edward Coke, *The Third Part of the Institutes* 182-183 (1644).

This court has held that the Seventh Amendment imposes a no-adequate-remedy-at-law limitation on the scope of equity jurisdiction.

[W]henever, respecting any right violated, a court of law is competent to render a judgment affording a plain, adequate and complete remedy, the party aggrieved must seek his remedy in such court, [] because the defendant has a constitutional right to a trial by jury....

*Scott v. Neely*, 140 U.S. 106, 109-110 (1891); *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 510-511 (1959).

The English authority relied on by *Mowry*<sup>27</sup> and *American Bell*<sup>28</sup> to support their view that equity generally was a proper forum to revoke patents is *Atty. Gen. v. Vernon*, 1 Vern. 277, 23 Eng. Rep. 468 (1684) (*Vernon I*). This reliance is misplaced.

In *Vernon I*, the Attorney General brought a bill in equity to revoke a patent “under the Duchy’s seal” granting the defendants land from the King’s Duchy of Lancaster. The grounds were fraud. The allegation was that the value of money and lands exchanged for the grant was far less than the value of the property conveyed. There were no surveys done prior to the patent issuing. The value of the lands conveyed was not stated.

The defendants pled that the matter was properly decided in a court of law, and ought to be determined in the Duchy. The King objected that the Duchy court was a revenue court, not a court of law. Further, that *scire facias* was not an available remedy because the patent was not of record in Chancery and because *scire facias* relieved only deceits appearing in the body of the patent. The Lord Keeper overruled the plea, but reserved the question of jurisdiction of equity to the full hearing. *Id.* at 282.

At the full hearing, the Chancellor and the Lord Chief Justice and the Chief (of the Court of Common Pleas) decided that the legal remedy, *scire facias*, did not provide a remedy, let alone an adequate remedy:

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<sup>27</sup> 81 U.S. at 440.

<sup>28</sup> 128 U.S. 359-361, 364-365, 369.

*Lord Chief Baron Mountague* said, "... that no *scire fac.* would lie in this case, the deceit not appearing in the body of the grant...." He thought, "[H]is *Lordship* might justly decree a re-conveyance, and that the patent should be delivered up and cancelled: and he supposed care would be taken that the consideration should be restored."

*Lord Chief Justice Jones* said, "I take it, that a *scire fac.* will not lie in this case, or if it would, yet the deceit appears not in the body of the patent; and therefore a *scire fac.* will not reach it. The value is not mentioned in the patent, and shall there be no way then where the King is deceived for his Majesty to be relieved? That would be to put him in a worse condition than a subject."

*Lord Chancellor*, ... "The first question then is, whether this court upon an *English* bill may in any case decree letters patent to be delivered up and cancelled; and he was clear of opinion, that had the patent passed ever so regularly, that yet this court might have decreed it to be delivered up. Fraudulent contracts and bargains are properly relievable here; the precedents are common. ... (Emphasis in original.)

*Atty. Gen. v. Vernon*, 1 Vern. 370, 387-390, 23 Eng. Rep. 528, 535-536 (1685) (*Vernon II*). The patent was ordered delivered up and cancelled. Vernon in exchange received back his £7000, and separately £400 plus interest for the value of the lands Vernon had conveyed to the crown. Note that this sort of remedy -- the restoration of the status quo ante requiring that both parties re-convey to do justice --

would not be available by simply revoking the patent via the writ *scire facias*.

*Vernon II* stands for the proposition that a *scire facias* is not an adequate remedy to rescind a transaction for fraud where a patent is granted in an exchange for value and the fraud is in the exchange, and not in the patent. *Ibid.* *Vernon II* makes it abundantly clear that when a legal remedy is available, equity has no jurisdiction. Because *scire facias* actions provide a complete and adequate remedy at law for revoking a patent for invalidity, equity did not have jurisdiction to even try validity, let alone revoke a patent. Moreover, as noted above, the Chancellor's role in *scire facias* actions was that of a common law judge, not that of a judge in equity.

For the same reasons, equity today in the United States has no jurisdiction to try patent validity (without consent). *Scott v. Neely, supra*, at 109-110. To allow equity to try cases where there was an adequate remedy at law would be to violate the Seventh Amendment. *Ibid.* It is only a short leap to say that the same is true of Article II courts trying cases where there is an adequate remedy at law.

## CONCLUSION

In conclusion, from 1780, *scire facias* for repeal of patents for invalidity were tried to a jury at King's Bench.<sup>29</sup> Patent owners have a Seventh Amendment right to a trial by jury before their patents might be revoked for invalidity. Since IPR revoke patents for invalidity without a jury trial, IPR are unconstitutional.

Respectfully submitted,

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<sup>29</sup> It is also worth of note that validity was uniformly tried to a jury whether the action was for infringement, an injunction or revocation. In *Bramah v. Hardcastle*, 1 Carp. 168 (1789), an infringement case, validity was tried to a jury. Similarly, in *Rex v. Arkwright*, 1 Carp. P.C. 53, 1 WPC 64 (1785) a *scire facias* to repeal a patent and *Boulton and Watt v. Bull*, 1 Carp. P.C. 155 (1796) that began bill in equity. ("The bill was filed for an injunction to restrain the defendant from infringing the patent, and an injunction was obtained, that the question as to the validity of the patent might be tried at law.") *Boulton and Watt* confirms that equity courts did not try patent validity, but instead referred trial to the common law courts where juries were available. A temporary injunction issued on the presumption that the patent was valid. *See*, note 19, *supra*. *See*, also, Jones, William John. "An Introduction to Petty Bag Proceedings in the Reign of Elizabeth I." *California Law Review* (1963): 882-905, at 886-887 (legal disputes arising in equity were tried at King's Bench and to a jury).