

**INJUNCTIONS FOR PATENT INFRINGEMENT: HISTORICAL
EQUITY PRACTICE BETWEEN 1790–1882**

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ABSTRACT

In its 2006 decision in *eBay v. MercExchange*, the Supreme Court held that courts must use a “four-factor test historically employed by courts” based in a “long tradition of equity practice” before granting an injunction for patent infringement. Chief Justice John Roberts further claimed in a concurrence, from “the early 19th century, courts have granted injunctive relief upon a finding of infringement in the vast majority of patent cases.” Both of these historical claims are conventional wisdom among patent lawyers and judges today, but both are empirically unverified.

This Article tests these two historical claims with a database of 899 court opinions issued between 1790 and 1882 in which federal courts sat in equity in patent infringement lawsuits. The data challenges and confirms the conventional wisdom in *eBay* about historical equity practices. First, the *eBay* Court is wrong: there was no historical four-factor test in the “long tradition of equity practice.” In the 899 opinions, no judge applied a four-factor test in granting or denying an injunction. Second, Chief Justice Roberts is correct: courts did grant permanent injunctions as a remedy for patent infringement in a vast majority of cases. Courts awarded permanent injunctions in 91.2% of the cases in which a defendant infringed a valid patent. The Article concludes by explaining the doctrines applied by historical courts sitting in equity. It details how they applied the same equitable doctrines and principles in patent cases as those redressing continuing trespasses of real property, protecting patents in the same ways as other private property interests.

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I. INTRODUCTION

A significant debate in patent law today concerns what remedy a patent owner may receive when a court finds a defendant liable for patent infringement. As homeowners and other property owners, patent owners have long received an equitable remedy of an injunction to restrain continuing or willful infringement of their property rights.¹ This equitable remedy for patent infringement has been well established by statutes and court decisions reaching back to the early Republic.² In 1908, the Supreme Court observed that an injunctive remedy for

1. See Adam Mossoff, *Injunction Function: How and Why Courts Secure Property Rights in Patents*, 96 NOTRE DAME L. REV. 1581, 1594–99 (2021) (describing legal doctrine and economic function of injunctions for property rights in tangible assets and in inventions).

2. See Patent Act of 1836, § 17, Ch. 357, 5 Stat. 117, 124 (July 4, 1836) (providing that “courts shall have power . . . to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any inventor . . .”); see also Mossoff, *supra* note 1, at 1597–99 (summarizing early statutes and court decisions establishing the right of patent owners to obtain injunctions for infringements of their rights).

“trespasses and continuing wrongs” of a patent was so well established that “a citation of cases is unnecessary.”³

A century later, the Supreme Court once again addressed the nature of equitable remedies available to patent owners in *eBay Inc. v. MercExchange, L.L.C.*⁴ The *eBay* Court recognized that the modern patent statute recodified these longstanding statutory and judicial precedents without any alteration.⁵ Thus, it held that courts deciding the proper remedy for patent infringement today must use a “four-factor test historically employed by courts.”⁶ The *eBay* Court emphasized that this four-factor test was a “long tradition of equity practice.”⁷ In a concurring opinion, Chief Justice John Roberts further claimed that “[f]rom at least the early 19th century, courts have granted injunctive relief upon a finding of infringement in the vast majority of patent cases.”⁸

Both historical claims are conventional wisdom today in patent law. First, courts applied a traditional four-factor test for issuing injunctions for patent infringement. Second, courts awarded injunctions in a majority of cases since the early nineteenth century in which the defendant was found to infringe a valid patent. Both are empirically unverified claims. There has been no study of injunctive remedies issued by nineteenth-century courts for infringement of patents.

This article fills this lacuna in the judicial record and in the scholarship, presenting new data on federal courts issuing injunctions in the long tradition of equity practice in patent cases. It reports the results of a database compiled from the *Federal Cases* reporter in which plaintiffs sought an equitable remedy for patent infringement. *Federal Cases* is the official federal court reporter that compiled all the lower federal court decisions — district courts and circuit courts — published by private reporters between 1790–1880. This article is the first to explain exactly how federal courts ruled on bills in equity filed by patent owners seeking remedies for infringement of their property rights, such as permanent injunctions, preliminary injunctions, or an accounting.

3. *Continental Paper Bag Co. v. E. Paper Bag Co.*, 210 U.S. 405, 430 (1908).

4. 547 U.S. 388, 390 (2006).

5. *Id.* at 391–92 (“Nothing in the Patent Act indicates that Congress intended . . . a departure” from historical equity practice by courts.). The modern statutory provision authorizing injunctions for patent infringement mirrors the same language in the Patent Act of 1836. *Compare* 35 U.S.C. § 283 (“The several courts having jurisdiction of cases under this title may grant injunctions in accordance with the principles of equity to prevent the violation of any right secured by patent, on such terms as the court deems reasonable.”), *with* Patent Act of 1836, § 17 (“[C]ourts shall have power . . . to grant injunctions, according to the course and principles of courts of equity, to prevent the violation of the rights of any inventor as secured to him by any law of the United States, on such terms and conditions as said courts may deem reasonable . . .”).

6. *eBay*, 547 U.S. at 390.

7. *Id.* at 391 (quoting *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 320 (1982)).

8. *Id.* at 395 (Roberts, C.J., concurring).

This empirical study both challenges and confirms the conventional wisdom about injunctions found in *eBay* and in patent scholarship. First and foremost, the unanimous *eBay* opinion is wrong: there was no four-factor test in the “long tradition of equity practice” in patent cases. In the 899 opinions in *Federal Cases* by federal courts sitting in equity in lawsuits filed between 1790 and 1880, no judge applied a four-factor test for issuing an injunction, either for a permanent or a preliminary injunction. Second, Chief Justice Roberts is correct in his *eBay* concurrence: courts did grant permanent injunctions in a majority of these 899 cases as a remedy for infringement of a valid patent. Courts awarded permanent injunctions in 91% of the cases in which the defendant was found to infringe a patent that it failed to invalidate.⁹ Courts granted these injunctions by applying the same legal doctrines they applied when redressing continuing trespasses of real property, protecting patents as much as they protected real estate and other property interests.¹⁰

Today, the *eBay* four-factor test for issuing injunctions for patent infringement is hotly contested in both law and policy.¹¹ This article contributes to this debate by providing important empirical data on the doctrines used by courts in the “long tradition of equity practice” of issuing equitable remedies to patent owners for infringement of their property rights. It does not take a position in the policy debates, but it confirms as legal fact that *eBay* changed the law on equitable remedies for patent owners, and that patent owners previously received presumptive injunctions for continuing infringement of their property rights.¹²

In demonstrating that the *eBay* four-factor test was not a part of historical equity practice and that patent owners presumptively received injunctive remedies in a majority of cases, this article proceeds in four parts. First, it briefly describes the *eBay* decision and the legal

9. See *infra* Section III.C.

10. See, e.g., *Mann v. Bayliss*, 16 F. Cas. 635, 635 (C.C.N.D. Ohio 1876) (“[A patent owner] was just as much entitled to his right of property as a farmer to his wheat, or the fat which he put upon his animals.”); *Sloat v. Patton*, 22 F. Cas. 327, 327–30 (C.C.E.D. Pa. 1852) (No. 12,947) (“The invention set forth in letters patent belongs to the inventor as rightfully as the house he has built, or the coat he wears. . . . [H]e asks nothing in return for the contribution it makes to the general wealth and happiness, but that of security of enjoyment during a limited period, which the laws engage for all other property It would be a reproach to the judicial system if an ownership of this sort could be violated profitably or with impunity.”). Federal courts sitting in law made similar claims about securing property rights in patents. See, e.g., *Hovey v. Henry*, 12 F. Cas. 603, 604 (C.C.D. Mass. 1846) (No. 6,742) (“An inventor holds a property in his invention by as good a title as the farmer holds his farm and flock.”); *Davoll v. Brown*, 7 F. Cas. 197, 199 (C.C.D. Mass. 1845) (No. 3,662) (“[A] liberal construction is to be given to a patent, and inventors sustained, if practicable, . . . [as] only in this way can we protect intellectual property, the labors of the mind, productions and interests as much a man’s own, and as much the fruit of his honest industry, as the wheat he cultivates, or the flocks he rears.”).

11. See *infra* notes 14–17, and accompanying text.

12. See *infra* Part IV.

and policy debates, which establishes why this empirical study is necessary. Second, it details the database of 899 patent decisions by courts sitting in equity, presenting data on issuance rates of permanent injunctions and preliminary injunctions, as well as other empirical insights on this historical equity practice, such as information on the judges and jurisdictions, among other metrics. It reveals that no historical court applied a four-factor test for injunctions, confirming critiques by remedies scholars that *eBay* is without historical or legal justification.¹³ Third, it presents data about and describes the equitable doctrines applied by federal courts in assessing a patent owner's bill in equity seeking an injunction for patent infringement, demonstrating how courts assessed patents in similar ways to other property rights. Finally, the article concludes by identifying some of the limits of this empirical study.

II. A BRIEF SUMMARY OF *EBAY V. MERCEXCHANGE*

Much has been written about *eBay* in the almost twenty years since this decision was handed down by a unanimous Supreme Court. Legal scholars and economists have studied its impact on the issuance rates of injunctions,¹⁴ how lower courts have interpreted and applied the four-factor test,¹⁵ its impact on the licensing of patents,¹⁶ and other doctrinal and policy dimensions of the decision.¹⁷ This Part does not plod over this well-trodden ground, but it is necessary to briefly explain the *eBay* decision and the ensuing legal and policy controversy.

13. See, e.g., Douglas Laycock, *How Remedies Became a Field: A History*, 27 REV. LITIG. 161, 168 (2008) (stating that *eBay* is “a spectacular example of the confusion that can result from litigating a remedies issue without a remedies specialist”); Doug Rendleman, *The Trial Judge's Equitable Discretion Following eBay v. MercExchange*, 27 REV. LITIG. 63, 76 n.71 (2007) (“Remedies specialists had never heard of the four-point test.”).

14. See generally Kristina M.L. Acri, *Injunctive Relief in Patent Cases: the Impact of eBay*, 38 HARV. J. L. & TECH. 735 (2025) (identifying statistically significant reduction in courts granting injunctions under the *eBay* test for infringement of a valid patent between 2016–2022); Kirti Gupta & Jay P. Kesan, *Studying the Impact of eBay on Injunctive Relief in Patent Cases* 15 (Univ. Ill. Coll. L. Legal Stud., Rsch. Paper No. 17-03, 2016), <https://ssrn.com/abstract=2816701> [<https://perma.cc/5F3H-2B5P>] (identifying statistically significant reduction in courts granting injunctions under the *eBay* test for infringement of a valid patent between 2007–2012).

15. See, e.g., Ryan T. Holte, *The Misinterpretation of eBay v. MercExchange and Why: An Analysis of the Case History, Precedent, and Parties*, 18 CHAP. L. REV. 677, 682 (2015).

16. See Kristen Jackobsen Osenga, *The Loss of Injunctions under eBay: Evidence of the Negative Impact on the Innovation Economy*, HUDSON INST. (Feb. 28, 2024), <https://www.hudson.org/regulation/loss-injunctions-under-ebay-evidence-negative-impact-innovation-economy> [<https://perma.cc/N774-BRCG>].

17. See, e.g., Tomás Gómez-Arostegui & Sean Bottomley, *The Traditional Burdens for Final Injunctions in Patent Cases c.1789 and Some Modern Implications*, 71 CASE W. RES. L. REV. 403 (2020) (explaining that a finding of patent infringement by courts was sufficient for proving irreparable injury); Mark P. Gergen, John M. Golden & Henry E. Smith, *The Supreme Court's Accidental Revolution? The Test for Permanent Injunctions*, 112 COLUM. L. REV. 203 (2012) (explaining that the four-factor test is a doctrinal change in issuing injunctions).

The question in *eBay* was the proper legal test for issuing an injunction after finding continuing or willful infringement of a patent. At the time, the Court of Appeals for the Federal Circuit had developed what it called a “general rule” that injunctions should presumptively issue on a finding of infringement of a valid patent.¹⁸ In this case, *eBay* infringed a patent owned by *MercExchange*, and it challenged this general rule as contradicting the nature of an equitable remedy as such. It argued that injunctions historically were issued in England and in the early United States by equity courts that applied general standards, as distinguished from law courts that applied rules in issuing damages. *eBay* and its supporting amici asserted that a context-specific, multi-factor inquiry should be used to determine whether to grant or deny an injunction in cases of patent infringement.

In a brief opinion, a unanimous Court agreed with *eBay*’s argument, claiming historical practices and precedent rejected a “categorical rule” in determining whether an injunction should be granted for any violation of a private right, whether a patent or other legal entitlement.¹⁹ The Court stated at the outset of the opinion: “Ordinarily, a federal court . . . applies the four-factor test historically employed by courts of equity.”²⁰ This four-factor test was: (1) the plaintiff must suffer an irreparable injury, (2) a legal remedy, such as damages, must be inadequate, (3) the balance of the hardships between the defendant and plaintiff must weigh in favor of the plaintiff’s request for an equitable remedy, and (4) an injunction must not be against the public interest.²¹ Strangely, the Court cited only two late-twentieth-century cases as authority for this proposition, one of which was for a preliminary injunction, when it identified this historical four-factor test for a permanent injunction.²² The Court also made it clear that this allegedly historical four-factor test was a burden that the plaintiff patent owner must meet: “According to well-established principles of equity, a plaintiff seeking a permanent injunction must satisfy a four-factor test”²³

The prevailing conventional wisdom, at least among patent law scholars, is that *eBay* is right.²⁴ Patent scholars accept that courts historically applied a four-factor test for issuing permanent injunctions,

18. *eBay*, 547 U.S. at 393–94 (citing *MercExchange, L.L.C. v. eBay, Inc.*, 401 F.3d 1323, 1338 (Fed. Cir. 2005)). All of the information in this paragraph is in the *eBay* Court’s majority opinion.

19. *Id.*

20. *Id.* at 390.

21. *Id.* at 391 (first citing *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 311–13 (1982); and then citing *Amoco Production Co. v. Village of Gambell*, 480 U.S. 531, 542 (1987)).

22. *Id.*

23. *Id.*

24. Some remedies and patent scholars have critiqued the *eBay* decision on historical, doctrinal, and policy grounds, see *supra* notes 13, 17 (citing sources).

and this claim is always supported by a citation to *eBay*.²⁵ Even in the two concurrences in *eBay*, neither Chief Justice Roberts nor Justice Kennedy contested the claim in the majority opinion that the four-factor test represented “historical equity practices” in all other civil cases in which plaintiffs sought injunctions. Notably, no Justice in *eBay* cites a single nineteenth-century case in support of the many historical and legal claims made in the three opinions.

The absence of any cases or other legal authority earlier than 1982 in a unanimous opinion setting forth a four-factor test as a longstanding, historical, and well-established equitable doctrine is a glaring omission.²⁶ It is tantamount to a Justice claiming to apply the original public meaning of the Constitution and not citing a single authoritative legal source earlier than 1982.²⁷ In the almost twenty years since *eBay*, this

25. See, e.g., Paul R. Gugliuzza, *The Federal Circuit as a Federal Court*, 54 WM. & MARY L. REV. 1791, 1818 (2013) (“The Supreme Court had already rejected patent law exceptionalism in cases addressing . . . remedies for patent infringement . . .”) (citing *eBay*, 547 U.S. at 391–92); David Olson & Stefania Fusco, *Rules Versus Standards: Competing Notions of Inconsistency Robustness in Patent Law*, 64 ALA. L. REV. 647, 674 (2013) (“The Supreme Court has developed a substantial body of law on injunctions over the course of its existence. . . . [T]he Court applies the same equitable, four-factor test regardless of the type of law at issue in a case.”); Lily Lim & Sarah E. Craven, *Injunctions Enjoined: Remedies Restructured*, 25 SANTA CLARA COMPUT. & HIGH TECH. L.J. 787, 795, 797 (2009) (“The Supreme Court . . . explained that the historical four-factor equitable test for permanent injunctions applies equally to the Patent Act as in other contexts. . . . [T]he Court simply wished to bring the Federal Circuit in line with the injunctive standard governing other cases.”); Sheri J. Engelken, *Opening the Door to Efficient Infringement: eBay, Inc. v. MercExchange, L.L.C.*, 2 AKRON INTELL. PROP. J. 57, 57 (2008) (“Justice Thomas’ opinion for the Supreme Court overturning the Federal Circuit’s general rule . . . begins and ends with traditional equitable principles and the well-established four-factor test for the grant of permanent injunctive relief.”); Michael W. Carroll, *Patent Injunctions and the Problem of Uniformity Cost*, 13 MICH. TELECOMMS. & TECH. L. REV. 421, 426–27 (2007) (quoting *eBay*’s four-factor test and its invocation of “traditional principles of equity” and stating that this holding was “[a]s simple and as expected as [it] was”).

26. See *supra* note 22 and accompanying text (identifying the only two court decisions from 1987 and 1982, respectively, cited by *eBay* in support of its historical four-factor test).

27. Cf. *Bilski v. Kappos*, 561 U.S. 593, 613 (2010) (Stevens, J., concurring) (“For centuries, it was considered well established that a series of steps for conducting business was not, in itself, patentable.”). Justice Stevens further claimed that “[d]uring the first years of the patent system, no patents were issued on methods of doing business.” *Id.* at 635 (citing Edward C. Walterscheid, *To Promote the Progress of Science and Useful Arts: The Background and Origin of the Intellectual Property Clause of the United States Constitution*, 2 J. INTELL. PROP. L. 173–76 (1994); Malla Pollack, *The Multiple Unconstitutionality of Business Method Patents: Common Sense, Congressional Consideration, and Constitutional History*, 28 RUTGERS COMPUT. & TECH. L.J. 61, 107–08 (2002)). Despite these historical claims in an extensive historical overview of the U.S. patent system, Justice Stevens does not quote or cite a single judge, congressperson, or legal treatise from the early Republic stating that business methods are not patentable. The Walterscheid and Pollack articles cited by Justice Stevens are similarly bereft of any such statements about the unpatentability of business methods. They could not, and the reason is simple: They are wrong. See Michael Risch, *America’s First Patents*, 64 FLA. L. REV. 1279, 1279, 1320–1324 (2012) (reporting from empirical study of all available patents granted between 1790 and the middle of 1839 that 7.16% of all process patents were for business methods); see also Adam Mossoff, *Business Methods Patents: A*

void has not been filled in numerous articles about *eBay* and patent injunctions. Patent scholars simply take *eBay* at its word, citing *eBay* as sufficient authority for this historical claim that a four-factor test was historically employed by courts sitting in equity.²⁸

Yet an omission of early historical cases in support of the four-factor test is not by itself a refutation of the *eBay* holding that there was a longstanding, historical four-factor test in equity for issuing injunctions. *eBay* critics have also lacked the historical data to confirm if it is incorrect. The remedies scholars who stridently critique *eBay* for making up the four-factor test out of whole cloth could be mistaken.²⁹ It is conceivable that there was a special, four-factor test employed by federal courts in only patent cases in deciding whether to issue injunctions for patent infringement, as opposed to other types of legal entitlements. Scholars who invoke Chief Justice Roberts' claim that courts traditionally issued injunctions for infringement of a valid patent in a majority of cases also lack empirical verification. After almost twenty years since *eBay*, this article provides this important data that indeed confirms *eBay* is historically and legally wrong, and that Chief Justice Roberts is correct that injunctions were issued in a majority of patent cases.

III. DATA ON EQUITABLE REMEDIES IN NINETEENTH-CENTURY PATENT CASES

Similar to the *United States* reporter for Supreme Court decisions in the eighteenth and nineteenth centuries and the *English Reports* for English court decisions, the *Federal Cases* reporter collates the federal court opinions by district courts or circuit courts prepared by the private court reporters working in the eighteenth and nineteenth centuries. *Federal Cases* collects the extant lower federal court opinions issued between 1790 and 1880, although it has some decisions in its thirty-two volumes that go a few years beyond 1880; for example, there are several patent decisions in the reporter from 1881 and 1882.³⁰

In the *Federal Cases* reporter, there are 1,458 total patent cases. I reread all the opinions.³¹ For this study, I collected all opinions in which

Key Part of American Patents from 1790 to Today, LOCKE'S NOTEBOOK BLOG (Dec. 22, 2020), <https://www.property-rtis.org/post/business-methods-patents-a-key-part-of-american-patents-from-1790-to-today> [<https://perma.cc/M4XA-4FJX>].

28. See *supra* note 25 (citing sources).

29. See *supra* note 13 (citing sources).

30. See, e.g., *Green v. Gardner*, 10 F. Cas. 1109 (D.N.J. 1882) (No. 5,758a); *Franz & Pope Knitting-Mach. Co. v. Lamb Knitting-Mach. Mfg. Co.*, 9 F. Cas. 721 (C.C.E.D. Pa. 1881) (No. 5,061).

31. I first read these opinions in a prior empirical project in which I tested and then critiqued the Jeffersonian Story of Patent Law, i.e., modern scholars and judges relying solely on Thomas Jefferson to support a historical claim that patents were viewed in the early

a lower federal court sat in equity in adjudicating a bill submitted by a petitioner seeking a preliminary injunction, a permanent injunction, an accounting, or a combination of a permanent injunction and an accounting. There are also a smattering of other equitable cases, such as decisions on motions for contempt given an infringer's continuing acts infringing a patent despite a prior injunction, motions for modification of accounting decrees, and so on. The result is a database of 899 total patent cases in which federal courts sat in equity arising from a patent owner's initial allegation of patent infringement. This Part explicates this database.

A. Primer on Law and Equity

Before discussing the data, it's first necessary to describe the institutional details of federal courts sitting in equity in the late eighteenth and nineteenth centuries. Today, lawyers speak of equitable remedies (injunctions) or legal remedies (damages), as well as equitable doctrines, such as defenses like laches, estoppel, and unclean hands. But equity and law once were more than remedies or doctrines; these were distinct courts within the Anglo-American legal system that developed and applied these respective doctrines and remedies.³² Following the English judicial system, the Constitution authorized federal courts to sit in both equity and law,³³ and this they did for the first 148 years of the federal judiciary. Before the merger of law and equity in the Federal Rules of Civil Procedure in 1938,³⁴ federal courts sitting in equity received bills for patent infringement in which they adjudicated the claims and issued equitable remedies.³⁵

American Republic as monopolies, not property rights. See generally Adam Mossoff, *Who Cares What Thomas Jefferson Thought About Patents? Reevaluating the Patent "Privilege" in Historical Context*, 92 CORNELL L. REV. 953 (2007). I possess these opinions in hardcopy format in file folders organized by volume number after photocopying them from the thirty volumes of the *Federal Cases* reporter. I used the original reporter monographs in creating my collection because electronic databases are sometimes missing materials in opinions, whether due to mistake in the scanning process or by omission.

32. See JOHN H. LANGBEIN, RENÉE LETTOW LERNER & BRUCE P. SMITH, *HISTORY OF THE COMMON LAW: THE DEVELOPMENT OF ANGLO-AMERICAN LEGAL INSTITUTIONS* 85–124, 271–344 (2009); J.H. BAKER, *AN INTRODUCTION TO ENGLISH LEGAL HISTORY* 97–111 (4th ed. 2002).

33. See CONST. art. III, § 2 ("The judicial Power shall extend to all Cases, in Law and Equity . . .").

34. See FED. R. CIV. P. 1 (1938) ("These rules govern the procedure in the United States district courts in all suits of a civil nature whether cognizable as cases at law or in equity . . ."); *id.* at 2 ("There shall be one form of action to be known as 'civil action.'").

35. See *Potter v. Dixon*, 19 F. Cas. 1145, 1145, 1147 (C.C.S.D.N.Y. 1863) (No. 11,325) ("It has been frequently decided that the power conferred on the United States circuit court to entertain bills in equity in controversies arising under the patent act, is a general equity power, and carries with it all the incidents belonging to that species of jurisdiction."); *Nevins v. Johnson*, 18 F. Cas. 28, 29 (C.C.S.D.N.Y. 1853) (No. 10,136) (recognizing that federal courts had

Before the 1938 merger of law and equity, there were different procedures, substantive doctrines, and different terms of art in equity courts and law courts. A “plaintiff” filed a “writ” in a court at law, but a “petitioner” or “complainant” submitted a “bill” in a court in equity.³⁶ Following English practice, equity courts acted directly against a person, as the Court of Chancery represented the Crown in issuing commands to his or her subjects.³⁷ Thus the core equitable remedy was a “decree” of a perpetual or permanent “injunction,” a practice followed by federal courts sitting in equity before 1938.³⁸ Legal courts determined rights and duties arising from a singular or “fugitive” act by the defendant, such as a single innocent trespass, and thus the core legal remedy was damages.³⁹

But these were not categorical differences, as equity courts awarded remuneration by an accounting, which disgorged an unjust enrichment, such as the profits earned by someone infringing a patent through commercial sales.⁴⁰ Law courts also had some injunctive-type remedies, such as a writ of replevin, which resulted in a court ordering

general jurisdiction to issue injunctions in patent cases and that Congress enacted a patent statute in 1819 to provide specifically for equitable jurisdiction only “to remove doubts as to the authority of the courts of the United States to employ that process in patent cases to the same extent it is used in courts of general jurisdiction.”); *Motte v. Bennett*, 17 F. Cas. 909, 915 (C.C.D.S.C. 1849) (No. 9,884) (“The federal courts in this country have . . . under the patent laws of congress . . . protected the right by injunction.”) (citing *Morse v. Reed*, 17 F. Cas. 873 (C.C.D.N.Y. 1796) (No. 9860)).

36. *See, e.g.*, *Washing Mach. Co. v. Earle*, 29 F. Cas. 332, 332 (C.C.E.D. Pa. 1861) (No. 17,219) (“This was a bill for injunction . . .”); *Waterbury Brass Co. v. New York & B. Brass Co.*, 29 F. Cas. 395, 395 (C.C.S.D.N.Y. 1853) (No. 17,256) (“This was an action on the case . . . This is a suit brought by the plaintiff . . . to recover damages of the defendants for infringing upon the rights secured by that patent.”).

37. *See* LANGBEIN ET AL., *supra* note 32, at 286. Some early federal courts apparently mimicked English legal institutions to the degree that they issued injunctions in the name of the President, the U.S. analog to the English Crown, although it is unclear if this was standard practice or not. *See, e.g.*, *Bussey v. Wager*, 4 F. Cas. 886, 888 (C.C.N.D.N.Y. 1876) (No. 2,231) (publishing injunction order from “The President of the United States of America” to the defendants to “desist and refrain” from continuing infringement of the patent).

38. *See* 2 JOSEPH STORY, COMMENTARIES ON EQUITY JURISPRUDENCE, AS ADMINISTERED IN ENGLAND AND AMERICA 237 (Melville M. Bigelow ed., 13th ed. 1886) (“[T]he plaintiff could at law have no preventative remedy which should restrain the future uses of his invention . . . injuriously to his title and interests. And it is this preventative remedy which constitutes the peculiar feature of Equity Jurisprudence and enables it to accomplish the great purposes of justice.”); *see, e.g.*, *Henderson v. Cleveland Coop. Stove Co.*, 11 F. Cas. 1079, 1083 (C.C.N.D. Ohio 1877) (No. 6,351) (“The usual decree will be entered for an injunction . . .”).

39. STORY, *supra* 38, at 229 (“[I]t has been said that every common trespass is not a foundation for an injunction, where it is only contingent, fugitive, or temporary.”); *id.* at 236 (“It is quite plain that if no other remedy could be given in cases of patents and copyrights than an action at law for damages, the inventor or author might be ruined by the necessity of perpetual litigation, without ever being able to have a final establishment of his rights.”).

40. *See id.* at 237 (“[I]n most cases of this sort [in which an injunction is sought to restrain continuing infringement] the bill usually seeks an account . . . of the profits which have arisen from the use of the invention from the persons who have pirated the same.”).

the return of personal property converted by a defendant.⁴¹ Legal practice was complicated, which explains in part the impetus for the merger of law and equity, which began in the states in the nineteenth century and occurred in the federal courts in 1938.⁴² Justice Joseph Story, one of the architects of U.S. patent law given his many opinions in nineteenth-century patent cases,⁴³ also authored multi-volume treatises on equity jurisprudence and equitable procedures (among many other achievements).⁴⁴

B. The Coding of the Equity Cases

This brief walk down memory lane from a first-year law school course in civil procedure or an upper-level course in remedies is necessary for two reasons concerning the coding and presentation of the dataset. First, as a substantive matter, one must remember that the filing of the legal action before 1938 determined the remedy; thus, if a petitioner filed a bill in federal court in 1848 alleging patent infringement, this person sought an injunction, an accounting, or both.⁴⁵ The 899 court opinions in the *Federal Cases* reporter are not opinions analyzing only a motion for an injunction after a hearing on infringement liability and patent validity challenges, as they would be today. Rather, these are complete judicial opinions addressing liability, patent validity, and the remedy, as these were inextricably linked in an equity court adjudicating a patent dispute.⁴⁶

This is important because it means that a court sitting in equity would sometimes deny an injunction given a finding of noninfringement or the defendant succeeded in invalidating the patent. This would be no different than a court hearing a writ filed in law denying damages given a finding of noninfringement or the defendant successfully proving the patent is invalid. The total number of denials of injunctions is

41. See, e.g., *Anderson v. Gouldberg*, 53 N.W. 636, 637 (Minn. 1892) (“[T]he only question is whether bare possession of property, though wrongfully obtained, is sufficient title to enable the party enjoying it to maintain replevin against a mere stranger, who takes it from him. We had supposed that this was settled in the affirmative as long ago, at least, as the early case of *Armory v. Delamirie* . . .”).

42. See Thomas O. Main, *Traditional Equity and Contemporary Procedure*, 78 WASH. L. REV. 429, 431, 464–76 (2003) (summarizing the reform movement in the nineteenth century that arose in response to the complexities of the law and equity court pleadings and leading to the merger of law and equity in the state and federal court systems).

43. See Frank D. Prager, *The Influence of Mr. Justice Story on American Patent Law*, 5 AM. J. LEGAL HIST. 254, 254 (1961).

44. See generally STORY, *supra* note 38.

45. There were other equitable remedies, but this empirical study is limited to only these remedies given that these were the principal equitable remedies for patent infringement in the nineteenth century, just as an injunction is the principal equitable remedy today.

46. See, e.g., *Union Mfg. Co. v. Lounsbury*, 24 F. Cas. 587, 588 (C.C.D. Conn. 1862) (No. 14,368) (“If [the patent] is valid, and the respondents infringe, then they are liable to be enjoined. I have no doubt on this question.”).

thus higher than the injunctions that were denied after a finding of infringement of a valid patent. (See Table 1, below) To ensure that we are properly testing the claim by Chief Justice Roberts that patent owners often received an injunction on a finding of infringement of a valid patent, we have to filter out the decisions in which courts denied injunctive remedies given a predicate finding of no liability (noninfringement or invalidity).

Second, to avoid awkwardness caused by antiquated terminology, the equity cases presented and discussed in this article are framed in modern terms. This is admittedly an anachronism. But this article is an empirical study testing two historical claims in *eBay*. It is not a work of legal history in which anachronisms undercut the veracity of the historical analysis. Thus, I will use the universal terms today of plaintiff, defendant, complaint, and so on.

More generally, in reading the 899 court opinions, I identified the relief sought, the relief granted, and the analysis by the court in reaching its decision, such as the specific factors of analysis. I am using “factors” here only in a loose sense to refer to doctrinal requirements, such as challenges to the validity of a plaintiff’s patent, or to the facts that are relevant in finding a defendant liable for infringement of a patent, such as comparing the patent to the defendant’s product or process. In other words, these were always *implicit* factors, as equity courts did not apply explicit multi-factor tests like the multi-factor tests that exist today and are applied by modern courts.⁴⁷ I also identified the year, district, judge, the legal status of the plaintiff (inventor, assignee, or licensee), and the commercial status of the plaintiff (licensor, manufacturer, or both). Whenever an opinion did not provide the relevant information or addressed procedural matters or sought relief other than injunctions or accounting, I coded this as an “N/A,” which is reported as “Unclear or Other” in the tables and charts below, given that the decision was unclear as to the ultimate remedy sought by the plaintiff.

What follows below are tables and charts presenting this data with some additional explanations. It first presents the overall data of decisions by courts sitting in equity in patent cases in the *Federal Cases* reporter. Second, it discusses the null result for *eBay*’s claim of a traditional or historical four-factor test for injunctions. Third, it presents the data confirming the historical claim by Chief Justice Roberts that a majority of patent owners received injunctions when a court found the defendant liable for infringing a valid patent (a patent that survived validity challenges, if argued). Lastly, it presents some interesting additional data from the dataset on jurisdictions, judges and the rates of

47. Cf. Gergen et al., *supra* note 17, at 207 (observing that the “*eBay* test does feature factors that courts have traditionally considered in deciding whether to grant injunctive relief” but the *eBay* Court’s formulation of the four-factor test itself was nonetheless “transformative”).

opinions over the time span of patent cases in the *Federal Cases* reporter (1790–1882).

C. Overall Data on Equitable Remedies

If one counts only total decisions by courts granting or denying injunctions in the *Federal Cases* reporter, this will include the two confounding variables of either patent owners failing to prove infringement or a defendant proving patent invalidity. Both are necessary predicates that preempt a patent owner from receiving an equitable remedy. For example, the total number of complaints by patent owners seeking permanent injunctions is 604, and courts granted permanent injunctions in 404 decisions. This yields a total grant rate for all court decisions of 66.9%, a denial rate of 32.1%, and unclear or other decisions of 1.0%. But the total grant rate for permanent injunctions when courts found *infringement* of a *valid patent* was 91.2%, denying an injunction in 7.7% of decisions, and unclear or other decisions of 1.1% (Table 3, below).

In sum, given the institutional separation between courts sitting in equity and courts at law, most courts sitting in equity denied patent owners their requested relief of a permanent injunction on grounds other than equitable doctrines or defenses, such as laches or balance of the hardship. Rather, most of these denials were for the same reason that patent owners would have been denied damages if they had proceeded instead with trials in a court at law — plaintiff’s failure to prove infringement or defendant’s success in proving patent invalidity. Again, before 1938, federal courts sitting in equity held full hearings on both liability and remedy.⁴⁸ Chief Justice Roberts thus rightly limited his historical claim in his *eBay* concurrence to patent owners receiving injunctions after proving infringement of a valid patent, because the *eBay* four-factor test is only applied today after infringement of a valid patent has been established in the liability hearing before the court.

Table 1: Overall Requests for Equitable Remedies

Total Injunctions Requested	Preliminary Injunctions Requested	Permanent Injunctions Requested	Accounting Requested	Unclear or Other Matters
808	204	604	30	61

48. See *infra* Section IV.A–B.

Table 2: Overall Outcomes for Injunctions

Preliminary Injunctions Granted	Preliminary Injunctions Denied	Permanent Injunctions Granted	Permanent Injunctions Denied
119	84	404	194

An overwhelming majority (91.2%) of patent owners seeking a permanent injunction received this remedy after a court found infringement of a patent that survived any validity challenges by the defendant (Table 3, below). This data confirms the conventional wisdom in Chief Justice Roberts' concurrence in *eBay*. In fact, many of these court opinions typically end with the court stating that it is granting "the usual decree" by awarding a permanent injunction, an accounting, or both if requested by the plaintiff.⁴⁹

49. *Hussey v. Bradley*, 12 F. Cas. 1053, 1059 (C.C.N.D.N.Y. 1863) (No. 6,946) ("[T]here must be the usual decree for a permanent injunction and an account of the profits received by them in consequence of their infringement of the plaintiff's patents."); *see also* *Howes v. McNeal*, 12 F. Cas. 715, 724 (C.C.N.D.N.Y. 1878) (No. 6,789) (concluding "there must be the usual decree for the plaintiffs for an injunction"); *Henderson v. Cleveland Coop. Stove Co.*, 11 F. Cas. 1079, 1083 (C.C.N.D. Ohio 1877) (No. 6,351) ("The usual decree will be entered for an injunction . . ."); *New York Rubber Co. v. Chaskel*, 18 F. Cas. 159, 159 (C.C.S.D.N.Y. 1876) (No. 10,215) ("The complainant is therefore entitled to a decree in its favor in the usual form for a perpetual injunction and for an account . . ."); *Bachelder v. Moulton*, 2 F. Cas. 307, 310 (C.C.S.D.N.Y. 1873) (No. 706) ("The plaintiff's title and the validity of his claims are free of doubt, and have been established, and the infringement by the defendants' machine is clear. An injunction must issue on all the claims."); *Potter v. Holland*, 19 F. Cas. 1160, 1165–66 (C.C.D. Conn. 1858) (No. 11,330) ("The evidence to support the plaintiff's rights are, the issuing of the patents; the quiet enjoyment under them, for a considerable time; several judgments at law, as well as decrees in equity, in which parties have already been enjoined With this view of the case, an injunction must issue, as prayed for."); *Motte v. Bennett*, 17 F. Cas. 909, 916 (C.C.D.S.C. 1849) (No. 9,884) ("[Plaintiff] comes before the court . . . with a patent granted in the usual form . . . which . . . the court must consider as conclusive of title. This and the other requisites of possession and use [along with defendant lacking adequate validity challenges] . . . we are left without any alternative . . . except to award against [defendant] a perpetual injunction."); *Morse v. Reed*, 17 F. Cas. 873, 873 (C.C.D.N.Y. 1796) (No. 9,860) (Opinion not available in *Federal Cases* reporter, but headnote states that "in a suit . . . for infringement of a patent, the circuit court will also grant a perpetual injunction.").

Table 3: Court Decisions Granting Permanent Injunctions for Infringement of a Valid Patent

	Court Decisions	%
Granted	404	91.2%
Denied	34	7.7%
Unclear	5	1.1%

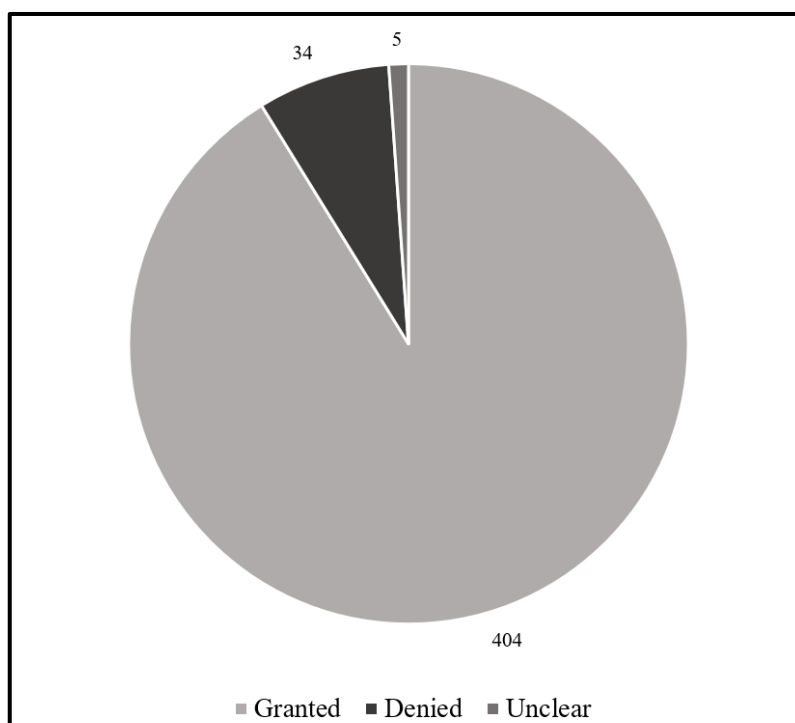


Figure 1: Court Decisions Granting Injunctions for Infringement of a Valid Patent

The database also tracked judges, the specific courts in which the complaints were filed, and the years of the court decisions. Surprisingly, given his preeminence in U.S. patent law,⁵⁰ Justice Story was not in the top twenty, although I added him to the table given his justly earned legal fame in patent law. The following graphs and table present some of this additional data.

50. See *supra* note 43.

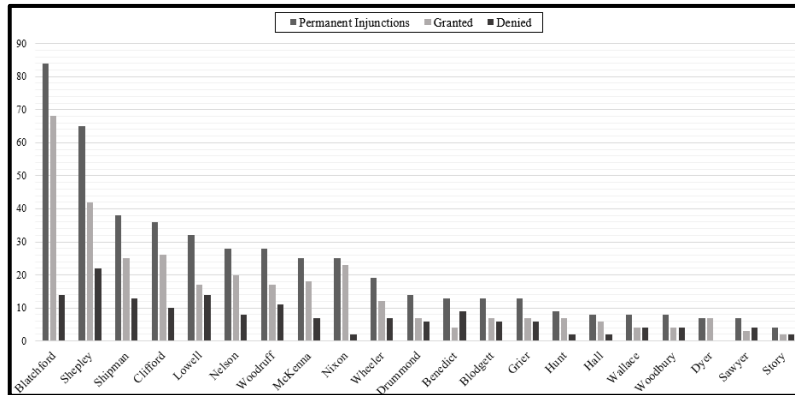


Figure 2: Permanent Injunctions from District Judges and Circuit Justices with the Most Patent Cases in Equity (Top 20 + Circuit Justice Story)

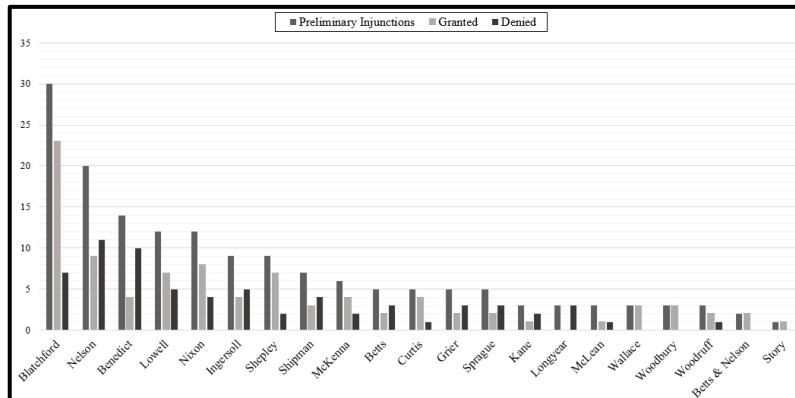


Figure 3: Preliminary Injunctions from District Judges and Circuit Justices with the Most Patent Cases in Equity (Top 20 + Circuit Justice Story)

At first blush, the trend among the judges and circuit justices sitting in equity who heard the most cases was to grant more requests than to deny, with District Judge Charles Benedict the only clearly consistent outlier. Judge Benedict denied in greater numbers than granting both preliminary injunctions and permanent injunctions. Also, Figures 2 and 3 suggest that Judge (and later Justice) Samuel Blatchford should be added to the Pantheon along with Justice Story of nineteenth-century jurists who contributed significantly to the development of U.S. patent law in the first 100 years of the patent system. In fact, Judge Blatchford was recognized as such by his contemporaries. In 1879, District Judge

Henry Blodgett referred to then-Judge Blatchford as one “who stands pre-eminent as an expounder of patent law in this country.”⁵¹ There is much here for historians to further mine about the jurisprudence of specific judges or the influences of political ideology on a judge’s approach to patent law,⁵² but this is beyond the scope of this article.

Table 4: Equitable Relief Sought and Grants/Denials of Preliminary and Permanent Injunctions by Jurisdiction

Court	Preliminary Injunctions	Permanent Injunctions	Preliminary Injunctions Granted	Preliminary Injunctions Denied	Permanent Injunctions Granted	Permanent Injunctions Denied
C.C.D. N.Y.		3			1	2
C.C.E.D. N.Y.	15	12	4	11	5	7
C.C.N.D. N.Y.	16	53	12	4	35	18
C.C.S.D. N.Y.	60	145	34	26	105	37
D.C.S.D. N.Y.	1	1	1		1	
D.S.D. N.Y.	1	1		1		1
C.C.D. Mass.	31	133	21	10	81	50
D.C.D. Mass.	1			1		
C.C.E.D. Wis.		9			8	1
C.C.W.D. Wis.	1			1		
D. Wis.		1			1	
D.W.D. Wis.		1				1
C.C.D. Ohio	5	4	3	1	2	2
C.C.N.D. Ohio	2	8	2		7	1
C.C.S.D. Ohio	3	15	1	2	13	2
C.C.D. Pa.	1	1	1			1
C.C.E.D. Pa.	17	34	11	6	24	10
C.C.W.D. Pa.	3	11	1	2	7	4
D. Pa.	1		1			
C.C.E.D. Mich.	3	5		3	4	1
C.C.W.D. Mich.		1			1	
C.C.E.D. Mo.	2	3		2	2	1
C.C.W.D. Mo.						
D.C.D. Conn.		1			1	

51. *Irwin v. McRoberts*, 13 F. Cas. 124, 125 (C.C.N.D. Ill. 1879) (No. 7,085).

52. See Adam Mossoff, *O’Reilly v. Morse and Claiming a “Principle” in Antebellum Era Patent Law*, 71 CASE W. RES. L. REV. 735, 768–75 (2020) (describing how Chief Justice Roger Taney’s commitment to the political ideology of Jacksonian Democracy led him to misconstrue patent doctrines in his judicial opinions).

C.C.D. Conn.	8	35	5	3	21	14
C.C.D. Del.		1				1
C.C.D. Ind.		2			2	
C.C.D. Kan.		1			1	
C.C.D. Ky.		2			1	1
C.C.D. La.	1	4	1		3	1
C.C.D. Md.	1	10	1		8	2
C.C.D. Me.	1	6	1		5	1
C.C.D. Minn.	2	6	1	1	5	1
C.C.D. N.H.	1	4	1			4
C.C.D. N.J.	17	32	11	6	27	5
C.C.D. R.I.	2	9	1	1	7	2
C.C.D. S.C.		1			1	
C.C.D. Vt.	1	5		1	3	2
C.C.D. W.Va.	1		1			
C.C.E.D. Tex.		1				1
C.C.E.D. Va.	1			1		
C.C.N.D. Ill.	4	30	3	1	16	13
C.C.S.D. Ill.		2			2	
D.C. Supreme Court		1				1
C.C.D. Cal.		9			4	5
S.C. D.C.	1		1			
Blank		1				1
Totals	204	604	119	84	404	194

D. Court Decisions Applying the “Historical” Four-Factor Test in eBay

Remedies scholars reacted negatively to the *eBay* decision. They claimed there was no four-factor test in “well-established” or “traditional practices in equity” that was applied by courts in issuing permanent injunctions.⁵³ The database confirms their critiques. In fact, no court opinion in the *Federal Cases* reporter applied a four-factor test in analyzing requests for either permanent injunctions or preliminary injunctions; the analyses applied by courts followed traditional equitable inquiries in securing property rights against continuing or willful infringement, as described in Part IV.

Some remedies scholars believe that the *eBay* Court was confused by the four-factor test long used for issuing *preliminary* injunctions.⁵⁴ This four-factor test has been used in patent cases reaching back many

53. See *supra* note 13 (citing critiques).

54. See DOUGLAS LAYCOCK, MODERN AMERICAN REMEDIES: CASES AND MATERIALS 444 (4th ed. 2010) (observing that remedies scholars believe that “the Court tried to transfer to permanent injunctions in *eBay*” the “traditional” four-factor test for preliminary injunctions).

decades.⁵⁵ But this study also confirms that even the “traditional” four-factor test for preliminary injunctions is of relatively modern origin. Again, no court applied a four-factor test in issuing preliminary injunctions in adjudicating any patent complaint between 1790 and 1882.

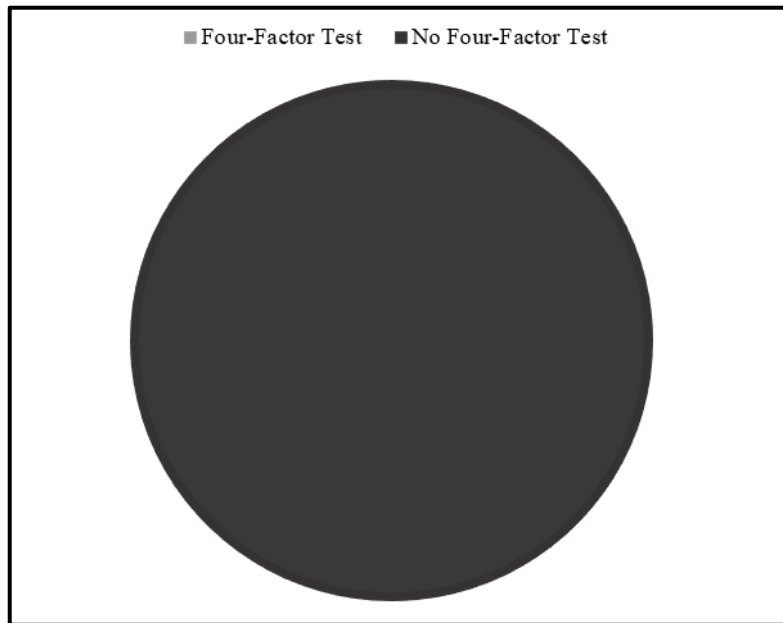


Figure 4: Historical Court Decisions Applying the Four-Factor Test in *eBay*

IV. THE HISTORICAL EQUITY PRACTICE IN ISSUING OR DENYING INJUNCTIONS

As demonstrated in Part III, the conventional wisdom is correct in that patent owners historically received injunctions in a vast majority of court cases after proving infringement of a valid patent. Even more significantly, *eBay* is wrong. There was no historical four-factor test. The *eBay* Court claimed that “well-established principles of equity” plainly established that a “plaintiff seeking a permanent injunction must satisfy a four-factor test.”⁵⁶ It stressed that this four-factor test was “historically employed by courts” in a “long tradition of equity

55. See, e.g., *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343, 1350 (Fed. Cir. 2001) (citing *Reebok Int'l Ltd. v. J. Baker, Inc.*, 32 F.3d 1552, 1555 (Fed. Cir. 1994)); *Hybritech v. Abbott Lab's*, 849 F.2d 1446, 1451 (Fed. Cir. 1988) (citing *T.J. Smith & Nephew Ltd. v. Consol. Med. Equip., Inc.*, 821 F.2d 646, 647 (Fed. Cir. 1987)).

56. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391 (2006).

practice” (citing only two court decisions from the 1980s).⁵⁷ The history and tradition of federal courts sitting in equity in deciding patent cases is starkly different: no federal court sitting in equity in the 899 opinions in the *Federal Cases* reporter used the *eBay* four-factor test in assessing a patent owner’s request for an injunction — either a permanent injunction or even a preliminary injunction.

This data, as significant as it is in laying to rest *eBay*’s alleged historical authority for its holding, does not tell us how courts adjudicated a plaintiff’s complaint seeking an injunction against a defendant accused of infringing a patent. The positive story of what did occur is just as important as confirming the negative story of what did not occur. This is important if only because some professors defend the *eBay* four-factor test by acknowledging that, while the *format* of the four factors may not have been used in historical court decisions, the *substance* of the four-factor test does represent classic principles of equity. Mark Lemley states that, “[e]ven accepting the criticism that the Court cobbled together the four-factor test . . . it certainly seems to capture the factors that *courts in equity cases have used in the past* in deciding whether to grant injunctions”⁵⁸

At a high level of generalization, a defendant may argue in equity that the balance of hardships or the public interest militate against the issuance of a permanent injunction.⁵⁹ But this abstract statement of equitable doctrine is not the same proposition as claiming that courts *in fact* applied these principles in all cases or even in a significant minority of cases. First and foremost, the defendant had to raise the argument, not the court. Professor Lemley asserts, however, that courts sitting in equity have an independent “responsibility to decide” if the balance of hardships and public interest weighed against an injunction for infringement of a valid patent, i.e., a patent in which the defendant did not rebut the infringement argument by the patent owner nor successfully invalidate the patent under the statutory patentability requirements.⁶⁰ As with other scholars, Professor Lemley does not cite any historical patent cases or other cases to support his claim. Once more, as with *eBay* itself, conventional wisdom about historical equity practice in issuing injunctions for patent infringement is unverified.

57. *Id.*

58. Mark A. Lemley, *Did eBay Irreparably Injure Trademark Law?*, 92 NOTRE DAME L. REV. 1795, 1795–96 (2017) (emphasis added).

59. See Gergen et al. *supra* note 17, at 226–27 n.114 (listing numerous contemporary treatises and articles on the equitable defense of “balancing the equities”).

60. See Mark A. Lemley, *The Ongoing Confusion over Ongoing Royalties*, 76 MO. L. REV. 695, 695 (2011) (“In *eBay Inc. v. MercExchange, L.L.C.*, the United States Supreme Court correctly concluded that courts had both the power and the *responsibility to decide* whether a successful patent owner needed injunctive relief and whether the imposition of that relief would unduly harm either the defendant or the public.”) (emphasis added).

This Part summarizes how historical treatises and courts addressed and applied equitable principles and defenses in issuing injunctions for patent infringement. The practice of equity courts was complicated, and thus it is not possible in this Part to detail all the procedural and substantive details, but it also is not necessary given the scope and function of this article. The purpose here is to address the next logical question raised by Part III: If there was no four-factor test, then what did historical legal authorities, including both commentators and courts, say in issuing injunctions for patent infringement?

A. Nineteenth-Century Commentators on Injunctions for Patent Infringement

During the period of the *Federal Cases* reporter, nineteenth-century treatises on equity and patent law do not support claims today that courts had an independent duty to raise and assess equitable defenses, such as laches, the balance of hardship, or the public interest. In his famous treatise on equity jurisprudence, Justice Story states only fleetingly at the end of a lengthy chapter on injunctions that “no injunction will be granted whenever it will operate oppressively, or inequitably, or contrary to the real justice of the case; . . . or where it will or may work an immediate mischief or fatal injury.”⁶¹ This is in essence a succinct and pithy statement of the balance of hardship and public interest principles in equity. In a short list of examples of what these equitable principles entail as defenses, Justice Story explicitly identifies laches in patent and copyright cases as an example of how a defendant can invoke these equitable principles to preclude an injunction.⁶² This is the entire extent of Justice Story’s discussion of these equitable principles; he does not address the balance of hardship, public interest, or any equitable defenses in his specific discussion of injunctions for patent infringement earlier in his treatise.⁶³ Notably, Justice Story does not say it is the responsibility of a court to independently assess equitable defenses like balance of hardship or laches separate from any arguments or the lack of arguments by defendants.

Early American patent law treatises published during the period of the *Federal Cases* reports primarily addressed only the legal requirements for obtaining a patent.⁶⁴ The few treatises that did discuss remedies are similarly devoid of discussions of general equitable defenses

61. See STORY, *supra* note 38, at 262.

62. See *id.* at 262–63.

63. See *id.* at 236–39.

64. See generally HENRY LUND, A TREATISE ON THE SUBSTANTIVE LAW RELATING TO LETTERS PATENT FOR INVENTIONS (1851); W.M. HINDMARCH, TREATISE ON THE LAW RELATING TO PATENT PRIVILEGES FOR THE SOLE USE OF INVENTIONS; AND THE PRACTICE OF OBTAINING LETTERS PATENTS FOR INVENTIONS (1846).

such as undue hardship on the defendant (balance of the hardship) and public interest. In his famous 1849 patent law treatise, George Ticknor Curtis's chapter on injunctions addresses in detail the procedural and substantive requirements for patent owners seeking and receiving both preliminary and permanent injunctions (and an accompanying claim for an accounting), but he does not discuss or even mention the defenses of the balance of the hardship or public interest.⁶⁵ Curtis does discuss specific equitable defenses that may result in the denial of an injunction for infringement of a valid patent, such as a prior license by the defendant, laches, abandonment, and estoppel.⁶⁶

Another early American treatise on patent law published during the same period as the decisions in the *Federal Cases* (1790–1882) reflects the same approach in the Curtis treatise. Willard Phillips discusses injunctions for patent infringement in his 1837 patent law treatise, but he does not address general equitable defenses of balance of the hardship or the public interest.⁶⁷ Instead, Phillips mostly discusses the “certain general rules” that justify the “granting of an injunction” without necessarily first obtaining a judgement at law that the patent is valid.⁶⁸ Phillips writes that “[t]he material considerations by which the court is governed in these cases are the clearness of the plaintiff's right to the exclusive privilege, and his possession and use of it. All the cases on injunctions turn upon these considerations.”⁶⁹ As will be seen in the next following sections, Phillips' statement on the case law is correct.

B. The Institutional Framework for Patent Lawsuits in Equity Courts

The 899 patent cases in equity reflect the same, if not somewhat surprising, dearth of what lawyers and scholars think of today as “traditional” equitable defenses. The database identifies the analyses employed by courts sitting in equity in adjudicating patent infringement complaints. The database identifies the general doctrinal framework used by courts, which primarily focused on assessing the allegation of infringement and evaluating any invalidity challenges by the defendant. It also identifies when courts assessed specific equitable doctrines, such as the balance of hardship, laches, estoppel, and the public interest, among others. This Section details how these equity doctrines were framed and applied in these patent infringement cases.

65. See GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF PATENTS FOR USEFUL INVENTIONS IN THE UNITED STATES OF AMERICA ch. X (3d ed. 1867).

66. *Id.* at 471–84.

67. See WILLARD PHILLIPS, THE LAW OF PATENTS FOR INVENTIONS; INCLUDING THE REMEDIES AND LEGAL PROCEEDINGS IN RELATION TO PATENT RIGHTS 452 (1837).

68. *Id.*

69. *Id.* For the proper understanding of “privilege” as a legal term of art as used here by Phillips, see Mossoff, *supra* note 31, at 1008 (explaining that patents are “privileges” in the sense that they are civil rights securing property rights).

The doctrines and requirements for patent owners to obtain injunctions in equity courts can be divided into three general categories: jurisdiction, substantive, and defenses. Doctrines such as the inadequate remedy at law or preventing a multiplicity of lawsuits in courts of law were originally jurisdictional doctrines given that equity courts were distinct legal institutions from law courts.⁷⁰ These were the doctrines that authorized a plaintiff to sue in equity court and that the dispute was justiciable by a court sitting in equity. Furthermore, patent owners were able to file lawsuits directly in equity courts without first having to obtain judgments from law courts, and thus equity courts held hearings to determine if the defendant was infringing and if the defendant's challenges to the validity of the patent were successful.⁷¹ Lastly, equity courts assessed defenses, such as the balance of hardship weighed in favor of the defendant or that the plaintiff committed laches, among others, which a defendant would plead to rebut a plaintiff proving infringement and sustaining the validity of its patent against any challenges.

It bears emphasizing that equity courts did not apply these three categories formalistically or as per se rules that must be assessed in every case. The name of the game was discretion — bounded by equitable principles.⁷² In cases of patent infringement, the respective parties either raised patent law or equitable issues, or they did not, given the

70. *See supra* note 32.

71. *Cf. McMillin v. Barclay*, 16 F. Cas. 302, 303–04 (C.C.W.D. Pa. 1871) (No. 8,902) (“The principle . . . upon which courts of equity have jurisdiction in patent cases, and upon which injunctions are granted in them, is not that there is no legal remedy, but that the law does not furnish a complete remedy to those whose property is invaded; for . . . each infringement of the patent . . . [t]he inventor . . . might be ruined by the necessity of perpetual . . .” (quoting *Motte v. Bennett*, 17 F. Cas. 909, 910–11 (C.C.D.S.C. 1849) (No. 9,884) (internal quotation marks omitted))); *Goodyear v. Hullihen*, 10 F. Cas. 696, 699 (D.W. Va. 1867) (“An inventor may bring an action at law against parties infringing his patent, and the court has power to treble the damages awarded by the jury, or, if he prefer to do so, he may in the first instance seek redress in equity, without having established his right at law . . .”); *Potter v. Muller*, 19 F. Cas. 1170, 1170 (C.C.S.D. Ohio 1864) (No. 11,334) (“The rule as to granting or continuing injunctions in patent right cases is now well settled by the modern usages of the courts of the United States. They are now granted without a previous trial at law in cases where the owner of the patent shows a clear case of infringement, and has been in the possession and enjoyment of the exclusive right for a term of years without any successful impeachment of its validity.”); *Sickels v. Mitchell*, 22 F. Cas. 74, 76 (C.C.S.D.N.Y. 1857) (No. 12,835) (“There is no necessity that the validity of a patent should be established in a trial at law, before an injunction can be granted.”); *Motte*, 17 F. Cas. at 911 (stating that “at the present day it is not generally necessary that the plaintiff should establish his right at law, in order to come into equity”) (citing English precedents)); *Isaacs v. Cooper*, 13 F. Cas. 153, 153 (C.C.D. Pa. 1821) (No. 7,096) (“The practice of the court of equity . . . is to grant an injunction upon the filing of the bill, and before a trial at law, if the bill state a clear right, and verify the same by affidavit.”).

72. *See Sanders v. Logan*, 21 F. Cas. 321, 323 (C.C.W.D. Pa. 1861) (No. 12,295) (“It is true that injunctions are now more liberally granted than in former times, yet the granting or refusal of them rests in the sound discretion of the court. A rash or indiscreet exercise of this power may be very oppressive . . . it should be administered only for prevention or protection.”).

unique circumstances of each case of alleged patent infringement. For example, the now-omnipresent requirement that a plaintiff may receive an injunction only if there is an inadequate remedy at law is raised in only several cases in the database.⁷³ In sum, the 899 court opinions vary in both form and substance, as one would expect of equity courts. With that said, equity courts did generally address the two core issues of infringement and patent validity, if only because plaintiffs had to prove infringement and defendants almost always contested patent validity in a dispute of alleged patent infringement.

In the cases in the *Federal Cases* reporter, courts did not distinguish between a preliminary injunction and a permanent injunction in either substantive doctrines or their analyses.⁷⁴ (In equity courts, these remedies were sometimes called “provisional injunctions” and “perpetual injunctions,” respectively, but I will continue to use the modern usage in this article.) This may sound surprising to modern lawyers and scholars given the modern four-factor test for preliminary injunctions,⁷⁵ which is undisputed, unlike the *eBay* four-factor test for permanent injunctions.⁷⁶ Yet, no historical federal court decision distinguished between preliminary injunctions and permanent injunctions in terms of the general equitable inquiries and substantive doctrinal analyses. There was no four-factor test for preliminary injunctions. In sum, courts applied the same doctrinal framework in patent cases for both preliminary injunctions and permanent injunctions — ensuring proper equitable jurisdiction, finding infringement, sustaining validity of the patent if challenged by the defendant, and hearing any equitable defenses given the context of the facts and the nature of the remedy.⁷⁷

73. See *Vaughan v. Cent. Pac. R. Co.*, 28 F. Cas. 1107, 1110 (C.C.D. Cal. 1877) (No. 16,897); *Spaulding v. Page*, 22 F. Cas. 892, 893–94, 896 (C.C.D. N.J. 1871) (No. 13,219); *Morris v. Lowell Mfg. Co.*, 17 F. Cas. 822, 823 (C.C.D. Mass. 1866) (No. 9,833).

74. See, e.g., *Green v. French*, 10 F. Cas. 1107, 1109 (C.C.D.N.J. 1870) (No. 5,757) (“[T]he court has no discretion, but is bound to grant a preliminary injunction where the validity of the complainant’s patent has been established by protracted and expensive litigation, and the proof of infringement is clear.”).

75. See *Winter v. Nat’l Res. Def. Council, Inc.*, 555 U.S. 7, 20 (2008) (“A plaintiff seeking a preliminary injunction must establish that he is likely to succeed on the merits, that he is likely to suffer irreparable harm in the absence of preliminary relief, that the balance of equities tips in his favor, and that an injunction is in the public interest.” (first citing *Munaf v. Geren*, 553 U.S. 674, 689–90 (2008); then *Amoco Prod. Co. v. Gambell*,

480 U.S. 531, 542 (1987); and then *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 311–12 (1982)).

76. See *supra* notes 53–55 and accompanying text (stating results of study that there was no historical four-factor test and the *eBay* Court appeared to conflate the doctrinal tests for preliminary and permanent injunctions).

77. See, e.g., *Blake v. Boisselier*, 3 F. Cas. 589, 589 (C.C.E.D. Mo. 1879) (No. 1,493) (analyzing patent invalidity challenges and proof of infringement as predicates for issuing a preliminary injunction); *Burleigh Rock-Drill Co. v. Lobdell*, 4 F. Cas. 750, 751 (C.C.D. Mass. 1875) (No. 2,166) (same); *Earth Closet Co. v. Fenner*, 8 F. Cas. 261, 264 (C.C.D.R.I. 1871) (No. 4,249) (same); *Doughty v. West*, 7 F. Cas. 969, 970 (S.D.N.Y. 1865) (No. 4,029) (same);

The only (non-substantive) difference between preliminary injunctions and permanent injunctions was that courts emphasized more in preliminary injunctions that the remedy was *discretionary*.⁷⁸ This makes sense. A permanent injunction follows after a full hearing in which the plaintiff proves infringement, defendant's validity challenges are rejected, and any equitable defenses further raised by a defendant are also rejected; in these cases, courts spoke strongly about the patent owner's right to an injunction.⁷⁹ In contrast, a court issued a preliminary injunction to prevent an immediate "mischief" to the plaintiff on the basis of an initial review of the infringement claim and any defenses concerning patent validity or other equitable doctrines.⁸⁰ In such cases, defendants would be restrained before their rightful day in court to contest fully either the validity of the patent or the infringement allegation. Courts were thus legitimately concerned with committing a wrong against the defendant if the defendant was able to rebut the plaintiff's allegations of infringement of a valid patent.⁸¹ Aside from this

Ely v. Monson & B. Mfg. Co., 8 F. Cas. 604, 604–05 (C.C.D. Mass. 1860) (No. 4,431) (same); Sargent v. Carter, 21 F. Cas. 495, 498 (C.C.D. Mass. 1857) (No. 1,262) (same); Colt v. Young, 6 F. Cas. 171, 171–72 (C.C.S.D.N.Y. 1852) (No. 3,032) (same).

78. See, e.g., *Earth Closet*, 8 F. Cas. at 264 ("The law makes the judge's discretion the rule . . ."); *Irwin v. Dane*, 13 F. Cas. 116, 116 (C.C.N.D. Ill. 1871) (No. 7,081) ("The granting of a preliminary injunction is a matter of judicial discretion, to be determined by the circumstances under which the case is presented . . ."); *Hodge v. Hudson River R.R. Co.*, 12 F. Cas. 276, 279 (C.C.S.D.N.Y. 1868) (No. 6,560) ("In acting on applications for temporary injunctions to restrain the infringement of patents, there is much latitude of discretion . . ."); *Toppan v. Nat'l Bank-Note Co.*, 24 F. Cas. 60, 61 (C.C.S.D.N.Y. 1861) (No. 14,100) ("I can grant no provisional injunction. This extraordinary relief is never granted as a matter of course.").

79. See, e.g., *Bachelder v. Moulton*, 2 F. Cas. 307, 310 (C.C.S.D.N.Y. 1873) (No. 706) ("The plaintiff's title and the validity of his claims are free from doubt, and have been established, and the infringement by the defendants' machine is clear. An injunction must issue on all the claims."); *Conover v. Mers*, 6 F. Cas. 322, 323 (S.D.N.Y. 1868) (No. 3,123) ("[W]here, as here, the patent has been sustained on full hearing, and the infringement is clear . . . the complainant is entitled to have his rights promptly protected by injunction."); *Poppenhusen v. New York Gutta Percha Comb Co.*, 19 F. Cas. 1056, 1056–57 (C.C.S.D.N.Y. 1858) (No. 11,281) ("If the rights of a party, under a patent, have been fully and clearly established, and an infringement of such rights is threatened, or, if, when they have been infringed, the party has good reason to believe they will continue to be infringed, an injunction will issue.").

80. See, e.g., *Day v. Candee*, 7 F. Cas. 230, 240 (C.C.D. Conn. 1853) (No. 3,676) (denying a motion for a preliminary injunction given concerns raised about patent validity and thus "granting [a preliminary] injunction there would be a greater probability of producing incalculable mischief than there would be of preventing it"); *Parker v. Sears*, 18 F. Cas. 1159, 1162 (C.C.E.D. Pa. 1850) (No. 10,748) (stating that "the chief object of issuing [a preliminary injunction] before the final hearing of the cause, is, to prevent irreparable mischief"); *Essex Hosiery Mfg. Co. v. Dorr Mfg. Co.*, 8 F. Cas. 791, 791 (C.C.D. Mass. 1846) (No. 4,533) (stating that "a preliminary injunction should only be issued for the purpose of preventing mischief, and in aid of the legal right").

81. See *Goodyear v. Dunbar*, 10 F. Cas. 684, 685 (C.C.D.N.J. 1860) (No. 5,570) ("The remedy by [preliminary] injunction, though necessary in certain cases to do complete justice, is nevertheless one which should always be cautiously granted If the defendant shows a belief that he has a just defence, and is not a willful pirate of the plaintiff's invention . . . which [justifies] the court in using their festinum remedium.").

difference, the substantive analysis was largely the same in court decisions for both preliminary and permanent injunctions — assessing the alleged infringement by the plaintiff, considering any validity challenges by the defendant, and assessing any equitable defenses further raised by the defendant.

C. The Doctrinal Framework for Injunctions in Patent Lawsuits

If equity courts did not apply a four-factor test for either permanent or preliminary injunctions, then how did they adjudicate a plaintiff's request for an injunction given an allegation that a defendant was infringing a patent? Equity courts generally followed the same doctrinal framework they applied in issuing equitable remedies for violations of tangible property rights such as real estate.⁸² This was essentially a two-step inquiry: If a plaintiff succeeded in (1) proving continuing or willful infringement by the defendant and (2) rebutting patent validity challenges by the defendant, then this created the presumptive right of the plaintiff to an injunction.⁸³ Once a patent owner established this presumptive right to an injunction, the defendant had a right to attempt to rebut it by convincing the court to dismiss plaintiff's complaint and thus deny the injunction by pleading equitable defenses.

Before pleading equitable defenses, if a defendant succeeded in proving either noninfringement or invalidity of the patent, the complaint was dismissed and the injunction was denied.⁸⁴ The majority of

82. See *Cook v. Ernest*, 6 F. Cas. 385, 391 (C.C.D. La. 1872) (No. 3,155) ("If the rights of property so invaded were rights to land or other tangible estate, no court would hesitate for a moment to restrain the wrong-doer by injunction. The property in a patent is just as much under the protection of the law as property in land. The owner has the same right to invoke the protection of the courts, and when he has made good his claim to his patent, and shown an infringement of it, it is the duty of the courts to give him the same relief meted out to suitors in other cases."); *Isaacs v. Cooper*, 13 F. Cas. 153, 153–54 (C.C.D. Pa. 1821) (No. 7,096) ("[I]f the defects in the patent, or specification, are so glaring that the court can entertain no doubt as to that point, it would be most unjust to restrain the defendant from using a machine or other thing which he may have constructed, probably at great expense, until a decision at law can be had.").

83. See, e.g., *Cook*, 6 F. Cas. at 391 ("The property in a patent is just as much under the protection of the law as property in land. The owner has the same right to invoke the protection of the courts, and when he has made good his claim to his patent, and shown an infringement of it, it is the duty of the courts to give him the same relief meted out to suitors in other cases."); *Hoffheins v. Brandt*, 12 F. Cas. 290, 294, 297 (C.C.D. Md. 1867) (No. 6,575) (applying two-step inquiry of patent validity and infringement); *Jenkins v. Greenwald*, 13 F. Cas. 519, 521 (C.C.S.D. Ohio 1857) (No. 7,270) ("In his treatise on Patents (section 335) Mr. Curtis says: 'If the plaintiff shows the necessary possession, and an infringement has actually been committed by the defendant, the injunction will be granted, notwithstanding the defendant admits the infringement, and promises not to repeat it.'").

84. See, e.g., *Stow v. Chicago*, 23 F. Cas. 195, 199 (C.C.N.D. Ill. 1877) (No. 13,512) (dismissing complaint and denying injunction given that the defendant proved that patent is invalid); *Smith v. Clark*, 22 F. Cas. 487, 488 (C.C.D. Mass. 1850) (No. 13,027) (dismissing complaint and denying injunction given that defendant proved that he did not infringe the

the denials of injunctions resulted from a defendant succeeding in the liability phase of the trial in which the defendant successfully proved either invalidity or noninfringement.⁸⁵ In such cases, courts did not rely on equitable defenses to reach their decisions, as there was no claim of a violation of a property right that required rebutting by the defendant.

One antebellum court summarized this doctrinal framework: “Under the rules of equity pleading . . . the defendants must disprove [either] the invention . . . or the infringement of the patent Otherwise, the plaintiff will be entitled to an injunction on his proofs.”⁸⁶ There was no difference in the doctrinal requirements for establishing a claim to a preliminary injunction.⁸⁷

Federal courts sitting in equity developed additional doctrines and presumptions for patent owners pleading cases of patent infringement and seeking equitable remedies. One was a jurisdictional rule that permitted patent owners to file a complaint seeking an injunction without first pleading before a court in law that a patent was valid or that the defendant infringed its patent.⁸⁸ As Phillips states in his 1837 treatise, an injunction is “essential to the security of patentees, since the remedy at law for damages will not, in all cases, afford an adequate remedy.”⁸⁹

Courts sitting in equity developed another doctrinal presumption that they applied in the liability phase of a lawsuit in which the defendant argued that the patent is invalid. If the defendant sought to invalidate the plaintiff’s patent, federal courts recognized two presumptions of validity that defendants had the burden to overcome in their arguments in contesting a claim of infringement.

patent); *Hovey v. Stevens*, 12 F. Cas. 609, 614 (C.C.D. Mass. 1846) (dismissing complaint and denying injunction given questions about validity that should be first resolved in trial at law).

85. See *supra* Section III.B (describing and showing data on how most denials of injunctions in *Federal Cases* were for the same reasons patent owners would have been denied damages if they had proceeded with a trial in a court at law by failing either to prove infringement or to rebut patent validity challenges by the defendant).

86. *Day v. New England Car Co.*, 7 F. Cas. 248, 248–49 (C.C.S.D.N.Y. 1854) (No. 3,686).

87. See *Green v. French*, 10 F. Cas. 1107, 1109 (C.C.D.N.J. 1879) (No. 5,757) (stating that “the court has no discretion, but is bound to grant a preliminary injunction where the validity of the complainant’s patent has been established by protracted and expensive litigation, and the proof of infringement is clear”) (citing *Gibson v. Van Dresar*, 10 F. Cas. 329 (C.C.N.D.N.Y. 1850) (No. 5,402); *Winans v. Eaton*, 30 F. Cas. 262, 264 (C.C.N.D.N.Y. 1854) (No. 17,861) (denying motion for preliminary injunction given “if there exist[s] any reasonable doubt about the originality or novelty of the car, as arranged and constructed by the patentee, or about the substantial identity of the cars manufactured by the defendants with the plaintiff’s, then I am not at liberty to interfere and arrest the manufacture at this stage of the proceedings”).

88. See *Brooks v. Stolley*, 4 F. Cas. 302, 305 (C.C.D. Ohio 1845) (No. 1,962) (“In . . . an ordinary case of infringement [in which parties are strangers] . . . an absolute injunction is the only adequate relief”); STORY, *supra* note 38, at 236 (“It is upon similar principles [justifying injunctions for breaches of other property rights], to prevent irreparable mischief or to suppress multiplicity of suits and vexatious litigation, that Courts of Equity interfere in cases of patents for inventions . . . to secure the rights of the inventor . . .”).

89. PHILLIPS, *supra* note 67, at 451.

The first is the well-known presumption of validity in a patent issued by the Patent Office (now the Patent & Trademark Office).⁹⁰ In his 1849 treatise, Curtis states that “the practice is, to grant an injunction upon the filing of the bill, and before a trial at law, if the bill state[s] a clear right, and [it is] verif[ied] . . . by affidavit.”⁹¹ This presumption of validity continues to this day, and is now codified in the modern patent statute.⁹²

Of course, as Curtis recognized, if a defendant or court found “defects” in the patent that were so “glaring” such that “the court can entertain no doubt” about the legitimate questions of invalidity, it would “be most unjust to restrain the defendant . . . until a decision at law can be had.”⁹³ In the database, though, almost every court ruled directly on the validity challenges, and held that the patent was invalid without sending the patent owner to a court at law.

A good example of this general jurisprudential approach in equity is found in the 1854 court decision that brought to an end the long-running patent dispute between Charles Goodyear and Horace Day. Day had long tormented Goodyear with extensive and willful infringement of Goodyear’s patent on his invention of vulcanized rubber.⁹⁴ In *Goodyear v. Day*, Circuit Justice Robert Grier recognized:

[I]n England the chancellor will generally not grant a final and perpetual injunction in patent cases, when the answer denies the validity of the patent, without sending the parties to law to have that question decided. But even there the rule is not absolute or

90. See *Am. Saddle Co. v. Hogg*, 1 F. Cas. 719, 720 (C.C.D. Mass. 1872) (No. 316) (“A patentee is entitled to the presumptions arising from the grant of his patent . . .”); *Sands v. Wardwell*, 21 F. Cas. 348, 349 (C.C.D.N.H. 1869) (No. 12,306) (“[T]he settled rule of law is, that letters-patent when introduced in evidence in a suit in equity or at law, if they are in due form, afford a prima facie presumption that the inventor is the original and first inventor . . .”); *Hoffheins v. Brandt*, 12 F. Cas. 290, 294 (C.C.D. Md. 1867) (No. 6,575) (“The patent itself is prima facie evidence that it was lawfully issued . . .”); *White v. Allen*, 29 F. Cas. 969, 972 (C.C.D. Mass. 1863) (No. 17,535) (“Power to grant letters patent is conferred by law upon the commissioner of patents, and when that power is lawfully exercised, and a patent has been duly granted, it is prima facie evidence that the patentee is the original and first inventor . . .”); see also Mossoff, *supra* note 31, at 998–1001 (detailing presumption in favor of liberal interpretations of patents favoring their owners created by early nineteenth-century courts before the examination system was adopted in 1836).

91. CURTIS, *supra* note 65, at 439.

92. See 35 U.S.C. § 282(a) (“A patent shall be presumed valid.”); *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1429 n. 3 (Fed. Cir. 1988) (“Courts do not find patents ‘valid,’ only that the patent challenger did not carry the ‘burden of establishing invalidity . . .’” (citations omitted)).

93. CURTIS, *supra* note 65, at 439–40.

94. See CHARLES SLACK, NOBLE OBSESSION: CHARLES GOODYEAR, THOMAS HANCOCK, AND THE RACE TO UNLOCK THE GREATEST INDUSTRIAL SECRET OF THE NINETEENTH CENTURY 117–25, 147–53, 169–94, 242–44 (2002) (describing Goodyear’s lengthy travails with the dastardly Day).

universal; It always rests on the sound discretion of the court.⁹⁵

Acting on his authorized discretion as a court sitting in equity, Circuit Justice Grier “proceed[ed] to examine the questions both of fact and law, which affect the validity of [Goodyear’s] patents.”⁹⁶ He ultimately found Goodyear’s patent to be valid and infringed and issued an injunction against Day.⁹⁷

The second presumption of validity was based in the patent owner’s licensing or manufacturing of the patent in the marketplace or in the longstanding public acquiescence to the patent (a type of ratification or estoppel by third parties).⁹⁸ In 1844, Circuit Justice Story stated that the presumption of validity created by an “exclusive possession of some duration” of the patent was one reason why a patent owner could immediately file a complaint in equity, as opposed to first running the legal gauntlet in a court at law in obtaining a legal judgment concerning the validity of the patent.⁹⁹ In an earlier patent decision in 1827, Circuit Justice Smith Thompson ultimately denied an injunction given proof of lack of novelty by the defendant, but he first explained why the patent owner was permitted to file suit in equity: “When there has been an exclusive possession, for some considerable time, of the patent right, the court will sometimes, on the ground of possession,

95. See *Goodyear v. Day*, 10 F. Cas. 678, 683 (C.C.D.N.J. 1852) (No. 5,569). It should be noted that Circuit Justice Grier’s representation of English practice here should be read with caution. See H. Tomás Gómez-Arostegui & Sean Bottomley, *Patent-Infringement Suits and the Right to a Jury Trial*, 72 AM. U. L. REV. 1293, 1353–55 (2023) (describing how the English courts developed similar presumptions permitting full adjudication of patent rights in courts sitting in equity).

96. *Day*, 10 F. Cas. at 683.

97. *Id.* at 694.

98. See *Foster v. Moore*, 9 F. Cas. 563, 566 (C.C.D. Mass. 1852) (No. 4,978) (“The familiar rule . . . is, that when a patent has been granted, and there has been an exclusive possession of some duration under it, the court will enjoin, without putting the party previously to establish his right at law. . . . The reason for the presumption in favor of the validity of the grant is, the acquiescence of the public in the exclusive right of the patentee”); *Orr v. Badger*, 18 F. Cas. 831, 832 (C.C.D. Mass. 1844) (No. 10,587) (“Dr. Orr was in quiet enjoyment of the benefit of his invention for several years under the original patent, and received considerable sums of money. This is prima facie evidence of the right. If the public submit to his claim for a reasonable time, it raises a presumption of right.”).

99. See *Washburn v. Gould*, 29 F. Cas. 312, 329 (C.C.D. Mass. 1844) (No. 17,214) (Story, Circuit Justice) (“The doctrine laid down . . . is this — that when a patent has been granted, and an exclusive possession of some duration, under it, the court will interpose its injunction, without putting the patentee previously to establish the validity of his patent by an action at law. But where the patent is but of yesterday (meaning, that it is recent) . . . the court will not . . . act upon the presumed validity or invalidity of the patent . . . and will send the patentee to law, and oblige him to establish the validity of his patent in a court of law, before it will grant him the benefit of an injunction.”); see also *Sullivan v. Redfield*, 23 F. Cas. 357, 360 (C.C.D.N.Y. 1825) (No. 13,597) (recognizing as authoritative precedent the rule in English Chancery Court that “where a patent has been granted, and there has been an exclusive possession of some duration under it, the court will interpose its injunction, without putting the party previously to establish the validity of his patent at law”).

grant an injunction, without putting the party previously to establish the validity of the patent at law.”¹⁰⁰

When plaintiffs were unable to establish an evidentiary basis for these presumptions, such as an absence of licensing or manufacturing activities under the patent, or if the defendant was able to sow legitimate doubts as to the validity of the patent, courts would either send the patent owner to a court at law or deny outright the injunction.¹⁰¹ Again, these presumptions were applied equally for preliminary and permanent injunctions.¹⁰²

D. Equitable Defenses

In addition to a defendant contesting either infringement or the validity of the patent, a defendant had additional sources of equitable relief. As noted earlier, a patent owner established a presumptive right to an injunction given proof of infringement of a valid patent, but defendants could always attempt to rebut this presumptive right with additional equitable defenses.¹⁰³ If a defendant raised these defenses, then a court would assess whether an injunction imposed a greater hardship on the defendant than the hardship of the infringement on the patent

100. *Thomas v. Weeks*, 23 F. Cas. 978, 980 (C.C.S.D.N.Y. 1827) (No. 13,914).

101. *See, e.g., Jones v. Field*, 13 F. Cas. 953, 954 (C.C.E.D.N.Y. 1875) (No. 7,461) (dismissing complaint given that patent had issued only five months earlier and defendant contested novelty).

102. *See, e.g., Chase v. Wesson*, 5 F. Cas. 526, 526 (C.C.D. Mass. 1873) (No. 2,631) (“As the complainant has been long in the enjoyment of his rights under the patent, and there is no doubt upon the question of infringement, the injunction will issue . . .”); *Toppan v. Nat’l Bank-Note Co.*, 24 F. Cas. 60, 61 (C.C.S.D.N.Y. 1861) (No. 14,100) (“The principle that exclusive possession for a time strengthens the title of a patentee, is founded on the idea that, as it is a claim of right adverse to the public, and the public acquiesce in that claim, such acquiescence raises a presumption that the claim is good.”); *Sargent v. Carter*, 21 F. Cas. 495, 498 (C.C.D. Mass. 1857) (No. 1,262) (granting a preliminary injunction in part on the basis of “prima facie title of the plaintiffs, founded on their exclusive possession of the thing patented”); *Sargent v. Seagrave*, 21 F. Cas. 505, 505–06 (C.C.D.R.I. 1855) (No. 12,365) (“The ground upon which the plaintiffs rest their claim, is an exclusive possession of the right, and the acquiescence of the public therein since the issue of the letters-patent, a period of about two years, and also the acquiescence of the public in their claim of a right under a caveat, for about two years before the date of the patent.”); *Motte v. Bennett*, 17 F. Cas. 909, 916 (C.C.D.S.C. 1849) (No. 9,884) (“[W]here the case is clear and without reasonable doubt, where the bill states a clear right to the thing patented, which, together with the alleged infringement, is verified by affidavit, and where the plaintiff has been in possession of it, by having sold or used it in part or in the whole, the court will grant an injunction and continue it till the hearing or further order, without sending the plaintiff to law to try his right.”); *Ogle v. Ege*, 18 F. Cas. 619, 620 (C.C.D. Pa. 1826) (No. 10,462) (Washington, Circuit Justice) (“I take the rule to be, in cases of injunctions in patent cases, that where the bill states a clear right to the thing patented, which, together with the alleged infringement, is verified by affidavit; if he has been in possession of it by having used or sold it in part, or in the whole, the court will grant [a preliminary] injunction . . .”).

103. *See supra* notes 82–85 and accompanying text.

owner (the balance of the hardship),¹⁰⁴ whether the injunction was contrary to the public interest,¹⁰⁵ or whether the plaintiff committed inequitable acts, such as laches,¹⁰⁶ estoppel,¹⁰⁷ or unclean hands.¹⁰⁸ If the

104. See, e.g., *Waterman v. Wallace*, 29 F. Cas. 408, 410 (C.C.D. Conn. 1875) (No. 17,261) (“Although I am inclined to believe that there is a hardship in the position in which the defendants are placed, I am of opinion that it is a hardship from which they cannot be relieved under the present state of the decisions . . .”); *Thompson v. Jewett*, 23 F. Cas. 1053, 1055 (C.C.E.D. Pa. 1872) (No. 13,961) (noting that the commercial competition created by the defendant’s infringement was “highly injurious” to the plaintiff); *Hodge v. Hudson River R.R. Co.*, 12 F. Cas. 276, 278 (C.C.S.D.N.Y. 1868) (No. 6,560) (“In this case, the validity of the plaintiffs’ patent has been fully established. There have been five trials by a jury [with verdicts for plaintiff]. . . . [T]he rule, as established by this court is, that a plaintiff has a right to protection by injunction, although great injury may thereby be caused to the infringer.” (citing *Potter v. Fuller*, 19 F. Cas. 1148 (C.C.S.D.N.Y. 1862) (No. 11,327))); *Morris v. Lowell Mfg. Co.*, 17 F. Cas. 822, 823 (C.C.D. Mass. 1866) (No. 9,833) (“On the other hand, there are cases so clear that a court of equity will not permit further litigation; and there are others in which upon a balance of the equities, and of the danger of serious injury, the plaintiffs’ rights decidedly preponderate.”); *Sickels v. Tileston*, 22 F. Cas. 77, 78 (C.C.S.D.N.Y. 1857) (No. 12,837) (“The rights of the plaintiff are manifest [despite denial of infringement by defendant] . . . [and] the violation of right on the part of the defendant is clear. . . . In such a case, the consideration of either public or private convenience should have little weight.”); *Woodworth v. Edwards*, 30 F. Cas. 567, 572 (C.C.D. Me. 1847) (No. 18,014) (“The rights of inventive genius, and the valuable property produced by it, all persons in the exercise of this spirit will be willing to vindicate and uphold, without colorable invasions or wanton piracies; but those rights, on the other hand, should be maintained in a manner not harsh towards other inventors, nor unaccommodating to the growing wants of the community.”).

105. See *Whitely v. Swayne*, 29 F. Cas. 1044, 1050 (C.C.S.D. Ohio 1865) (No. 17,568) (denying injunction and accounting sought by plaintiff given “abuse of the right” in obtaining a reissue patent by means of “positive fraud,” as well as the defendant’s machine is “very popular and useful labor-saving agricultural implement, and is extensively manufactured in various parts of the country”); *Guidet v. Palmer*, 11 F. Cas. 105, 106 (C.C.E.D.N.Y. 1872) (No. 5,859) (denying an injunction given balance of hardship and “public interest” concerns of successful patent infringement lawsuit against city for use of patented cement in sidewalks); *Bliss v. City of Brooklyn*, 3 F. Cas. 706, 707 (C.C.E.D.N.Y. 1871) (No. 1,544) (denying an injunction “at the present time” for the infringing use of patented hoses by city’s fire department given the hoses “are necessary for the daily use of the city in the prevention of fires”); *Hodge*, 12 F. Cas. at 278–79 (rejecting defendant’s claims of public interest in its “common carrier” status as a railroad that carries U.S. mail).

106. See *Spring v. Domestic Sewing Mach. Co.*, 22 F. Cas. 977, 978 (C.C.D.N.J. 1879) (No. 13,258) (denying motion for preliminary injunction given laches by plaintiff); *Sperry v. Ribbons*, 22 F. Cas. 927, 928 (C.C.D.N.J. 1878) (No. 13,238) (same); *United States Rifle Etc. Co. v. Whitney Arms Co.*, 28 F. Cas. 819, 820, 822 (C.C.D. Conn. 1877) (No. 16,793) (denying preliminary injunction given “laches and want of diligence in procuring the patent, to the injury of the intervening equities of other inventors and patentees”); *Goodyear v. Honsinger*, 10 F. Cas. 692, 695–96 (C.C.N.D. Ill. 1867) (No. 5,572) (considering laches by plaintiff but ultimately granting a conditional preliminary injunction); *Parker v. Sears*, 18 F. Cas. 1159, 1163 (C.C.E.D. Pa. 1850) (No. 10,748) (denying an injunction given laches by plaintiff); *Cooper v. Mattheys*, 6 F. Cas. 482, 485–87 (C.C.E.D. Pa. 1842) (No. 3,200) (same).

107. See *Sprague v. Adriance*, 22 F. Cas. 958, 959–60 (C.C.S.D.N.Y. 1877) (No. 13,248) (rejecting estoppel defense and issuing injunction); *Stover v. Halsted*, 23 F. Cas. 190, 194 (C.C.S.D.N.Y. 1875) (No. 13,509) (same); *Thompson v. Jewett*, 23 F. Cas. 1053, 1054–55 (C.C.E.D. Pa. 1872) (No. 13,961) (same).

108. See *Wilson Packing Co. v. Clapp*, 30 F. Cas. 249, 250 (C.C.N.D. Ill. 1878) (No. 17,850) (denying preliminary injunction given bad faith litigation tactics by plaintiff); *Nellis v. McLanahan*, 17 F. Cas. 1311, 1312 (C.C.W.D. Pa. 1873) (No. 10,099) (dismissing complaint and denying injunction given defendants allegations of “multifariousness” by plaintiffs in their litigation tactics).

court agreed with the defendant's defenses, then the injunction would not issue despite the defendant's infringement of a valid patent. But defendants did not always argue these equitable defenses, or at least they did not always succeed, which explains the 91% grant rate for injunctions when a court found the defendant infringed a valid patent.

There are some other interesting aspects of these defenses in the cases in the database. As noted, the relative number of cases in which these defenses were raised is surprisingly small given the preeminence of these equitable defenses today — especially given that two were officially written into the mandatory four-factor *eBay* test for issuing injunctions (balance of hardship and public interest). Interestingly, this practice of early federal courts sitting in equity in patent cases not hearing or deciding equitable defenses is consistent with traditional equity practices in the English Chancery Court, where there was a similar absence of arguments by defendants raising balance of hardship or public interest defenses in patent cases.¹⁰⁹

In the *Federal Cases* reporter, there are only four cases in which the defendant argued the public interest,¹¹⁰ three cases in which defendant argued unclean hands,¹¹¹ three cases in which the defendant argued estoppel,¹¹² and fifteen cases in which the defendant argued laches.¹¹³

The most common equitable defense that appears to have been argued by defendants was the balance of hardship, which was either explicitly or implicitly addressed by a court in thirty-two total cases. Notably, the majority of these cases in which defendants argued the balance of the hardship, whether successfully or not, entailed pleadings

109. See Gómez-Arostegui & Bottomley, *supra* note 17, at 431 (“Hardship (and/or the public interest) are considerations we have encountered on interlocutory injunctions, but, even there, largely in suits where the underlying merits of the plaintiff’s case were questionable. We are aware of only one intangible-property case where a defendant’s hardship affected a decree [for a permanent injunction], and it did so only tangentially.” (emphasis omitted)).

110. See *supra* note 105 (listing cases). Some of the cases in which the public interest was successfully argued by defendant were de facto takings cases, as the patent owner sought an injunction against a public corporation. See *Guidet*, 11 F. Cas. at 106 (denying a preliminary injunction in part given “public interest” in sidewalks made with plaintiff’s patented cement); *Bliss*, 3 F. Cas. at 707 (ordering an accounting and denying an injunction against the City of Brooklyn).

111. See *supra* note 108 (listing cases).

112. See *supra* note 107 (listing cases).

113. See *supra* note 106 (listing some of the cases); see also Wortendyke v. White, 30 F. Cas. 639, 640–41 (C.C.D.N.J. 1875) (No. 18,050); Johnson v. Onion, 13 F. Cas. 777, 779 (C.C.D. Md. 1870) (No. 7,401); Sykes v. Manhattan Elevator & Grain Drying Co., 23 F. Cas. 585, 586 (C.C.S.D.N.Y. 1869) (No. 13,710); Potter v. Davis Sewing-Mach. Co., 19 F. Cas. 1144, 1145 (C.C.S.D.N.Y. 1868) (No. 11,324); Morris v. Lowell Mfg. Co., 17 F. Cas. 822, 824 (C.C.D. Mass. 1866) (No. 9,833); Potter v. Fuller, 19 F. Cas. 1148, 1150 (C.C.S.D.N.Y. 1862) (No. 11,327); Essex Hosiery Mfg. Co. v. Dorr Mfg. Co., 8 F. Cas. 791, 792 (C.C.D. Mass. 1846) (No. 4,533); Stevens v. Felt, 23 F. Cas. 10, 11 (S.D.N.Y. 1843) (No. 13,397); Wyeth v. Stone, 30 F. Cas. 723, 731 (C.C.D. Mass. 1840) (No. 18,107) (Story, Circuit Justice).

by patent owners for *preliminary injunctions*.¹¹⁴ Courts expressed skepticism of applying this defense to defendants adjudicated as infringers of valid patents. In one case in 1862 in which the Sewing Machine Combination sued Abraham Fuller for infringing a patent owned by the Wheeler, Wilson & Co., one of the members of this first patent pool, Judge Smalley stated that “where the validity of the patent is fully established and the infringement is clear, a party has a right to protection by injunction, although it may cause great injury to the infringer.”¹¹⁵ Similarly, Judge Ingersoll stated a few years earlier in 1857 that “the consideration of either public or private convenience should have little weight” when the “rights of the plaintiff are manifest [and] . . . the violation of right on the part of the defendant is clear. . . . and [the defendant] insists upon doing, without making compensation therefor, that which has been adjudged to be a violation.”¹¹⁶ Judge Ingersoll thus granted the patent owner a preliminary injunction.¹¹⁷

V. AN IMPLICATION AND SOME LIMITATIONS OF THE DATABASE OF PATENT CASES IN EQUITY

Ultimately, the complete dearth of historical precedent for the four-factor test in *eBay*, both as a test and in the absence of the actual substantive inquiries represented by these factors — irreparable injury/inadequate remedy at law, balance of the hardships, and public interest — may explain the development following *eBay* in which the judges began citing Justice Anthony Kennedy’s concurring opinion in issuing or denying injunctions, as opposed to citing the unanimous majority opinion.¹¹⁸ Judges are smart people, and they know the difference between a unanimous majority opinion that sets forth the law and a concurring

114. See, e.g., *Tucker v. Burditt*, 24 F. Cas. 266, 266 (C.C.D. Mass. 1879) (No. 14,216); *Rumford Chem. Works v. Vice*, 20 F. Cas. 1355, 1355–56 (C.C.E.D.N.Y. 1877) (No. 12,136); *Sargent Mfg. Co. v. Woodruff*, 21 F. Cas. 511, 511–12 (C.C.W.D. Wis. 1873) (No. 12,368); *Thompson v. Jewett*, 23 F. Cas. 1053, 1053, 1055 (C.C.E.D. Pa. 1872) (No. 13,961); *Guidet v. Palmer*, 11 F. Cas. 105, 105–06 (C.C.E.D.N.Y. 1872) (No. 5,859); *Irwin v. Dane*, 13 F. Cas. 116, 116 (C.C.N.D. Ill. 1871) (No. 7,081); *Sykes*, 23 F. Cas. at 585–86; *Hodge v. Hudson River R.R. Co.*, 12 F. Cas. 276, 276–78 (C.C.S.D.N.Y. 1868) (No. 6,560); *Potter v. Schenck*, 19 F. Cas. 1182, 1182, 1184 (C.C.N.D. Ill. 1866) (No. 11,337); *Lowell Mfg.*, 17 F. Cas. at 822–24; *Potter v. Whitney*, 19 F. Cas. 1191, 1191–92 (C.C.D. Mass. 1866) (No. 11,341); *Stainthorp v. Humiston*, 22 F. Cas. 1035, 1035 (C.C.N.D.N.Y. 1862) (No. 13,280); *Parker v. Sears*, 18 F. Cas. 1159, 1159, 1163 (C.C.E.D. Pa. 1850) (No. 10,748); *Woodworth v. Edwards*, 30 F. Cas. 567, 567, 570 (C.C.D. Me. 1847) (No. 18,014); *Sickels v. Tileston*, 22 F. Cas. 77, 78 (C.C.S.D.N.Y. 1857) (No. 12,837); *Sargent v. Seagrave*, 21 F. Cas. 505, 505–06 (C.C.D.R.I. 1855) (No. 12,365); *Essex*, 8 F. Cas. at 791–92; *Smith v. Mercer*, 22 F. Cas. 597, 602 (C.C.E.D. Pa. 1846) (No. 13,078).

115. *Potter*, 19 F. Cas. at 1150. See generally Adam Mossoff, *The Rise and Fall of the First American Patent Thicket: The Sewing Machine War of the 1850s*, 53 ARIZ. L. REV. 165 (2011) (providing background on this case).

116. *Sickels*, 22 F. Cas. at 78.

117. *Id.*

118. See Holte, *supra* note 15, at 682.

opinion representing the views of one or a minority of other Justices. Why did this happen?

The well-documented shift by lower courts to citing Justice Kennedy's opinion for the holding of *eBay* now may make sense. One can imagine that district courts and the Court of Appeals for the Federal Circuit were metaphorically lost at sea in response to *eBay*'s mandate that it apply non-existent historical case law in issuing injunctions for infringement of a valid patent. *eBay* explicitly said that it was applying a "four-factor test historically employed by courts of equity" drawn from a "long tradition of equity practice."¹¹⁹ Thus, after *eBay*, lawyers and judges looked at the historical cases representing this "long tradition of equity practice" for guidance in applying the *eBay* four-factor test, and they found nothing — or, at least, almost next to nothing.

Instead of the *eBay* four-factor test, trial and appeals court judges found opinions by courts sitting in equity in which judges assessed infringement and challenges to patent validity, which then created classic burden-shifting in which the patent owner had a presumption of an injunction that the defendant could attempt to rebut with equitable doctrines like balance of hardship or defenses like laches. The number of historical cases in which defendants carried this burden were exceedingly small, which explains why permanent injunctions issued to patent owners 91% of the time. But this presumption of an injunction appeared to have been rejected by *eBay* as improperly representing the "general rule" applied by the Federal Circuit in its case law since the 1980s.¹²⁰

As a result of the absence of any purported historical legal precedent — the sole justification for the four-factor test in the *eBay* majority opinion — judges understandably turned to the only part of the *eBay* decision that contained substantive arguments: the policy arguments by Justice Kennedy in his concurring opinion about allegedly new patent licensing business models and the supposed inequitable abuse by these patent owners of injunctions.¹²¹ Justice Kennedy's claims about the novelty of patent licensing, invalid patents, and litigation abuses were tendentious, and they have been the subject of much legal, historical,

119. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 390–91 (2006). The second quote from *eBay* in this sentence is from *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 320 (1982), and then *eBay* cites the preliminary injunction decision in *Amoco Production Co. v. Village of Gambell*, 480 U.S. 531, 542 (1987).

120. See *Robert Bosch LLC v. Pylon Mfg. Co.*, 659 F.3d 1142, 1148–49 (Fed. Cir. 2011) (stating that *eBay*'s rejection of a "general rule that a permanent injunction will issue once infringement and validity have been adjudged" meant that the traditional rebuttable presumption of injunctive relief had been abrogated (citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1247 (Fed. Cir. 1989)). But see *Gómez-Arostegui & Bottomley*, *supra* note 17, at 444 (contesting whether *eBay* abrogated the presumption of an injunction and "offer[ing] clear grounds for the Federal Circuit to revisit its 2011 decision in *Bosch* where it abandoned its separate presumptions concerning irreparable injury and the lack of an adequate remedy at law").

121. See *eBay*, 547 U.S. at 395–97 (Kennedy, J., concurring).

and policy criticism in the ensuing years.¹²² Nonetheless, he made substantive claims in law and policy that provided some guidance on how to apply the new four-factor test created by the *eBay* Court. The shift to Justice Kennedy's concurrence as the ersatz *eBay* decision, imbued with skepticism about the role of patents in the modern innovation economy, has corresponded with a significant drop in the rate of injunctions issuing for infringement of valid patents, as confirmed by rigorous empirical analysis.¹²³

Beyond confirming the change in the law of injunctive remedies for patent owners and explaining how this change influenced the law of patent remedies in the ensuing years, it is important to bear in mind some important limitations of this empirical study. First and foremost, it is not making any statistical claims about legal practices or litigation rates; it is testing only the veracity of two historical claims in the *eBay* decision. Thus, it is not making any claims about the relative scope of requests for injunctions by patent owners, changes in requests for injunctions, or other statistical claims in most empirical studies about patent litigation in which there is a legitimate concern about controlling for selection effects.¹²⁴ Second, this study is limited to the court decisions reported in the *Federal Cases* during the time period of 1790 through 1882. At some point later in the twentieth century, some courts started to talk in terms of multi-factor tests for both permanent and preliminary injunctions. This study does not address this later development in the law, but it need not, as it is testing the historical claim in *eBay* in Justice Clarence Thomas's majority opinion that there was a "long tradition of equity practice" confirming the existence of the four-factor test set forth in this opinion.¹²⁵ When Justice Thomas usually speaks of a "long tradition" in a doctrine that reaches back to the English common law, he is not talking about the 1980s.¹²⁶ Third, and certainly not least, this article does not make any policy or normative argument about *eBay*; it is entirely descriptive in its thesis in testing the two historical

122. See, e.g., Jonathan M. Barnett, *Has the Academy Led Patent Law Astray?*, 32 BERKELEY TECH. L.J. 1313 (2017); Alexander Galetovic, Stephen H. Haber & Ross Levine, *An Empirical Examination of Patent Holdup*, 11 J. COMP. L. & ECON. 549 (2015); Adam Mossoff, *Patent Licensing and Secondary Markets in the Nineteenth Century*, 22 GEO. MASON L. REV. 959 (2015); B. Zorina Khan, *Trolls and Other Patent Inventions: Economic History and the Patent Controversy in the Twenty-First Century*, 21 GEO. MASON L. REV. 825 (2014).

123. See Acri, *supra* note 14.

124. See generally George L. Priest & Benjamin Klein, *The Selection of Disputes for Litigation*, 13 J. LEGAL STUD. 1 (1988).

125. *eBay*, 547 U.S. at 391 (first quoting *Weinberger v. Romero-Barcelo*, 456 U.S. 305, 320 (1982); and then citing *Amoco Production Co. v. Village of Gambell*, 480 U.S. 531, 542 (1987)).

126. See *New York State Rifle & Pistol Ass'n, Inc. v. Bruen*, 597 U.S. 1, 21, 59–60 (2022) (adopting a legal standard rooted in "history and tradition" that considers authoritative eighteenth and nineteenth sources of public meaning of the Second Amendment and its incorporation against the states by the Fourteenth Amendment).

propositions set forth in the *eBay* decision. The normative import of this historical study and the 899 patent cases in equity in the *Federal Cases* reporter is the function of other articles, but not this one.

VI. CONCLUSION

This article empirically tested two authoritative historical claims by the *eBay* Court with a dataset of 899 patent cases in which federal courts sat in equity between 1790 and 1882. First, it assessed *eBay*'s famous — or infamous, depending on one's perspective — four-factor test for issuing injunctions, which the Court justified solely by appeal to history and tradition. The *eBay* Court's purported historical justification for its four-factor test is wrong: there was no "long tradition of equity practice" of a "four-factor test historically employed by courts of equity" in issuing injunctions.¹²⁷ No judge applied a four-factor test in issuing an injunction in a single patent case in the entire database of 899 cases, neither in issuing permanent injunctions nor preliminary injunctions. Thus, this article confirms the critiques of *eBay* by remedies scholars that *eBay* did not return patent law remedies to any traditional practices in equity; to the contrary, it achieved an "accidental revolution" in creating a *new* legal test for issuing injunctions for infringement of a valid patent.¹²⁸

Second, this article assessed Chief Justice Roberts' claim in his *eBay* concurrence that patent owners historically received injunctions for infringement of a valid patent in a majority of decisions. Although this has long been conventional wisdom among lawyers, judges, and scholars, it has never been empirically confirmed in a survey of historical patent decisions in equity. The database of 899 cases confirms that Chief Justice Roberts is correct: patent owners received injunctions in 91% of the cases in which a court found infringement of a valid patent. But Chief Justice Roberts only receives half-credit, however, because he still joined the unanimous majority opinion in *eBay*.

Ultimately, this article confirms the critiques of *eBay* by remedies scholars and it reinforces recently published historical research demonstrating that English equity practices at common law also contradict *eBay*'s appeals to "a long tradition of equity practice" as the sole justification for its four-factor test.¹²⁹ As this article explains, the United States continued these equity practices first developed in English courts in the ninety-two years following the enactment of the 1790 Patent Act by the First Congress. *eBay* did not return patent law or remedies law to any longstanding, historical practices in equity. It changed the law.

127. See *eBay*, 547 U.S. at 390, 391 (first quoting *Weinberger*, 456 U.S. at 320; and then citing *Amoco*, 480 U.S. at 542).

128. Gergen et al. *supra* note 16, at 205.

129. See Gómez-Arostegui & Bottomley, *supra* note 17, at 407.

This should be discussed and debated forthrightly as a legal revolution, shorn of its misleading and confusing claims to historical authority.