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THE WAY LAWYERS WORKED

Michael Risch
Mike Viney

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INTRODUCTION

Due to a shortage of federal district court judges, Justice Stephen Breyer decides to hear and try several cases in the District of Massachusetts. In one of those cases, his brother, now semi-retired Senior Judge Charles Breyer, appears as counsel for the plaintiff. Charles Breyer files a one-and-a-half-page handwritten motion for a preliminary injunction. The motion relies on the defendant’s former attorney’s
deposition testimony about what that attorney and his client, the defendant, discussed during representation. Even though Charles is the author of a treatise in this area, he fails to cite the key Supreme Court case—one that Stephen Breyer wrote only a few months earlier. Nevertheless, Justice Breyer grants the injunction, citing his prior opinion but leaving out other relevant Supreme Court precedent beneficial to the defense. When the Supreme Court decides a similar issue a few months later, Justice Breyer makes no mention of his district court opinion on the same topic.

Of course, none of this happened, but it would be jaw dropping if it had. The idea of a Supreme Court justice trying cases is foreign by today’s standards, though some appellate judges do so. That may be the least shocking part of the story because we are familiar with the historic practice of justices “riding circuit.” Conflicts of interest, lawyers testifying against their clients, case law missed by learned treatise authors, and Supreme Court precedent simply ignored by a justice are the types of eccentricities nobody expects from the legal system, either now or in the retelling of history. And yet, all of this and more happened in three ordinary cases about a kitchen gadget. Perhaps even more shocking, at least one of these examples legally continued well into the Twenty-First Century.

To know how the system worked in the 1800s is not so apparent. Today, we take visibility into court operations for granted. Modern media outlets not only describe cases but also routinely publish the actual court filings for lawyers and laypeople to examine and critique. This was never more apparent than after the 2020 presidential election, when President Donald Trump’s lawyers filed cases throughout the country alleging election fraud. Professional and amateur reporters alike were able to publish the actual court filings and comment on them, allowing members of the public to examine how the evidence presented in court matched with rhetoric; it also allowed for a deep look into the litigation process, including how courts handled filings made in the wrong court or the consequences of failure to serve parties and misspellings.

The development of the law and legal systems has historically been shrouded by a lack of published documents, especially when that development occurred nearly 170 years ago. Litigation documents were not typically available. Judicial rulings were not published unless a reporter decided to share it. And after more than a century, the memories of those involved are lost, leaving us with little insight into how lawyers and courts went about their business.

1. Charles Breyer remains a Senior Judge and does not practice on the side or author a treatise.
This Article shares how archived, unpublished documents can reveal new insights about the history of our legal system and provides an avenue for how other researchers might expand our knowledge in these areas. We shed light on the nineteenth century legal system, perhaps unexpectedly, by examining cases involving a simple household tool: the apple parer. Like eggbeaters and food mills, someone had to invent this common kitchen device; while there were many unpatented versions, early patented parers led to a string of litigation. Using contemporaneous records from media, litigation, and patent office filings, we closely examine the first apple parer patent litigation to highlight how court practices and the law developed at that time.

While everyone reads and cites nineteenth century judicial opinions, nobody has examined how litigants behaved given the constraints of limited communication methods available at the time. Few historical studies have considered the mechanics of litigation, let alone patent litigation, from that time. The first court cases involving apple parer infringement illuminate developments in litigation and patent law of the time. Documents associated with the cases show how the law developed and propagated, based on handwritten and often unpublished depositions, briefs, and opinions invisible to today’s online research services.

Finally, our research reveals an interpersonal story involving many of the same players in this area. These details, including non-reported lawsuits and settlements, are simply unavailable from the three published court opinions available from these first lawsuits.

Part I of this Article presents some background information. First, it describes the sources available for assessing historical litigation practices and the dearth of literature that actually leverages those sources. Second, it describes apple parers, including the invention at issue in the first litigation about them. Part II describes the three primary cases, along with a few unreported cases. In doing so, it explains and shows the archival material, original photos of the devices involved, and unreported court documents.

Part III synthesizes what we can learn from these cases. The topics range from visibility into legal practice, information dissemination, development of the law, and patent office practice. Part IV briefly concludes with some lessons for today.

I. BACKGROUND

A. Litigation

Lawyers know what they are doing—hopefully in the “competence” sense, but certainly in the “what does law practice entail” sense. They know which service providers offer deposition transcript and video services, which software is best for case management, and what litigation analytics say about judicial predilections. But even they do not know all; continuing legal education and bar conferences allow lawyers to learn current best practices from each other.

But the inner workings of law practice are a bit opaque to the outside observer. In one hundred years, no one will have first-hand knowledge of how law firms practice today. Historians will recreate such practice from accounts of the day as well as the court system. Each of these channels provides much more information than what was available 170 years ago.

Today, there are many more accounts of court cases and legal practice. This includes traditional journalism, blogging, and even Twitter accounts. But there is also a record of the continuing legal education and bar events (though these are often lost after a number of years). Finally, advertisements are not what they used to be. Rather than a one-inch square advertisement in the back of Scientific American, today’s vendors have entire websites that are archived at the Internet Archive, which stores old versions of web pages.44

Additionally, court watchers are somewhat familiar with how much of our litigation works today. Transparency with court operations is at an all-time high. One can easily obtain every court filing, oral argument, and decision with the click of a few buttons. There are even blogs devoted to watching these aspects as they happen.

Court documents are an especially important way to learn about litigation practice and the specifics of cases. Documents filed with courts preserve for posterity the actual evidence and underlying procedures used in the case. That is, copies of interrogatories and deposition transcripts show how discovery was done, motion filings show the style of argument, and exhibits show how documents were produced. For this reason, courts that go beyond sealing all but the most confidential information do a disservice not only to the living5 but future historians as well.


There was no internet in the nineteenth century. Court records were unavailable for easy retrieval, and indices either did not exist or were unavailable to the masses. Even today, the only electronic index available from the National Archives is sorted by name and/or case number rather than individual court documents. There were few legal periodicals, and many of them served primarily as legal digests of court outcomes. Further, published discussion often lingered on study of the past rather than explanation of the present. There were also legal dictionaries, which included short, useful summaries. And there were treatises, which provided a concise statement of the law. Finally, of course, there were contemporaneous accounts, letters, archives, and other materials from which historians construct history.

And yet, almost nobody has written about the specifics of litigation, how lawyers found precedent to cite, how official documents were distributed, or how the law developed in the shadow of technological limitations. While people have written about justices riding circuit, they have not addressed whether justices actually used the district court experience as a breeding ground for new legal theories—one of the purported purposes of the practice.

Others look at the business of the courts in terms of types of cases, rather than the behavior of advocates in those cases. For reasons of importance and availability, there is some attention devoted to practice

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10. 1 John Bouvier, A Law Dictionary Adapted to the Constitution and Laws of the United States of America, and of the Several States of the American Union; with References to the Civil and Other Systems of Foreign Law 408 (Childs & Peterson 6th ed. 1856) (The entry for deposition begins: “The testimony of a witness reduced to writing, in due form of law, taken by virtue of a commission or other authority of a competent tribunal.”).
11. 3 John Bouvier, Institutes of American Law (Robert E. Peterson & Co. 1854) (providing wide ranging law summaries, ranging from structure of the courts to evidence to substantive law, including patents). This book was dedicated to a pre-Dred Scott Justice Taney.
13. Glick, supra note 2 at 1761.
14. See, e.g. Fritz, supra note 3.
methods before the Supreme Court. Those articles that address specific narratives tend to present aggregate details about the industry and legal developments, rather than specifics about how the law was practiced. And, here and there, archivists might use source material to comment on nineteenth century practices.

Nineteenth century cases are much more than the opinions we read today. Fully understanding these cases requires an examination of archival case records to uncover the essential details.

B. Apple Parers

The apple parer is an American invention that appeared sometime during the late eighteenth century. Don Thornton’s book Apple Parers documents an astonishing variety of early parer designs made by artisans for their local community, which included: direct drive, belt drive, cord drive, wood pegs and teeth, and cast-iron pegs and gears. Despite the many varieties, the concept remained the same: an apple rotated, and a hand-held or mounted knife pared the apple.

Few patents marked the early years of apple paring inventions. Although many parers are known from the first half of the nineteenth century, only a handful received patents. Moses Coates (1746-1816) was granted the first U.S. patent for an apple parer on February 14th, 1803. In order to obtain a patent, inventors filed an application with the Patent Office, just as they would today. Patent examiners then considered what others had previously invented and determined whether the claimed invention was novel. Upon issuance of a patent, the owner had the right to exclude others from making, using, or selling the patented claim.

Ephraim Loriston Pratt (1817-1869) was a prolific inventor of apple parers, with eight U.S. patents granted for improvements in apple parer designs and one patent for an apple-slicing machine. Pratt established himself as an inventor of apple parers during the 1850s, a time when parers were increasingly mass-manufactured from interchangeable cast iron parts and designed to work solely by turning a crank. The mass manufacture of parers coincided with a dramatic increase in patents.
The first litigation involving a patent for an apple parer followed on the heels of these changes to apple parer design and manufacture.

Pratt’s creative power was evident from the very first apple parer design he chose to patent. An 1852 New York agricultural report takes note of Pratt’s invention: “One Pratt’s patent Automatic Apple Parer, J. Sargent, Shelburne Falls, Mass.; a "very ingenious and perfect contrivance to avoid personal labor; works expeditiously, evenly and surely, Thomas Fruit Cultivator $2.,” fig. 1.

Pratt was granted a patent for his Automatic Apple Parer on Tuesday, October 4, 1853. The Automatic Apple Parer was a quick return design—after paring an apple, the knife returned to its original position, under spring tension, with a snap, fig. 2.

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21. 5 DOCUMENTS OF THE ASSEMBLY OF THE STATE OF NEW YORK, SEVENTY-SIXTH SESSION, no. 112 (1853).
The patent did not secure the quick return mechanism, however. By describing it but not claiming it, Pratt dedicated that portion of the patent to the public domain. It appears that other patents disclosed self-returning mechanisms as well. Instead, Pratt claimed as his invention a mechanism that allowed “the knife to vibrate and accommodate itself to any irregularity in the surface of the apple or vegetable pared.”

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22. Decision of Commissioner in Case of E.L. Pratt Assigned to Sargent & Foster (Aug. 1853). If the reader desires, copies of this source and similarly-aged sources throughout this Article are available both at the National Archives and from the authors.

“vibration,” which also allowed for a rotation “around the rod in a circular direction” was the primary inventive leap of Pratt’s first patent. It allowed the knife to better conform to the curves of the apple on each end as well as any other odd shapes.

Many pre-patent versions of this parer are made with a block carrying the knife, known as the paring head, which did not rotate about the paring arm, fig. 1. This is a seemingly minor difference, but the rigidly mounted knives left parts of an apple, especially the ends, unpeeled. Indeed, during one of the cases discussed below, the defendants elicited testimony from a machine craftsman, John Williams (1806-1882), who testified that he built the exact machine described in Pratt’s patent, except for the loose knife. Williams described how the serendipitous discovery occurred. The threads of the knife were stripped and no longer secured the knife. So, Pratt carved a V-shaped groove in the rod to hold it in place, but it held much more loosely than the threads would. Pratt then discovered that his new construction was better at paring apples than the rigid knife.

Williams went on to testify that Pratt was “not a responsible man to work for” and that Pratt had Williams look to Sargent & Foster to pay for his work. This might explain why Pratt wound up selling his invention. Pratt explicitly noted and claimed as his invention a paring head that is designed to rotate about the block to accommodate itself to irregular surfaces being pared. Thus, his parer removed the apple skin completely, except for the “small space” right next to where the apple was mounted.

Pratt transferred the rights to his invention by listing himself as assignor to James Sargent (1824-1910) and Dan Packard Foster (1815-1893). Pratt’s design would now be advertised and sold as Sargent & Foster’s Patent Automatic Apple Parer. An advertisement for Sargent & Foster’s patented parer appears in a September 1, 1855 issue of The Ohio Cultivator, fig. 3—advertisements appeared in newspapers as well.

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24. Deposition of John Williams, Sargent v Larned (Printed Version) (May 1855).
25. Pratt did sell his inventions to several different companies over the course of his life.
II. APPLE PARER LAWSUITS AS A WINDOW INTO NINETEENTH CENTURY LITIGATION

Cases asserting infringement of Ephraim Pratt’s 1853 patent for an improved apple parer comprise the first three trial court cases involving a patent for an apple parer invention, but as discussed below, these reported cases were not the only cases involving this patent. The National Archives includes files of more litigation, which provide valuable details about attempts to avoid litigation through interferences and written agreements.

Sargent & Foster sued many infringers during the 1850s. The three primary cases involved two competitors. The first was John Seagrave and the second was Charles Carter. Seagrave and Carter were also apple paring device inventors and manufacturers but ran into trouble when they attempted to use Pratt’s improvement in their products.

These first three cases were heard in circuit courts, two in Massachusetts and one in Rhode Island. All were presided over by Benjamin Robbins Curtis (1809-1874), a Supreme Court justice. Like other members of the Supreme Court during this period in U.S. history,
Justice Curtis “rode circuit.” Much of a Supreme Court justice’s time during the year was spent traveling between several circuit courts to hear cases. When they did so, they sat as trial judges. Many of the famous patent trial court opinions were written by Supreme Court justices riding circuit, though maybe the cases became famous due to the authors’ identity. Even so, the pay was modest, there were no pensions, and time away from home could be stressful.27 Worse yet, traveling expenses were not covered. One positive aspect of the job description is that it resulted in more interaction between the public and Supreme Court justices.

Curtis served as a Supreme Court justice for only six years, from 1851-1857. He was the first justice to have formal legal training and the only Whig ever to serve on the Court. Curtis was one of two dissenters in the Dred Scott decision.28 In fact, Curtis eventually resigned from the Supreme Court over bitter disagreements with Roger Taney (1777-1864) precipitated by the Dred Scott case, making him the first and only justice to resign as a matter of principle.

Despite his short time on the Court, Curtis was no stranger to patents. His brother, George Ticknor Curtis (1812-1894), was a well-known patent lawyer who wrote a leading treatise of the time, Curtis on Patents. The second edition of the treatise was published in 1854, just as the apple parer cases were being heard.29 The justice himself had learned patent law while practicing in Boston beginning in 1834.30

Curtis’s familiarity with patents was probably a good thing for the development of patent law in the trial courts.31 At that time, federal courts were localized and politicized, so having a Supreme Court justice with patent experience to decide patent cases was unusual32 but helpful.33 It is reasonable to assume that he both understood the nature of cases before him and had an interest in shaping patent law.

27. Glick, supra note 2.
29. GEORGE TICKNOR CURTIS, A TREATISE ON THE LAW OF PATENTS FOR USEFUL INVENTIONS IN THE UNITED STATES OF AMERICA (Little, Brown and Company 2nd ed. 1854).
A. The First Case: Sargent et al. v. Larned et al., 1855

Collectors of apple parers have noticed that parers similar to that of Pratt’s design contain labels attributed to different manufacturers. In fact, we discovered that these unusual parers relate to the first case involving an apple parer patent, in which Sargent & Foster brought a suit in equity against Larned and Seagrave. The case was more complicated than a mere infringement suit, and the judge eventually determined whether a covenant signed between the two parties was valid. In fact, the court considered two contracts signed by both parties.

1. Early Interference Practice

The first contract considered in this first case resulted from an interference declared by the Patent Office. An interference is a trial held in the Patent Office to determine the first inventor when two applicants claim the same invention. Both E. L. Pratt and John Dorrington Seagrave (1814-1893) had claims to a similar improved apple parer design, but the patents had not yet been granted. Pratt’s patent appears to have been in a better position, because Pratt had filed a “caveat” with the Patent Office two years earlier, which gave public notice of his early invention date. A caveat was a filing that allowed inventors to be notified if someone else tried to claim the same invention before a patent was filed. It had the effect of placing a stake in the ground. Today’s closest analogue is probably a provisional patent, which allows the applicant to secure a filing priority date without actually applying for a patent; however, the Patent & Trademark Office no longer notifies applicants of similar patent filings.

34. Figure 4. Parer similar to Pratt’s design with known examples that have different manufacturing labels.
Figure 4. Quick Return Parer, similar to Sargent & Foster (Pratt’s design), found with two different manufacturing labels, either Larned & Seagrave or Sargent & Foster.
The interference involved the design of the knife blade attachment. In this first agreement, Seagrave verbally consented to withdraw opposition to Pratt’s patent in the interference, essentially conceding that Pratt was the first inventor. Withdrawing the opposition would give Pratt the patent and leave Seagrave with nothing. Seagrave testified that both parties agreed that, if Pratt were granted his patent, then each would use the other’s improvements and, in all events, Seagrave could use Pratt’s improvement for a license fee. Seagrave claimed that Sargent, who had purchased Pratt’s invention, did not want that part in writing because it would endanger the patent.

Thus, the resulting written contract, dated September 6, 1853, merely stated that John D. Seagrave was engaged in making certain paring machines that incorporated an improvement invented by E. L. Pratt for which Pratt had a patent pending to which Sargent & Foster were assignees. The contract gave Seagrave license to assemble and sell castings already made at a market price equivalent to Sargent & Foster’s machines. But there was no mention of a license by Sargent & Foster that would allow Seagrave to use Pratt’s improvement in Seagrave’s future parers. Thus, any use of Pratt’s invention would be infringement if the written agreement were followed to the letter.

Seagrave did withdraw any overlapping claim to the same invention. This withdrawal looks strange by today’s standards, as it simply withdraws any interfering subject matter with no mention of any specific details. However, it sheds light on how nineteenth century interferences were conducted. Today, patent claims are considered “peripheral,” meaning that each claim describes the exact metes and bounds of the claimed invention. As a result, an interference always required essentially identical claims, at least until the practice was abolished in 2011. Indeed, patent applicants would sometimes copy a claim right out of someone else’s patent and put it in their own application to trigger an interference. Thus, an amendment to end an interference will very specifically drop the conflicting, identical claim. But prior to the late 1800s, “central” claiming ruled, meaning that patentees claimed some set of elements as set forth in the patent specification. For example, Pratt’s patent claim included “Hanging or connecting the block S...substantially as described.” The first phrase would be remarkable today, because modern patent claims are more general than this and do not refer back to the drawings (“block S”) except in rare, statutorily defined situations. The
second phrase would also be remarkable today but was standard for the time.

The changing interference practice is relevant to the Pratt/Seagrave interference, because the proposed claims in the competing applications were completely different. If the patent office found a similarity for interference, it must have been in the description rather than the claimed invention. In fact, Seagrave’s initial claim had nothing to do with knife vibrations:

I do not claim as my invention the general structure of the machine nor any part thereof, except the following. The forks capable of being changed by the set screw. The sheath of the fork and the arrangement for throwing off the fruit [and other elements of the fork]…as hereinbefore described.

Seagrave’s attorney wrote to the Commissioner of Patents asking what Pratt’s invention and filing date were, reiterating that his invention was about throwing the fruit off. At the time, all patent application information was kept secret until the patent was issued. As a result, the Patent Office declined the request unless Sargent & Foster agreed as assignees. Interestingly, the letter from counsel was sent after Seagrave had withdrawn any interfering subject matter, so Seagrave subsequently told the Patent Office to ignore the request for information.

So, when Seagrave “withdrew” any offending invention in the interference, he did not actually amend his patent at all. Instead, he simply disclaimed any subject matter, “so far as [it] interfere[d] with the junior application of E.L. Pratt…” The withdrawal appears to have been in name only, as Seagrave never attempted to patent a loose knife attachment, despite his insistence that Pratt “admit[] that he ha[d] the junior right.”

Seagrave’s final issued claim differed from the initial application by disclaiming other prior art and including a very specific description of the claimed arrangement. Rather than naming Pratt’s patent, Seagrave instead disclaimed Carter’s 1849 patent for a return-style parer. Indeed, the final claim was drafted by someone at the Patent Office and suggested as an acceptable amendment to overcome novelty concerns associated with the Carter patent. This type of recommendation is also highly unusual today.

As discussed below, Charles Paige Carter claimed that he was...

43. Specification and Claims as Amended, supra note 42.
44. Letter from Dwight Foster to Commissioner of Patents (Sep. 1853).
45. Letter from Patent Office to John Seagrave (Sep. 1853).
46. Letter from John Seagrave to Patent Office (Nov. 1853).
47. Letter from John Seagrave to Patent Office, supra note 39.
49. Charles deGrazia et al., Examination incentives, learning, and patent office outcomes: The
the original inventor of Pratt’s innovation as a defense against a suit brought by Sargent & Foster. The Patent Office apparently agreed, at least with respect to the broad notion of an automatic return parer, which was Seagrave’s initial claim. Despite all this effort, no known model of Seagrave’s apple parer included removable forks or a “throwing off” functionality so important to the patent.

This strange, short-lived interference differs from modern practice in how it began and how it ended. From a legal standpoint, it illustrates the differences between patent claiming practice in the 1850s and today. At the beginning, that an interference would be instituted on such different claims is surprising by today’s standards because today’s interference requires identical claims, while the 1850s Patent Office clearly had a broader understanding of the term “interfere” in the statute. At the end, it is shocking from a public notice standpoint that a pending interference action could be terminated through such a non-substantive withdrawal of subject matter. It would have been nearly impossible to identify the overlapping invention or the released patentable subject matter. From a marketplace standpoint, it shows the importance of Pratt’s vibrating knife invention. Though claiming to be the first inventor, Seagrave’s push-off fork assembly was easily avoided by others—Seagrave gave up the opportunity to pursue what turned out to be an important invention that could not be replicated without infringing. It appears that Seagrave represented himself for at least a part of the interference, while Pratt, Sargent, and Foster had counsel.

After settlement of the interference, E. L. Pratt’s patent of October 4, 1853 was the thirteenth patent granted for an apple parer. The U.S. granted its fourteenth patent for an apple parer to John D. Seagrave on April 18, 1854, fig. 5. Seagrave made no mention of a loose knife in the 1854 patent, either in the description, illustrations, or in the claims.

50. Compare former 35 U.S.C. § 102(g)(1) (abrogated in 2011) (requiring an interference when the invention—which is the claim—is the same) with § 8 of the Patent Act of 1836, Ch. 357, 5 Stat. 117 (July 4, 1836) (requiring adjudication when an application would “interfere” with another patent or application).


2. The Ensuing Litigation

After Seagrave’s 1854 patent issued, the parties could not come to an agreement based upon their first contract, presumably because Seagrave was unhappy with his agreement to withdraw his claim, and Sargent refused to grant a license. Indeed, Sargent & Foster even sued Seagrave in April of 1854 and then quickly dismissed the case. The court stated that the plaintiffs discovered their error—presumably the existence of a contract—but it was more likely that Seagrave threatened to sue them for fraud or breach of contract. So, a second written agreement was formulated and dated May 26, 1854 that was slightly fairer to Seagrave.

In the second contract, Seagrave agreed not to “make *any* apple paring machines.” In exchange, Sargent & Foster agreed to pay $117 for castings already made by Seagrave. Seagrave was entitled to sell machines that were already assembled, numbering 1,500 in Worcester and 500 to 700 in other places at prices equivalent to Sargent & Foster. All machines were to be sold within eight months or not at all. Sargent & Foster retained the right to extend this deal another eight months during which Seagrave would be allowed to build and sell his machines. Seagrave signed the second contract and received due compensation. Despite its importance, Sargent lost his copy of the agreement and had to request a court order for

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Seagrave to produce a copy. Furthermore, due to technological limitations at the time, printed patents were not created and copied immediately. Indeed, issued patents were not regularly printed until 1867, and the printed patents seen before this time, including Pratt’s, were likely later transcriptions of the original handwritten patents held by patentees and copied in the Patent Office binders. The patent in evidence in Sargent v. Larned was a handwritten copy, including the drawings, fig. 6. Most of the patents in all these cases were referred to by name and date, rather than by patent number, which was presumably assigned later when the patent was bound in the Patent Office volumes.

Figure 6. Drawing from Pratt’s Patent from Litigation Files.

But Seagrave read “any” to mean only apple paring machines that infringed Pratt’s patent. This was not an unreasonable reading; the court noted that Sargent collected only the infringing parts as part of the written agreement and left Seagrave with parts for other apple parers. Thus, Seagrave continued to make parers using his April 18, 1854 patent but did not leave the knife loosely connected to the rod as set forth in the Pratt patent. Seagrave instead modified the paring arm, leaving it loose where it met the main machine. Seagrave argued he was using an improved paring arm design that was unique and did not infringe upon Pratt’s

55. Pratt’s Apple Parer Patent (Pre-Print Version) (Oct. 1853).
patent, thereby complying with the May 26, 1854 covenant. Perhaps Seagrave truly believed that a “loose arm” was different than a “loose knife.” This improvement would later appear on another apple parer patent granted to Seagrave.\textsuperscript{56} However, Seagrave only described the rod’s turning motion, rather than claiming a loose rod as a patentable invention.

Nonetheless, Sargent & Foster moved for a temporary (now called preliminary) injunction.\textsuperscript{57} The motion was two and a half handwritten pages—almost comically short by today’s standards. Also short was the testimony, with a deposition transcript taking up maybe five or six handwritten pages instead of the more than 200 transcribed pages per day in today’s depositions. Though it was short, the final submission was not that short. The parties submitted entire transcripts, despite being several pages, in evidence. Thus, the short motion was supported by much longer testimony than would be expected today when parties cut and paste a single question and answer or photocopy select pages of a printed transcript. Other litigation in the nineteenth century followed these norms, but the complex aspects of patent cases, including testimony from expert witnesses and prior art references, meant that litigants and courts were particularly hamstrung by the available litigation technology.

The first question was whether Larned and Seagrave could challenge the validity of the patent at all because of their agreement with Sargent. The court—still Justice Curtis—noted that “equity will not allow Seagrave to violate his covenant and defend himself by attacking the validity of the patent.” Though this holding is but a side point to the story here, it was an important one, implicitly affirmed in a Supreme Court opinion authored by Justice Curtis a few months later.\textsuperscript{58} In this sense, the district court was a testing ground for legal rules; Sargent v. Larned was not even cited in the Supreme Court opinion. More than one hundred years later—much too late for Seagrave—the Supreme Court finally ruled that licensees are not estopped from challenging the validity of licensed patents.\textsuperscript{59}

After disposing of the validity challenge, the court turned to infringement. Justice Curtis considered Seagrave’s argument by comparing Pratt’s patented improvement with Seagraves new design, fig. 7.

The improvement patented consists in so attaching the knife block to the rod which moves it, as to allow it to rotate around the rod at right angles therewith, and thus the knife accommodates itself to any irregularity in the

\textsuperscript{57} Motion for Temporary Injunction, Sargent v. Larned (1856).
\textsuperscript{58} Kinsman v. Parkhurst, 59 U.S. (18 How.) 289 (1855).
surface of the vegetable to be pared. The defendants, instead of making the knife thus movable on the rod, have made the rod movable in its socket. *The knife block has the same motion; but in one it is around the rod, in the other, it is with the rod.*

Justice Curtis concluded that Seagrave’s change in mechanical structure was merely a change in form and did not introduce “a new mode of operation, within the meaning of the patent law.” Thus, the Court held that it was an infringement of Pratt’s patent—citing *Winans v. Denmead* for support. Justice Curtis also authored the opinion in *Winans v. Denmead*, which held that an octagonal-shaped railroad car was close enough to a circular-shaped car to infringe. *Winans* is considered by many to be important in the evolution of the doctrine of equivalents. To this day, the doctrine of equivalents can be used to find infringement of a patent even when the accused product is not an exact copy. The *Winans* case introduced the test in this way: “In our judgment, . . . [the accused railroad car] must be so near to a true circle as substantially to embody the patentee's mode of operation, and thereby attain the same kind of result as was reached by his invention.” The decision was five-four, with Taney in the dissent. And though it was a close case, the doctrine of equivalents continues as a viable infringement theory today. The current standard echoes *Winans*, asking whether a similar but not identical element performs the same function, in the same way, with the same result.

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62. *Id.*
63. Morriss & Nard, supra note 32 at 165 (*Winans* was first case to recognize non-literal infringement).
64. *Winans*, 56 U.S. at 344.
Figure 7. Top, Sargent & Foster’s paring arm is hinged, but with a paring head that can rotate 90 degrees about the paring arm rod. Bottom, Larned & Seagrave design in which the paring head has very little play, but the rod is in a socket to allow the paring arm to rotate (note that this example has a Sargent & Foster label – discussed below).

It surely did not hurt that Sargent & Foster were represented by Justice Curtis’s brother, George Ticknor Curtis. Surprisingly, however, the basis for the decision did not yet appear in the *Curtis on Patents* treatise. While the 1854 second edition of the treatise had a section on infringement by equivalents, which cited several lower court decisions, the 1853 *Winans* decision, in which the Supreme Court put the issue to bed, was missing from it. In the temporary injunction motion filed with the court, George Curtis instead cited the *O’Reilly v. Morse* case for the proposition that an infringing product need not exactly match the patent claim. The curious non-citation of *Winans* is addressed further below.

Justice Curtis ruled that Seagrave was bound by the second covenant, and selling the revised parer was therefore an infringement. The court

67. Motion for Temporary Injunction, Sargent v Larned, *supra* note 57; O’Reilly v. Morse, 56 U.S. 62 (1853).
enjoined sales and awarded Sargent & Foster an accounting of Seagraves’ profits. Pitt A. Larned (1811-1897) is named as the first defendant in this case. The judge noted that Larned was merely a workman for Seagrave and should not be affected by the judgment. Perhaps Larned was named in the case because his name appears first on paper labels made for their parers. He was related to John D. Seagrave by marriage; Seagrave was married to Pitt Larned’s half-sister Sarah Burnap Larned (1814-1865). Thus, the plaintiffs may have reasoned they were business partners. In October of 1855, Larned and Seagrave settled the case with Pratt. They agreed to a permanent injunction and a return of $500 in profits.\(^{68}\)

A quick return parer similar to Pratt’s patent, but with a different gear arrangement, is well known to collectors, as shown in fig. 4, above. Some examples of this parer bear Sargent & Foster’s paper labels, as noted in fig. 7, while others have Larned & Seagrave paper labels. In fact, one known example has one company’s label pasted over another company’s label.\(^{69}\)

Don Thornton noted in his book *Apple Parers* that the relationship between the two manufacturers was unknown at the time his book was published.\(^{70}\) The label issue has thus always been a mystery to apple parer enthusiasts. Antique collectors have long thought that the parer shown in fig. 4 was manufactured by both Sargent & Foster and Larned & Seagrave.

The litigation reviewed here, however, explains the enthusiasts’ confusion and solves the unknown source of different labels. This first court decision provides evidence that parers of this design were most likely manufactured by Larned & Seagrave, but some were eventually labeled and sold by Sargent & Foster through their parts purchase of May 26, 1854 and any settlement after the injunction.

**B. The Second Case: Sargent et al. v. Seagrave, 1855**

The first case was not the end of the dispute, though. John’s brother, Joseph Day Seagrave (1824-1898), started making the Larned & Seagrave parer after the above judgment. In a new case in Rhode Island, with Justice Curtis riding circuit, Sargent & Foster asked the court for a preliminary injunction to stop Joseph from making and selling the improved parer because it infringed on Pratt’s patent in the previous court decision.\(^{71}\)

While this seems like an obvious end-run around the court’s earlier

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68. Final Decree, Sargent v Larned (Oct. 1855).
69. THORNTON, supra note 18 at 104.
70. Id.
ruling, it was a shrewd legal strategy by the Seagrave brothers. While John Seagrave was estopped from challenging the validity of the patent due to the license, Joseph was not bound by such a limitation. As such, he provided the court with several prior unpatented apple parers that he claimed practiced the same improvement patented by Pratt. This strategy worked in part; while Justice Curtis expressed doubt that any of the prior parers would invalidate Pratt’s invention, he left the question for trial to answer.

There is no discussion in either opinion about whether the Pratt patent constituted an “invention”—what we would call obviousness today. For modern day patent law, obviousness is a critically important patent doctrine. It invalidates any patent that a skilled artisan would have invented given the state of the art at the time, even if the exact invention had not been known before. The point of the rule is to keep inventors from patenting minor improvements to existing technology, only to block others from using minor achievements and crowd industries with low value patents. This judge-made doctrine was called “invention” for about a century but was codified and renamed obviousness in the 1952 Patent Act. 72

But obviousness/invention was in its infancy at the time of Sargent v. Seagrave, 73 and perhaps Justice Curtis did not have it front of mind. Then again, he may have had a desire for full trial testimony before allowing Seagrave to make validity arguments in an attempt to invalidate the Pratt patent. Obviousness was indeed an issue, though. During the Pratt patent prosecution, the Patent Office was concerned that, “The only doubt about the propriety of granting a patent grows out of the obviousness of the contrivance….After due reflection and some consultation with others I am disposed to think there sufficient ingenuity manifested to entitle the applicant to a patent….?” 74 In fact, the Patent Office did not allow a second claim, which it considered to lack invention—or to be obvious—in obviousness light of the prior art.

In a full-blown litigation with appeal, however, the “invention” of Pratt’s asserted claim might have been challenged. Pratt’s accidental invention illustrates an interesting gloss on obviousness. While nineteenth century cases generally spoke of “invention,” accidental invention was frowned upon at least as early as 1941, when the Supreme Court required a “flash of creative genius.” 75 However, the 1952 Patent Act reversed this line of cases, stating explicitly that the manner of invention shall not

74. Decision of Commissioner in Case of E.L. Pratt Assigned to Sargent & Foster, supra note 23.
render an invention obvious.76

But Seagrave’s gambit to challenge the validity of the patent only worked so well, because the judge ordered a preliminary injunction pending trial anyway:

He voluntarily assumed the position of infringing an existing patent, in the validity of which, his brother had so far acquiesced as to be enjoined…. This does not prevent him from contesting its validity. But it does prevent him from alleging that any particular hardship attends his case, … that he must refrain from further infringing, until he has proved the invalidity of the patent on a trial at law.77

Apparently, the preliminary injunction was enough to dissuade Seagrave.78 The matter proceeded to trial, and after a jury was empaneled, Seagrave withdrew his answer and defaulted.79 The Court ordered a permanent injunction and referred the matter to a special master to determine damages. The archives do not contain the results of the special master’s hearing (if there was one prior to a settlement). Given that Seagrave chose to default rather than try the case, there were likely low damages. Due to the injunction, Seagrave had probably not sold many parers upon (re)entering the market.


A third case involving Sargent & Foster’s Automatic Patent Apple Parer was brought against Charles P. Carter. Sargent & Foster applied for a preliminary injunction to stop Carter from making and selling parers that contained the loose knife improvement protected by Pratt’s October 4, 1853 patent. This case was filed in Massachusetts, once again before Justice Curtis.

Carter admitted to making a considerable number of parers bearing the mark P under contract with a wholesale dealer to make and sell the same model in large numbers. Justice Curtis noted that Carter’s parers are indistinguishable (with respect to the patented improvement) from the parers found to be an infringement of the October 4, 1853 patent in the previous two cases.

In his defense, Carter claimed that he was in fact the original inventor of Pratt’s improvement used in Sargent & Foster’s Automatic Patent Apple Parer. Carter claimed that his apple parer patent of October 16, 1849 accidentally failed to mention the loose knife improvement.

76. 35 U.S.C. § 103(a).
78. Lubar, supra note 31 at 958 (of 1850s patent litigation: ”A hearing before a judge, followed by an injunction, became the general rule in patent cases.”).
This was not the only time Carter claimed to have been an earlier inventor. For example, he claimed to invent the phonograph before Thomas Edison, alleging that he had simply failed to patent it. Carter also claimed to have invented the very first apple parer and to obtain the first patent on one, both of which were demonstrably false. Like many cases, this is an example where evidence presented to the court varied significantly from statements made to the public. The laws of evidence are the great equalizer.

Carter sought and obtained a reissue of his 1849 patent, which was granted on August 12, 1856, fig. 8. The reissue corrected the supposed oversight of claiming a loose knife. Carter claimed as his invention: “Giving to the knife a slight play around its axis independent of the mechanism which actuates it, for the purpose herein set forth.” The supposed purpose set forth was to allow the knife to accommodate itself to uneven surfaces of the apple. Carter believed this language to be equivalent to Pratt’s loose-knife improvement.

To rebut Carter’s claim that the oversight was a mistake, Sargent & Foster used the testimony of Carter’s own patent solicitor. This litigation took place before the attorney-client privilege applied to patent lawyers.


82. Note, the only known example is missing some parts, including the paring head—the infringing part!
and Carter’s solicitor, Robert Henry Eddy (1812-1887), testified via deposition in the Larned case, but that same testimony was used in the Carter case, where validity was more of an issue, fig. 9.83 Eddy was not new to litigation; he had testified in another case where he helped obtain the patent for using ether as a surgical anesthetic.84

Figure 9. An example of patent solicitor testimony that would be barred today.

Eddy testified that Carter never told him about a construction that would have allowed for the loose knife. If Carter had, then Eddy would have put it in the original Carter patent specification. In other words, there was no mistake. Carter apparently used a different patent solicitor to obtain his reissue patent.85

More importantly, Carter’s patent solicitor Eddy was also Pratt’s patent agent on the patent in suit. At the time, most patent practitioners were not lawyers but unregulated patent agents.86 By today’s standards, this would likely have been a conflict of interest—to prosecute competing patents on very similar technology at the same time. Eddy testified that the invention of Pratt’s patent was the vibrating knife and he was unaware of seeing or hearing about that invention anywhere else, presumably including from Carter. This was surely devastating testimony to Carter’s claim of prior invention.

While dual representation is problematic today, the testimony is not so foreign to today’s mores. Until very recently, the “conduit” theory was the primary theory of patent lawyer-client privilege.87 So long as the information sought was technical information about the invention, from

85. Carter’s Reissue Patent was the only patent file that we could not retrieve from the National Archives.
87. See, e.g., In re Queen’s Univ. at Kingston, 820 F.3d 1287 (Fed. Cir. 2016) (recognizing patent agent privilege for the first time).
the client, intended to be conveyed to the patent examiner, with the patent lawyer as a conduit between the two, then it was not privileged. Eddy’s testimony fell within the conduit exception and was not only allowed in the 1850s but would have been allowed in the 1980s.

The defendant, Carter, produced an affidavit from two experts who testified that Carter’s invention was substantially the same as Pratt’s. He also produced several affidavits from witnesses who claimed that they had seen a similar invention. These affidavits were by and large ignored, as they often were. Affidavits are still ignored because of a principle set forth in a much later Supreme Court case:

[A]lmost every important patent, from the cotton gin of Whitney to the one under consideration, has been attacked by the testimony of witnesses who imagined they had made similar discoveries long before the patentee had claimed to have invented his device, [which] has tended to throw a certain amount of discredit upon all that class of evidence, and to demand that it be subjected to the closest scrutiny.

Figure 10. Affidavit of farmer Samuel Morse…No Relation to the Samuel Morse.

The complainants, Sargent & Foster, submitted an affidavit from an expert who detailed experiments with Carter’s parer and found that the knife could not move independently of the mechanism that actuated it once the machine was in motion. In other words, although Carter’s patent described the ability to move the knife arm to accommodate different apple shapes, once paring, the knife blade locked into place and could not vibrate back and forth, thus operating differently than Pratt’s invention. The expert testimony of a rigid knife was consistent with Carter’s own initial advertisements, which stated that the knife was held steady.

The defense offered two additional improvements, which were made by Carter, that they argued were equivalent to Pratt’s patent but predated it—a flexible arm carrying the knife block that could undergo torsion, and a socket/pin mechanism for securing the rod carrying the knife block. Both modifications, the defense claimed, allowed the knife to oscillate to

accommodate itself to irregularities in the surface of the fruit. Justice Curtis noted that the flexible arm was not described in the patent application. Furthermore, Carter was not currently using the design on his parers. Justice Curtis also noted that the socket/pin system was not described in the patent application. And an affidavit from the complainants stated that their expert demonstrated experimentally that the socket/pin system did not oscillate once the machine was in motion.

Justice Curtis denied, at least until trial, the defendant’s claim that he was the original inventor of the loose knife improvement. This ruling demonstrates two important features of patent law. First, claims added later (here in the reissue) must be supported by the written description of the invention at the time of first filing. This is still an important rule today, although this case is never cited for that proposition. Second, even if a patent does not describe an improvement, a defendant may still argue prior invention by demonstrating evidence that such an invention was made. Here, the Court deferred to a jury trial the question of whether any of Carter’s prior models practiced the Pratt invention before Pratt did, even if Carter failed to describe them in his patent application.

In September 1856, Curtis issued a preliminary injunction preventing Carter from making or selling parers that were found to infringe upon Sargent & Foster’s patent, though the case was not reported until May 1857 along with the denial of Carter’s claim to first inventorship. As with the Seagraves, the preliminary injunction was enough to halt the infringing activity. The parties agreed to make the injunction permanent in 1857, and the court assessed costs of about $100, most of which appeared to be from obtaining copies of the record from prior cases. Unlike Larned & Seagrave, the damages were low, only $5. This was a highly competitive and fast-moving area. As the next section discusses, this invention was not the first time these inventors would tussle for priority.

D. Other Cases

The first three cases were the only reported decisions, but they were not the only cases brought to enforce Pratt’s loose knife patent. Sargent & Foster also sued David Henshaw Whittemore (1832-1892), who later invented a lathe-style parer, on the same day they sued Carter. It may

92. The America Invents Act patent reform of 2012 changes the rules a bit, but the general proposition still stands that prior art need not be present in a patent only.
93. Decree of Temporary Injunction, Sargent v. Carter (Sep. 1856); Sargent v. Carter, 21 F. 495.
95. Bill of Complaint Against Charles P. Carter, Sargent v Carter (Jul. 1856); Bill of Complaint
be an accident of history or deliberate strategy, but the concurrent lawsuits filed by Sargent & Foster against Carter and Whittemore in the vibrating-knife cases were filed on the same day that depositions were taken on behalf of Pratt—July 11, 1856—in a separate three-way interference on the later lathe-parer invention, which all three claimed to have invented. Perhaps knowing that each party would be in the room, George Curtis decided on the expedient solution for service of process. Or perhaps this was strategic behavior designed to maximize settlement leverage.

The court granted a preliminary injunction in September 1856, the same day as Carter. However, due to the informal nature of case reporting at the time, only the Carter injunction was reported. The Whittemore case settled about a year later (in September 1857, on or around the same day as Carter) for $5 and a permanent injunction. The low dollar amount implies that Whittemore had also sold very few units, though the case files do not reveal information either way. The timing of the motions and settlement imply that Whittemore tied his defense to Carter’s, and when Carter failed, Whittemore settled as well.

Carter and Whittemore were further tied together in refusal to pay after settlement. Sargent & Foster had U.S. Marshals seize more than 10,000 pounds of apple paring machines and casted and wood parts from each of the defendants on the same day, January 27, 1858. This method of obtaining property to satisfy a judgment is still in use today, and it is still carried out by the U.S. Marshal Service in federal cases.

Carter and Whittemore were not the only defendants sued on that same day. Sargent & Foster also sued Ephraim Brown (1820-1900) on that day in July of 1856. Brown settled for $50 and a permanent injunction about three months after the suit began but only about two weeks after receiving the affidavits filed by Carter in his case. Brown settled before Justice Curtis issued the preliminary injunction. It appears that both Whittemore and Brown relied on Carter to make the invalidity defense (though Whittemore also included some affidavits), and when that failed, they settled.

The complaints against Brown, Carter, and Whittemore all reference another settlement with James L. Haven (1825-1901) and Benjamin F. Paddock (1837-1908) in Ohio for $200 and an agreement to cease using the patent. The parer at issue was likely one invented by John David Browne (1807-1891), as those were the parers offered by J. L. Haven &

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Against D.H. Whittemore, Sargent v Whittemore (Jul. 1856).
96. Decree of Temporary Injunction, Sargent v Whittemore (Sep. 1856).
97. Agreement for Judgment, Sargent v Whittemore (Sep. 1857); Final Decree and Permanent Injunction, Sargent v Whittemore (Sep. 1857).
98. Writ of Execution, Sargent v Carter (Jan. 1858); Writ of Execution, Sargent v Whittemore (Jan. 1858).
Co. during that time period.99 Browne received two patents in 1856.100 This settlement may account for the rarity of the Browne parers today.

While these cases were nowhere near the “litigation explosion” of the time,101 they were an example of a manufacturer aggressively filing suit against infringers, which is reminiscent of patent litigation campaigns today. Sargent & Foster sued at least five infringers and must have expected to sue more because they went to the trouble of printing a “form” complaint, in which they could handwrite the names of the defendants and the infringing devices, fig. 11. In the days before computerized word processing, this was a big step from the usual handwritten complaint.102

Figure 11. Portions of a Form Complaint Against Charles Carter.

III. LESSONS FOR THE DEVELOPMENT OF LAW AND PRACTICE

We can learn several lessons from these initial apple parer cases that exemplified the growing sophistication of legal analysis at the time. They provide previously unexplored visibility into legal practice. The cases highlight information dissemination problems associated with limited communication and travel means. They show how the early stages of patent law developed. Finally, they illuminate patent practices that previously puzzled others.

A. Visibility into Legal Practice

These cases illustrate some of the vagaries of nineteenth century litigation practice, which are usually glossed over in historic analyses. For example, the use of form complaints appears to have been a cutting-edge

99. THORNTON, supra note 18.
102. We are unaware of any literature detailing a shift to form complaints in the nineteenth century.
technique, juxtaposed with rudimentary, filled-in, handwritten blanks. The short length of deposition testimony is also very different from today’s epic-length transcribed affairs. Although here, too, George Ticknor Curtis appeared to have been technologically advanced, having the testimony printed for a future case. There is no mention of the evidentiary rules getting such testimony admitted, as such testimony would have been hearsay in a later case, even back in the 1850s.\textsuperscript{103}

This led to extremely short motion papers. Today, courts will limit parties to 10, 15, or 25 typewritten pages, depending on the motion.\textsuperscript{104} Two-or-three-page handwritten motions would have been necessarily focused. But were they complete? As discussed below, the short motion in this case failed to cite the most important available precedent. While some people today likely lament the length of court filings, there is probably a middle ground between bloated, irrelevant filings and too-short filings that ask the court to read all the testimony in whole to determine a winner.

Also of interest is the clear conflict associated with having a lawyer argue a case before his brother. While such a conflict might be waived, there is no record of even an objection. This appears to have been commonplace: George Curtis was co-counsel for Dred Scott while his brother heard the case and ruled in Scott’s favor. It is difficult to imagine a lawyer today in high stakes litigation leaving such a conflict untouched. The further conflict of having the same patent agent pursuing patents on (literally) competing patents is something that happens today, but such a tactic would be recognized and weaponized by one of the parties.\textsuperscript{105}

\textbf{B. Information Dissemination}

Perhaps the biggest mystery of litigation practice is George Curtis’s failure to cite \emph{Winans v. Denmead} (the leading equivalents case) to his brother, the author of \emph{Winans}. There are a few potential explanations. Perhaps G. Curtis did not know about the case because it was new. It was not cited in the latest version of his treatise. However, reliance on \emph{O’Reilly}, a case from the same year as \emph{Winans}—a more directly applicable case—implies that the case reporting system (in which court observers—not the courts—published opinions)\textsuperscript{106} sometimes hindered

\begin{footnotesize}
\begin{enumerate}
\item[103.] \textit{3 Bouvier}, supra note 11, at 359 (hearsay exception only applies to testimony of unavailable witnesses).
\item[104.] \textit{See}, e.g., L.R., D. Mass. 7.1.4(b)(4) (describing the default page limit in the District of Massachusetts as 20 pages).
\item[105.] \textit{General Elec. Co. v. Valeron Corp.}, 608 F.2d 265, 268 (1979) (affirming lawyer disqualification where lawyer drafted patents for opposing party).
\item[106.] \textit{Young}, supra note 12.
\end{enumerate}
\end{footnotesize}
the spread of information regarding new court decisions.\textsuperscript{107} Volume 15 of Howard’s Supreme Court Reports was not published until sometime in 1854. Delay in publication was likely not an explanation, though, given that \textit{O’Reilly} was decided after \textit{Winans} and was reported in the same volume. Thus, it is hard to believe that George Curtis knew about \textit{O’Reilly} but not \textit{Winans}. It is also possible that Curtis was just not that good and missed the clear import of \textit{Winans}. This too is unlikely, but if true, it speaks volumes about the quality of nineteenth century lawyering that we hold in high esteem. The most likely explanation is that George Curtis learned of the case because both he and his judicial brother represented Samuel Morse. In fact, Benjamin Curtis recused himself from the \textit{O’Reilly v. Morse} case. This explanation implies that information about other people’s cases travelled much more slowly than information about one’s own cases, even if one is writing a treatise on the subject. This is undoubtedly true today, though the delay today is typically minutes or hours rather than months.

That may be the primary takeaway, whatever the reason: information, even as important as Supreme Court opinions, flowed much more slowly and intermittently in the mid-1800s.\textsuperscript{108} This phenomenon is certainly present in other aspects of these cases. There is no published record of Sargent & Foster suing Whittemore, even though they did so on the same day they sued Carter, and even though Whittemore was subject to the same injunction that applied to Carter. This information was only available by a name search in the National Archives.

Furthermore, even though \textit{Sargent v. Larned} decided an important issue of licensee estoppel, Justice Curtis did not refer to the case in a later Supreme Court opinion on the same topic. It may be that the injunction ruling had not been reported in citable form yet. As noted, \textit{Sargent v. Carter} was not reported until long after the issue ordered. Even so, if the point of justices riding circuit was to get them familiar with local law, this was the perfect opportunity to do so.

Despite slowness of the law, it appears that information about who to sue traveled well enough, as Sargent & Foster had no trouble finding defendants.\textsuperscript{109} Advertisements, fairs, and word of mouth appear to have provided sufficient information about competing parers on the market.

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\textsuperscript{107} Sargent v. Larned was the second case to cite \textit{Winans}. The first was a case decided in September of 1854. \textit{See Am. Pin Co. v. Oakville Co.}, 1 F. Cas. 712, 713 (C.C.D. Conn. 1854).

\textsuperscript{108} \textit{Carl Brent Swisher, The TaneY Period, 1836-64 503} (Macmillan Publishing 1974) (discussing contemporary complaints about how slowly the \textit{O’Reilly v. Morse} decision was released to the public).

\textsuperscript{109} Beauchamp, \textit{supra} note 101 (describing plaintiffs who sued hundreds of defendants around the country).
\end{flushleft}
C. Development of Law

The primary patent infringement theory discussed herein, the doctrine of equivalents, was still evolving at the time and it influenced judgments in all three cases. According to the doctrine of equivalents, the inventive scope being patented by Pratt was not just the specifically claimed elements but also insignificant differences from those elements made to achieve the same purpose and operation. Thus, a parer with a slight change in form, such as Seagrave’s, or even a completely different design, like Carter’s, could be found to infringe on Pratt’s patented invention so long as there was a mechanism to allow the knife arm to loosely rotate. Here, despite the failure of counsel to point it out, the law developed exactly as one would expect. The court applied the recent Winans case to this new fact pattern.

There were other important legal questions answered, without the benefit of precedent. The doctrine of licensee estoppel applied to bar John Seagrave from challenging the validity of the Pratt patent even though the Supreme Court had yet to rule on that question. The public’s “acquiescence” in the Pratt invention allowed the court to find little injury in granting preliminary injunctions.

At a time when reissue patents were considered a growing problem, Carter’s written description limited the new claims he attempted to add after seeing Pratt’s solution.

The doctrine of obviousness was fledgling and appeared to sway the court in allowing the matter to go to a jury without explicit mention of it. The Patent Office, on the other hand, expressly considered obviousness in granting Pratt’s patent. Finally, Carter was allowed to submit evidence of prior inventions, even though they were not patented.

Other than licensee estoppel, each of these doctrines is still used in some form today. Although one wonders whether a modern court (not being argued by the judge’s brother) would have resolved the factual issues of each case the same way.

D. Patent Office Practice

Some takeaways from the cases have to do with how the patent system operated. Patent interference practice, though robust, appears to have been much less rigorous than we would expect by today’s standards. Rather than identifying specific overlapping claims, the Patent Office appeared content with general subject matter conflict. This allowed for settlements through waiver of subject matter without requiring any kind

of claim amendments. The interference resulting in Pratt’s patent reflected the peculiar claiming methods of the time and allowed Seagrave to yield without amending his patent.

One eccentricity of nineteenth century technology, which was not reported in the patent administration literature but revealed in both Pratt’s and Seagrave’s patent files, is that the entire patent specification would be returned to the applicant to strike out or otherwise amend the application. At the end of the process, a series of edits to the same document constituted the final patent. This process seems reasonably efficient, given that there were only 12 patent examiners in the entire office at that time. Abandonment in those days was much simpler—simply fail to return the patent specification. There is likely little historical record of such failed patents, especially because the original application would be missing. This is contrary to other suppositions that such abandoned files are missing simply because they were destroyed in the 1930s. However, this does explain a mystery, namely the “interlined” patent of Oliver Evans.

IV. CONCLUSION

These few cases, picked from a sea of litigation, reveal so much about how lawyers, judges, courts, and agencies worked in the 1800s. To be sure, none of this detail was available on the face of the opinions; it took digging in the National Archives to reveal the underlying detail. However, there is more to be learned from other cases, should scholars choose to look for these details.

This Article has uncovered things unknown before, especially about patent office practice. The practice of sending patent applications back to the applicant for editing is not something discussed in other articles. Similarly, the loose interference practice is not widely discussed, but even the court proceedings provided more than was available in just the reported court opinion.

This Article also solved some mysteries on the business side. Apple parer enthusiasts had long wondered why identical parers bore differing

111. We have not seen this particular method of patent examination reported in the literature, so we point it out here. It does explain the mystery of Oliver Evans’s “interlined” patent, challenged in at least one court case. Evans v. Chambers, 8 F.Cas. 837, 837 (1807). Interlineation is not defined in the case, but we assume that it refers to the process of adding text to the original patent application to form the final patent document, as described in this case.
113. Reingold, supra note 54, at 160 (noting that even some granted applications were returned to inventors).
114. Id. at 164.
115. Evans, 8 F.Cas. 837.
labels or why some parers had one label on top of another. The detailed accounts of parts purchases, injunctions, and judgment executions explain how this could have happened. The business-type studies are more common, but there were many more skirmishes than have been recorded to date. This Article adds one more story to the literature.

Most importantly, this Article has paved a way forward for others. The National Archives are not useful only for obtaining specific documents. The collection—and the inferences made from it—tells a story not only of the parties to a specific case but to the very process itself. We learn not just what lawyers and judges did but how they did it.

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