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Stevens Vs. Gladding

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Decided On : 1854

Appeal No. : 58 U.S. 447

Appellant : Stevens

Respondent : Gladding

Judgement :

Stevens v. Gladding - 58 U.S. 447 (1854)
U.S. Supreme Court Stevens v. Gladding, 58 U.S. 17 How. 447 447 (1854)

58 U.S. (17 How.) 447

APPEAL FROM THE CIRCUIT COURT OF THE UNITED

STATES FOR THE DISTRICT OF RHODE ISLAND

SYLLABUS

Whether patent rights and copyrights held under the laws of the United States are subject to seizure and sale on execution is a question upon which the Court does not express an opinion in the present case.

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The seizure and sale under execution of "one copperplate for the map of the State of Rhode Island" did not carry with it the right to print and publish the map.

It is distinguishable from a voluntary sale of a plate by the owner thereof.

The ownership of a plate and the ownership of the copyright are distinct species of property, and the plate may be used without infringing upon the copyright of printing and publishing the map. .

But the penalties imposed by the 7th section of the Act of Congress passed on the 3d of February, 1831 -- namely the forfeiture of the printed copies and the sum of one dollar for each sheet unlawfully printed -- cannot be enforced in a court of equity. Under a prayer for general relief, the court can decree for an account of profits. This right is incident to the right to an injunction in copy and patent right cases.

This was a branch of the case of *Stevens v. Cady,* 14 How. 528, and the difference between the two cases is stated in the opinion of the Court.

The decree of the circuit court was as follows:

" *Decree* "

"This cause came on to be heard on the bill, answer, replication, depositions, and other papers in the case, and after the hearing it is ordered by the court that the following entry be made on the minutes in relation to the same:"

"The court differ in opinion as to the effect of the sale of the copperplate, but agrees that injunction cannot issue without a return of the money paid for the plate."

And afterwards, at the same term, Mr. Stevens, having the election to return the price of the plate or not, elected not to return the same, upon which the respondents move that the bill be dismissed, which is dismissed as follows:

"This cause having been heard on the bill, answer, and other pleadings therein and the complainant having refused to return the price of the plate of the map in question as required by the court: "

"It is now, on motion of the respondents and by the consideration of the court ordered, adjudged, and decreed that the said bill be and the same is hereby dismissed with costs."

"November term, A.D. 1849."

From this decree Stevens appealed to this Court.

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MR. JUSTICE CURTIS delivered the opinion of the Court.

The appellant filed his bill in the Circuit Court of the United States for the District of Rhode Island to restrain the defendants from printing and publishing a map of that state whereof he claimed to be the exclusive proprietor under the Act of Congress of February 3, 1831, concerning copyrights of maps &c.; The defendants admit that they have sold such maps, but allege that a copperplate, owned by the plaintiff, was duly sold on an execution which issued on a judgment recovered against the plaintiff in the Court of Common Pleas for the County of Bristol in State of Massachusetts, and that one Isaac H. Cady was the purchaser of the plate under that sale; that Cady has used the plate to print the said maps, and the defendants have sold them, and they insist that by the purchase of the copperplate Cady acquired the right to print maps therewith and to publish and sell them and that therefore the defendants have not infringed on any exclusive right of the complainants.

By reference to the case of *Stevens v. Cady,* 14 How. 528, it will be seen that the same title now asserted by

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these defendants was tried on that case between the complainant and Cady. But as is stated in the report of that case, no counsel then appeared or was heard in support of Cady's title, and Mr. Justice Woodbury, who sat in the cause in the circuit court, having deceased, this Court was not apprised of the grounds and reasons on which the decree of that court dismissing the bill rested, and when this cause was called, counsel having appeared and desired to be heard, though he frankly avowed that the question passed on in the former case was the only one which could be raised, the court readily assented, and, having now considered the argument of the respondent's counsel, the Court directs me to state its opinion in the cause.

The positions assumed by the respondent's counsel are that copy and patent rights are subject to seizure and sale on execution, and that whenever the owner of a copyright of a map causes a plate to be made which is capable of no beneficial use except to print his map, he thereby annexes to the plate the right to use it for printing that map and also the right to publish and sell the copies when printed, and that when the plate is sold on execution, these rights pass with the plate and as incidents or accessories thereto, though no mention is made of them in the sale.

There would certainly be great difficulty in assenting to the proposition that patent and copyrights held under the laws of the United States are subject to seizure and sale on execution. Not to repeat what is said on this subject in 14 How. 55 U. S. 531 , it may be added that these incorporeal rights do not exist in any particular state or district; they are coextensive with the United States. There is nothing in any act of Congress or in the nature of the rights themselves to give them locality anywhere so as to subject them to the process of courts having jurisdiction limited by the lines of states and districts. That an execution out of the Court of Common Pleas for the County of Bristol, in the State of Massachusetts, can be levied on an incorporeal right subsisting in Rhode Island or New York will hardly be pretended. That by the levy of such an execution the entire right could be divided, and so much of it as might be exercised within the County of Bristol sold would be a position subject to much difficulty.

These are important questions on which we do not find it necessary to express an opinion because in this case neither the copyright, as such, nor any part of it was attempted to be sold. The return of the officer on the execution is that he seized and sold "one copperplate for the map of the State of Rhode Island." The defendants must therefore stand upon the second position assumed by their counsel, that the right to

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print and publish the map passed by the execution sale with the plate.

There are no special facts in this case to distinguish it from any case of a sale on execution of copper or stereotype plates. It appears that the plaintiff owned the plate; whether he made it or caused it to be made or purchased it after it had been made does not appear.

Nor should the case be confounded with one where the owner of copper or stereotype plate sells them. What rights would pass by such a sale would depend on the intentions of its parties, to be gathered from their contract and its attendant circumstances. In this case, the owner of the copyright made no contract of sale, and necessarily had no intention respecting its subject matter.

The sole question is whether the mere fact that the plaintiff owned the plate attached to it the right to print and publish the map, so that this right passed with the plate by a sale on execution.

And upon this question of the annexation of the copyright to the plate it is to be observed first, that there is no necessary connection between them. They are distinct subjects of property, each capable of existing, and being owned and transferred independent of the other. It was lawful for anyone to make, own, and sell this copperplate. The manufacture of stereotype plates is an established business, and the ownership of the plates of a book under copyright may be, and doubtless in practice is, separated from the ownership of the copyright. If an execution against a stereotype founder were levied on such plates, which he had made for an author and not delivered, the title to those plates would be passed by

the execution sale, and the purchaser might sell them, but clearly he could not print and publish the book for which they were made. The right to print and publish is therefore not necessarily annexed to the plate nor parcel of it.

Neither is the plate the principal thing and the right to print and publish an incident or accessory thereof. It might be more plausibly said that the plate is an incident or accessory of the right, because the sole object of the existence of the plate is as a means to exercise and enjoy the right to print and publish.

Nor does the rule that he who grants a thing grants impliedly what is essential to the beneficial use of that thing apply to this case. A press and paper and ink are essential to the beneficial use of a copperplate. But it would hardly be contended that the sale of a copperplate passed a press and paper and ink as incidents of the plate because necessary to its enjoyment.

The sale of a copperplate passes the right to such lawful use

thereof as the purchaser can make by reason of the ownership of the thing he has bought; but not the right to a use thereof, by reason of the ownership of something else which he has not bought and which belongs to a third person. If he has not acquired a press or paper or ink, he cannot use his plate for printing, because each of these kinds of property is necessary to enable him to use it for that purpose. So if he has not acquired the right to print the map, he cannot use his plate for that purpose, because he has not made himself the owner of something as necessary to printing as paper and ink or as clearly a distinct species of property as either of those articles. He may make any other use of the plate of which it is susceptible. He may keep it till the limited time during which the exclusive right exists shall have expired, and then use it to print maps. He may sell it to another who has the right to print and publish, but he can no more use that right of property than he can use a press or paper which belongs to a third person.

The cases mentioned at the bar, in which incorporeal rights have been held to pass with corporeal property, do not apply.

By the levy of an execution on a mill, the incorporeal rights actually annexed to the mill and necessary to its use pass with the mill. So does what is parcel of the mill, though temporarily removed from it -- as a millstone, which has been taken from its place to be picked. These and many other such cases are collected in Broome's Legal Maxims 198, 205.

But the right in question is not parcel of the plate levied on, nor a right merely appendant or appurtenant thereto, but a distinct and independent property, subsisting in grant from the government of the United States, not annexed to any other thing either by the act of its owner or by operation of law.

For these reasons as well as those stated in 14 How., our conclusion is that the mere ownership of a copperplate of a map by the owner of the copyright does not attach to the plate the exclusive right of printing and publishing the map held under the act of Congress, or any part thereof, but the incorporeal right subsists wholly separate from and independent of the plate, and does not pass with it by a sale thereof on execution.

The next question is whether the complainant can have a decree in accordance with the prayer of his bill for the penalties imposed by the 7th section of the Act of February 3, 1831. The bill prays specifically for a decree for these penalties. We speak of the forfeiture of the printed copies, as well as of the sum of one dollar for each sheet unlawfully printed, as penalties, for under the laws of the United States it is clear that the complainant can have no title to either of them except by way of penalty.

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There being no common law of copyright in this country, whatever rights are possessed by the proprietor of the copyright must be derived from some grant thereof in some act of Congress, either *nominatim* or by a satisfactory implication, and looking to the act of Congress applicable to this subject matter, it appears that the rights claimed by this bill are expressly conferred by way of forfeiture. Its language is:

"Then such offender shall forfeit the plate or plates on which such map &c.;, shall be copied, and also all and every sheet thereof so copied or printed as aforesaid, to the proprietor or proprietors of the copyright thereof, and shall further forfeit one dollar for every sheet of such map &c.;, which may be found in his or their possession, printed &c.;, contrary to the true intent and meaning of this act, the one moiety thereof to the proprietor or proprietors and the other moiety to the use of the United States, to be recovered in any court having competent jurisdiction thereof."

In the case of *Colburn v. Simms,* 2 Hare 554, Mr. Vice-Chancellor Wigram came to the conclusion that since the decision of the House of Lords in the case of *Miller v. Taylor,* the right to a decree for the delivery up of copies must be rested by the complainant upon some statute provision, and that inasmuch as courts of equity do not enforce forfeitures by an exercise of their ordinary jurisdiction, such a jurisdiction also must be derived from an act of Parliament. And though the 8th section of the Act of 1 and 2 Vict. c. 59, as well as the preceding Act of 54 Geo. III, c. 156, 4, allows the forfeited copies to be recovered in "any court of record in which an action at law, or a suit in equity, shall be commenced by such author or authors, or other proprietor or proprietors" &c.;, yet it was admitted in *Colburn v. Simms* that no such order had ever been made *in invitum* in a court of equity. It is a significant fact that Congress, in legislating on this subject, though manifestly acquainted with the phraseology of the act of Geo. III, and though in some particulars it adopted that phraseology, yet omitted to confer upon courts of equity power to enforce either of the forfeitures provided for, but left them to be recovered "in any court having competent jurisdiction thereof." And the only equitable jurisdiction as to copyright conferred upon the courts of the United States is by the Act of February 15, 1819, which gives original cognizance to the courts of the United States, as well in equity as at law, of cases arising under any law of the United States granting to authors or inventors the exclusive right to their respective writings, inventions, and discoveries, and, upon any bill in equity filed by any party aggrieved in any such case, shall have authority to grant injunctions according to the course and principles of courts of equity to prevent the violation of the

rights of any authors or inventors secured to them by any laws of the United States on such terms as the said courts may deem fit and reasonable. Though the substance of this enactment is incorporated into the 17th section of the Patent Act of July 4, 1836, so far as it related to inventors and so far as it related to the subject of patent rights is no longer in force *proprio vigore,* yet so far as it gave cognizance to the courts of the United States of cases of copyright, it still remains in force, and is the only law conferring equitable jurisdiction on those courts in such cases, for the 9th section of the Act of February 3, 1831, protects manuscripts only.

There is nothing in this act of 1819 which extends the equity powers of the courts to the adjudication of forfeitures, it being manifestly intended that the jurisdiction therein conferred should be the usual and known jurisdiction exercised by courts of equity for the protection of analogous rights. The prayer of this bill for the penalties must therefore be rejected.

The remaining question is whether there ought to be a decree for an account of the profits. The complainant has not prayed for such an account, nor have the defendants stated one in their answer, but the bill does pray for general relief.

The right to an account of profits is incident to the right to an injunction in copy- and patent-right cases. *Colburn v. Simms,* 2 Hare 554; 3 Dan.Ch.Pr. 1797. And this Court has held, in *Watts v. Waddle,* 6 Pet. 389, that where the bill states a case proper for an account, one may be ordered under the prayer for general relief. *See also* 27 U. S. 2 Pet. 612; 39 U. S. 14 Pet. 156; 41 U. S. 16 Pet. 195; 50 U. S. 9 How. 405.

The decree of the circuit court must be reversed, and the cause remanded to the circuit court, with directions to award a perpetual injunction as prayed for in the bill, and to take an account of the profits received by the defendants from the sales of the map.

ORDER

This cause came on to be heard on the transcript of the record from the Circuit Court of the United States for the District of Rhode Island, and was argued by counsel. On consideration whereof it is now here ordered, adjudged, and decreed by this Court, that the decree of the said circuit court in this cause be and the same is hereby reversed with costs, and that this cause be and the same is hereby remanded to the said circuit court, with directions to award a perpetual injunction, as prayed for in the bill filed in this case, and to take an account of the profits received by the defendants from the sales of the map, and for such further proceedings in conformity to the opinion of this Court, as to law and justice shall appertain.

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