

2020

The Traditional Burdens for Final Injunctions in Patent Cases c.1789 and Some Modern Implications

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THE TRADITIONAL BURDENS FOR FINAL INJUNCTIONS IN PATENT CASES *C.1789* AND SOME MODERN IMPLICATIONS

H. Tomás Gómez-Arostegui[‡] & *Sean Bottomley*^{††}

ABSTRACT

This Article reassesses the first two *eBay* factors for final injunctions—irreparable injury and the inadequacy of legal remedies—in light of traditional equitable principles. Tracking most closely with tradition would require the Federal Circuit to recognize that in patent cases: (1) an injury it seeks to redress with a final injunction is future infringement itself, not merely follow-on harms caused by future infringement; (2) it can presume future infringement from past infringement; (3) it can presume that legal remedies are inadequate to remedy future infringement; and (4) it need not require a plaintiff to show that alternative equitable remedies, like ongoing royalties, would inadequately redress future infringement. Moreover, the Federal Circuit can recognize, without relying on any presumptions, that the burden on the first two *eBay* factors is not onerous. A patentee can satisfy them by showing that a defendant is likely to infringe again and that any legal damages awarded at trial did not fully compensate the patentee for the life of the patent.

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INTRODUCTION

Not long after its creation in 1982, the Federal Circuit ruled that federal courts were to presume irreparable injury and the lack of an adequate remedy at law when considering requests for final injunctions in patent suits. Defendants bore the burden of rebutting these presumptions.¹ In 2006, the Supreme Court decided *eBay Inc. v. MercExchange, L.L.C.*, where it rejected a separate, broader rule from the Federal Circuit that final injunctions must issue absent exceptional circumstances to protect the public interest.² Although the parties in *eBay* asked the Court to address the Federal Circuit’s separate rebuttable presumptions, it declined to do so. It instead confined itself to the broad observations that district courts must exercise their discretion “consistent with traditional principles of equity” and that “traditional equitable principles do not permit . . . broad classifications” or “categorical rule[s]” that require a trial court to grant or deny a final injunction.³ In light of these statements, which the Federal Circuit construed liberally, the Federal Circuit jettisoned its rebuttable presumptions in 2011.⁴ To obtain a final injunction, a patentee must

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1. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1247 (Fed. Cir. 1989).
 2. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 394 (2006), *rev’g* *MercExchange, L.L.C. v. eBay, Inc.*, 401 F.3d 1323 (Fed. Cir. 2005).
 3. *Id.* at 393–94.
 4. *Robert Bosch LLC v. Pylon Mfg.*, 659 F.3d 1142, 1149 (Fed. Cir. 2011).

now always prove that some future injury is likely—one caused by, but exceeding, any future infringement itself—and that the identified injury is not otherwise redressable by legal or equitable remedies.

Nonetheless, the old presumptions of irreparable injury and the inadequacy of legal remedies remain top of mind. Scholars, for one, have criticized *eBay* for how its sweeping statements have indirectly laid waste to presumptions, not only in patent cases but in other areas as well.⁵ Legislators have introduced bills in the Senate or House for each of the last four years in an effort to restore the rebuttable presumptions in patent cases on requests for final injunctions.⁶ And there remains the possibility that the Federal Circuit will revisit the presumptions *en banc* or that the Supreme Court will take up the matter.

In light of the interest that members of the Federal Circuit, Supreme Court, Congress, and others have in this issue, this Article scrutinizes the assumption (for it is only an assumption) that in patent cases presumptions of irreparable injury and the inadequacy of legal remedies contradict “traditional equitable principles.” Rather than concentrate on 19th-century American traditions, a task underway by Adam Mossoff,⁷ we focus on equitable principles as they existed in England at the end of the 18th century. As well as directing courts to consider traditional equitable principles more generally, the Court has told us that, unless altered by Congress, the substantive prerequisites

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5. 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); see also, e.g., DOUGLAS LAYCOCK & RICHARD L. HASEN, MODERN AMERICAN REMEDIES 443–46 (5th ed. 2019); David McGowan, *Irreparable Harm*, 14 LEWIS & CLARK L. REV. 577, 582–84 (2010); Richard A. Epstein, *The Disintegration of Intellectual Property*, 62 STAN. L. REV. 455, 489–95 (2010); Doug Rendleman, *The Trial Judge’s Equitable Discretion Following eBay v. MercExchange*, 27 REV. LITIG. 63, 87–88 (2007).
 6. Restoring America’s Leadership in Innovation Act, H.R. 7366, 116th Cong. § 12 (June 25, 2020); Inventor Rights Act, H.R. 5478, 116th Cong. § 3 (Dec. 18, 2019); STRONGER Patents Act, S. 2082 & H.R. 3666, 116th Cong. § 106 (July 10, 2019); Inventor Protection Act, H.R. 6557, 115th Cong. § 3(b) (July 26, 2018); Restoring America’s Leadership in Innovation Act, H.R. 6264, 115th Cong. § 12 (June 28, 2018); STRONGER Patents Act, H.R. 5340, 115th Cong. § 106 (Mar. 20, 2018); STRONGER Patents Act, S. 1390, 115th Cong. § 106 (June 21, 2017). Congress recently restored these presumptions in trademark cases. Trademark Modernization Act of 2020 § 226, 15 U.S.C. § 1116(a) (abrogating circuit court decisions that had discarded the presumptions).
 7. Adam Mossoff, *The Injunction Function: How and Why Courts Secure Property Rights in Patents*, 96 NOTRE DAME L. REV. 1581, 1587–1602 (2021); Adam Mossoff, *Injunctions for Patent Infringement* (draft).

for obtaining injunctive relief in federal court depend on historical practices of the English Court of Chancery circa 1789.⁸

Investigating the enforcement of invention patents in the Court of Chancery is not for the faint of heart. No 18th-century practitioner ever wrote a treatise with a view to anticipating and answering all the questions that courts might care about 230 years later in some faraway and rebellious land. Today, judges and litigants tend to focus on a smattering of printed reports from the late 18th century, along with a handful of printed reports and treatises from the 19th century. That is understandable. Courts and litigants have neither the time nor the resources to delve deeply into 18th-century practice, and many probably believe that few records survive from the period. But in fact, there is a whole host of extant material. Hundreds of primary sources remain, some in print but most in manuscript, and they can help us reconstruct what would have been known to practitioners and others at the end of the 18th century—the known “course of the court.” To know these materials is to know traditional equitable principles.

We advance several critical points respecting final injunctions at the end of the 18th century. First, patentees faced no separately articulated requirement of demonstrating “irreparable” injury. Irreparable harm was an inquiry that played a role, if at all, on requests for interim injunctions and it concerned, in part, whether an alternative equitable remedy would suffice instead. No similar inquiry occurred at the final-injunction stage. Second, the inadequate-remedy-at-law requirement—the test for equitable jurisdiction—turned principally on the likelihood of future actionable wrongs (and not solely on the harms that might stem from those wrongs). Third, the Chancery could presume that future wrongs were likely from the fact of a defendant’s past wrongs. And lastly, the legal remedy of damages was presumptively inadequate because it could not redress future wrongs, meaning that additional retrospective actions were needed against recalcitrant defendants. It was this prospect that triggered equitable jurisdiction.

Turning to modern implications, we show that *eBay* and Congress have done nothing to alter these precepts. Tracking most closely with tradition would thus call on the Federal Circuit to recognize that: (1) an injury it seeks to redress with a final injunction is future infringement itself, not just follow-on harms caused by future infringement; (2) it can presume future infringement from past infringement; (3) it can presume that legal remedies are inadequate to remedy future infringement; and (4) it need not require a plaintiff to show that alternative equitable remedies, like ongoing royalties, would inadequately redress future infringement. Congress can endorse these same steps without fear of uprooting traditional principles or *eBay*.

8. Grupo Mexicano de Desarrollo, S.A. v. All. Bond Fund, Inc., 527 U.S. 308, 318–19 (1999); see also *infra* text accompanying notes 30–36.

By writt of privy Seal
James Watt & Co. v. Boulton & Watt
(12)
GEORGE the Third by the Grace of God &c.
To all to whom these presents shall come
Greeting WHEREAS James Watt of Birmingham
in our County of Warwick Esquire had by this or
petition humbly represented unto us that he or
he after some Labour and Expence invented or
retain new Improvements upon fire and Steam or
Engines and upon sustained worked or moved by
the same which he apprehends will be of great
publick utility and in regard the petitioner is the
first and true inventor thereof and the same have not
been practised or used by any other person or persons
to his best of his knowledge and belief the petitioner
therefore most humbly prayed us to grant unto him
his Executors Administrators and Assignes our Special
Letters Patent under the Great Seal of Great Britain
for the sole benefit and advantage of this said Kingdom
of England our Dominion of Wales and Town of Berwick
upon Tweed for the Term of fourteen years according
to the Statute in that case made and provided and
we being willing to give encouragement to all arts
and Inventions which may be for the publick good
are graciously pleased to condescend to the petitioners
request and we therefore that we of our
special grace retain knowledge and our motion
DO give and grant and by these presents for us
our Heirs and Successors DO give and grant unto the
said James Watt his Executors Administrators and
Assignes our special Licence full power sole privilege
and authority that he the said James Watt his
Executors Administrators and Assignes and every of
them by himself and his or her or by his and their
Deputy or Deputies Servants or Agents or others in
and as the said James Watt his Executors
Administrators or Assignes shall at any time agree
with and no other from time to time and at all times
hereafter during the Term of years therein expressed
shall and lawfully may make use exercise and vend
the said Invention within that part of our Kingdom
of Great Britain called England our Dominion of
Wales and Town of Berwick upon Tweed in such
manner as to him the said James Watt his
Executors Administrators and Assignes or any of
them shall in this or their Discretions seem meet
and that he the said James Watt his Executors
Administrators and Assignes shall and lawfully may
have and enjoy the whole profit benefit commodity
and advantage from time to time coming growing
arising and arising by reason of the said Invention
for and during the Term of years therein mentioned
TO HAVE used exercise and enjoy the said
Licence powers privileges and advantages therein
before granted or mentioned to be granted unto the
said James Watt his Executors Administrators

Patent Enrollment, James Watt, C66/3812, no. 12 (1784)

Moreover, the Federal Circuit can simply recognize, without using any presumptions, that a patentee can satisfy *eBay*'s irreparable injury and inadequate-remedy-at-law requirements by showing that a defendant is likely to infringe again without a final injunction and that any legal damages awarded at trial did not fully compensate the patentee for the life of the patent.

Part I briefly outlines U.S. law on patent injunctions from 1983 to the present. Part II turns to the Court of Chancery of the 18th century. Apart from explaining why cases from this period remain doctrinally relevant, it describes the usual course of patent suits in Chancery and its jurisdictional limitations. Lastly, Parts III and IV home in on final injunctions. They treat historical practices and explore the modern ramifications of those practices. Importantly, our Article takes no position on whether final injunctions should, as a matter of policy, be granted freely in patent cases, nor do we endorse or condemn the Supreme Court's focus on 18th-century practices and principles.

I. FINAL INJUNCTION PRACTICE IN PATENT CASES 1983–2020

For the first 28 years or so of its existence, the Federal Circuit employed presumptions of irreparable harm and the inadequacy of legal remedies on injunction requests. The court often expressed the two concepts interchangeably, with irreparable harm used as the favored term. For preliminary injunctions, the court instructed judges to presume irreparable harm when a patentee could make out a “clear” or “strong” showing of likelihood of success on the merits.⁹ A weaker case required an actual showing of irreparable injury.¹⁰ On final injunctions, the Federal Circuit directed judges to presume irreparable harm unconditionally because the patentee had already proven validity and infringement.¹¹ A defendant could rebut either of these presumptions by producing “clear” or “persuasive” evidence to “establish” that the presumed harm was absent.¹²

But the Federal Circuit went further. Building from cases that acknowledged final injunctions as the norm, the court adopted a broader rule that final injunctions “will issue when infringement has

9. *Smith Int'l, Inc. v. Hughes Tool Co.*, 718 F.2d 1573, 1581 (Fed. Cir. 1983).

10. *Id.* at 1581 n.7.

11. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1247 (Fed. Cir. 1989).

12. *See respectively* *Roper Corp. v. Litton Sys., Inc.*, 757 F.2d 1266, 1271–72 (Fed. Cir. 1985); *Bio-Tech. Gen. Corp. v. Genentech, Inc.*, 80 F.3d 1553, 1566 (Fed. Cir. 1996); *Polymer Techs., Inc. v. Bridwell*, 103 F.3d 970, 974–75 (Fed. Cir. 1996); *Pfizer, Inc. v. Teva Pharms., Inc.*, 429 F.3d 1364, 1381 (Fed. Cir. 2005). Unfortunately, the language quoted above muddles whether the court intended to shift a burden of persuasion or production to the defendant.

been adjudged, absent a sound reason for denying it.”¹³ In 2005, the court stiffened the rule when it demanded near-automatic grants. Under *MercExchange, L.L.C. v. eBay, Inc.*, denials became proper only in “exceptional” cases to protect the “public interest.”¹⁴ This mandate produced an *irrebuttable* presumption on all the criteria for a final injunction, except for the public interest. The court achieved as much by overruling its own precedent *sub silentio*.¹⁵

In 2006, the Supreme Court granted certiorari on whether this more demanding “general rule” was proper in patent cases.¹⁶ Holding it was not, the Court stated in *eBay Inc. v. MercExchange, L.L.C.* that “traditional equitable considerations” apply to final injunctions in patent cases, no differently from other types of cases, and therefore the mere fact that a defendant had infringed a valid patent did not necessarily mean a final injunction must issue.¹⁷ A plaintiff seeking a final injunction in a patent case still had to satisfy the following “well-established . . . four-factor test”:

A plaintiff must demonstrate: (1) that it has suffered an irreparable injury; (2) that remedies available at law, such as monetary damages, are inadequate to compensate for that injury; (3) that, considering the balance of hardships between the plaintiff and defendant, a remedy in equity is warranted; and (4) that the public interest would not be disserved by a permanent injunction.¹⁸

The Court stressed that district courts were to exercise their discretion in granting an injunction in a manner “consistent with traditional principles of equity.”¹⁹ But it did not explain how the first two factors differed from each other, or why they were stated in the past tense.²⁰ Nor did the Court define the type of injury that counted

13. *Richardson*, 868 F.2d at 1247.

14. *MercExchange, L.L.C. v. eBay, Inc.*, 401 F.3d 1323, 1338–39 (Fed. Cir. 2005).

15. *Id.* (implicitly overruling *Roche Prods., Inc. v. Bolar Pharm. Co.*, 733 F.2d 858, 866–67 (Fed. Cir. 1984), without going *en banc*).

16. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391, 393–94 (2006).

17. *Id.* at 392–93.

18. *Id.* at 391.

19. *Id.* at 394; *see also id.* at 392 (“[I]njunctive ‘may’ issue ‘in accordance with the principles of equity.’” (quoting 35 U.S.C. § 283)).

20. Samuel L. Bray, *The Supreme Court and the New Equity*, 68 VAND. L. REV. 997, 1024–28, 1048–49 (2015) (discussing scholarly critiques); Gergen et al., *supra* note 5, at 207–14 (critique); John M. Golden, *The Supreme Court as “Prime Percolator”: A Prescription for Appellate*

under the first factor. We only know for certain that the second factor refers to the traditional trigger of equitable jurisdiction—the inadequate-remedy-at-law requirement—which functions prophylactically to help preserve the constitutional right to a jury trial as it existed at the time of the Seventh Amendment in 1791.²¹ A party cannot be forced to face an equitable remedy assessed by a judge when an adequate remedy, and a right to a jury, would be available at law.

Although the petitioners in *eBay* asked the Court to address the Federal Circuit’s separate rebuttable presumptions,²² it declined to do so. The closest the Court came was stating that a plaintiff “must demonstrate” the aforesaid four factors, and that “traditional equitable principles do not permit . . . broad classifications” or “categorical rule[s]” that *require* a trial court to *grant* or *deny* a final injunction in a patent or other suit.²³ Having never mentioned the separate presumptions, none of the three opinions in *eBay* discussed whether they contravened traditional equitable practices or principles.

On remand, the Federal Circuit jettisoned its general rule. But more importantly, the court later discarded its rebuttable presumptions. Acknowledging that *eBay* did not address them, the Federal Circuit nevertheless held in *Robert Bosch LLC v. Pylon Mfg.* that the Court’s aversion to “broad classifications” and “categorical rule[s]” signaled their end.²⁴ Notably, the Federal Circuit did not assess whether

Review of Questions in Patent Law, 56 UCLA L. REV. 657, 694–98 (2009) (same); Rendleman, *supra* note 5, at 75–98 (same).

21. *Granfinanciera, S.A. v. Nordberg*, 492 U.S. 33, 48–49 (1989); *Younger v. Harris*, 401 U.S. 37, 43–44 (1971); *Schoenthal v. Irving Tr. Co.*, 287 U.S. 92, 94 (1932); *Root v. Ry. Co.*, 105 U.S. 189, 206, 212–13 (1882).
22. Brief of Petitioners at 29–30, *eBay*, 547 U.S. 388 (No. 05-130); Brief for Respondent at 16–17, *eBay*, 547 U.S. 388 (No. 05-130); Reply Brief at 7, *eBay*, 547 U.S. 388 (No. 05-130).
23. *eBay*, 547 U.S. at 391, 393–94. The Court had previously ruled in a conclusory fashion, and on a request for a *preliminary* injunction, that a presumption of irreparable harm on an ANILCA violation would be “contrary to traditional equitable principles.” *Amoco Prod. Co. v. Vill. of Gambell*, 480 U.S. 531, 544–45 (1987); *cf. Winter v. Nat. Res. Def. Council, Inc.*, 555 U.S. 7, 21–22 (2008) (holding that the standard for preliminary relief is “likelihood” not “possibility” of irreparable harm). But *eBay* did not cite *Amoco* for this proposition. More recently, the Court has indicated that a rebuttable presumption of *all* four factors for final-injunctive relief would be inappropriate on a NEPA violation. *Monsanto Co. v. Geertson Seed Farms*, 561 U.S. 139, 157–58 (2010). *But see Roman Cath. Diocese of Brooklyn v. Cuomo*, 141 S. Ct. 63, 67 (2020) (ruling that violations of the First Amendment are intrinsically irreparable injuries); *Osborne v. Mo. Pac. Ry. Co.*, 147 U.S. 248, 258–59 (1893) (stating in *dictum* that courts can presume irreparable injury in ordinary takings cases).
24. *Robert Bosch LLC v. Pylon Mfg.*, 659 F.3d 1142, 1148–49 (Fed. Cir. 2011) (alteration in original) (quoting *eBay*, 547 U.S. at 393).

its presumptions comported with traditional equitable principles. The briefing before the court mentioned the rebuttable presumptions only in passing, and no party sought to preserve them.²⁵

As a consequence of the Federal Circuit's ruling, federal courts can no longer presume irreparable injury or the inadequacy of legal remedies. Treating the two concepts as closely related, the court has reconciled them as follows. First, a patentee typically must prove that it will suffer injury caused by future infringements, but the prospect of future infringement itself does not qualify as a cognizable injury. And second, a patentee must demonstrate that remedies available at law, such as damages, would be inadequate to compensate for the injury identified in the first step.²⁶ For example, potential future lost sales caused by future infringements constitute injury, but unless the patentee proves otherwise, the court assumes that legal damages are adequate compensation for that injury.²⁷ As we will see later, courts often treat the second inquiry as examining whether any monetary form of relief, including an *equitable* one, would redress the future injury.²⁸

One member of the court, Judge Reyna, has advocated that the Federal Circuit recognize future infringement *per se* as an injury sought to be avoided by a final injunction, rather than just the harms ensuing from that infringement (like lost sales or tarnished reputation). Thus, by his lights, violation of the right to exclude could itself constitute a cognizable injury under the first factor.²⁹

II. ENFORCEMENT IN THE COURT OF CHANCERY c.1789

We focus on the English Court of Chancery in the late 18th century because the Supreme Court has ruled that the default equitable jurisdiction of the federal courts stems from, and is today “[s]ubstantially, . . . the jurisdiction in equity exercised by the High Court of Chancery in England at the time of the adoption of the Constitution and the enactment of the original Judiciary Act [of

25. Non-Confidential Brief of Defendant-Appellee Pylon Manufacturing Corp. at 46 n.11, *Bosch*, 659 F.3d 1142 (No. 2011-1096).

26. *TEK Global, S.R.L. v. Sealant Sys. Int'l, Inc.*, 920 F.3d 777, 792 (Fed. Cir. 2019); *Nichia Corp. v. Everlight Ams., Inc.*, 855 F.3d 1328, 1341–44 (Fed. Cir. 2017); *Apple Inc. v. Samsung Elecs., Co.*, 809 F.3d 633, 639–45 (Fed. Cir. 2015).

27. *Metalcraft of Mayville, Inc. v. Toro Co.*, 848 F.3d 1358, 1368–69 (Fed. Cir. 2017); *Auto. Merch. Sys., Inc. v. Crane Co.*, 357 F. App'x 297, 300–01 (Fed. Cir. 2009).

28. *See infra* text accompanying notes 152–158.

29. *Apple*, 809 F.3d at 648–52 (Reyna, J., concurring); *see also* 35 U.S.C. § 283 (injunctions “prevent the *violation* of any *right* secured by patent”) (emphases added).

1789].”³⁰ Unless altered by Congress, the “substantive prerequisites for obtaining an equitable remedy as well as the general availability of injunctive relief . . . depend on traditional principles of equity jurisdiction” circa 1789.³¹ Relatedly, the Court has ruled that determining whether there is an “adequate remedy at law, which is the test of equitable jurisdiction” in federal court, must be tested against the legal remedies that “existed when the Judiciary Act of 1789 was adopted,” except insofar as Congress has “subsequently changed” the remedies³² or made the old remedies more readily available with the Federal Rules of Civil Procedure.³³

In sum, despite the merger of law and equity procedure in federal courts in 1938, the Court often insists on the “historic division between”

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30. *Grupo Mexicano de Desarrollo, S.A. v. All. Bond Fund, Inc.*, 527 U.S. 308, 318 (1999) (quoting A. DOBIE, *HANDBOOK OF FEDERAL JURISDICTION AND PROCEDURE* 660 (1928)). Section 16 of the Judiciary Act limited equitable jurisdiction to cases where no “plain, adequate and complete remedy may be had at law.” Act of Sept. 24, 1789, ch. 20, § 16, 1 Stat. 73, 82. Congress repealed that section in 1948 as part of a belated statutory cleanup after the merger of law and equity procedure in 1938. Act of June 25, 1948, ch. 646, § 39, 62 Stat. 869, 992, 996 (repealing Act of Mar. 3, 1911, ch. 231, § 267, 36 Stat. 1087, 1163); H.R. REP. NO. 79-2646, at A221 (1946). But the repeal did not affect the inadequate-remedy-at-law requirement, *see Stainback v. Mo Hock Ke Lok Po*, 336 U.S. 368, 382 & n.26 (1949), because section 16 was merely declaratory of the equitable principles that predated it, *New York v. Connecticut*, 4 U.S. (4 Dall.) 3, 5 n.4 (1799) (Paterson, J.) (“The rule was so before, and is so independent of the provision in the act of congress.”); *accord Atlas Life Ins. Co. v. W.I. Southern, Inc.*, 306 U.S. 563, 569 (1939); *Matthews v. Rodgers*, 284 U.S. 521, 525 (1932); *Whitehead v. Shattuck*, 138 U.S. 146, 150–51 (1891); *Parker v. Winnipiseogee Lake Cotton & Woollen Co.*, 67 U.S. 545, 551 (1863); *Boyce’s Ex’rs v. Grundy*, 28 U.S. (3 Pet.) 210, 215 (1830).
 31. *Grupo Mexicano*, 527 U.S. at 318–19 (quoting 11A C. WRIGHT, A. MILLER & M. KANE, *FEDERAL PRACTICE AND PROCEDURE* § 2941, at 31 (2d ed. 1995)); *accord Sprague v. Ticonic Nat’l Bank*, 307 U.S. 161, 164–65 (1939); *Atlas Life*, 306 U.S. at 568–69; *Robinson v. Campbell*, 16 U.S. (3 Wheat.) 212, 222–23 (1818).
 32. *McConihay v. Wright*, 121 U.S. 201, 206 (1887); *accord* 1 ROGER FOSTER, *A TREATISE ON FEDERAL PRACTICE CIVIL AND CRIMINAL* § 81, at 564–65 (6th ed. 1920); W.S. SIMKINS, *A FEDERAL EQUITY SUIT* 15–16 (3d ed. 1916); 1 THOMAS ATKINS STREET, *FEDERAL EQUITY PRACTICE* §§ 45–47, at 30–31 (1909); 1 C.L. BATES, *FEDERAL EQUITY PROCEDURE* § 10, at 12 (1901); OLIVER P. SHIRAS, *EQUITY PRACTICE IN THE UNITED STATES CIRCUIT COURTS* § 9, at 10 (Chicago, 2d ed. 1898).
 33. *Beacon Theatres, Inc. v. Westover*, 359 U.S. 500, 507, 509 (1959) (5–3 on this point); *cf.* 1 JOHN NORTON POMEROY & SPENCER W. SYMONS, *A TREATISE ON EQUITY JURISPRUDENCE* §§ 276–277, at 617–18 (5th ed. 1941) (explaining that *common-law* developments do not oust equity of its earlier recognized jurisdiction); 1 JOSEPH STORY, *COMMENTARIES ON EQUITY JURISPRUDENCE* § 64(i), at 81–82 (Boston, 4th ed. 1846) (same).

the two systems.³⁴ This is particularly so with remedies, where there “has been remarkably little merger of law and equity” due to their *substantive* nature.³⁵ As the Court stated recently, the “substantive and remedial principles [applicable] prior to the advent of the federal rules [have] not changed.”³⁶

A. *The Records*

The best way to reconstruct and understand late 18th-century English practice is to review the hundreds of intangible-property cases filed in the Chancery between 1660 and 1800. Our sources include manuscript court records (pleadings, affidavits, minutes, orders, and decrees); case reports, in print and manuscript; practice manuals, in print and manuscript; and other related primary sources. These are documents we have collected and reviewed over the last 15 years. The number of invention suits far exceeds what courts assume were litigated, and there are numerous copyright and printing-patent suits as well.³⁷ Printing patents gave holders the sole right to print a work or a whole class of works,³⁸ and they issued in a manner similar to invention patents.³⁹ Notably, the steps for obtaining injunctive relief were identical in all pertinent respects across invention-patent,

34. Bray, *supra* note 20, at 1000.

35. Samuel L. Bray, *The System of Equitable Remedies*, 63 UCLA L. REV. 530, 541 (2016).

36. *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 679 (2014) (alteration in original) (quoting 4 C. WRIGHT, A. MILLER & M. KANE, FEDERAL PRACTICE AND PROCEDURE § 1043, at 177 (3d ed. 2002)); *see also Romag Fasteners, Inc. v. Fossil, Inc.*, 140 S. Ct. 1492, 1496 (2020) (explaining that “principles of equity” involve “matters like . . . modes of proof . . . and remedies”); *Allentown Mack Sales & Serv., Inc. v. NLRB*, 522 U.S. 359, 378 (1998) (“[E]videntiary presumptions . . . are in effect substantive rules of law”); *Dick v. N.Y. Life Ins. Co.*, 359 U.S. 437, 446 (1959) (“Under the *Erie* rule, presumptions (and their effects) and burden of proof are ‘substantive’” (footnote omitted)).

37. Sean Bottomley, *Patent Cases in the Court of Chancery, 1714–58*, 35 J. LEGAL HIST. 27, 32–37 (2014) (describing records); H. Tomás Gómez-Arostegui, *What History Teaches Us About Copyright Injunctions and the Inadequate-Remedy-at-Law Requirement*, 81 S. CAL. L. REV. 1197, 1222–25 (2008) (same).

38. H. Tomás Gómez-Arostegui, *Stationers v Seymour (1677)*, in LANDMARK CASES IN INTELLECTUAL PROPERTY LAW 21, 26–27 (Jose Bellido ed., 2017).

39. *Compare* SEAN BOTTOMLEY, THE BRITISH PATENT SYSTEM DURING THE INDUSTRIAL REVOLUTION 1700–1852, at 35–40 (2014), *with* Arnold Hunt, *Book Trade Patents, 1603–1640*, in THE BOOK TRADE & ITS CUSTOMERS 1450–1900, at 27, 37 (Arnold Hunt et al. eds., 1997).

printing-patent, and copyright cases.⁴⁰ This Article draws on primary sources from all three types of cases, but it focuses on invention suits.⁴¹

B. Basic Procedures and Relief

Litigants commenced patent-infringement suits in the Court of Chancery with an unsworn bill of complaint. Bills set out the terms of the patent,⁴² any assignment of the patent to the plaintiff (if he was not the original grantee),⁴³ and any extension of the patent term granted by act of Parliament.⁴⁴ Having set forth the basis of the right, plaintiffs would then recite how the defendant and his confederates had infringed the patent. The bills then asked for several things. First, they requested a discovery of various matters, including the number of infringing wares the defendant made or sold. Second, they prayed for a final injunction to restrain the defendant from using, making, or selling the plaintiff's invention or any other item that imitated, resembled, or counterfeited the invention. And third, they sought a writ of subpoena summoning the defendant to appear and answer the allegations laid out in the complaint. By the mid-18th century, bills also regularly requested a disgorgement of the defendant's profits,⁴⁵ which coincides with a similar development in copyright cases.⁴⁶

In an effort to invoke jurisdiction, plaintiffs would claim that the defendant's conduct was "contrary to Equity and good Conscience and tend[ed] to the apparent wrong and injury of your Orator."⁴⁷ They would further state that they had exhibited their bills in equity because

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40. For the affinity, see *Att'y Gen. v. Walker*, LL Parker Exchequer 1693–1745 MS 1, pp. 144, 148, Bodl. Viner MS 43, ff. 17^r, 17^v (Exch. 1739) (arg.); *Blanchard v. Hill*, LI Hill MS 5, pp. 93, 94 (Ch. 1742) (tm) (arg.); *Anonymous*, 1 Ves. Sr. 476, 476 (Ch. 1750); *Goodeson v. Gallatin*, 2 Dick. 455, 455 (Ch. 1771); *Horton v. Maltby*, LI Hill MS 18, pp. 148, 149 (Ch. 1783) (pat.).
41. In citations, we identify the three main types of English cases as follows: (pat.) = invention patent; (pr. pat.) = printing patent; and (©) = copyright. A few cited cases involve other forms of exclusive rights, which we abbreviate: (calico) = linen printing; (roy. lic.) = royal license; and (tm) = trademark.
42. *E.g.*, *Tomlyn v. Stephens*, C5/43/113 (Ch. 1662) (pat.).
43. *E.g.*, *Kay v. Butterworth*, C11/2456/21, no. 1 (Ch. 1737) (pat.).
44. *E.g.*, *Liardet v. Johnson*, C12/1346/22, no. 1 (Ch. 1777) (pat.).
45. *E.g.*, *Zomer v. Gapper*, C12/749/21, no. 1 (Ch. 1754) (pat.).
46. H. Tomás Gómez-Arostegui, *Equitable Infringement Remedies before 1800*, in *RESEARCH HANDBOOK ON THE HISTORY OF COPYRIGHT LAW* 195, 220–25 (Isabella Alexander & H. Tomás Gómez-Arostegui eds., 2016).
47. *Pope v. Mount*, C11/513/43, no. 1 (Ch. 1733/4) (pat.).

they had no remedy or “adequate Relief”⁴⁸ at law. The bill in *Bridges v. Fowler* is typical in stating that

your Orators cannot have an Adequate Remedy against the said Confederates at the Common Law nor can compel the said Confederates to Discover [certain matters,] . . . nor can restrain them from continuing or going on with their said Practices without the Aid of a Court of Equity[.] And for that Matters of this Nature are properly Cognizable & relievable in a Court of Equity[.]⁴⁹

Subpoenas would issue as a matter of course, summoning the defendant to appear and submit a sworn answer or otherwise respond to the complaint. The answer was the principal way of obtaining testimony from a defendant. The parties might later conduct additional discovery—chiefly through depositions (meaning, oral answers provided on oath and memorialized in writing by a court agent in response to written interrogatories)—after which the parties could set the cause down for a “hearing.” The hearing in Chancery was its equivalent of a bench trial. The court’s ruling following the hearing was called a “decree,” not a judgment.

Along the way, the Chancery could grant four types of injunctions. The steps for obtaining them largely track those in copyright suits, which one of us has discussed in detail elsewhere.⁵⁰ Briefly, (1) an injunction until answer was designed to last until the defendant filed a “full and perfect” answer—that is to say, an answer that responded to all the material allegations of the bill.⁵¹ After a defendant submitted a suitable answer, a plaintiff could seek (2) an injunction that lasted until the hearing of the cause.⁵² And at the conclusion of that hearing,⁵³ or sometimes beforehand,⁵⁴ the Chancery might also (3) enjoin a defendant while the case was being adjudicated at law to test the patent’s validity. Throughout this Article, we use the terms “interlocutory” and “interim” interchangeably to refer to the three injunction types just mentioned. Lastly, at the conclusion of the case the court might decree (4) a perpetual (*i.e.*, final) injunction.⁵⁵ Alongside this final injunction the

48. *Morris v. Oldham*, C12/379/15, no. 3 (Ch. 1766) (pat.).

49. *Bridges v. Fowler*, C11/2134/8, no. 1 (Ch. 1750) (pat.).

50. Gómez-Arostegui, *supra* note 46, at 196–220.

51. *E.g.*, *Wedgwood v. Neale*, C33/436, f. 16^v (Ch. 1770) (pat.).

52. *E.g.*, *Dwight v. Garner*, C33/281, f. 898^v (Ch. 1694) (pat.).

53. *E.g.*, *Hills v. Wright*, C33/259, ff. 313^v–314^r, C37/373 (Ch. 1682/3) (pr. pat.).

54. *E.g.*, *Liardet v. Johnson*, C33/448, f. 411^r (Ch. 1777) (pat.).

55. *E.g.*, *Stoughton v. Wilkinson*, C33/342, ff. 118^v–119^r (Ch. 1723/4) (pat.).

Chancery could also decree that the defendant deliver up any infringing items for destruction, disgorge any profits earned from the infringement, and pay costs.⁵⁶ None of these remedies stemmed from any statutory authority, apart from costs.⁵⁷ The only general statute touching invention patents, the Statute of Monopolies, neither created a cause of action for patent infringement nor provided any remedies for it.⁵⁸

The aforesaid equitable remedies should be contrasted with those available at law. Actions for the infringement of an invention patent were brought as actions for trespass on the case and the remedies were damages and costs.⁵⁹ Damages were recoverable as a matter of common law and could include punitive damages assessed by the jury,⁶⁰ particularly when sought against a repeat offender.⁶¹ Costs were allowed by statute,⁶² and included, among other things, fees for attorneys and barristers.⁶³ Again, the Statute of Monopolies supplied no legal remedies.

C. General Observations on Jurisdiction and Authority

There is no question, of course, that the Chancery had jurisdictional limitations in the 18th century. The court would not entertain a suit and grant the final relief sought by the complaint when the plaintiff could obtain adequate relief for the same wrong in a court of law. “In all such Cases, wherein the plaintiff hath his Remedy at Common Law

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56. *E.g.*, *Morris v. Unwin*, C33/436, ff. 281^v–283^v (Ch. 1771) (pat.).
57. This general power to award costs can only obliquely be traced to statutory authority. JOHN BEAMES, *A SUMMARY OF THE DOCTRINE OF COURTS OF EQUITY WITH RESPECT TO COSTS* 2–9, 159–60 (London, 1822).
58. Statute, 1624, 21 Jac. 1 c. 3; *BOTTOMLEY*, *supra* note 39, at 102–03.
59. *E.g.*, *Morris v. Branson*, KB139/99, f. 216^v (K.B. Trin. 1776) (pat.) (£500 damages, £113 10s costs); *Brodie v. Hopkins*, KB139/100, f. 68^v (K.B. Mich. 1778) (pat.) (1s damages, £66 9s costs); *Boulton v. Hornblower*, CP40/3818, rot. 567 (C.P. judg. Mich. 1796) (pat.) (1s damages, £2002 costs); *Turner v. Hughes*, KB139/104, f. 8^r (K.B. Mich. 1798) (pat.) (£50 damages, £33 costs).
60. *See generally* *Huckle v. Money*, 2 Wils. K.B. 205, 207 (C.P. 1763); *Wilkes v. Wood*, Lofft 1, 18–19 (C.P. 1763); *Benson v. Frederick*, 3 Burr. 1845, 1846 (K.B. 1766); *THE CITIZEN’S LAW COMPANION* 110 (London, 1794).
61. *E.g.*, *Morris v. Branson*, *MORNING CHRON.*, June 1, 1776, at 3 (K.B. 1776) (pat.); 1 JAMES OLDHAM, *THE MANSFIELD MANUSCRIPTS* 745 (1992) (transcribing trial notes taken by Lord Mansfield in *Morris*).
62. Statute of Gloucester, 1278, 6 Edw. 1 c. 1, § 1; WILLIAM TIDD, *THE LAW OF COSTS IN CIVIL ACTIONS* 2–3 (London, 1793).
63. R. BOOTE, *AN HISTORICAL TREATISE OF AN ACTION OR SUIT AT LAW* 176–78 (London, 1766); 2 MATTHEW BACON & HENRY GWILLIM, *A NEW ABRIDGMENT OF THE LAW* 263 (London, 5th ed. 1798).

for the very same Things, he shall not be relieved here.”⁶⁴ Although bills of complaint nearly always declared that the plaintiff had no remedy at law or no adequate remedy at law, that declaration was *pro forma*. Neither its inclusion nor its absence mattered as much as what was alleged in the complaint.⁶⁵ Those allegations described the nature of the suit and the ultimate objective of the plaintiff—*e.g.*, a bill seeking a final injunction or a bill seeking discovery only—both of which helped determine whether the Chancery had jurisdiction.⁶⁶ If the court determined it had no jurisdiction, it would dismiss the suit without prejudice and leave the plaintiff to her remedy at law.

When the Chancery had jurisdiction to decree final relief—assuming the case would eventually reach a hearing—it might also need to address whether to issue interim relief along the way, *e.g.*, an injunction until answer or an injunction until the hearing. The court developed certain conventions for when it would act and in this respect it established an authority to act. Most well known is the irreparable-injury rule, which, when invoked, assessed the mischief, if any, a plaintiff would suffer without an interim injunction and the mischief, if any, a defendant would suffer from an injunction.⁶⁷ Apart from considering the relief a court of law could award to address any such mischief,⁶⁸ the Chancery could also consider whether a subsequent form of equitable relief would suffice instead.⁶⁹ An injunction granted after an answer, for example, might do instead of one granted beforehand, and an award of profits at the hearing might obviate the need to grant an injunction

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64. WILLIAM BOHUN, *CURSUS CANCELLARIÆ* 8 (Savoy, 2d ed. 1723).
65. THE PRACTICAL REGISTER IN CHANCERY 24–25 (Savoy, 1714); JOHN MITFORD, *A TREATISE ON THE PLEADINGS IN SUITS IN THE COURT OF CHANCERY BY ENGLISH BILL* 43, 46 (London, 2d ed. 1787).
66. MITFORD, *supra* note 65, at 8; 1 JOSEPH HARRISON & JOHN GRIFFITH WILLIAMS, *THE ACCOMPLISH'D PRACTISER IN THE HIGH COURT OF CHANCERY* 398 (London, 7th ed. 1790).
67. *See, e.g.*, Lord Orrery v. Newton, Ridg. t. H. 252, 252 (Ch. 1744); Smith v. Haytwell, Amb. 66, 66–67 (Ch. 1747); Anonymous, 1 Ves. Sr. 476, 476 (Ch. 1750); Ryder v. Bentham, 1 Ves. Sr. 543, 543 (Ch. 1750); Fishmongers' Co. v. E. India Co., 1 Dick. 163, 164 (Ch. 1752); Horton v. Maltby, LI Hill MS 18, pp. 148, 149 (Ch. 1783) (pat.); Mortimer v. Cottrell, 2 Cox Eq. Cas. 205, 205 (Ch. 1789) (arg.); Isaacs v. Humpage, 3 Bro. C.C. 463, 465 (Ch. 1792); Patrick v. Harrison, 3 Bro. C.C. 476, 477 (Ch. 1792) (arg.); Johnson v. Goldswaine, 3 Anst. 749, 750 (Exch. 1796).
68. *See, e.g.*, Duke of Grafton v. Hilliard, Amb. (2d ed.) 159 n.2 (Ch. 1736); Jackson v. Barnard, Ridg. t. H. 259, 260 (Ch. 1744); Anonymous, 2 Ves. Sr. 414, 414–15 (Ch. 1752); Pechel v. Fowler, 2 Anst. 549, 550 (Exch. 1795).
69. *See, e.g.*, Gibson v. Smith, BL Add. MS 36016, pp. 148, 148, BL Add. MS 36019, pp. 219, 219 (Ch. 1742); Univs. of Oxford & Cambridge v. Richardson, 6 Ves. Jr. 689, 701 (Ch. 1802) (pr. pat.) (arg.).

until the hearing. We anachronistically use the term “authority” here because the court’s decision that it lacked authority to grant interim relief might only result in the denial of a motion, rather than dismissal.⁷⁰

As we noted earlier, one of the issues that plagues injunction jurisprudence today is the uncertain meaning of “irreparable injury” and how the concept differs, if at all, from the inadequate-remedy-at-law requirement. This is a problem we will revisit later. Those hoping for purity of conceptual diction in the 18th century will be disappointed. Although the phrases “irreparable mischief” or “irremediable injury” were used much more commonly during requests for interlocutory relief, and in the manner described previously, usage did slip from time to time.⁷¹ What matters more than the labels are the inquiries themselves. Determining equitable jurisdiction to decree final relief solely required examining the remedies available at law, while determining the court’s authority to enjoin a defendant before the final decree examined whether alternative legal or equitable relief would do instead of the interim injunction sought by the plaintiff.⁷²

III. FINAL INJUNCTIONS

Because the jurisdiction of the Court of Chancery largely turned on the end of the bill, we begin our discussion of final injunctions by treating the unusual scenario of a plaintiff seeking retrospective relief only and no injunction. If this occurred, that meant a plaintiff had

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70. The burdens for interim injunctions in patent and copyright cases are too intricate to recount here. We will note, however, that Chief Justice De Grey stated in a copyright case that it was no “objection that the party applying for [an interim injunction], has a remedy at law.” *Donaldson v. Becket*, *MORNING CHRON.*, Feb. 23, 1774, at 2 (H.L. 1774) (©) (De Grey, C.J.). Moreover, ordering a defendant to keep an account of his profits, in lieu of an interim injunction, appears to have occurred only when the court had doubts about the merits of a plaintiff’s case and concerns over the hardship of an injunction. *E.g.*, *Stationers v. Carnan*, C33/442, ff. 188^r–189^r (Ch. 1774) (pr. pat.) (enjoining some activities while a case was sent to law to adjudicate the validity of a patent but allowing other activities if the defendant kept an account); *Liardet v. Johnson*, C33/448, f. 411^r (Ch. 1777) (pat.) (same).
71. *E.g.*, *Earl Bathurst v. Burden*, 2 Bro. C.C. 64, 65 (Ch. 1786) (arg.); *Dench v. Bampton*, 4 Ves. Jr. 700, 704, 706 (Ch. 1799) (arg.).
72. For a modern interpretation of the two concepts that most closely tracks 18th-century English practice, see John Leubsdorf, *The Standard for Preliminary Injunctions*, 91 HARV. L. REV. 525, 551 (1978) (“At trial, [irreparable injury] refers to injury for which there is no adequate remedy at law. At the interlocutory [stage], it denotes injury for which there is no adequate remedy—legal or equitable—at final judgment.”). For similar views, see OWEN M. FISS, *THE CIVIL RIGHTS INJUNCTION* 48 (1978); DOUGLAS LAYCOCK, *THE DEATH OF THE IRREPARABLE INJURY RULE* 110–13 (1991).

concluded that the defendant would not repeat his tortious acts. We then turn to the routine course in patent suits, which was to anticipate that the defendant would infringe again, and to pray for a final injunction in the bill. Whereas the first scenario typically undermined the Chancery's jurisdiction, the second triggered it. After reviewing the history, we will see that the test for equitable jurisdiction was fairly lenient, that it depended in great measure on the likelihood of future wrongs, and that presuming equitable jurisdiction in patent cases—which is what a presumption of the inadequacy of legal remedies accomplishes—comports with traditional equitable principles. We will also see that the Chancery did not require a plaintiff to demonstrate at the hearing that some other equitable remedy, in lieu of a final injunction, would not suffice to redress potential future infringements.

A. Plaintiffs not Seeking a Final Injunction

The clearest instance of resisting jurisdiction can be found in tort cases where a plaintiff sought retrospective monetary relief but no injunction. As a general matter, these cases are hard to find in equity because they were vulnerable to dismissal. Lord Hardwicke stated the general principle in 1745 in a suit involving a claim for “waste,” *viz.*, the destruction of land, timber, or houses by a person who held them subject to a reversion or remainder in the plaintiff.⁷³ There, in *Jesus College v. Bloome*, the defendant was no longer in possession of the land and could commit no further waste, and so although the complaint originally prayed for injunctive relief,⁷⁴ the plaintiff did not seek a final injunction. At the hearing, Lord Hardwicke dismissed the suit, ruling that the plaintiff had a remedy at law for the past wrong by bringing an action for trover.⁷⁵ He found no relevant precedent allowing the court to decree, under the circumstances presented, retrospective monetary relief where no injunctive relief could or would be granted.⁷⁶

73. On the affinity between waste and infringement, see, e.g., Att’y Gen. v. Walker, Bodl. Viner MS 43, ff. 17^r, 18^r (Exch. 1739) (Comyns, C.B.) (stating that the Chancery restrained “wast[e]” in copyright-infringement cases); *Millar v. Taylor*, 4 Burr. 2303, 2324 (K.B. 1769) (©) (Willes, J.) (“*Injunctions to stay printing or the Sale of Books printed, are in the Nature of Injunctions to stay Waste . . .*”); *Doolittle v. Walton*, 2 Dick. 442, 442 (Ch. 1771) (characterizing injunctions in infringement cases as falling under the “head of waste”); *Goodeson v. Gallatin*, 2 Dick. 455, 455 (Ch. 1771) (noting that jurisdiction in invention cases stemmed from its jurisdiction in waste cases); *Donaldson v. Becket*, MORNING CHRON., Feb. 24, 1774, at 2 (H.L. 1774) (©) (Camden, L.C.) (stating that copyright injunctions are “obtained for the purpose of staying waste”).

74. *Jesus Coll. v. Bloome*, C11/1074/41, no. 1 (Ch. 1742/3).

75. *Jesus Coll. v. Bloome*, 3 Atk. 262, 264, C33/386, ff. 27^v–28^r (Ch. 1745).

76. *Jesus Coll. v. Bloom*, Amb. 54, 55 (Ch. 1745). For a copyright suit where the bill sought retrospective relief only, and the Court of Exchequer

We have yet to encounter an invention-infringement suit where the complaint prayed solely for retrospective monetary relief. This is no surprise. Counsel for patent holders would have known that the Chancery would likely dismiss the suit on the ground the plaintiff had an adequate remedy at law for damages.

B. Plaintiffs Seeking a Final Injunction

The power of the Chancery increased remarkably when it anticipated the repetition of tortious acts. Indeed, the court's jurisdiction to decree final injunctions in patent cases for future wrongs was unquestionable in the 18th century, and it was not something the court required plaintiffs to revisit in each patent suit. It is not surprising, then, that no case can be cited from the period stating that a victim of infringement bore a burden of proving at the hearing that they would suffer some injury in the absence of a final injunction and that legal relief would be inadequate to compensate for that injury. Damages were deemed inadequate in cases where future infringement was likely, and courts could presume future infringement from past infringement.

To start, the only remedy available at law for patent infringement—damages—was deficient. The principal reason was straightforward and stemmed from a legal conclusion, rather than a factual one. The legal remedy was limited to torts occurring *before* the action commenced. Common-law courts could not award damages for infringements that occurred after the action commenced, let alone infringements expected to occur after judgment. That meant that without a final injunction, a plaintiff who succeeded in an action at law might have to file additional actions against the same defendant. It was this prospect that made the legal remedy inadequate.⁷⁷

reached a similar conclusion about its equity jurisdiction, see *Keble v. Onley*, E112/836/802, no. 1 (Exch. 1705), E161/64, f. 151^r (Exch. 1705/6) (©). A report of the ruling is at BL Add. MS 22610, f. 11^v (Exch. 1705/6), *printed in* EQUITY CASES IN THE COURT OF EXCHEQUER 1660 TO 1714, at 556 (W.H. Bryson ed., 2007). *Accord* *Grierson v. Eyre*, C13/594/14, no. 1 (Ch. 1802), 9 Ves. Jr. 341, 346–47 (Ch. 1804) (pr. pat.) (dismissing suit where the complaint did not seek an injunction); *see also infra* text accompanying notes 99–101.

77. One can discern a follow-on harm from future infringement—in the form of the actual anticipated expenses of future litigation—but the Chancery did not specifically ask whether the legal remedy was inadequate to redress the costs of future prosecutions. The analysis occurred at a higher level of abstraction. Insofar as other follow-on harms of infringement (like lost sales) and their redressability at law might arise, those could form additional grounds for equitable jurisdiction. For example, a secondary reason for finding retrospective damages inadequate was that proving damage causation might be especially difficult if not impossible in some cases. *E.g.*, *Richardsons v. Univs. of Oxford & Cambridge* (H.L. 1804) (pr. pat.) (Lord Ellenborough) (observing that where a plaintiff and another printer not named in the suit had equal rights to produce a work

One of us has previously identified a number of 17th- and 18th-century authorities for the general proposition that a plaintiff could not recover damages at common law for wrongs (*i.e.*, torts) anticipated to occur after commencing the action.⁷⁸ But the doctrine is also reflected in 18th-century invention cases. The bill in *Bell v. Heath* is instructive in this regard. There, counsel for the plaintiff correctly stated that

by the Strict Rules of the Common Law [your Orator has no] . . . means to restrain the [defendants] . . . from making & selling [the infringing wares] . . . but has remedy only by way of Action to recover damages for the Injury done to him[,] which must be repeated as often as the said [defendants] . . . shall think proper to disturb your Orator in the exercise of his said Invention⁷⁹

And in *Blanchard v. Hill*, the Attorney General also suggested as much while analogizing his client's case, which dealt with a trademark, to invention and copyright cases:

[T]he Ground of Granting Injunctions on these Occasions is that the Person who is Injured cant have an adequate remedy for it by a Recovery in an Action at Law[,] for such a Recovery won't put a stop to repeating the same abuse for the future [T]his Case is on the same reason with the Proprietors of Books to be printed or prints, or patents for the sole use of new Inventions[,] in which Cases Prohibitions and Injunctions are frequent⁸⁰

in England, it was difficult to ascertain whether the defendant's importation of an identical work into England would have taken income away from the plaintiff, given that without the infringing importation, the work might have been supplied to the purchasing public by the other authorized English printer rather than by the plaintiff), *printed in* *Judgments and Extracts from Pleadings; The Universities of Oxford and Cambridge versus Richardsons* 26, 30 (s.l.n. [c.1822]), NRS CS236/B/24/2, no. 3.

78. H. Tomás Gómez-Arostegui, *Prospective Compensation in Lieu of a Final Injunction in Patent and Copyright Cases*, 78 *FORDHAM L. REV.* 1661, 1696–99 (2010). For additional authority, see 2 *MATTHEW BACON, A NEW ABRIDGMENT OF THE LAW* *1, *4 (London, 4th ed. 1778); 5 *AN ABRIDGMENT OF THE MODERN DETERMINATIONS IN THE COURTS OF LAW AND EQUITY* 135–36 (London, 1805); JOHN BAKER, *BAKER AND MILSOM: SOURCES OF ENGLISH LEGAL HISTORY* 196–97, 200 (2d ed. 2010) (describing a 1383 decision and a treatise from c.1516).
79. *Bell v. Heath*, C11/1532/5, no. 1 (Ch. 1736) (pat.).
80. *Blanchard v. Hill*, LI Hill MS 5, pp. 93, 94 (Ch. 1742) (tm) (arg.); *accord* *Baskett v. Univ. of Cambridge*, LI Coxe MS 54, pp. 267, 279 (K.B. 1749) (pr. pat.) (arg.) (“A further reason why the Court of Chancery may be said to interpose in Cases of this kind is that the remedy at Law gives [retrospective] Damages only but this Court preserves the thing in Specie.”).

Middlesex *vs* Elizabeth Taylor Widow puts in her plea John Illson
 for Attorney against Richard Sucket in a plea of Trover upon
 the Case

Middlesex *vs* Richard Sucket puts in his plea John Webb his
 Attorney at the Suit of Elizabeth Taylor Widow in the plea
 aforesaid

Middlesex *vs* *Re it* Remembered that in Lawe Term last past
 before our Lord the King at Westminster came Elizabeth Taylor
 Widow by Brian Lawson her Attorney and brought here into this
 Court of our said Lord the King then there her certain Bill against
 Richard Sucket being in the Custody of the Marshal of the High Court
 of our said Lord the King before the King himself of a plea of
 Trover upon the Case and there was Judgment for the
 Defendant to wit John Doe and Richard Roe which said
 Bill followeth in these words: *Middlesex* Elizabeth
 Taylor Widow Complaine of Richard Sucket being in the Custody of
 the Marshal of the High Court of our said Lord the King
 before the King himself for that whereas our said Lord
 George the Third by his Grace of God of Great Brittain
 France and Ireland King Defender of the Faith upon the
 sixth Day of December in the third year of his Majesty his said
 Majesty's said date at Westminster the same day and year
 did cause to be made with his great Seal of Great Brittain and which
 said Letters Patent was the said Elizabeth now brings
 into Court the same day and year ever said Richard that
 whereas the said Elizabeth called in the said Letters Patent
 by the name and description of Elizabeth Taylor of the Marriage
 of Walter Taylor late of this same place Blockmaker deceased and
 Taylor's son in law by her said Letters Patent the said Letters Patent
 had their said late husband had by his industry labour and
 industry and at a great Expence invented a sort of Engines
 or Instruments and other Apparatus for the making of
 Blotche Sifters and Sifters whereby the said Letters Patent
 had been enabled to supply the said King's Navy with all
 kinds of Sifters and Sifters which were used in
 the said Navy and were more certain and efficient
 in their Operation than any ever before used and which would
 be the means of a great saving of the
 said Letters Patent and being that the said Blockmaker's
 Letters Patent were examined by the principal Officers of the
 Admiralty and by Licence in the year one thousand seven
 hundred and fifty nine and in the month of July did
 between them and the said Blockmaker's Letters Patent a Trial was made
 of the said Letters Patent and the said Blockmaker's Letters Patent
 principal Officers of the said King's Navy by the said
 Letters Patent at a Court on which Trial was made
 by the said Blockmaker's Letters Patent were found to be greatly superior to
 all others that the Commissioners of the said Letters Patent
 had contracted with the Blockmaker for supplying
 the said King's Navy with a quantity of the said
 Blotche Sifters and Sifters and were desirous of having
 the whole Navy supplied therewith but for as much as the
 said Blockmaker was apprehensive that by employing a great
 number of Workmen under her the means of constructing the
 said Engines Tools Instruments and other Apparatus and
 making the said Blockmaker would be discovered and by
 might be deprived of the benefit of the said Letters Patent

Roll 94. Lee

Plea Roll, Taylor v. Sucket, KB122/360, rot. 94 (K.B. bill Pasch. 1770)

Records of common-law actions are also revealing. Although infringement cases commenced differently in the two principal common-law courts—by original writ in the Court of Common Pleas versus bill of Middlesex in the Court of King’s Bench—in both the action was for trespass on the case. The plaintiff would set out the various ways in which the defendant infringed the patent and identify when the infringement had begun. Importantly, because a plaintiff could only recover for infringements up to the time she had commenced the action, patentees limited their recovery in the King’s Bench to the day of “Exhibiting the said bill,”⁸¹ and in the Common Pleas to the “day of suing out the Original Writ.”⁸² William Hindmarch encapsulated the rule in 1846: “[A] Court of Law has power only to give a patentee damages for any injury he may have sustained by the actual violation of his right, after it has been committed”⁸³

Plaintiffs could benefit from something akin to issue preclusion,⁸⁴ and they could wait six years to sue again (the limitations period for infringement).⁸⁵ But additional actions between the same parties inevitably raised new issues—or old issues that were not apparent on the record of the prior action—and to wait six years to file must have been as unrealistic then as it is now. This is why 19th-century sources speak of injunctions being necessary to avoid the inconvenience and expense of having to bring additional patent-infringement actions at law.⁸⁶ Boiled down to its essence, if future wrongs were more likely than

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81. *E.g.*, Taylor v. Sucket, KB122/360, rot. 94 (K.B. bill Pasch. 1770) (pat.); Horton v. Harvey, KB122/461, rot. 1828 (K.B. bill Pasch. 1781) (pat.).
 82. *E.g.*, Arkwright v. Nightingale, CP40/3768, rot. 720–722 (C.P. writ Pasch. 1784) (pat.); Boulton v. Hornblower, CP40/3818, rot. 567–569 (C.P. writ Mich. 1796) (pat.); *cf.* 3 WILLIAM BLACKSTONE, COMMENTARIES ON THE LAWS OF ENGLAND 226 (Oxford, 1768) (“For the plaintiff cannot recover damages for more waste than is contained in his original complaint; neither is he at liberty to assign or give in evidence any waste made after the suing out of the writ”).
 83. W.M. HINDMARCH, A TREATISE ON THE LAW RELATING TO PATENT PRIVILEGES FOR THE SOLE USE OF INVENTIONS 305 (London, 1846); *see also* Sheriff v. Coates, 1 Russ. 159, 164 (Ch. 1830) (calico) (arg.) (“retrospective only”).
 84. *See generally* Trial of Elizabeth Duchess Dowager of Kingston, 20 How. St. Tr. col. 355, 538 n.* (H.L. 1776); Kinnersley v. Orpe, Dougl. 499, 499–500 (K.B. 1780); Gahan v. Maingay, Irish T.R. 20, 54 (Exch. Ch. Ir. 1793); *cf. also* Liardet v. Johnson, LI Hill MS 20, p. 227, 1 Y. & C. Ch. Cas. 527 (Ch. 1780) (pat.).
 85. Statute, 1624, 21 Jac. 1 c. 16 (limitations period for actions on the case).
 86. *See, e.g.*, Smith v. London & Sw. Ry. Co., Kay 408, 415 (Ch. 1854) (pat.) (arg.); GEORGE JEREMY, A TREATISE ON THE EQUITY JURISDICTION OF THE HIGH COURT OF CHANCERY 327 (London, 1828); HINDMARCH, *supra* note 83, at 305. Similar observations were made in statutory copyright cases, though those claims carried a shorter limitations period of twelve

not, then the remedy at law was inadequate, and equity had jurisdiction to intervene and decree relief. If the jurisdictional test does not seem onerous, that is because it was not.⁸⁷

Notably, this equitable principle was not limited to patent- and copyright-infringement suits. By way of example, the Solicitor General, John Scott, who was later appointed as Lord Chancellor Eldon, invoked the principle successfully in a 1790 case involving the unauthorized digging for ore:

Now the remedy at law can at most be only for the injury done at the time of the commencement of the Action & if the defendant goes on digging it will commit so many distinct trespasses for which fresh Actions must be brought by the plaintiff from time to time which is such an inconvenience as will induce this Court to interfere.⁸⁸

There was one underlying factual consideration relevant to whether the court had jurisdiction to decree an injunction: whether the defendant's activity could be expected to continue. If that was impossible, then, barring special circumstances inapplicable here, a plaintiff's claim in reality could only seek retrospective relief, and an action at law was the appropriate course. Imagine, for instance, a patent that expired before the suit was filed. That aside, it appears patentees were not expected to prove that infringement would continue. Speaking to this point more generally in 1745, in the waste case mentioned above, Lord Hardwicke stated that the court would "presume[]" that "when a man has done waste he may commit the same again."⁸⁹ Two years later he reiterated the point, stating that even if a defendant claimed he had stopped wasting property, the court would nevertheless "presume he

months, *see* *Rundell v. Murray*, Jac. 311, 314 (Ch. 1821) (©); *Lawrence v. Smith*, Jac. 471, 472 (Ch. 1822) (©), or six months, *see* *Wilkins v. Aikin*, 17 Ves. Jr. 422, 424 (Ch. 1810) (©). *Cf.* EDWARD LLOYD, *THE LAW OF TRADE MARKS* 5 (London, 2d ed. 1865) (stating that in trademark cases the Chancery proceeds "on the assumption that the legal remedy is inadequate"); *Ford v. Foster*, 7 L.R. Ch. App. 611, 632 (Ch. App. 1872) (tm) (Mellish, L.J.) (repeated actions at law are inadequate).

87. *See generally* 1 HARRISON & WILLIAMS, *supra* note 66, at 396 (explaining that the legal remedy must be "clear and certain" and as "effectual and complete" as the equitable one); 3 BLACKSTONE, *supra* note 82, at 438 (stating that the Chancery had a "concurrent jurisdiction" and "cognizance" with courts of law in cases involving waste to property and "other similar injuries" that permitted it to enjoin).
88. *Flamank v. Gullett*, LI Misc. MS 108, pp. 167, 168 (Ch. 1790) (arg.); *accord* *Falmouth v. Innys*, Mosely 87, 89 (Ch. 1728/9) (arg.); *Coulson v. White*, BL Hargrave MS 54, pp. 400, 400, 3 Atk. 21, 21 (Ch. 1742/3); *Hughes v. Trs. of Morden Coll.*, 1 Ves. Sr. 188, 189 (Ch. 1748).
89. *Jesus Coll. v. Bloom*, Amb. 54, 55 (Ch. 1745); *see also supra* note 73.

may do further waste.”⁹⁰ Nineteenth-century cases certainly had no trouble presuming that a defendant who had already infringed an exclusive right, like a patent, would likely infringe in the future.⁹¹

That one did not need to affirmatively prove future infringement or inadequacy is further borne out by briefs that Charles Yorke used in three copyright cases in which he served as plaintiff’s counsel at the hearing of the cause. The son of Lord Hardwicke, Yorke served as Solicitor General (1756–1762), Attorney General (1762–1763 and 1765–1766), and briefly as Lord Chancellor (1770) for a few days before his death.⁹² The first suit involved common-law copyrights, the second statutory copyrights, and the third a mixture of both. The briefs summarized the facts Yorke hoped to prove at the hearings and utilized documents, depositions, and excerpts of the defendants’ answers to support those facts. None of the proofs in the briefs contain any inkling of facts regarding the defendants’ future conduct or the remedies available at law. Rather, they focus exclusively on showing: (1) the plaintiffs’ right in a work, including by proving the execution of indentures, deeds poll, and receipts; the authenticity of signatures on those documents; the death of witnesses to those documents; the partnerships of plaintiffs; and the death of authors; and (2) the defendants’ infringement of a work, typically through admissions contained in the answers.⁹³

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90. Att’y Gen. v. Burrows, 3 Atk. 485, 485, 1 Dick. 128, 128 (Ch. 1747); *accord* Countess of Strathmore v. Bowes, 2 Dick. 673, 675 (Ch. 1786) (registrar); Robinson v. Lord Byron, 2 Dick. 703, 705 (Ch. 1788).
91. Losh v. Hague, 1 Web. Pat. Cas. 200, 200–01, 2 Coop. T. Cott. 59, 59 (Ch. 1837) (pat.); Proctor v. Bayley, 6 R.P.C. 538, 542 (C.A. 1889) (pat.); WILLIAM W. KERR ET AL., A TREATISE ON THE LAW AND PRACTICE OF INJUNCTIONS 270 (4th ed. 1903) (“[P]ast infringement of a recent date is *primâ facie* evidence of an intention to repeat the wrong.”); *cf.* Millington v. Fox, 3 My. & Cr. 338, 342–43, 350–52 (Ch. 1838) (tm); Geary v. Norton, 1 De G. & Sm. 9, 10–12 (Ch. 1846) (calico); Phillips v. Thomas, 62 L.T. 793, 795–96 (Ch. 1890) (nuisance) (contrasting *quia timet* injunctions where a plaintiff *must* demonstrate that reasonable men would expect a wrong to occur).
92. JOHN SAINTY, A LIST OF ENGLISH LAW OFFICERS, KING’S COUNSEL AND HOLDERS OF PATENTS OF PRECEDENCE 48, 65 (1987); HANDBOOK OF BRITISH CHRONOLOGY 91 (E.B. Fryde et al. eds., 3d ed. 1996).
93. *See* (1) Millar v. Taylor, Brief for Hearing, BL Add. MS 36193, ff. 88–90 (Ch. 1765) (©) (involving *The Seasons*); Millar v. Taylor, C33/426, ff. 68^v–69^f (Ch. 1765) (sending parties to law to test the viability of common-law copyright, but continuing injunction in the meantime); (2) Millar v. Taylor, Brief for Hearing, BL Add. MS 36193, ff. 91–94 (Ch. 1765) (©) (involving *The Complaint*); Millar v. Taylor, C33/426, f. 60^v (Ch. 1765) (granting final injunction); (3) Bathurst v. Donaldson, Brief for Hearing, BL Add. MS 36193, ff. 225–228 (Ch. 1767) (©); Bathurst v. Donaldson, C33/429, ff. 546^v–547^v (Ch. 1767) (sending parties to law to test the viability of common-law copyright, and continuing injunction in the meantime as to the statutory copyright). In 1769, the King’s Bench

Succeeding on the merits presumptively entitled a plaintiff to a final injunction,⁹⁴ and we have never encountered a case that denied a final injunction on the ground that the successful patentee had an adequate remedy at law. Three cases spanning 100 years highlight these points. The first is the 1684 decree in *Hills v. Wright*, which involved a patent to print the Bible. There, Lord Keeper Guilford decreed that

where it appeared to this Court that there was a right as it doth in this Case[,] the Law having determined the same for the plaintiff[,] Itt was Naturall for this Court to give releife for the same in specie[.] And doth therefore thinck fitt & soe orders and decrees that the [interlocutory] Injunction \formerly granted in this Cause . . . bee made perpetuall/⁹⁵

The second was decided in the Court of Exchequer, on its equity side, and involved another printing patent. Chief Baron Skynner stated that granting a final injunction at the hearing was simply “a matter of form.”⁹⁶ The Court of Exchequer shared an equitable jurisdiction with the Chancery and followed the same basic principles.⁹⁷ And the third suit involved an invention patent. There, Baron Eyre, who was sitting

upheld common-law copyright in *Millar v. Taylor*, 4 Burr. 2303 (K.B. 1769), leading the Chancery to grant a final injunction in the first case. *Millar v. Taylor sub nom. Grant v. Taylor*, C33/433, ff. 413^r–414^r (Ch. 1770). The third case appears to have settled after *Millar*.

94. For decrees granting final injunctions, see, e.g., *Hills v. Wright*, C33/261, ff. 282^v–283^r (Ch. 1683/4) (pr. pat.); *Stationers v. Wright*, C33/262, f. 260^{r-v} (Ch. 1683/4) (pr. pat.); *Baskett v. Parsons*, C33/329, ff. 418^r–419^r (Ch. 1718) (pr. pat.); *Knaplock v. Curll*, C33/339, f. 12^{r-v} (Ch. 1722) (©); *Stoughton v. Wilkinson*, C33/342, ff. 118^v–119^r (Ch. 1723/4) (pat.); *Webb v. Rose*, C33/358, ff. 308^v–309^r, C33/362, f. 55^{r-v} (Ch. 1732–33) (©); *Gibbs v. Cole*, C33/365, f. 222^{r-v} (Ch. 1735/6) (© & roy. lic.); *Baller v. Watson*, C33/369, ff. 315^v–316^v (Ch. 1737) (©); *Blackwell v. Harper*, 2 Atk. 93, 96 (Ch. 1740) (©); *Manby v. Owen*, C33/410, f. 396^{r-v} (Ch. 1758) (©); *Millar v. Taylor*, C33/426, f. 60^{r-v} (Ch. 1765) (©); *Nicoll v. Simpson*, C33/430, ff. 251^v–252^v (Ch. 1768) (©); *Millar v. Taylor sub nom. Grant v. Taylor*, C33/433, ff. 413^r–414^r (Ch. 1770) (©); *Macklin v. Richardson*, C33/436, ff. 35^v–36^r (Ch. 1770) (©); *Morris v. Unwin*, C33/436, ff. 281^v–283^v (Ch. 1771) (pat.); *Morris v. Unwin*, C33/438, f. 146^{r-v} (Ch. 1772) (pat.); *Becket v. Donaldson*, C33/439, ff. 26^r–27^r (Ch. 1772) (©); *Pyle v. Falkener*, C33/442, ff. 309^v–311^r (Ch. 1774) (© & roy. lic.); *Bach v. Longman*, C33/447, ff. 582^v–583^r (Ch. 1777) (© & roy. lic.); *Mason v. Murray*, C33/452, ff. 486^r–487^r (1779) (©); *Liardet v. Johnson*, C33/454, ff. 527^v–530^r (Ch. 1780) (pat.); *Beckford v. Hood*, C33/500, f. 504^{r-v} (Ch. 1798) (©).
95. *Hills v. Wright*, C33/261, ff. 282^v–283^r (Ch. 1683/4) (pr. pat.).
96. *Eyre v. Carnan*, 5 Bacon Abr. (5th ed.) 597, 600 (Exch. 1781) (pr. pat.).
97. CHARLES BARTON, AN HISTORICAL TREATISE OF A SUIT IN EQUITY 17, 22 (London, 1796); W.H. BRYSON, THE EQUITY SIDE OF THE EXCHEQUER 9 (1975).

by designation in the Chancery, called final injunctions the “Ordinary” form of relief in patent cases—something to which a patentee who had succeeded on the merits would be “intitled”—as distinguished from a few areas where he called injunctions an “extraordinary remedy.”⁹⁸

Although the Chancery undoubtedly had jurisdiction to grant final injunctions in patent (and other) cases—due to the prospect of continuing wrongs—we must also say a word about whether the Chancery required patentees to demonstrate that alternative *equitable* remedies would not suffice to redress future infringements. The potential inquiry here would be prudential rather than jurisdictional. The answer, again, is no, and the reason, once more, is simple. The court’s ability to award monetary relief in these types of cases was limited to a disgorgement of the defendant’s profits *alongside* a final injunction. As Lord Hardwicke put it, again in the context of waste, monetary relief in Chancery was proper when “incident[al]” to injunctive relief.⁹⁹ “Where the bill is for an injunction, and waste has been already committed, the court, to prevent a double suit,” meaning a suit in equity for prospective relief and an action at law for retrospective relief, “will decree an account, and satisfaction for what is past.”¹⁰⁰ This meant that equitable monetary relief in patent- and copyright-infringement suits was backward looking.¹⁰¹ Not surprisingly, it also meant that the Chancery did not utilize ongoing royalties in these cases.¹⁰²

The hardship a defendant might suffer from a final injunction and the interests of the public, though factors listed in *eBay*, are not the

98. *Liardet v. Johnson*, LI Hill MS 20, pp. 227, 240–41, 243, 1 Y. & C. Ch. Cas. 527, 532–33 (Ch. 1780) (pat.); *see also* *Blackwell v. Harper*, BL Hargrave MS 412, ff. 130^v, 131^v (Ch. 1740) (©) (Hardwicke, L.C.) (stating that the copyright statute “secures the property [in a copyright] so as to entitle the plaintiff to an Injunction in this Court”); Opinion of William Murray, Solic. Gen. (later ennobled as Lord Mansfield), *printed in* *Petition of the Booksellers of London* 11 (Sess. July 15, 1746) (©), SL Session Papers v. 6, no. 41 (“Authors and Proprietors . . . *always* have Recourse to a Court of Equity, which proceeds upon the Foundation of the *Property* declared by the [copyright] Act, and [the court] gives a specifick Relief, by granting Injunctions to restrain . . . pirated Editions . . .”).

99. *Jesus Coll. v. Bloome*, BL Add. MS 36017, pp. 121, 123, 3 Atk. 262, 262 (Ch. 1745); *Jesus Coll. v. Bloom*, Amb. 54, 55 (Ch. 1745) (“[T]his Court will decree an account of waste done at the same time, with an injunction . . .”); *see also supra* text accompanying notes 73–76.

100. *Jesus Coll.*, 3 Atk. at 262.

101. *See* *Grierson v. Eyre*, 9 Ves. Jr. 341, 346–47, GT Eldon MS 1803–1804, ff. 132^r–133^v (Ch. 1804) (pr. pat.); *Baily v. Taylor*, 1 Russ. 73, 76 (Ch. 1829) (©); *Millington v. Fox*, 3 My. & Cr. 338, 350–51 (Ch. 1838) (tm) (arg.); *Bacon v. Jones*, 4 My. & Cr. 433, 435 (Ch. 1839) (pat.) (arg.); *Smith v. London & Sw. Ry. Co.*, Kay 408, 415 (Ch. 1854) (pat.).

102. Gómez-Arostegui, *supra* note 78, at 1699–1707.

focus of this Article. Nevertheless, we will note that Baron Eyre dismissed the former in the invention case mentioned previously:

Where it restrains in Cases of Patents it takes nothing from the Individuals restrained which is their right. It only hinders them from invading anothers [right] As to tying up the Party[,] the Right to do so is established.¹⁰³

[As to the argument] that it will be a hardship to tie the Defendant up for ever from making this Cement[,] . . . if the Plaintiffs have established their Right at Law, they are intitled to tie him up. This is not different from other Injunctions in like Cases.¹⁰⁴

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.¹⁰⁵ We are aware of only one intangible-property case where a defendant's hardship affected a decree, and it did so only tangentially. There, the Court of Chancery modified a seizure order to permit a defendant to transport infringing books from England back to Scotland, where they could be sold legally.¹⁰⁶

C. Subsequent Developments

The retrospective limit on damages at common law for continuing wrongs largely remains the rule in England today,¹⁰⁷ meaning that the legal remedy continues to be inadequate.¹⁰⁸ Over the years, as Parliament enacted additional patent statutes, it did nothing to abrogate the common-law bar, though a rules committee did eventually

103. *Liardet v. Johnson*, GT Eldon MS, Notes of Cases 1779, pp. 34, 46, 47 (Ch. 1780) (pat.).

104. *Liardet v. Johnson*, LI Hill MS 20, pp. 227, 242–43, 1 Y. & C. Ch. Cas. 527, 533 (Ch. 1780) (pat.).

105. *E.g.*, *Hills v. Univ. of Oxford*, 1 Vern. 275, 276 (Ch. 1684) (pr. pat.); *see also* *Univs. of Oxford & Cambridge v. Richardson*, 6 Ves. Jr. 689, 711 (Ch. 1802) (pr. pat.) (considering public interest to *favor* an interlocutory injunction where there was some doubt about the patentee's standing); *see also supra* text accompanying notes 67–70 (discussing hardship).

106. *Baskett v. Parsons*, C33/337, ff. 124^v–125^r (Ch. 1721/2) (pr. pat.); *see also* H. Tomás Gómez-Arostegui, *Patent and Copyright Exhaustion in England circa 1800*, at 41–45 (2017), <http://ssrn.com/abstract=2905847>.

107. JAMES EDELMAN, *MCGREGOR ON DAMAGES* 396–99 (20th ed. 2018).

108. *Jaggard v. Sawyer*, [1995] 2 All E.R. 189, 204–05 (C.A. 1994) (Millett, L.J.) (stating that the common-law remedy in cases of continuing trespass remains inadequate due to legal damages still “cover[ing] the past only and not the future”).

permit courts to consider actionable wrongs through the time of trial.¹⁰⁹ Nevertheless, developments on the equity side eclipsed the legal remedy in some respects. In 1858, Parliament empowered the Chancery to award monetary relief in lieu of a final injunction for future wrongful acts.¹¹⁰ This power was not limited to patent cases but applied to all manner of suits. According to the leading 19th-century authority on the subject, creating this new equitable remedy did not alter traditional equity practice on final injunctions. That would have required a more specific Parliamentary directive:

[T]he Court of Chancery has repudiated the notion that the Legislature intended to turn that Court into a tribunal for legalizing wrongful acts Expropriation, even for a money consideration, is only justifiable when Parliament has sanctioned it.¹¹¹

Plaintiffs thus remained “*prima facie*” entitled to an injunction,¹¹² including in patent cases.¹¹³ That meant it was incumbent on defendants to prove their case was an “exceptional” one, warranting no injunction, such as by demonstrating that future actionable wrongs were unlikely; or that the anticipated injury to the plaintiff’s “legal rights” was small, that the injury could be compensated by a “small money payment,” and that the injunction would unduly oppress the defendant.¹¹⁴ Although the U.K. Supreme Court has more recently broadened a court’s discretion to deny a final injunction, it has reaffirmed that the “*prima facie* position is that an injunction should be granted, so the legal burden [*i.e.*, the burden of persuasion] is on the defendant to show why it should not.”¹¹⁵ This allocation of burdens applies in patent-infringement suits: “[An] injunction to restrain future infringements is

109. Rules of the Supreme Court, 1883, Order 36, Rule 58.

110. Chancery Amendment Act (Lord Cairns’ Act) 1858, 21 & 22 Vict. c. 27, § 2 (current version at Senior Courts Act 1981, c. 54, § 50); *see also* Gómez-Arostegui, *supra* note 78, at 1699–1701, 1706.

111. *Shelfer v. City of London Elec. Lighting Co.*, [1895] 1 Ch. 287, 315–16 (C.A. 1894) (nuisance) (Lindley, L.J.).

112. *Id.* at 316, 321, 322.

113. *Proctor v. Bayley*, 6 R.P.C. 538, 542 (C.A. 1889) (pat.); WILLIAM W. KERR, A TREATISE ON THE LAW AND PRACTICE OF INJUNCTIONS IN EQUITY 435 (London, 1867); WILLIAM JOYCE, THE DOCTRINES AND PRINCIPLES OF THE LAW OF INJUNCTIONS 150 (London, 1877); *see also* HINDMARCH, *supra* note 83, at 321, 354, 361.

114. *Shelfer*, 1 Ch. at 310–24; VALE NICOLAS, THE LAW AND PRACTICE RELATING TO LETTERS PATENT FOR INVENTIONS 203–04 (1904).

115. *Coventry v. Lawrence*, [2014] UKSC 13, ¶ 121 (Lord Neuberger) (nuisance); *accord Fisher v. Brooker*, [2009] UKHL 41, ¶¶ 16–19 (Lord Hope) (©).

the normal remedy [and] . . . the burden is on the defendant to give reasons why such an injunction should not be granted.”¹¹⁶

IV. MODERN IMPLICATIONS

So what can U.S. stakeholders make of this history? Most broadly, it could lead courts to presume that all four *eBay* factors favor patentees on final injunctions, until the defendant rebuts them. Doing so would take the Federal Circuit to the position it held just *before* its 2005 decision in *eBay*.¹¹⁷ Our focus, however, is on how the history affects the first two *eBay* factors alone: irreparable injury and the inadequacy of legal remedies. Adhering to traditional equitable principles would counsel the Federal Circuit to recognize that (1) future infringement itself is a cognizable injury, (2) legal remedies remain inadequate today because they continue to be limited retrospectively, and (3) courts can presume the existence of the first two *eBay* factors.

In the first two sections that follow, we discuss these steps and demonstrate that taking them does not clash with the Supreme Court’s decision in *eBay* or federal patent legislation. A third section examines a recently emerged requirement, post-*eBay*, that patentees must also demonstrate that alternative equitable remedies, in the form of ongoing royalties, would imperfectly redress future infringements. We discuss how neither Congress nor the Court has imposed such an obligation.

A. Cognizable Injury: Future Infringement

As we have already shown, the Court of Chancery did not engage in a separate “irreparable” injury analysis at the final-injunction stage. But it remains possible to situate traditional equitable principles within the first *eBay* factor by recognizing that future injury is the proper focus of injunctive relief (rather than past injury, as the *eBay* decision seems to require), and that future infringement *per se* is a cognizable future injury. Any “irreparability” analysis of the injury should be left to the second *eBay* factor, something lower courts are already doing.

To start, the Supreme Court in *eBay* did not overrule the principle that injunctions are typically designed to redress future wrongs, rather than past ones.¹¹⁸ It might appear that it did, given that the Court

116. *Evalve Inc. v. Edwards Lifesciences Ltd.*, [2020] EWHC 513, ¶ 73 (pat.); *accord* *Edwards Lifesciences LLC v. Bos. Sci. Scimed Inc.*, [2018] EWHC 1256, ¶ 13 (pat.); *HTC Corp. v. Nokia Corp.*, [2013] EWHC 3778, ¶ 8 (pat.).

117. *See supra* text accompanying note 13. The caveat being that it might clash with the Supreme Court’s decision in *Monsanto*. *See supra* note 23.

118. *United States v. Or. State Med. Soc’y*, 343 U.S. 326, 333 (1952) (“The sole function of an action for an injunction is to forestall future violations.”); *Swift & Co. v. United States*, 276 U.S. 311, 326 (1928) (“[A] suit for an injunction deals primarily, not with past violations, but with

instructed courts to focus on *past* irreparable injury (“has suffered”) rather than future injury.¹¹⁹ But the Federal Circuit has correctly treated that as an accidental slip—and one not meant as an exclusive limitation.¹²⁰ So has the Supreme Court. Four years after *eBay*, it realigned itself with traditional principles by subtly redirecting courts to focus on a plaintiff’s future injury on final injunctions.¹²¹ Nor did *eBay* reject the principle that a future violation or tort could constitute a cognizable injury *per se*—it only rejected using a statutory right to exclude as the *sole basis* for *granting* an injunction.¹²²

Furthermore, in cases decided well before (and left untouched by) *eBay*,¹²³ the Court recognized, also in accordance with the Court of Chancery, that preventing future trespasses and avoiding additional actions between the same parties were well-known bases for triggering equitable jurisdiction.¹²⁴ Harnessing this general principle in patent cases, the Court stated in 1908:

It hardly needs to be pointed out that the right [of a patent] can only retain its attribute of exclusiveness by a prevention of its violation If the conception of the law [is] that a judgment in an action at law is reparation for the trespass, it is only for the

threatened future ones”).

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

120. *E.g.*, *Endo Pharms. Inc. v. Teva Pharms. USA, Inc.*, 731 F. App’x 962, 975 (Fed. Cir. 2018); *Presidio Components, Inc. v. Am. Tech. Ceramics Corp.*, 875 F.3d 1369, 1383 (Fed. Cir. 2017); *Nichia Corp. v. Everlight Ams., Inc.*, 855 F.3d 1328, 1341–44 (Fed. Cir. 2017); *O2 Micro Int’l Ltd. v. Beyond Innovation Tech. Co.*, 449 F. App’x 923, 932 (Fed. Cir. 2011).

121. *Monsanto Co. v. Geertson Seed Farms*, 561 U.S. 139, 156, 162 (2010); *see also* Gergen et al., *supra* note 5, at 209–10 (critiquing use of past tense in *eBay*).

122. *eBay*, 547 U.S. at 392–93; *see also* 35 U.S.C. § 283 (injunctions “prevent the *violation* of any *right* secured by patent” (emphases added)).

123. *Accord Innovation in America: How Congress Can Make our Patent System STRONGER: Hearing on S. 2082 Before the Subcomm. on Intell. Prop. of the Comm. on the Judiciary*, 116th Cong. 22 (2019) (statement of Adam Mossoff, Professor, Antonin Scalia Law School, George Mason University), <http://ssrn.com/abstract=3457804>.

124. *E.g.*, *Rondeau v. Mosinee Paper Corp.*, 422 U.S. 49, 59 (1975); *United States v. W.T. Grant Co.*, 345 U.S. 629, 633 (1953); *Donovan v. Penn. Co.*, 199 U.S. 279, 304–05 (1905); *City of Walla Walla v. Walla Walla Water Co.*, 172 U.S. 1, 12 (1898); *Parker v. Winnipiseogee Lake Cotton & Woollen Co.*, 67 U.S. 545, 551 (1863); *Pennsylvania v. Wheeling & Belmont Bridge Co.*, 54 U.S. 518, 562–64 (1852); *accord* 1 POMEROY & SYMONS, *supra* note 33, §§ 252, 263, 267, 271 (discussing principle); DAN B. DOBBS & CAPRICE L. ROBERTS, *LAW OF REMEDIES* 93 (3d ed. 2018) (same); LAYCOCK, *supra* note 72, at 73–75 (same); Gergen et al., *supra* note 5, at 220–23, 235–37 (same).

particular trespass that is the ground of the action. There may be other trespasses and continuing wrongs and the vexation of many actions. These are well-recognized grounds of equity jurisdiction, especially in patent cases, and a citation of cases is unnecessary.¹²⁵

Because of its accidental focus on past injury alone, *eBay* said nothing about how probable a future injury must be for a court to retain its equitable jurisdiction to grant a final injunction. But the Court's earlier cases do, and they demonstrate that the standard, like that of the 18th century, is not demanding. In its only patent case to address the point directly, *Goshen Mfg. Co. v. Hubert A. Myers Mfg. Co.*, the Court ruled that future patent infringement need only be "reasonably apprehended."¹²⁶ It went on to note that the requisite proof for or against could be drawn from a defendant's alleged past infringement, whether a defendant retained the means for further infringement, and how strenuously a defendant contested the plaintiff's right or asserted its own rights.¹²⁷ A presumption of future infringement from adjudicated past infringement was neither sought nor discussed in *Goshen*, so the Court had no occasion to endorse or reject one. And, of course, *eBay* did not address so limited a presumption either.¹²⁸

125. *Cont'l Paper Bag Co. v. E. Paper Bag Co.*, 210 U.S. 405, 430 (1908); *accord Goshen Mfg. Co. v. Hubert A. Myers Mfg. Co.*, 242 U.S. 202, 207–08 (1916); *Clark v. Wooster*, 119 U.S. 322, 325–26 (1886); *Root v. Ry. Co.*, 105 U.S. 189, 216 (1882); BEIRNE STEDMAN, PATENTS § 250, at 606 (1939); 3 ANTHONY WILLIAM DELLER, WALKER ON PATENTS § 538, at 1817 (1937); GEORGE TUCKER BISPHAM & JOSEPH D. MCCOY, THE PRINCIPLES OF EQUITY 707–08 (10th ed. 1922); WILLIAM MACOMBER, THE FIXED LAW OF PATENTS 39–40 (2d ed. 1913); 3 WILLIAM C. ROBINSON, THE LAW OF PATENTS FOR USEFUL INVENTIONS § 932, at 112, § 1088, at 400–01, § 1094, at 414 (Boston, 1890); 2 STORY, *supra* note 33, §§ 930–931, at 262–63; *see also* Gómez-Arostegui, *supra* note 78, at 1730 (discussing principle).

Relatedly, the Supreme Court has not overruled its long-standing authority, following 18th-century principles, that "in order to exclude a concurrent remedy [in] equity," the legal remedy "must be as complete, as practical and as efficient to the ends of justice and its prompt administration, as the remedy in equity." *Walla Walla*, 172 U.S. at 12; *accord Twp. of Hillsborough v. Cromwell*, 326 U.S. 620, 629 (1946); *Terrace v. Thompson*, 263 U.S. 197, 214 (1923); *Boise Artesian Hot & Cold Water Co. v. Boise City*, 213 U.S. 276, 281 (1909); *Davis v. Wakelee*, 156 U.S. 680, 688 (1895); *Parker*, 67 U.S. at 551. For an 18th-century statement of this principle, *see supra* note 87.

126. *Goshen*, 242 U.S. at 208 (defendant claimed it had ceased to infringe).

127. *Id.* at 207.

128. *See supra* text accompanying note 22.

The Court later elaborated on the equitable trigger in an antitrust case:

The necessary determination is that there exists some cognizable danger of recurrent violation, something more than mere possibility which serves to keep the case alive. . . . To be considered are the bona fides of the expressed intent to comply [with the law], the effectiveness of the discontinuance[,] and, in some cases, the character of the past violations.¹²⁹

Even if the Court in *eBay* had wanted to discard the substantive principles of the Court of Chancery—and the Court’s own decisions employing them—it would have been hard pressed to do so given that Congress has never disturbed those principles in the many patent laws it has enacted over the years. Every mention of equitable jurisdiction in patent legislation, from the first explicit recognition in 1819 through to the 1952 Patent Act, simply adheres to the “course” and “principles” of courts of equity.¹³⁰ Totally absent from the legislation is the “unequivocal statement” the Court seeks from Congress when the latter wishes to depart from a principle of “equity practice with a background of several hundred years of history.”¹³¹

B. Legal Relief: Retrospectively Limited and Inadequate

Our next point is that the remedy available “at law” in federal courts today, though now embodied in 35 U.S.C. § 284, appears to suffer from the same impediment as in England. Initially, that is because the English rule barring damages at common law for post-writ wrongs carried over to the courts of the United States, subject now to Federal Rule of Civil Procedure 15, which allows recovery for actionable wrongs occurring between the filing of the complaint and the time of

129. *W.T. Grant*, 345 U.S. at 633; *accord* *Kansas v. Nebraska*, 574 U.S. 445, 466 (2015); *Rondeau*, 422 U.S. at 59; *see also* *United States v. Or. State Med. Soc’y*, 343 U.S. 326, 333 (1952) (“All it takes . . . is a real threat of future violation or a contemporary violation of a nature likely to continue or recur.”). Although the language quoted above sounds eerily familiar to a mootness analysis, the Court views mootness as a separate inquiry. *E.g.*, *W.T. Grant*, 345 U.S. at 632–33. Like *Goshen*, these cases also did not address whether courts could presume future violations from past ones.

130. *See* Act of Feb. 15, 1819, ch. 19, 3 Stat. 481, 481–82; Act of July 4, 1836, ch. 357, § 17, 5 Stat. 117, 124; Act of July 8, 1870, ch. 230, § 55, 16 Stat. 198, 206; Act of Mar. 3, 1897, ch. 391, § 6, 29 Stat. 692, 694; Act of Feb. 18, 1922, ch. 58, § 8, 42 Stat. 389, 392; Act of Aug. 1, 1946, ch. 726, 60 Stat. 778, 778; Act of July 19, 1952, ch. 950, § 283, 66 Stat. 792, 812.

131. *Hecht Co. v. Bowles*, 321 U.S. 321, 329 (1944); *accord* *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 391–92 (2006); *Holmberg v. Armbrrecht*, 327 U.S. 392, 395 (1946); *see also supra* text accompanying notes 30–33.

trial.¹³² The Supreme Court, for instance, used the common-law rule to affirm jury instructions in a pair of patent and antitrust cases that only allowed recovery for wrongs occurring before the action was filed.¹³³ And in another patent case, the Court stated that, in an action at law, one “could only recover damages for past infringements.”¹³⁴ Practitioners similarly understood that the legal remedy was “limited . . . to the recovery of damages for past infringements.”¹³⁵

In 1984, the Federal Circuit implicitly acknowledged the common-law rule. It stated that the “general rule [is] that only those acts committed before the complaint is filed may be considered at trial,” while recognizing that a patentee could file supplemental complaints under Rule 15(d) to capture actionable wrongs through trial.¹³⁶ And more recently, the court stated, when reviewing a jury verdict, that the word “‘damages,’ . . . by definition[,] covers only past” wrongs, and thus a jury instructed to award a reasonable royalty as “damages” would not ordinarily think of future wrongs.¹³⁷

Despite the foregoing, the Federal Circuit has (as we explain below) allowed juries to award legal damages in a lump sum for future infringements in certain circumstances. That might lead one to conclude that because damages for future wrongs are now available at law, the

132. Gómez-Arostegui, *supra* note 78, at 1682–84, 1691, 1708–12; FED. R. CIV. P. 15(d) (allowing supplemental complaints).

133. *Suffolk Co. v. Hayden*, 70 U.S. (3 Wall.) 315, 320 (1866), *aff'g* 11 F. Cas. 900, 907 (C.D. Mass. 1862) (No. 6,261); *Lawlor v. Loewe*, 235 U.S. 522, 536 (1915), *aff'g* 209 F. 721, 729 (2d Cir. 1913); *see also* *Wicker v. Hoppock*, 73 U.S. 94, 99 (1867) (contract); *Bradley v. Washington, Alexandria & Georgetown Steam Packet Co.*, 34 U.S. (9 Pet.) 107, 116 (1835) (*assumpsit*).

134. *Excelsior Wooden Pipe Co. v. Pac. Bridge Co.*, 185 U.S. 282, 290 (1902); *accord* *Cont'l Paper Bag Co. v. E. Paper Bag Co.*, 210 U.S. 405, 430 (1908); *Birdsall v. Coolidge*, 93 U.S. 64, 64 (1876).

135. 1 JAMES LOVE HOPKINS, *THE LAW OF PATENTS* § 375, at 503 (1911); *accord* STEDMAN, *supra* note 125, § 232, at 557; 3 DELLER, *supra* note 125, § 538, at 1816–17, 1959; ALBERT H. WALKER, JOHN H. HILLIARD & EUGENE EBLÉ, *TEXT-BOOK OF THE LAW PATENTS FOR INVENTIONS* § 572, at 636 (5th ed. 1917); 3 ROBINSON, *supra* note 125, § 932, at 112, § 1053, at 321; *cf.* EATON S. DRONE, *A TREATISE ON THE LAW OF PROPERTY IN INTELLECTUAL PRODUCTIONS* 496–97 (Boston, 1879) (noting in the context of copyrights that the “remedies afforded by law are available only when the wrong has been done”).

136. *Rosemount, Inc. v. Beckman Instr., Inc.*, 727 F.2d 1540, 1550 (Fed. Cir. 1984); *cf.* *De Graffenried v. United States*, 228 Ct. Cl. 780, 784 (1981) (“[R]elief for future [patent] infringements is beyond the power of th[is] court by declaratory judgment or otherwise.”).

137. *WhitServe, LLC v. Comput. Pkgs., Inc.*, 694 F.3d 10, 35 (Fed. Cir. 2012) (concluding that a jury had not awarded a paid-in-full, lump-sum license).

prospect of additional actions is a thing of the past, and the remedy at law is no longer inadequate.

We would respond by first noting that when it has allowed legal damages for infringements that have yet to occur, the Federal Circuit has done so without considering that section 284 does not expressly empower courts to award such relief. When a statute is silent on a matter, courts must presume that Congress adopted established “adjudicatory principles,”¹³⁸ like the aforesaid common-law bar, and other “prominent feature[s] of the relevant [decisional] landscape”¹³⁹ before enactment. The Federal Circuit has yet to review either closely, nor has it considered the relevant legislative history indicating that section 284 compensates patentees for past, not future, infringements.¹⁴⁰ In short, there is a substantial question whether the Federal Circuit has always acted with statutory or common-law authority.

Second, even if authorized, the court’s use of legal damages for future infringements has been limited, and it therefore remains unavailable in many cases. The Federal Circuit has never, to our knowledge, held that a patentee can recover “lost profit” damages under section 284 for infringements expected to occur after judgment.¹⁴¹ Rather, nearly every instance approved thus far by that court has involved a jury awarding, as a “reasonable royalty,” a paid-up, lump-sum license for all infringements past and future.¹⁴² Moreover, when

138. *Astoria Fed. Sav. & Loan Ass’n v. Solimino*, 501 U.S. 104, 108 (1991).

139. *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S. Ct. 954, 963, 966 (2017); *accord Stokeling v. United States*, 139 S. Ct. 544, 551 (2019).

140. Section 284 of the 1952 Patent Act “merely ‘reorganiz[ed] in language’” predecessor provisions enacted in 1946. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 377 U.S. 476, 505 n.20 (1964) (quoting H.R. REP. NO. 82-1923, at 10, 29 (1952)). The 1946 legislative history notes that the purpose of its damages provision—which called for “general damages which shall be due compensation[.] . . . not less than a reasonable royalty,” 35 U.S.C. § 70 (1946)—was to remedy “past infringement,” while injunctions prevented future infringement. *Recovery in Patent Infringement Suits: Hearing Before the Comm. on Patents on H.R. 5231*, 79th Cong., 2d Sess., at 7 (1946) (statement of Conder C. Henry, Ass’t Comm’r of Patents); *accord* S. REP. NO. 79-1503, at 2 (1946); H.R. REP. NO. 79-1587, at 1 (1946). For a discussion of the limited scope and application of reasonable-royalty awards before 1952, see Michael Risch, *(Un)reasonable Royalties*, 98 B.U. L. REV. 187 (2018); LEON H. AMDUR, PATENT LAW AND PRACTICE § 6, at 993, §§ 13–14, at 1003–10 (1935).

141. *Cf. Gómez-Arostegui*, *supra* note 78, at 1683 n.112, 1709–10 (contrasting future damages caused *solely* by *past* infringements).

142. *E.g.*, *Prism Techs., LLC v. Sprint Spectrum L.P.*, 849 F.3d 1360, 1377–78 (Fed. Cir. 2017); *Summit 6, LLC v. Samsung Elecs.*, 802 F.3d 1283, 1300–01 (Fed. Cir. 2015). *But see* *Interactive Pictures Corp. v. Infinite Pictures Corp.*, 274 F.3d 1371, 1384 (Fed. Cir. 2001) (5-year license).

contested, the Federal Circuit has only allowed this form of relief when the proof supports it. Evidence must demonstrate that a hypothetical negotiation between the parties, entered into before infringement began, would have resulted in a lump-sum, paid-in-full license.¹⁴³ For many patented inventions this will not be the case. Alternatively and more theoretically, a suit might involve an already “established royalty”¹⁴⁴ in the form of an upfront license fee sought by the patentee for the future exercise of a patent, by which is generally meant a licensing scheme open to all comers.¹⁴⁵ If neither a hypothetical reasonable royalty nor an already established royalty would cover all infringements for the life of the patent, paid in a lump sum, then a jury will often award a lump-sum amount that covers pre-judgment infringements only.

Importantly, if a patentee obtains a lump-sum award at trial for all infringements, past and future, then a final injunction is unnecessary, and barring confusion over a verdict or a concern the defendant will not pay the award, the patentee will not seek a final injunction.¹⁴⁶

143. *Enplas Tech Sols., Inc. v. Seoul Semiconductor Co.*, 909 F.3d 398, 409–12 (Fed. Cir. 2018); *Laserdynamics, Inc. v. Quanta Comput., Inc.*, 694 F.3d 51, 79–80 (Fed. Cir. 2012); *Wordtech Sys., Inc. v. Integrated Networks Sols., Inc.*, 609 F.3d 1308, 1319–21 (Fed. Cir. 2010); *Lucent Techs., Inc. v. Gateway, Inc.*, 580 F.3d 1301, 1324–36 (Fed. Cir. 2009).

144. *Dowagiac Mfg. Co. v. Minn. Moline Plow Co.*, 235 U.S. 641, 648–49 (1915); *Rude v. Wescott*, 130 U.S. 152, 165 (1889).

145. WILLIAM C. ROOKLIDGE ET AL., *COMPENSATORY DAMAGES ISSUES IN PATENT INFRINGEMENT CASES* 8–12 (2d ed. 2017) (Fed. Jud. Ctr.); STEDMAN, *supra* note 125, § 232, at 555–56; 3 ROBINSON, *supra* note 125, § 1055, at 324–29; *e.g.*, *Emerson v. Simm*, 8 F. Cas. 640, 641–42 (C.C.D.N.J. 1873) (No. 4,443) (limited to future *use*); *Sickels v. Borden*, 22 F. Cas. 67, 70–71 (C.C.S.D.N.Y. 1856) (No. 12,832) (same). An established royalty is less likely to result in a full course of litigation, and we are unaware of the Federal Circuit having ever approved one that comprehensively covered past and future infringements in a lump sum.

146. Ambiguous verdicts are not uncommon and might lead patentees to believe that the jury did not compensate them for future infringements. *E.g.*, *Prism*, 849 F.3d at 1377–78. Additionally, a lump-sum award only eliminates future infringements once the defendant has paid it. To avoid the prospect of future infringement as a trigger of equitable jurisdiction, and the additional argument that the legal remedy is inadequate due to an inability to pay it, a defendant could be required, in forestalling a final injunction, to post security sufficient to cover the entire lump-sum award. *See* 3 ROBINSON, *supra* note 125, § 1088, at 400–01; *cf.* *Amstar Corp. v. Envirotech Corp.*, 823 F.2d 1538, 1548–49 (Fed. Cir. 1987) (utilizing exhaustion doctrine *sub silentio* to refuse to enjoin a purchaser and *user* of seven infringing devices because the patentee had obtained a damages award on the sale of those devices against a co-defendant who manufactured them, and the parent company of the manufacturer guaranteed to pay the award). A district court could also grant the final injunction, and actually enjoin the defendant, but permit the defendant to buy it out

Largely, then, it is plaintiffs who do *not* receive prospective compensation at trial that will seek an injunction. For them, post-judgment infringements are still not compensable at law, and therefore the legal remedy is just as inadequate today as it was in 1789. Stated another way, federal courts today have equitable jurisdiction over every request for final injunctive relief where the legal damages awarded at trial do not fully compensate the plaintiff for the life of the patent, and where future infringements remain likely.

* * *

With the historical record and prior two sections in mind, the modern implications should crystallize. In cases where a patentee seeks a final injunction, federal courts today can presume, in accordance with traditional equitable principles, and much like the Federal Circuit did before 2011, that a patentee is likely to suffer injury in the absence of a final injunction, and that the “remedies available at law . . . are inadequate to compensate”¹⁴⁷ the patentee for that injury. Future infringement itself is a cognizable injury, and federal courts can presume from a defendant’s past infringement that future infringements are likely and that the legal remedy is inadequate. The more debatable question is what courts should require a defendant to present to overcome the presumptions. Some of the details of that inquiry—such as whether the defendant has a burden of persuasion or production—are beyond the scope of this Article. But we will note that insofar as the presumptions are substantive (and not procedural)¹⁴⁸ that might indicate that a defendant bears a burden of persuasion, rather than a burden of production. Regardless of the obligation, two main rebuttals appear available. A defendant can demonstrate to the court’s satisfaction that it is unlikely to infringe again. Or it might demonstrate that a lump-sum trial award fully compensated the patentee for all future infringements, and that it has the ability to satisfy the entire judgment.

Additionally, and without relying on any presumptions, patentees could simply bear the full burden of proof themselves. Patentees need only show that in the absence of a final injunction future infringement is more likely than not and that any lump-sum award at trial did not fully compensate them for the life of the patent. A defendant might even concede the points.

Strictly speaking, a defendant’s undue hardship and the public interest do not affect the likelihood of future infringement or render the remedy at law adequate. Those are separate considerations, and we take

just as soon as the defendant is able to satisfy the lump-sum award. Satisfaction would obviate the need for ongoing equitable jurisdiction.

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

148. Some authorities conflict. *Compare* sources cited *supra* note 36, *with* FED. R. EVID. 301.

no position whether, given the historical record, they could or should continue to play a role on requests for final injunctions. We suggest only that, insofar as they are relevant, these two factors are the natural place to consider whether an injunction would unfairly burden defendants (perhaps where a plaintiff's invention forms a very small, but inextricable, part of a defendant's product) or unduly harm the public.

C. Alternative Equitable Relief: Ongoing Royalties

One last matter requires our attention. In an effort to avoid the prospect of future lawsuits between the same parties, the Federal Circuit approved a new form of prospective equitable relief in 2007: an ongoing royalty in lieu of a final injunction. The court endorsed the remedy after *eBay* in *Paice LLC v. Toyota Motor Corp.*, while acknowledging that no statute provided for ongoing royalties in patent cases and that royalties would not “prevent the violation of any right secured by patent,” something 35 U.S.C. § 283 requires.¹⁴⁹ Notably, the infringer in *Paice*, Toyota, had not argued that section 283 (or 284) authorized this type of relief; instead, Toyota relied on a federal court's inherent and “traditional equitable powers.”¹⁵⁰ This alternative form of relief has been profoundly important because it is a major reason federal courts have felt comfortable denying injunctive relief to patentees who have prevailed at trial.¹⁵¹ And by *selectively* treating this form of monetary relief as a remedy *at law*, courts have expressly required patentees to prove that an ongoing royalty would provide inadequate redress.¹⁵²

149. *Paice LLC v. Toyota Motor Corp.*, 504 F.3d 1293, 1314 (Fed. Cir. 2007) (quoting 35 U.S.C. § 283, which authorizes “injunctions”); *cf.* *AMG Cap. Mgmt. v. FTC*, 141 S. Ct. 1341, 1347 (2021) (stating that authorizing injunctive relief in a statute “is not the same as [authorizing] an award of equitable monetary relief”); *United States v. Oakland Cannabis Buyers' Coop.*, 532 U.S. 483, 497 (2001) (“[A] court sitting in equity cannot ‘ignore the judgment of Congress, deliberately expressed in legislation.’” (quoting *Virginian R. Co. v. Ry. Emps.*, 300 U.S. 515, 551 (1937))); *INS v. Pangilinan*, 486 U.S. 875, 883 (1988) (same); *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 203 (1985) (same).

150. Reply Brief for Defendants-Appellants at 52–55, *Paice*, 504 F.3d 1293 (Nos. 2006-1610, -1631). Although the Federal Circuit recently declared that *Paice* found this authority in section 283, *see Prism*, 849 F.3d at 1377, that misstates *Paice*.

151. *See generally* Christopher B. Seaman, *Permanent Injunctions in Patent Litigation After eBay: An Empirical Study*, 101 IOWA L. REV. 1949 (2016); Christopher B. Seaman, *Ongoing Royalties in Patent Cases After eBay: An Empirical Assessment and Proposed Framework*, 23 TEX. INTEL. PROP. L.J. 203 (2015).

152. *E.g.*, *ActiveVideo Networks, Inc. v. Verizon Comms. Inc.*, 694 F.3d 1312, 1340 (Fed. Cir. 2012); *Solutran, Inc. v. U.S. Bancorp*, No. 13-CV-02637, 2019 WL 405513, at *26 (D. Minn. Jan. 18, 2019); *EcoServices, LLC v. Certified Aviation Servs., LLC*, 340 F. Supp. 3d 1004, 1023–28 (C.D. Cal.

There are two problems here. Most fundamentally, *Paice* was wrongly decided. As one of us has argued elsewhere at length, federal courts lack the authority to award ongoing royalties for post-judgment infringements. Apart from the absence of statutory authorization, the English Court of Chancery did not recognize a remedy like this in 1789, which is the time and place the Supreme Court looks to for the default, equitable remedies of the federal courts.¹⁵³ Second, because ongoing royalties are an equitable remedy,¹⁵⁴ they actually do nothing to impede the conclusion, reached a few paragraphs ago, that patentees have no adequate remedy at law. Indeed, that conclusion must stand in order to trigger the equitable jurisdiction necessary to award an ongoing royalty in lieu of a final injunction. A federal court cannot redress an injury with *any* equitable remedy when the court has concluded the plaintiff has a suitable remedy at law for it.¹⁵⁵ There is the Seventh Amendment to consider: a party should not be forced to face an equitable remedy assessed by a judge when an adequate remedy, and a right to a jury trial, would be available at law.¹⁵⁶ The Federal Circuit seems to have lost sight of the above, along with the nature of the remedy itself, when it recently and inconsistently stated that ongoing royalties are an “adequate remedy at law,”¹⁵⁷ despite ruling several times previously that the remedy was equitable and thus not subject to a constitutional right to a jury trial.¹⁵⁸

2018); *Schwendimann v. Arkwright Advanced Coating, Inc.*, No. 11-820, 2018 WL 3621206, at *24–25 (D. Minn. July 30, 2018).

153. *Gómez-Arostegui*, *supra* note 78, at 1682–1728; *see also* *Trump v. Hawaii*, 138 S. Ct. 2392, 2425 (2018) (Thomas, J., concurring) (“This Court has never treated general statutory grants of equitable authority as giving federal courts a freewheeling power to fashion new forms of equitable remedies. Rather, it has read such statutes as constrained by ‘the body of law which had been transplanted to this country from the English Court of Chancery’ in 1789.” (quoting *Guar. Tr. Co. v. York*, 326 U.S. 99, 105 (1945))).
154. *Prism*, 849 F.3d at 1378; *Paice*, 504 F.3d at 1313–16 & n.13. Further supporting this characterization is that all money judgments at law must be for a specific amount, and periodic or contingent awards are not permitted. *Slater v. Mexican Nat’l R.R. Co.*, 194 U.S. 120, 128 (1904); *DOBBS & ROBERTS*, *supra* note 124, at 220, 265.
155. *Franklin v. Gwinnett Cty. Pub. Schs.*, 503 U.S. 60, 75–76 (1992); *Dairy Queen, Inc. v. Wood*, 369 U.S. 469, 478 (1962).
156. *Gómez-Arostegui*, *supra* note 78, at 1728–30; *see also supra* text accompanying note 21.
157. *ActiveVideo*, 694 F.3d at 1340; *see also* *TD Bank N.A. v. Hill*, 928 F.3d 259, 282–83 (3d Cir. 2019) (making the same mistake in a copyright case).
158. *See supra* note 154; *see also* *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 807 F.3d 1311, 1331–33 (Fed. Cir. 2015).

At some point, the Supreme Court should clarify two things. The first is whether a plaintiff *must* demonstrate, before obtaining a final injunction, that no other equitable remedy would suffice to redress a defendant's future actionable wrongs. Perhaps that is what the Court had in mind when it included "irreparable" injury as the first *eBay* factor; but if so, it did so obliquely.¹⁵⁹ A remedial hierarchy preferring legal over equitable relief is understandable in light of constitutional jury-trial concerns and the coercive power of equitable decrees. It is also well supported by traditional equitable principles. But it is doctrinally unclear why a federal court must subjugate one form of final equitable relief (an injunction) to another (ongoing royalties), especially when English equity practice contained no support for that proposition, and the latter remedy was only recently *judicially* adopted for all patent cases in 2007. Contrary to the Court's appeal to "traditional" and "well-established" equitable principles in *eBay*, awards of ongoing royalties can hardly be said to be a traditional equitable option.

Lastly, the Court must squarely address whether federal courts actually have the power to impose an ongoing royalty in lieu of a final injunction in patent cases. The point has yet to be directly contested at the Court, and it has sent conflicting messages, all without the benefit of any historical evidence. On the one hand, it has stated in *dictum* in a copyright case that an ongoing royalty may be available in some circumstances.¹⁶⁰ But in *eBay*, four justices, also in *dictum*, spoke only of "legal damages" as a possible substitute for a patent injunction.¹⁶¹ Given the Court's obvious understanding of the difference between *legal* damages and *equitable* monetary relief,¹⁶² it seems likely that these justices were not thinking, at the time, of alternative equitable relief. In any case, the Court must reconcile two facts: that Congress has never authorized ongoing royalties in patent cases, and that the Court has ruled that Congress must act if it wishes courts to employ a *novel* equitable remedy—one not recognized by the 18th-century Chancery.

159. *See also* *Monsanto Co. v. Geertson Seed Farms*, 561 U.S. 139, 165–66 (2010) (stating that a final injunction should not be granted if a "less drastic" remedy is available). *But see* *Younger v. Harris*, 401 U.S. 37, 43–44 (1971) (appearing to equate irreparable injury with the inadequate-remedy-at-law requirement); *Amoco Prod. Co. v. Vill. of Gambell*, 480 U.S. 531, 545 (1987) (same); *Pennsylvania v. Wheeling & Belmont Bridge Co.*, 54 U.S. 518, 561, 564 (1852) (same).

160. *Petrella v. Metro-Goldwyn-Mayer, Inc.*, 572 U.S. 663, 687–88 (2014) (drawing from a suggestion made by the government).

161. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388, 396–97 (2006) (Kennedy, J., joined by Stevens, Souter, and Breyer, JJ., concurring).

162. *E.g.*, *SCA Hygiene Prods. Aktiebolag v. First Quality Baby Prods., LLC*, 137 S. Ct. 954, 964, 966, 969–70 (2017); *Mertens v. Hewitt Assocs.*, 508 U.S. 248, 253–58 (1993); *Lorillard v. Pons*, 434 U.S. 575, 583 (1978).

CONCLUSION

Two important points emerge from the preceding discussion.

First, we offer clear grounds for the Federal Circuit to overrule its 2011 decision in *Bosch* where it abandoned its separate presumptions concerning irreparable injury and the lack of an adequate remedy at law. The Supreme Court never ruled on those presumptions in *eBay*, and the Federal Circuit renounced them without the benefit of briefing or considering the historical record. Traditional equitable principles, originating from a period the Court has indicated is the most crucial, demonstrate that federal courts can recognize future infringement *per se* as a cognizable injury, presume future infringement, and presume the inadequacy of legal damages. Alternatively, courts can simply recognize, without relying on any presumptions, that the burden on the first two *eBay* factors is not onerous. A patentee can satisfy them by showing that a defendant is likely to infringe again without a final injunction and that any legal damages awarded at trial did not fully compensate the patentee for the life of the patent. The same historical record demonstrates that in order to obtain a final injunction patentees do not have to prove that some other form of equitable relief, like ongoing royalties, would be inadequate to redress future infringements.

Second, and similarly, we demonstrate that if Congress chooses to reinstate the separate presumptions—as some stakeholders have asked it to do—it can do so with the knowledge that it would be comporting with *eBay* and traditional equitable principles rather than overruling them.