No. _____

IN THE

Supreme Court of the United States

ATM SHAFIQUL KHALID
Petitioner,
v.
CITRIX SYSTEMS, INC.
Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Ninth Circuit

APPENDIX

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July 20, 2023

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Appendix A - Order Regarding Petitioner's appeal to the Court of Appels for the Ninth Circuit, Filed March 14, 2023

NOT FOR PUBLICATION

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

ATM SHAFIQUL KHALID, Esquire, an individual and on behalf of similarly situated,
Plaintiff-Appellant,

v.

CITRIX SYSTEMS, INC., John Doe n,
Defendant-Appellee.

No. 21-35376
D.C. No. 2:20-cv-00711-RAJ
MEMORANDUM*

Appeal from the United States District Court
for the Western District of Washington
Richard A. Jones, District Judge, Presiding

Submitted March 10, 2023[1]
San Francisco, California

[1] The panel unanimously concludes this case is suitable for decision without oral argument. See Fed. R. App. P. 34(a)(2).

Appendix A - Order Regarding Petitioner's appeal to the Court of Appels for the Ninth Circuit, Filed March 14, 2023

Before: HAWKINS, S.R. THOMAS, and McKEOWN, Circuit Judges.

ATM Shafiqul Khalid appeals pro se the district court's dismissal of his action against Citrix Systems, Inc. We have jurisdiction under 28 U.S.C. § 1291. We review de novo the district court's dismissal for failure to state a claim under Federal Rule of Civil Procedure 12(b)(6). Curry v. Yelp, Inc., 875 F.3d 1219, 1224 (9th Cir. 2017). We affirm the district court's judgment.

The district court properly dismissed Counts 2, 5, 9, and 10 as barred by res judicata under Washington law in light of Khalid's prior state court suit against Citrix. See Hardwick v. County of Orange, 980 F.3d 733, 740 (9th Cir. 2020) (federal court looks to state preclusion law); Afoa v. Port of Seattle, 421 P.3d 903, 914 (Wash. 2018) (requirements for res judicata).

The district court correctly concluded that Khalid failed to state a claim of price discrimination or exclusive dealing under the Clayton Act premised on Citrix's alleged wrongful claim to ownership of Khalid's patents. See Aerotec Int'l, Inc. v. Honeywell Int'l, Inc., 836 F.3d 1171, 1187 (9th Cir. 2016) (price discrimination); Allied Orthopedic Appliances, Inc. v. Tyco Health Care Grp. LP, 592 F.3d 991, 996 (9th Cir. 2010) (exclusive dealing).

The district court correctly concluded that Khalid failed to state a claim for attempted monopolization under Sherman Act § 2. See Optronic

Techs., Inc. v. Ningbo Sunny Elec. Co., 20 F.4th 466, 481–82 (9th Cir. 2021) (elements of claim); see also Ill. Tool Works, Inc. v. Indep. Ink, Inc., 547 U.S. 28, 41–43 & n.4 (2006)(market power is not presumed from the mere fact that one holds a patent).

The district court correctly concluded that Khalid failed to state a forced labor claim under the Trafficking Victims Protection Act because he did not plausibly allege Citrix attempted to coerce him into providing labor. See 18 U.S.C. § 1589.

The district court correctly concluded that Khalid's civil rights claims are barred by the three-year statute of limitations. See Boston v. Kitsap County, 852 F.3d 1182, 1185 (9th Cir. 2017) (three-year statute of limitations for § 1983 claims in Washington); McDougal v. County of Imperial, 942 F.2d 668, 673–74 (9th Cir. 1991) (statute of limitations for § 1985(3) claims is the same as for § 1983 claims).

Citrix's request for sanctions under Federal Rule of Appellate Procedure 38 is denied.

AFFIRMED.

Appendix B - Order Regarding Petitioner's Complaint in the Dist. Court, WD Washington, Filed April 14, 2021

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF WASHINGTON
AT SEATTLE

ATM SHAFIQUL KHALID, an individual
and on behalf of similarly situated,
XENCARE SOFTWARE, INC.,
Plaintiff,

v.

CITRIX SYSTEMS, INC., a Delaware corporation,
AKA John Doe n. ,
Defendants.

CASE NO 2:20-CV-00711-RAJ

ORDER GRANTING
DEFENDANT CITRIX MOTION TO
DISMISS

This matter comes before the Court on Defendant Citrix Systems, Inc.'s ("Defendant") Motion to Dismiss. Dkt. # 10. Having considered the parties' briefing, the record, and the applicable law, the Court finds that oral argument is unnecessary. For the reasons below, the motion is GRANTED.

Appendix B - Order Regarding Petitioner's Complaint in the Dist. Court, WD Washington, Filed April 14, 2021

I. BACKGROUND

Plaintiff ATM Shafiqul Khalid[2] ("Plaintiff" or "Khalid") is an engineer who had been employed by Defendant Citrix Systems, Inc. ("Defendant" or "Citrix") for approximately five years beginning on September 18, 2006. Dkt. # 8 ¶ 13.[3] On the day of his hire, Khalid signed an employment agreement that included a patent assignment clause ("Invention Assignment Clause"). Dkt. # 8 ¶ 14; Dkt. # 16 at 4. During his employment with Citrix, Khalid filed two patent applications that resulted in US Patent No. 8,286,219 ("'219 patent") and US Patent No. 8,782,637 ("'637 patent"). Dkt. # 8 ¶ 16.

On October 3, 2011, Citrix terminated Khalid. Id. ¶ 16. On October 25, 2011, Citrix counsel claimed ownership of all patent applications filed by Khalid "which may be used in relation" with "products . . . sold by Citrix." Id. ¶ 18. On October 26, 2011, Khalid asked Citrix to reinterpret the employment agreement to align with what he alleged to be

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[2] Khalid brings this action on behalf of himself and his company, Xencare Software, Inc. Both are named as plaintiffs. Although Khalid may represent himself, he cannot represent his company before this Court pursuant to Local Rule 83.2(b)(4) of the Western District of Washington, which requires that "[a] business entity, except a sole proprietorship, must be represented by counsel." As Khalid asserts his claims as the sole plaintiff throughout his amended complaint, the Court will address him as the sole plaintiff here.

[3] In considering a motion to dismiss, the Court assumes the truth of the factual allegations set forth in the amended complaint, Dkt. # 8. See Sanders v. Brown, 504 F.3d 903, 910 (9th Cir. 2007).

violations of RCW 49.44.140. Id. ¶ 19. Citrix declined to do so and maintained that it possessed ownership rights to the patent applications filed by Khalid. Id. ¶¶ 20-21.

On October 2, 2015, Khalid sued Citrix in King County Superior Court "to clear patent ownership issue of '219 and '637 patent along with damage." Id. ¶ 22. He alleged violations of Washington's Consumer Protection Act ("CPA"), breach of employee contract, wrongful termination in retaliation, breach of the duty of good faith and fair dealing, and tortious interference, and sought declaratory judgment that the Invention Assignment Clause was unenforceable under RCW 49.44.140 and that Citrix had no ownership rights to the '219 or '637 patents. Dkt. # 11-4 at 23-26; Khalid v. Citrix Sys., Inc., 15 Wash. App. 2d 1043 at *8.[4]

On May 5, 2016, Citrix attempted to remove the case to federal district court based on diversity and filed several counterclaims, including breach of contract, unjust enrichment, and infringement of Citrix's "Xen" trademark in violation of the Lanham Act. Khalid v. Citrix Systems, No. C16-0650 JCC, 2016 WL 9412678 (W.D. Wash. May 5, 2016) (Dkt. # 1). A month later, Khalid filed a motion to remand the case back to state court. Id. (Dkt. # 19). On July 21, 2016, the Honorable John C. Coughenour remanded

[4] A court may "'take judicial notice of matters of public record outside the pleadings' and consider them for purposes of the motion to dismiss." Mir v. Little Co. of Mary Hosp., 844 F.2d 646, 649 (9th Cir. 1988).

the case after concluding that removal was untimely. Khalid v. Citrix Sys. Inc., No. C16-0650 JCC, 2016 WL 9412678, at *1 (W.D. Wash. July 21, 2016). Three weeks later, on May 27, 2016, Microsoft sent a letter to Khalid ("M&G letter") claiming that Microsoft had rights to patents '219 and '637 based on its vendor agreement with Citrix. Dkt. # 8 ¶ 24.

After remand to state court, Khalid moved for partial summary judgment claiming, among other things, that the Invention Assignment Clause was unenforceable because it violated RCW 49.44.140 and that Citrix's actions constituted unfair or deceptive acts under RCW 19.86.020 and an unlawful restraint of trade under RCW 19.86.030. Khalid v. Citrix Sys., Inc., 15 Wash. App. 2d 1043 at *8. Citrix filed a cross motion for summary judgment seeking dismissal of all of Khalid's claims and for summary judgment on its infringement claim against Khalid's use of "Xen." Id.

In 2018, the trial court granted in part Khalid's motion for summary judgment with respect to his CPA claim under RCW 19.86.020 finding that his employment agreement with Citrix violated RCW 49.44.140. Id. at *9. The court concluded that the remedy for the violation, however, was "to strike the offending language and amend the language to conform to the requirements of the statute." Id. The trial court denied the remaining claims, including the ownership of the patents at issue. Id. Finally, the court concluded that Khalid had infringed Citrix's trademarks based on his use of Citrix's "Xen" trademarks for his startup businesses but otherwise

denied Citrix's motion for summary judgment. Id. Citrix filed a motion for summary judgment on Khalid's restraint of trade claim alleging that Khalid had no evidence that Citrix had conspired with any other entity to restrict competition. Id. The trial court granted the motion and dismissed Khalid's claim under RCW 19.86.030. Id. Khalid's remaining claims for the jury included the following: (1) alleged breach of the Employment and Severance Agreements; (2) alleged breach of the covenant of good faith and fair dealing related to these two agreements; CPA violation; and (4) tortious interference with Khalid's business expectancies. Id.

In 2018, a jury found that Citrix had breached Khalid's employment agreement and severance agreement and awarded Khalid over $3 million in damages. Id. The trial court concluded that "Citrix has no ownership or other rights to or arising under US Patent No. 8,286,219 and 8,782,637," and entered a declaratory judgment in Khalid's favor with respect to patent ownership. Id. In post-trial motions, Khalid was awarded $2.6 million in attorney fees and costs, and Citrix was awarded $117,816 in legal fees and costs for prevailing in part on summary judgment in its trademark infringement counterclaim. Id. Both Khalid and Citrix appealed various pre-trial, trial, and post-trial decisions. Id.

In 2019, Khalid filed suit pro se against Microsoft, where he was employed from 2012 through 2015, alleging various claims related to the patents at issue in the state case. Dkt. # 11-6; Khalid v.

Microsoft Corp., No. C19-130-RSM, 2020 WL 1674123, at *1 (W.D. Wash. Apr. 6, 2020). He asserted violations of Sections 1 and 2 of the Sherman Act; violation of the Racketeer Influenced and Corrupt Organizations Act ("RICO") 18 U.S.C. § 1962(c-d); Actual or Attempted Forced Labor 18 U.S.C. § 1589 predicated on a RICO violation 18 U.S.C. § 1964; violation of civil rights under 42 U.S.C. § 1983 and 1985; and violation of 18 U.S.C. § 1595(a), among others. Dkt. # 11-6 ¶¶ 97-165. After dismissing his initial complaint with leave to amend, the Honorable Ricardo S. Martinez dismissed with prejudice Khalid's second amended complaint on April 6, 2020. Khalid, 2020 WL 1674123, at *11.

On May 11, 2020, Khalid filed suit pro se against Citrix in this Court. Dkt. # 1. In his amended complaint, Khalid alleged that Citrix violated various federal statutes by "claiming free ownership to '219 and '637 patents." Dkt. # 8 ¶¶ 96-163. He asserted violations of three provisions of the Clayton Act; violations of Sections 1 and 2 of the Sherman Act; attempted violation of involuntary servitude under 18 U.S.C. § 1594(a); violation of RICO, 18 U.S.C. § 1962(c-d); conspiracy – obstruction of justice under 42 U.S.C. § 1985(1)-(2); violations of civil rights under 42 U.S.C. § 1983, and others. Id. On August 26, 2020, Citrix filed the pending motion to dismiss under Federal Rules of Civil Procedure 12(b)(1) for lack of subject matter jurisdiction and 12(b)(6) for failure to state a claim upon which relief can be granted. Dkt. # 10.

After the motion to dismiss was fully briefed before this Court, the Court of Appeals of Washington issued its ruling on the parties' state court appeals. Khalid v. Citrix Sys., Inc., 15 Wash. App. 2d 1043. On December 7, 2020, the appeals court "affirm[ed] the decisions of the trial court and the judgment entered on the jury's verdicts." Id. *1. The court remanded with instructions to adjust attorney fee awards and prejudgment interest based on its finding that the trial court erred in denying Khalid pre-judgment interest on the jury's $3 million damages award and in awarding Citrix attorney fees on its trademark infringement claim. Id.

II. LEGAL STANDARD

Citrix moves the Court to dismiss Khalid's amended complaint under Rules 12(b)(1) and 12(b)(6). Under Federal Rule of Civil Procedure 12(b)(1), a court may dismiss a claim for lack of subject matter jurisdiction. An argument against jurisdiction may be facial or factual. Safe Air for Everyone v. Meyer, 373 F.3d 1035, 1039 (9th Cir. 2004). In a facial attack, the moving party claims that the allegations in the complaint "are insufficient on their face to invoke federal jurisdiction." Id. In a factual attack, the moving party disputes the truth of the allegations that would invoke federal jurisdiction. Id.

Under Federal Rule of Civil Procedure 12(b)(6), a court may dismiss a complaint for failure to state a claim. Fed. R. Civ. P. 12(b)(6). The court must assume the truth of the complaint's factual allegations and

credit all reasonable inferences arising from those allegations. Sanders v. Brown, 504 F.3d 903, 910 (9th Cir. 2007). A court "need not accept as true conclusory allegations that are contradicted by documents referred to in the complaint." Manzarek v. St. Paul Fire & Marine Ins. Co., 519 F.3d 1025, 1031 (9th Cir. 2008). Instead, the plaintiff must point to factual allegations that "state a claim to relief that is plausible on its face." Bell Atl. Corp. v. Twombly, 550 U.S. 544, 568 (2007). If the plaintiff succeeds, the complaint avoids dismissal if there is "any set of facts consistent with the allegations in the complaint" that would entitle the plaintiff to relief. Twombly, 550 U.S. at 563; Ashcroft v. Iqbal, 556 U.S. 662, 678 (2009).

On a motion to dismiss, a court typically considers only the contents of the complaint. However, a court is permitted to take judicial notice of facts that are incorporated by reference in the complaint. United States v. Ritchie, 342 F.3d 903, 908 (9th Cir. 2003) ("A court may . . . consider certain materials documents attached to the complaint, documents incorporated by reference in the complaint"). A court may "properly look beyond the complaint to matters of public record and doing so does not convert a Rule 12(b)(6) motion to one for summary judgment." Mack v. S. Bay Beer Distributors, Inc., 798 F.2d 1279, 1282 (9th Cir. 1986), abrogated by Astoria Fed. Sav. & Loan Ass'n v. Solimino on other grounds, 501 U.S. 104 (1991). With these principles in mind, the Court turns to the instant motion.

Under Rule 201 of the Federal Rules of Evidence, a court "may judicially notice a fact that is not subject to reasonable dispute because it (1) is generally known within the trial court's territorial jurisdiction; or (2) can be accurately and readily determined from sources whose accuracy cannot reasonably be questioned." Fed. R. Evid. 201(b). The court may take judicial notice on its own at any stage of the proceeding. Fed. R. Evid. 201(c-d). Pursuant to this Rule, the Court takes notice of the state court proceedings in which Plaintiff and Defendant were litigating the same matters at issue here.

III. DISCUSSION

In the pending motion, Citrix alleges, inter alia, that Khalid's claims are barred by issue and claim preclusion and they fail to state claims. Dkt. # 10 at 13-14. Under the Full Faith and Credit Act, 28 U.S.C. § 1738, federal courts must give a state court judgment "the same preclusive effect as would be given that judgment under the law of the State in which the judgment was rendered." Migra v. Warren City Sch. Dist. Bd. of Educ., 465 U.S. 75, 81 (1984). Accordingly, the preclusive effect in this Court of Khalid's state court judgment is determined by Washington law.

Under Washington state law, issue preclusion, or collateral estoppel, bars the re-litigation of issues that were decided in a previous proceeding involving the same parties. Sprague v. Spokane Valley Fire Dep't, 409 P.3d 160, 183 (Wash. 2018). To prevail on

an argument of issue preclusion or collateral estoppel in Washington, a defendant must show (1) the actions address the same issues; (2) the prior action ended in a final judgment on the merits; (3) the party against whom the doctrine is asserted was a party to, or in privity with, a party to the prior action; and (4) application of the doctrine is not unjust. Afoa v. Port of Seattle, 421 P.3d 903, 914 (Wash. 2018). Washington courts have held that "summary judgment can be a final judgment on the merits with the same preclusive effect as a full trial, and is therefore a valid basis for application of res judicata." Ensley v. Pitcher, 222 P.3d 99, 103 (Wash. Ct. App. 2009).

Washington's claim preclusion doctrine, or res judicata, "prohibits the relitigation of claims and issues that were litigated or could have been litigated in a prior action." Eugster v. Washington State Bar Ass'n, 397 P.3d 131, 145 (Wash. Ct. App. 2017) (emphasis added); see also Williams v. Leone & Keeble, Inc., 254 P.3d 818, 820 (Wash. 2011). "Filing two separate lawsuits based on the same event—claim splitting—is precluded in Washington." Ensley, 222 P.3d at 102. Claim preclusion applies where the subsequent claim involves (1) the same subject matter, (2) the same cause of action, (3) the same persons and parties, and (4) the same quality of persons for or against whom the claim is made. Afoa, 421 P.3d at 914; 254 P.3d at 820.

Washington does not, however, require literal identity of claims to satisfy the second factor. Eugster

v. Washington State Bar Ass'n, 397 P.3d 131, 146 (Wash. 2017). Instead, Washington courts consider four factors to determine whether two causes of action are the same: (1) whether the rights or interests established in the prior judgment would be destroyed or impaired by the prosecution of the second action; (2) whether substantially the same evidence is presented in the two actions; (3) whether the suits involved infringement of the same right; and (4) whether the two suits arise out of the same transactional nucleus of facts." 222 P.3d at 104. These four factors are to be used as "analytical tools; it is not necessary that all four factors be present to bar the claim." Id. Moreover, Washington courts apply the primary-rights theory, under which violation of the same primary right gives rise to a single cause of action. According to the Supreme Court of Washington, "the claim is the same if the same primary right is violated by the same wrong in both actions, or if the evidence needed to support the second action would have sustained the first action." Mellor v. Chamberlin, 673 P.2d 610, 612 (Wash. 1983) (internal quotation and citation omitted).

The preclusive effect of state court judgments has been qualified with respect to matters that are within the exclusive jurisdiction of federal courts. See Marrese v. Am. Acad. of Orthopaedic Surgeons, 470 U.S. 373, 382, (1985). The United States Supreme Court held the following:

> With respect to matters that were not decided in the state proceedings, we note that claim

> preclusion generally does not apply where "[t]he plaintiff was unable to rely on a certain theory of the case or to seek a certain remedy because of the limitations on the subject matter jurisdiction of the courts . . . ." Restatement (Second) of Judgments § 26(1)(c)(1982). If state preclusion law includes this requirement of prior jurisdictional competency, which is generally true, a state judgment will not have claim preclusive effect on a cause of action within the exclusive jurisdiction of the federal courts."
>
> Id.

Washington's law on claim preclusion requires prior jurisdictional competency because it bars the re-litigation of claims and issues "that were litigated or could have been litigated in a prior action." Eugster, 397 P.3d at 145 (emphasis added); see also, e.g., In re Lease Oil Antitrust Litig. (No. II), 16 F. Supp. 2d 744, 750-51 (S.D. Tex. 1998), aff'd, 200 F.3d 317 (5th Cir. 2000) (holding that "the limitation of preclusive effect to those claims which 'could have been litigated in the prior action' . . . would indicate that the Alabama Supreme Court requires prior jurisdictional competency"). The Court, therefore, must consider whether each of Khalid's claims raised here were or could have been litigated in the prior state court action.

In both the amended complaint before this Court, Dkt. # 8, and the state court complaint, Dkt. #

11-4, Khalid alleged the same facts in support of the same key issue, that is, ownership rights of two specific patents. In the state complaint, Khalid sought declaratory judgment that Citrix had no ownership rights to U.S. patent '219 or '637, and asserted various claims related to such a judgment, such as a breach of contract claim for enforcement of an invention assignment section that restricted his patent ownership rights, and tortious interference with a contract or business expectancy based on Citrix's "refusal to release its patent claim," among others. Dkt. # 11-4 at 23. The trial court concluded, and the court of appeals affirmed, that "Citrix has no ownership interest in two of Khalid's patents ['219 and '637]" and entered declaratory judgment to that effect in Khalid's favor. 15 Wash. App. 2d 1043 at *1.

Khalid now asserts ten causes of action before this Court. Dkt. # 8. Although Khalid asserts various federal law claims in place of most of the previously litigated state law claims, the claims are still centered on the exact same subject matter, that is, the ownership of '219 and '637 patents. Dkt. # 8 ¶¶ 94-163. The claims also involve the same parties and the same quality of persons for or against whom the claim is made because Khalid and Citrix are in the same roles of plaintiff and defendant. Walker v. BAC Home Loans Servicing, L.P., No. C14-1709JLR, 2015 WL 999920, at *5 (W.D. Wash. Mar. 5, 2015). Khalid does not dispute this. Instead, he argues that res judicata does not apply here because "[n]o State court shall have jurisdiction over any claim for relief arising

under any Act of Congress relating to patents." Dkt. # 16 at 7 (citing 28 USC § 1338(a)). This argument, on its face, could defeat claim preclusion by showing that the cause of action raised before this Court was not and could not have been asserted in state court based on the exclusive jurisdiction of federal courts. See Marrese, 470 U.S. at 382.

As a preliminary matter, the Court finds that Counts 9 and 10, a common law tort claim and an unfair competition claim under RCW 19.86.020, both of which were based on Citrix's claim to ownership of the patents at issue, are not federal law claims and could have been litigated in the prior state court action. Dkt. # 8 ¶¶ 153-63. For purposes of claim preclusion, both causes of action involve the same subject matter, the same parties, and the same quality of persons for or against whom the claim is made as those in the state court claims. Both claims also constitute the "same cause of action" as prior state claims because they arise out of the same transactional nucleus of facts, involve substantially the same evidence as those litigated in the state action, and a primary right is violated by the same wrong. See Ensley, 222 P.3d at 104; Feminist Women's Health Ctr. v. Codispoti, 63 F.3d 863, 868 (9th Cir. 1995). Consequently, these two pending claims are precluded from consideration by this Court.

Counts 1 through 8 are claims brought under federal statutes, which Khalid seems to argue cannot be litigated in state court. See Dkt. # 16 at 7. This is misleading. The grant of jurisdiction to federal courts

does not by itself make federal jurisdiction exclusive. Rice v. Janovich, 742 P.2d 1230, 1233 (Wash. 1987); see also 453 U.S. at 479 (holding that the "mere grant of jurisdiction to a federal court does not operate to oust a state court from concurrent jurisdiction over the cause of action"). Indeed, "[t]he general principle of state-court jurisdiction over cases arising under federal laws is straightforward: state courts may assume subject-matter jurisdiction over a federal cause of action absent provision by Congress to the contrary or disabling incompatibility between the federal claim and state-court adjudication." Gulf Offshore Co. v. Mobil Oil Corp., 453 U.S. 473, 477-78 (1981). The Court considers the claims in seriatim to determine (1) whether they are precluded from consideration by this Court, and if not, (2) whether they state a claim for relief that it plausible on its face.

A. Count I - Violations of Clayton Act

In Count I, Khalid alleges various violations of the Clayton Act pursuant to 15 USC §§ 13-14,18. First, he alleges that by "claiming free ownership or free license to [patents '219 and '637] using an illegal contract, declining $50,000/patent licensing offer, withholding severance money and filing injunction costing Khalid $2.8 million," Citrix engaged in price fixing in violation of the Clayton Act, 15 U.S.C. § 13. Dkt. # 8 ¶ 95. Khalid also alleges that Citrix restricted Khalid from engaging with any competitors with respect to the patents at issue in violation of the

exclusive dealings provision of Section 14 of the Clayton Act. Id. ¶ 96. Finally, Khalid alleges that by claiming ownership of the patents at issue, Citrix sought to engage in an "illegal and hostile takeover [of] the patent market to lessen competition," in violation of Section 18 of the Clayton Act Id. ¶ 97. Because violations of the Clayton Act are generally considered to be within the exclusive jurisdiction of federal courts, this claim is not necessarily precluded here. Rice v. Janovich, 742 P.2d 1230, 1233 (Wash. 1987). Nevertheless, the Court finds that Khalid fails to state a claim under the Clayton Act.

Under 15. U.S.C. § 18, or Section 7 of the Clayton Act, business acquisitions whose effect "may be substantially to lessen competition, or to tend to create a monopoly" in a relevant market are prohibited. Plaintiffs must "first establish a prima facie case that a merger is anticompetitive." DeHoog v. Anheuser-Busch InBev SA/NV, 899 F.3d 758, 763 (9th Cir. 2018). A plaintiff must allege facts that an acquisition creates "an appreciable danger" or "a reasonably probability" of anticompetitive effects in a particular market. Id. Here, Khalid fails to allege any cognizable merger, much less any anticompetitive effects or appreciable danger in a particular market.

Similarly, his claims of price fixing and exclusive dealing under the same statute are without factual support. "Exclusive dealing involves an agreement between a vendor and a buyer that prevents the buyer from purchasing a given good from any other vendor." Allied Orthopedic Appliances Inc.

v. Tyco Health Care Grp., 592 F.3d 991, 996 (9th Cir. 2010). Khalid does not point to any such agreement that would foreclose a buyer from buying a particular good from another vendor. Similarly, he points to no agreement on price fixing. Khalid's attempt to repackage a contractual dispute into a federal antitrust claim is unsuccessful and is dismissed.

B. Count II - Violation of Sherman Act, Section 1

In his second cause of action, Khalid alleges that Citrix violated Section 1 of the Sherman Act in concert with Microsoft both through a per se violation of the statute and through its conduct in "maintain[ing] illegal ownership claim on '219 and '637 patent by Citrix and Microsoft [violating] 'the exclusive Right' [of the patents at issue]." Dkt. # 8 ¶¶ 99-112. Under Section 1 of the Sherman Act "[e]very contract, combination in the form of trust or otherwise, or conspiracy, in restraint of trade or commerce among the several States, or with foreign nations, is declared to be illegal." 15 U.S.C. § 1.

In state court, Khalid also filed a restraint of trade claim under RCW 19.86.030, which is Washington's equivalent of section 1 of the Sherman Antitrust Act, see State v. Black, 676 P.2d 963, 967 (1984). Khalid v. Citrix Sys., Inc., 15 Wash. App. 2d 1043 at *8. Similar to Section 1 of the Sherman Act, the state statute RCW 19.86.030 provides that "[e]very contract, combination, in the form of trust or otherwise, or conspiracy in restraint of trade or

commerce is hereby declared unlawful." RCW 19.86.030. "In construing RCW 19.86.030, courts are to be guided by federal decisions interpreting comparable federal provisions." Murray Pub. Co. v. Malmquist, 66 Wash. App. 318, 324, 832 P.2d 493, 497 (1992). The trial court dismissed this claim, and the Court of Appeals of Washington reviewed Khalid's appeal of the dismissal and concluded that the trial court did not err in dismissing the claim. Khalid v. Citrix Sys., Inc., 15 Wash. App. 2d 1043 at *13. This constitutes final judgment under Washington preclusion doctrine. See Ensley, 222 P.3d at 103.

Khalid now seeks to resubmit his restraint of trade claim under RCW 19.86.030 in state court as a restraint of trade claim under the Sherman Act before this Court. Under Washington law, "a plaintiff is not allowed to recast his claim under a different theory and sue again . . . . [A]ll issues which might have been raised and determined are precluded." Shoemaker v. City of Bremerton, 745 P.2d 858, 860 (Wash. 1987) (en banc). The action here addresses the same issues as in the state court action, the prior action ended in a final judgment on the merits, and Citrix is the defendant in both actions, satisfying three out of the four requirements for issue preclusion. Afoa, 421 P.3d at 914. With respect to the final requirement, Court finds that the application of issue preclusion here is not unjust because Khalid had a full opportunity to litigate this issue. Thus, the Court is precluded from conducting such duplicative review of this issue.

C. Count III – Violation of the Sherman Act, Section 2

Under Section 2 of the Sherman Act, "[e]very person who shall monopolize, or attempt to monopolize, or combine or conspire with any other person or persons, to monopolize any part of the trade or commerce among the several States, or with foreign nations, shall be deemed guilty of a felony." 15 U.S.C. § 2. Khalid's claim that Citrix violated Section 2 of the Sherman Act is based on the same theory and alleged facts he submitted in Khalid v. Microsoft Corp. 2020 WL 1674123, at *3. It fails here for the same reasons.

Khalid claims that Citrix "attempted to retain 100% market power within the $4 billion sub-market attached to the '637 patent, and share that market power with Microsoft." Dkt. # 8 ¶ 115. This act, Khalid contended, violated Section 2 of the Sherman Act for "attempted monopoly in the sub-market." Id. To state a claim for attempted monopolization, a plaintiff must allege (1) specific intent to control process or destroy competition; (2) predatory or anticompetitive conduct directed at accomplishing that purpose; (3) a dangerous probability of achieving "monopoly power" and (4) causal antitrust injury. Rebel Oil Co. v. Atl. Richfield Co., 51 F.3d 1421, 1432–1433 (9th Cir. 1995). However, as already confirmed by the district Court in Khalid v. Microsoft Corp., "economic market power cannot be inferred from the mere fact that one holds a patent." 2020 WL 1674123, at *7. Moreover, "an intent to acquire patent rights does not automatically equate to an intent to

monopolize or attempt to monopolize a particular market." Id. The Court agrees with this analysis and dismisses this claim.

D. Count IV – Attempt to Violate Involuntary Servitude, 18 U.S.C. § 1594(a) Khalid alleges that Citrix's alleged attempt to obtain patent titles from Khalid without compensation constitutes "an attempt . . . to get free labor or service with serious harm" in violation of the Trafficking Victims Protection Reauthorization Act

("TVPRA"), 18 U.S.C. § 1589. Dkt. # 8 ¶ 122. The statute bars a person from

"knowingly provid[ing] or obtain[ing] the labor or services of a person . . . by means of force . . . by means of serious harm or threats of serious harm . . . by means of the abuse or threatened abuse of law or legal process." 18 U.S.C. § 1589(a). Khalid brought the same claim against Microsoft in his original complaint in Khalid v. Microsoft, alleging the same facts as here with respect to his work and time spent on patents '219 and '637. There, as here, Khalid claims "he would have never offered Citrix [or Microsoft] voluntarily free labor or service." Dkt. # 8 ¶ 123.

However, as Judge Martinez noted in his earlier order dismissing Khalid's original complaint in Khalid v. Microsoft, Khalid had not been coerced to continue working on his patents—he had a choice. Khalid v. Microsoft Corp., 409 F. Supp. 3d 1023, 1034 (W.D. Wash. 2019), appeal dismissed sub nom. ATM

Shafiqul Khalid v. Microsoft Corp., No.19-35841, 2019 WL 6250434 (9th Cir. Oct. 25, 2019), and reconsideration denied, No. C19-0130 RSM, 2019 WL 6213162 (W.D. Wash. Nov. 21, 2019). The Court finds that Khalid's claims of involuntary servitude pursuant to 18 U.S.C. § 1584 and forced labor under 18 U.S.C. § 1589 against Citrix fail for the same reason. His work on his patents was a choice, and there is no evidence of coercion by serious harm or a threat of serious harm by Citrix. This claim is dismissed.

E. Count V – Violation of Racketeering Act, 18 U.S.C. § 1962(c-d)

Khalid's RICO claim, which centers around that ownership rights to the patents at issue, is precluded because it could have been brought in state court. The Supreme Court of Washington has held that state courts have concurrent jurisdiction over RICO claims. Rice v. Janovich, 742 P.2d 1230, 1235 (Wash. 1987) (holding that "RICO provides neither the explicit statutory direction or unmistakable implication of exclusivity, nor clear incompatibility with state court jurisdiction sufficient to overcome the presumption of concurrent jurisdiction").

The RICO claim involves the same subject matter—ownership of the two patents at issue—as well as the same parties and same quality of parties with respect to the positions they occupy as the claims already litigated in state court. The cause of action is "the same" because it arises out of the same nucleus

of facts, involves infringement of the same right, and the same evidence would be presented in the two actions. See Ensley, 222 P.3d at 104. Moreover, Washington's preclusion doctrine dictates the following:

> While the rule is universal that a judgment upon one cause of action does not bar suit upon another cause which is independent of the cause which was adjudicated, it is equally clear that res judicata applies to every point which properly belonged to the subject of litigation, and which the parties, exercising reasonable diligence, might have brought forward at the time.

Feminist Women's Health Ctr. v. Codispoti, 63 F.3d 863, 867 (9th Cir. 1995)

(internal citations and quotations omitted). Because Khalid could have raised this claim in his state court case, he is now barred from bringing it before this Court.

F. Count VI – VIII – Civil Rights Claims

Khalid alleges various violation of his civil rights under 42 U.S.C §§ 1983 and 1985. Khalid contends that "inventors" are a protected class under the Constitution and that Congress is "required to secure 'the exclusive Rights' in inventions to inventors." Dkt. # 8 ¶ 135. Khalid claims that "by using the M&G letter with false information, Citrix

and Microsoft, or Citrix and its employees conspired for the purpose

> of . . . obstructing . . . justice in Washington state court, with intent to deny Khalid the equal protection of the laws." Id. ¶ 138. These claims with the same factual nexus were filed before Judge Martinez and dismissed for failure to state a claim and untimeliness. Khalid, 409 F. Supp. 3d at 1037. The Court concurs with these conclusions.

First, as Citrix notes, Khalid became aware that Citrix sought to claim ownership of the patents at issue in October 2011. Dkt. # 19 at 29. There is no dispute about this time frame as it is at the center of Khalid's state litigation. Khalid filed this compliant almost nine years after he learned about Citrix's claim of the patents and five years after he filed suit in state court on the same issue. Because there is a three-year statute of limitations for §§ 1983 and 1985 claims, his claims are untimely. Oliver v. Spokane Cty. Fire Dist. 9, 963 F. Supp. 2d 1162, 1172 (E.D. Wash. 2013) (three-year statute of limitations for § 1983 claims in Washington); McDougal v. Cty. of Imperial, 942 F.2d 668, 673-74 (9th Cir. 1991) (statute of limitations for § 1985 claims is the same as for § 1983 claims).

Second, Khalid fails to establish the elements of a civil rights claim under either statute. As explained in Khalid v. Microsoft:

> A claim under § 1983 requires that a person or entity be acting "under color of any statute, ordinance, regulation, custom, or usage, of any

> State or Territory" when depriving a party of his rights, privileges or immunities. 42 U.S.C. § 1983. "Only in rare circumstances" will a court view a private party as a state actor for § 1983 purposes. Sutton v. Providence St. Joseph Med. Ctr., 192 F.3d 826, 835 (9th Cir. 1999). For private conduct to constitute governmental action, there must be a "close nexus between the State and the challenged action that seemingly private behavior may be treated as that of the State itself." Brentwood Acad. v. Tenn. Secondary Sch. Athletic Ass'n, 531 U.S. 288, 295, 121 S.Ct. 924, 148 L.Ed.2d 807 (2001) (internal quotations omitted).

409 F. Supp. 3d at 1036. Having failed to allege any facts establishing the elements of a civil rights claim under §§ 1983 or 1985, Khalid fails to state a claim.

Appendix B - Order Regarding Petitioner's Complaint in the Dist. Court, WD Washington, Filed April 14, 2021

IV. CONCLUSION

For the foregoing reasons, Defendant Citrix's Motion to Dismiss is GRANTED. Because Plaintiff has already had the opportunity to litigate these claims or issues in both state and federal court, the claims are dismissed with prejudice.

DATED this 14th day of April, 2021.

The Honorable Richard A. Jones

United States District Judge

Appendix C - Order Regarding Petitioner's motion for rehearing to the Court of Appels for the Ninth Circuit, Filed April 21, 2023

UNITED STATES COURT OF APPEALS
FOR THE NINTH CIRCUIT

ATM SHAFIQUL KHALID, Esquire, an individual and on behalf of similarly situated,
Plaintiff-Appellant,

v.

CITRIX SYSTEMS, INC., John Doe n,
Defendant-Appellee.

No. 21-35376
D.C. No. 2:20-cv-00711-RAJ
Western District of Washington,
Seattle

ORDER

Before: HAWKINS, S.R. THOMAS, and McKEOWN, Circuit Judges.

Judge S.R. Thomas has voted to deny the petition for rehearing en banc, and Judges Hawkins and McKeown so recommend. The full court has been advised of the petition for rehearing en banc and no judge has requested a vote on whether to rehear the matter en banc. Fed. R. App. P. 35. The petition for rehearing en banc is

DENIED.

Appendix D – Statutory Provisions and Federalist Papers

15 U.S. Code§ 1 - Trusts, etc., in restraint of trade illegal; penalty

Every contract, combination in the form of trust or otherwise, or conspiracy, in restraint of trade or commerce among the several States, or with foreign nations, is declared to be illegal. Every person who shall make any contract or engage in any combination or conspiracy hereby declared to be illegal shall be deemed guilty of a felony, and, on conviction thereof, shall be punished by fine not exceeding $100,000,000 if a corporation, or, if any other person, $1,000,000, or by imprisonment not exceeding 10 years, or by both said punishments, in the discretion of the court.

15 U.S. Code§ 2 - Monopolizing trade a felony; penalty

Every person who shall monopolize, or attempt to monopolize, or combine or conspire with any other person or persons, to monopolize any part of the trade or commerce among the several States, or with foreign nations, shall be deemed guilty of a felony, and, on conviction thereof, shall be punished by fine not exceeding $100,000,000 if a corporation, or, if any other person, $1,000,000, or by imprisonment not exceeding 10 years, or by both said punishments, in the discretion of the court.

Appendix D – Statutory Provisions and Federalist Papers

42 U.S. Code§ 1983 - Civil action for deprivation of rights

Every person who, under color of any statute, ordinance, regulation, custom, or usage, of any State or Territory or the District of Columbia, subjects, or causes to be subjected, any citizen of the United States or other person within the jurisdiction thereof to the deprivation of any rights, privileges, or immunities secured by the Constitution and laws, shall be liable to the party injured in an action at law, suit in equity, or other proper proceeding for redress, except that in any action brought against a judicial officer for an act or omission taken in such officer's judicial capacity, injunctive relief shall not be granted unless a declaratory decree was violated or declaratory relief was unavailable. For the purposes of this section, any Act of Congress applicable exclusively to the District of Columbia shall be considered to be a statute of the District of Columbia.

42 U.S. Code § 1985 - Conspiracy to interfere with civil rights

(1)Preventing officer from performing duties

If two or more persons in any State or Territory conspire to prevent, by force, intimidation, or threat, any person from accepting or holding any office, trust, or place of confidence under the United States, or from discharging any duties thereof; or to induce by like means any officer of the United States to leave any State, district, or place, where his duties as an officer are required to be performed, or to injure him in his person or property on account of his lawful discharge of the duties of his office, or while engaged in the lawful discharge thereof, or to injure his property so as to molest, interrupt, hinder, or impede him in the discharge of his official duties;

(2)Obstructing justice; intimidating party, witness, or juror

If two or more persons in any State or Territory conspire to deter, by force, intimidation, or threat, any party or witness in any court of the United States from attending such court, or from testifying to any matter pending therein, freely, fully, and truthfully, or to injure such party or witness in his person or property on account of his having so attended or testified, or to influence the verdict, presentment, or indictment of any grand or petit juror in any such court, or to injure such juror in his person or property on account of any verdict, presentment, or indictment lawfully assented to by him, or of his being or having been such juror; or if two or more persons conspire for the purpose of impeding, hindering, obstructing, or defeating, in any manner, the due course of justice in any State or Territory, with intent to deny to any citizen the equal protection of the laws, or to injure him or his property for lawfully enforcing, or attempting to enforce, the right of any person, or class of persons, to the equal protection of the laws;

(3)Depriving persons of rights or privileges

If two or more persons in any State or Territory conspire or go in disguise on the highway or on the premises of another, for the purpose of depriving, either directly or indirectly, any person or class of persons of the equal protection of the laws, or of equal privileges and immunities under the laws; or for the purpose of preventing or hindering the constituted authorities of any State or Territory from giving or securing to all persons within such State or Territory the equal protection of the laws; or if two or more persons conspire to prevent by force, intimidation, or

threat, any citizen who is lawfully entitled to vote, from giving his support or advocacy in a legal manner, toward or in favor of the election of any lawfully qualified person as an elector for President or Vice President, or as a Member of Congress of the United States; or to injure any citizen in person or property on account of such support or advocacy; in any case of conspiracy set forth in this section, if one or more persons engaged therein do, or cause to be done, any act in furtherance of the object of such conspiracy, whereby another is injured in his person or property, or deprived of having and exercising any right or privilege of a citizen of the United States, the party so injured or deprived may have an action for the recovery of damages occasioned by such injury or deprivation, against any one or more of the conspirators.

Appendix D – Statutory Provisions and Federalist Papers

Declaration of Independence: A Transcription

In Congress, July 4, 1776

The unanimous Declaration of the thirteen united States of America, When in the Course of human events, it becomes necessary for one people to dissolve the political bands which have connected them with another, and to assume among the powers of the earth, the separate and equal station to which the Laws of Nature and of Nature's God entitle them, a decent respect to the opinions of mankind requires that they should declare the causes which impel them to the separation.

We hold these truths to be self-evident, that all men are created equal, that they are endowed by their Creator with certain unalienable Rights, that among these are Life, Liberty and the pursuit of Happiness.--That to secure these rights, Governments are instituted among Men, deriving their just powers from the consent of the governed, --That whenever any Form of Government becomes destructive of these ends, it is the Right of the People to alter or to abolish it, and to institute new Government, laying its foundation on such principles and organizing its powers in such form, as to them shall seem most likely to effect their Safety and Happiness. Prudence, indeed, will dictate that Governments long established should not be changed for light and transient causes; and accordingly all experience hath shewn, that mankind are more disposed to suffer, while evils are sufferable, than to right themselves by abolishing the forms to which they are accustomed. But when a long train of abuses and usurpations, pursuing invariably the same Object evinces a design

to reduce them under absolute Despotism, it is their right, it is their duty, to throw off such Government, and to provide new Guards for their future security.-- Such has been the patient sufferance of these Colonies; and such is now the necessity which constrains them to alter their former Systems of Government. The history of the present King of Great Britain is a history of repeated injuries and usurpations, all having in direct object the establishment of an absolute Tyranny over these States. To prove this, let Facts be submitted to a candid world.

He has refused his Assent to Laws, the most wholesome and necessary for the public good.

He has forbidden his Governors to pass Laws of immediate and pressing importance, unless suspended in their operation till his Assent should be obtained; and when so suspended, he has utterly neglected to attend to them.

He has refused to pass other Laws for the accommodation of large districts of people, unless those people would relinquish the right of Representation in the Legislature, a right inestimable to them and formidable to tyrants only.

He has called together legislative bodies at places unusual, uncomfortable, and distant from the depository of their public Records, for the sole purpose of fatiguing them into compliance with his measures.

He has dissolved Representative Houses repeatedly, for opposing with manly firmness his invasions on the rights of the people.

He has refused for a long time, after such dissolutions, to cause others to be elected; whereby the Legislative

powers, incapable of Annihilation, have returned to the People at large for their exercise; the State remaining in the mean time exposed to all the dangers of invasion from without, and convulsions within.

He has endeavoured to prevent the population of these States; for that purpose obstructing the Laws for Naturalization of Foreigners; refusing to pass others to encourage their migrations hither, and raising the conditions of new Appropriations of Lands.

He has obstructed the Administration of Justice, by refusing his Assent to Laws for establishing Judiciary powers.

He has made Judges dependent on his Will alone, for the tenure of their offices, and the amount and payment of their salaries.

He has erected a multitude of New Offices, and sent hither swarms of Officers to harrass our people, and eat out their substance.

He has kept among us, in times of peace, Standing Armies without the Consent of our legislatures.

He has affected to render the Military independent of and superior to the Civil power.

He has combined with others to subject us to a jurisdiction foreign to our constitution, and unacknowledged by our laws; giving his Assent to their Acts of pretended Legislation:

For Quartering large bodies of armed troops among us:

For protecting them, by a mock Trial, from punishment for any Murders which they should commit on the Inhabitants of these States:

For cutting off our Trade with all parts of the world:

For imposing Taxes on us without our Consent:

For depriving us in many cases, of the benefits of Trial by Jury:

For transporting us beyond Seas to be tried for pretended offences

For abolishing the free System of English Laws in a neighbouring Province, establishing therein an Arbitrary government, and enlarging its Boundaries so as to render it at once an example and fit instrument for introducing the same absolute rule into these Colonies:

For taking away our Charters, abolishing our most valuable Laws, and altering fundamentally the Forms of our Governments:

For suspending our own Legislatures, and declaring themselves invested with power to legislate for us in all cases whatsoever.

He has abdicated Government here, by declaring us out of his Protection and waging War against us.

He has plundered our seas, ravaged our Coasts, burnt our towns, and destroyed the lives of our people.

He is at this time transporting large Armies of foreign Mercenaries to compleat the works of death, desolation and tyranny, already begun with circumstances of Cruelty & perfidy scarcely paralleled in the most barbarous ages, and totally unworthy the Head of a civilized nation.

He has constrained our fellow Citizens taken Captive on the high Seas to bear Arms against their Country,

to become the executioners of their friends and Brethren, or to fall themselves by their Hands.

He has excited domestic insurrections amongst us, and has endeavoured to bring on the inhabitants of our frontiers, the merciless Indian Savages, whose known rule of warfare, is an undistinguished destruction of all ages, sexes and conditions.

In every stage of these Oppressions We have Petitioned for Redress in the most humble terms: Our repeated Petitions have been answered only by repeated injury. A Prince whose character is thus marked by every act which may define a Tyrant, is unfit to be the ruler of a free people.

Nor have We been wanting in attentions to our Brittish brethren. We have warned them from time to time of attempts by their legislature to extend an unwarrantable jurisdiction over us. We have reminded them of the circumstances of our emigration and settlement here. We have appealed to their native justice and magnanimity, and we have conjured them by the ties of our common kindred to disavow these usurpations, which, would inevitably interrupt our connections and correspondence. They too have been deaf to the voice of justice and of consanguinity. We must, therefore, acquiesce in the necessity, which denounces our Separation, and hold them, as we hold the rest of mankind, Enemies in War, in Peace Friends.

We, therefore, the Representatives of the united States of America, in General Congress, Assembled, appealing to the Supreme Judge of the world for the rectitude of our intentions, do, in the Name, and by Authority of the good People of these Colonies, solemnly publish and declare, That these United

Colonies are, and of Right ought to be Free and Independent States; that they are Absolved from all Allegiance to the British Crown, and that all political connection between them and the State of Great Britain, is and ought to be totally dissolved; and that as Free and Independent States, they have full Power to levy War, conclude Peace, contract Alliances, establish Commerce, and to do all other Acts and Things which Independent States may of right do. And for the support of this Declaration, with a firm reliance on the protection of divine Providence, we mutually pledge to each other our Lives, our Fortunes and our sacred Honor.

Note: The following text is a transcription of the Stone Engraving of the parchment Declaration of Independence (the document on display in the Rotunda at the National Archives Museum.) The spelling and punctuation reflects the original.

Appendix D – Statutory Provisions and Federalist Papers

FEDERALIST NO. 43
The Same Subject Continued: The Powers Conferred by the Constitution Further Considered
For the *Independent Journal.*
Author: James Madison
To the People of the State of New York:

THE FOURTH class comprises the following miscellaneous powers:

A power "to promote the progress of science and useful arts, by securing, for a limited time, to authors and inventors, the exclusive right to their respective writings and discoveries. "The utility of this power will scarcely be questioned. The copyright of authors has been solemnly adjudged, in Great Britain, to be a right of common law. The right to useful inventions seems with equal reason to belong to the inventors. The public good fully coincides in both cases with the claims of individuals. The States cannot separately make effectual provisions for either of the cases, and most of them have anticipated the decision of this point, by laws passed at the instance of Congress.

"To exercise exclusive legislation, in all cases whatsoever, over such district (not exceeding ten miles square) as may, by cession of particular States and the acceptance of Congress, become the seat of the government of the United States; and to exercise like authority over all places purchased by the consent of the legislatures of the States in which the same shall be, for the erection of forts, magazines, arsenals, dockyards, and other needful buildings.

"The indispensable necessity of complete authority at the seat of government, carries its own evidence with it. It is a power exercised by every legislature of the Union, I might say of the world, by virtue of its general supremacy. Without it, not only the public authority might be insulted and its proceedings interrupted with impunity; but a dependence of the members of the general government on the State comprehending the seat of the government, for protection in the exercise of their duty, might bring on the national councils an imputation of awe or influence, equally dishonorable to the government and dissatisfactory to the other members of the Confederacy. This consideration has the more weight, as the gradual accumulation of public improvements at the stationary residence of the government would be both too great a public pledge to be left in the hands of a single State, and would create so many obstacles to a removal of the government, as still further to abridge its necessary independence. The extent of this federal district is sufficiently circumscribed to satisfy every jealousy of an opposite nature. And as it is to be appropriated to this use with the consent of the State ceding it; as the State will no doubt provide in the compact for the rights and the consent of the citizens inhabiting it; as the inhabitants will find sufficient inducements of interest to become willing parties to the cession; as they will have had their voice in the election of the government which is to exercise authority over them; as a municipal legislature for local purposes, derived from their own suffrages, will of course be allowed them; and as the authority of the legislature of the State, and of the inhabitants of the

ceded part of it, to concur in the cession, will be derived from the whole people of the State in their adoption of the Constitution, every imaginable objection seems to be obviated. The necessity of a like authority over forts, magazines, etc. , established by the general government, is not less evident. The public money expended on such places, and the public property deposited in them, requires that they should be exempt from the authority of the particular State. Nor would it be proper for the places on which the security of the entire Union may depend, to be in any degree dependent on a particular member of it. All objections and scruples are here also obviated, by requiring the concurrence of the States concerned, in every such establishment.

"To declare the punishment of treason, but no attainder of treason shall work corruption of blood, or forfeiture, except during the life of the person attained. "As treason may be committed against the United States, the authority of the United States ought to be enabled to punish it. But as new-fangled and artificial treasons have been the great engines by which violent factions, the natural offspring of free government, have usually wreaked their alternate malignity on each other, the convention have, with great judgment, opposed a barrier to this peculiar danger, by inserting a constitutional definition of the crime, fixing the proof necessary for conviction of it, and restraining the Congress, even in punishing it, from extending the consequences of guilt beyond the person of its author.

"To admit new States into the Union; but no new State shall be formed or erected within the jurisdiction of any other State; nor any State be formed by the junction of two or more States, or parts of States, without the consent of the legislatures of the States concerned, as well as of the Congress. "In the articles of Confederation, no provision is found on this important subject. Canada was to be admitted of right, on her joining in the measures of the United States; and the other COLONIES, by which were evidently meant the other British colonies, at the discretion of nine States. The eventual establishment of NEW STATES seems to have been overlooked by the compilers of that instrument. We have seen the inconvenience of this omission, and the assumption of power into which Congress have been led by it. With great propriety, therefore, has the new system supplied the defect. The general precaution, that no new States shall be formed, without the concurrence of the federal authority, and that of the States concerned, is consonant to the principles which ought to govern such transactions. The particular precaution against the erection of new States, by the partition of a State without its consent, quiets the jealousy of the larger States; as that of the smaller is quieted by a like precaution, against a junction of States without their consent.

"To dispose of and make all needful rules and regulations respecting the territory or other property belonging to the United States, with a proviso, that nothing in the Constitution shall be so construed as to prejudice any claims of the United States, or of any particular State. "This is a power of very great

importance, and required by considerations similar to those which show the propriety of the former. The proviso annexed is proper in itself, and was probably rendered absolutely necessary by jealousies and questions concerning the Western territory sufficiently known to the public.

"To guarantee to every State in the Union a republican form of government; to protect each of them against invasion; and on application of the legislature, or of the executive (when the legislature cannot be convened), against domestic violence.

"In a confederacy founded on republican principles, and composed of republican members, the superintending government ought clearly to possess authority to defend the system against aristocratic or monarchial innovations. The more intimate the nature of such a union may be, the greater interest have the members in the political institutions of each other; and the greater right to insist that the forms of government under which the compact was entered into should be SUBSTANTIALLY maintained. But a right implies a remedy; and where else could the remedy be deposited, than where it is deposited by the Constitution? Governments of dissimilar principles and forms have been found less adapted to a federal coalition of any sort, than those of a kindred nature. "As the confederate republic of Germany," says Montesquieu, "consists of free cities and petty states, subject to different princes, experience shows us that it is more imperfect than that of Holland and Switzerland. " "Greece was undone," he adds, "as soon as the king of Macedon obtained a seat among the

Amphictyons." In the latter case, no doubt, the disproportionate force, as well as the monarchical form, of the new confederate, had its share of influence on the events. It may possibly be asked, what need there could be of such a precaution, and whether it may not become a pretext for alterations in the State governments, without the concurrence of the States themselves.

These questions admit of ready answers. If the interposition of the general government should not be needed, the provision for such an event will be a harmless superfluity only in the Constitution. But who can say what experiments may be produced by the caprice of particular States, by the ambition of enterprising leaders, or by the intrigues and influence of foreign powers? To the second question it may be answered, that if the general government should interpose by virtue of this constitutional authority, it will be, of course, bound to pursue the authority. But the authority extends no further than to a GUARANTY of a republican form of government, which supposes a pre-existing government of the form which is to be guaranteed. As long, therefore, as the existing republican forms are continued by the States, they are guaranteed by the federal Constitution. Whenever the States may choose to substitute other republican forms, they have a right to do so, and to claim the federal guaranty for the latter. The only restriction imposed on them is, that they shall not exchange republican for antirepublican Constitutions; a restriction which, it is presumed, will hardly be considered as a grievance.

Appendix D – Statutory Provisions and Federalist Papers

A protection against invasion is due from every society to the parts composing it. The latitude of the expression here used seems to secure each State, not only against foreign hostility, but against ambitious or vindictive enterprises of its more powerful neighbors. The history, both of ancient and modern confederacies, proves that the weaker members of the union ought not to be insensible to the policy of this article. Protection against domestic violence is added with equal propriety. It has been remarked, that even among the Swiss cantons, which, properly speaking, are not under one government, provision is made for this object; and the history of that league informs us that mutual aid is frequently claimed and afforded; and as well by the most democratic, as the other cantons. A recent and well-known event among ourselves has warned us to be prepared for emergencies of a like nature. At first view, it might seem not to square with the republican theory, to suppose, either that a majority have not the right, or that a minority will have the force, to subvert a government; and consequently, that the federal interposition can never be required, but when it would be improper. But theoretic reasoning, in this as in most other cases, must be qualified by the lessons of practice. Why may not illicit combinations, for purposes of violence, be formed as well by a majority of a State, especially a small State as by a majority of a county, or a district of the same State; and if the authority of the State ought, in the latter case, to protect the local magistracy, ought not the federal authority, in the former, to support the State

authority? Besides, there are certain parts of the State constitutions which are so interwoven with the federal Constitution, that a violent blow cannot be given to the one without communicating the wound to the other. Insurrections in a State will rarely induce a federal interposition, unless the number concerned in them bear some proportion to the friends of government. It will be much better that the violence in such cases should be repressed by the superintending power, than that the majority should be left to maintain their cause by a bloody and obstinate contest. The existence of a right to interpose, will generally prevent the necessity of exerting it.

Is it true that force and right are necessarily on the same side in republican governments? May not the minor party possess such a superiority of pecuniary resources, of military talents and experience, or of secret succors from foreign powers, as will render it superior also in an appeal to the sword? May not a more compact and advantageous position turn the scale on the same side, against a superior number so situated as to be less capable of a prompt and collected exertion of its strength? Nothing can be more chimerical than to imagine that in a trial of actual force, victory may be calculated by the rules which prevail in a census of the inhabitants, or which determine the event of an election! May it not happen, in fine, that the minority of CITIZENS may become a majority of PERSONS, by the accession of alien residents, of a casual concourse of adventurers, or of those whom the constitution of the State has not

admitted to the rights of suffrage? I take no notice of an unhappy species of population abounding in some of the States, who, during the calm of regular government, are sunk below the level of men; but who, in the tempestuous scenes of civil violence, may emerge into the human character, and give a superiority of strength to any party with which they may associate themselves. In cases where it may be doubtful on which side justice lies, what better umpires could be desired by two violent factions, flying to arms, and tearing a State to pieces, than the representatives of confederate States, not heated by the local flame? To the impartiality of judges, they would unite the affection of friends. Happy would it be if such a remedy for its infirmities could be enjoyed by all free governments; if a project equally effectual could be established for the universal peace of mankind! Should it be asked, what is to be the redress for an insurrection pervading all the States, and comprising a superiority of the entire force, though not a constitutional right? the answer must be, that such a case, as it would be without the compass of human remedies, so it is fortunately not within the compass of human probability; and that it is a sufficient recommendation of the federal Constitution, that it diminishes the risk of a calamity for which no possible constitution can provide a cure. Among the advantages of a confederate republic enumerated by Montesquieu, an important one is, "that should a popular insurrection happen in one of the States, the others are able to quell it. Should abuses creep into one part, they are reformed by those that remain sound. "

"To consider all debts contracted, and engagements entered into, before the adoption of this Constitution, as being no less valid against the United States, under this Constitution, than under the Confederation. "This can only be considered as a declaratory proposition; and may have been inserted, among other reasons, for the satisfaction of the foreign creditors of the United States, who cannot be strangers to the pretended doctrine, that a change in the political form of civil society has the magical effect of dissolving its moral obligations. Among the lesser criticisms which have been exercised on the Constitution, it has been remarked that the validity of engagements ought to have been asserted in favor of the United States, as well as against them; and in the spirit which usually characterizes little critics, the omission has been transformed and magnified into a plot against the national rights. The authors of this discovery may be told, what few others need to be informed of, that as engagements are in their nature reciprocal, an assertion of their validity on one side, necessarily involves a validity on the other side; and that as the article is merely declaratory, the establishment of the principle in one case is sufficient for every case. They may be further told, that every constitution must limit its precautions to dangers that are not altogether imaginary; and that no real danger can exist that the government would DARE, with, or even without, this constitutional declaration before it, to remit the debts justly due to the public, on the pretext here condemned.

"To provide for amendments to be ratified by three fourths of the States under two exceptions only. "That useful alterations will be suggested by experience, could not but be foreseen. It was requisite, therefore, that a mode for introducing them should be provided. The mode preferred by the convention seems to be stamped with every mark of propriety. It guards equally against that extreme facility, which would render the Constitution too mutable; and that extreme difficulty, which might perpetuate its discovered faults. It, moreover, equally enables the general and the State governments to originate the amendment of errors, as they may be pointed out by the experience on one side, or on the other. The exception in favor of the equality of suffrage in the Senate, was probably meant as a palladium to the residuary sovereignty of the States, implied and secured by that principle of representation in one branch of the legislature; and was probably insisted on by the States particularly attached to that equality. The other exception must have been admitted on the same considerations which produced the privilege defended by it.

"The ratification of the conventions of nine States shall be sufficient for the establishment of this Constitution between the States, ratifying the same. "This article speaks for itself. The express authority of the people alone could give due validity to the Constitution. To have required the unanimous ratification of the thirteen States, would have subjected the essential interests of the whole to the caprice or corruption of a single member. It would have marked a want of foresight in the convention,

which our own experience would have rendered inexcusable. Two questions of a very delicate nature present themselves on this occasion:

On what principle the Confederation, which stands in the solemn form of a compact among the States, can be superseded without the unanimous consent of the parties to it?

What relation is to subsist between the nine or more States ratifying the Constitution, and the remaining few who do not become parties to it? The first question is answered at once by recurring to the absolute necessity of the case; to the great principle of self-preservation; to the transcendent law of nature and of nature's God, which declares that the safety and happiness of society are the objects at which all political institutions aim, and to which all such institutions must be sacrificed.

PERHAPS, also, an answer may be found without searching beyond the principles of the compact itself. It has been heretofore noted among the defects of the Confederation, that in many of the States it had received no higher sanction than a mere legislative ratification. The principle of reciprocality seems to require that its obligation on the other States should be reduced to the same standard. A compact between independent sovereigns, founded on ordinary acts of legislative authority, can pretend to no higher validity than a league or treaty between the parties. It is an established doctrine on the subject of treaties, that all the articles are mutually conditions of each other; that a breach of any one article is a breach of the whole treaty; and that a breach, committed by either of the

parties, absolves the others, and authorizes them, if they please, to pronounce the compact violated and void. Should it unhappily be necessary to appeal to these delicate truths for a justification for dispensing with the consent of particular States to a dissolution of the federal pact, will not the complaining parties find it a difficult task to answer the MULTIPLIED and IMPORTANT infractions with which they may be confronted? The time has been when it was incumbent on us all to veil the ideas which this paragraph exhibits. The scene is now changed, and with it the part which the same motives dictate.

The second question is not less delicate; and the flattering prospect of its being merely hypothetical forbids an overcurious discussion of it. It is one of those cases which must be left to provide for itself. In general, it may be observed, that although no political relation can subsist between the assenting and dissenting States, yet the moral relations will remain uncancelled. The claims of justice, both on one side and on the other, will be in force, and must be fulfilled; the rights of humanity must in all cases be duly and mutually respected; whilst considerations of a common interest, and, above all, the remembrance of the endearing scenes which are past, and the anticipation of a speedy triumph over the obstacles to reunion, will, it is hoped, not urge in vain MODERATION on one side, and PRUDENCE on the other.

PUBLIUS.

FEDERALIST NO. 69
The Real Character of the Executive
From the *New York Packet*
Friday, March 14, 1788.
Author: Alexander Hamilton

To the People of the State of New York:

I PROCEED now to trace the real characters of the proposed Executive, as they are marked out in the plan of the convention. This will serve to place in a strong light the unfairness of the representations which have been made in regard to it.

The first thing which strikes our attention is, that the executive authority, with few exceptions, is to be vested in a single magistrate. This will scarcely, however, be considered as a point upon which any comparison can be grounded; for if, in this particular, there be a resemblance to the king of Great Britain, there is not less a resemblance to the Grand Seignior, to the khan of Tartary, to the Man of the Seven Mountains, or to the governor of New York.

That magistrate is to be elected for FOUR years; and is to be re-eligible as often as the people of the United States shall think him worthy of their confidence. In these circumstances there is a total dissimilitude between HIM and a king of Great Britain, who is an HEREDITARY monarch, possessing the crown as a

patrimony descendible to his heirs forever; but there is a close analogy between HIM and a governor of New York, who is elected for THREE years, and is re-eligible without limitation or intermission. If we consider how much less time would be requisite for establishing a dangerous influence in a single State, than for establishing a like influence throughout the United States, we must conclude that a duration of FOUR years for the Chief Magistrate of the Union is a degree of permanency far less to be dreaded in that office, than a duration of THREE years for a corresponding office in a single State.

The President of the United States would be liable to be impeached, tried, and, upon conviction of treason, bribery, or other high crimes or misdemeanors, removed from office; and would afterwards be liable to prosecution and punishment in the ordinary course of law. The person of the king of Great Britain is sacred and inviolable; there is no constitutional tribunal to which he is amenable; no punishment to which he can be subjected without involving the crisis of a national revolution. In this delicate and important circumstance of personal responsibility, the President of Confederated America would stand upon no better ground than a governor of New York, and upon worse ground than the governors of Maryland and Delaware.

The President of the United States is to have power to return a bill, which shall have passed the two

branches of the legislature, for reconsideration; and the bill so returned is to become a law, if, upon that reconsideration, it be approved by two thirds of both houses. The king of Great Britain, on his part, has an absolute negative upon the acts of the two houses of Parliament. The disuse of that power for a considerable time past does not affect the reality of its existence; and is to be ascribed wholly to the crown's having found the means of substituting influence to authority, or the art of gaining a majority in one or the other of the two houses, to the necessity of exerting a prerogative which could seldom be exerted without hazarding some degree of national agitation. The qualified negative of the President differs widely from this absolute negative of the British sovereign; and tallies exactly with the revisionary authority of the council of revision of this State, of which the governor is a constituent part. In this respect the power of the President would exceed that of the governor of New York, because the former would possess, singly, what the latter shares with the chancellor and judges; but it would be precisely the same with that of the governor of Massachusetts, whose constitution, as to this article, seems to have been the original from which the convention have copied.

The President is to be the "commander-in-chief of the army and navy of the United States, and of the militia of the several States, when called into the actual service of the United States. He is to have power to grant reprieves and pardons for offenses against the United States, EXCEPT IN CASES OF

IMPEACHMENT; to recommend to the consideration of Congress such measures as he shall judge necessary and expedient; to convene, on extraordinary occasions, both houses of the legislature, or either of them, and, in case of disagreement between them WITH RESPECT TO THE TIME OF ADJOURNMENT, to adjourn them to such time as he shall think proper; to take care that the laws be faithfully executed; and to commission all officers of the United States." In most of these particulars, the power of the President will resemble equally that of the king of Great Britain and of the governor of New York. The most material points of difference are these:

First. The President will have only the occasional command of such part of the militia of the nation as by legislative provision may be called into the actual service of the Union. The king of Great Britain and the governor of New York have at all times the entire command of all the militia within their several jurisdictions. In this article, therefore, the power of the President would be inferior to that of either the monarch or the governor.

Secondly. The President is to be commander-in-chief of the army and navy of the United States. In this respect his authority would be nominally the same with that of the king of Great Britain, but in substance much inferior to it. It would amount to nothing more than the supreme command and direction of the military and naval forces, as first General and

admiral of the Confederacy; while that of the British king extends to the DECLARING of war and to the RAISING and REGULATING of fleets and armies, all which, by the Constitution under consideration, would appertain to the legislature.1 The governor of New York, on the other hand, is by the constitution of the State vested only with the command of its militia and navy. But the constitutions of several of the States expressly declare their governors to be commanders-in-chief, as well of the army as navy; and it may well be a question, whether those of New Hampshire and Massachusetts, in particular, do not, in this instance, confer larger powers upon their respective governors, than could be claimed by a President of the United States.

Thirdly. The power of the President, in respect to pardons, would extend to all cases, EXCEPT THOSE OF IMPEACHMENT. The governor of New York may pardon in all cases, even in those of impeachment, except for treason and murder. Is not the power of the governor, in this article, on a calculation of political consequences, greater than that of the President? All conspiracies and plots against the government, which have not been matured into actual treason, may be screened from punishment of every kind, by the interposition of the prerogative of pardoning. If a governor of New York, therefore, should be at the head of any such conspiracy, until the design had been ripened into actual hostility he could insure his accomplices and adherents an entire impunity. A President of the Union, on the other hand, though he

may even pardon treason, when prosecuted in the ordinary course of law, could shelter no offender, in any degree, from the effects of impeachment and conviction. Would not the prospect of a total indemnity for all the preliminary steps be a greater temptation to undertake and persevere in an enterprise against the public liberty, than the mere prospect of an exemption from death and confiscation, if the final execution of the design, upon an actual appeal to arms, should miscarry? Would this last expectation have any influence at all, when the probability was computed, that the person who was to afford that exemption might himself be involved in the consequences of the measure, and might be incapacitated by his agency in it from affording the desired impunity? The better to judge of this matter, it will be necessary to recollect, that, by the proposed Constitution, the offense of treason is limited "to levying war upon the United States, and adhering to their enemies, giving them aid and comfort"; and that by the laws of New York it is confined within similar bounds.

Fourthly. The President can only adjourn the national legislature in the single case of disagreement about the time of adjournment. The British monarch may prorogue or even dissolve the Parliament. The governor of New York may also prorogue the legislature of this State for a limited time; a power which, in certain situations, may be employed to very important purposes.

The President is to have power, with the advice and consent of the Senate, to make treaties, provided two thirds of the senators present concur. The king of Great Britain is the sole and absolute representative of the nation in all foreign transactions. He can of his own accord make treaties of peace, commerce, alliance, and of every other description. It has been insinuated, that his authority in this respect is not conclusive, and that his conventions with foreign powers are subject to the revision, and stand in need of the ratification, of Parliament. But I believe this doctrine was never heard of, until it was broached upon the present occasion. Every jurist2 of that kingdom, and every other man acquainted with its Constitution, knows, as an established fact, that the prerogative of making treaties exists in the crown in its utomst plentitude; and that the compacts entered into by the royal authority have the most complete legal validity and perfection, independent of any other sanction. The Parliament, it is true, is sometimes seen employing itself in altering the existing laws to conform them to the stipulations in a new treaty; and this may have possibly given birth to the imagination, that its co-operation was necessary to the obligatory efficacy of the treaty. But this parliamentary interposition proceeds from a different cause: from the necessity of adjusting a most artificial and intricate system of revenue and commercial laws, to the changes made in them by the operation of the treaty; and of adapting new provisions and precautions to the new state of things, to keep the machine from running into disorder. In this respect, therefore, there is no comparison between the intended power of the

President and the actual power of the British sovereign. The one can perform alone what the other can do only with the concurrence of a branch of the legislature. It must be admitted, that, in this instance, the power of the federal Executive would exceed that of any State Executive. But this arises naturally from the sovereign power which relates to treaties. If the Confederacy were to be dissolved, it would become a question, whether the Executives of the several States were not solely invested with that delicate and important prerogative.

The President is also to be authorized to receive ambassadors and other public ministers. This, though it has been a rich theme of declamation, is more a matter of dignity than of authority. It is a circumstance which will be without consequence in the administration of the government; and it was far more convenient that it should be arranged in this manner, than that there should be a necessity of convening the legislature, or one of its branches, upon every arrival of a foreign minister, though it were merely to take the place of a departed predecessor.

The President is to nominate, and, WITH THE ADVICE AND CONSENT OF THE SENATE, to appoint ambassadors and other public ministers, judges of the Supreme Court, and in general all officers of the United States established by law, and whose appointments are not otherwise provided for by the Constitution. The king of Great Britain is

emphatically and truly styled the fountain of honor. He not only appoints to all offices, but can create offices. He can confer titles of nobility at pleasure; and has the disposal of an immense number of church preferments. There is evidently a great inferiority in the power of the President, in this particular, to that of the British king; nor is it equal to that of the governor of New York, if we are to interpret the meaning of the constitution of the State by the practice which has obtained under it. The power of appointment is with us lodged in a council, composed of the governor and four members of the Senate, chosen by the Assembly. The governor CLAIMS, and has frequently EXERCISED, the right of nomination, and is ENTITLED to a casting vote in the appointment. If he really has the right of nominating, his authority is in this respect equal to that of the President, and exceeds it in the article of the casting vote. In the national government, if the Senate should be divided, no appointment could be made; in the government of New York, if the council should be divided, the governor can turn the scale, and confirm his own nomination.3 If we compare the publicity which must necessarily attend the mode of appointment by the President and an entire branch of the national legislature, with the privacy in the mode of appointment by the governor of New York, closeted in a secret apartment with at most four, and frequently with only two persons; and if we at the same time consider how much more easy it must be to influence the small number of which a council of appointment consists, than the considerable number of which the national Senate would consist, we cannot

hesitate to pronounce that the power of the chief magistrate of this State, in the disposition of offices, must, in practice, be greatly superior to that of the Chief Magistrate of the Union.

Hence it appears that, except as to the concurrent authority of the President in the article of treaties, it would be difficult to determine whether that magistrate would, in the aggregate, possess more or less power than the Governor of New York. And it appears yet more unequivocally, that there is no pretense for the parallel which has been attempted between him and the king of Great Britain. But to render the contrast in this respect still more striking, it may be of use to throw the principal circumstances of dissimilitude into a closer group.

The President of the United States would be an officer elected by the people for FOUR years; the king of Great Britain is a perpetual and HEREDITARY prince. The one would be amenable to personal punishment and disgrace; the person of the other is sacred and inviolable. The one would have a QUALIFIED negative upon the acts of the legislative body; the other has an ABSOLUTE negative. The one would have a right to command the military and naval forces of the nation; the other, in addition to this right, possesses that of DECLARING war, and of RAISING and REGULATING fleets and armies by his own authority. The one would have a concurrent power with a branch of the legislature in the formation of

treaties; the other is the SOLE POSSESSOR of the power of making treaties. The one would have a like concurrent authority in appointing to offices; the other is the sole author of all appointments. The one can confer no privileges whatever; the other can make denizens of aliens, noblemen of commoners; can erect corporations with all the rights incident to corporate bodies. The one can prescribe no rules concerning the commerce or currency of the nation; the other is in several respects the arbiter of commerce, and in this capacity can establish markets and fairs, can regulate weights and measures, can lay embargoes for a limited time, can coin money, can authorize or prohibit the circulation of foreign coin. The one has no particle of spiritual jurisdiction; the other is the supreme head and governor of the national church! What answer shall we give to those who would persuade us that things so unlike resemble each other? The same that ought to be given to those who tell us that a government, the whole power of which would be in the hands of the elective and periodical servants of the people, is an aristocracy, a monarchy, and a despotism.

PUBLIUS.

Appendix D – Statutory Provisions and Federalist Papers

Patent Act of 1790

United States Statutes at Large/Volume 1/1st Congress/2nd Session/Chapter 7

< United States Statutes at Lar e I Volume 1 I 1st Con ress I 2nd Session

CHAP. VII.·An Act to promote the progress of useful Arts

SECTION 1. Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That upon the petition of any person or persons to the Secretary of State, the Secretary

for the department of war, and the Attorney General of the United States, setting forth, that he, she, or they, hath or have invented or discovered any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used, and praying that a patent may be granted therefor, it shall and may be lawful to and for the said Secretary of State, the Secretary for the department of war, and the Attorney General, or any two of them, if they shall deem the invention or discovery sufficiently useful and important, to cause letters patent to be made out in the name of the United States, to bear teste by the President of the United States, reciting the allegations and suggestions of the said petition, and describing the said invention or discovery, clearly, truly and fully, and thereupon granting to such petitioner or petitioners, his, her or their heirs, administrators or assigns for any term not exceeding fourteen years, the sole and exclusive right and liberty

of making, constructing, using and vending to others to be used, the said invention or discovery; which letters patent shall be delivered to the Attorney General of the United States to be examined, who shall, within fifteen days next after the delivery to him, if he shall find the same conformable to this Act, certify it to be so at the foot thereof, and present the letters patent so certified to the President, who shall cause the seal of the United States to be thereto affixed, and the same shall be good and available to the grantee or grantees by force of this act, to all and every intent and purpose herein contained, and shall be recorded in a book to be kept for that purpose in the office of the Secretary of State, and delivered to the patentee or his agent, and the delivery thereof shall be entered on the record and endorsed on the patent by the said Secretary at the time of granting the same.

SEC. 2. And be it further enacted, That the grantee or grantees of each patent shall, at the time of granting the same, deliver to the Secretary of State a specification in writing, containing a description, accompanied with drafts or models, and explanations and models (if the nature of the invention or discovery will admit of a model) of the thing or things, by him or them invented or discovered, and described as aforesaid, in the said patents; which specification shall be so particular, and said models so exact, as not only to distinguish the invention or discovery from other things before known and used, but also to enable a workman or other person skilled in the art or manufacture, whereof it is a branch, or wherewith it may be nearest connected, to make, construct, or use the same, to the end that the public may have the full

benefit thereof, after the expiration of the patent term; which specification shall be filed in the office of the said Secretary, and certified copies

thereof, shall be competent evidence in all courts and before all jurisdictions, where any matter or thing, touching or concerning such patent, right, or privilege, shall come in question.

SEC. 3. And be it further enacted, That upon the application of any person to the Secretary of State, for a copy of any such specification, and for permission to have similar model or models made, it shall be the duty of the Secretary to give such copy, and to permit the person so applying for a similar model or models, to take, or make, or cause the same to be taken or made, at the expense of such applicant.

SEC. 4. And be it further enacted, That if any person or persons shall devise, make, construct, use, employ, or vend within these United States, any art, manufacture, engine, machine or device, or any invention or improvement upon, or in any art, manufacture, engine, machine or device, the sole and exclusive right of which shall be so as aforesaid granted by patent to any person or persons, by virtue and in pursuance of this act, without the consent of the patentee or patentees, their executors, administrators or assigns, first had and obtained in writing, every person so offending, shall forfeit and pay to the said patentee or patentees, his, her or their executors, administrators or assigns such damages as shall be assessed by a jury, and moreover shall forfeit to the person aggrieved, the thing or things so devised, made, constructed, used, employed or vended,

contrary to the true intent of this act, which may be recovered in an action on the case founded on this act.

SEC. 5. And be it further enacted, That upon oath or affirmation made before the judge of the district court, where the defendant resides, that any patent which shall be issued in pursuance of this act, was obtained surreptitiously by, or upon false suggestion, and motion made to the said court, within one year after issuing the said patent, but not afterwards, it shall and may be lawful to and for the judge of the said district court, if the matter alleged shall appear to him to be sufficient, to grant a rule that the patentee or patentees, his, her, or their executors, administrators or assigns, show cause why process should not issue against him, her, or them, to repeal such patents; and if sufficient cause shall not be shown to the contrary, the rule shall be made absolute, and thereupon the said judge shall order process to be issued as aforesaid, against such patentee or patentees, his, her, or their executors, administrators, or assigns. And in case no sufficient cause shall be shown to the contrary, or if it shall appear that the patentee was not the first and true inventor or discoverer, judgment shall be rendered by such court for the repeal of such patent or patents; and if the party at whose complaint the process issued, shall have judgment given against him, he shall pay all such costs as the defendant shall be put to in defending the suit, to be taxed by the court, and recovered in such manner as costs expended by defendants, shall be recovered in due course oflaw.

SEC. 6. And be it further enacted, That in all actions to be brought by such patentee or patentees, his, her, or their executors, administrators or assigns, for any penalty incurred by virtue of this act, the said patents or specifications shall be primafacie evidence, that the said patentee or patentees was or were the first and true inventor or inventors, discoverer or discoverers of the thing so specified, and that the same is truly specified; but that nevertheless the defendant or defendants may plead the general issue, and give this act, and any special matter whereof notice in writing shall have been given to the plaintiff, or his attorney, thirty days before the trial, in evidence, tending to prove that the specification filed by the plaintiff does not contain the whole of the truth concerning his invention or discovery; or that it contains more than is necessary to produce the effect described; and if the concealment of part, or the addition of more than is necessary, shall appear to have been intended to mislead, or shall actually mislead the public, so as the effect described cannot be produced by the means specified, then, and in such cases, the verdict and judgment shall be for the defendant.

SEC. 7.And be it.further enacted, That such patentee as aforesaid, shall, before he receives his patent, pay the following fees to the several officers employed in making out and perfecting the same, to wit: For receiving and filing the petition, fifty cents; for filing specifications, per copy-sheet containing one hundred words, ten cents; for making out patent, two dollars; for affixing great seal, one dollar; for indorsing the day of delivering the same to the patentee, including all intermediate services, twenty cents.

APPROVED, April 10, 1790.

Appendix D – Statutory Provisions and Federalist Papers

Copyright Act of 1790

1 Statutes At Large, 124

An Act for the encouragement of learning, by securing the copies of maps, Charts, And books, to the authors and proprietors of such copies, during the times therein mentioned.

Section 1. Be it enacted by the Senate and House of Representatives of the United States of America in Congress assembled, That from and after the passing of this act, the author and authors of any map, chart, book or books already printed within these United States, being a citizen or citizens thereof, or resident within the same, his or their executors, administrators or assigns, who halt or have not transferred to any other person the copyright of such map, chart, book or books, share or shares thereof; and any other person or persons, being a citizen or citizens of these United States, or residents therein, his or their executors, administrators or assigns, who halt or have purchased or legally acquired the copyright of any such map, chart, book or books, in order to print, reprint, publish or vend the same, shall have the sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the term of fourteen years from the recording the title thereof in the clerk's office, as is herein after directed: And that the author and authors of any map, chart, book or books already made and composed, and not printed or published, or that shall hereafter be made and composed, being a citizen or citizens of these United States, or resident therein, and his or their executors, administrators or assigns, shall have the

sole right and liberty of printing, reprinting, publishing and vending such map, chart, book or books, for the like term of fourteen years from the time of recording the title thereof in the clerk's office as aforesaid. And if, at the expiration of the said term, the author or authors, or any of them, be living, and a citizen or citizens of these United States, or resident therein, the same exclusive right shall be continued to him or them, his or their executors, administrators or assigns, for the further term of fourteen years; Provided, He or they shall cause the title thereof to be a second time recorded and published in the same manner as is herein after directed, and that within six months before the expiration of the first term of fourteen years aforesaid.

Sec. 2 And be it further enacted, That if any other person or persons, from and after the recording the title of any map, chart, book or books, and publishing the same as aforesaid, and within the times limited and granted by this act, shall print, reprint, publish, or import, or cause to be printed, reprinted, published, or imported from any foreign Kingdom or State, any copy or copies of such map, chart, book or books, without the consent of the author or proprietor thereof, first had and obtained in writing, signed in the presence of two or more credible witnesses; or knowing the same to be so printed, reprinted, or imported, shall publish, sell, or expose to sale, or cause to be published, sold or exposed to sale, any copy of such map, chart, book or books, without such consent first had and obtained in writing as aforesaid, then such offender or offenders shall forfeit all and every sheet and sheets, being part of the same, or either of

them, to the author or proprietor of such map, chart, book or books, who shall forthwith destroy the same: And every such offender and offenders shall also forfeit and pay the sum of fifty cents for every sheet which shall be found in his or their possession, either printed or printing, published, imported or exposed to sale, contrary to the true intent and meaning of this act, the one moiety thereof to the author or proprietor of such map, chart, book or books, who shall sue for the same, and the other moiety thereof to and for the use of the United States, to be recovered by action of debt in any court of record in the United States, wherein the same is cognizable. Provided always, That such action be commenced within one year after the cause of action shall arise, and not afterwards.

Sec. 3 And be it further enacted, That no person shall be entitled to the benefit of this act, in cases where any map, chart, book or books, hath or have been already printed and published, unless he shall first deposit, and in all other cases, unless he shall before publication deposit a printed copy of the title of such map. chart, book or books, in the clerk's office of the district court where the author or proprietor shall reside: And the clerk of such court is hereby directed and required to record the same forthwith, in a book to be kept by him for that purpose, in the words following, (giving a copy thereof to the said author or proprietor, under the seal of the court, if he shall require the same)."District of to wit: Be it remembered, that on the day of

in the year of the independence of the United States of America, A. B. of the said district, hath

deposited in this office the title of a map, chart, book or books, (as the case may be) the right whereof he claims as author or proprietor. (as the case may be) in the words following to wit: [here insert the title] in conformity to the act of the Congress of the United States, intituled ' An act for the encouragement of learning, by securing the copies of maps, chart, and book, to the authors and proprietors of such copies, during the time therein mentioned.' C. D. clerk of the district of ." For which the said clerk shall be entitled to receive sixty cents from the said author or proprietor, and sixty cents for every copy under seal actually given to such author or proprietor as aforesaid. And such author or proprietor shall, within two months from the date thereof cause a copy of the said record to be published in one or more of the newpapers printed in the United States, for the space of four weeks.

Sec. 4 And be it further enacted, That the author or proprietor of any such map, chart, book or books, shall, within six months after the publishing thereof, deliver, or cause to be delivered to the Secretary of State a copy of the same, to be preserved

Sec. 5 And be it further enacted, That nothing in this act shall be construed to extend to prohibit the importation or vending, Reprinting or publishing within the United States, of any map, chart, book or books, written, printed, or published by any person not a citizen of the United States, in foreign parts or places without the jurisdiction of the United States.

Sec. 6 And be it further enacted, That any person or persons who shall print or publish and manuscript,

without the consent and approbation of the author or proprietor thereof, first had and obtained as aforesaid, (if such author or proprietor be a citizen of or resident in these United States) shall be liable to suffer and pay to the said author or proprietor all damages occasioned by such injury, to be recovered by a special action on the case founded upon this act, in any court having cognizance thereof.

Sec. 7 And be it further enacted, That if any person or persons shall be sued or prosecuted for any matter, act or thing done under or by virtue of this act, he or they may plead the general issue, and give the special matter in evidence.