

# Limitations Inherent in the Grant of Letters Patent

Albert R. Henry

Follow this and additional works at: <http://scholarship.law.cornell.edu/clr>

 Part of the [Law Commons](#)

---

### Recommended Citation

Albert R. Henry, *Limitations Inherent in the Grant of Letters Patent*, 27 Cornell L. Rev. 214 (1942)

Available at: <http://scholarship.law.cornell.edu/clr/vol27/iss2/5>

This Article is brought to you for free and open access by the Journals at Scholarship@Cornell Law: A Digital Repository. It has been accepted for inclusion in Cornell Law Review by an authorized administrator of Scholarship@Cornell Law: A Digital Repository. For more information, please contact [jmp8@cornell.edu](mailto:jmp8@cornell.edu).

# LIMITATIONS INHERENT IN THE GRANT OF LETTERS PATENT†

ALBERT R. HENRY

The doctrine of "limitation, inherent in the grant," as expounded in the *Motion Picture Patents* case,<sup>1</sup> the *Carbice* case,<sup>2</sup> and the *Barber Asphalt* case,<sup>3</sup> is susceptible of two interpretations. These may be called respectively a "claim construction" theory and a "use restriction" theory. The first, which seems to be generally accepted as that intended by the Supreme Court, has been permissibly questioned and criticized. The alternative hypothesis, while occasionally alluded to, has not been emphasized, although it appears to be simpler, more logical, and practically applicable. This paper will endeavor to present some considerations in its support.

## *Summary Review of Leading Cases*

The judgment in each of the three cases is in conflict with earlier case law precedents and, apparently, with what may be termed fundamental principles of patent law. Every patent, on its face, grants the exclusive right to make, use, and vend its invention for a limited term of years. Any unauthorized practice is considered to be an infringement of the patentee's right—a tort analogous to trespass on land. Thus, the infringer may appropriate the right without any color of license, or his wrong may flow from violation of a condition under which an original entry was sanctioned. He may be an actual maker, user, or seller of the whole invention, and therefore a direct infringer. He may, while personally standing clear of the patentee's domain, induce another to perform the unlawful act, and thereby be a contributory infringer. For infringement in any form the patentee's common remedy is by bill in equity, praying for an injunction and an accounting. If he can sustain the validity of his patent and prove the fact of unauthorized practice, he is, generally speaking, entitled to the relief prayed for.

In each of the leading cases, the Supreme Court accepted the patent as

---

†An article based upon a review of the legislative and case histories of the Sherman Act and Section 3 of the Clayton Act, and their relation to the patent law, supplemented by consideration of law journal commentaries. On this evidence, it is concluded that the "anti-trust law" supplies the true basis for an interpretation of the paper's title, and that such doctrine cannot be fully explained on any other basis.

<sup>1</sup>*Motion Picture Patents Co. v. Universal Film Mfg. Co.*, 243 U. S. 502, 37 Sup. Ct. 416 (1917).

<sup>2</sup>*Carbice Corp. v. American Patents Development Corp.*, 283 U. S. 27, 51 Sup. Ct. 334 (1931).

<sup>3</sup>*Leitch Mfg. Co. v. Barber Co.*, 302 U. S. 458, 58 Sup. Ct. 288 (1938).

valid, and found, on undisputed evidence, that the conduct of the defendants was in willful violation of the terms under which the patentee sanctioned use of the invention. Thus, the elements of the patentee's case having been established, the question is, by what warrant did the Court refuse to honor the grant?

In the *Motion Picture Patents* case, the patentee of a motion picture film projecting machine caused the machines to be sold for use in theaters. It affixed a notice to them restricting authorized use with films procured from certain parties, and warned the user that operation with other films would be an infringement. One user obtained films from an unlicensed source, and the patentee sued on the theory that the user was a direct infringer and that the film supplier was a contributory infringer. The film, as such, was not patented.

It would appear from the opinion that the Supreme Court conceived the patentee's case to be good if the notice was valid, but that the defendants were to be excused if the notice could be treated as non-existent. To continue the analogy, were the defendants trespassers because of condition broken, or were they still invitees because legally there was no notice? In developing the proposition that the notice was ineffective, the majority of Court considered the law under which patents are granted and the fact that the film itself was not patented, summing up as follows:

"Such a restriction is invalid because such a film is obviously not any part of the invention of the patent in suit; because it is an attempt, without statutory warrant, to continue the patent monopoly in this particular character of film after it has expired, and because to enforce it would be to create a monopoly in the manufacture and use of moving picture films, wholly outside of the patent in suit and of the patent law as we have interpreted it."<sup>4</sup>

The patent in the *Carbice* case was on a container adapted to receive solid carbon dioxide, or "dry ice," which, by evaporation, produced a refrigerating effect. The patentee attempted, by notice, to compel purchasers to buy the dry ice from its nominee, and sued to prevent another vendor from selling the commodity to users of the patented article. While the dry ice itself was not patented, it was included in the claims of the container patent as a material element. This latter circumstance was considered by the Court to be "without legal significance," and, by that summary disposition, the case was brought under the rule of the *Motion Picture* case. Again noting that the dry ice was not patented, the Court concluded:

---

<sup>4</sup>243 U. S. at 518.

"On that commodity they have not been granted a monopoly. Their attempt to secure one cannot be sanctioned."

In the *Barber* case the action was brought on a patent for curing concrete by coating it with a bituminous emulsion, again an old thing. One defendant sold such material to persons who, as it knew and intended, would thereupon practice the invention without any permission from, or compensation to, the patentee. In suing to protect its exclusive right, the patentee therefore followed precedent by joining as a defendant the party who made a multiplicity of trespasses possible. While the element of notice was missing, the Court again ruled this to be "without legal significance," and concluded that:

"every use of a patent as a means of obtaining a limited monopoly of unpatented material is prohibited. It applies whether the patent be for a machine, a product, or a process."

These excerpts constitute the foundation for the theory noted above as that generally accepted, and, withal, the basis for the criticisms and questionings which have appeared in the commentaries and lower court decisions.

#### *The Claim Construction Theory*

The claim construction theory may be stated thus:

Every letters patent, conveying an exclusive right to make, use, and vend, is inherently limited by the patent law to the subject matter claimed. A patentee who seeks to suppress conduct by another with respect to something not claimed—as, for example, the sale of an "unpatented" element for an infringing use—therefore attempts extension of his monopoly beyond the "limitation, inherent in the grant." Accordingly, the court cannot grant the relief prayed for.

It will not be necessary here to state all of the arguments advanced against the theory. Probably no one doubts its premise, for it is fundamental that an act of "infringement" must be established to warrant relief to the patentee. The objections are to the conclusion, and rightly so. It appears as an anomaly in equity jurisprudence. Equity, invoked to enjoin trespass, is concerned with the fact of damage to the plaintiff's property, and not his title to the means of inflicting injury. Accordingly, the presence or absence of a claim to the element generating the tort should be immaterial.

Apart from this or other objections to the legalistic logic, the claim construction theory presents practical problems. The trial of the issue made thereunder requires judicial construction of the patent and its claims—always a potential source of error—usually some consideration of the prior art, and injection of many of the other incidents of a technical patent suit. These factors can work to the patentee's advantage. He may hold the threat

of suit "in terrorem over the ignorant and the timid,"<sup>5</sup> and as persuasion to the prudent to the "purchase of peace."<sup>6</sup> Psychological suggestion and economic pressure may therefore gain for him his desired objective even though the judges are alert.

They have not, of course, always appeared to be so. Thus, the *Barber* case in substance seems to deny to a process patentee the right to sue a competing vendor abetting clear-cut infringement, because of the lack of a claim on the commodity itself. But in *Dovan Chemical Co. v. Corona Cord Tire Co.*,<sup>7</sup> the Supreme Court entertained an action on a process patent, wherein the patentee wished to attain a "limited monopoly" in sales of the essential element. Again, in *Smith v. Snow*,<sup>8</sup> decided after the *Carbice* case, which in turn was the authority for the *Barber* case, one finds a suit on a process claim, brought for the practical purpose of securing monopoly in the sales of apparatus (assumed not to be patented) required to operate the process. And the Supreme Court condemned the infringer for his conduct. It does not clarify to stress the concept of contributory, as distinguished from direct, infringement, for *American Lecithin Co. v. Warfield Co.*<sup>9</sup> turned on that point, and the Supreme Court denied certiorari.

Of course, if the patentee is fortunate enough to get a suitable claim from the Patent Office, the claim construction theory cannot be easily applied. Thus, *Basick Mfg. Co. v. R. M. Hollingshead Co.*<sup>10</sup> may be cited as such an instance, and the Supreme Court deemed it expedient to resort to "old combination" as a ground of invalidity. Unfortunately, some of the examiners have adopted that as a matter of substantive patent law, and the difficulties of prosecution have been proportionately increased.<sup>11</sup>

In a word, the claim construction theory, no matter how stated, makes the doctrine of "limitation, inherent in the grant" a thing of technical patent law, which may or may not be pertinent, depending upon the form of the patent and its claims. History shows its productivity of contention, litigation, and irreconcilable judgments. In common with all such doctrines, it hardly merits perpetuation.

<sup>5</sup>*Strauss v. Victor Talking Machine Co.*, 243 U. S. 490, 499, 37 Sup. Ct. 412 (1916).

<sup>6</sup>*Thropp's Sons Co. v. Seiberling*, 264 U. S. 320, 330, 44 Sup. Ct. 346 (1923).

<sup>7</sup>276 U. S. 358, 48 Sup. Ct. 380 (1928).

<sup>8</sup>294 U. S. 1, 55 Sup. Ct. 279 (1935).

<sup>9</sup>105 F. (2d) 207 (C. C. A. 7th 1939), *cert. denied*, 308 U. S. 609, 60 Sup. Ct. 171 (1939).

<sup>10</sup>298 U. S. 415, 56 Sup. Ct. 787 (1935).

<sup>11</sup>For consideration of this point, see Seegrist, *Old Combination* (1941) 23 J. PAT. OFF. SOC. 327. That the theory might be so circumvented was editorially noted, (1939) 21 J. PAT. OFF. SOC. 967. It is no secret that some examiners, as well as attorneys, look favorably on a claim to a process, drafted in "use-product" form, so as to relieve the patentee from the disability of the claim construction theory.

*The Use Restriction Theory*

The alternative hypothesis may be summarized thus:

Every patent conveys an exclusive right to make, use, and vend its claimed subject matter, which is personal to the patentee. For the protection of the personal right, equity has, and should exercise, the power to enjoin sales of commodities intended for an infringing purpose, whether or not they are patented. The patentee moreover has a right to share his invention with others, but the terms and conditions which he may impose on them are restricted by law. Whenever it is made to appear that the patentee seeks judicial sanction for any condition so prohibited, relief must be denied to him, for no court has power to countenance that which the law forbids.

There is no originality in this theory, for it has been stated by the Supreme Court on several occasions. Any apparent novelty in it may reside in recognition of its sufficiency as a separate and independent defense against the patentee, and its complete freedom from the complications of technical patent law. Presented as a plea by the alleged infringer, it focuses attention on the patentee's commercial purpose and practical object. If, for example, the patentee seeks security for his own enjoyment of his patented invention, his exclusive monopoly may be protected by enjoining a parts maker or vendor from contributing to infringement of the patent. If the patentee wants to impose a condition on some purchaser, lessee, or licensee, he may or may not have a right to do so. The questions are, what restraint would be imposed by the granting of the prayer, and, is such a restraint lawful? If unlawful, the prayer must be denied, irrespective of the form of the claims, the prior art, or any other consideration.

The terms and conditions desired by patentees for the enjoyment by others of their inventions frequently relate to the right of sale, the right of use, or both. Limitations on the patentee's right to impose restraints of this nature are dealt with to a limited degree by the Sherman Act, and to a greater and different extent by Section 3 of the Clayton Act. Because these are "anti-trust" laws, a serious impediment has existed to their universal understanding and application. An almost endless list of cases may be cited to show that the bill for patent infringement is *sui generis*, and, against it, "anti-trust law is no defense."

Accordingly, the fallacious belief has been entertained that while, perhaps, the legality of certain conduct can be challenged under these statutes, in an action *ex contractu* the patentee may foreclose that issue by laying jurisdiction under the "patent" law and treating his adversary as an "infringer." None of the sophistries of the patent law is less tenable. If the relief sought

by the patentee relying on his patent touches or affects an unlawful restraint, the "infringer" should be as free to raise that issue as would be the complaining or defaulting party to a formal contract.

Based upon the foregoing consideration, these conclusions seem justified: (1) the claim construction theory deserves to be discarded in its entirety, as a wholly unnecessary doctrine of law; (2) the courts might well reinstate to its former dignity the alternative theory, which is independent of the technical complications of patent law; that such alternative theory is consistent with those laws which, on the one hand, secure to inventors the benefits of patents as a means to encourage the advancement of the useful arts, and, on the other hand, seek to protect the public from unjust results flowing from such monopolies. The writer's "best evidence" originates in the statutory history of the two anti-trust laws noted above.

#### *The Limited Pertinence of the Sherman Act*

Horace R. Lamb, in "The Relation of the Patent Law to the Federal Anti-Trust Laws" states:<sup>12</sup>

"Frequently reference is made to a so-called conflict between the Sherman Act and the patent law. Such expressions indicate a failure to appreciate that the legal rights under the patent statutes constitute a valid exception to the prohibitions of the Sherman Act, to the same extent that letters-patent for new inventions were excepted in the ancient Statute of Monopolies. In the debates in the Senate on the Sherman Act, it was said by Senator Sherman:

"It is the unlawful combination, tested by rules of common law and human experience, that is aimed at by this bill, and not the lawful and useful combination. . . . *A limited monopoly, secured by a patent right, is an admitted exception.* For this is the only way by which the inventor can be paid for his invention.'

\* \* \*

"*A conflict arises only when the patent law and rights granted under it are used as a guise or device to conceal a combination which in its very nature violates the Sherman Act.* But this cannot be said to be a conflict of laws in any sense. It is nothing more than a stratagem to circumvent the law."

A review of the numerous cases decided by the Supreme Court in which a patent right and the statute have been involved indicates a reasonably close adherence to this analysis. Only a few will be recalled here as illustrative.

In *Bement v. National Harrow Co.*,<sup>13</sup> the patentee, exercising a right of election, sued a licensee for breach of an agreement providing for main-

<sup>12</sup>(1927) 12 CORNELL L. Q. 261, at 266, 273.

<sup>13</sup>186 U. S. 70, 22 Sup. Ct. 747 (1902).

tenance of the licensee's selling price and limitation of his manufacturing operations. The defense was that the agreement was illegal under the Sherman Act, and therefore unenforceable. In giving judgment for the patentee, the Court stated:

"Any one sued upon a contract may set up, as a defence, that it is a violation of an act of Congress.

"The object of the patent laws is monopoly, and the rule is with few exceptions, that any conditions which are not in their very nature illegal with regard to this kind of property, imposed by the patentee, and agreed to by the licensee for the right to manufacture or use or sell the article, will be upheld by the courts; and the fact that the conditions in the contracts keep up the monopoly, does not render them illegal."<sup>14</sup>

The Court observed also that a contrary "construction of the act we have no doubt was never contemplated by its framers."

*Henry v. A. B. Dick*<sup>15</sup> was an action for contributory infringement, in that the defendant had sold a can of unpatented ink for use in a patented mimeograph upon which the patentee had placed a notice restricting operation of the machine to operation with supplies procured from the patentee. This, of course, is the classical "tying clause" restraint. The ineffectiveness of the notice as a condition was assailed on principles of common law, and through the Sherman Act. The majority held:

"Although a contract in regard to use of a patent may include interstate commerce and restrain interstate trade, if it involves only the reasonable and legal conditions imposed under the patent law, it is not within the prohibitions of the Sherman Act."<sup>16</sup>

The Court went on to say:

"If the stipulation in an agreement between patentees and dealers in patented articles, which, among other things, fixed a price below which the patented articles should not be sold, would be a reasonable and valid condition, it must follow that any other reasonable stipulation, *not inherently violative of some substantive law*, imposed by a patentee as a part of a sale of a patented machine, would be equally valid and enforceable."<sup>17</sup>

The strong dissenting opinion, written by Mr. Chief Justice White, does not attempt to hold such a restriction illegal under the Sherman Act, but rather, in common with the majority opinion, casts about for some substantive law preventing the patentee from imposing such a contract and en-

---

<sup>14</sup>*Id.* at 91.

<sup>15</sup>224 U. S. 1, 32 Sup. Ct. 364 (1912).

<sup>16</sup>Headnote of 224 U. S. 1 at 3.

<sup>17</sup>*Id.* at 31. Italics added.



forcing it. It may be noted that in the two cases cited above, the "use restriction" theory is recognized, as is the congressional purpose underlying the anti-trust law. Here, however, was laid the foundation for the "claim construction" theory,<sup>18</sup> because, finding no general law which limited the right to impose the contractual restraint, the minority seized on the fact that the ink was not patented. It is unnecessary for the purpose of this paper to consider this case further with respect to the imposition of a restraint on a chattel, the complete legal title to which had passed to the user.

*United States v. United Shoe Machinery Co.*<sup>19</sup> was an action, instituted in 1911, for alleged violation of the Sherman Act, in that the defendant as patentee of certain machines leased them subject to a series of restrictive covenants. These, as the government contended, had led to an illegal monopoly. The Court, which in previous term had "overruled" the *Dick* case by its decision in the *Motion Picture Patents* case, nevertheless held such restraints lawful, saying:

"Of course, there is restraint in a patent. Its strength is in its restraint, the right to exclude others from the use of the invention, absolutely or on the terms the patentee chooses to impose. This strength is the compensation which the law grants for the exercise of invention. Its exertion within the field covered by the patent law is not an offense against the Anti-Trust Act."<sup>20</sup>

By way of contrast, reference may be made to *Strauss et al. v. Victor Talking Machine Co.*<sup>21</sup> The patentee wanted to maintain resale prices. The Macy Store violated the restrictive notice, or contract, affixed to the machines. While the opinion, holding the conditions non-enforceable, is not based squarely on their illegality under the Sherman Act, the record shows that this was the real factor in the case: the Messrs. Strauss forthwith sued the patentee for damages, because the patentee in attempting to impose the restraint had violated the Sherman Act, and a substantial judgment was allowed.<sup>22</sup>

It would thus appear that the Supreme Court, in this line of cases, has appreciated the existence of the "use restriction" theory and the inapplicability of the Sherman Act with respect to use restraints imposed by the patentee *on an immediate privity*. Its approval of the right so to contract appears in actions *ex contractu*, in tort, and in statutory proceedings instituted by the Department of Justice. Its willingness to permit the "infringer"

<sup>18</sup>See *id.* at 52, 53.

<sup>19</sup>247 U. S. 32, 38 Sup. Ct. 473 (1918).

<sup>20</sup>*Id.* at 57.

<sup>21</sup>243 U. S. 490, 37 Sup. Ct. 412 (1917).

<sup>22</sup>*Strauss v. Victor Talking Machine Co.*, 297 Fed. 791 (C. C. A. 2d 1924).

to plead "anti-trust" law is reflected by the *Strauss* case. Thus, while "anti-trust" law, if it be the Sherman Act, may not be a defense, that is because of its substantive limitation and not because it is invoked by an "infringer." If the infringer can show facts falling within the prohibitions of this law, no court should deprive him of the right to prove them.

The material difference between the effect of the Sherman Act and Section 3 of the Clayton Act may be determined by following a similar method of investigation.

### *Section 3 of the Clayton Act*

The Clayton Act of 1914 was designed and enacted as a supplement to the Sherman Act, and for the general purpose of prohibiting a variety of practices which, while apparently lawful under the earlier statute, were nevertheless deemed inimical to public welfare.<sup>22a</sup> Among such practices was the device known as "tying," which was condemned as "one of the greatest agencies and instrumentalities of monopoly ever devised by the brain of man." Tying, as then understood, is exemplified in part by the situations presented in the *Dick* and first *Shoe Machinery* cases—a manufacturer, armed with patents on machines, conditioned the use of such machines on the user's undertaking to buy supplies from the patentee alone. Tying was also understood to be possible even in some instances where the vendor did not have a patent. Section 3 (then numbered Section 4) was expressly directed to this practice.

The Section, as passed by the House, was subjected to three amendments before final enactment. A penal clause, making violation a misdemeanor, was eliminated. The phrase, "whether patented or unpatented," was added by the Senate Judiciary Committee, while the final clause was added in conference.<sup>23</sup> These amendments are italicized in the following quotation of the statute:<sup>24</sup>

"It shall be unlawful for any person engaged in commerce, in the course of such commerce, to lease, or make a sale or contract for sale of goods, wares, merchandise, machinery, supplies, or other commodities, *whether patented or unpatented*, for use, consumption, or resale within the United States or any Territory thereof or the District of Columbia or any insular possession or other place under the jurisdiction of the United States, or fix a price charged therefor, or discount from, or rebate upon, such price, on the condition, agreement, or understanding that the lessee or purchaser thereof shall not deal in the goods, wares, merchandise, machinery, supplies, or other commodities of a

---

<sup>22a</sup>H. R. REP. No. 627, May 6, 1914, reprinted in THORNTON, COMBINATIONS IN RESTRAINT OF TRADE.

<sup>23</sup>H. R. REP. No. 1168, 63d. Cong., 2d Sess. (Sept. 25, 1914).

<sup>24</sup>38 STAT. 731 (1914), 15 U. S. C. A. § 14 (1941).

competitor or competitors of the lessor or seller, *where the effect of such lease, sale, or contract for sale or such condition, agreement, or understanding may be to substantially lessen competition or tend to create a monopoly in any line of commerce.*"

*The Meaning of the Phrase "Whether Patented or Unpatented"*

The far-reaching significance of this phrase is made clear by reference to the debate in the Senate.<sup>25</sup> Beginning about page 14,088, one finds Senator Reed imploring his colleagues to enact the Section because the Supreme Court, in the *Dick* case, had stated: (a) that there was no existing law prohibiting tying under patent rights, and (b) that legislative intervention was necessary if the practice was to be outlawed. The Senator then assailed the practice, and, pointing out that the favorite method of enforcement was the suit for contributory infringement, cited the cases listed in the footnote.<sup>26</sup>

He said:

"Section 4 provided, in particular terms, I may say, against 'tying contracts', an infamous practice that has grown up since the decision of the cases I referred to the other day, by which a corporation having some patented article attaches to it a little notice to the effect that the man who uses the patented article shall buy certain other goods and certain other supplies exclusively from the man who sold the patented article. Section 4 covered that practice but was somewhat broader. It provided that a man could not make a sale and attach a condition to it compelling the purchaser to buy from him and him alone."<sup>27</sup>

A further quotation from the Record is of importance:

"Mr. Culberson: The Supreme Court in the *Dick* case, from which the Senator has been reading, held in effect that so far as the contract which was under consideration was concerned the patent law of the United States was superior to the Sherman antitrust law. What I want to know from the Senator is whether it would be more appropriate, and, in fact, absolutely necessary, in view of that decision, to amend the patent law rather than cover the question by a supplement to the Sherman antitrust law?"

"Mr. Reed: No, Mr. President, I cannot agree with the Senator in regard to that. It is, of course, true, and no one will dispute it, that in the enactment of this antitrust bill we can by substantive provisions

<sup>25</sup>51 CONG. REC., 63d Cong., 2d Sess., 1914.

<sup>26</sup>*Henry v. A. B. Dick*, 224 U. S. 1, 32 Sup. Ct. 364 (1912); *Crown Cork & Seal Co. of Baltimore City v. Brooklyn Stopper Co.*, 172 Fed. 225 (E. D. N. Y. 1909); *Aeolian Co. v. Harry H. Juelg Co.*, 155 Fed. 119 (C. C. A. 2d 1907); *Brodrick Copygraph Co. v. Roper*, 124 Fed. 1019 (D. R. I. 1903); *Cortelyou v. Carter's Ink Co.*, 118 Fed. 1022 (S. D. N. Y. 1902); *Cortelyou v. Lowe*, 111 Fed. 1005 (C. C. A. 2d 1901); *Tubular Rivet & Stud Co. v. O'Brien et al.*, 93 Fed. 200 (D. Mass. 1898); *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 Fed. 288 (C. C. A. 6th 1896).

<sup>27</sup>51 CONG. REC. at 14,226 (1914).

change any other law of the United States with reference to any subject. We do here, in Sec. 4, expressly limit the patent law, because we insert the language—and it was put in in our committee at the time we intended to report this section favorably—‘whether patented or unpatented’ so that with that phrase here we at once cut off at the roots any claim based upon the patent laws. . . .

“Mr. Reed: I have not the slightest doubt but that the Congress of the United States can pass a law at this time providing that no man who has a patent shall attach to the sale of the patented article any condition whatsoever. I have no doubt on earth but that Congress can today repeal every patent law there is on the books and end every patent at this moment. . . .

“Mr. White: What is the necessity of inserting the words ‘whether patented or not’. Do not the words ‘whether patented or not’ embrace all kinds of articles? If so, why encumber the amendment with this verbiage? All articles are either patented or not. I would be pleased if the Senator will give me his reason for using these words.

“Mr. Walsh: That was simply for greater clarity and definiteness. They were suggested by the decisions in two cases. In the Mimeograph case the articles tied to the patented articles were unpatented. They consisted of ink and paper with other articles of that character to be used in connection with the mimeograph. It is contended, however, in the Shoe Machinery Case,\* that they are permitted under any circumstances to tie several patented articles together. It was feared that if the language ‘whether patented or not’ was not in the amendment it would be contended that it was restricted in its application only to unpatented articles. It was for the purpose of making it clear that neither patented nor unpatented articles could be tied that the clause was inserted.”<sup>28</sup>

These statements need no extended exposition. The Supreme Court had declared that tying under patents was lawful. But tying was an abuse which had to go. The Congress, therefore, declared the practice unlawful and, with four little words, destroyed the means theretofore used to attain the end. It gave to the public and to the courts a substantive law which limited the right to make and enforce a certain type of contract. In so doing, it enacted one the operation of which should be free of theories, errors, or predilections in the Patent Office or the courtroom. A law which repeals the whole body of patent law makes any technical discussion pure surplusage.

It has been asserted, however—and apparently without appreciation of the meaning of this phrase—that since a patent conveys a monopoly the control of commerce in supplies, if merely co-extensive with the market created by the machine demand, is not illegal, but, in fact, is justified by the

---

\*Then pending in the lower court.  
<sup>28</sup>51 CONG. REC. at 14,094 and 14,275.

final proviso of the Section, which requires extraneous proof of the substantial lessening of competition.<sup>29</sup>

The contention goes to the heart of the Section and deserves critical analysis rather than disposition by mere conjecture or surmise, for it follows, if the argument is sound, that the effect of the final proviso is to nullify the first amendment with respect to the declared purpose of the phrase. One express purpose of the words "whether patented or unpatented" was to defeat that type of co-extensive tying found in the *Button-Fastener* case, and others. If, therefore, the final clause has the effect contended for, Section 3 rather than forbidding such practice actually legalizes it. Does the evidence show that the statute, as enacted, defeats its avowed purpose?

The answer here given is in the negative. For example, it was said in the House that no "rule of reason" should attach to the Clayton bill.<sup>30</sup> It appears that there were open advocates of machine tying under patent rights. They were in the minority.<sup>31</sup> There is not one item of evidence found by the writer to show that at any time did the Congress intend to give sanction to the rule of the *Button-Fastener* case, or to permit tying under patent rights to a limited extent but not quite as much as was sought by the *United Shoe*<sup>31a</sup> type of leases.

On the other hand, concern was repeatedly shown, even by proponents of Senator Reed's proposal, that in dealing with a condition having so many aspects, phraseology would be employed which at some future time would operate to impose unintended handicaps on those whose practices were not assailed.<sup>32</sup> For example, while the patentee was to be stripped of his patent, he was not, after that, to be treated as one worse than a man who never had a patent.

When these factors are duly weighed, a conclusion or interpretation can be stated which seems to be consistent with all the evidence of intent, as well as with the language of the Section itself. The phrase, "whether pat-

---

<sup>29</sup>See for example Peaslee, *The Effect of the Federal Anti-Trust Laws on Commerce in Patented and Copyrighted Articles* (1915) 28 HARV. L. REV. 394; Powell, *The Nature of a Patent Right* (1917) 17 COL. L. REV. 663; Comment, *Repudiation of Patent Protection by Extension of Section 3 of the Clayton Act* (1937) 40 YALE L. J. 954; Oberlin, *Patent License Contracts* (1941) 23 J. PAT. OFF. SOC. 98. Cases: *Westinghouse Elec. & Mfg. Co. v. Diamond State Fibre Co.*, 268 Fed. 121 (D. Del. 1920) [later questioned by Judge Morris, who wrote the opinion]; *Vulcan Mfg. Co. v. Maytag Co.*, 73 F. (2d) 136 (C. C. A. 8th 1934) (Clayton Act "construed" by Sherman Act cases); *G. S. Suppiger Co. v. Morton Salt Co.*, 117 F. (2d) 968 (C. C. A. 7th 1941) [same approach, here by a court which assumes to take judicial notice of the reasons leading to the law! Cf. *Swift & Co. v. Federal Trade Commission*, 8 F. (2d) 595 (C. C. A. 7th 1925)].

<sup>30</sup>51 CONG. REC. 9077 (1914).

<sup>31</sup>For an index to their efforts, see Comment (1931) 40 YALE L. J. 954, note 10.

<sup>31a</sup>*Supra* note 19.

<sup>32</sup>51 CONG. REC. 14,098, 14,264 (1914).

ented or unpatented," deprives the trader, even for jurisdictional purposes, of all patent rights presented to impose a tying clause. As against the patentee, the tendency to monopoly is conclusively presumed.<sup>33</sup> When the situation does not involve a patent right, evidence of the substantial lessening of competition may then be material in determining the legality or illegality of the agreement. The final proviso, in other words, modifies only the word "unpatented."

To those who cannot accept the concept of the patentee's purpose as an automatic repeal of the patent, a slightly different form of analysis may be more acceptable. Consider a normal trade situation, wherein the patentee's lessee of his own volition has contracted to buy from the lessor all his necessary supplies for a substantial period of time. Such an agreement is not unlawful, even though, after its execution, it imposes restraints on purchasers and eliminates competition for the period of its duration by removing the incentive of the purchaser to invite bids from competitors. Obviously, the term "restraint," as used in the anti-trust law, does not include those obligations which attach to a valid agreement, but connotes that element of compulsion which induces the purchaser to deal with a certain vendor, or those circumstances which limit the purchaser's choice, either in respect of number, price, or certainty.<sup>34</sup>

It is precisely at this point that the patent right enters. The threat of suit for infringement, whether openly stated or delicately suggested, definitely operates on purchasers and their potential vendors substantially to lessen competition by restraining the freedom to contract. And it is for this reason—so clearly understood in the Senate—that the presumption against the patentee is conclusive.

#### *Interpretation of the Phrase by the Supreme Court*

The Supreme Court has twice made an intelligent examination of this phrase, in *United Shoe Machinery Corp. v. United States*,<sup>35</sup> and *International Business Machines Corp. v. United States*.<sup>36</sup>

<sup>33</sup>The method of analysis intentionally forestalls bolstering the argument by citation of case law. But it may be noted that the Section is concerned only with relations between the parties named in it [*Curtis Publishing Co. v. Federal Trade Commission*, 270 Fed. 881, 904 (C. C. A. 3d 1921), *aff'd*, 260 U. S. 568, 43 Sup. Ct. 210 (1922)], and that the *quantum* of the monopoly is not controlling [*Fashion Originator's Guild of America v. Federal Trade Commission*, 114 F. (2d) 80 (C. C. A. 2d 1940), *aff'd*, 312 U. S. 457, 61 Sup. Ct. 703 (1941)].

<sup>34</sup>Is this not another reason for rejecting the claim construction theory, which seems to imply that the purchase contract is unlawful or in restraint of trade because the subject matter is not covered by patent claims? There is certainly a difference between the validity of the agreement, and the legality of the means by which it is induced.

<sup>35</sup>258 U. S. 451, 42 Sup. Ct. 363 (1921).

<sup>36</sup>298 U. S. 131, 56 Sup. Ct. 701 (1935).

In the second *Shoe Machinery* case, the government again attacked the validity of the United tying leases, charging that the same restraints found valid under the Sherman Act were unlawful under the Clayton Act. Relying on the later statute, the Court held the restrictive provisions illegal, and pointed out that the two laws "provide different tests of liability."<sup>37</sup> The Court also observed:

"The Clayton Act specifically applies to goods, wares, machinery, etc., whether '*patented or unpatented*'. This provision was inserted in the Clayton Act with the express purpose of preventing rights granted by letters patent from securing immunity from the inhibitions of the Act.

\* \* \*

"No matter how good the machines of the United Company may be, or how efficient its service, it is not at liberty to lease its machines upon conditions prohibited by a valid law of the United States. Congress has undertaken to deny the protection of patent rights to such covenants as come within the terms of the Clayton Act, and if the Statute is constitutional the sole duty of the Court is to enforce it in accordance with its terms."<sup>38</sup>

In reaching its judgment, the Court was fully advised of the purposes of the statute, and its history. The appellant's brief, in particular, referred in great detail to the legislative history, and, one may naturally assume, to every circumstance which tended to minimize the limiting effect of the law. In assailing the validity of the Section, it boldly charged:

"Section 3, so far as it applies to patents, is not in reality a regulation of commerce. It is a repeal of the patent law, over a wide area. It operates, not to regulate a use of property, but to destroy it."

\* \* \*

"The Government in substance contends that the Clayton Act has deprived the owner of a patent, even of a patent issuing prior to the passage of the Clayton Act, of the right to grant a limited license authorizing use of his patented article only in a certain manner.

"If the patentee is deprived of this right by the Clayton Act he is deprived of the very thing which has been granted under the patent law, viz., the right of an exclusive use."<sup>39</sup>

In affirming the decree below, the Court moreover affirmed this severable clause:

"forever restrained and enjoined from making a lease of their machinery . . . which in terms of like tenor or effect contain the following terms, clauses, and conditions. . . (c) The lessee shall also purchase from the

---

<sup>37</sup>258 U. S. at 459.

<sup>38</sup>*Id.* at 460, 462.

<sup>39</sup>Main brief of appellant at 448, and Reply brief at 28. Excerpts copied from the briefs as filed in the United States Supreme Court Library.

lessor exclusively, at the prices from time to time established by the lessor all supplies, including string nail, tack strips, and other fastening material used in connection with the leased machinery."

Having looked to the record,<sup>40</sup> the conclusion is obvious. In an action squarely presenting the relationship between Section 3 and the patentee's right to impose restraints, the Court held that the statute prohibited a restraint previously legal, and particularly the imposition of a supplies tying clause on a patented machine.

A short statement of the facts in the *International Business Machines* case may be permissible. I. B. M., and one other, practically control, by patents, complicated machinery which consumes large quantities of cards. These cards must be carefully made and formed. The government, as lessee, had signed a contract conditioning the use of the machines on (a) purchase of cards from the patentee, or (b) the payment of an additional royalty if procured elsewhere. It is to be noted that the "monopoly" over the card market was co-extensive with the monopoly asserted through the machine patents and was moreover independently protected by several patents on the cards. And finally, the restraint was imposed by exercise of a discount or rebate provision. The government, having executed the lease, sued to expugn from it the tying clause.

The Court held, in substance:

"While the section does not purport to curtail the patent monopoly of the lessor, the prohibition of tying clauses is not limited to unpatented supplies but includes also supplies which have been patented to the lessor either separately or in combination with the patented machines."<sup>40a</sup>

There can hardly be much discussion about this language, for, as the opinion shows, express citation is made to those parts of the Congressional Record declaring that all patent law stands repealed when invoked to impose a supplies tying clause. Whether the Court's attention to the Congressional Record was invited during argument or whether the reference was made of its own motion, the writer cannot say. The briefs do not make such reference. But, with the Record available, the Court interpreted the statute exactly as Senators Reed and Walsh had proposed.

#### *What Constitutes a Tying Clause?*

While the foregoing supports the view that there is no "patent law" available to impose a supplies tying clause on the purchaser or lessee of a

---

<sup>40</sup>As Mr. Justice Frankfurter invites us to do, in *Milk Wagon Drivers Union v. Meadowmoor Dairies*, 312 U. S. 287, 61 Sup. Ct. 552 (1941).

<sup>40a</sup>Headnote to the U. S. Report, 298 U. S. 131.



patented machine, there still remains the somewhat perplexing question: "When is a 'tying clause' lawful, and when is it illegal?" Apart from the field of patent law, there are numerous cases in which an attempted imposition of the restraint has been held unlawful, and other instances when it has not.<sup>41</sup>

Thus, in *Federal Trade Commission v. Sinclair Refining Co.*,<sup>42</sup> the Sinclair Company (and others similarly situated) had leased gasoline dispensing pumps to retail vendors subject to the condition that only the lessor's product would be sold from them. Again, in *Pick Mfg. Co. v. General Motors Co.*,<sup>43</sup> the condition was that authorized dealers would use genuine General Motors parts in making repairs on the vendor's automobiles. Both agreements were held lawful. These cases have been explained on the theory that the condition was necessary to preserve the manufacturer's good-will and to protect the public from "passing off,"<sup>44</sup> or, on the averment that there was no substantial lessening of competition in fact. These cases may also be considered as instances of agency contracts, which, as such, were not intended to be outlawed, as the House Report makes clear.

With particular reference to agreements bottomed on patents, there are two situations other than machine tying which deserve consideration. In one, exemplified by the *Dovan*, *Smith*, and *Barber* cases,<sup>44a</sup> the patentee of a pure process seeks to monopolize the sale, for the patented purpose, of the unpatented essential. The other is typified by the grant of a patent license to make and use or sell tangible commodities, coupled with an obligation to buy from the licensor some of the raw materials.

There is much sympathy for the pure process patentee. Many processes result from the discovery of new uses for old things, and, to make the invention beneficial to the public, it is necessary that it be used by many *in situ*. Instances range from highly technical factory use, as reflected by the *Dovan* case, to domestic processes typified by employing a grease solvent. Since an inventor cannot run from door to door, executing formal licenses with housewives, it is futile to talk of any such method of exploitation. The process patentee's method of exercising his exclusive right of sale is to sell the essential at so much per package, with directions for use; and if he is at the mercy of the cut-rate drug store, he has no effective patent at all.<sup>45</sup>

---

<sup>41</sup>For a painstaking summation of the cases, see Rose, *Federal Trade Commission: Enforcement of Section 3 of the Clayton Act* (1939) 8 GEO. WASH. L. REV. 639.

<sup>42</sup>261 U. S. 463, 43 Sup. Ct. 450 (1923).

<sup>43</sup>299 U. S. 3, 57 Sup. Ct. 1 (1936).

<sup>44</sup>*Cf.* 51 CONG. REC. 9409 (1914); *Carter Carburetor Co. v. Federal Trade Commission*, 112 F. (2d) 722 (C. C. A. 8th 1940).

<sup>44a</sup>*Supra* notes 7, 8, and 3.

<sup>45</sup>Legislative repeal of the *Barber* case has been advocated [(1941) 23 J. PAT. OFF. SOC. 723-725], but as worded the proposals seem to lose sight of the import of Section 3.

The right of a pure process patentee to monopolize the sale of an old thing solely for the purpose of practicing the invention can be argued to be both within and without the language of the Section. Yet an adverse application of the phraseology would also seem to imply that the patentee of a machine, article, or composition of matter likewise could not sell a specimen thereof with the understanding that if the user wanted another he must buy from the patentee. This, however, was clearly not intended by the Congress—the patent right was to remain in full force and effect—unless, of course, the patentee tried to tie one tangible to another tangible.

As far as statutory history is concerned, the evidence appears to favor the process patentee. Just as the machine patentee's ownership of a separate patent on supplies was made ineffective to impose the forbidden condition, so does the Record indicate that the process patentee should not be subjected to discrimination, because of the nature of his invention. Senator Reed, for example, appears to have referred but once to a patent on a "process," and then only inadvertently and in a non-technical sense. He meant, in fact, an "article" patent.<sup>46</sup>

There were pending, with the Clayton bill, a House bill,<sup>47</sup> and a Senate bill<sup>48</sup> offered by Senator Gore which were so phrased as to impose a limitation on process patentees. The Gore bill, in fact, was offered by Senator Walsh as a substitute for Section 3. Neither of these bills was enacted. The patent attorney, familiar with file-wrapper estoppels through claim cancellations, may draw an obvious inference from his circumstance.

It may, of course, be said that all this discussion is foreclosed by the decision in the *Barber* case. That presupposes (a) the Supreme Court has considered the subject from the viewpoint of the intent of the Clayton Act, and (b) the rule of *stare decisis* presents an insurmountable obstacle.<sup>49</sup> The simple fact is that the *Barber* case was briefed, and decided, on the authority of the *Carbice* case, and particularly on the emphasis therein on "unpatented" commodities. The distinction between a machine tying clause and the nature of a process patent, the immateriality of the patentability of the supplies (as found in the *I. B. M.* case), and the pertinence of Section 3 are all matters which seem to have been completely forgotten.

---

<sup>46</sup>51 CONG. REC. 14,093, 14,270 (1914).

<sup>47</sup>H. R. 1082, Aug. 12, 1914, "Revision of Patent Laws."

<sup>48</sup>51 CONG. REC. 14,098 (1914).

<sup>49</sup>"We recognize that *stare decisis* embodies an important social policy. It represents an element of continuity in law, and is rooted in the psychologic need to satisfy reasonable expectations. But *stare decisis* is a principle of policy and not a mechanical formula of adherence to the latest decision, however recent and questionable, when such adherence involves collision with a prior doctrine more embracing in its scope, intrinsically sounder, and verified by experience." Mr. Justice Frankfurter, in *Helvering v. Hallock*, 309 U. S. 106, 119, 60 Sup. Ct. 444 (1939). See also *U. S. v. Minnesota*, 113 F. (2d) 770, 774 (C. C. A. 8th 1940).

On the other hand, the fact that the patentee has a process patent should not, in itself, determine the legality of his object. Thus, in *Philad Co. v. Lechler Laboratories, Inc.*,<sup>50</sup> the suit was on a process patent, and the record indicates that by means of it the patentee hoped to impose a supplies tying clause on users of its machines covered by other patents. Relief was denied, and, in view of statutory history, properly so. But from a review of the transcript of the record and the briefs of counsel, it is quite apparent that the case was not presented as one under Section 3 (anti-trust law being no defense, etc.). Rather, it was decided, with some questioning, on the claim construction theory.

Some of the cases in Note 29, *supra*, as well as *Lord et al. v. Radio Corp. of America*,<sup>51</sup> illustrate another type of "tying clause" patent agreement. In these, the patentee grants a manufacturing license, but requires the licensee to buy supplies used therein from him. Thus, in the *Lord* case, there was a patent license in usual form, which included, as a separate covenant, the provision that the licensee would buy from R. C. A. the first set of tubes required to complete the assembly of the licensed radio sets.

While the licensor protested that because of its patents it had a right so to condition the licenses, it would seem, particularly from Judge Morris' opinion, that the court treated the agreement for the purchase of the tubes as an entirely separate and severable contract of sale, and one which, in fact, had led to a substantial lessening of competition. Finding that the sales contract, independently considered, was unlawful under Section 3, he ruled for the plaintiff, who was seeking rescission. The judgment appears to be fair.<sup>52</sup>

Unless the patentee of a pure process, seeking a modicum of financial reward by exclusive sales of the essential for his invention, is to be made a victim, and in fact an innocent victim, he must be differentiated from (a) the machine or article patentee attempting monopoly over necessary supplies, (b) the process patentee seeking to impose a forbidden and continuing condition on a machine use, and (c) the patentee who grants a license to make and use or sell a patented tangible, conditioned on the purchase of parts consumed in the manufacturing operation. The classification, of course, suggests the formula for rescuing the innocent process patentee from his present

<sup>50</sup>107 F. (2d) 747 (C. C. A. 2d 1939).

<sup>51</sup>24 F. (2d) 565 (D. Del. 1928), *aff'd*, 28 F. (2d) 257 (C. C. A. 3d 1928), *cert. denied*, 278 U. S. 648, 49 Sup. Ct. 83 (1928).

<sup>52</sup>The *Lord* case is analyzed in (1931) 1 J. RADIO L. 140, 375; (1928) 28 COL. L. REV. 828; (1931) 31 COL. L. REV. 743. See also (1935) 17 J. PAT. OFF. SOC. 685; Oxford Varnish Corp. v. Ault & Wiborg Corp., 83 F. (2d) 764 (C. C. A. 6th 1936); Steiner Sales Co. v. Schwartz Sales Co., 98 F. (2d) 999 (C. C. A. 10th 1938). (1929) 1 AIR L. REV. 132; (1931) 40 YALE L. J. 954.

plight. His claim to an exclusive right to control sales is based on his good faith, the intangible nature of his invention, and the circumstance that in conveying a right of use he is not attempting to superimpose on it a severable sales contract for some other commodity.

#### *The Motion Picture Patents and Carbice Cases*

There is necessarily some element of speculation in wondering why the Supreme Court decided these cases as it did. Each presented a clear-cut attempt, by the patentee, to impose a supplies tying clause on the user of a patented machine or article, and each therefore fell within the proscription of Section 3. The writer has his own view, which is that the Court was not fully advised of the materiality of the statute.

In the opinion of Mr. Justice Clarke, the total severability of technical patent law and contract law is purportedly recognized. A contract, at least so it has been said, is valid unless there is law making it illegal. The grant of a patent may, of course, provide the incentive for the contract, but that is no reason to hold that the resulting agreement, to be legal, must be co-extensive with the scope of the claims. Adoption of the claim construction theory may, therefore, be some evidence of a failure to understand the statute. And relegation of it to an obscure and unimportant position by both majority and minority is further evidence of this circumstance.

As the foregoing presentation has attempted to show, the Court in the *Motion Picture Patents* case was in reality without judicial power to consider the claim construction theory. The statutory law applicable to the facts of the case was one which declared a certain contract unlawful and repealed all patent law in such instance. There being no patent law, there was neither a patent nor jurisdiction to consider one; and hence what the Court really decided was directed to a moot proposition. Nevertheless, the opinion came down, and, generally speaking, it invited several unfortunate inferences.

These included the thought that the Clayton Act, as a statute, was relatively innocuous: that "anti-trust" law, including the Clayton Act was no defense in an infringement suit: and that the existence or non-existence of a patent on the supplies was of paramount importance. The inferences, as stated, were unfortunate, for there has been many a suit innocently prosecuted, and an agreement entered into, in complete violation of Section 3 since 1917.<sup>53</sup>

---

<sup>53</sup>The extent to which bench and bar were directed away from the Section may be illustrated by recalling that the Second Circuit Court of Appeals, which rested squarely on it in the *Motion Picture Patents* case, held for the patentee in the *Carbice* case, and, in the *Philad* case, commended to the patentee its asserted patents on the commodities as the means for attempting to monopolize the commerce in machine supplies!

Despite allusion to the statute, it seems improbable that the Court adequately considered it—an inference which is further not unsupported by review of the briefs.

The *Carbice* case shows lack of understanding on the face of the opinions. Thus, the initial opinion<sup>54</sup> strangely commingles patent, English, state, Sherman Act, and Clayton Act law, leaving one bewildered as to which is most pertinent. It is true that the petitioner's brief specifically invoked Section 3 as one point, and it is also true that this statement:

“But it may not exact as a condition of a license that unpatented materials used in connection with the invention shall be purchased only from the licensor. . . .”

was supported by citation of the second *Shoe Machinery* case. In the light of the intent, as recognized in the *I. B. M.* case, obviously the emphasis on “unpatented” was unwarranted. While one might, therefore, imply that the Clayton Act was the intended *ratio decidendi* of the *Carbice* case,<sup>55</sup> the foregoing factors, with subsequent events, detract from this view. For, on rehearing,<sup>56</sup> the Court felt called upon to examine the technical validity of the patent, because the patentee was threatening to sue the users directly, as a means of imposing the supplies tying clause.

The conclusion to be drawn is essentially one of fact. When the Supreme Court has considered Section 3 in the light of its history, as it did in the second *Shoe Machinery* case, and the *I. B. M.* case, it has applied it in accordance with its intent. When that statute has been relevant to the issue presented by a patent infringement action, it has entered judgments admitting of a less flattering observation. Congress clearly intended, as Senator Reed's remarks show, that the one statute should suffice for all justiciable controversies. The Court has, on occasion, observed that intent and invited attention to the evidence of it. The view herein expressed seems, therefore, to have some factual support.

### Conclusion

The decrees in the *Motion Picture Patents* case and the *Carbice* case appear proper in view of the purpose of Section 3 of the Clayton Act. The decree in the *Barber* case is questionable. None of these judgments can be fairly sustained on the claim construction theory.

That theory originated in an attempt, by the sheer exercise of judicial

<sup>54</sup>283 U. S. 27, 51 Sup. Ct. 334 (1931).

<sup>55</sup>Christy, *The Dry Ice Case* (1931) 13 J. PAT. OFF. SOC. 367-374. As far as the writer's search revealed, this was one of the first, if not the first, of the efforts to point out the relationship. See also (1931) 45 HARV. L. REV. 150.

<sup>56</sup>283 U. S. 420, 51 Sup. Ct. 496 (1931).

power, to correct a trade situation deemed intolerable. It was ultimately adopted as law in a case where, under the statutory law then applicable, the Court had been foreclosed from consideration of any technical patent question. Twenty years' experience has shown the theory to be unsatisfactory. It gives to the public less protection than Congress intended to provide; it denies to patentees, in other instances, that which may be their due. It is deserving of sentence as a ghost of the patent law to some limbo preventing it from continuing to cast its obscuring shadow.

There are laws, wholly independent of the laws under which patents are granted, construed, and their inventions weighed, which impose a "limitation, inherent in the grant." When applicable, they, and not technical patent law, represent the equitable balance between the litigants, and they, and not patent law, should be invoked. The concept underlying such law is to provide the patentee with a reward, and concurrently to protect the public from abuse of the privilege.

Obviously, the underlying philosophy of this paper differs from that of the extremists, one species of which would restore to the patentee his former power to impose abuses, and the other species of which would abrogate all patent grants lest in some way they be used to inflict a restraint that might be an abuse. The immediate criticism of the claim construction theory is intended as something more than a legal abstraction. It is practically intended as a demolition work to clear the ground for a more substantial structure. The reader must decide whether the project is worthwhile, and, if so, whether a reasonably sound engineering proposal has been offered.

---

#### ADDENDUM

*Patentee's purpose to subvert "public policy" as a bar to a suit for patent infringement: Morton Salt Company v. G. S. Suppiger Company,*<sup>57</sup> and *B. B. Chemical Company v. Ellis et al.*<sup>58</sup>

These cases, submitted and decided subsequent to the preparation of the foregoing article, appear to support the "use-restriction" theory as stated, but to make its application dependent upon a broad rule of public policy, which is taken to include the "unpatented commodity" aspect of the "claim-construction" theory. In the *Morton Salt* case, plaintiff sued for alleged infringement of a machine for dispensing salt tablets, and defendant successfully moved for summary judgment of dismissal upon discovering that the patentee leased its machines subject to a supplies tying clause. The court of appeals set aside

---

<sup>57</sup>62 Sup. Ct. 402, 10 U. S. L. WEEK 4126 (1942).

<sup>58</sup>62 Sup. Ct. 406, 10 U. S. L. WEEK 4128 (1942).

this judgment, relying on the co-extensive concept of the Clayton Act,<sup>59</sup> and its decree is now reversed by the Supreme Court. The *Ellis* case involved a process patent, and defendant showed that the patentee sold the necessary unpatented supplies for use in practicing the method. A judgment of dismissal entered below on the authority of the *Barber* case<sup>60</sup> is now affirmed.

The Court appears hesitant, in the *Morton Salt* case, to base its judgment squarely on the proposition that the patentee, having employed the patent to create tying lease contracts, was thereby divested of its patent right.<sup>61</sup> But it states: "respondent is making use of its patent monopoly to restrain competition in the marketing of unpatented articles, salt tablets, for use with the patented machines, and is aiding in the creation of a limited monopoly in the tablets not within that granted by the patent."<sup>62</sup> The Court then develops the proposition that equity may withhold relief "where the plaintiff is using the right asserted contrary to public interest," and observes:

"Where the patent is used as a means of restraining competition with the patentee's sale of an unpatented product, the successful prosecution of an infringement suit even against one who is not a competitor in such sale is a powerful aid to the maintenance of an attempted monopoly of the unpatented article, and is thus a contributing factor in thwarting the public policy underlying the grant of the patent. . . . It is the adverse effect upon the public interest of a successful infringement suit in conjunction with the patentee's course of conduct which disqualifies him to maintain the suit, regardless of whether the particular defendant has suffered from misuse of the patent. . . . The patentee . . . may not claim protection of his grant by the courts where it is being used to subvert that [public] policy."

In deciding the *Ellis* case, the Court was shown no cause to modify the reasoning of the *Barber* case, and, in resting upon it, there is a definite suggestion that the process patentee who also trades in essential materials must resort to a licensing plan of exploitation. These decisions present two questions which merit further examination.

First, the opinion in the *Morton Salt* case implies that the special defense is available to any infringer, even though he is unable to show any injury to himself from the alleged misuse of the patent. This pronouncement differs

<sup>59</sup>*Supra* note 29.

<sup>60</sup>*Supra* note 3.

<sup>61</sup>Acknowledgment is due counsel for the petitioners in both cases for supplying copies of the briefs. In the *Morton* case, petitioner stressed the unpatented nature of the tablets, and respondent urged that its leases were sanctioned by the opinion in the gasoline pump cases, *supra* note 42. Neither party in the *Ellis* case directly invoked the Clayton Act; respondent expressly asserted that it was not involved. Thus, neither case squarely presented the instant question.

from the statutory condition under which a private litigant may complain of a violation of anti-trust law—which law, of course, is “a most persuasive expression of public policy.”<sup>63</sup> The remedies of Sections 4 and 16 of the Clayton Act are available only to “any person who shall be injured” or confronted with “threatened loss or damage by a violation of the anti-trust laws.”<sup>64</sup> There are numerous cases which impose the same condition in the pleading of defenses.<sup>65</sup> Thus, the Court seems to have brushed aside a general rule relating to the injection of “anti-trust” law into suits between private parties, and to depute all infringers as special agents to investigate the patentee’s trade affairs. This may have far-reaching repercussions, particularly against manufacturing patentees who habitually and naturally sell accessories and raw materials. From this aspect, therefore, the pronouncement appears to be too broad.

On the other hand, the statement is defensible with respect to the particular case, by regarding Section 3 as a “repeal [of] every patent law there is on the books” which becomes effective as soon as the patentee attempts to enter into forbidden tying clause leases. The question of personal injury to the defendant then is immaterial, since his defense, in reality, denies the legal existence of the patent. So viewed, the Section may be considered equally applicable to both intrastate and interstate commerce.<sup>66</sup> This reasoning, however, does not appear on the face of the opinion.

*Second*, the Court adheres to the concept of the unpatented nature of the commodity over which some control is sought as the test for determining circumvention of public policy. It is pure reiteration to say that the very phrase, “whether patented or unpatented,” is the negation of any such standard and is ample evidence that some other was intended by the Congress. As long as this criterion is employed, however, it appears that the most essen-

---

<sup>62</sup>If the word “unpatented” were stricken and there were added the phrase “by reason of the effect of Section 3 of the Clayton Act,” this sentence would fully accord with the main thesis presented above.

<sup>63</sup>Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U. S. 502, 517, 37 Sup. Ct. 416 (1917).

<sup>64</sup>38 STAT. 731 (1914), 15 U. S. C. § 15; 38 STAT. 737 (1914), 15 U. S. C. § 26 (1941).

<sup>65</sup>*E.g.*, Connolly v. Union Sewer Pipe Co., 184 U. S. 540, 22 Sup. Ct. 432 (1902). The cases which held anti-trust law no defense to a patent suit—all now apparently disapproved—sometimes conceded that if the defendant could show “some equity *special to itself* and not *generally* a violation . . . then a defense based on such facts could be pleaded.” Radio Corp. of America v. Majestic Distributors, Inc., 53 F. (2d) 641 (D. Conn. 1931); *cf.* Comment (1932) 45 HARV. L. REV. 1118.

<sup>66</sup>The Supreme Court, in United Shoe Machinery Corp. v. United States, 258 U. S. 451, *supra* note 35, apparently found the power to enact Section 3 in the commerce clause, Art. I, § 8, cl. 3. But, as applied to patents, such power is also derived from Art. I, § 8, cl. 8, the patent clause; and it will be noted that the Section does not employ the word “interstate.”



tial attribute of the "public policy" underlying patents will be minimized, particularly with respect to process patentees who are also merchants; for the word "exclusive" is to be found in the Constitution,<sup>67</sup> and the "compulsory licensing" test of the *Barber* and *Ellis* cases operates to delete it. More, it may be said to enable the public to dictate the terms on which they will accept licenses; one may infer that one such term will be royalty-free. This could operate to eliminate processes from the specified fields of inventive effort,<sup>68</sup> and there seems to be no tenable authority for any such result. These cases, therefore, have a practical as well as a legal aspect.

---

<sup>67</sup>"The Congress shall have power . . . to promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." Art. I, § 8, cl. 8.

<sup>68</sup>"Arts" (processes), machines, manufactures, compositions of matter, and certain types of plants are expressly enumerated as patentable. 16 STAT. 201 (1870), 35 U. S. C. § 31 (1940).