

but in ten.¹⁵ The same court has also held that execution on a vendor's lien may be had at any time within ten years.¹⁶ The court in the principal case draws an analogy between special benefit judgments and mechanic's lien judgments in that they can only be liens against the particular property involved and that they are judgments *in rem*. The court held unanimously that since a lien for a judgment for special benefits runs for ten years, the same limitation should apply to a mechanic's lien judgment.

R. R. N., JR.

PATENTS — DIRECT INFRINGEMENT — DEFENSES — ATTEMPT OF PATENT OWNER TO ESTABLISH MONOPOLY OVER UNPATENTED MATERIAL BY MEANS OF PATENT — [United States].— Respondent (plaintiff in the lower court) patented machines for depositing salt tablets, used by the canning industry for flavoring canned foods. The machines were leased to canners, and the leases specified that the lessee should use only respondent's unpatented salt tablets in the leased machines. Respondent sought an injunction and an accounting for direct infringement of the patent by petitioner, a competitor in the salt business. Petitioner set up the defense that the condition in the leases was contrary to public policy and prohibited respondent from suing for infringement. *Held*, equity will not enjoin the infringement of a patent where the holder is using that patent to restrain trade or create a monopoly over and above that of the patent itself. *Morton Salt Co. v. G. S. Suppiger Co.*¹

The principal case makes explicit a limitation on the legitimate use of patents which may be implied from earlier decisions. A patent grants an exclusive right to make, use and vend the particular device described in the patent,² but it does not carry with it the right to a monopoly not within the grant.³ It is the general rule that courts, particularly courts of equity,

15. Gill, *op. cit.* supra note 9, at 636, §1421. *Boyd v. Ellis* (1891) 107 Mo. 394, 18 S. W. 29; *Fleckenstien v. Baxter* (1893) 114 Mo. 493, 21 S. W. 852; *George W. Watson v. The Keystone Iron Works Co.* (1904) 70 Kan. 43, 74 Pac. 269; *Moore v. Ogden* (1880) 35 Ohio St. 430; *Eyssel v. St. Louis* (1902) 168 Mo. 607, 68 S. W. 893; *City of St. Louis v. Annex Realty Co.* (1903) 175 Mo. 63, 74 S. W. 961, *Schwab v. City of St. Louis* (1925) 310 Mo. 116, 274 S. W. 1058; supra note 6, *Wayland v. Kansas City* (1928) 321 Mo. 654, 12 S. W. (2d) 438.

16. *Hockaday v. Lawther* (1885) 17 Mo. App. 636.

1. (1942) 62 S. Ct. 402, 86 L. Ed. 317.

2. These rights are sanctioned by the United States Constitution, Art. I, §8, cl. 8, which reads, "The Congress shall have power * * * (8) To promote the progress of science and the useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries." They are expressly provided for by statute (35 U. S. C. A. *passim*).

3. Strictly speaking, a patentee has no right to do anything under the patent grant, but only the right to exclude others from doing certain things. However, this is the language ordinarily used. *Interstate Circuit v. United States* (1939) 306 U. S. 208; *Ethyl Gasoline Corp. v. United States* (1940) 309 U. S. 436.

may withhold their aid where the plaintiff is using the right asserted contrary to the public interest.⁴ A restriction, either by notice⁵ or contract,⁶ upon the use of articles with a patented machine after its sale or in a patented process has been held not within the patent grant and void.⁷

4. *Beasley v. Texas and Pacific Ry. Co.* (1903) 191 U. S. 492, 497; *Central Kentucky Natural Gas Co. v. Railroad Comm'n* (1933) 290 U. S. 264, 270, 273; *Harrisonville v. W. S. Dickey Clay Mfg. Co.* (1933) 289 U. S. 334, 337, 338; *Virginian R. Co. v. System Federation* (1937) 300 U. S. 515, 552; *United States v. Morgan* (1939) 307 U. S. 183, 194; *Securities & Exchange Comm'n v. United States Realty Co.* (1940) 310 U. S. 434, 455.

5. *Motion Picture Patents Co. v. Universal Film Mfg. Co.* (1917) 243 U. S. 502, where plaintiff sold patented movie-projection machines with a notice specifying the film which could be used in the machine, *held*, infringement suit would not lie because of the restraining effect of the condition, and *Carbice Corp. v. American Patent Development Corp.* (1931) 283 U. S. 27, where respondent was not allowed to maintain suit for the infringement of a patent on a package for the use of solid carbon dioxide as a refrigerant for ice cream where the use was restricted to *Dry Ice*.

6. In the case of *International Business Machines Corp. v. United States* (1936) 298 U. S. 131, involving the sale of a tabulating machine with a contractual prohibition against the use of any cards but those put out by I. B. M., the defense was made that the cards had to be of a certain thickness, durability, etc., but was *held* unavailing, the court saying that the company might restrict the kind and quality of cards used, but it could not specify from whom they were to be bought. See also *American Lecithin Co. v. Warfield Co.* (C. C. A. 7, 1939) 105 F. (2d) 207, where plaintiff sold its patented process for preventing chocolate from "graying," but required that one essential ingredient, lecithin, an unpatented material, be purchased from plaintiff. It was *held* to be an unwarranted use of the patent right. In *Leitch Mfg. Co. v. Barber Co.* (1938) 302 U. S. 458, which concerned an attempt to control the sale of an ingredient in road-making by use of a process-patent for surfacing roads, the court restated the principle that where a patentee seeks to monopolize an unpatented article he loses his patent rights. Another case on the same order is *United Shoe Machinery Corp. v. United States* (1921) 258 U. S. 451, a case involving the so-called "tying clause," wherein a manufacturer seeks to compel the use of one article which is non-exclusive by tying its use to another article which is essential and monopolized.

7. MacCormack, in an interesting article on this subject in 31 Col. L. Rev. 743, explains this judicial tendency to restrict the extent of the patent grant by saying that the rights to use and dispose of the patented article have always been conceived as separate from all other rights in the article, and could remain in the patentee when all else was in another. He goes on to explain (p. 753), "The owner of a patent for a cigar lighter might, under this theory, walk up Broadway, depositing one of the patented articles upon each street corner and intending to relinquish ownership to the persons who would first pick them up; and yet if he made it clear by appropriate notices that he had no intention to grant any rights of use or sale, the finders could not lawfully exercise those rights. They might do anything with the articles except put them to the use for which they were intended, or sell them. They might destroy them, keep them as ornaments, or give them away. But if they lighted cigarettes with them or sold them, they would be infringers of the patent. As might be expected, *this theory came into conflict with a strong prejudice against restricting the free use and alienability of personal property and its implications were never accepted.*" (Italics ours.) By extending the theory a step further the court's attitude toward the present case may be understood.

The *lease* of an unpatented machine upon condition that a certain unpatented article be used with it⁸ has been upheld as not tending to restrain trade or create a monopoly.⁹ The present case, however, involves a patented machine, leased with a restriction as to its use. The distinction is all-important because the feature of a patent is its *exclusive* character. A patent, almost by definition, carries with it a need, and to compel the use of an unpatented article with the patented article or process would naturally bring about a limited monopoly.

The principal case is harsh in its effects upon the patentee, for as a result of it he is unable to bring suit even for direct infringement¹⁰ and thus is denied the value of his patent until he ceases the unfair practice,¹¹ but it is in accord with reason as well as law. Monopolies are frowned upon in our economic system, and to attach a penalty to their existence seems just and right.

R. S. S.

TORTS—FALSE IMPRISONMENT—INSTRUCTIONS—IMPRISONMENT PRIOR TO RETURN OF GOODS WRONGFULLY TAKEN—[Missouri].—Plaintiff's sister-in-law falsely claimed to be the wife of one A. F. Foster and charged goods to his account at defendant's department store. The store detective who knew the real Mrs. Foster became suspicious and detained plaintiff and her sister-in-law. An investigation was made, in the course of which Mr. Foster was called on the telephone. He denied any acquaintance with the women and they were not allowed to talk to him. They were questioned sharply and duress was used to compel them to admit having made the purchase upon the credit of an innocent third party. Some packages had

8. Federal Trade Comm'n v. Sinclair Ref. Co. (1923) 26 U. S. 463, where defendant had leased unpatented gasoline pumps upon condition that only Sinclair gasoline be used in them, the court *held* that there was no showing of an unfair trade practice since there was no restraint upon the purchase and sale of competing gasoline (so long as other pumps were used). The distinction between this and the principal case is that in the principal case the lease made a restraint upon the purchase of competing salt tablets (since other machines could not be obtained).

9. This is in accordance with the contract theory as to contracts which are not in restraint of trade. See 5 Williston, *Contracts* (2d ed. 1938) §1642, p. 4602.

10. Many of the previous cases dealt with *contributory* infringement, where the sale of unpatented materials used with a patented machine or in a patented process was sought to be enjoined, whereas this case deals with *direct* infringement by the manufacture of the very thing covered by the patent.

11. In *B. B. Chemical Co. v. Ellis* (1942) 62 S. Ct. 406, 86 L. Ed. 320, a case similar to the principal one and decided the same day, the court said, " * * * petitioner suggests it is entitled to relief because it is now willing to give unconditional licenses to manufacturers on a royalty basis, which it offers to do. It will be appropriate to consider petitioner's right to relief when it is able to show that it has fully abandoned its present method of restraining competition in the sale of unpatented articles and that the consequences of that practice have been fully dissipated."