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Article

**The Misuse Defense and Intellectual
Property Litigation**

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I. THE NATURE OF MISUSE

1. Misuse is an affirmative defense that an alleged patent infringer can assert in a lawsuit.¹ Misuse renders intellectual property rights unenforceable when the right holder extends the scope of his rights through tying or practices that violate antitrust laws.² The defense is not necessarily coextensive with an antitrust claim and does not lead to affirmative relief. It is nevertheless extremely important to patent owners and their adversaries because it can render a patent unenforceable against the world, at least until the misuse is purged. It serves both as a licensee's defense to a suit under a license and as a defense to an infringement suit against an unlicensed infringer.

II. THE HISTORY OF MISUSE

A. *The Origins of the Doctrine*

2. Misuse originally served as a defense to contributory infringement suits brought by a patent owner who tied items used with a patented machine or process to the patent's license.³ The tie usually was included in the license agreement or stamped directly on the machine that was leased or sold. At the turn of the century, the courts upheld these restrictions and allowed patent owners to sue violators for infringement. The courts dismissed the arguments that tying was against public policy and violated the then recently enacted Sherman Antitrust Act.⁴
3. The Supreme Court's decision in *Henry v. A. B. Dick & Co.*⁵ represents the most famous expression of why courts allowed patent owners to obtain reward through tying. The Court sustained the tie of ink to the use of a patented mimeograph machine and reasoned that [h]ad he [the patentee] kept his invention to himself, no ink could have been sold by others for use upon machines embodying that invention. By selling it subject to the restriction he took nothing from others and in no wise restricted their legitimate market.⁶
4. Five years later, however, the Court overruled *A.B. Dick* in *Motion Picture Patent Co. v. Universal Film Mfg. Co.*⁷ The case involved the tie of film — the subject-matter of an expired patent — to the use of a patented component of a commercial film projector. The Supreme Court condemned tie-ins as substantially likely to lessen competition under the 1914 Clayton Act,⁸ signaling that it had decided *A. B. Dick* incorrectly. The Court held that a tie-in extended the legitimate

claims of a patent to items that were neither claimed nor capable of being claimed in a patent prosecution, and hence could not be legally enforced.

5. The Court reasoned that first, tie-ins turned patent owners into their own patent examiners, bypassing the system of close examination of claims. Second, tie-ins allowed patent owners to obtain *de facto* "monopolies" over non-patented claims by extending their patents to cover non-claimable items.
6. Misuse reached its zenith as a bar to patent infringement suits in the *Mercoïd* line of cases,⁹ decided in the 1940s. In the *Mercoïd* cases, the Court used sweeping language to severely limit remedies against contributory infringement in cases of misuse.¹⁰
7. The decisions alarmed the patent bar. Two years earlier, *Morton Salt Co. v. G.S. Suppinger Co.* held that misuse rendered a patent unenforceable against *anyone* — even an outright infringer not a party to the license — until the misuse was purged.¹¹ In *Morton Salt* the defendant, a competitor who allegedly copied the patent owner's machine, submitted to the court a contract with a tie-in between the patent owner and a licensee. He obtained summary judgment without demonstrating any of the traditional elements of an antitrust claim: market power, effect on the market, or injury to himself.¹² Misuse thus became a *per se* defense that an infringer could successfully use to escape all liability. In this respect it proved to be a real windfall for patent infringers.¹³

B. *Consequences of Misuse and the Question of Purge*

8. Once patent owners have had a full and fair opportunity to litigate the issue of misuse, *Blonder Tongue Labs. v. University of Illinois Found.* may preclude them from suing any subsequent infringers, until and unless they can prove that they purged the misuse.¹⁴ The only question the owners can still litigate is whether purge occurred since the original finding of misuse, either through abandonment and lapse of time,¹⁵ or because the patent owners took additional affirmative steps to cure the misuse.¹⁶ There are no set standards for determining when purge has occurred: the inquiry is highly fact-specific and depends largely on the court's view of the seriousness of the misuse.¹⁷ Once patent owners purge the misuse, they may only recover damages or royalties for the period post-purge.

C. Misuse and Tying

9. Misuse first developed as a defense in the area of tie-ins, but in 1952 Congress changed the law by adding section 271(d) to the Patent Act. Section 271(d) prevents a potential infringer from asserting as a defense that the owner misused the patent by tying, if the owner only tied an item that is a material part of the invention and that has no substantial independent uses (a non-staple).¹⁸ Congress enacted this statute to overrule the *Mercoïd* cases, but its language also affected those who tied staples such as the ink in *A.B. Dick* or salt in *Morton Salt*.
10. In 1988, Congress amended section 271(d) again at the urging of the patent bar, adding subsections (4) and (5). As amended, the statute establishes that tying constitutes misuse only if a patent owner has market power in a relevant market “in view of the circumstances.”¹⁹ The statute thus creates a market power standard comparable to, if perhaps looser than, that in an antitrust case; it may also allow the patent owner to adduce rule-of-reason type justifications and explanations for the alleged misuse of their patents.
11. At the time of the 1988 legislation, Congress rejected proposals to abolish all or most of the misuse doctrine in other contexts, and adhered to the rule in *Morton Salt* that a patent remains unenforceable until the patent owner purges the misuse.²⁰

D. Other Forms of Misuse

12. Other examples — not necessarily exhaustive — of misuse include the following:
13. 1. Total Sales Royalties: Insistence by a patent owner on royalties on total sales or conditioning payment of royalties on items not covered by the claims of the patent. The Department of Justice does not necessarily consider this practice illegal under antitrust law, although it did attack total sales royalties in the recent Microsoft decree.²¹ The Supreme Court, however, held in *Zenith Radio Corp. v Hazeltine Res., Inc.* that total sales royalties are illegal and constitute misuse.²² Although the requirements of section 271(d) do not apply to these royalties, under *Zenith-Hazeltine* the defendant must show that the patent owner coerced the defendant or conditioned the license on total sales royalties.²³
14. 2. Tie-outs: Agreements not to develop or market goods that compete with those of the patent owner. Both the Fourth and Ninth circuits consider such provisions to be *per se* misuse.²⁴ Recently a district court held that a tie-out is sufficiently similar to

a tie-in for section 271(d)'s proof of market power requirement to apply.²⁵ The Supreme Court has not ruled conclusively on this issue. The Federal Circuit would probably employ a rule-of-reason approach.²⁶

15. 3. Post-expiration Royalties: Royalties that continue to accrue after the patent expires. The Supreme Court in *Brulotte v. Thys Co.* held that post-expiration royalties were contrary to patent policy.²⁷ The Court in *Brulotte* simply refused to enforce the post-expiration royalties, rather than deny recovery of pre-expiration payments or apply the *Morton Salt* misuse rule. The lower courts are split on whether this practice constitutes a misuse that makes the patent unenforceable even before it expires.²⁸
16. 4. Post-Sale Non-Price Restrictions: Restrictions regarding territory, customers or price. The lower courts have often held these distribution restrictions to be misuse, although most of this law developed when such restraints were considered illegal *per se* as a matter of antitrust law under *United States v. Arnold, Schwinn & Co.*²⁹ Antitrust analysis has since changed, and courts use the rule of reason to determine whether vertical non-price restrictions violate anti-trust law.³⁰
17. Nevertheless, in *Mallinckrodt, Inc. v. Medipart, Inc.* the Federal Circuit held that conditions imposed at the time of sale on a patented item that restrict post-sale activities may be enforceable in a patent infringement action.³¹ Such conditions on the first sale do not constitute an extension of the patent or misuse unless the conditions are unrelated to the claims of the patent, unreasonable in scope, or "otherwise unjustified."³²
18. The law of misuse as it currently applies to post-sale, non-price distribution restraints is unclear but will probably be similar to the rule-of-reason treatment of such restraints under antitrust law.³³ Post-sale price restrictions, however, will probably continue to constitute *per se* misuse, just as they constitute *per se* antitrust violations. Finally, the Supreme Court in *United States v. General Electric Co.* used antitrust law to uphold price restrictions in a patent license where no sale was involved,³⁴ but later limited its holding to the circumstances in the case.³⁵
19. 5. Antitrust Violations: Use of the patent as an integral part of a scheme to violate antitrust law.³⁶ This is sometimes referred to as antitrust misuse, as opposed to extension-of-patent misuse. Proof of an antitrust violation involving the patent is required. It is extremely difficult to know how or when the patent owner can purge antitrust misuse.

20. 6. Copyright Misuse: Misuse has arisen under copyright law chiefly in circumstances of blockbooking,³⁷ tie-outs such as those involved in *Lasercomb Am., Inc. v. Reynolds*,³⁸ and certain forms of fraud or inequitable conduct before the Copyright Office.³⁹ The requirements of section 271(d), which apply only to patents, do not cover these forms of copyright misuse.

III. MISUSE AND LITIGATION

A. Practical Considerations

21. A well-founded misuse defense can have a profound effect on a suit for patent infringement. If the defendant asserts that the patent owner is misusing the patent, the defendant will be immune from suit, even if the conduct constituting misuse does not involve the defendant. Furthermore, once a patent owner has litigated the issue of misuse and lost, under *Blonder-Tongue* it may be precluded from suing for any subsequent patent infringement of the patent, at least for a considerable period of time, if not forever, unless the owner can establish purge.⁴⁰ The only question that remains to be litigated is whether purge occurred since the original finding of misuse, either through abandonment and lapse of time,⁴¹ or because the patent owner took additional affirmative curative steps.⁴² The determination of when purge has occurred is guided by no set standards, is extremely fact-specific, and depends largely on the court's view of the seriousness of the misuse.⁴³ When misuse is purged, damages or royalties can be recovered only for the period post-purge.
22. The law has changed in many ways since *Morton Salt*. Defendants now must show market power or effect on competition before some tie-ins or post-sales restrictions can qualify as misuse. Because, however, the standard for showing market power is lower in misuse cases than in antitrust actions,⁴⁴ it may be possible to resolve these cases quickly, either through summary judgment or an expedited trial procedure with the aid of expert testimony and limited discovery. Federal judges, already burdened by extensive trial dockets and reluctant to plumb the depths of a complicated new technology, might find a well-supported motion for summary judgment or separate trial quite attractive. Moreover, the fact that misuse is an equitable defense to be tried to the court, instead of the jury, should encourage judges to dispose of misuse actions quickly.
23. Even if asserting the misuse defense does not result in dismissal of the claim or an expedited trial, it may allow the defendant to use the discovery process to uncover

the patent owner's business practices.⁴⁵ This could give the defendant a tactical advantage, by delaying the proceedings and providing the defendant with the opportunity to discover additional affirmative claims. Furthermore, the defendant could cause a deposition witness and licensee to question the licensing practices of the patent owner, thereby gaining an ally in challenging the patent owner's licensing practices. This last possibility can be a two-edged sword since some deponents (whom the defendant may need to cultivate as customers) may resent the defendant's injecting them into the process and asking them difficult, perhaps even embarrassing, questions.

24. At worst, from a defendant's standpoint, conducting discovery will slow down the plaintiff's infringement action and postpone the trial date or preliminary injunction hearing. On the other hand, a misuse defense might raise enough questions about the patent owner's likelihood of success, the balance of hardships between the parties, or the public interest standard that the Federal Circuit will apply, to tip the balance against granting extensive interim relief to the patent owner. This applies in particular to preliminary injunction hearings, where the statutory presumption of patent validity does not apply.⁴⁶

B. Pleading Misuse or Lack Thereof

1. Pleading No Misuse

25. If a case presents a serious issue of potential misuse, counsel for both sides should address the defense and the factual and tactical questions it presents — proof of market power, establishing coercion or unreasonableness, lack of justification, and evidence of possible purge — seriously and sooner rather than later. The patent owner would like to eliminate this issue from the case once and for all. If the owner thinks it can prove lack of market power or lack of coercion, it could consider a motion to strike under Fed. R. Civ. P. 12(f) or for partial summary judgment under Fed. R. Civ. P. 56. The burden of proof on these motions is substantial, but courts sometimes grant them.⁴⁷ If nothing else, this strategy might limit the time spent in discovery, even if the court does not rule on the motion itself until close to trial or in a separate trial. If the misuse involves conduct that the patent owner has largely discontinued, the patent owner should raise the issue of purge in his motion for summary judgment motion.

2. Pleading Misuse

26. As mentioned above, the defendant should not only explore the basis for a misuse defense but also assert it early, in order to establish an adequate schedule for discovery. Misuse is an affirmative defense that the defendant must plead before the court, otherwise the defense will be deemed waived under Fed. R. Civ. P. 12. The courts have generally allowed defendants to amend their pleadings under Fed. R. Civ. P. 15, as long as this will not prejudice the plaintiff.⁴⁸ Indeed, one court even referred to the public interest in allowing such a defense to be asserted. Often, however, the defendant learns the facts pertinent to the defense only in the course of discovery. Moreover, not all courts are so understanding or so sympathetic toward the defense. Therefore, it is crucial to establish a schedule that will allow for adequate discovery.⁴⁹
27. *Bio-Rad Labs, Inc. v. Nicolet Instrument Corp* and *Senza-Gel Corp. v. Seiffhart* illustrate the lack of a common standard for misuse defenses.⁵⁰ In *Bio-Rad* the court held that the defendant waived his misuse claims because he did not specifically plead them until the eve of trial. In *Senza-Gel*, on the other hand, the court — purporting to apply Ninth Circuit standards — permitted the defendant to assert misuse after the trial.

C. Declaratory Judgment Actions

28. A potential infringer may also file for declaratory judgment if it thinks that it can successfully assert the misuse defense. The infringer must have a strong case, face a real threat of litigation and enforcement, and may not simply seek to gain an edge over the patent owner in ongoing license negotiations. The complaint may be followed by a prompt motion for summary judgment.⁵¹ This strategy reduces the risk of damages and the possibility that the court will declare the defendant to be a willful infringer.

D. Misuse Issues at Trial

29. The misuse defense is an equitable defense that raises interesting questions of separation of issues, trial tactics and judicial efficiency. The questions change depending on whether an infringement case is tried to a jury or to the court, as is explained below.

E. *Affirmative Defenses*

30. At any time until the close of the plaintiff's case the defendant may raise misuse as an affirmative defense, which the defendant bears the burden of proving. The defendant, however, may want to introduce the theme of misuse and even establish some elements of his defense through plaintiff's own witnesses. The plaintiff may use his witnesses to emphasize the value and importance of the patented invention for several purposes: (i) to help establish infringement; (ii) to lay the basis for substantial damages; or (iii) to help overcome an obviousness defense by establishing commercial success. The defendant in turn might try to cross-examine these same witnesses to establish the market power that the patent confers on the plaintiff, or plaintiff's ability to coerce licensees to agree to unfavorable terms because there are no substitutes available for his patents. This may be especially important if the defendant seeks to show that it is a party to overreaching license terms or that it has been refused a license except on such terms.
31. If the misuse defense accompanies an antitrust counterclaim, the plaintiff will probably have a good chance of bifurcating the trial on this issue and only dealing with it after the infringement case, although the decision whether to bifurcate is discretionary and fact-specific.⁵² If the defendant asserts a misuse defense without the antitrust counterclaim, on the other hand, it might have a better chance of trying all the issues simultaneously, or even obtaining discovery and a separate trial on the issue of misuse.⁵³
32. Historically, patent misuse claims, though equitable in nature, often have been tried to a jury along with the other issues in the case.⁵⁴ In *In re Yarn Processing* a district court held that the issue of purge was an equitable issue apart from infringement that the judge could try separately and prior to the jury trial on infringement.⁵⁵ The court determined that the factual issues were not so common that this procedure would frustrate the patent owner's right to a jury trial.
33. Recently, the Federal Circuit barred plaintiff's right to a jury trial on a different equitable defense that also renders a patent unenforceable: inequitable conduct in proceedings before the Patent Office to obtain the patent.⁵⁶ Although there appear to be no cases on point yet, it seems likely that the same logic would apply to the misuse defense. Thus, misuse is a defense that will probably not be tried by a jury in the future, absent consent or overlap with issues such as an antitrust counterclaim, which a jury may try.

34. These developments will have a significant effect on the dynamics of proof and should increase the likelihood of bifurcation, and in some cases early trial and disposition of the misuse defense.
35. Parties have essentially five procedural options:
 - (1) Try everything to the jury by consent under Fed. R. Civ. P. 39(c);
 - (2) Try misuse with the infringement case, in which case the judge, not the jury, makes the findings of fact on the misuse issues;⁵⁷
 - (3) Try the issues together, using the jury as an advisory body on the misuse issues;⁵⁸
 - (4) Try the misuse issue to the court before the infringement jury trial on the theory that there is little, if any, factual overlap between issues that would implicate jury trial rights, and the outcome may be dispositive;⁵⁹ or
 - (5) Try the misuse defense to the court after the jury trial, if necessary.
36. Generally, all these options except the last favor the defendant, although, as noted above, there may be cases in which the plaintiff itself might seek an expedited ruling to dispose of the misuse issues, or cases in which the defendant might prefer that the jury decide the facts and therefore consent to a jury trial.
37. Which option the defendant chooses depends on the type and complexity of the misuse claim and its relation — usually slight — to the factual issues in the infringement claim. If there is substantial overlap between the factual issues in the two claims, the patent owner will argue that the jury trial must proceed first, lest it prejudice its right to have the jury determine certain issues. This argument could, however, also lead to options two or three (joint trial with decision reserved to the judge), an outcome the patent owner might want to avoid.
38. A relatively simple extension-of-patent misuse issue, such as a total sales royalty or a tie-out, stands a much better chance of being tried first than an antitrust violation or a tying claim related to a substantial antitrust claim. In a suit on a license where the defendant tries to prove that the patent owner coerced it into the provisions that constitute misuse, the court might have to try the misuse claim either at the same time as or after the contract claim, in order to preserve the parties' right to a jury trial. Counsel must carefully weigh the opportunities and be alert not to waive inadvertently any procedural advantages that may be available.

F. *Misuse and Appeals*

39. The Federal Circuit now hears all appeals in patent infringement cases, but not necessarily cases to enforce a license.⁶⁰ The court has not looked favorably on the misuse defense, as evidenced in its decisions in *Windsurfing Int'l, Inc. v. AMF Corp.* and *Mallinckrodt*. In both cases the court indicated its reluctance to find misuse in any conduct that the Supreme Court has not already held to be either a misuse or the equivalent of an antitrust violation, unless the defendant can show that the condition is clearly unrelated to the subject of the patent and is unjustified or unreasonably restricts competition.⁶¹
40. When purely procedural issues arise in connection with misuse, the Federal Circuit applies the law of the regional circuit from which the case originates.⁶² Note that copyright cases or suits to enforce a license not involving an infringement claim are appealed to the regional federal circuit courts, assuming they are brought in federal court in the first place.

G. *Misuse and Settlement*

41. Parties who wish to settle a case with a substantial misuse issue instead of litigating it must also weigh their options carefully. Ideally, from the defendant's standpoint, the patent owner will drop the offending provision in the defendant's license (if that is the nature of the misuse) or, if the defendant is not directly affected by the provision, the patent owner will dismiss the case with prejudice or execute a covenant not to sue and release. Problems can arise in more complicated settlements, however, if the defendant drops its misuse attack in exchange for a license that allows it to practice the perhaps unenforceable patent — while precluding other competitors from doing the same — or if the license contains price, territorial, or customer restrictions.
42. Depending on the circumstances, the exclusionary license might be characterized in subsequent litigation as a conspiracy to enforce a patent known to be unenforceable or an attempt to monopolize the market if a large market share is involved. Courts may view as *per se* illegal license restrictions based on a misused and therefore unenforceable patent if, as is likely, the patent owner and the infringer are competitors or potential competitors.⁶³ This is not to say that all such settlement agreements are illegal or will lead to liability, but to caution parties to draft their terms with care and consider the relative risks and benefits of these terms. If the parties specifically include their settlement of the misuse issue in a

consent decree as well as in the settlement agreement, under the Federal Circuit' decision in *Foster v. Hallco Mfg. Co.* they should successfully bar relitigation of the misuse issue between themselves, although not by third parties.⁶⁴

IV. CONCLUSION

43. Misuse has become a more limited, more complicated defense to patent infringement than it used to be. But it is still a potent piece of ammunition in a licensee or infringer's arsenal, and it can still be a potential landmine for a patent owner licensing its patent.

ENDNOTES

- ¹ See, e.g., 35 U.S.C. § 271(d) (1988).
- ² D. CHISUM & M. JACOBS, UNDERSTANDING INTELLECTUAL PROPERTY LAW § 2B(4)(c) (1992).
- ³ See *DAWSON CHEM. CO. v. ROHM & HAAS CO.*, 448 U.S. 176 (1980); 5 D. CHISUM, PATENTS § 19.04[1] (1994); J. Diane Brinson, *Patent Misuse: Time for a Change*, 16 RUTGERS COMPUTER & TECH. L.J. 357, 363-64 (1990); Richard Calkins, *Patent Law: The Impact of the 1988 Patent Misuse Reform Act and Noerr-Pennington Doctrine on Misuse Defenses and Antitrust Counterclaims*, 38 DRAKE L. REV. 175, 180-85 (1988-89); James B. Kobak, Jr., *A Sensible Doctrine of Misuse for Intellectual Property Cases*, 2 ALB. L.J. SCI. & TECH. 1, 3-19 (1992); Jere M. Webb & Lawrence A. Locke, *Intellectual Property Misuse: Recent Developments in the Misuse Doctrine*, 71 J. PAT. [& TRADEMARK] OFF. SOC'Y 339 (1991).
- ⁴ *Leeds & Catlin Co. v. Victor Talking Mach. Co.*, 213 U.S. 325 (1909), *overruled by* *Mercoird Corp. v. Mid-Continent Inv. Co.*, 320 U.S. 661 (1944) (holding patent unenforceable); *Brown Saddle Co. v. Troxel*, 98 F. 620, 621 (C.C.D. Ohio 1899); *Heaton-Peninsular Button-Fastener Co. v. Eureka Specialty Co.*, 77 F. 288 (6th Cir. Mich. 1896); see generally CHISUM, *supra* note 3, § 19.04[1].
- ⁵ 224 U.S. 1 (1912).
- ⁶ *Id.* at 33.
- ⁷ 243 U.S. 502, 518 (1917).
- ⁸ 15 U.S.C. §§ 12-27 (1988 & Supp. V 1993).
- ⁹ *Mercoird*, 320 U.S. 661; *Mercoird Corp. v. Minneapolis-Honeywell Regulator Co.*, 320 U.S. 680 (1944) (sustaining antitrust liability).
- ¹⁰ *Mercoird*, 320 U.S. at 669 ("The result of this decision, together with those which have preceded it, is to limit substantially the doctrine of contributory infringement. What residuum may be left we need not stop to consider.").

- ¹¹ *Morton Salt Co. v. G.S. Suppinger Co.*, 314 U.S. 488 (1942); *B.B. Chem. Co. v. Ellis*, 314 U.S. 495 (1942) (companion case).
- ¹² *Morton Salt*, 314 U.S. at 493-94. See Robert J. Hoerner, *Licensing — In Theory and Practice: Patent Misuse*, 53 ANTITRUST L.J. 641 (1984).
- ¹³ See Brinson, *supra* note 3 at 360, labelling misuse the “super *per se* rule.”
- ¹⁴ *Blonder Tongue Labs v. University of Illinois Found.*, 402 U.S. 313 (1971); see *General Electro Music Corp. v. Samiele Music Corp.*, No. 93-1299 (Fed. Cir. Mar. 22, 1994) (applying the *Blonder-Tongue* rule to issues of unenforceability as well as invalidity, though not in a misuse context); see *Sanza-Gel Corp. v. Seiffhart*, 803 F.2d 661, 668 n.10 (Fed. Cir. 1986).
- ¹⁵ See *United States Gypsum Co. v. National Gypsum Co.*, 352 U.S. 457, 476 (1957); *B.B. Chem. Co. v. Ellis*, 314 U.S. 495, 498 (1942).
- ¹⁶ *Preformed Line Prods. Co. v. Fanner Mfg. Co.*, 328 F.2d 265, 279 (6th Cir. 1964), *cert. denied*, 379 U.S. 846 (1964).
- ¹⁷ *White Cap. Co. v. Owens-Illinois Glass Co.*, 203 F.2d 694 (6th Cir. 1953), *cert. denied*, 346 U.S. 876 (1953). The *White Cap* court held that where there was no proof the misuse had any detrimental effects, abandonment of the offending practice sufficed to purge and that abandonment could occur during the dependency of the infringement suit. Usually, however, something more needs to be shown. There appears to be no Federal Circuit law on what constitutes purge.
- ¹⁸ *Dawson Chem. Co. v. Rohm & Haas Co.*, 448 U.S. 176, 177 (1980).
- ¹⁹ For the history of this legislation and the possible meaning of the phrase “in view of the circumstances,” see Calkins, *supra* note 3; James B. Kobak, Jr., *The New Patent Misuse Law*, 71 J. PAT. & TRADEMARK OFF. SOC’Y 859 (1989); CHISUM, *supra* note 3, § 19.04[1] at 19-295, 19-297 (1994).
- ²⁰ See 134 CONG. REC. S17146-02 (daily ed. Oct. 21, 1988) (statement of Sen. DeConcini).
- ²¹ See *United States v. Microsoft Corp.*, 159 F.R.D. 318 (1995).
- ²² 395 U.S. 100 (1969).
- ²³ Compare *id.*, with *Automatic Radio Mfg. Co. v. Hazeltine Res., Inc.*, 339 U.S. 827 (1950); *overruled in part by Lear, Inc. v. Adkins*, 395 U.S. 653 (1969). Mandatory package licensing of non-blocking patents, dealt with in *Zenith*, may also constitute misuse, though this conduct is now covered by § 271(d)(5) and its market power requirement. See CHISUM, *supra* note 3, at § 19.04[3].
- ²⁴ *Lasercomb Am., Inc. v. Reynolds*, 911 F.2d 970, 979 (4th Cir. 1990) (finding copyright misuse as the licensor had included in the standard licensing agreement clauses which prohibited the licensee from creating “computer assisted die-making software” in competition with the licensor); *Berlenbach v. Anderson & Thompson Ski Co.*, 329 F.2d 782 (9th Cir. 1964), *cert. denied*, 379 U.S. 830 (1964) (finding patent misuse as the patentee had included in a standard sale agreement clauses which prohibited the sales agent from manufacturing or distributing competing “automatic releasing ski binding[s]”); *Compton v. Metal Prods., Inc.*, 453 F.2d 38, 44 (4th Cir. 1971), *cert. denied*, 406 U.S. 968 (1972); see also *Lyle Stewart v.*

Motrim, Inc., 192 U.S.P.Q. 410 (S.D. Ohio 1975). Some of the tie-out cases well illustrate the harshness and unpredictability of the misuse doctrine. In *Motrim* the tie-out provision was inserted into the contract by the licensee, not the patent owner; in *Lasercomb* there was testimony that the non-compete provision, though part of a standard form contract, was negotiable and had been stricken from several licenses (as well as never signed by the defendant).

²⁵ *In re Recombinant DNA Tech. Patent & Contract Litig.*, 850 F. Supp. 769 (S.D. Ind. 1994).

²⁶ See *Windsurfing Int'l, Inc. v. AMF Corp.*, 782 F.2d 995, 1001-2 (Fed. Cir. 1986), *cert. denied*, 477 U.S. 905 (1986).

²⁷ *Brulotte v. Thys Co.*, 379 U.S. 29 (1964).

²⁸ *Compare Agrashell, Inc. v. Hammons Prods. Co.*, 479 F.2d 269, 281-83 (8th Cir. 1973) *cert. denied*, 414 U.S. 1022 (1973) [*and*] *Rocform Corp. v. Acitelli-Standard Concrete Wall, Inc.*, 367 F.2d 678, 681 (6th Cir. 1966), *with* *Modrey v. American Gage & Mach. Co.*, 478 F.2d 470 (2d Cir. 1973) [*and*] *Atlas-Pacific Eng. Co. v. Geo. W. Ashlock Co.*, 339 F.2d 288, 289 n.1 (9th Cir. 1964), *cert. denied*, 482 U.S. 842 (1965). Clauses that prevent a licensee from challenging a licensed patent — so-called “no contest” clauses — are also unenforceable under *Lear, Inc. v. Adkins*, 395 U.S. 653 (1969), but have been held not to amount to a misuse. *Panther Pumps & Equip. Co. v. Hydrocraft, Inc.* 468 F.2d 225, 232 (7th Cir. 1972), *cert. denied*, 411 U.S. 965 (1973).

²⁹ *United States v. Arnold, Schwinn & Co.*, 388 U.S. 365 (1967), *overruled by* *Continental T.V., Inc. v. GTE Sylvania, Inc.*, 433 U.S. 36 (1977).

³⁰ *Continental*, 433 U.S. at 47-59.

³¹ *Mallinckrodt, Inc. v. Medipart, Inc.*, 976 F.2d 700, 709 (Fed. Cir. 1992).

³² The Federal Circuit has not defined what it means by “otherwise unjustified.”

³³ See *Windsurfing Int'l, Inc. v. AMF, Inc.* 782 F.2d 995 (Fed. Cir. 1986); *USM Corp. v. SPS Technologies, Inc.*, 694 F.2d 505, 511-12 (7th Cir. 1982), *cert. denied*, 462 U.S. 1107 (1983).

³⁴ *United States v. General Electric Co.*, 272 U.S. 476 (1926).

³⁵ *United States v. United States Gypsum Co.*, 333 U.S. 364, 400 (1948); *United States v. Line Material Co.*, 333 U.S. 287 (1948); *Newburgh Moire Co. v. Superior Moire Co.*, 237 F.2d 283 (3d Cir. 1956); *United States v. Vehicular Parking, Ltd.*, 54 F. Supp. 828 (D. Del. 1944).

³⁶ *Ansul Co. v. Uniroyal, Inc.*, 448 F.2d 872, 879-80 (2d Cir. 1971), *cert. denied*, 404 U.S. 1018 (1972).

³⁷ *M. Witmark & Sons v. Jensen*, 80 F. Supp. 843 (D. Minn. 1948), *aff'd sub nom. M. Witmark & Sons v. Berger Amusement Co.*, 177 F.2d 515 (8th Cir. 1949). In *United States v. Loew's Inc.*, 371 U.S. 38, 39-50 (1962), and *United States v. Paramount Pictures, Inc.*, 334 U.S. 131, 156-59 (1948), the Supreme Court held blockbooking illegal and enjoined it under the antitrust laws, finding it an extension of copyright, but neither case held that the practice was necessarily a misuse that would prevent an infringement suit against someone who, for example, simply copied and distributed a copyrighted film.

- ³⁸ 911 F.2d 970 (4th Cir. 1990); see *PRC Realty Sys. Inc. v. Nat'l Ass'n of Realtors*, No. 91-1143, 1992 U.S. App. LEXIS 18017 (4th Cir. Aug. 4, 1992).
- ³⁹ *E.g.*, *QAD, Inc. v. ALN Assoc., Inc.*, 770 F. Supp. 1261 (N.D. Ill. 1991).
- ⁴⁰ See *supra* notes 14-17 and accompanying text.
- ⁴¹ See *United States Gypsum Co. v. National Gypsum Co.*, 352 U.S. 457, 476 (1957); *B.B. Chem. Co. v. Ellis*, 314 U.S. 495, 498 (1942).
- ⁴² *Preformed Line Prods. Co. v. Fanner Mfg. Co.*, 328 F.2d 265, 279 (6th Cir. 1964), *cert. denied*, 379 U.S. 846 (1964).
- ⁴³ See *supra* note 17 and accompanying text.
- ⁴⁴ Compare *Robintech, Inc. v. Chemidus Wavin, Ltd.*, 628 F.2d 142 (D.C. Cir. 1980) with *United States v. Studiengesellschaft Kohle, m.b.H.*, 670 F.2d 1122 (D.C. Cir. 1981).
- ⁴⁵ See *Diamond Crystal Salt Co. v. Package Masters, Inc.*, 319 F. Supp. 911, 913 (D. Del. 1970).
- ⁴⁶ *A.E. Prods. Group v. California Supply, Inc.*, U.S.P.Q. 2d 1041, 1044 (Fed. Cir. 1993) (inequitable conduct); see *Nutrition 21 v. United States*, 930 F.2d 867 (Fed. Cir. 1991) (inequitable conduct); *Black & Decker, Inc. v. Hoover Serv. Ctr.*, 765 F. Supp. 1129, 1137 (D. Conn. 1991); *Multi-Tech Sys. v. Hayes Microprocessor Prods.*, 800 F. Supp. 825 (D. Minn. 1992).
- ⁴⁷ *Lucas Arts Ent. Co. v. Humongous Ent. Co.*, 815 F. Supp. 332 (N.D. Cal. 1993) (granting cross-motion for summary judgment striking the misuse defense).
- ⁴⁸ *In re Recombinant DNA Tech.*, 850 F. Supp. 769 (citing *Key Pharmaceuticals Inc. v. Lowey*, 373 F. Supp. 1190 (S.D.N.Y. 1974)).
- ⁴⁹ See *Congoleum Indus., Inc. v. Armstrong Cork Co.*, 319 F. Supp. 714, 717-18 (E.D. Pa. 1970) (denying defendant's motion to amend answer to plead patent misuse, where information providing basis for such a defense was available for extensive period of time and where case would be delayed substantially); *Trio Process Corp. v. L. Goldstein's Sons, Inc.*, 461 F.2d 66, 74 (3d Cir. 1972), *cert. denied*, 409 U.S. 997 (1972) (holding that defendant waived the misuse defense by failing to assert the defense in answer); *CTS Corp. v. Alloys Unlimited, Inc.*, No. 69-C-1058, 1972 WL 607 (E.D.N.Y. July 13, 1972).
- ⁵⁰ Compare *Bio-Rad Labs, Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604, 617 (Fed. Cir. 1984) *cert. denied*, 469 U.S. 1038 (1984) with *Senza-Gel*, 803 F.2d at 671.
- ⁵¹ See Fed. R. Civ. P. 56(a). Often, a misuse declaratory judgment claim is asserted in conjunction with an affirmative antitrust claim.
- ⁵² For a summary of case law and discussion on this issue, see ABA, ANTITRUST SECTION, THE ANTITRUST COUNTERATTACK IN PATENT INFRINGEMENT LITIGATION 147-54 (1994) [hereinafter ANTITRUST COUNTERATTACK].
- ⁵³ See *In re Yarn Processing Patent Validity Litig.*, 472 F. Supp. 170 (S.D. Fla. 1979) (severing for separate trial the equitable issue of purge of misuse); *Western Elec. Co. v. Milgo Electronic Corp.*, 190 U.S.P.Q. 546, 550 (S.D. Fla. 1976).

⁵⁴ See *Bio-Rad Labs.*, 739 F.2d at 617 (finding waiver of any jury trial right on the issue under the circumstances after looking to Ninth Circuit law).

⁵⁵ *In re Yarn Processing*, 472 F. Supp. at 180.

⁵⁶ E.g., *Paragon Podiatry Lab., Inc. v. KLM Labs., Inc.*, 984 F.2d 1182, 1190 (Fed. Cir. 1993); *Gardco Mfg., Inc. v. Herst Lighting Co.*, 820 F.2d 1209, 1211-13 (Fed. Cir. 1987). See also *Burroughs Wellcome Co. v. Barr Labs. Inc.*, 828 F. Supp. 1200 (E.D.N.C. 1993); *Gentex Corp. v. Donnelly Corp.*, 26 U.S.P.Q. 2d 1558 (W.D. Mich. 1993).

⁵⁷ See *Burroughs Wellcome*, 828 F. Supp. 1200.

⁵⁸ See *Gentex*, 26 U.S.P.Q.2d. 1558.

⁵⁹ See *In re Yarn Processing*, 472 F. Supp. 170 (trying issue of purge before infringement).

⁶⁰ 28 U.S.C. § 1295(a)(1) (1993); see ANTITRUST COUNTERATTACK, *supra* note 52, at 201-07.

⁶¹ *Mallinckrodt, Inc. v. Medipart, Inc.*, 976 F.2d 700, 706-08 (Fed. Cir. 1992); *Windsurfing Int'l, Inc. v. AMF Corp.*, 782 F.2d 995, 1001-02 (Fed. Cir. 1986), *cert. denied*, 477 U.S. 905 (1986); see also *Hodosh v. Block Drug Co.*, 833 F.2d 1575 (Fed. Cir. 1987), *cert. denied*, 485 U.S. 1007 (1988).

⁶² See *Bio-Rad Labs., Inc. v. Nicolet Instrument Corp.*, 739 F.2d 604 (Fed. Cir. 1984), *cert. denied*, 469 U.S. 1038 (1984).

⁶³ See ANTITRUST COUNTERATTACK, *supra* note 52, at 87-88, 191-93.

⁶⁴ *Foster v. Hallco Mfg. Co.*, 947 F.2d 469 (Fed. Cir. 1991).