
Patents - Factual Application of the "Old Combination" Doctrine

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The four members of the court who formed the minority were joined by Justice White on one point of the case, thus becoming the majority as to this matter. The point was whether the contributory infringement section of the 1952 Patent Act required scienter on the part of alleged contributory infringers before they could be liable to inventors for their tort. That is, are the alleged contributory infringers required to have knowledge of the fact that the device for which they supply a component is both patented and infringed? The majority of the court found that this knowledge is required and thus held that ARO was not liable to Convertible until it was informed that the convertible tops for which it manufactured replacement fabric components were both patented and their product was infringing.²²

The majority's holding in regard to the reinstatement of the doctrine of contributory infringement returns to inventors a valuable tool in the struggle to protect their inventions, since it returns to them the right to proceed against a manufacturer who supplies the tools of infringement as opposed to the necessity of proceeding against multitudinous consumer-infringers. The requirement of knowledge of the existence of the patent and of the infringing use on the part of the contributory infringer will not limit this relief substantially, since in many cases it will not be difficult to prove such knowledge. Thus, it appears that the decision returns to patentee a substantial right, the existence of which has been in serious doubt ever since the *Mercoïd* case.

Michael O'Neil

²² *Id.* at 488, 141 U.S.P.Q. at 687.

PATENTS—FACTUAL APPLICATION OF THE “OLD COMBINATION” DOCTRINE

Holstensson and others brought action against the V-M Corporation for infringement of Holstensson's patent. The claim, in defining the scope of the monopoly granted to the inventor, covered the combination of a new and improved spindle or post for holding phonograph records with other components of the record changer. The defendant tried to raise the defense that the plaintiff's patent was invalid for patenting more than he had actually invented, which is referred to as the doctrine of “old combination.” At the trial, the defendant's expert demonstrated that the only novel portion of the record player was the spindle. A demonstration showed that the plaintiff's novel spindle could be employed in an old record changer, which had previously been patented by one Arvidius, apparently without any changes being made in the other com-

ponents of the record changer. Defendant therefore contended that the combination of the spindle with the other elements of the record changer was an old combination, and that the only novel element was the spindle per se. However, the district court held that the patent was valid and infringed.¹ The court of appeals reversed the lower court's decision on appeal, stating that, in view of the doctrine of old combination, Holstensson's patent was invalid. *Holstensson v. V-M Corporation*, 325 F.2d 109, 139 U.S.P.Q. 401 (6th Cir. 1963), cert. den. 377 U.S. 966 (1964).

It is well-established patent law that old elements or components well-known in the art may be included in a combination so as to bring about a new, useful, and unobvious result, thereby constituting a patentable invention; for example, old parts can be combined to make a patentable road-building machine.² This concept must be contrasted with the equally well-established doctrine of old combination wherein the improvement of only one element of a combination well-known in the art does not give rise to a patentable invention. To protect the improved element, the inventor must patent it per se rather than in a combination.³

The leading decisions of the Supreme Court on old combination are *Bassick Mfg. Co. v. R. M. Hollingshead Co.*⁴ and *Lincoln Eng. Co. v. Stewart Warner Corp.*⁵ In each case, an improved attachment for a grease gun was patented in combination with a grease gun that was well known in the art; and the defendants were manufacturers of similar grease guns. The Supreme Court held the patents to be invalid in each case on the grounds of old combination, because the only novel component in each combination was the attachment which coupled an ordinary grease gun to an automobile for supplying grease thereto. The Court in the *Lincoln* case stated that the attachment itself appeared to have been patentable, but the extension of the monopoly of the invention of the improved attachment to old parts having no new function when operated in connection with the attachment rendered the claimed patent void.

¹ 198 F. Supp. 779 (W.D. Mich. 1961).

² *Gibson-Steward Co. v. William Bros. Boiler and Mfg. Co.*, 264 F.2d 776, 120 U.S.P.Q. 352 (6th Cir. 1959). See also *In re Nelson & Parker*, 30 C.C.P.A. (Patents) 1257, 137 F.2d 106, 58 U.S.P.Q. 550 (1943).

³ *E.g.*, *Heyl & Patterson, Inc. v. McDowell Co.*, 317 F.2d 719, 137 U.S.P.Q. 620 (4th Cir. 1963) (apparatus for loading coal into ship's hold); *Bergman v. Aluminum Lock Shingle Corp. of America*, 251 F.2d 801, 116 U.S.P.Q. 32 (9th Cir. 1958) (novel drain slot in aluminum shingle).

⁴ 298 U.S. 415 (1936); *Landis Machinery Co. v. Chaso Tool Co.*, 141 F.2d 800, 61 U.S.P.Q. 164 (6th Cir. 1944).

⁵ 303 U.S. 545 (1938). See also *Sparton Corp. v. Evans Products Co.*, 293 F.2d 669, 130 U.S.P.Q. 387 (6th Cir. 1961).

The doctrine of old combination has not been totally accepted by the profession.⁶ Furthermore, the *Bassick* and *Lincoln* cases have been specifically criticized because other grounds for these decisions were available.⁷ However, it appears that the decisions were just, because clearly it would be inequitable to allow the defendant to pay damages for manufacturing and selling grease guns which were not invented by the patentee, and which functioned independently from the improved attachment. The law of old combination was perhaps the only practical means of reaching such a result. It appears that the doctrine of old combination, while quite simple in theory, has not been clearly defined by the courts with respect to the application of this doctrine to specific factual situations. This lack of a clear definition or test by which practitioners may be guided is the true problem, and it is not merely a question of finding other grounds for a decision. This note is written to explore the test which was created in the *Holstensson* case to handle specific factual situations under the doctrine. In effect, the test states that the doctrine applies where the improved element in the combination does not provide a new functional interdependence with the other elements of the combination and such improved element can readily be substituted for its corresponding old element without a substantial change in the combination.⁸ If so, the claim becomes invalid on the grounds that the invention was overclaimed, in which case, the claim can be restricted to the new element.

Applying this test to the grease gun cases, it can be seen that the improved attachment does not provide any new functional interdependence with the well-known grease gun, because the improved attachment was, in fact, interchangeable with old attachments. The substitution of an improved pressure seal for the old seal in an old valve constitutes an old combination under the *Holstensson* test and was so held;⁹ likewise, the substitution of a pressure-operated valve for an old mechanically operated valve was found to be an old combination.¹⁰ An improved anchoring device to prevent the movement of cargo in a freight car could not have

⁶ See e.g., 42 TEXAS L. REV. 929 (1964).

⁷ *Williams Mfg. Co. v. United Shoe Machinery Corp.*, 316 U.S. 364 (1942) (contributory infringement). See also *Forestek Plating and Mfg. Co. v. Knapp-Monarch Co.*, 106 F.2d 554, 43 U.S.P.Q. 39 (6th Cir. 1939).

⁸ *Holstensson v. V-M Corp.*, 325 F.2d 109, 118 (6th Cir. 1963): "the new spindle mechanism in no way changed the function or operation of the cycling mechanism and that the latter, as contained in the patent in suit, made no different contribution of function to record dropping than it had in the old Arvidius machine."

⁹ *Hobbs v. Wisconsin Power & Light Co.*, 250 F.2d 100, 115 U.S.P.Q. 371 (7th Cir. 1957).

¹⁰ *Anthony v. Ranco, Inc.*, 316 F.2d 509, 137 U.S.P.Q. 393 (5th Cir. 1963).

been patented in combination with the wall of the car, because there is no new functional interdependence between the new clamp and the wall and also the new clamp can be substituted for the old clamp;¹¹ likewise, this was true for a new fastener on an aluminum awning,¹² and for an improved clamp for the skeleton frame for batteries.¹³ The mere modification of one element of the combination to provide an increased efficiency or speed of the combination is an old combination,¹⁴ because the improved element still retains the same functional inter-relationship with the other old elements and the modified element is essentially interchangeable with a corresponding old element. Accordingly, there are many other decisions, each regarding a single improved element which fits this test.¹⁵ In addition, this test also applies to a patentable sub-combination which is combined with old elements where no new functional relationship is created between such a new component part and the remaining elements of the over-all combination,¹⁶ because the new sub-combination is substantially interchangeable with the old sub-combination.

An example of a patentable combination where the doctrine does not apply was an improved pivotal connector for an umbrella which was specifically designed to cooperate with the center stick, runner, spreaders and ribs of the umbrella,¹⁷ because the improved connector functioned in a new manner with the umbrella and was in no way interchangeable with the old connector. Also, a vegetable shredder with an improved blade was not an old combination because the new blade was not interchangeable with the old blades;¹⁸ and similarly an automatic machine

¹¹ *In re Hall*, 41 C.C.P.A. (Patents), 208 F.2d 370, 100 U.S.P.Q. 46 (1953).

¹² *B & M Corp. v. Koolvent Aluminum Awning Corp. of Indiana*, 156 F. Supp. 691, 116 U.S.P.Q. 9 (S.D. Ind. 1957).

¹³ *Mabe v. Howard & Lewis Motor Sales, Inc.*, 132 F.2d 40, 56 U.S.P.Q. 35 (1st Cir. 1943).

¹⁴ *Aetna Ball & Roller Bearing Co. v. Standard Unit Parts Corp.*, 198 F.2d 222, 94 U.S.P.Q. 129 (7th Cir. 1952) (reduction in size of one element); *Timken-Detroit Axle Co. v. Cleveland Steel Products Corp.*, 148 F.2d 267, 65 U.S.P.Q. 76 (6th Cir. 1945) (substitution of metal for ceramic in fuel burner).

¹⁵ *E.g.*, *Minneapolis-Moline Co. v. Massey-Harris Co.*, 107 F. Supp. 673, 95 U.S.P.Q. 252 (D. Minn. 1952) (self-propelled grain combine); *In re Lambert*, 35 C.C.P.A. (Patents) 839, 165 F.2d 441, 76 U.S.P.Q. 310 (1948) (speed governor with new switch to disconnect motor); *In re Avery*, 35 C.C.P.A. (Patents) 913, 166 F.2d 193, 76 U.S.P.Q. 120 (1943) (process claim); *In re Cook*, 30 C.C.P.A. (Patents) 935, 134 F.2d 494, 57 U.S.P.Q. 120 (1943) (mining drill coupler).

¹⁶ *In re Holt*, 34 C.C.P.A. (Patents) 1129, 161 F.2d 472, 74 U.S.P.Q. 155 (1947) (rotary abrasive drum in floor surfacing machine).

¹⁷ *In re Tibony*, 44 C.C.P.A. 801, 241 F.2d 953, 113 U.S.P.Q. 70 (1957).

¹⁸ *Zysset v. Popeil Bros., Inc.*, 276 F.2d 354, 125 U.S.P.Q. 152 (7th Cir. 1960), *cert. denied*, 364 U.S. 826 (1960).

for making wire scouring brushes which contained an improved device for supporting a pair of wires substantially parallel and adjacent to each other was not an old combination.¹⁹

To avoid overclaiming an invention where the novelty is situated in only one element of a combination but the improved element can merely be substituted for a corresponding old element without affecting the other elements in the combination, the following alternatives are available: (1) patenting the novel element per se²⁰ when such element is meaningful by itself, *i.e.*, without combining it with the other elements of the combination or (2) patenting the novel element only for use in a particular combination or environment,²¹ where such a novel element is not meaningful by itself and is difficult to describe without reference to the other elements of the combination. However, this latter method of claiming an invention must be used with discretion, because the environmental elements constitute part of the claimed invention as they are limitations in the claim,²² thus patenting the novel element per se may often be more appropriate.

Bernard Kleinke

¹⁹ American Technical Machinery Corp. v. Caparotta, 229 F. Supp. 479, 141 U.S.P.Q. 386 (E.D.N.Y. 1964).

²⁰ *Supra* note 3.

²¹ Ex parte Jepson, 1917 Dec. Com. Pat. 62, 243 O.G. Pat. Off. 525 (1917).

²² Ex parte Belcher, 58 U.S.P.Q. 34 (Pat. Off. Bd. App., 1942).

TAXATION—PUBLIC RECORDS DOCTRINE AS LIMITED BY TAXPAYER'S CONSTITUTIONAL RIGHTS

Brewer, a special agent for the Secretary of the Treasury (engaged in a tax examination), served a summons¹ upon Wild, as president of a corporation, to produce certain records² regarding the tax liability of Wild as an individual. Wild appeared but refused to come forth with

¹ The authority to issue summons is provided in INT. REV. CODE OF 1954, § 7602: "For the purpose of ascertaining correctness of any return . . . determining the liability of any person for any internal revenue tax . . . , the Secretary or his delegate is authorized—(1) to examine any books, papers, records, or other data which may be relevant or material to such inquiry . . ."

The agent's investigative authority is evidenced by his pocket commission, which is usually sufficient to obtain compliance with requests for records.

² Records required from the Air Conditioning Supply Co. were general ledger, books of original entry, subsidiary ledgers, sales invoices, bank statements with cancelled checks, minute book, and stock ledger.