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PATENTS, COPYRIGHTS AND TRADE SECRETS — DESTRUCTION OF INFRINGING INSTRUMENTS OWNED BY INFRINGER — Where a patent is infringed, it is safe to assume that the patenter can collect damages from the infringer as well as secure an accounting for profits and an injunction against further infringement. Any one of these forms of relief or of various combinations is usually granted as a matter of course. Such relief is also granted for infringement of trade secrets,

copyrights and literary property. Many courts believe that the problem is solved at this point. But two questions still remain: Does this relief give sufficient practical protection to the plaintiff? And, if not, can destruction of the tangible articles, which were produced in violation of the plaintiff's patent or other right, be decreed as further relief? It is the purpose of this article to indicate that the usual forms of relief named above sometimes fail to give adequate protection; that destruction of articles owned or controlled by the defendant is necessary; and that reason and authority show that such destruction can be compelled, by way of supplemental relief. Damages and an accounting for profits are designed to compensate the plaintiff for past infringements only. The injunction against further use is supposed to protect him from future infringement; but, where the defendant retains possession of infringing instruments, a mere order to refrain from using them is likely to be ineffective. It was said by one court¹ that,

"Enjoining a party therefore, from using or communicating the plaintiff's secret code or system, while effective so long as the defendants are within the jurisdiction of the court, would yet be of little efficacy in case defendants should go beyond the jurisdiction of the court and take with them the copy."

In addition, secret uses and sales are easily accomplished, and defendants in this type of case are not noted for their high standard of conduct in business, in morals, or in law.

The following examples bring out these points, namely that after courts clearly recognize the plaintiff's right, they sometimes overlook the problem of real relief; and that because of this failure under the circumstances of the case, the plaintiff's right is an empty one, interesting to lawyers but not helpful to plaintiff. In *Macbeth-Evans Glass Co. v. Schnellbach*² the defendant induced the plaintiff's plant superintendent to work for him, thereby breaching his contract with the plaintiff, and to reveal the plaintiff's secret process for producing a certain kind of glass very much in demand. Plaintiff was the only manufacturer who could make it successfully. The order of the court follows:

"They [defendants] are also enjoined from making and selling the same quality of glass by any other name, if the glass is made by using the essential ingredients of the secret formula. . . . They must not produce this particular quality of glass by making use of the secret formula protected by the decree, or by a practically similar process in which the essential ingredients of the

¹ *Simmons Hardware Co. v. Waibel*, 1 S. D. 488 at 496 (1891). See note 19 for a brief summary of the facts of this case.

² 239 Pa. 76, 86 A. 688 (1913).

formula are used; nor can they by indirection or by simulating the secret formula of appellee do that which the decree intends to forbid.”

It is clear that the court is thinking of the plaintiff's right and trying to protect it; for it goes so far as to specifically prohibit some ways in which that right could be violated. But how about the obvious way—that is, the large inventory of this kind of glass which the defendant had in his warehouse and of course under his complete control and which was in great demand? How could anyone stop surreptitious sales? It would be practical for the court to order this glass to be broken, destroying its market value, and allowing the defendant to make what use he could of the pieces, as junk.

Another example of this failure to mention destruction, let alone to use it as a means of relief, is furnished by *Tabor v. Hoffman*,³ a leading case establishing trade secrets as property. Here the defendant had patterns made from measurements secretly stolen from the plaintiff and used them to make parts for a pump. The parts themselves were not protected, but because of shrinkage in metals and allowance for expansion of working parts under varying temperatures, the size of the patterns differed from that of the parts and could only be determined by experiments and experience. The defendant had been enjoined from the use of these patterns by the lower court. The following reference is the only one made to the problem of a remedy: “We think that the patterns were a secret device that was not disclosed by the publication of the pump, and that the plaintiff was entitled to the preventive remedies of the court.” But delivery up of the patterns to be destroyed was not granted as might have been done. As the parts could be made from patterns resulting from the defendant's own experiments, how was it possible for the plaintiff to discover if the particular ones in question were being used, or if those patterns were used to make other patterns, claimed by the defendant to have been independently made? It is submitted that the court did not realize that it had a problem in regard to a remedy, but merely assumed that the usual and ordinary restraining injunction would do. The circumstances seem to cast doubt upon this assumption.⁴

It seems a far cry from the position outlined immediately above

³ 118 N. Y. 30 (1889) (quotation at page 37).

⁴ Other similar cases could be given, but they would add nothing, as those quoted serve to illustrate the point sufficiently. However, the following are particularly noteworthy examples. In *Elaterite Paint & Mfg. Co. v. S. E. Frost Co.*, 105 Minn. 239, 117 N. W. 388 (1908), the defendant retained a large inventory of paint made by the plaintiff's secret process. In *Oertel v. Wood*, 40 How. Prac. 10 (N. Y. 1870), the defendant made a number of reproductions of the plaintiff's unpublished painting and had been selling them.

to the view that destruction should be decreed every time it is requested. There are cases so holding which will be discussed in a succeeding paragraph, in particular *Betts v. De Vitre*.⁵ Between these extremes there are cases taking intermediate positions. Group one recognizes destruction as valuable relief in some cases but not in theirs; group two recognizes the inadequacy of the usual decree but attempts to get results by other means; the third group applies the destruction doctrine because the unusual circumstances of the case demand it. While the decisions of groups one and two cannot be cited as authority for the proposition that destruction is available as an outlined legal doctrine, many valuable dicta are found and cogent analogies can be drawn. The following language from *American Bell Tel. Co. v. Kitsell*⁶ is self-explanatory.

“It is common in England to include such a provision as is asked for in the decree. . . . In this country the common injunction against making, vending, or using the infringing article has generally been found ample to protect the owner of a patent-right; and it is not desirable to put in motion any of the extraordinary machinery of the court to attain ends which its simple and familiar process is fully adequate to accomplish. If it appeared that the defendant had *mala fide* and clandestinely set about to appropriate the invention patented, or if it appeared probable from his conduct in the past that he would attempt to use the infringing article in the future, or even if there were any peculiar circumstances to indicate that the infringing telephonic instruments could be readily used surreptitiously to the injury of the complainant, the exceptional decree sought might be granted. As nothing of the kind appears, the complainant must be content with the remedy given to ordinary suitors.”⁷

Although the question is by no means settled, there are many cases granting a type of affirmative relief under the following circumstances, which furnish a close analogy to the granting of destruction of infringing instruments. These cases permanently enjoin a former employee

⁵ 34 L. J. N. S. 289 (Ch. 1865), discussed at note 12, *infra*.

⁶ (C. C. N. Y. 1888) 35 F. 521 at 523-524.

⁷ Other cases containing similar dicta, but refusing relief for similar reasons, that is, that it was unnecessary, are *Merryweather v. Moore*, [1892] 2 Ch. 518, and *American Carmel Co. v. Thomas Mills & Bro.*, (C. C. A. 3d, 1907) 162 F. 147. Compare *Birdsell v. Shaliol*, 112 U. S. 485, 5 S. Ct. 244 (1884), which is quoted at note 15, *infra*.

Relief was refused but the destruction doctrine expressly approved in *Needham v. Oxley*, 8 L. T. N. S. 604 (1863), where the patent covered a combination. Therefore the separate parts, as they were not protected as such, could be used for other purposes. Incidentally, this seems to be the earliest case mentioning the doctrine.

of the plaintiff from any solicitation of customers on routes over which he drove the plaintiff's delivery trucks and is now trying to secure this custom for a rival. In these cases the courts recognize such custom as sufficient to establish a right to exclusive use. Furthermore they definitely wrestle with the problem of practical relief; for the usual restraining injunction would not permanently enjoin future solicitation, but only prevent the defendant's use of plaintiff's information. The utter impossibility of putting this distinction into practice is well brought out in *People's Coat, Apron, & Towel Supply Co. v. Light*.⁸ The court said,

"There is no evidence that Light had a written list of them [customers]. There was in his head what was equivalent. . . . He had entry and introduction and solicited them, not as strangers, but as persons known to him. He used what he had gained through the plaintiff to take away its customers. It is idle to say that he did not have the advantage of a knowledge and acquaintance that he would not have had save for his former employment, and it is unimportant that there was some other possible way of discovering and reaching them. It is clear enough what means he used."

This case rests on *Witkop & Holmes Co. v. The Great Atlantic & Pacific Tea Co.*,⁹ where virtually the same fact situation was present. In the *A. & P.* case the court said:

"The conduct of defendants amounts to an unlawful obtaining and use of a trade list . . . a carrying to a business rival the benefit of business secrets acquired while in the employ of plaintiff, and as such should be enjoined.

"A reason why this relief is due to the plaintiff is that, although the defendants' conduct is grossly unfair, unjust and injurious, the damage to the plaintiff's property rights is incapable of being ascertained and an action at law would be inadequate."

Presumably the usual injunction would be inadequate also. It is clear that, throughout, the court is looking to the practical protection of the plaintiff's rights. It is also clear that the reasoning and language itself could be adapted without strain to support one's contention that destruction of infringing instruments should be given. In fact, in the *Light* case the court seems to use this analogy in reverse, as it were,

⁸ 171 App. Div. 671 at 673, 157 N. Y. S. 15 (1916), *affd.* 224 N. Y. 727, 121 N. E. 886 (1918).

⁹ 69 Misc. 90 at 92, 124 N. Y. S. 956 (1910). This case, and those depending upon it, present an unusual reason for granting relief at all; namely, unfair competition. See 24 COL. L. REV. 654 (1924) for a defense of this view. *Witkop v. Boyce*, 64 Misc. 374, 118 N. Y. S. 461 (1909), a similar case, is also relied upon.

for it says written lists could be destroyed, therefore, a permanent injunction against the use of the memory is well founded. Notice the first part of the quotation given immediately above. The reason why these cases are especially valuable for our purposes, in addition to the analogy between the memory and physical lists, is that the court in both instances is trying to accomplish the very same result, namely to protect, in an effective way, the right to exclusive use.¹⁰ This latter angle is well illustrated by the interesting case of *Conviser v. Brownstone & Co.*,¹¹ where both physical lists and the former employee's memory were used indiscriminately. The court drew no distinction and granted destruction of the lists as well as a permanent injunction against future solicitation, saying, "To remove the prohibition from them [defendants] would be to practically deprive the plaintiff of the benefit of his judgment." This reason supports both types of relief. As shown, this case is actual authority to support the destruction doctrine but is given at this point because it involves the form of relief discussed in this paragraph. Other actual authority follows in the next paragraph, and involves cases covering patents, trade secrets, copyrights, and literary property. These divisions are made for convenience of discussion only; for, as shown, we have assumed that the plaintiff has established a right. We are discussing the problem of relief.

The field in which relief through destruction of infringing instruments is most clearly given is that of patents. Although *Betts v. De Vitre*,¹² was decided first, the leading case seems to be *Frearson v. Loe*.¹³ Here, the defendant had a patent on a machine used for making screws and for the screws themselves, which were improved articles. The defendant copied the machine, possessed screws, and threatened to use the former and sell the latter. The court said,

"I give a verdict for the Plaintiff on all points, and grant him

¹⁰ These cases bring out another problem present throughout this article but clearly beyond its scope. This involves jurisdiction and procedure in connection with the question of to whom the relief is applied. Some enjoin the new employer, others limit relief to the first infringer, and some grant it against any third person with knowledge or possession of instruments. Those taking the limited view include *Lamb v. Evans*, [1892] 3 Ch. 462, *Witkop & Holmes Co. v. The A. & P.*, 69 Misc. 90, 124 N. Y. S. 956 (1910), and *Whiting Milk Co. v. Grondon*, 282 Mass. 41, 184 N. E. 379 (1933). *Contra*: *People's Coat, Apron, & Towel Supply Co. v. Light*, 171 App. Div. 671, 157 N. Y. S. 15 (1916), *affd.* 224 N. Y. 727, 121 N. E. 886 (1918); *Conviser v. Brownstone Co.*, 209 App. Div. 584, 205 N. Y. S. 82 (1924); *Henry v. Rhinesmith*, 219 Iowa 1088, 260 N. W. 9 (1936); *Pressed Steel Car Co. v. Standard Car Co.*, 210 Pa. 464, 60 A. 4 (1905).

¹¹ 209 App. Div. 584 at 591-592, 205 N. Y. S. 82 (1924).

¹² 34 L. J. N. S. 289 (Ch. 1865).

¹³ 9 Ch. Div. 48 at 67 (1878).

an injunction to restrain in the usual way the infringement of either of his letters patent by the Defendant. I also order the defendant either to deliver up to the plaintiff or to destroy in his presence any machinery in his possession or power, and to pay the costs of the action."

In the *Betts* case there was no showing of threatened continued use, nor was there evidence of particularly flagrant infringement, yet similar relief was granted, and the court ordered that,

"an inquiry should be made whether the defendants or any of them had in their possession or power any or what articles manufactured in violation of the plaintiff's patent, and . . . that all articles which should be certified to have been so manufactured and to be in the possession of the defendants . . . should be destroyed in the presence of persons named, being the managers and solicitors of the plaintiffs."¹⁴

The first American case is *Birdsell v. Shaliol*,¹⁵ which relies upon *Frearson v. Loe*. In this case the lower court had held that the patentee was estopped from suing the user of an infringing machine because of a previous adjudication in his favor as against the seller thereof. The court reversed this, saying,

"an infringer does not, by paying damages for making and using a machine in infringement of a patent, acquire any right himself to the future use of the machine. On the contrary, he may . . . be restrained by injunction from further use, and, when the whole machine is an infringement of the patent, be ordered to deliver it up to be destroyed."

This approval of the destruction principle might be dictum as it is not clear whether the upper court is suggesting that it be actually decreed, or ordering that it be done. The lower court's decree is simply reversed. It follows that in England destruction of goods infringing patents is decreed as a matter of course, while it is clearly approved but not ordinarily done in the United States.

In the copyright field we should expect to discover that similar action is taken, and this supposition is correct. In *Drury v. Ewing*¹⁶ the plaintiff had a copyright for a chart and a guide for dressmakers. The defendant made an imitation with colorable differences only, and was found guilty of infringement. The court said,

"with the intimation that such future action as circumstances may require, will be taken by the court, it is now ordered that the

¹⁴ 34 L. J. N. S. 289 at 291 (Ch. 1865).

¹⁵ 112 U. S. 485 at 487, 5 S. Ct. 244 (1884).

¹⁶ (C. C. Ohio, 1862) 1 Bond 540, 7 Fed. Cas. 1113 at 1118.

defendants . . . surrender to the clerk of this court, within twenty days, all the published copies of the guide in their possession, or within their control, together with the plate or plates on which they are printed. . . .”

In the literary property field *Prince Albert v. Strange*¹⁷ contains an exhaustive review of many early cases protecting an author's unpublished works. The case was decided at common law and decreed that cuts of etchings, and a catalogue describing them, be delivered up and destroyed. Prince Albert had made these etchings, an impression being taken by a workman, which the defendant secured. He printed the catalogue and advertised an exhibition of the etchings. The prior cases relied upon in that decision do not appear to grant the relief discussed herein; but the principle case does so, evidently depending upon them nevertheless.

Turning to the trade secrets angle, the case of *Pen Carbon Manifold Co. v. Tomney*,¹⁸ is most persuasive. Here the defendant had disclosed secrets pertaining to machines to his son and together they started to manufacture them, infringing the plaintiff's secret. The court said,

“The defendants complained that they are required to deliver to complainants all patterns, photographs, drawings, or designs of machines, all raw or finished parts of machines, all tangible and informative writings relative to the machines, their use or operation, or to any of the secret methods employed in construction. . . . We see no objection to requiring the defendants to perform. . . .”

This case is unusual and extreme in that it gives the instruments to the plaintiff and seems to stand alone on that proposition; but its language is broad and vigorous. As the object of this paragraph has been the showing that the destruction doctrine exists in the various fields mentioned, the cases quoted within are merely examples. There are others.¹⁹

¹⁷ 2 De G. & Sm. 652, 64 Eng. Rep. 293 (1849).

¹⁸ 90 N. J. Eq. 233 at 235, 110 A. 445 (1920) (italics supplied).

¹⁹ Together with the cases mentioned in the above paragraph, the following list contains all the cases actually granting destruction of infringing instruments which the writer was able to discover. The category in which each is placed is in accordance with the language of the court. That this division is arbitrary is evident from a comparison of the facts given below.

Copyrights: *Lamb v. Evans*, [1892] 3 Ch. 462, where headings of a business directory were held to be copyrighted, but not advertisements. Salesmen were restrained from giving information of either type to a rival and the printer ordered to deliver up cuts intended for the rival catalogue.

Literary property: *Pressed Steel Car Co. v. Standard Car Co.*, 219 Pa. 464, 60

As indicated before, the reason for destruction of infringing articles is simple and practical. If the right to exclusive use is to mean anything more than an academic legal conclusion it is necessary to protect it by some means producing practical effective results. It is submitted that the destruction doctrine accomplishes just this, and moreover, that often it is the only way. It is not contended that it should always be done. But where spying, fraud, enticement of servants, breach of trust, breach of contract, and clandestine and shady practices in general are found in a large percentage of cases, a mere order to cease has to be backed up. Nor can one feel sympathetic for a defendant who has used such methods.²⁰ This view is best summarized in *American Bell Telephone Co. v. Kitsell*.²¹ The court there said,

“Where the court has power to decree, necessarily it has power to carry its decree into effectual execution; and a court which does not hesitate to enforce its process by attachment and imprisonment of the person, and by sequestration of the property of parties, in order to compel obedience, would not hesitate from any consid-

A. 4 (1905). Blueprints of plaintiff's railroad cars were given to customers for the purpose of aiding in ordering, suggesting alterations, and getting repair parts. They were secured by a rival. Ordered returned and all copies delivered up. *Simmons Hardware Co. v. Waibel*, 1 S. D. 488 (1891). Defendant got a traveling salesman to reveal a secret code of the plaintiff's costs and made a copy.

Trade secrets: Conviser v. Brownstone & Co., 209 App. Div. 584, 205 N. Y. S. 82 (1924). An employee was bribed to give the plaintiff's rival a list of customers, in particular paid-up customers. These lists were ordered delivered up and in addition both employee and his new employer were enjoined permanently from all solicitation. *Robb v. Greene*, [1895] 2 Q. B. 315. A servant surreptitiously made a copy of his master's account book. Cites *Morison v. Moat*, 9 Hare 241, 68 Eng. Rep. 492 (1851), where there were similar facts and the same decision reached.

In addition, in *The Emperor of Austria v. Day*, 2 Giff. 628, 66 Eng. Rep. 263 (1861), it was held that a foreign emperor can sue an English court to uphold and protect his exclusive right to control the currency of his dominion. The defendants had printed large amounts of notes for a proposed new government of Hungary. They were ordered to deliver these up to be destroyed as well as the plates and lithographic equipment.

Compare *American Bell Telephone Co. v. Kitsell*, (C. C. N. Y. 1888) 35 F. 521, and *Merryweather v. Moore*, [1892] 2 Ch. 518. Relief refused but discussed. Also see *McGowin v. Remington*, 12 Pa. St. 56 (1849), where title was held to be in the plaintiff for the instruments themselves and thus that replevin would lie. Delivery was decreed in equity nevertheless.

²⁰ An apt remark from *Conviser v. Brownstone & Co.*, 209 App. Div. 584 at 586-587, 205 N. Y. S. 82 (1924), in this connection is, “I do not understand that appellants question the right of the plaintiff to an injunction restraining the use of the list obtained from plaintiff's unfaithful employee, but if they do, I think the judgment was entirely right. It was a flagrant case of the modern methods pursued by some of our fellow-citizens whose desire for profit smothers all sense of right and decency.”

²¹ (C. C. N. Y. 1888) 35 F. 521 at 523.

eration of want of power or propriety to order property to be destroyed which has been created in defiance of the rights of another . . . whenever it might be essential to the ends of justice that this should be done."

In relatively few cases is the real issue met, as it is in this one; that is, with recognition that protection is to be emphasized and once the right to exclusive use is established in theory it should be established in practice, legal considerations as to why it was granted at all being a separate problem in so far as methods for its enforcement go. In *The Emperor v. Day*,²² the court said, "That protection can only be effectually afforded by the relief prayed for in this suit; and there must be a decree against the defendants according to the prayer." Likewise in *Pen Carbon Manifold Co. v. Tomney*,²³ it was said, "We agree with the vice-chancellor that this is necessary to the proper protection of the complainant's secrets, and we see no objection to requiring the defendant to perform what the decree directs." These statements seem entirely adequate to show that the destruction of infringing instruments is available to protect the plaintiff's right to exclusive use, as well as to indicate the reason therefor; which is its necessity if any practical relief is to be secured.²⁴

²² 2 Giff. 628 at 682, 66 Eng. Rep. 213 (1861).

²³ 90 N. J. Eq. 233 at 235, 110 A. 445 (1920).

²⁴ If relief is the main purpose, as expounded herein, interlocutory injunctions should be available. While it would be difficult to show that a remedy so very hard on the defendant is justified before a final hearing, this can be done on the usual doctrine of immediate and irreparable injury to the plaintiff. They were granted in *Prince Albert v. Strange*, 2 De G. & Sm. 652, 64 Eng. Rep. 293 (1849), in *Simmons Hardware Co. v. Waibel*, 1 S. D. 488 (1891), and in *Pressed Steel Car Co. v. Standard Car Co.*, 210 Pa. 464, 60 A. 4 (1905).