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PATENTS—INFRINGEMENT OF COMBINATION PATENT—SALE AND USE  
OF REPLACEMENT FABRIC FOR CONVERTIBLE TOP STRUCTURE  
CONSTITUTES PERMISSIBLE REPAIR.

*Aro Manufacturing Co. v. Convertible Top Replacement Co.* (U.S. 1961).

Under the patent provisions of the United States Code,<sup>1</sup> plaintiff, Convertible Top Replacement Company, brought suit to enjoin defendant from continuing in the manufacture of certain custom-shaped fabric tops for automobiles, alleging infringement and contributory infringement of its "Mackie-Duluk" patent.<sup>2</sup> The patent, acquired by a territorial grant from the owners, was for a combination, including a metal frame, a flexible fabric cover, and a unique mechanism for sealing the fabric cover automatically to the body of the automobile. The various metal and mechanical elements were all of a permanent nature, usually lasting the lifetime of the automobile. The fabric cover, however, was less durable, deteriorating from a normal wear and tear in about three years. Defendant sought to capitalize on this fact by manufacturing only the unpatented fabric portion of the combination, custom-fitted for sale to owners whose automobiles were equipped with "Mackie-Duluk" combination tops. In opposition to plaintiff's claim of infringement, defendant argued that to replace an unpatented element of a combination patent, or to contribute to its replacement, was permissible so long as the effect was not a reconstruction of the entire combination. The question whether defendant's acts constituted forbidden reconstruction or permissible repair<sup>3</sup> was resolved by the United States District Court for the District of Massachusetts in favor of the plaintiff. The United States Court of Appeals, First Circuit, affirmed<sup>4</sup> and the United States Supreme Court granted certiorari. In reversing, with three justices dissenting, the Supreme Court held that maintenance of the "use of the whole" of the patented combination through replacement of a spent, unpatented element does not constitute reconstruction. *Aro Manufacturing Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 81 S. Ct. 599 (1961).

1. 35 U.S.C. § 271(a) (1958): "Except as otherwise provided in this title, whoever without authority makes, uses or sells any patented invention, within the United States during the term of the patent therefor, infringes the patent." 35 U.S.C. § 271(c) (1958): "Whoever sells a component of a patented machine, manufacture, combination or composition, or a material or apparatus for use in practicing a patented process, constituting a material part of the invention, knowing the same to be especially made or especially adapted for use in an infringement of such patent, and not for a staple article or commodity of commerce suitable for substantial noninfringing use, shall be liable as a contributory infringer."

2. U.S. Letters Patent 2,569,734, granted October 2, 1951 to Harry A. Mackie and Stanley Duluk.

3. For general information in this area see 3 WALKER, PATENTS 1771-1775 (Deller's ed. 1937).

4. 270 F.2d 200 (1st Cir. 1960).

Combination patents naturally invite certain types of infringement, the more common instances being those involving an attempt to improve a patented combination by the addition of a new element,<sup>5</sup> and those in which repairs are made to maintain an existing combination,<sup>6</sup> as in the instant case. The tendency to infringe upon combination patents is easily explained; generally the elements of a combination are not sufficient discoveries<sup>7</sup> in their own right to be patentable. Before taking up the repair-reconstruction distinction, it might be well to make note of the so-called "misuse" cases. Not infrequently combination patentees have sought to extend their monopolies to include the manufacture, sale or supply of those unpatented elements within the combination.<sup>8</sup> These cases are relevant here only insofar as they fix the character of a combination patent monopoly.<sup>9</sup> *Wilson v. Simpson*<sup>10</sup> is rightfully acknowledged in three of the four opinions in the instant case to be the leading case on the issue of repair *versus* reconstruction. While that case is of great value for giving the first thorough-going analysis of what constitutes repair and what constitutes reconstruction, it is somewhat lacking in its application to the instant situation because of its facts. In *Wilson*, as in most of the repair-reconstruction cases to date,<sup>11</sup> the element replaced was such that by its very nature it dictated a finding of repair as opposed to reconstruction. The approaches taken by the courts in drawing this distinction have been nearly as varied as the cases, ranging in emphasis from the

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5. *Cimiotti Unhairing Co. v. American Fur Co.*, 198 U.S. 399, 25 S. Ct. 697 (1905); *Eames v. Godfrey*, 68 U.S. (1 Wall.) 547 (1863); *Prouty v. Ruggles*, 41 U.S. (16 Pet.) 336 (1842).

6. *Heyer v. Duplicator Manufacturing Co.*, 263 U.S. 100, 44 S. Ct. 31 (1923); *Chaffee Boston Belting Co.*, 63 U.S. (22 How.) 240 (1859); *Wilson v. Simpson*, 50 U.S. (9 How.) 66 (1850); *Automotive Parts Co. v. Wisconsin Axle Co.*, 81 F.2d 125 (6th Cir. 1935).

7. U.S. CONST. art. 1, § 8, cl. 8: "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."

8. *Mercoird Corp. v. Midcontinent Inv. Co.*, 320 U.S. 661, 64 S. Ct. 268 (1944); *Morton Salt Co. v. G. S. Suppiger Co.*, 314 U.S. 488, 62 S. Ct. 402 (1942); *Carbice Corp. v. American Patents Corp.*, 283 U.S. 27, 51 S. Ct. 334 (1931); *Morgan Envelope Co. v. Albany Perforated Wrapping Paper Co.*, 152 U.S. 425, 14 S. Ct. 627 (1894). *But cf.* *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 325, 29 S. Ct. 503 (1908). See also, Hogg, *Patent Misuse Before and After Section 271*, 42 J. PAT. OFF. Soc'y 683 (1960); Comment, 3 VILL. L. REV. 355 (1958).

9. *Aro Manufacturing Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 81 S. Ct. 599, 604, n. 10 (1961).

10. 50 U.S. (9 How.) 66 (1850). In this case the patented combination was a planing machine which included, among its several elements, certain cutting knives which usually wore out after a few months' use. The Court held that the purchaser had the right to replace the knives from time to time without the patentee's consent.

11. *Heyer v. Duplicator Manufacturing Co.*, 263 U.S. 100, 44 S. Ct. 31 (1923) (gelatin band for multiple copying machine); *Wilson v. Simpson*, 50 U.S. (9 How.) 66 (1850) (cutting knives for planing machine); *Gillette Safety Razor Co. v. Standard Safety Razor Co.*, 64 F.2d 6 (2d Cir. 1933) (razor blades for safety razor).

relative life<sup>12</sup> or cost<sup>13</sup> of the part replaced, to the intention of the patent owner<sup>14</sup> and the importance<sup>15</sup> of the replaced article in relation to the whole invention.

The instant case forced the Court to seek a more basic solution inasmuch as the relative qualities of the fabric cover were not so insignificant as to admit of a clear-cut finding that reconstruction had not taken place. It is significant that the Court, rather than taking the several evidentiary factors used in past cases in the aggregate and applying them *en masse* to the instant case, turned to a single, more generally applicable solution.<sup>16</sup> The difficulty now lies in trying to mold that solution into the understandable common denominator it was intended to be. The Court uses the word "test" sparingly, once in reference to a statement of Judge Learned Hand in an earlier case,<sup>17</sup> and once in disclaiming the approach of the lower courts in the instant case as erroneous.<sup>18</sup> It would appear that the Court's position can be deduced from these references: operative facts relied upon in prior cases are not to be determinative of the question of repair or reconstruction; nothing short of actually "making" a new article will constitute impermissible reconstruction.

Perhaps the clearest indication of the extent to which the majority would go before finding that reconstruction had occurred lies in the fact that it cites *American Cotton-Tie Co.*<sup>19</sup> as a sole example of forbidden reconstruction. It is not to be disputed that something more than a repair has taken place when scrap metal straps with buckles, for the tying of cotton, are reworked to be used identically a second time, as happened in that

12. *Heyer v. Duplicator Manufacturing Co.*, 263 U.S. 100, 44 S. Ct. 31 (1923); *Wilson v. Simpson*, 50 U.S. (9 How.) 66 (1850); *Williams v. Barnes*, 234 Fed. 339 (7th Cir. 1916); *Slocomb and Co., Inc. v. A.C. Layman Machine Co.*, 227 Fed. 94 (D.C. 1915), *aff'd* 230 Fed. 1021 (3d Cir. 1916).

13. *Heyer v. Duplicator Manufacturing Co.*, 263 U.S. 100, 44 S. Ct. 31 (1923); *El Dorado Foundry, Machine & Supply Co. v. Fluid Packed Pump Co.*, 81 F.2d 782 (8th Cir. 1936); *American Safety Razor Corp. v. Frings Bros. Co.*, 62 F.2d 416 (3d Cir. 1932).

14. *Westinghouse Elec. and Mfg. Co. v. Hesser*, 131 F.2d 406 (6th Cir. 1942); *Electric Auto-Lite Co. v. P. & D. Mfg. Co.*, 78 F. 2d 700 (2d Cir. 1935); *Slocomb and Co., Inc. v. A. C. Layman Machine Co.*, 227 Fed. 94 (D.C. 1915), *aff'd* 230 Fed. 1021 (3d Cir. 1916).

15. *Leeds & Catlin Co. v. Victor Talking Machine Co.*, 213 U.S. 325, 29 S. Ct. 503 (1908); *Morrin v. Robert White Engineering Works*, 143 Fed. 519 (2d Cir. 1905); *Davis Electrical Works v. Edison Electrical Light Co.*, 60 Fed. 276 (1st Cir. 1894).

16. It is difficult to reduce to specific language the test used by the Court. In the closing sentence of the majority opinion the Court says it has "measured by this test . . . reconstruction of a patented entity, comprised of unpatented elements, is limited to such a true reconstruction of the entity as to in fact make a new article. . . ." *United States v. Aluminum Co. of America*, 148 F.2d 416 (2d Cir. 1945), is cited by the Court in support of this test.

17. *United States v. Aluminum Co. of America*, 148 F.2d 416 (2d Cir. 1945). At page 425 Judge Hand says: "Nor can he [the monopolist] prevent their [combination patent holders] reconditioning articles worn by use, *unless they in fact make a new article.*" (Emphasis supplied).

18. *Aro Manufacturing Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 81 S. Ct. 599, 600 (1961).

19. *American Cotton-Tie Co. v. Simmons*, 106 U.S. 89 (1882).

case Mr. Justice Black, concurring in a separate opinion, likewise advocates an extreme position whereby only the most extraordinary case could even raise the question of reconstruction. In fact, Mr. Justice Black is decidedly more outspoken than the majority in describing the disadvantages of a "several-factor" test.<sup>20</sup> Diametrically opposed to the simple test invoked by the majority, that is whether a new article has in fact been made or not, is the "several-factor" test subscribed to by Justices Brennan and Harlan.<sup>21</sup> They maintain that each operative fact must be weighed in each case prior to any conclusion of repair or reconstruction. The question remaining to be answered is this: is the single test, propounded by the majority, as vague for its simplicity as the "several-factor" test allegedly is for its complexity? It is submitted that the answer is decidedly no. Admittedly, it seems at first glance that the majority and Mr. Justice Black have been too much taken up with demonstrating the disadvantages of applying ambiguous evidentiary standards and not enough with considering the difficulties inherent in their own solution. However, it would appear that, by not being explicit in this respect, the Court compels the conclusion that it intends only the rarest of cases to be even suspect as containing an issue of reconstruction. Any attempts to clarify the "making" test, be it by example or description or otherwise, would necessarily have the effect of dispelling any vestiges of simplicity that might surround it. Such attempts would undo all which the Court set out to accomplish in this opinion; not a single case of alleged combination patent infringement involving the replacement of a part would be beyond the purview of the rule. Thus, significantly, the Court has laid down an unequivocal test, unhampered by confusing, weakening qualifications. As a result, combination patent holders and small business entrepreneurs will better appreciate the limits of their respective offices, and the courts will less frequently find before them an issue of repair or reconstruction.

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20. In an interesting argument, Mr. Justice Black makes every effort to point up the deleterious effect that the rule advocated by the minority would have on small business enterprises. The unpredictability resulting from varying standards would have the effect, he argues, of deterring small businessmen from engaging in activities that would have been found, if pursued, to be non-infringing.

21. While propounding the same basic theories on repair and reconstruction, Justices Brennan and Harlan disagree in classifying the issue as a question of law or of fact. Mr. Justice Brennan clearly sees it as a question of law, which accounts for his concurrence in the result of the majority. Mr. Justice Harlan sees the issue as a mixed one of law and fact; he concludes that, in as much as the lower courts have applied the proper principles, he is constrained to abide by their findings on the facts.