
[¶ 62,853] United States v. United States Gypsum Co., National Gypsum Co., Certain-Teed Products Corp., The Celotex Corp., Ebsary Gypsum Co., Inc., Newark Plaster Co., Samuel M. Gloyd, d.b.a. Texas Cement Plaster Co., Sewell L. Avery, Oliver M. Knode, Melvin H. Baker, Frederick G. Ebsary, and Frederick Tomkins.

In the District Court of the United States for the District of Columbia. Civil Action No. 8017. May 15, 1951.

Sherman Antitrust Act

Final Amended Decree—Price Fixing and Customer Classification in Gypsum Board ndustry—Compulsory Non-Exclusive Licensing of Patents.—An amended decree, issued in conformity with the mandate of the Supreme Court after a finding that gypsum board companies had entered license and other agreements violative of the Sherman Act and in restraint of trade, prohibits continuation of listed unlawful agreements, prohibits future agreements fixing prices or classifying customers, requires non-exclusive licensing of gypsum board patents at reasonable royalties to all proper applicants, and provides for supervision and enforcement of the decree by officials of the Justice Department. An interim license form is appended to the decree.

See the Sherman Act annotations, Vol. 1, ¶ 1270.134, 1270.379, 1610.290, 1610.301, 1610.551.

Entering decree in conformity with opinion and mandate of the Supreme Court of the United States, 71 S. Ct. 160, reported at ¶ 62,729.

[*In full text*]

Preliminary Statement

This cause came on for trial before this Court on November 15, 1943. At the conclusion of plaintiff's presentation of the case defendants moved pursuant to Rule 41 (b) of the Federal Rules of Civil Procedure for judgment dismissing the complaint on its merits. The motion of defendants was granted August 6, 1946. The judgment so rendered by this Court was reversed by the Supreme Court of the United States and the case was remanded to this court for further proceedings in conformity with the opinion of the Supreme Court (333 U. S. 364).

Following the remand, the plaintiff pursuant to Rule 56 of the Federal Rules of Civil Procedure, moved for summary judgment in its favor upon the pleadings and all of the proceedings which theretofore had been had in the case, or, in the alternative for such further proceedings as this Court might direct, and defendants, by direction of the Court, filed proffers of proof.

Argument by counsel for the respective parties upon the motion of plaintiff was heard by the Court and after due consideration of such argument and of defendants' proffers of proof, Garrett, J. and Jackson, J., constituting a majority of the Court, announced a ruling to the effect that plaintiff's motion for summary judgment would be granted, and Stephens, Jr., who presided during the trial, announced his dissent from such ruling.

Thereafter counsel for plaintiff and counsel for certain of the defendants submitted forms of final decrees for the consideration of the Court and also suggested findings of fact, the latter to be considered in the event the Court should deem it necessary to make any findings of fact additional to those originally found by it and to those stated in the opinion of the Supreme Court.

In due course, the Court heard arguments respecting the proposed decrees and the suggested findings of fact, and full consideration was given thereto and to all prior proceedings—all being considered in the light of the decision of the Supreme Court which, as understood by the majority of this Court, held that the defendants acted in concert to restrain trade and commerce in the gypsum board industry and monopolized said trade and commerce among the several states in that section hereinafter referred to as the eastern territory of the United States, which section embraces all the states of the United States westward from the eastern coast thereof to the Rocky Mountains and including New Mexico, Colorado, Wyoming, and the eastern half of Montana.

Thereafter this Court, on November 7, 1949, entered its decree sustaining plaintiff's motion for summary judgment and granting relief which it deemed appropriate to its adjudication. Plaintiff thereupon appealed to the Supreme Court seeking to have the scope of the relief enlarged, and certain defendants appealed to the Supreme Court for a reversal of the judgment, which latter appeal was dismissed by the Supreme Court on May 29, 1950. On November 27, 1950, the Supreme Court rendered an opinion on the plaintiff's appeal, affirming this Court's adjudication of Sherman Act violation, holding there was concerted action through the fixed-price licenses and accepting as true the underlying facts in the defendants' proof by proffer. Nevertheless, the Supreme Court reversed the decree heretofore entered herein and remanded the cause to this Court with instructions to modify its decree and

for further proceedings in conformity with its opinion.

Upon remand, this Court, after ordering counsel for the plaintiff and for the defense to submit forms of decree in conformity with the Supreme Court opinion and after considering such forms has modified its decree of November 7, 1949, in accordance with the Supreme Court's opinion of November 27, 1950.

Decree

IT IS THEREFORE ORDERED, ADJUDGED AND DECREED:

ARTICLE I

[Jurisdiction of Matter]

This Court has jurisdiction of the subject matter hereof and of the parties hereto. The complaint states a cause of action against defendants under the Act of Congress of July 2, 1890 entitled "An Act to Protect Trade and Commerce Against Unlawful Restraints and Monopolies," commonly known as the Sherman Antitrust Act, and acts amendatory thereof and supplemental thereto.

ARTICLE II

[Definitions]

As used in this decree:

1. "Defendant companies" shall mean all of the corporate defendants and Samuel M. Gloyd, doing business under the name of Texas Cement Plaster Company.

2. "Gypsum board" shall mean plaster board, lath, wallboard, special surface board, sheathing, liner board (including any such product which is perforated or metallized) made from gypsum.

3. "Gypsum products" shall mean gypsum board as defined in the preceding paragraph, and plaster, block, tile and Keene's cement made from gypsum.

4. "Patents" shall mean United States Letters Patent and applications for United States Letters Patent relating to gypsum board, its processes, methods of manufacture or use, now owned or controlled by defendant United States Gypsum Company and issued to, applied for or acquired by defendant United States Gypsum Company within a period of five (5) years from the date of this decree, including Letters Patent issued upon any of said applications, and continuations in whole or in part, renewals, reissues, divisions and extensions of any such Letters Patent or applications for Letters Patent.

5. "Patent Licenses" shall mean the patent license agreements which were in effect between defendant United States Gypsum Company and each of the other defendant companies at the time the complaint herein was filed and described in said complaint as follows:

Agreement dated October 15, 1929, between United States Gypsum Company, as licensor, and Certain-Teed Products Corporation, as licensee;

Agreement dated October 17, 1929, between United States Gypsum Company, as licensor, and National Gypsum Company, as licensee;

Agreement dated October 18, 1929, between United States Gypsum Company, as licensor, and Ebsary Gypsum Company, as licensee;

Agreement dated November 5, 1929, between United States Gypsum Company, as licensor, and Universal Gypsum and Lime Company (National Gypsum Company, as Assignee), as licensee;

Agreement dated November 25, 1929, between United States Gypsum Company, as licensor, and American Gypsum Company (The Celotex Corporation, as Assignee), as licensee;

Agreement dated April 23, 1930, between United States Gypsum Company, as licensor, and Kelley Plasterboard Company (Newark Plaster Co., as Assignee), licensee;

Agreement dated February 10, 1937, between United States Gypsum Company, as licensor, and Texas Cement Plaster Company, as licensee;

Agreement dated October 5, 1934, between United States Gypsum Company, as licensor, and National Gypsum Company, as licensee (Metallized board);

Agreement dated October 12, 1934, between United States Gypsum Company, as licensor, and Kelley Plasterboard Company (Newark Plaster Company, as Assignee), as licensee (Metallized board);

Agreement dated November 2, 1934, between United States Gypsum Company, as licensor, and Certain-Teed Products Corporation, as licensee (Metallized board);

Agreement dated December 4, 1934, between United States Gypsum Company, as licensor, and American Gypsum Company (The Celotex Corporation, as Assignee), as licensee (Metallized board);

Agreement dated August 14, 1935, between United States Gypsum Company,

as licensor, and Ebsary Gypsum Company, as licensee (Metallized Board);

Agreement dated June 8, 1938, between United States Gypsum Company, as licensor, and Certain-Teed Products Corporation, as licensee (Perforated lath);

Agreement dated September 16, 1938, between United States Gypsum Company, as licensor, and Certain-Teed Products Corporation, as Licensee (Perforated lath);

Agreement dated February 2, 1937, between United States Gypsum Company, as licensor, and Ebsary Gypsum Company, as licensee (Perforated lath);

Agreement dated September 16, 1938, between United States Gypsum Company, as licensor, and Ebsary Gypsum Company, as licensee (Perforated lath);

Agreement dated June 23, 1937, between United States Gypsum Company, as licensor, and Kelley Plasterboard Company (Newark Plaster Company, as Assignee), as licensee (Perforated lath);

Agreement dated January 3, 1939, between United States Gypsum Company, as licensor, and Newark Plaster Company, as licensee (Perforated lath);

and any supplement or amendment to any of said patent license agreements.

ARTICLE III

[*Finding of Restraint*]

The defendant companies have acted in concert in restraint of trade and commerce among the several states in the eastern territory of the United States to fix, maintain and control the prices of gypsum board and have monopolized trade and commerce in the gypsum board industry in violation of sections 1 and 2 of the Sherman Antitrust Act.

ARTICLE IV

[*Licenses Unlawful*]

Each of the license agreements listed in Article II hereof is adjudged unlawful under the antitrust laws of the United States and illegal, null and void.

ARTICLE V

[*Agreements Prohibited*]

The defendant companies, and their respective officers, directors, agents, employees, representatives, subsidiaries, and any person acting or claiming to act under, through or for them, or any of them, be and each of them hereby is enjoined from entering into or performing any agreement or understanding among the defendant companies or other manufacturers of gypsum products to fix, maintain or stabilize, by patent license agreements or other acts or course of action, the prices, or the terms or conditions of sale, of gypsum products sold or offered for sale to other persons, in or affecting interstate commerce; and from engaging in, pursuant to such an agreement or understanding, any of the following acts or practices;

(1) agreeing upon any basis for the selection or classification of purchasers of gypsum products;

(2) refraining from selling gypsum products to any purchaser or any class of purchasers;

(3) agreeing upon any plan of selling or quoting gypsum products at prices calculated or determined pursuant to a delivered price plan which results in identical prices or price quotations at given points of sales or quotation by defendants using such plan;

(4) policing, investigating, checking or inquiring into the prices, quantities, terms or conditions of any offer to sell or sale of gypsum products.

ARTICLE VI

[*Compulsory Licensing*]

1. Defendant United States Gypsum Company is hereby ordered and directed to grant to each applicant making application therefor, but only in so far as it has the right to do so, a non-exclusive license to make, use and vend under any, some or all patents as hereinbefore defined, at a reasonable, nondiscriminatory royalty or royalties therefor. Defendant United States Gypsum Company is hereby enjoined from making any sale or other disposition of any of said patents which deprives it of the power or authority to grant such licenses unless it requires as a condition of such sale, transfer or assignment that the purchaser, transferee or assignee shall observe the requirements of Articles VI and VII of this decree, and unless the purchaser, transferee or assignee shall file with this Court, prior to or as a part of the consummation of said transaction, an undertaking to be bound by said articles of this decree.

[*Permissible Restrictions in Licenses*]

2. Defendant United States Gypsum Company is hereby enjoined from including any restriction or condition whatsoever in any

license or sublicense granted by it pursuant to the provisions of this article, except that (a) the license may be indivisible and non-transferable; (b) a reasonable, non-discriminatory royalty may be charged, which royalty may not be imposed upon or measured by patent-free products, processes or uses; (c) provision may be made requiring licensee to keep full and accurate records of the gypsum board manufactured and sold by it under any such patent and requiring licensee to make appropriate reports to licensor as to the royalty due, but such reports shall not disclose the selling price of the board or disclose a breakdown of the size or thickness of the board sold; (d) reasonable provision may be made for periodic inspection of the books and records of the licensee by an independent auditor, or by any person acceptable to the licensor and licensee, who shall report to the licensor only the amount of royalty due and payable; (e) reasonable provision may be made for marking the gypsum board manufactured or sold under the licensed patent; and (f) reasonable provision may be made for cancellation of the license upon failure of the licensee to pay the royalty or to permit the inspection of its books and records or for other material breach of the terms of the license agreement by licensee or in the event licensee shall be adjudged a bankrupt. The license agreement shall be in writing signed by the parties thereto and shall to the extent that licensor has the right to do so, grant to the licensee the full right to make, use and vend the inventions and improvements described in the claims of each patent license, in the manufacture, sale or use of gypsum board, for the full term of the patent and any renewal, reissue, division, or extension thereof, and may contain the provisions hereinabove set forth and such other lawful provisions as may be agreed upon between the parties thereto and which are not in conflict with any of the provisions of this decree.

[*Agreement Upon Royalties*]

3. Upon receipt of written request for such a license defendant United States Gypsum Company shall advise the applicant in writing of the royalty which it deems reasonable for the patent or patents to which the request pertains. If the parties are unable to agree upon a reasonable royalty within sixty (60) days from the date such request for a license was received by United States Gypsum Company, the applicant therefor shall within ten (10) days thereafter apply to this Court for a determination of a reasonable royalty or be deemed to have abandoned his said request for such license. The applicant shall promptly give written notice of the filing of such application to the United States Gypsum Company and to the Attorney General of the United States, who shall have the right to be heard thereon. The reasonable royalty rate or rates so determined by the court shall apply to such patent or patents in the license of the applicant from the date of his last written request for such license, and to such patent or patents in all other licenses then or thereafter issued under this decree from the date of such determination. Pending the completion of any such proceeding, applicant shall have the right to make, use and vend under the patent or patents to which his application pertains upon the terms and conditions as set forth in paragraph 4 of this Article, provided he files his application for the determination of a reasonable royalty as aforesaid.

[*Interim Royalties by Court*]

4. Where an application has been made to this Court for the determination of a reasonable royalty under paragraph 3 of this Article, the applicant or the United States Gypsum Company may apply to the court to fix an interim royalty rate pending final determination of what constitutes a reasonable royalty. If the court fixes such interim royalty rate, United States Gypsum Company shall then issue and the applicant shall accept an interim license agreement effective as of the date of the applicant's last written request for such license hereunder and in the form this day filed herein and approved by the court, providing for the periodic payment of royalties at such interim rate from the effective date of such interim license. If applicant fails to accept such interim license or fails to pay the interim royalty in accordance therewith, any such action or omission shall be grounds for the dismissal of the application for the determination of a reasonable royalty and the withdrawal or cancellation of the interim license. Where an interim license has been issued pursuant to this paragraph, reasonable royalty rates for any patent or patents as finally determined by the court shall apply to such patent or patents in the licenses of the applicant and all other applicants then before the court and shall be

retroactive with respect to each such applicant to the date of his said written request for such license.

ARTICLE VII

[*Fair-Trade and Other Exceptions*]

Nothing contained in this decree shall be deemed to have any effect upon the operations or activities of said defendants which are authorized or permitted by the Act of Congress of April 10, 1918, commonly called the Webb-Pomerene Act, or the Act of Congress of August 17, 1937, commonly called the Miller-Tydings Act, or by any present or future act of Congress or amendment thereto; provided, however, nothing contained in this Article shall in any manner affect the provisions of Article VI of this decree.

ARTICLE VIII

[*Visitation and Inspection*]

For the purpose of securing compliance with this decree, and for no other purpose, duly authorized representatives of the Department of Justice, upon written request of the Attorney General or any Assistant Attorney General, and on reasonable notice in writing addressed to any defendant company at its principal office, shall be permitted, subject to any legally recognized privilege: (a) access during the office hours of said defendant to all books, ledgers, accounts, correspondence, memoranda, and other records and documents in its possession or under its control relating to any of the matters contained in this judgment; (b) subject to the reasonable convenience of said defendant and without restraint or interference from it, to interview officers or employees of said defendant regarding any of the matters contained in this judgment; provided, however, that either said defendant or any such officer or employee may have counsel present at any such interview. No information obtained by the means permitted in this Article shall be divulged by any representative of the Department of Justice to any person other than a duly authorized representative of the Department of Justice, except in the course of legal proceedings in which the United States of America is a party, for the purpose of securing compliance with this decree or as otherwise required by law.

ARTICLE IX

[*Costs*]

Judgment is entered against the defendant companies for 50% of the costs of $2,824.00 to be taxed in this proceeding, and the costs so to be taxed are hereby prorated against the several defendant companies as follows:

United States Gypsum Company	$776.60
National Gypsum Company	324.76
Certain-Teed Products Corporation	155.32
The Celotex Corporation	42.36
Ebsary Gypsum Company, Inc.	42.36
Newark Plaster Company	56.48
Samuel M. Gloyd, doing business under the name of Texas Cement Plaster Company	14.12

ARTICLE X

[*Jurisdiction Retained*]

Jurisdiction of this cause, and of the parties hereto, is retained by the Court for the purpose of enabling any of the parties to this decree, or any other person, firm or corporation that may hereafter become bound thereby in whole or in part, to apply to this Court at any time for such orders, modifications, vacations or directions as may be necessary or appropriate (1) for the construction or carrying out of this decree, and (2) for the enforcement of compliance therewith. Let the decree be entered.

Interim License

THIS AGREEMENT, made this ..... day of ....., A. D. ....., by and between UNITED STATES GYPSUM COMPANY, an Illinois corporation, of Chicago, Illinois, hereinafter referred to as Licensor, and ..... a ..... corporation, of ....., hereinafter referred to as Licensee,

WITNESSETH, That

WHEREAS, Licensee desires to obtain a license to make, use and sell gypsum board made according to the processes or embodying the claims of one or more of the hereinafter mentioned patents, owned by Licensor, through the full term thereof;

NOW, THEREFORE, in consideration of the sum of One Dollar and other good and valuable considerations, the receipt whereof is hereby acknowledged, and of the mutual covenants and agreements hereinafter contained, the parties hereto have agreed as follows, to wit:

1. Licensor has agreed to and does hereby give and grant unto Licensee an indivisible and non-exclusive right, license, and privilege to make, use and vend the inventions and improvements claimed in the following letters patent:

Patent Number Date Expiration Date

in the manufacture, use or sale of gypsum board, in the United States of America and the territories and possessions thereof, for the full term of the last to expire of said letters patent, including any reissues thereof.

2. Licensee agrees to pay to Licensor for the right and privilege granted under Paragraph 1 above a license fee or royalty at the rate of — per cent (—%) of Licensee's selling price of all gypsum board manufactured under any of the processes or embodying any of the inventions covered by said patents and sold by it during the term hereof, provided that no license fee or royalty shall be payable on gypsum board exported by Licensee to any foreign country. Nothing herein contained shall prevent Licensee from selling any of said gypsum board in any foreign country.

Licensee's selling price for the purpose of computing the royalty shall mean the net price at Licensee's shipping point after deducting transportation charges and cash discounts allowed by Licensee.

3. The license herein granted shall be personal to the Licensee and shall not be sold, assigned or transferred by it either voluntarily or by operation of law without the written consent of Licensor.

4. Licensee agrees to keep separate, full and accurate books of accounts and records showing the exact quantity of all gypsum board manufactured under any of the processes or embodying any of the inventions covered by said patents and sold by it, together with the Licensee's selling price thereof, and agrees that on or before the 20th day of each calendar month it will deliver to Licensor at its office in Chicago, Illinois, true written returns, verified under oath by an officer or other authorized agent of Licensee, setting forth, without any breakdown with respect to thickness and size of gypsum board, the quantity of all such gypsum board manufactured by it, and sold during the preceding calendar month, and the amount of royalty due and payable on account of such gypsum board so manufactured and sold. Licensee also agrees to pay to Licensor at its said office on or before the 20th day of each calendar month the hereinbefore stipulated royalties or license fees which may then be due under the terms of this agreement on account of all such gypsum board manufactured by it and sold during the preceding calendar month.

5. Licensor shall have the right, at all reasonable times and for such period or periods of time as it may from time to time determine, to verify the correctness of the royalty payments by periodic inspection of the accounts and records of Licensee referred to in the next preceding paragraph, provided, however, that such inspection shall be made by an independent auditor, or by any other person acceptable to both Licensor and Licensee, who shall report to Licensor only the amount of the royalties which were payable during the period covered by the inspection. If Licensee shall object to the independent auditor selected by Licensor, then Licensor shall name, in writing addressed to Licensee, three certified public accountants of good standing, not directly or indirectly employed by it or in any other manner connected with it, and if Licensee shall not within ten days thereafter accept in writing any one of them, then Licensor shall have the right to designate one of the three to act as the independent auditor. In any event, the expense of making any such audit shall be borne equally by the parties.

6. Licensee agrees that all gypsum board manufactured and sold by it under or embodying the claims of any of such patents shall be distinctly marked with the word "Patent" followed by the numbers of any of the aforesaid patents, the claims of which are embodied in said gypsum board, and Licensee further agrees to distinctly mark said gypsum board with the words "Licensed under the above patents and also under the process claims of patent," followed by the number of any of the aforesaid patents of which any process claimed therein is utilized in the manufacture of said product.

7. In the event either party shall at any time neglect, fail or refuse to keep or perform any of the conditions or agreements to be kept or performed by it under the provisions hereof, then the other party may at its election serve upon the party in default written notice of intention to terminate this license and specifying the alleged default. If the party in default shall not cure the default so specified within thirty (30) days

thereafter, then the other party may cancel and terminate this agreement by serving upon the party in default written notice of its election so to do. In the event the Licensee shall at any time be adjudicated a bankrupt, then the license hereunder shall immediately be and become cancelled and terminated. Neither party, by any such cancellation or termination, shall be relieved from any liability accrued at the time thereof.

8. Any notice required or permitted to be served by either party upon the other under the terms hereof, may be served by mailing the same to the other party, postage prepaid and registered, addressed to such other party at its last known principal office, and the deposit of such notice in the United States mails, postage prepaid and so addressed, shall constitute service of notice hereunder.

9. In case Licensor shall grant to any other person any license under the aforesaid patents for the manufacture, sale or use of gypsum board made by use of the processes or embodying the claim or inventions claimed in any of said patents, or shall grant any right under any such license, upon terms more favorable than those granted hereunder to this Licensee, then it will grant to this Licensee a license on the same terms or extend to it the same right granted to any such other person.

10. This Agreement shall be effective as of the ..... day of .....

IN WITNESS WHEREOF the parties hereto have caused these presents to be signed in duplicate by their respective presidents, attested by their respective secretaries, and their corporate seal to be hereunto affixed, the day and year first above written.

UNITED STATES GYPSUM COMPANY

By .....
President

ATTEST:

.....
Secretary

.....
.....
President

ATTEST:

.....
Secretary

[¶ 67,813] United States v. United States Gypsum Co., et al.

In the United States District Court for the District of Columbia. Civil Action No. 8017. Filed July 6, 1954.

Case No. 548 in the Antitrust Division of the Department of Justice.

Petitions of the United States, National Gypsum Co., Certain-Teed Products Co., Ebsary Gypsum Co., Inc., and Newark Plaster Co. for Orders, Modifications or Directions for the Enforcement, Construction or Carrying Out of the Final Decree of May 15, 1951.

Sherman Antitrust Act

Private Enforcement and Procedure—Suit by Co-Defendants in U. S. Antitrust Suit to Restrain Other Defendant from Seeking to Recover for Use of Its Patents—Jurisdiction—Right of Private Parties to Seek Construction or Enforcement of Government Decree.—Petitioners, parties to a Government antitrust decree declaring certain patent licensing agreements void, sought an injunction against respondent, another party to the decree, to restrain four separate suits filed by the respondent against the petitioners in other courts for royalties or for the reasonable value of certain of its patents or for damages because of infringement. The contention of the respondent that the court had no jurisdiction to entertain the injunction suit because (1) only the Government could move to construe or enforce the final decree, and (2) the Government could participate in the four patent suits as an intervenor or as *amicus curiae* was overruled. Although the Attorney General represents the public interest in antitrust cases, where a decree accords rights to parties thereto, they can enforce such rights in a manner consonant with the underlying purposes of the decree. By the terms of the final decree jurisdiction was reserved for any parties to the decree to apply for construction and enforcement of the decree. Further, jurisdiction could be taken, because (1) a court of equity can compel obedience to its decree, and where it is contended that there has been a violation of the decree, the court can determine whether or not such violation has actually been committed; (2) when a status established by a final decree is allegedly endangered by the acts of the respondent, an issue within the jurisdiction of the court is created; (3) jurisdiction to modify the final decree within limits necessary to perfect its effectuation was expressly reserved by the terms of that decree; and (4) to avoid the possible misconstruction of the final decree in a multiplicity of actions, each involving the meaning and application of the decree.

See Dept. of Justice Enforcement and Procedure, Vol. 2, ¶ 8233.325, 8233.400, 8233.475; Private Enforcement and Procedure, Vol. 2, ¶ 9035.05.

Private Enforcement and Procedure—Where Right Sought to Be Enforced Is Integral Part of Scheme in Violation of Antitrust Laws—Patents—Suit for Royalties or for Infringement Damages—Licensing Agreements Void Under Final Judgment—Scope of Provision of Final Judgment.—Petitioners, parties to a Government antitrust decree declaring certain patent licensing agreements null and void, sued to restrain the respondent, another party to the decree, from bringing in other courts four separate suits, each based on alternative claims for royalties or for the reasonable value of the use of certain of its patents or for damages because of infringement. Petitioners contended that the final decree in the Government case, declaring license agreements illegal, null and void, barred the patent suits. Since two counts in each of the four patent suits were based squarely on license agreements set forth in the Government decree and declared null and void by it, further prosecution of these two counts was enjoined as violative of the final decree. Limited actions involving the direct issue of patent infringement were not enjoined, since in this situation, the final decree entered in the Government case would not be affected.

See Dept. of Justice Enforcement and Procedure, Vol. 2, ¶ 8233.325; Private Enforcement and Procedure, Vol. 2, ¶ 9041.155, 9041.350.

Private Enforcement and Procedure—Where Right Sought to Be Enforced Is Integral Part of Scheme in Violation of Antitrust Laws—Licensing Agreements Void Under Final Judgment—Modification of Judgment—Infringement, Contract, and *Quantum Meruit* Suits.—Petitioners, parties to a Government antitrust decree declaring certain patent licensing agreements null and void, sued to restrain the respondent, another party to the

decree, from bringing in other courts four separate suits, each based upon alleged patent uses. Petitioners contended that the patent suits were barred by the provisions of the final decree in the Government suit, but that if they were not so barred, that the Government decree should be modified so as to prohibit them. The purpose and permissible function of an antitrust decree modification order is to cover something within the broad purposes of the decree but which, for some proper reason, was not included in the existing decree. The determinative test is whether or not modification is reasonably necessary to effectuate the basic purposes of the decree. The purpose of the decree was to prevent the unlawful use of patent rights to violate the antitrust laws. The final decree did not cover suits for infringement, in contract, or for *quantum meruit*. Consequently, the final decree was modified to enjoin prosecutions based on patent infringements and on contracts. To allow recovery on the contracts and grant the relief sought would bring about the very recovery prohibited by the decree declaring the agreements null and void. As to the count based on *quantum meruit* covering the use of the patents, this count would [illegible]uld not be enjoined unless the respondent would be barred by unpurged misuse of its patents. However, it was determined that patent misuse existed, that it was shown as a matter of law and on the facts, and that it was unpurged. Consequently, the counts for *quantum meruit* were enjoined also.

See Dept. of Justice Enforcement and Procedure, Vol. 2, ¶ 8233.325; Private Enforcement and Procedure, Vol. 2, ¶ 9027.30, 9043.05.

For the petitioners: Edward Knuff, Special Assistant to the Attorney General, argued orally; Vincent A. Gorman and Lawrence Gochberg, trial attorneys for the United States, appeared; Stanley N. Barnes, Assistant Attorney General, Charles H. Weston and Edward Knuff, Special Assistants to the Attorney General, William D. Kilgore and Vincent A. Gorman, trial attorneys for the United States, were on the briefs (all for the United States). Samuel I. Rosenman argued orally; Seymour Krieger, Elmer E. Finck, and Seymour D. Lewis appeared; Samuel I. Rosenman, Elmer E. Finck, Seymour D. Lewis, Stanley M. Silverberg, Howard Weinstein, and Seymour Krieger were on the briefs, with Finck & Huber, and Rosenman, Goldmark, Colin & Kaye, of counsel (all for National Gypsum Co.). Norman A. Miller argued orally; Herbert W. Hirsh, C. Roger Nelson, Henry Clausen, and Franklin M. Schultz appeared; Herbert W. Hirsh, Norman A. Miller, and Clausen, Hirsh & Miller were on the briefs, with Garson Purcell, and Purcell & Nelson, of counsel (for Certain-Teed Products Corp.). Benjamin P. DeWitt argued orally (for Newark Plaster Co.), and Joseph S. Rippey argued orally (for Ebsary Gypsum Co., Inc.); joint briefs were filed for Newark Plaster Co. and for Ebsary Gypsum Co., Inc., upon which were De Witt, Pepper & Howell (attorneys for Newark) and Joseph S. Rippey (attorney for Ebsary), as were Benjamin P. DeWitt, Sidney Pepper, and Joseph S. Rippey, of counsel.

For the respondent: Cranston Spray and Bruce Bromley argued orally; Robert C. Keck, Hugh Lynch, Jr., and John E. MacLeish appeared; Bruce Bromley, Cranston Spray, Robert C. Keck, and Hugh Lynch, Jr., were on the briefs, as were Cravath, Swaine & Moore, and MacLeish, Spray, Price & Underwood, of counsel (for United States Gypsum Co.).

For the Celotex Corporation: Albert E. Hallett.

Before KIMBROUGH STONE, Circuit Judge, and EUGENE WORLEY and WILLIAM P. COLE, JR., Judges of the U. S. Court of Customs and Patent Appeals, sitting as District Judges.

For other judgments entered in this proceeding in the U. S. District Court, District of Columbia, see 1950-1951 Trade Cases ¶ 62,578, 62,853; 1946-1947 Trade Cases ¶ 57,473. For opinions of the U. S. Supreme Court, see 1950-1951 Trade Cases ¶ 62,632, 62,729; 1948-1949 Trade Cases ¶ 62,226.

[*History of Litigation*]

STONE, Circuit Judge [*In full text except for omissions indicated by asterisks*]: The United States brought an antitrust action (Civil No. 8017) against United States Gypsum Company, *et al.*, which were engaged in the mining of gypsum rocks and in the manufacture and sale of gypsum products. The complaint charged that a controlling unlawful combination was effectu-

ated by means of substantially uniform patent license agreements between USG and the other manufacturing defendants as licensees. At the close of evidence for the United States, the statutory Court of three Judges sustained a motion to dismiss the complaint under Rule 41(b) of the Federal Rules of Civil Procedure upon the ground that on the facts and the law the Government had shown no right to relief (*U. S. v. U. S. Gypsum Co., et al.* [1946-1947 TRADE CASES ¶ 57,473], 67 F. Supp. 397).

The Government appealed and the Supreme Court reversed and remanded "for further proceedings in conformity with this opinion" [1948-1949 TRADE CASES ¶ 62,226] (333 U. S. 364, 402). This decision was on March 8, 1948 with rehearing denied on April 5, 1948 (333 U. S. 869).

After remand, the Government moved for a summary judgment, which was entered on November 7, 1949 (one Judge dissenting) [1950-1951 TRADE CASES ¶ 62,578]. As of that date, this Court entered a decree intended to cover the matters involved. Both sides appealed. The Government contended that the decree was not adequate to cure the ill effects of the illegal conduct of the defendants. The defendants contended that the summary judgment had denied their right to present direct evidence which would have established the lawfullness of their activities.

May 29, 1950, the Supreme Court dismissed the appeal of the defendants [1950-1951 TRADE CASES ¶ 62,632] (339 U. S. 959) in a memorandum (339 U. S. 960) wherein it affirmed Article III of the November 7, 1949, decree and stating:

> "* * * Article III of the decree of the District Court of November 7, 1949, reading as follows: 'The defendant companies have acted in concert in restraint of trade and commerce among the several states in the eastern territory of the United States to fix, maintain and control the prices of gypsum board and have monopolized trade and commerce in the gysum board industry in violation of sections 1 and 2 of the Sherman Antitrust Act,' is affirmed. The corporate defendants and Samuel M. Gloyd, doing business as Texas Cement Plaster Company, are enjoined, pending further order of this Court, from (1) enforcing in any manner whatsoever the provisions of their current license agreements fixing, maintaining, or stabilizing prices of gypsum board or the terms and conditions of sale thereof, and (2) from entering into or performing any agreement or understanding in restraint of trade and commerce in gypsum board among the several states in the eastern territory of the United States by license agreements to fix, maintain or stabilize prices of gypsum board or by license or other concerted action arranging the terms and conditions of sale thereof."

On November 27, 1950, the Supreme Court decided [1950-1951 TRADE CASES ¶ 62,729] (340 U. S. 76) that the decree of November 7, 1949 was inadequate. The Court pointed out wherein it found such inadequacies and closed its opinion as follows: "With these general suggestions, the details and form of the injunction can be more satisfactorily determined by the District Court. Its procedure for the settlement of a decree is more flexible than ours." On the same day, the Supreme Court extended its injunction order of May 29, 1950 (339 U. S. 960) to be "continued in effect until the entry of a final decree in the District Court." [1]

On May 15, 1951, this Court modified its earlier decree in accordance with this opinion of the Supreme Court [1950-1951 TRADE CASES ¶ 62,853]. There was no appeal therefrom. This is the present Final Decree.

In January, February or March, 1953, USG filed separate similar actions against four of the other corporate defendants in the antitrust action. These suits were: against the National Gypsum Company, in the Northern District of Iowa; against Certain-Teed Products Corporation, in the same District; against Newark Plaster Company, in the District of New Jersey; and against the Ebsary Gypsum Company, in the Southern District of New York. Each of these suits was based on alternative claims for royalties or for the reasonable value of the use of certain of its patents or for damages because of infringement. The time period covered by each of these four suits was, roughly, from the first opinion by the Supreme Court (March 8, 1948), to the date of the Final Decree (May 15,

[1] This extension order appears in the mandate issued to this Court on the remand from the opinion in 340 U. S.

1951), and, as to Newark and Ebsary, up to the filing of the complaint against each of them.

[*Antitrust Decree Claimed as Bar to Patent Suits*]

The Petitioner in each of the four suits here has filed, in the antitrust case, its separate petition to enjoin the USG suit against it and for associated relief. Very broadly stated, these petitions are based on claimed protection of the Final Decree in the antitrust case, on misuse of patents, and on prevention of a multiplicity of actions. Stay orders have been entered in the two Iowa District cases to await action here. Also, the United States has filed a petition to enjoin USG from asserting any claim or suit "in whole or in part on any of the license agreements adjudged illegal, null and void by the final decree of this Court entered on May 15, 1951, or on any provision thereof." As to any claims based on such license agreements, the United States alleges that such "are barred by, and constitute an attempt to defeat, said decree." As to any "alternative claims" set forth in such four suits, the United States "takes no position" as to whether or not they are barred by the Final Decree.

Both by briefs and oral arguments, the issues have been excellently presented by very able counsel for all of the parties.

A plan as a guide to our sequence in considering the issues before us is under four general headings as follows:

I—Jurisdiction
II—Scope of Article IV of the Decree
III—Modification of the Decree
IV—Misuse and Purge

This opinion will follow that arrangement.

I—Jurisdiction

Jurisdiction of a Court to act upon matters presented to it is purely a matter of power to act. Having such power, whether a Court should exercise it may or may not become a matter of discretion depending upon whether, under all the circumstances of the situation before the Court, the Court has a duty or has a choice.

Petitioners claim jurisdiction here on four grounds: (a) to compel obedience to the Decree, (b) to implement the Decree in order to effectuate its "basic" purposes, (c) to exercise a "paramount" jurisdiction under express reservations in Article X thereof, and (d), under broad powers of a court of equity, as the most appropriate forum to prevent possible misconstruction of the Decree, in a multiplicity of actions, by Courts unfamiliar with this antitrust case litigation.

Besides countering each of these grounds, USG contends (a) that only the Government (being the sole original complainant) can move to construe or enforce the Decree, and (b) that the Government can participate in the four suits as a permitted intervener or as an *amicus curii*.

Such being the contentions as to this issue, it seems logical to consider first the contentions of USG. The main reliance of USG is *Buckeye Coal and Railway Co. v. Hocking Valley Co.*, 269 U. S. 42. Petitioners distinguish this case on the grounds that the Buckeye was not a party to that antitrust suit (while Petitioners are defendants in such action here); and that Article X of this decree expressly reserves jurisdiction to enable "any of the parties to this decree * * * to apply to this Court, at any time for such orders" etc. They cite *Missouri-Kansas Pipe Line Co. v. U. S.* [1940-1943 TRADE CASES ¶ 56,103], 312 U. S. 502; *Local Loan Co. v. Hunt*, 292 U. S. 234 and *Terminal Railroad Assn. v. U. S.*, 266 U. S. 17 to support their contention that parties to an antitrust case may act to protect their interest based on the antitrust Decree.

[*General Enforcement Powers of Equity*]

Speaking generally and without regard to any special considerations applicable to antitrust suits, it is correct to say that a court of equity has power to enforce its decrees and that such power includes implementation of the basic purposes thereof in so far as such appears from the language or from the clear intendment thereof. These rules apply to civil antitrust suits brought by the Government with the important qualification or limitation as to the parties who may take advantage of them. This difference arises from the purposes of such suits. The purposes of such an action are to destroy an economic situation which is resulting from a conspiracy or monopoly in restraint of interstate commerce to the harm of the public.

To represent and protect this public interest is made the duty of the Attorney-General (15 U. S. C. A. § 4 and related sections of the Act).[2]

USG relies upon the *Buckeye Coal & Railway Co. et al. v. Hocking Valley Railway Company et al.*, 269 U. S. 42, which dismissed certain petitions in intervention seeking relief in an antitrust suit brought by the Government and in which a decree for dissolution had been entered some seven years before the intervening petitions were filed, as establishing the doctrine that only the Attorney-General can seek to enforce, construe or modify a decree requiring dissolution under the Act. There are expressions in the *Buckeye* case which tend to support such a view.[3] However, this statement is immediately followed by another which clearly implies that the situation might have been different had interveners been parties to the antitrust suit.[4]

Parties to an original antitrust suit have a status therein which often does not apply to outsiders. This arises from the practical effects of the decree upon the legal rights of the parties. Such a decree is based upon a determination that the Act has been violated by an existing economic situation. Necessarily, the relief is such alteration of that situation as will do away with all unlawful features and potentialities. Unavoidably, such legal surgical operations involve and change the inter-relationship of the defendants, whose only reason for being made parties defendant was that they participated in the violation of the Act. Such decrees are intensely practical. Often, in this readjusting process, a decree provides not only for duties but also for rights *inter se* the parties. Where such rights are given, they carry to the recipient party the right to urge compliance, within the limits of the decree.

This is the rule applied in *Terminal Railroad Association of St. Louis et al. v. United States et al.*, 266 U. S. 17. This was an action for contempt instituted by the "west side lines" against the "east side lines" based upon the contention that the latter had violated an antitrust case decree to the damage of rights alleged accorded the "west side lines" under that decree. In that opinion (p. 27) the Court stated:

> "In these proceedings, the United States did not join in the complaint or participate in the hearing in the District Court, but has since appeared and is aligned with the appellees. The Proceedings were instituted by the west side lines, not to vindicate the authority of the court, but to enforce rights claimed by them under the original decree. The controversy is between them and the east side lines as to whether the former or the latter shall bear transfer charges on west bound through freight."

Also, the Court (p. 29) stated:

> "* * * The question whether the east side lines are bound to pay transfer charges on west bound through freight depends upon the proper construction and application of the original decree."

[*Intervention in Columbia Gas Case Cited*]

There is another case which is important. In an antitrust suit by the *United States v. Columbia Gas and Electric Co. et al.*, a consent decree was entered. The closing paragraph of the decree provided that Panhandle Eastern Pipe Line Co. (not a party in the action), "upon proper application, may become a party hereto for the limited purpose of enforcing the rights conferred by Section IV hereof." Thereafter, Panhandle sought to do this by applying for leave to intervene, which was denied by the District Court. The appeal of *Panhandle is Missouri-Kansas Pipe Line Co. v. United States et al.* [1940-1943 TRADE CASES ¶ 56,103], 312 U. S. 503.

In discussing the case, the Supreme Court stated (p. 504) that the "issues here revolve around the scope of those provisions of the decree." Among the arguments pressed was a challenge to the jurisdiction over

[2] This duty is different and broader than the right given individuals to recover separate damages under 15 U. S. C. A. § 15. Compare *United States v. The Borden Company et al.*, [1954 TRADE CASES ¶ 67,754] 348 U. S. —, May 17, 1954.

[3] At page 49 of that opinion the Court stated: "* * * The United States, which must alone speak for the public interest, does not appear with them (the interveners) on this appeal. They have therefore no *locus standi*. *United States v. Northern Securities Co.*, 128 Fed. 865" (should be 808).

[4] At page 49 appears:
"Underneath all these reasons for dismissing the appeal, is the fundamental objection that these coal companies presented no case upon their petition justifying their intervention. They were not parties to the original suit."

the appeal or, "in the alternative, insisting on the propriety of the action of the district court" (p. 505). It was argued that "the Attorney-General is the guardian of the public interest in enforcing the antitrust laws * * * (and that) injection of new issues ought not to be allowed to delay disposition of the main litigation * * *" (p. 505). The Court stated (p. 506):

> "All of these arguments misconceive the basis of the right now asserted. Its foundation is the consent decree. We are not here dealing with a conventional form of intervention, whereby an appeal is made to the court's good sense to allow persons having a common interest with the formal parties to enforce the common interest with their individual emphasis. Plainly enough, the circumstances under which interested outsiders should be allowed to become participants in a litigation is, barring very special circumstances, a matter for the *nisi prius* court. But where the enforcement of a public law also demands distinct safeguarding of private interests by giving them a formal status in the decree, the power to enforce rights thus sanctioned is not left to the public authorities nor put in the keeping of the district court's discretion.
>
> "That is the present case. Panhandle's right to economic independence was at the heart of the controversy. An important aspect of that independence was the extension of its operations to permit sales in Detroit. The assurance of this extention was deemed so vital that it was safeguarded by explicit provisions in the decree."

Further, the Court stated (p. 508):

> "We are not concerned with the subsubstantiality of this claim. The sole question before us is whether there was standing to make the claim before the district court. We hold there was such standing. To enforce the rights conferred by Section IV was the purpose of the motion." "Nor can the enforcement of this protection be deemed remotely in conflict with the public duties of the Attorney-General, nor to bring in digressive issues, nor to impeach the existing decree. It is a vindication of the decree."

In the concluding paragraph, the Court states (p. 509):

> "In a memorandum filed by the Attorney General we are advised that on January 18, 1941, the district court filed an opinion approving the plan for modifying the original decree subject to some suggestions by the Government. This, we are told 'is believed to satisfy the public interest,' and so the Government desires to sustain the action of the court below without further litigation. We recognize the duty of expeditious enforcement of the antitrust laws. But expedition cannot be had at the sacrifice of rights which the original decree itself established. We assume that the district court will adjust the right which belongs to Panhandle with full regard to that public interest which underlay the original suit."

[*Jurisdiction Sustained*]

We think that these three cases announce the following rules of law applicable to the situation here: the Attorney-General is the representative of the "public interest" in antitrust cases brought by the Government; but that where a dissolution decree by specific statement or by fair implication therein accords rights to parties thereto, they have a standing, in the main suit, to enforce such rights in a manner consonant with the underlying purposes of the decree.[5]

In this Final Decree, there was (Article X) an expressly reserved jurisdiction "for the purpose of enabling any of the parties to this decree, or any other person, firm or corporation that may hereafter become bound thereby in whole or in part, to apply to this Court at any time for such orders, modifications, vacations or directions as may be necessary or appropriate (1) for the construction or carrying out of this decree, and (2) for the enforcement of compliance therewith.

Such reservation is sufficient to sustain jurisdiction.

For the reasons that the Petitioners here are parties to the original antitrust suit presenting claims to rights under the Final Decree; and that Article X of that Decree expressly reserves jurisdiction, we hold that jurisdiction to entertain these petitions

[5] We have confined our discussion to parties to the original Antitrust suits. However, there are other cases where persons not parties but directly affected by the decree in such cases have been allowed, in connection with such suits, to intervene or to defend to test their rights. Examples are *Hughes v. United States* [1952 TRADE CASES ¶ 67,213], 342 U. S. 353; *United States v. Paramount Pictures et al.* [1948-1949 TRADE CASES ¶ 62,244], 334 U. S. 131, 176-178; *United States v. Swift & Co. et al.*, 286 U. S. 106; *United States v. California Cooperative Canneries*, 279 U. S. 553; *Continental Ins. Co. et al. v. United States et al.*, 259 U. S. 156.

[¶ 67,813] United States v. United States Gypsum Co., et al.

In the United States District Court for the District of Columbia. Civil Action No. 8017. Filed July 6, 1954.

Case No. 548 in the Antitrust Division of the Department of Justice.

Petitions of the United States, National Gypsum Co., Certain-Teed Products Co., Ebsary Gypsum Co., Inc., and Newark Plaster Co. for Orders, Modifications or Directions for the Enforcement, Construction or Carrying Out of the Final Decree of May 15, 1951.

Sherman Antitrust Act

Private Enforcement and Procedure—Suit by Co-Defendants in U. S. Antitrust Suit to Restrain Other Defendant from Seeking to Recover for Use of Its Patents—Jurisdiction—Right of Private Parties to Seek Construction or Enforcement of Government Decree.—Petitioners, parties to a Government antitrust decree declaring certain patent licensing agreements void, sought an injunction against respondent, another party to the decree, to restrain four separate suits filed by the respondent against the petitioners in other courts for royalties or for the reasonable value of certain of its patents or for damages because of infringement. The contention of the respondent that the court had no jurisdiction to entertain the injunction suit because (1) only the Government could move to construe or enforce the final decree, and (2) the Government could participate in the four patent suits as an intervenor or as *amicus curiae* was overruled. Although the Attorney General represents the public interest in antitrust cases, where a decree accords rights to parties thereto, they can enforce such rights in a manner consonant with the underlying purposes of the decree. By the terms of the final decree jurisdiction was reserved for any parties to the decree to apply for construction and enforcement of the decree. Further, jurisdiction could be taken, because (1) a court of equity can compel obedience to its decree, and where it is contended that there has been a violation of the decree, the court can determine whether or not such violation has actually been committed; (2) when a status established by a final decree is allegedly endangered by the acts of the respondent, an issue within the jurisdiction of the court is created; (3) jurisdiction to modify the final decree within limits necessary to perfect its effectuation was expressly reserved by the terms of that decree; and (4) to avoid the possible misconstruction of the final decree in a multiplicity of actions, each involving the meaning and application of the decree.

See Dept. of Justice Enforcement and Procedure, Vol. 2, ¶ 8233.325, 8233.400, 8233.475; Private Enforcement and Procedure, Vol. 2, ¶ 9035.05.

Private Enforcement and Procedure—Where Right Sought to Be Enforced Is Integral Part of Scheme in Violation of Antitrust Laws—Patents—Suit for Royalties or for Infringement Damages—Licensing Agreements Void Under Final Judgment—Scope of Provision of Final Judgment.—Petitioners, parties to a Government antitrust decree declaring certain patent licensing agreements null and void, sued to restrain the respondent, another party to the decree, from bringing in other courts four separate suits, each based on alternative claims for royalties or for the reasonable value of the use of certain of its patents or for damages because of infringement. Petitioners contended that the final decree in the Government case, declaring license agreements illegal, null and void, barred the patent suits. Since two counts in each of the four patent suits were based squarely on license agreements set forth in the Government decree and declared null and void by it, further prosecution of these two counts was enjoined as violative of the final decree. Limited actions involving the direct issue of patent infringement were not enjoined, since in this situation, the final decree entered in the Government case would not be affected.

See Dept. of Justice Enforcement and Procedure, Vol. 2, ¶ 8233.325; Private Enforcement and Procedure, Vol. 2, ¶ 9041.155, 9041.350.

Private Enforcement and Procedure—Where Right Sought to Be Enforced Is Integral Part of Scheme in Violation of Antitrust Laws—Licensing Agreements Void Under Final Judgment—Modification of Judgment—Infringement, Contract, and *Quantum Meruit* Suits.—Petitioners, parties to a Government antitrust decree declaring certain patent licensing agreements null and void, sued to restrain the respondent, another party to the