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## Federal Practice—Dependent Claim Dismissed on Failure of Federal Claim

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## RECENT DECISIONS

tended to restrict circulation of published matter, whether the legislation was passed under the guise of the state taxing power or the state police power. See *Grosjean v. American Press Co.*, 297 U. S. 233 (1936); and *Near v. Minnesota*, 283 U. S. 697 (1931).

The First Amendment guarantees the right of the individual to express his views as to current issues and controversies. One of the main organs for such expression is the national magazine. There the reader finds editorial comment, letters to the editors, portraits of men in public office and general political argumentation. See current issues of *Newsweek*, *Colliers*, *The Atlantic Monthly* and *Time*. The fact that these magazines are printed for profit as well as for the dissemination of political information should not make them any less protected than a pamphlet distributed on religious matters, see *Strubers' case*, *supra*, at least where the conflicting right involved is that of the right of the individual's privacy in his own home.

It is submitted that perhaps the decision in the instant case can best be understood if viewed with the Court's extended interest in preserving the privacy of the individual. The Green River type ordinance, although it affects interstate commerce, is upheld as a valid exercise of the state police power when such ordinance is designed to provide to the home owner a privacy uninterrupted by house to house peddlers of varied house-hold articles. *Town of Green River v. Fuller Brush Co.*, *supra*. A blanket denial to all of the use of sound amplifying devices on the city's streets does not contravene the rights of "free speech," and "free press" if such denial is intended to protect the citizens from the annoyances of loud noises. *Kovacs v. Cooper*, 336 U. S. 77 (1948).

In the instant case, the Court has taken another step in the recognition of the citizen's right of privacy. The Court has now ruled that the constitutional guarantee of "free press" which is not absolute, see *Prince v. Massachusetts*, 321 U. S. 158 (1944), must also give way to the right of the citizen to be free from invasions of his privacy.

*Joseph A. Taddeo*

## FEDERAL PRACTICE—DEPENDENT CLAIM DISMISSED ON FAILURE OF FEDERAL CLAIM

A patent was issued on a removable shoulder pad for use in women's dresses. The patentee (plaintiff here) entered into an agreement with the defendant in this action whereby the latter was to have the use of the patent, if valuable, and in return would compensate the patentee for such use. The defendant used the device, but has failed to make payment. The United States Court of Appeals, Second

Circuit, held the patent invalid for lack of invention and, therefore, not infringed. It said that it had no jurisdiction over the second claim which asserted a breach of this agreement through failure to pay royalties, as it was a simple contract claim not arising out of the same identical facts giving rise to the patent action, and there was no diversity of citizenship. *Kleinman v. Betty Dain Creations*, 189 F. 2d 596 (2d Cir. 1951).

The Supreme Court held in *Siler v. Louisville & Nashville R.R. Co.*, 213 U. S. 175 (1908) that a Federal court, when it acquires jurisdiction over a suit because a federal question is involved, may pass on all issues in the case, even though it decides the federal question adversely to the party raising it. However, in its reaffirmation of that rule in *Hurn v. Oursler*, 289 U. S. 238 (1933) the court said that the rule does not go so far as to permit a federal court to assume jurisdiction over a separate and distinct cause of action merely because it is joined in a complaint with the federal cause of action. The Supreme Court distinguished between a case where there are two distinct grounds alleged for one cause of action, only one of which is a federal question, and a case where two separate and distinct causes of action are alleged, one only, being federal in character. In the first of those situations, where the federal question is not plainly wanting in substance, the Federal court, even though the federal ground is not established, may dispose of the case on the non-federal ground. In the second situation, the court may not hear the non-federal question on failure of the federal cause.

The Second Circuit has uniformly given a narrow interpretation to the *Hurn* rule despite persistent objection by Judge Clark. In *Lewis v. Vendome Bags Inc.*, 108 F. 2d 16 (2d Cir. 1939) the court dismissed a copyright claim, and then held that it could not decide a claim of unfair competition which arose from different facts as this was a separate cause of action. In *Musher Foundation Inc. v. Alba Trading Co.*, 127 F. 2d 9 (2d Cir. 1942) Augustus Hand, speaking for the court said that their interpretation of the *Hurn* rule was that a non-federal claim, over which the court had no jurisdiction because of the absence of diversity, might be heard on failure of the federal claim if the non-federal differed only because it asserted a different ground of recovery upon substantially the same set of facts. Similarly in *Kaplan v. Helen Hart Novelty Co.*, 182 F. 2d 311 (2d Cir. 1950) a majority of the court said that joinder of an unregistered trade mark claim with a patent claim did not give the court jurisdiction over the trade mark claim because the rights in issue under the patent and those under the trade mark are not dependent upon substantially the same facts. In the present suit, the facts involved in the two claims are not substantially the same and do not meet the *Hurn* test.

The majority's finding in the instant case that the second claim was for breach of contract seems well substantiated. In *Chadiloid Chemical Co. v. Johnson*, 203

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Fed. 993 (7th Cir. 1913) there was a violation of a license agreement and the patentee charged the licensee with infringement. The court held that covenants to pay royalties are matters of contract law and no words of the parties can make them matters of patent law. A claim in contract raises no federal question. Also in *American Pastry Products Corp. v. United Products Corp. et al*, 39 F. 2nd 181 (D. Mass. 1930) the court said that if there was an outstanding license on the face of which the defendant's conduct is authorized, in other words if it is within the scope of the license, the matter is one of contract. Since this second claim does not arise out of the same narrow set of facts as the federal claim, which is the requirement of the *Hurn* rule, and since it is not unfair competition as required by the statutory exception to the rule, the majority concluded there was no jurisdiction.

Judge Clark in his dissent argues that the facts as presented in this second claim constitute unfair competition, and therefore bring the case under 28 U.S.C.A., sec. 1338 (B) (1948) the statutory exception to the *Hurn* rule. See *Schreyer et al v. Casco Products Corp.*, 89 F. Supp. 177 (D. Conn. 1950). This section declares that "The district court shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent or trade mark laws."

Although it is difficult to agree with Clark's finding that the claim was one for unfair competition, the policy behind his reasoning is admirable. The federal rule as to dependent jurisdiction is too strict and it causes unfortunate "piece meal litigation." Judge Clark has stated that it will be no loss to statecraft if, in the daily activities of courts, the need of practical administration may dissuade compelling two lawsuits where one will completely serve the interests of the parties. *Lewis v. Vendome Bags Inc.*, *supra* at 20. To reject all consideration of what is spread upon the record and invite renewal of litigation in a state court is a lack of judicial economy hardly demanded to sustain our form of government. *Treasure Imports v. Henry Amdur & Son*, 127 F. 2nd 3 (2d Cir. 1942).

It is submitted that broad congressional action should make possible the common sense treatment of this subject. Perhaps some day Congress will enact legislation broadening the dependent jurisdiction of the federal courts. Such a law could require that where a bona fide federal claim fails, and the dependent non-federal claim arises out of the same general fact situation, the federal courts should entertain jurisdiction over the dependent claim.

*Charles Ryan Desmond*