

The Burger Court Opinion Writing Database

*Blonder-Tongue Laboratories, Inc. v.
University of Illinois Foundation*
402 U.S. 313 (1971)

Paul J. Wahlbeck, George Washington University
James F. Spriggs, II, Washington University
Forrest Maltzman, George Washington University



Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
THE CHIEF JUSTICE.

October 15, 1970

Re: No. 338 - Blonder-Tongue Laboratories v.
University of Illinois Foundation

Dear Hugo:

This will confirm my earlier oral message that I will
join in your position in the above.

*Replies
WSB.*

Mr. Justice Black

cc: The Conference

Supreme Court of the United States
Washington, D. C. 20543

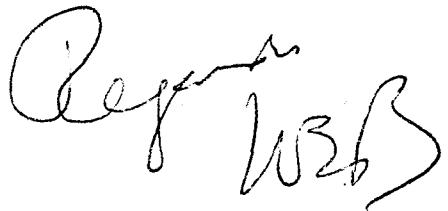
CHAMBERS OF
THE CHIEF JUSTICE

October 26, 1970

Re: No. 338 - Blonder-Tongue Laboratories v.
University of Illinois Foundation

Dear John:

The questions you propose are satisfactory
to me.



Mr. Justice Harlan

cc: The Conference

Supreme Court of the United States
Washington, D. C. 20543

April 22, 1971

CHAMBERS OF
THE CHIEF JUSTICE

No. 338 - Blonder-Tongue Lab. v. Univ. of Ill. Foundation

Dear Byron:

Please join me.

Regards,

W.B.

Mr. Justice White

cc: The Conference

To: The Chief Justice
Mr. Justice Douglas
Mr. Justice Harlan
Mr. Justice Brennan
Mr. Justice Stewart
Mr. Justice White
Mr. Justice Marshall
Mr. Justice Blackmun

2

From: Black, J.

SUPREME COURT OF THE UNITED STATES

Recirculated OCT 8 1970

October Term, 1970

Recirculated:

BLONDER-TONGUE LABORATORIES, INC. v.
UNIVERSITY OF ILLINOIS
FOUNDATION ET AL.

ON PETITION FOR WRIT OF CERTIORARI TO THE UNITED
STATES COURT OF APPEALS FOR THE
SEVENTH CIRCUIT

No. 338. Decided October —, 1970

MR. JUSTICE BLACK, with whom MR. JUSTICE WHITE
joins, dissenting.

I would grant certiorari to resolve a conflict in the Courts of Appeals on the validity of a patent for a home television antenna. In a previous case, the Court of Appeals for the Eighth Circuit held that this patent was invalid because of "obviousness," *Illinois Foundation v. Winegard Co.*, 402 F. 2d 125 (C. A. 8th Cir. 1968). Here the Court of Appeals for the Seventh Circuit rejected the Eighth Circuit view and held the patent valid, 422 F. 2d 769 (C. A. 7th Cir. 1970). Thus in the State of Illinois, the owner has a valid patent and a legal right to damages for infringement, while in the State of Iowa, just across the Mississippi River, the identical patent is worthless and anyone may use it with impunity.

When the Founding Fathers drafted our Constitution and made patent rights a matter of federal law, they rejected the idea that patents would be valid in some States and invalid in others. U. S. Const. Art. I, § 8. Under the affirmative grant of power to secure "to Authors and Inventors the exclusive Right to their respective Writings and Discoveries," Congress has created a patent system of uniform nationwide application. In the past this Court has achieved the patent uniformity

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE HUGO L. BLACK

October 26, 1970

Dear John,

Re: No. 338 - Blonder-Tongue Laboratories v.
University of Illinois Foundation.

As stated in the conference, I object to asking the lawyers to discuss the question about the present-day validity of the old case of Triplett v. Lowell, 297 U. S. 638. It strikes me as being bad practice for the Court to ask counsel to discuss whether old cases should be overruled when counsel have apparently never even thought enough of such a question to suggest it. I have no objection to overruling cases when they are bad but I think it is unwise judicial policy for the Court to raise questions that involve a departure from previous precedents and where such an idea has not even been remotely suggested by the lawyers.

I therefore shall continue to object to asking counsel to discuss your questions in the above case.

Sincerely,

H. L. B.

Mr. Justice Harlan

cc: Members of the Conference

Supreme Court of the United States
Washington, D. C. 20543

BR
M
CHAMBERS OF
JUSTICE HUGO L. BLACK

April 20, 1971

Dear Byron,

Re: No. 338- Blonder-Tongue
Laboratories, Inc. v. Univ. of
Illinois Foundation, et al.

Please join me in your opinion in this
case.

Sincerely,

Hugo
Hugo

Mr. Justice White

cc: Members of the Conference

October 26, 1970

Dear John
I enclose
a aantal
other questions
CW

MEMORANDUM TO THE CONFERENCE

Re: No. 338 - Blonder-Tongue Laboratories v.
University of Illinois Foundation

Dear Brethren:

These are the questions I think we should ask the parties to brief and argue in this case, in which the granting of the writ has already been announced. It would be desirable, of course, if there is a general consensus, to issue the request before the next Conference, as the parties may already be working on their briefs. Would you kindly let me know your reactions so that the Clerk may be instructed accordingly.

"In addition to the questions tendered in the petition for certiorari, the parties in this case are requested to address the following questions in their briefs and oral arguments:

1. Should the holding of Triplet v. Lowell, 297 U.S. 638, that a determination of patent invalidity is not res judicata as against the patentee in subsequent litigation against a different defendant, be adhered to?
2. If not, does the determination of invalidity in the Winegard litigation bind the respondents in this case?"

Sincerely,

J. M. H.

April 22, 1971

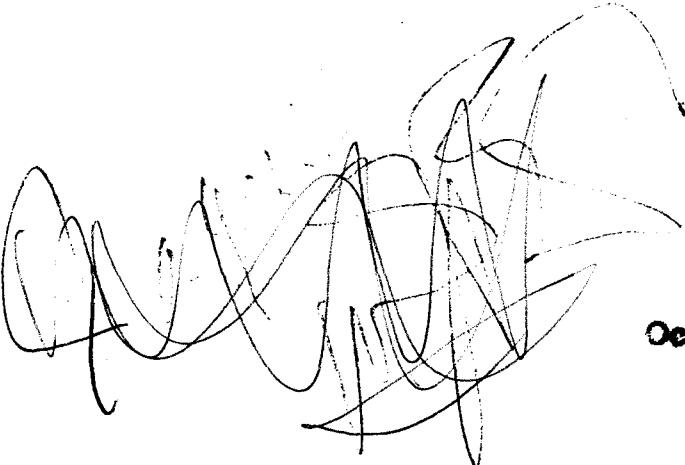
Dear Byron:

In No. 338 - Blonder-Tongue v.
University of Illinois, I agree with
your opinion.

W. O. D.

Mr. Justice White

W
Ad



October 26, 1970

MEMORANDUM TO THE CONFERENCE

**Re: No. 338 - Blonder-Tongue Laboratories v.
University of Illinois Foundation**

Dear Brethren:

These are the questions I think we should ask the parties to brief and argue in this case, in which the granting of the writ has already been announced. It would be desirable, of course, if there is a general consensus, to issue the request before the next Conference, as the parties may already be working on their briefs. Would you kindly let me know your reactions so that the Clerk may be instructed accordingly.

"In addition to the questions tendered in the petition for certiorari, the parties in this case are requested to address the following questions in their briefs and oral arguments:

1. Should the holding of Triplet v. Lowell, 297 U.S. 638, that a determination of patent invalidity is not res judicata as against the patentee in subsequent litigation against a different defendant, be adhered to?
2. If not, does the determination of invalidity in the Winegard litigation bind the respondents in this case?"

Sincerely,

J. M. H.

Supreme Court of the United States
Washington, D. C. 20542

CHAMBERS OF
JUSTICE JOHN M. HARLAN

April 26, 1971

Dear Byron:

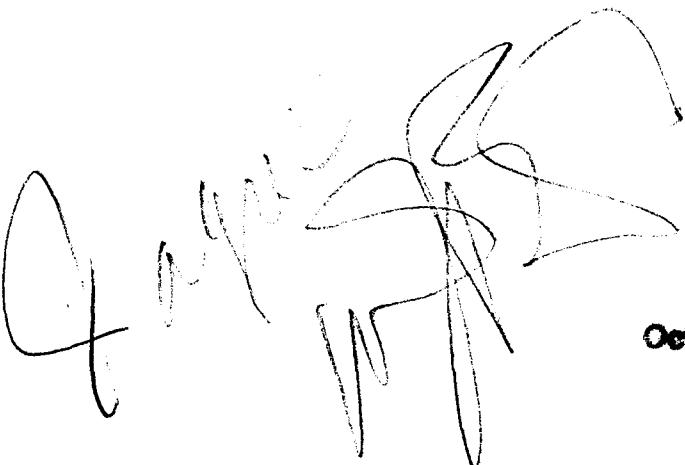
Re: No. 338, 1970 Term
Blonder-Tongue Laboratories v.
University of Illinois Foundation

I am happy to join your careful opinion for the Court in this messy case. I offer two minor suggestions for your consideration. First, in view of the American Patent Law Association's fear that Anderson's-Black Rock v. Pavement Salvage Co., 396 U.S. 57 (1969), revived the "invention" test of patentability, perhaps it would be better to rephrase the sentence on page 30 at note 39 to read something like "A patent yielding returns for what would have been obvious to a person having ordinary skill in the art is anomalous." Second, at the top of page 34, I would insert "as a practical matter" between the words "are" and "unrecoverable." Without some change along this line, the sentence might hereafter be interpreted to lay down a rule of privity or proximate causation which I am sure you do not intend.

Sincerely,

J. M. H.

Mr. Justice White
cc: The Conference



October 26, 1970

MEMORANDUM TO THE CONFERENCE

Re: No. 333 - Blonder-Tongue Laboratories v.
University of Illinois Foundation

Dear Brethren:

These are the questions I think we should ask the parties to brief and argue in this case, in which the granting of the writ has already been announced. It would be desirable, of course, if there is a general consensus, to issue the request before the next Conference, as the parties may already be working on their briefs. Would you kindly let me know your reactions so that the Clerk may be instructed accordingly.

"In addition to the questions tendered in the petition for certiorari, the parties in this case are requested to address the following questions in their briefs and oral arguments:

1. Should the holding of Triplet v. Lowell, 287 U.S. 638, that a determination of patent invalidity is not res judicata as against the patentee in subsequent litigation against a different defendant, be adhered to?
2. If not, does the determination of invalidity in the Winegard litigation bind the respondents in this case?"

Sincerely,

J. M. H.

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE WM. J. BRENNAN, JR.

April 12, 1971

RE: No. 338 - Blonder-Tongue Laboratories,
Inc. v. Univ. of Illinois Foundation

Dear Byron:

I agree.

Sincerely,


W.J.B. Jr.

Mr. Justice White
cc: The Conference

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE POTTER STEWART

October 26, 1970

No. 338 - Blonder-Tongue Labs v.
University of Illinois Foundation

Dear John,

The questions you have framed in this
case are satisfactory to me.

Sincerely yours,

P.S.

Mr. Justice Harlan

Copies to the Conference

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE POTTER STEWART

April 26, 1971

No. 338 - Blonder Tongue Laboratories, Inc.

Dear Byron,

I am glad to join your opinion for the Court
in this case.

Sincerely yours,

OSW
J

Mr. Justice White

Copies to the Conference

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE BYRON R. WHITE

April 12, 1971

MEMORANDUM TO THE CONFERENCE

Re: No. 338 - Blonder-Tongue Laboratories, Inc. v.
University of Illinois Foundation et al.

Although I am not confident that the Conference clearly determined to modify Triplett v. Lowell, there was substantial sentiment to this effect. Accordingly, I submit the attached draft to put the matter at issue. This version does not reach issues of validity and publication as such.


B.R.W.

To: The Chief Justice
 Mr. Justice Black
 ✓Mr. Justice Douglas
 Mr. Justice Harlan
 Mr. Justice Brennan
 Mr. Justice Stewart
 Mr. Justice Marshall
 Mr. Justice Blackmun

From: White, J.

1st DRAFT

Circulated: 4-12-71

Recirculated:

SUPREME COURT OF THE UNITED STATES

No. 338.—OCTOBER TERM, 1970

Blonder-Tongue Laboratories, Inc., Petitioner,
 v.
 University of Illinois Foundation et al.

} On Writ of Certiorari to the
 United States Court of Appeals for the Seventh Circuit.

[April --, 1971]

MR. JUSTICE WHITE delivered the opinion of the Court.

Respondent University of Illinois Foundation (hereafter Foundation) is the owner by assignment of U. S. Patent 3,210,767, issued to Dwight E. Isbell on October 5, 1965. The patent is for "Frequency Independent Uni-directional Antennas," and Isbell first filed his application May 3, 1960. The antennas covered are designed for transmission and reception of electromagnetic radio frequency signals used in many types of communications, including the broadcasting of radio and television signals.

The patent has been much litigated since it was granted, primarily because it claims a high quality television antenna for color reception.¹ The first infringement suit brought by the Foundation was filed in the Southern District of Iowa against the Winegard Company, an antenna manufacturer.² Trial was to the court, and after pursuing the inquiry mandated by *Graham v. John Deere Co.*, 383 U. S. 1, 37 (1966), Chief Judge Stephenson held the

¹ The Foundation has filed six infringement actions based on the Isbell patent. Respondent Foundation's Brief, p. 22.

² The Foundation claimed that all of the Isbell patent's 15 claims except numbers 6, 7, and 8 were infringed by one or more of Winegard's 22 antenna models designed for receiving television signals.

WJW

R
pp 12, 22, 30, 32, 34
R
*Join it out
already done*

To: The Chief Justice
Mr. Justice Black
Mr. Justice Douglas
Mr. Justice Harlan
Mr. Justice Brennan
Mr. Justice Stewart
~~Mr.~~ Justice Marshall
Mr. Justice Blackmun

2nd DRAFT

From: White, J.

SUPREME COURT OF THE UNITED STATES

Recirculated:

No. 338.—OCTOBER TERM, 1970 Recirculated: 4-38-71

Blonder-Tongue Laboratories, Inc., Petitioner,
v.
University of Illinois Foundation et al.

On Writ of Certiorari to the
United States Court of
Appeals for the Seventh
Circuit.

[May —, 1971]

MR. JUSTICE WHITE delivered the opinion of the Court.

Respondent University of Illinois Foundation (hereafter Foundation) is the owner by assignment of U. S. Patent 3,210,767, issued to Dwight E. Isbell on October 5, 1965. The patent is for "Frequency Independent Unidirectional Antennas," and Isbell first filed his application May 3, 1960. The antennas covered are designed for transmission and reception of electromagnetic radio frequency signals used in many types of communications, including the broadcasting of radio and television signals.

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² The Foundation claimed that all of the Isbell patent's 15 claims except numbers 6, 7, and 8 were infringed by one or more of Winegard's 22 antenna models designed for receiving television signals.

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE THURGOOD MARSHALL

April 27, 1971

Re: No. 338 - Blonder-Tongue Laboratories, Inc.
v. University of Illinois Foundation

Dear Byron:

Please join me.

Sincerely,



T.M.

Mr. Justice White

cc: The Conference

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE HARRY A. BLACKMUN

October 15, 1970

Re: No. 338 - Blonder-Tongue Laboratories v.
University of Illinois Foundation

Dear Hugo:

On October 9 I indicated to you that on reflection I decided to join your position in this case. This note will confirm that oral statement.

Sincerely,

Mr. Justice Black

cc: The Conference

G

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE HARRY A. BLACKMUN

October 26, 1970

Re: No. 338 - Blonder-Tongue Laboratories, Inc.
v. University of Illinois Foundation

Dear John:

It seems to me that the questions you propose are most appropriate. For me, they express the key to the granting of certiorari and, without the questions, the parties might be unaware of the real basis for the Court's action.

Sincerely,



Mr. Justice Harlan

cc: The Conference

April 26, 1971

Re: No. 338 - Blonder-Tongue Laboratories, Inc.
v. University of Illinois Foundation

Dear Byron:

Please join me.

Sincerely,

H. A. B.

Mr. Justice White

cc: The Conference