The Burger Court Opinion Writing Database

Gottschalk v. Benson

409 U.S. 63 (1972)

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

November 17, 1972

Re: 71-485 - Gottschalk v. Benson

Dear Bill:

Please join me.

Regards,

Warren

Mr. Justice Douglas

Copies to the Conference

Please join me
WOD

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

CHAMBERS OF
JUSTICE WILLIAM O. DOUGLAS

November 9, 1972

MEMORANDUM TO THE CONFERENCE:

In re No. 71-485 - Gottschalk v. Benson,

I asked my office to circulate the opinion October 27 last. Apparently it was not circulated. So I am sending it around belatedly.

W. O. D.

Again!!

2nd DRAFT

SUPREME COURT OF THE UNITED STATES

No. 71-485

Robert Gottschalk, Acting Commissioner of Patents, Petitioner, *v.* Gary R. Benson and Arthur C. Tabbot.	On Writ of Certiorari to the United States Court of Customs and Patent Appeals.

11/9/72

[November —, 1972]

MR. JUSTICE DOUGLAS delivered the opinion of the Court.

Respondents filed in the Patent Office an application for an invention which was described as being related "to the processing of data by program and more particularly to the programmed conversion of numerical information" in general purpose digital computers. They claimed a method for converting binary-coded-decimal (BCD) numerals into pure binary numerals. The claims were not limited to any particular art or technology, to any particular apparatus or machinery, or to any particular end use. They purported to cover any use of the claimed method in a general purpose digital computer of any type. Claims 8 and 13 [1] were rejected by the Patent Office but sustained by the Court of Customs and Patent Appeals, 441 F. 2d 682. The case is here on a petition for a writ of certiorari. 406 U. S. —.

The question is whether the method described and claimed is a "process" within the meaning of the Patent Act.[2]

[1] They are set forth in the Appendix to this opinion.

[2] 35 U. S. C. § 100 (b) provides:

"The term 'process' means process, art or method, and includes a

p. 10

To: The Chief Justice
Mr. Justice Brennan
Mr. Justice Stewart
Mr. Justice White
Mr. Justice Marshall
Mr. Justice Blackmun
Mr. Justice Powell
Mr. Justice Rehnquist

3rd DRAFT

SUPREME COURT OF THE UNITED STATES

No. 71-485

Circulated: _____

Recirculated: 11-10

Robert Gottschalk, Acting Commissioner of Patents, Petitioner, *v.* Gary R. Benson and Arthur C. Tabbot.

On Writ of Certiorari to the United States Court of Customs and Patent Appeals.

[November —, 1972]

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4th DRAFT

SUPREME COURT OF THE UNITED STATES

No. 71-485

Robert Gottschalk, Acting Commissioner of Patents, Petitioner, *v.* Gary R. Benson and Arthur C. Tabbot.	On Writ of Certiorari to the United States Court of Customs and Patent Appeals.

[November —, 1972]

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

CHAMBERS OF
JUSTICE WM. J. BRENNAN, JR.

November 9, 1972

RE: No. 71-485 - Gottschalk v. Benson

Dear Bill:

I agree.

Sincerely,

Bill

Mr. Justice Douglas

cc: The Conference

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

CHAMBERS OF
JUSTICE POTTER STEWART

November 9, 1972

RE: NO. 71-485 - GOTTSCHALK v. BENSON

Dear Bill,

I should appreciate your stating at the foot of your opinion in this case that I did not participate in its consideration or decision.

Sincerely yours,

P.S.

Mr. Justice Douglas

Copies to the Conference

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

CHAMBERS OF
JUSTICE BYRON R. WHITE

November 14, 1972

Re: No. 71-485 - Gottschalk v. Benson

Dear Bill:

On page eight of your circulation in this case you say that a process patent must either be tied to a particular machine or apparatus or must operate to change articles or materials to a different state or thing. I have some difficulties with this formulation.

First, because claim 8 refers to a "shift register" in almost every step of the described process, it is not irrational to conclude that the process is tied to the specific equipment of which a shift register is normally a part.

Perhaps just as telling with respect to both claims is the argument of the Patent Court, and others, that the described process is necessarily tied to computers because it has no practical utility or application except for use in connection with such equipment.

Also, even if these claims were fatally defective for lack of a machine tie, either these or the next claims that were drafted could easily be made to pass muster.

I feel some compulsion, therefore, to consider the view that I expressed at conference. Simply put, it is this: If, as everyone including Hugh Cox admits, one cannot patent an idea, a mathematical formula or an algorithm and if the algorithm for converting binary code to pure binary has no practical application except in connection with a computer, then a "process" should not be patented even when tied to a computer because the patent would wholly preempt the formula and in practical effect would be a patent on the algorithm itself.

WD

Perhaps this gives more content to the no-patent-on-ideas rule than has been true in the past. It also gives the rule clear priority over what may obviously read on the statutory definition of "process"--a "new use" for an existing machine, that is, a computer being used to practice a mathematical formula that was never known or conceived before.

Could we chat about this? I do want to join you if at all possible. I have not circulated this memorandum.

Sincerely,

Byron

Mr. Justice Douglas

3. You joined 11/16

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

CHAMBERS OF
JUSTICE BYRON R. WHITE

November 15, 1972

Re: No. 71-485 - Gottschalk v. Benson

Dear Bill:

Please join me.

Sincerely,

Mr. Justice Douglas

Copies to Conference

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

file

CHAMBERS OF
JUSTICE THURGOOD MARSHALL

November 10, 1972

Re: No. 71-485 - Gottschalk v. Benson

Dear Bill:

Please join me.

Sincerely,

T.M.

Mr. Justice Douglas

cc: Conference

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

CHAMBERS OF
JUSTICE HARRY A. BLACKMUN

November 9, 1972

Re: No. 71-485 - Gottschalk v. Benson

Dear Bill:

Will you please note, for any opinion filed in this case, that I also did not participate in its consideration or decision.

Sincerely,

HAB.

Mr. Justice Douglas

cc: The Conference

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

CHAMBERS OF
JUSTICE LEWIS F. POWELL, JR.

November 9, 1972

Re: No. 71-485 Gottschalk v. Benson

Dear Bill:

Please note at the appropriate place that I did not participate in the above case.

Sincerely,

Lewis

Mr. Justice Douglas

LFP, Jr.:pls

WO

2nd DRAFT

SUPREME COURT OF THE UNITED STATES

No. 71-485

Robert Gottschalk, Acting Commissioner of Patents, Petitioner, *v.* Gary R. Benson and Arthur C. Tabbot. | On Writ of Certiorari to the United States Court of Customs and Patent Appeals.

[November —, 1972]

MR. JUSTICE REHNQUIST, dissenting.

The question presented by this case is whether the respondents' digital computer program is a patentable "process" within the meaning of the Patent Act, 35 U. S. C. §§ 100 (b), 101 (1970). The answer to this question depends on whether the program is properly classifiable as simply an abstract mathematical principle or whether the mental discovery behind the program has been reduced to a specific and concrete application. All the parties agree that the former is not patentable, while the Court's previous decisions make it clear that the latter may be.[1]

The determination of whether or not respondents' program falls within the meaning of the statute requires, in my estimation, both a basic technical understanding of

[1] In passing on these types of claims, the Court of Customs and Patent Appeals has developed the so-called mental-step doctrine which holds that "purely mental steps do not form a process which falls within the scope of patentability as defined by statute." *Application of Shao Wen Yuan*, 188 F. 2d 377, 380 (CCPA 1951). While this Court has never passed directly on the appropriateness of the mental-step doctrine *per se* in gauging the patentability of process claims, we have held that fundamental scientific truths or phenomena of nature as such are not patentable. *E. g., Funk Bros. Seed Co.* v. *Kalo Co.*, 333 U. S. 127, 130 (1948).

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

CHAMBERS OF
JUSTICE WILLIAM H. REHNQUIST

November 15, 1972

Re: No. 71-485 - Gottschalk v. Benson

Dear Bill:

The fourth draft of your opinion for the Court in this case pretty well accommodates the major thrust of my draft dissent. I don't feel sufficiently strongly about the patentability of this particular process to dissent from your opinion if you retain the existing changes on pages 8 and 9, with whatever changes in style you think appropriate in view of the fact that there will apparently be no dissent.

Sincerely,

WHR

Mr. Justice Douglas

Copies to Conference