The Burger Court Opinion Writing Database

Kewanee Oil Co. v. Bicron Corp.

416 U.S. 470 (1974)

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

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

1st DRAFT

From: The Chief Justice

Circulated: APR 22 1974

Recirculated: _____

SUPREME COURT OF THE UNITED STATES

No. 73–187

Kewanee Oil Company, Petitioner, *v.* Bicron Corporation et al. } On Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit.

[April —, 1974]

MR. CHIEF JUSTICE BURGER delivered the opinion of the Court.

We granted certiorari to resolve a question on which there is a conflict in Courts of Appeals: whether state trade secret protection is pre-empted by operation of the federal patent law.[1] In the instant case the Sixth Circuit Court of Appeals held that there was pre-emption.[2] The Second, Fourth, Fifth, and Ninth Circuit Courts of Appeals have reached the opposite conclusion.[3]

I

Harshaw Chemical Company, an unincorporated division of Petitioner, is a leading manufacturer of a type of synthetic crystal which is useful in the detection of ionizing radiation. In 1949 Harshaw commenced research into

[1] 414 U. S. 818 (1973).

[2] *Kewanee Oil Company* v. *Bicron Corporation*, 478 F. 2d 1074 (CA6 1973).

[3] *Painton & Co.* v. *Bourns, Inc.*, 442 F. 2d 216 (CA2 1971); *Dekar Industries, Inc.* v. *Bissett-Berman Corp.*, 434 F. 2d 1304 (CA9 1970), cert. denied, 402 U. S. 945 (1971); *Water Services, Inc.* v. *Tesco Chemicals, Inc.*, 410 F. 2d 163 (CA5 1969); *Winston Research Corp.* v. *Minnesota Mining & Mfg. Co.*, 350 F. 2d 134 (CA9 1965); *Servo Corp. of America* v. *General Electric Co.*, 337 F. 2d 716 (CA4 1964), cert. denied, 383 U. S. 934 (1966).

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2nd DRAFT

SUPREME COURT OF THE UNITED STATES

No. 73–187

Kewanee Oil Company, Petitioner, *v.* Bicron Corporation et al. } On Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit.

[January —, 1974]

MR. JUSTICE DOUGLAS, dissenting.

Today's decision is at war with the philosophy of *Sears, Roebuck & Stiffel Co.*, 376 U. S. 225, and *Compco Corp* v. *Day-Brite Lighting, Inc.*, 376 U. S. 234. Those cases involved patents—one of a pole lamp and one of fluorescent lighting fixtures each of which was declared invalid. The lower courts held, however, that though the patents were invalid the sale of identical or confusing similar products to the products of the patentees violated state unfair competition laws. We held that when an article is unprotected by a patent state law may not forbid others to copy it, because every article not covered by a valid patent is in the public domain. Congress in the patent laws decided that where no patent existed, free competition should prevail; that where a patent is rightfully issued, the right to exclude others should obtain for no longer than 17 years and that the States may not "under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objective of federal patent laws," [1] 376 U. S., at 231.

[1] Here as in *Lear Inc.* v. *Adkins*, 395 U. S. 653, 674, which held that a licensee of a patent is not precluded by a contract from

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

Please join me

SUPREME COURT OF THE UNITED STATES

Mr. J.

Circulated: 4-24

No. 73-187

Recirculated:

Kewanee Oil Company, Petitioner, *v.* Bicron Corporation et al. } On Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit.

[January —, 1974]

MR. JUSTICE DOUGLAS, dissenting.

Today's decision is at war with the philosophy of *Sears, Roebuck & Co.* v. *Stiffel Co.*, 376 U. S. 225, and *Compco Corp* v. *Day-Brite Lighting, Inc.*, 376 U. S. 234. Those cases involved patents—one of a pole lamp and one of fluorescent lighting fixtures each of which was declared invalid. The lower courts held, however, that though the patents were invalid the sale of identical or confusing similar products to the products of the patentees violated state unfair competition laws. We held that when an article is unprotected by a patent state law may not forbid others to copy it, because every article not covered by a valid patent is in the public domain. Congress in the patent laws decided that where no patent existed, free competition should prevail; that where a patent is rightfully issued, the right to exclude others should obtain for no longer than 17 years and that the States may not "under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objective of federal patent laws," [1] 376 U. S., at 231.

[1] Here as in *Lear Inc.* v. *Adkins*, 395 U. S. 653, 674, which held that a licensee of a patent is not precluded by a contract from

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

4th DRAFT

From: Douglas, J.

SUPREME COURT OF THE UNITED STATES

No. 73-187

Circulated: _____

Recirculated: 4/25/74

Kewanee Oil Company, Petitioner, v. Bicron Corporation et al. } On Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit.

[January —, 1974]

MR. JUSTICE DOUGLAS, with whom MR. JUSTICE BRENNAN concurs, dissenting.

Today's decision is at war with the philosophy of *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U. S. 225, and *Compco Corp* v. *Day-Brite Lighting, Inc.*, 376 U. S. 234. Those cases involved patents—one of a pole lamp and one of fluorescent lighting fixtures each of which was declared invalid. The lower courts held, however, that though the patents were invalid the sale of identical or confusing similar products to the products of the patentees violated state unfair competition laws. We held that when an article is unprotected by a patent state law may not forbid others to copy it, because every article not covered by a valid patent is in the public domain. Congress in the patent laws decided that where no patent existed, free competition should prevail; that where a patent is rightfully issued, the right to exclude others should obtain for no longer than 17 years and that the States may not "under some other law, such as that forbidding unfair competition, give protection of a kind that clashes with the objective of federal patent laws," [1] 376 U. S., at 231.

[1] Here as in *Lear, Inc.* v. *Adkins*, 395 U. S. 653, 674, which held that a licensee of a patent is not precluded by a contract from

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

CHAMBERS OF
JUSTICE WM. J. BRENNAN, JR.

April 25, 1974

RE: No. 73-187 Kewanee Oil v. Bicron Corp.

Dear Bill:

Please join me in your dissenting opinion in the above.

Sincerely,

Bill

Mr. Jutice Douglas

cc: The Conference

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

CHAMBERS OF
JUSTICE POTTER STEWART

April 23, 1974

73-187, Kewanee Oil v. Bicron

Dear Chief,

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

Sincerely yours,

P.S.

The Chief Justice

Copies to the Conference

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

CHAMBERS OF
JUSTICE BYRON R. WHITE

May 4, 1974

Re: No. 73-187 - Kewanee Oil Co. v. Bicron Corporation

Dear Chief:

Please join me.

Sincerely,

Byron

The Chief Justice

Copies to Conference

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

1st DRAFT

From: Marshall, J.

Circulated: MAY 8 19

Recirculated:

SUPREME COURT OF THE UNITED STATES

No. 73-187

Kewanee Oil Company, Petitioner, *v.* Bicron Corporation et al.	On Writ of Certiorari to the United States Court of Appeals for the Sixth Circuit.

[May —, 1974]

MR. JUSTICE MARSHALL, concurring in the result.

Unlike the Court, I do not believe that the possibility that an inventor with a patentable invention will rely on state trade secret law rather than apply for a patent is "remote indeed." *Ante*, at 19. State trade secret law provides substantial protection to the inventor who intends to use or sell the invention himself rather than license it to others, protection which in its unlimited duration is clearly superior to the 17-year monopoly afforded the patent laws. I have no doubt that the existence of trade secret portection provides in some instances a substantial disincentive to entrance into the patent system, and thus deprives society of the benefits of public disclosure of the invention which it is the policy of the patent laws to encourage. This case may well be such an instance.

But my view of sound policy in this area does not dispose of this case. Rather, the question presented in this case is whether Congress, in enacting the patent laws, intended merely to offer inventors a 17-year monopoly in exchange for disclosure of their invention, or instead to exert pressure on inventors to enter into this exchange by withdrawing any alternative possibility of legal protection for their inventions. I am persuaded that the former is the case. State trade secret laws and

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

CHAMBERS OF
JUSTICE HARRY A. BLACKMUN

April 24, 1974

Dear Chief:

Re: No. 73-187 - Kewanee Oil Co. v. Bicron Corp.

Please join me.

Sincerely,

Harry

The Chief Justice

Copies to the Conference

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

CHAMBERS OF
JUSTICE LEWIS F. POWELL, JR.

January 16, 1974

No. 73-187 Kewanee Oil v. Bicron

Dear Chief:

It has now come to my attention that one of the amicus briefs filed in the above case is on behalf of a corporation in which my wife (and a trust for her benefit) owns some shares.

I recall our discussion at the beginning of this Term as to general policy with respect to disqualification on the basis of amicus briefs. In summary, as I understood it, disqualification is certainly not automatic or even customary, but rests within the discretion of the individual Justice. I have no idea what interest this particular corporation has in this case, but the fact that it filed a brief prompts me to withdraw in view of Jo's personal interest.

I regret not having noted this before, but I do not recall many previous cases in which as many as 32 printed briefs and petitions have been filed.

I assume that the case should be resubmitted to the Conference, in which I will not participate.

Sincerely,

L.F.P.

The Chief Justice

lfp/ss

cc: The Conference

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

CHAMBERS OF
JUSTICE LEWIS F. POWELL, JR.

May 10, 1974

No. 73-187 Kewanee Oil v. Bicron

Dear Chief:

In accordance with my letter to you and the Conference of January 16, I would appreciate your adding at the end of the Court's opinion in the above case that I did not participate in the decision.

Sincerely,

L.F.P.

The Chief Justice

lfp/ss

cc: The Conference

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

CHAMBERS OF
JUSTICE WILLIAM H. REHNQUIST

April 24, 1974

Re: No. 73-187 - Kewanee Oil Co. v. Bicron Corp.

Dear Chief:

Please join me in your opinion for the Court in this case.

Sincerely,

WHR

The Chief Justice

Copies to the Conference