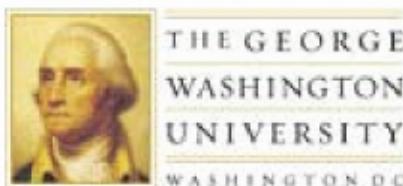


The Burger Court Opinion Writing Database

Dann v. Johnston

425 U.S. 219 (1976)

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



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

CHAMBERS OF
THE CHIEF JUSTICE

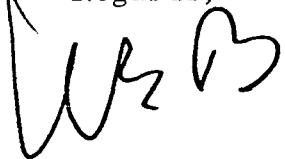
March 24, 1976

Re: 74-1033 - Dann v. Johnston

Dear Thurgood:

I join you in your circulation of March 4. You have
now paid your debt to patents!

Regards,



Mr. Justice Marshall

Copies to the Conference

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

CHAMBERS OF
JUSTICE WM. J. BRENNAN, JR.

February 27, 1976

RE: No. 74-1033 Dann v. Johnston

Dear Thurgood:

I agree.

Sincerely,

Bill

Mr. Justice Marshall

cc: The Conference

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

CHAMBERS OF
JUSTICE POTTER STEWART

February 26, 1976

Re: No. 74-1033, Dann v. Johnston

Dear Thurgood,

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

Sincerely yours,

P.S.

Mr. Justice Marshall

Copies to the Conference

✓
Supreme Court of the United States
Washington, D. C. 20543
5

CHAMBERS OF
JUSTICE BYRON R. WHITE

March 19, 1976

Re: No. 74-1033 — Dann v. Johnston

Dear Thurgood:

As you know, I am with you in this case.
I am sorry I did not confirm this at an earlier
time.

Sincerely,



Mr. Justice Marshall

cc: The Conference

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

From: Mr. Justice Marshall

Circulated: FEB 25 1976

Recirculated: _____

1st DRAFT

SUPREME COURT OF THE UNITED STATES

No. 74-1033

C. Marshall Dann, Commissioner of Patents and Trademarks, Petitioner,
v.
Thomas R. Johnston.

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

[March —, 1976]

MR. JUSTICE MARSHALL delivered the opinion of the Court.

Respondent has applied for a patent on what is described in his patent application as a "machine system for automatic record keeping of bank checks and deposits." The system permits a bank to furnish a customer with subtotals of various categories of transactions completed in connection with the customer's single account, thus saving the customer the time and/or expense of conducting this bookkeeping himself. As respondent has noted, the "invention is being sold as a computer program to banks and to other data processing companies so that they can perform these data processing services for depositors." Brief for Appellant, at 18, *Application of Johnston*, 502 F. 2d 765 (CCPA 1974).

Petitioner and respondent, as well as various *amici*, have presented lengthy arguments addressed to the question of the general patentability of computer programs. Cf. *Gottschalk v. Benson*, 409 U. S. 63 (1972). We find no need to treat that question in this case, however, because we conclude that in any event respondent's system is unpatentable on grounds of obviousness. 35

Page 11 & Stylistic change throughout

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

From: Mr. Justice Marshall

Circulated:

Recirculated: MAR 3 1976

2nd DRAFT

SUPREME COURT OF THE UNITED STATES

No. 74-1033

C. Marshall Dann, Commissioner of Patents and Trademarks, Petitioner,
v.
 Thomas R. Johnston. } On Writ of Certiorari to the United States Court of Customs and Patent Appeals.

[March —, 1976]

MR. JUSTICE MARSHALL delivered the opinion of the Court.

Respondent has applied for a patent on what is described in his patent application as a "machine system for automatic record keeping of bank checks and deposits." The system permits a bank to furnish a customer with subtotals of various categories of transactions completed in connection with the customer's single account, thus saving the customer the time and/or expense of conducting this bookkeeping himself. As respondent has noted, the "invention is being sold as a computer program to banks and to other data processing companies so that they can perform these data processing services for depositors." Brief for Appellant, at 18, *Application of Johnston*, 502 F. 2d 765 (CCPA 1974).

Petitioner and respondent, as well as various *amici*, have presented lengthy arguments addressed to the question of the general patentability of computer programs. Cf. *Gottschalk v. Benson*, 409 U. S. 63 (1972). We find no need to treat that question in this case, however, because we conclude that in any event respondent's system is unpatentable on grounds of obviousness. 35

5, 6

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

From: Mr. Justice Marshall

Circulated: _____

Recirculated: MAR 4 1976

3rd DRAFT

SUPREME COURT OF THE UNITED STATES

No. 74-1038

C. Marshall Dann, Commis-
 sioner of Patents and
 Trademarks, Petitioner,
 v.
 Thomas R. Johnston.

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

[March —, 1976]

MR. JUSTICE MARSHALL delivered the opinion of the Court.

Respondent has applied for a patent on what is described in his patent application as a "machine system for automatic record keeping of bank checks and deposits." The system permits a bank to furnish a customer with subtotals of various categories of transactions completed in connection with the customer's single account, thus saving the customer the time and/or expense of conducting this bookkeeping himself. As respondent has noted, the "invention is being sold as a computer program to banks and to other data processing companies so that they can perform these data processing services for depositors." Brief for Appellant, at 18, *Application of Johnston*, 502 F. 2d 765 (CCPA 1974).

Petitioner and respondent, as well as various *amici*, have presented lengthy arguments addressed to the question of the general patentability of computer programs. Cf. *Gottschalk v. Benson*, 409 U. S. 63 (1972). We find no need to treat that question in this case, however, because we conclude that in any event respondent's system is unpatentable on grounds of obviousness. 35

Page 11

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

From: Mr. Justice Marshall

Circulated:

Recirculated: MAR 26 1976

4th DRAFT

SUPREME COURT OF THE UNITED STATES

No. 74-1033

C. Marshall Dann, Commissioner of Patents and Trademarks, Petitioner,
v.
Thomas R. Johnston. } On Writ of Certiorari to the United States Court of Customs and Patent Appeals.

[March —, 1976]

MR. JUSTICE MARSHALL delivered the opinion of the Court.

Respondent has applied for a patent on what is described in his patent application as a "machine system for automatic record keeping of bank checks and deposits." The system permits a bank to furnish a customer with subtotals of various categories of transactions completed in connection with the customer's single account, thus saving the customer the time and/or expense of conducting this bookkeeping himself. As respondent has noted, the "invention is being sold as a computer program to banks and to other data processing companies so that they can perform these data processing services for depositors." Brief for Appellant, at 18, *Application of Johnston*, 502 F. 2d 765 (CCPA 1974).

Petitioner and respondent, as well as various *amici*, have presented lengthy arguments addressed to the question of the general patentability of computer programs. Cf. *Gottschalk v. Benson*, 409 U. S. 63 (1972). We find no need to treat that question in this case, however, because we conclude that in any event respondent's system is unpatentable on grounds of obviousness. 35

December 8, 1975

Re: No. 74-1033 - Dann, Commissioner v. Johnston

Dear Chief:

I have decided that I should not participate in
this case.

Sincerely,

HAB

The Chief Justice

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

CHAMBERS OF
JUSTICE HARRY A. BLACKMUN

February 25, 1976

Re: No. 74-1033 - Dann, Commissioner v.
Johnston

Dear Thurgood:

Will you please have your opinion show that I did not
participate in the consideration or decision of this case.

Sincerely,



Mr. Justice Marshall

cc: The Conference

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

CHAMBERS OF
JUSTICE LEWIS F. POWELL, JR.

March 1, 1976

3

No. 74-1033 Dann v. Johnston

Dear Thurgood:

Please join me.

Sincerely,

Lewis

Mr. Justice Marshall

lfp/ss

cc: The Conference

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

4

CHAMBERS OF
JUSTICE WILLIAM H. REHNQUIST

March 2, 1976

Re: No. 74-1033 - Dann, Commissioner, v. Johnston

Dear Thurgood:

Please join me.

Sincerely,

WRW

Mr. Justice Marshall

Copies to the Conference