The Burger Court Opinion Writing Database

Parker v. Flook

437 U.S. 584 (1978)

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

June 13, 1978

Dear Potter:

Re: 77-642 Parker v. Flook

I join your dissent. I continue to find this a hard, close case. I suspect we have not heard the last of this type of patent application in such a swiftly developing field.

Regards,

WEB

Mr. Justice Stewart

cc: The Conference

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

CHAMBERS OF
JUSTICE WM. J. BRENNAN, JR.

June 8, 1978

RE: No. 77-642 Parker v. Flook

Dear John:

Please join me.

Sincerely,

Bill

Mr. Justice Stevens

cc: The conference

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

From: Mr. Justice Stewart

Circulated: 12 JUN 1978

Recirculated: _____

No. 77-642, PARKER v. FLOOK

MR. JUSTICE STEWART, dissenting.

It is a commonplace that laws of nature, physical phenomena, and abstract ideas are not patentable subject matter.[1/] A patent could not issue, in other words, on the law of gravity, or the multiplication tables, or the phenomena of magnetism, or the fact that water at sea level boils at 100 degrees centigrade and freezes at zero--even though newly discovered. Le Roy v. Tatham, 14 How. 156, 175; Rubber-Tip Pencil Co. v. Howard, 20 Wall 498, 507; O'Reilly v. Morse, 15 How. 62, 112-121; Tilghman v. Proctor, 102 U.S. 707; Mackay Co. v. Radio Corp., 306 U.S. 86, 94; Funk Bros. Seed Co. v. Kalo Co., 333 U.S. 127, 130.

The recent case of Gottschalk v. Benson, 409 U.S. 63, stands for no more than this long-established principle, which the Court there stated in the following words:

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

From: Mr. Justice Stewart

Circulated: _____

1st DRAFT

Recirculated: 15 JUN 1978

SUPREME COURT OF THE UNITED STATES

No. 77-642

Lutrelle F. Parker, Acting Commissioner of Patents and Trademarks, Petitioner, *v.* Dale R. Flook.	On Writ of Certiorari to the United States Court of Customs and Patent Appeals.

[June —, 1978]

MR. JUSTICE STEWART, with whom THE CHIEF JUSTICE and MR. JUSTICE REHNQUIST join, dissenting.

It is a commonplace that laws of nature, physical phenomena, and abstract ideas are not patentable subject matter.[1] A patent could not issue, in other words, on the law of gravity, or the multiplication tables, or the phenomena of magnetism, or the fact that water at sea level boils at 100 degrees centigrade and freezes at zero—even though newly discovered. *Le Roy* v. *Tatham,* 14 How. 156, 175; *Rubber-Tip Pencil Co.* v. *Howard,* 20 Wall. 498, 507; *O'Reilly* v. *Morse,* 15 How. 62, 112–121; *Tilghman* v. *Proctor,* 102 U. S. 707; *Mackay Co.* v. *Radio Corp.,* 306 U. S. 86, 94; *Funk Bros. Seed Co.* v. *Kalo Co.,* 333 U. S. 127, 130.

The recent case of *Gottschalk* v. *Benson,* 409 U. S. 63, stands for no more than this long-established principle, which the Court there stated in the following words:

> "Phenomena of nature, though just discovered, mental processes, and abstract intellectual concepts are not pat-

[1] 35 U. S. C. § 101 provides:
"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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

CHAMBERS OF
JUSTICE BYRON R. WHITE

June 12, 1978

Re: 77-642 - Parker v. Flook

Dear John,

I cast a very shaky vote to affirm in this case but have been unsettled about it. Your opinion, which I have examined with some care, now impresses me as the better view, but I shall await the dissent before coming to rest.

Sincerely yours,

Byron

Mr. Justice Stevens

Copies to the Conference

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

CHAMBERS OF
JUSTICE BYRON R. WHITE

June 12, 1978

Re: 77-642 - Parker v. Flook

Dear John,

Please join me in your opinion in this case.

Sincerely yours,

Mr. Justice Stevens

Copies to the Conference

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

CHAMBERS OF
JUSTICE THURGOOD MARSHALL

June 7, 1978

Re: No. 77-642 - Parker v. Flook

Dear John:

Please join me.

Sincerely,

T.M.

Mr. Justice Stevens

cc: The Conference

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

CHAMBERS OF
JUSTICE HARRY A. BLACKMUN

April 28, 1978

Re: No. 77-642 - Parker v. Flook

Dear Chief:

After further consideration, I change my vote from "tentatively to affirm" to "tentatively to reverse."

Sincerely,

HAB.

The Chief Justice

cc: The Conference

This makes the vote 5 to 4 to Reverse

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

CHAMBERS OF
JUSTICE HARRY A. BLACKMUN

June 12, 1978

Re: No. 77-642 - Parker v. Flook

Dear John:

Please join me.

Sincerely,

Harry

Mr. Justice Stevens

cc: The Conference

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

CHAMBERS OF
JUSTICE LEWIS F. POWELL, JR.

June 13, 1978

No. 77-642 Parker v. Flook

Dear John:

Please join me.

Sincerely,

Lewis

Mr. Justice Stevens

lfp/ss

cc: The Conference

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

CHAMBERS OF
JUSTICE WILLIAM H. REHNQUIST

June 12, 1978

Re: No. 77-642 - Parker v. Flook

Dear Potter:

Please join me in your dissenting opinion in this case.

Sincerely,

WHR

Mr. Justice Stewart

Copies to the Conference

Brenn 77

Mr. Justice Brennan
Mr. Justice Stewart
Mr. Justice White
Mr. Justice Marshall
Mr. Justice Blackmun
Mr. Justice Powell
Mr. Justice Rehnquist

From: Mr. Justice Stevens

Circulated: JUN 6 '78

Recirculated: _____

77-642 - Lutrelle F. Parker v. Dale R. Flook

MR. JUSTICE STEVENS delivered the opinion of the Court.

Respondent applied for a patent on a "Method For Updating Alarm Limits." The only novel feature of the method is a mathematical formula. In Gottschalk v. Benson, 409 U.S. 63, we held that the discovery of a novel and useful mathematical formula may not be patented. The question in this case is whether the identification of a limited category of useful, though conventional, post-solution applications of such a formula makes respondent's method eligible for patent protection.

I

An "alarm limit" is a number. During catalytic conversion processes, operating conditions such as temperature, pressure, and flow rates are constantly monitored. When any of these "process variables" exceeds a predetermined "alarm limit," an alarm may signal the presence of an abnormal condition indicating either inefficiency or perhaps danger. Fixed alarm limits may be appropriate for a steady operation, but during transient operating situations, such as start-up, it may be necessary to "update" the alarm limits periodically.

Brenn 77

pp: 4-5, 8, 10, 11, 13

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

From: Mr. Justice Stevens

Circulated: _____

Recirculated: JUN 9 1978

Printed

1st DRAFT

SUPREME COURT OF THE UNITED STATES

No. 77-642

Lutrelle F. Parker, Acting Commissioner of Patents and Trademarks, Petitioner, *v.* Dale R. Flook.	On Writ of Certiorari to the United States Court of Customs and Patent Appeals.

[June —, 1978]

MR. JUSTICE STEVENS delivered the opinion of the Court.

Respondent applied for a patent on a "Method For Updating Alarm Limits." The only novel feature of the method is a mathematical formula. In *Gottschalk* v. *Benson,* 409 U. S. 63, we held that the discovery of a novel and useful mathematical formula may not be patented. The question in this case is whether the identification of a limited category of useful, though conventional, post-solution applications of such a formula makes respondent's method eligible for patent protection.

I

An "alarm limit" is a number. During catalytic conversion processes, operating conditions such as temperature, pressure, and flow rates are constantly monitored. When any of these "process variables" exceeds a predetermined "alarm limit," an alarm may signal the presence of an abnormal condition indicating either inefficiency or perhaps danger. Fixed alarm limits may be appropriate for a steady operation, but during transient operating situations, such as start-up, it may be necessary to "update" the alarm limits periodically.

Respondent's patent application describes a method of up-

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

CHAMBERS OF
JUSTICE JOHN PAUL STEVENS

June 21, 1978

MEMORANDUM TO THE CONFERENCE

RE: Cases held for No. 77-642 - Parker v. Flook

The only case held for Parker v. Flook is Parker v. Bergy, 77-1503.

Bergy sought a patent for a microbiological process for preparing the antibiotic lincomycin. The process utilized a newly discovered microorganism. In addition to his process claim, Bergy also sought a patent for the newly discovered microorganism itself. The patent examiner accepted the process claims but rejected the claim on the organism itself. The Board of Appeals also rejected the claim on the organism, reasoning that a "living organism" is not patentable subject matter under 35 U.S.C. § 101. A divided Court of Customs and Patent Appeals reversed. Judge Rich, writing for the majority, argued that microorganisms are, in effect, "tools" of the chemical industry and that they fall within the terms "manufacture" and "composition of matter" in § 101. The dissent, relying primarily on the fact that there is a separate Plant Patent Act, 35 U.S.C. §§ 161-164, concluded that a living organism is not patentable subject matter.

The issue in this case is clearly distinct from that in Flook--patentability of mathematical algorithms as subject matter "processes" under § 101, as opposed to patentability of microorganisms as subject matter "manufactures" or "compositions of matter" under § 101. In at least two respects, however, Flook does have a significant bearing on the reasoning used in Bergy.

First, in concluding that living organisms are patentable subject matter, the court relied on the following argument: