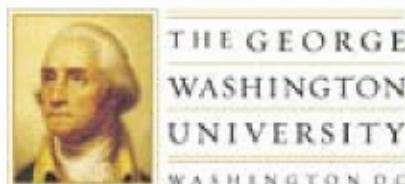


# The Burger Court Opinion Writing Database

*Diamond v. Chakrabarty*

447 U.S. 303 (1980)

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

May 8, 1980

Re: 79-136 - Diamond v. Chakrabarty

MEMORANDUM TO THE CONFERENCE:

Enclosed is a first draft in this case. My initial instincts were to include a footnote saying the following:

"One of the more extravagant statements attributed to a scientific source is that of Dr. Clement Market of Yale, who is depicted as researching the cloning of domestic livestock. He is quoted as saying:

"I could wipe out all of Yale's deficits with the valuable bulls raised from the embryos I could produce [in the laboratory] in one weekend."  
Fortune, June 19, 1978.

We, of course, would be happy to wipe out Yale's deficits and those of all the universities, great and small. But whether this should be done by genetic cloning of bulls or by the more prosaic method of door-to-door solicitation of alumni is not a matter on which we are ordained to decide.

I finally decided against including this passage for fear the Harvard men among us would demand equal time for the bull produced by their faculty.

Regards,

(LJW)

*Diamond*

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

From: The Chief Justice  
 Circulated: MAY 8 1980

1st DRAFT

Recirculated: \_\_\_\_\_

## SUPREME COURT OF THE UNITED STATES

No. 79-136

Sidney A. Diamond, Commissioner  
 of Patents and Trademarks,  
 Petitioner,  
 v.  
 Ananda M. Chakrabarty et al. } On Writ of Certiorari to  
 } the United States Court  
 } of Customs and Patent  
 } Appeals.

[May —, 1980]

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

We granted certiorari to determine whether a live, human-made micro-organism is patentable subject matter under 35 U. S. C. § 101.

### I

In 1972, respondent Chakrabarty, a microbiologist, filed a patent application, assigned to the General Electric Company. The application asserted 36 claims related to Chakrabarty's invention of "a bacterium from the genus *Pseudomonas* containing therein at least two stable energy-generating plasmids, each of said plasmids providing a separate hydrocarbon degradative pathway."<sup>1</sup> This human-made, genetically engi-

<sup>1</sup> Plasmids are hereditary units physically separate from the chromosomes of the cell. In prior research, Chakrabarty and an associate discovered that plasmids control the oil degradation abilities of certain bacteria. In particular, the two researchers discovered plasmids capable of degrading camphor and octane, two components of crude oil. In the work represented by the patent application at issue here, Chakrabarty discovered a process by which four different plasmids, capable of degrading four different oil components, could be transferred to and maintained stably in a single *Pseudomonas* bacteria, which itself has no capacity for degrading oil.

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

CHAMBERS OF  
THE CHIEF JUSTICE

June 11, 1980

Re: 79-136 - Diamond v. Chakrabarty

MEMORANDUM TO THE CONFERENCE:

Attached is a second draft of the opinion in this case. I believe the changes are stylistic only. It should be ready for release next week.

Regards,



CHANGES AS MARKED:

2, 3, 4, 5, 6, 10, 12, 13  
11

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

From: The Chief Justice

Circulated: \_\_\_\_\_

Recirculated: JUN 11 1980

2nd DRAFT

## SUPREME COURT OF THE UNITED STATES

No. 79-136

Sidney A. Diamond, Commissioner  
of Patents and Trademarks,  
Petitioner,  
*v.*  
Ananda M. Chakrabarty et al. } On Writ of Certiorari to  
the United States Court  
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### I

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

CHAMBERS OF  
JUSTICE Wm. J. BRENNAN, JR.

March 31, 1980

RE: No. 79-136 Diamond v. Chakrabarty

MEMORANDUM TO: Mr. Justice White  
Mr. Justice Marshall  
Mr. Justice Powell

We four voted to reverse at conference. I'll  
be happy to undertake the dissent.

  
W.J.B.Jr.

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

CHAMBERS OF  
JUSTICE WM. J. BRENNAN, JR.

May 12, 1980

RE: No. 79-136 Diamond v. Chakrabarty

Dear Chief:

In due course I shall circulate a dissent in the  
above.

Sincerely,



The Chief Justice

cc: The Conference

1st DRAFT

Mr. Justice BRENNAN

Transcribed

MAY 23 1980

**SUPREME COURT OF THE UNITED STATES**

No. 79-136

Sidney A. Diamond, Commissioner  
of Patents and Trademarks,  
Petitioner,  
*v.*  
Ananda M. Chakrabarty et al.

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

[June —, 1980]

MR. JUSTICE BRENNAN, dissenting.

I agree with the Court that the question before us is a narrow one. Neither the future of scientific research, nor even the ability of respondent Chakrabarty to reap some monopoly profits from his pioneering work, is at stake. Patents on the processes by which he has produced and employed the new living organism are not contested. The only question we need decide is whether Congress, exercising its authority under Art. I, § 8, of the Constitution, intended that he be able to secure a monopoly on the living organism itself, no matter how produced or how used. Because I believe the Court has misread the applicable legislation, I dissent.

The patent laws attempt to reconcile this Nation's deep-seated antipathy to monopolies with the need to encourage progress. *Deepsouth Packing Co. v. Laitram Corp.*, 406 U. S. 518, 530-531 (1972); *Graham v. John Deere Co.*, 383 U. S. 1, 7-10 (1966). Given the complexity and legislative nature of this delicate task, we must be careful to extend patent protection no further than Congress has provided. In particular, were there an absence of legislative direction, the courts should leave to Congress the decisions whether and how far to extend the patent privilege into areas where the common understanding has been that patents are not available.<sup>1</sup> Cf. *Deepsouth Packing Co. v. Laitram Corp.*, *supra*.

<sup>1</sup> I read the Court to admit that the popular conception, even among

14

## 2nd DRAFT

## SUPREME COURT OF THE UNITED STATES

No. 79-136

Circulated \_\_\_\_\_

JUN 2 1980

Received \_\_\_\_\_

Sidney A. Diamond, Commissioner  
of Patents and Trademarks,  
Petitioner,  
v.  
Ananda M. Chakrabarty et al.

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

[June —, 1980]

MR. JUSTICE BRENNAN, with whom MR. JUSTICE WHITE and  
MR. JUSTICE MARSHALL join, dissenting.

I agree with the Court that the question before us is a narrow one. Neither the future of scientific research, nor even the ability of respondent Chakrabarty to reap some monopoly profits from his pioneering work, is at stake. Patents on the processes by which he has produced and employed the new living organism are not contested. The only question we need decide is whether Congress, exercising its authority under Art. I, § 8, of the Constitution, intended that he be able to secure a monopoly on the living organism itself, no matter how produced or how used. Because I believe the Court has misread the applicable legislation, I dissent.

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

From: Mr. Justice Brennan

Circulated: \_\_\_\_\_

Recirculated: JUN 3 1980

3rd DRAFT

**SUPREME COURT OF THE UNITED STATES**

No. 79-136

Sidney A. Diamond, Commissioner  
 of Patents and Trademarks,  
 Petitioner,  
 v.  
 Ananda M. Chakrabarty et al.

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

[June —, 1980]

MR. JUSTICE BRENNAN, with whom MR. JUSTICE WHITE, MR. JUSTICE MARSHALL, and MR. JUSTICE POWELL join, dissenting.

I agree with the Court that the question before us is a narrow one. Neither the future of scientific research, nor even the ability of respondent Chakrabarty to reap some monopoly profits from his pioneering work, is at stake. Patents on the processes by which he has produced and employed the new living organism are not contested. The only question we need decide is whether Congress, exercising its authority under Art. I, § 8, of the Constitution, intended that he be able to secure a monopoly on the living organism itself, no matter how produced or how used. Because I believe the Court has misread the applicable legislation, I dissent.

The patent laws attempt to reconcile this Nation's deep-seated antipathy to monopolies with the need to encourage progress. *Deepsouth Packing Co. v. Laitram Corp.*, 406 U. S. 518, 530-531 (1972); *Graham v. John Deere Co.*, 383 U. S. 1, 7-10 (1966). Given the complexity and legislative nature of this delicate task, we must be careful to extend patent protection no further than Congress has provided. In particular, were there an absence of legislative direction, the courts should leave to Congress the decisions whether and how far to extend the patent privilege into areas where the common understand-

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

CHAMBERS OF  
JUSTICE POTTER STEWART

May 9, 1980

Re: 79-136 - Diamond v. Chakrabarty

Dear Chief:

I am glad to join your opinion for the Court.

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 13, 1980

Re: 79-136 - Diamond v. Chakrabarty

Dear Chief,

I await the dissent.

Sincerely yours,



The Chief Justice  
Copies to the Conference  
cmc

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

CHAMBERS OF  
JUSTICE BYRON R. WHITE

May 28, 1980

Re: 79-136 - Diamond v. Chakrabarty, et al

---

Dear Bill,

Please join me in your dissent.

Sincerely yours,



Mr. Justice Brennan

Copies to the Conference

cmc

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

CHAMBERS OF  
JUSTICE THURGOOD MARSHALL

May 12, 1980

Re: No. 79-136 - Diamond v. Chakrabarty

Dear Chief:

I await the dissent.

Sincerely,

*JM*

T.M.

The Chief Justice

cc: The Conference

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

CHAMBERS OF  
JUSTICE THURGOOD MARSHALL

May 28, 1980

Re: No. 79-136 - Diamond v. Chakrabarty

Dear Bill:

Please join me in your dissent.

Sincerely,

*JM*  
T.M.

Mr. Justice Brennan

cc: The Conference

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

CHAMBERS OF  
JUSTICE HARRY A. BLACKMUN

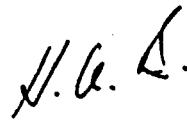
May 12, 1980

Re: No. 79-136 - Diamond v. Chakrabarty

Dear Chief:

Please join me.

Sincerely,



The Chief Justice

cc: The Conference

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

CHAMBERS OF  
JUSTICE LEWIS F. POWELL, JR.

May 10, 1980

79-136 Diamond v. Chakrabarty

Dear Chief:

In accordance with my Conference vote, I will await  
the dissent.

Sincerely,



The Chief Justice

lfp/ss

cc: The Conference

*sent?*

May 28, 1980

79-136 Diamond v. Chakrabarty

Dear Bill:

Please add my name to your dissenting opinion.

Sincerely,

Mr. Justice Brennan

lfp/ss

cc: The Conference

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

CHAMBERS OF  
JUSTICE LEWIS F. POWELL, JR.

May 29, 1980

79-136 Diamond v. Chakrabarty

Dear Bill:

Before I send you a join note in your dissent, as I expect to do, would you consider adding to the end of your opinion something along the following lines:

¶ "The Court protests that its holding today is dictated by the broad language of § 101, which 'cannot be confined to the "particular application[s] . . . contemplated by the legislators.'" Ante, at 12, quoting Barr v. United States, 324 U.S. 83, 90 (1945). But this decision does not follow the unavoidable implications of the statute. Rather, it extends the patent system to cover living material even though Congress plainly has legislated in the belief that § 101 does not encompass living organisms. It is the role of Congress, not this Court, to broaden or narrow the reach of the patent laws. This is especially true where, as here, the composition sought to be patented uniquely implicates matters of public concern."

*as I have shown to the Courts*

I was persuaded to dissent in this case, in significant part at least, by the relative novelty of patenting a living organism, and by my conviction that the issue should be decided by Congress. Although you have said this, I would be somewhat happier if you made it explicit at the end of your opinion.

Sincerely,

*Lewis*

Mr. Justice Brennan

lfp/ss

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

CHAMBERS OF  
JUSTICE LEWIS F. POWELL, JR.

June 2, 1980

79-136 Diamond v. Chakrabarty

Dear Bill:

Please add my name to your dissent.

Sincerely,



Mr. Justice Brennan

lfp/ss

cc: The Conference

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

CHAMBERS OF  
JUSTICE WILLIAM H. REHNQUIST

May 12, 1980

Re: No. 79-136 Diamond v. Chakrabarty

Dear Chief:

Please join me.

Sincerely,

The Chief Justice

Copies to the Conference

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

CHAMBERS OF  
JUSTICE JOHN PAUL STEVENS

May 14, 1980

Re: 79-136 - Diamond v. Chakrabarty

Dear Chief:

Please join me.

Respectfully,



The Chief Justice

Copies to the Conference