

The Burger Court Opinion Writing Database

Dawson Chemical Co. v. Rohm & Haas Co.

448 U.S. 176 (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

April 25, 1980

✓

Re: 79-669 - Dawson Chemical v. Rohm and Haas

MEMORANDUM TO THE CONFERENCE:

My vote is to affirm.

Regards,

Wm

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

CHAMBERS OF
THE CHIEF JUSTICE

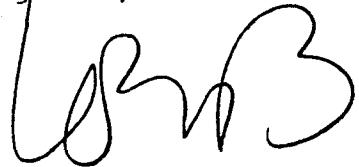
June 23, 1980

RE: 79-669 - Dawson Chemical Co. v. Rohm
and Haas Co.

Dear Harry:

I join.

Regards,



Mr. Justice Blackmun

Copies to the Conference

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

CHAMBERS OF
JUSTICE W. J. BRENNAN, JR.

April 28, 1980

RE: No. 79-669 Dawson Chemical Co. v. Rohm & Haas Co.

Dear Byron, Thurgood and John:

Byron has agreed to do the dissent in the above.

Sincerely,

Bril

Mr. Justice White
Mr. Justice Marshall
Mr. Justice Stevens

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

CHAMBERS OF
JUSTICE WM. J. BRENNAN, JR.

June 19, 1980

RE: No. 79-669 Dawson Chemical Co. v. Rohm & Haas Co.

Dear Byron:

Please join me in the dissenting opinion you have prepared in the above.

Sincerely,



Mr. Justice White

cc: The Conference

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

CHAMBERS OF
JUSTICE POTTER STEWART

June 18, 1980

Re: No. 79-669, Dawson v. Rohm & Haas Co.

Dear Harry,

I am glad to join your opinion for
the Court.

Sincerely yours,

C. S.
P.

Mr. Justice Blackmun

Copies to the Conference

BB
PP
PP

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

From: Mr. Justice White
19 JUN 1980

Circulated:

Dawson Chemical Co. v. Rohm & Haas Co.

Recirculated.

Re: 79-669 - Dawson Chemical Co. v. Rohm & Haas Co.

MR. JUSTICE WHITE, dissenting.

For decades this Court has denied relief from contributory infringement to patent holders who attempt to extend their patent monopolies to unpatented materials used in connection with patented inventions. The Court now refuses to apply this "patent misuse" principle in the very area in which such attempts to restrain competition are most likely to be successful. The Court holds exempt from the patent misuse doctrine a patent holder's refusal to license others to use a patented process unless they purchase from him an unpatented product that has no substantial use except in the patented process. The Court's sole justification for this radical departure from our prior construction of the patent laws is its interpretation of 35 U.S.C. § 271, a provision that created exceptions to the misuse doctrine and that we have held must be strictly construed "in light of this nation's historical antipathy to monopoly," Deepsouth Packing Co. v. Laitrim Corp., 406 U.S. 518, 530 (1972). The Court recognizes,

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

1, 9, 12, 14

From: Mr. Justice White

Circulated: _____

1st DRAFT

Recirculated: 6/23/80

SUPREME COURT OF THE UNITED STATES

No. 79-669

Dawson Chemical Company
et al., Petitioners, } On Writ of Certiorari to the
v. } United States Court of Appeals
Rohm and Hass Company. } for the Fifth Circuit.

[June —, 1980]

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

For decades this Court has denied relief from contributory infringement to patent holders who attempt to extend their patent monopolies to unpatented materials used in connection with patented inventions. The Court now refuses to apply this "patent misuse" principle in the very area in which such attempts to restrain competition are most likely to be successful. The Court holds exempt from the patent misuse doctrine a patent holder's refusal to license others to use a patented process unless they purchase from him an unpatented product that has no substantial use except in the patented process. The Court's sole justification for this radical departure from our prior construction of the patent laws is its interpretation of 35 U. S. C. § 271, a provision that created exceptions to the misuse doctrine and that we have held must be strictly construed "in light of this nation's historical antipathy to monopoly." *Deepsouth Packing Co. v. Laitram Corp.*, 406 U. S. 518, 530 (1972). The Court recognizes, as it must, that § 271 does not on its face exempt the broad category of nonstaple materials from the misuse doctrine, yet construes it to do so based on what it has gleaned from the testimony of private patent lawyers given in hearings before congressional committees and from the testimony of Department of Justice attorneys opposing the bill. The Court has often warned that in construing

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

From: Mr. Justice White

Circulated: _____

25 JUN 1980

Recirculated: _____

STYLISTIC CHANGES THROUGHOUT.

~~SEE PAGE 2~~

2nd DRAFT

SUPREME COURT OF THE UNITED STATES

No. 79-669

Dawson Chemical Company
et al., Petitioners, } On Writ of Certiorari to the
v. } United States Court of Ap-
Rohm and Haas Company. } peals for the Fifth Circuit.

[June —, 1980]

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

For decades this Court has denied relief from contributory infringement to patent holders who attempt to extend their patent monopolies to unpatented materials used in connection with patented inventions. The Court now refuses to apply this "patent misuse" principle in the very area in which such attempts to restrain competition are most likely to be successful. The Court holds exempt from the patent misuse doctrine a patent holder's refusal to license others to use a patented process unless they purchase from him an unpatented product that has no substantial use except in the patented process. The Court's sole justification for this radical departure from our prior construction of the patent laws is its interpretation of 35 U. S. C. § 271, a provision that created exceptions to the misuse doctrine and that we have held must be strictly construed "in light of this nation's historical antipathy to monopoly," *Deepsouth Packing Co. v. Laitram Corp.*, 406 U. S. 518, 530 (1972). The Court recognizes, as it must, that § 271 does not on its face exempt the broad category of nonstaple materials from the misuse doctrine, yet construes it to do so based on what it has gleaned from the testimony of private patent lawyers given in hearings before congressional committees and from the testimony of Department of Justice attorneys opposing the bill. The Court has often warned that in construing

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

CHAMBERS OF
JUSTICE THURGOOD MARSHALL

June 19, 1980

Re: No. 79-669 - Dawson Chemical Co. v. Rohm & Haas Co.

Dear Byron:

Please join me in your dissent.

Sincerely,

T.M.

T.M.

Mr. Justice White

cc: The Conference

June 16, 1980

Re: No. 79-669 - Dawson v. Rohm & Haas Company

Dear Byron:

I am truly sorry to be so late with the proposed opinion in this case. It proved to be a fairly large job. I suspect, however, that one takes either one route or the other and that you knew exactly what would be said in the opinion. I dislike to catch these "big" ones in the very last argument session of the Term.

Sincerely,

HAB

Mr. Justice White

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

From: Mr. Justice Blackmun
Circulated: JUN 16 1980

Recipients: _____

No. 79-669 - Dawson v. Rohm & Haas Company

MR. JUSTICE BLACKMUN delivered the opinion of the Court.

This case presents an important question of statutory interpretation arising under the patent laws. The issue before us is whether the owner of a patent on a chemical process is guilty of patent misuse, and therefore is barred from seeking relief against contributory infringement of its patent rights, if it exploits the patent only in conjunction with the sale of an unpatented article that constitutes a material part of the invention and is not suited for commercial use outside the scope of the patent claims. The answer will determine whether respondent, the owner of a process patent on a chemical herbicide, may maintain an action for contributory infringement

1/ The patent was issued to Rohm & Haas as the result of an interference proceeding in the United States Patent Office between Rohm & Haas and Monsanto. In that proceeding the Patent Office decided that Wilson, and not the applicant for the Monsanto patent (Huffman), was actually the first to invent the process for using propanil as a herbicide.

pp. 1, 16, 25, 42

Printed

1st DRAFT

To: The Chief Justice
Mr. Justice BRENNAN
Mr. Justice STEWART
Mr. Justice WHITE
Mr. Justice MARSHALL
Mr. Justice POWELL
Mr. Justice REHNQUIST
Mr. Justice STEVENS

From: Mr. Justice BLACKMUN

Circulated:

Recirculated: JUN 24 1980

SUPREME COURT OF THE UNITED STATES

No. 79-669

Dawson Chemical Company
et al., Petitioners,
v.
Rohm and Haas Company.

On Writ of Certiorari to the
United States Court of Ap-
peals for the Fifth Circuit.

[June —, 1980]

MR. JUSTICE BLACKMUN delivered the opinion of the Court.

This case presents an important question of statutory interpretation arising under the patent laws. The issue before us is whether the owner of a patent on a chemical process is guilty of patent misuse, and therefore is barred from seeking relief against contributory infringement of its patent rights, if it exploits the patent only in conjunction with the sale of an unpatented article that constitutes a material part of the invention and is not suited for commercial use outside the scope of the patent claims. The answer will determine whether respondent, the owner of a process patent on a chemical herbicide, may maintain an action for contributory infringement against other manufacturers of the chemical used in the process. To resolve this issue, we must construe the various provisions of 35 U. S. C. § 271, which Congress enacted in 1952 to codify certain aspects of the doctrines of contributory infringement and patent misuse that previously had been developed by the judiciary.

I

The doctrines of contributory infringement and patent misuse have long and interrelated histories. The idea that a patentee should be able to obtain relief against those whose acts facilitate infringement by others has been part of our

Supreme Court of the United States

Washington, D. C. 20543

CHAMBERS OF
JUSTICE LEWIS F. POWELL, JR.

June 18, 1980

No. 79-669 Dawson v. Rohm & Haas Company

Dear Harry:

Please join me.

Sincerely,

L.F.P.

Mr. Justice Blackmun

Copies to the Conference

LFP/lab

Supreme Court of the United States

Washington, D. C. 20543

CHAMBERS OF
JUSTICE WILLIAM H. REHNQUIST

June 18, 1980

Re: No. 79-669 Dawson v. Rohm & Haas Company

Dear Harry:

Please join me.

Sincerely,



Mr. Justice Blackmun

Copies to the Conference

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

CHAMBERS OF
JUSTICE JOHN PAUL STEVENS

June 19, 1980

Re: 79-669 - Dawson Chemical v. Rohm & Haas

Dear Byron:

Please join me.

Respectfully,



Mr. Justice White

Copies to the Conference

79-669 - Dawson Chemical Co. v. Rohm & Haas Co.

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

MR. JUSTICE STEVENS, dissenting.

From: Mr. Justice Stevens
Circulated: JUN 23 '80

Recirculated: _____

This patentee has offered no licenses, either to competing sellers of propanil or to consumers, except the implied license that is granted with every purchase of propanil from it. Thus, every license granted under this patent has been conditioned on the purchase of an unpatented product from the patentee. This is a classic case of patent misuse. As MR. JUSTICE WHITE demonstrates in his dissenting opinion, nothing in 35 U.S.C. § 271(d) excludes this type of conduct from the well-established misuse doctrine.

The Court may have been led into reaching the contrary, and in my view erroneous, conclusion by the particular facts of this case. It appears that it would not be particularly profitable to exploit this patent by granting express licenses for fixed terms to users of propanil or by granting licenses to competing sellers. Under these circumstances, the patent may well have little or no commercial value unless the patentee is permitted to engage in patent misuse. But surely this is not a good reason for interpreting § 271(d) to permit such misuse.

... 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 Stewart

Circulated:

JUN 25 '80

Recirculated:

1st PRINTED DRAFT

SUPREME COURT OF THE UNITED STATES

No. 79-669

Dawson Chemical Company
et al., Petitioners, | On Writ of Certiorari to the
v. | United States Court of Ap-
Rohm and Haas Company. | peals for the Fifth Circuit.

[June —, 1980]

MR. JUSTICE STEVENS, dissenting.

This patentee has offered no licenses, either to competing sellers of propanil or to consumers, except the implied license that is granted with every purchase of propanil from it. Thus, every license granted under this patent has been conditioned on the purchase of an unpatented product from the patentee. This is a classic case of patent misuse. As MR. JUSTICE WHITE demonstrates in his dissenting opinion, nothing in 35 U. S. C. § 271 (d) excludes this type of conduct from the well-established misuse doctrine.

The Court may have been led into reaching the contrary, and in my view erroneous, conclusion by the particular facts of this case. It appears that it would not be particularly profitable to exploit this patent by granting express licenses for fixed terms to users of propanil or by granting licenses to competing sellers. Under these circumstances, the patent may well have little or no commercial value unless the patentee is permitted to engage in patent misuse. But surely this is not a good reason for interpreting § 271 (d) to permit such misuse. For the logic of the Court's holding would seem to justify the extension of the patent monopoly to unpatented "non-staples" even in cases in which the patent could be profitably exploited without misuse. Thus, for example, it appears that the Court's decision would allow a manufacturer to condition a long-term lease of a patented