The Burger Court Opinion Writing Database

Diamond v. Diehr

450 U.S. 175 (1981)

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

November 20, 1980

Re: 79-1112 - Diamond v. Diehr

Dear Bill:

I join.

Regards,

WEB

Justice Rehnquist

Copies to the Conference

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

CHAMBERS OF
JUSTICE WM. J. BRENNAN, JR.

October 20, 1980

RE: No. 79-1112 Diamond v. Diehr & Lutton

Dear John:

You, Thurgood, Harry and I are in dissent in the above. Would you mind undertaking the dissent?

Sincerely,

Mr. Justice Stevens

cc: Mr. Justice Marshall
Mr. Justice Blackmun

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

CHAMBERS OF
JUSTICE WM. J. BRENNAN, JR.

February 26, 1981

RE: No. 79-1112 Diamond v. Diehr

Dear John:

I will be happy to join your opinion. I always did think that this case was squarely controlled by Parker v. Flook. However, I do have one suggestion concerning the statement on page 26, bottom, that we should have "an unequivocal holding that no program-related invention is a patentable process under Sec. 101 unless it makes a contribution to the art that is not dependent entirely on the utilization of a computer." I suppose my concern is with the "dependent entirely" language. Surely a newly-invented computer itself is a "program-related invention" that makes a "contribution to the art" that is also dependent entirely on a computer yet it is also surely patentable subject matter. In your admirable quest for simplifying the Flook holding, you may have introduced some additional difficulty. Do you really need this restatement? Why not just stick to the Flook formulation that we look to whether the claim reveals "some other inventive concepts?"

Sincerely,

Bill

Mr. Justice Stevens

Brennan 80

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

CHAMBERS OF
JUSTICE WM. J. BRENNAN, JR.

February 26, 1981

RE: No. 79-1112 Diamond v. Diehr & Lutton

Dear John:

Please join me in your dissent in the above.

Sincerely,

Bill

Mr. Justice Stevens

cc: The Conference

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

CHAMBERS OF
JUSTICE POTTER STEWART

November 14, 1980

Re: No. 79-1112, Diamond v. Diehr

Dear Bill,

I am glad to join your opinion for the Court.

Sincerely yours,

P.S.

Justice Rehnquist

Copies to the Conference

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

CHAMBERS OF
JUSTICE BYRON R. WHITE

November 17, 1980

Re: 79-1112 - Diamond v. Diehr

Dear Bill,

I shall await the dissent in this case.

Sincerely yours,

Byron

Mr. Justice Rehnquist

Copies to the Conference

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

CHAMBERS OF
JUSTICE BYRON R. WHITE

February 21, 1981

Re: 79-1112 - Diamond v. Diehr

Dear Bill,

Please join me.

Sincerely yours,

Byron

Mr. Justice Rehnquist

Copies to the Conference

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

CHAMBERS OF
JUSTICE THURGOOD MARSHALL

November 14, 1980

Re: No. 79-1112 - Diamond v. Diehr & Lutton

Dear Bill:

I await the dissent.

Sincerely,

T.M.

Mr. Justice Rehnquist

cc: The Conference

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

CHAMBERS OF
JUSTICE THURGOOD MARSHALL

February 26, 1981

Re: No. 79-1112 - Diamond v. Diehr

Dear John:

Please join me in your dissent.

Sincerely,

T.M.

Justice Stevens

cc: The Conference

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

CHAMBERS OF
JUSTICE HARRY A. BLACKMUN

November 17, 1980

Re: No. 79-1112 - Diamond v. Diehr and Lutton

Dear Bill:

I shall await the dissenting opinion.

Sincerely,

HAB.

Mr. Justice Rehnquist

cc: The Conference

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

CHAMBERS OF
JUSTICE HARRY A. BLACKMUN

February 24, 1981

Re: No. 79-1112 - Diamond v. Diehr

Dear John:

Please join me in your dissenting opinion. It seems to me that you have most adequately demonstrated that this is Flook revisited, and that your historical review recites how the CCPA has flouted the decisions of this Court.

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.

November 18, 1980

79-1112 Diamond v. Diehr and Lutton

Dear Bill:

I think you have written a fine opinion, and I probably will join you.

As I was with the Court in Flook, I think it is prudent for me to await the dissenting opinion before finally coming to rest.

Sincerely,

Lewis

Mr. Justice Rehnquist

lfp/ss

cc: The Conference

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

CHAMBERS OF
JUSTICE LEWIS F. POWELL, JR.

February 23, 1981

79-1112 Diamond v. Diehr

Dear Bill:

Although John has written a strong dissent in this difficult case, I will stay with my Conference vote.

Please join me.

Sincerely,

L. Lewis

Mr. Justice Rehnquist

lfp/ss

cc: The Conference

WHR
I await the dissent

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

From: Mr. Justice Rehnquist

Circulated: NOV 19 1980

Recirculated: ____

1st DRAFT

SUPREME COURT OF THE UNITED STATES

No. 79-1112

Sidney A. Diamond, Commissioner of Patents and Trademarks, Petitioner, *v.* James R. Diehr, II and Theodore A. Lutton.

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

[November —, 1980]

MR. JUSTICE REHNQUIST delivered the opinion of the Court.

We granted certiorari to determine whether a process for curing synthetic rubber which includes in several of its steps the use of a mathematical formula and a programmed digital computer is patentable subject matter under 35 U. S. C. § 101.

I

The patent application at issue was filed by the respondents on August 6, 1975. The claimed invention is a process for molding raw, uncured synthetic rubber into cured precision products. The process uses a mold for precisely shaping the uncured material under heat and pressure and then curing the synthetic rubber in the mold so that the product will retain its shape and be functionally operative after the molding is completed.[1]

Respondents claim that their process ensures the production of molded articles which are properly cured. Achieving

[1] A "cure" is obtained by mixing curing agents into the uncured polymer in advance of molding, and then applying heat over a period of time. If the synthetic rubber is cured for the right length of time at the right temperature, it becomes a useable product.

Stylistic changes
3, 7, 9, 11, 16

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

From: Mr. Justice Rehnquist

Circulated: NOV 19 1980

Recirculated:

2nd DRAFT

SUPREME COURT OF THE UNITED STATES

No. 79-1112

Sidney A. Diamond, Commissioner of Patents and Trademarks, Petitioner, *v.* James R. Diehr, II and Theodore A. Lutton.

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

[November —, 1980]

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I

The patent application at issue was filed by the respondents on August 6, 1975. The claimed invention is a process for molding raw, uncured synthetic rubber into cured precision products. The process uses a mold for precisely shaping the uncured material under heat and pressure and then curing the synthetic rubber in the mold so that the product will retain its shape and be functionally operative after the molding is completed.[1]

Respondents claim that their process ensures the production of molded articles which are properly cured. Achieving

[1] A "cure" is obtained by mixing curing agents into the uncured polymer in advance of molding, and then applying heat over a period of time. If the synthetic rubber is cured for the right length of time at the right temperature, it becomes a useable product.

Syllistic +17

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

From: Mr. Justice Rehnquist

Circulated: _____

Recirculated: FEB 23 1981

3rd DRAFT

SUPREME COURT OF THE UNITED STATES

No. 79-1112

Sidney A. Diamond, Commissioner of Patents and Trademarks, Petitioner, *v.* James R. Diehr, II and Theodore A. Lutton.

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

[November —, 1980]

MR. JUSTICE REHNQUIST delivered the opinion of the Court.

We granted certiorari to determine whether a process for curing synthetic rubber which includes in several of its steps the use of a mathematical formula and a programmed digital computer is patentable subject matter under 35 U. S. C. § 101.

I

The patent application at issue was filed by the respondents on August 6, 1975. The claimed invention is a process for molding raw, uncured synthetic rubber into cured precision products. The process uses a mold for precisely shaping the uncured material under heat and pressure and then curing the synthetic rubber in the mold so that the product will retain its shape and be functionally operative after the molding is completed.[1]

Respondents claim that their process ensures the production of molded articles which are properly cured. Achieving

[1] A "cure" is obtained by mixing curing agents into the uncured polymer in advance of molding, and then applying heat over a period of time. If the synthetic rubber is cured for the right length of time at the right temperature, it becomes a useable product.

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

CHAMBERS OF
JUSTICE WILLIAM H. REHNQUIST

March 17, 1981

MEMORANDUM TO THE CONFERENCE

Re: Cases Held for No. 79-1112 Diamond v. Diehr

No. 79-1941 Diamond v. Sherwood In this case the patent examiner rejected the invention because it was, in his opinion, drawn to non-statutory subject matter under §101. He found that the invention "comprises a program and algorithm utilized in conjunction with a digital computer," and noted that "initiation and reception of seismic signal, computer operations on seismic signals and sonogramming for seismic records are old in the art." The Board of Appeals affirmed the rejection, noting that the only difference between respondent's invention and a conventional time section lies in the calculations performed in connection with the equations. The Court of Custom and Patent Appeals reversed on the authority of In re Diehr which we in turned affirmed in Diamond v. Diehr. The CCPA noted that respondent had applied for a patent on a method for producing a subsurface map. It is common in geophysical prospecting for oil to use sonic waves to identify various subsurface geological formations. By translating these signals onto a piece of paper, the geologist can create a "time section." In a rough fashion, the geologist can use these "time sections" to determine the strata in the subsurface. Respondent developed a method for converting time section data into data from which an accurate "depth section" could be made. Generally, respondent's method involves sorting groups of seismic traces by the direction of the origination of the sound. The process of relating the geophone signals recorded on the time section to their subsurface point of origination is carried out on a large scale digital computer.

In its opinion, the CCPA discussed Gottschalk v. Benson, 409 U.S. 63, Parker v. Flook, 437 U.S. 584 (1978), and Mackay Radio Corp. & Telegraph Co. v. Radio Corp. of

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

CHAMBERS OF
JUSTICE JOHN PAUL STEVENS

October 21, 1980

Re: 79-1112 - Diamond v. Diehr & Lutton

Dear Bill:

I will be happy to undertake the dissent.

Respectfully,

JPS

Mr. Justice Brennan

cc: Mr. Justice Marshall
Mr. Justice Blackmun

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

CHAMBERS OF
JUSTICE JOHN PAUL STEVENS

November 13, 1980

Re: 79-1112 - Diamond v. Diehr

Dear Bill:

In due course I shall circulate a dissent in this case.

Respectfully,

John

Mr. Justice Rehnquist

Copies to the Conference

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: FEB 19 '81

1st DRAFT

Recirculated: _____

SUPREME COURT OF THE UNITED STATES

No. 79-1112

Sidney A. Diamond, Commissioner of Patents and Trademarks, Petitioner, *v.* James R. Diehr, II and Theodore A. Lutton.

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

[February —, 1981]

JUSTICE STEVENS, dissenting.

The starting point in the proper adjudication of patent litigation is an understanding of what the inventor claims to have discovered. The Court's decision in this case rests on a misreading of the Diehr and Lutton patent application. Moreover, the Court has compounded its error by ignoring the critical distinction between the character of the subject matter that the inventor claims to be novel—the § 101 issue—and the question whether that subject matter is in fact novel—the § 102 issue.

I

Before discussing the major flaws in the Court's opinion, a word of history may be helpful. As the Court recognized in *Parker* v. *Flook*, 437 U. S. 584, 595 (1978), the computer industry is relatively young. Although computer technology seems commonplace today, the first digital computer capable of utilizing stored programs was developed less than 30 years ago.[1] Patent law developments in response to this new tech-

[1] ENIAC, the first general purpose electronic digital computer, was built in 1946. Unlike modern computers, this machine was externally programmed; its circuitry had to be manually rewired each time it was to perform a new task. See Gemignani, Legal Protection for Computer Software: The View From '79, 7 Rut. J. Comp., Tech. & L. 269, 270