The Burger Court Opinion Writing Database

General Motors Corp. v. Devex Corp.

461 U.S. 648 (1983)

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 11, 1983

Re: 81-1661 - General Motors Corporation v. Devex Corporation

Dear Thurgood:

I join.

Regards,

WEB

Justice Marshall

Copies to the Conference

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

CHAMBERS OF
JUSTICE WM. J. BRENNAN, JR.

April 27, 1983

Re: General Motors v. Devex, No. 81-1661

Dear Thurgood:

I agree.

I do have one suggestion to make. Your footnote 12 suggests that a court might, in its discretion, decide to award no interest if adequate compensation is provided by attorney's fees or treble damages. This seems to me to under cut the deterrent and punitive purposes of the fees and treble damages; they can't accomplish their statutory purpose unless they are assessed on top of whatever ordinary compensatory damages (including interest) are awarded. May I suggest, instead, noting simply that interest should not be awarded on attorney's fees and the non-compensatory portion of treble damages?

Sincerely,

WJB, Jr.

Justice Marshall

Copies to the Conference

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

CHAMBERS OF
JUSTICE BYRON R. WHITE

April 27, 1983

Re: 81-1661 - General Motors Corporation
v. Devex Corporation

Dear Thurgood,

Please join me.

Sincerely,

Byron

Justice Marshall

Copies to the Conference

cpm

To: The Chief Justice
Justice Brennan
Justice White
Justice Blackmun
Justice Powell
Justice Rehnquist
Justice Stevens
Justice O'Connor

From: **Justice Marshall**

Circulated: APR 26 1983

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1st DRAFT

SUPREME COURT OF THE UNITED STATES

No. 81-1661

GENERAL MOTORS CORPORATION, PETITIONER *v.* DEVEX CORPORATION ET AL.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

[April ——, 1983]

JUSTICE MARSHALL, delivered the opinion of the Court.

This case concerns the proper standard governing the award of prejudgment interest in a patent infringement suit under 35 U. S. C. § 284.

I

In 1946 respondent Devex Corporation (Devex) filed a suit for patent infringement against petitioner General Motors Corporation (GMC) in the United States District Court for the Northern District of Illinois.[1] Devex alleged that GMC was infringing Reissue Patent No. 24,017, known as the "Hendricks" or "Devex" patent. The patent covered a lubricating process used in the cold-forming of metal car parts by pressure.[2] On June 29, 1962, the District Court

[1] The suit also named Houdaille Industries as a defendant. After the case against GMC was transfered to the United States District Court for the District of Delaware, the case against Houdaille Industries was tried separately, see *Devex Corp.* v. *Houdaille Ind.*, 382 F. 2d 17 (CA7 1967), and eventually settled.

[2] Claim 4 of the Patent covers:
"The process of working ferrous metal which comprises forming on the surface of the metal a phosphate coating and superimposing thereon a fixed film of a composition comprising a solid meltable organic binding material containing distributed there through a solid inorganic compound meltable

stylistic changes throughout

pp. 7, 9

To: The Chief Justice
Justice Brennan
Justice White
Justice Blackmun
Justice Powell
Justice Rehnquist
Justice Stevens
Justice O'Connor

From: **Justice Marshall**

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2nd DRAFT

SUPREME COURT OF THE UNITED STATES

No. 81-1661

GENERAL MOTORS CORPORATION, PETITIONER *v.* DEVEX CORPORATION ET AL.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

[May ——, 1983]

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P. 7

To: The Chief Justice
Justice Brennan
Justice White
Justice Blackmun
Justice Powell
Justice Rehnquist
Justice Stevens
Justice O'Connor

From: **Justice Marshall**

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Recirculated: 5/12/83

3rd DRAFT

SUPREME COURT OF THE UNITED STATES

No. 81-1661

GENERAL MOTORS CORPORATION, PETITIONER *v.* DEVEX CORPORATION ET AL.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

[May ——, 1983]

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(13)

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

CHAMBERS OF
JUSTICE HARRY A. BLACKMUN

April 28, 1983

Re: No. 81-1661 - General Motors Corp. v. Devex Corp.

Dear Thurgood:

Please join me. I shall leave to your good judgment the response to Bill Brennan's suggestion about footnote 12.

Sincerely,

Harry

Justice Marshall

cc: The Conference

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

CHAMBERS OF
JUSTICE LEWIS F. POWELL, JR.

April 28, 1983

81-1661 General Motors v. Devex Corporation

Dear Thurgood:

Please join me.

Sincerely,

Lewis

Justice Marshall

lfp/ss

cc: The Conference

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

CHAMBERS OF
JUSTICE WILLIAM H. REHNQUIST

April 29, 1983

Re: No. 81-1661 General Motors Corp. v. Devex Corp.

Dear Thurgood:

I agree with almost all of your opinion, and will be joining if you could make changes along two lines. First, the opinion relies on authorities from a few non-patent contexts in arriving at its interpretation of §284. See, e.g., p. 7 n.10, citing A.L.I. Restatement of Restitution, D. Dobbs, Law of Remedies, and so forth. The evidence that you have set out regarding Congress' intent in enacting §284 seems more than adequate to support the result in this case, without discussion of the way the law has evolved in other areas unrelated to the federal patent laws. I would be much more comfortable if you could eliminate the references in note 10 to nonpatent cases.

I would also hope that the opinion will not be read as an invitation to litigate interest awards in patent cases. While you go a long way toward this result by making it quite clear that an award of prejudgment interest will be reviewed on an abuse of discretion basis, see, e.g., p. 10, you do not make quite as clear the fact that a refusal to award interest will be judged by a similar standard. A sentence at the end of footnote 11 would satisfy my concerns.

Since you have a court in the present draft, I would understand if you were reluctant to make any changes. If you decide not to, I might write a brief concurrence along those lines.

Sincerely,

WHR

Justice Marshall

cc: The Conference

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

CHAMBERS OF
JUSTICE WILLIAM H. REHNQUIST

May 3, 1983

Re: No. 81-1661 General Motors Corp. v. Devex Corp.

Dear Thurgood:

Please join me.

Sincerely,

Justice Marshall

cc: The Conference

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

CHAMBERS OF
JUSTICE JOHN PAUL STEVENS

May 6, 1983

Re: 81-1661 - General Motors Corp. v. Devex Corp.

Dear Thurgood:

Although I have difficulty in describing it with any precision, I am inclined to believe that there may be another category of cases in which it may be appropriate to limit or to deny entirely prejudgment interests. I have in mind a case in which there is especially strong reason to believe that an untested patent may in fact be invalid, and in which there would be an especially strong public interest in having the patent tested. I wonder if you would consider adding at the end of the last sentence on page 8, the following additional language together with the following additional footnote:

> ", or where the infringer in good faith had especially strong reasons for questioning the patent's validity."*/

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*/In other contexts we have noted that the public interest is served by challenges to the validity of patents. "It is as important to the public that competition should not be repressed by worthless patents, as that the patentee of a really valuable invention should be protected in his monopoly; ..." Pope Manufacturing Co. v. Gormully, 144 U.S. 224, 234 (1892). In Lear, Inc. v. Adkins, 395 U.S. 653, 670 (1969), we wrote:

> "A patent, in the last analysis, simply represents a legal conclusion reached by the Patent Office. Moreover, the legal conclusion is predicated on factors as to

> which reasonable men can differ widely. Yet the Patent Office is often obliged to reach its decision in an ex parte proceeding, without the aid of the arguments which could be advanced by parties interested in proving patent invalidity. ..."
>
> There may well be a limited number of cases in which the infringer, although ultimately unsuccessful in litigation, may have been sufficiently justified in its conduct to make it appropriate for the District Court to deny prejudgment interest."

If you can incorporate this thought in your opinion, without necessarily adopting my suggested language, I will be happy to join you.

Respectfully,

Justice Marshall

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(8)

CHAMBERS OF
JUSTICE JOHN PAUL STEVENS

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

May 12, 1983

Re: 81-1661 - General Motors Corp. v. Devex Corp.

Dear Thurgood:

Please join me.

Respectfully,

Justice Marshall

Copies to the Conference

To: The Chief Justice
Justice Brennan
Justice White
Justice Marshall
Justice Blackmun
Justice Powell
Justice Rehnquist
Justice O'Connor

From: Justice Stevens

Circulated: NOV 12 '83

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81-1661 - General Motors Corp. v. Devex Corp.

JUSTICE STEVENS, concurring.

The 1946 amendments to the patent laws replaced the Duplate standard with a presumption favoring the award of prejudgment interest in the ordinary case. As the Court correctly holds, however, §284 does not automatically require an "award of prejudgment interest whenever infringement is found." Ante, at 8. In exercising its discretion to deny such interest in appropriate cases, the trial court may properly take into account the nature of the patent and the strength of the defendant's challenge.

In other contexts we have noted the public function served by patent litigation. In Lear, Inc. v. Adkins, 395 U.S. 653, 670 (1969), Justice Harlan, writing for the Court, explained:

> "A patent, in the last analysis, simply represents a legal conclusion reached by the Patent Office. Moreover, the legal conclusion is predicated on factors as to which reasonable men can differ widely. Yet the Patent Office is often obliged to reach its decision in an ex parte proceeding, without the aid of the arguments which could be advanced by parties interested in proving patent invalidity."

Hence, a patent challenge in the courts permits a more informed

To: The Chief Justice
Justice Brennan
Justice White
Justice Marshall
Justice Blackmun
Justice Powell
Justice Rehnquist
Justice O'Connor

From: **Justice Stevens**

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1st PRINTED DRAFT

SUPREME COURT OF THE UNITED STATES

No. 81-1661

GENERAL MOTORS CORPORATION, PETITIONER *v.* DEVEX CORPORATION ET AL.

ON WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

[May ——, 1983]

JUSTICE STEVENS, concurring.

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In other contexts we have noted the public function served by patent litigation. In *Lear, Inc.* v. *Adkins*, 395 U. S. 653, 670 (1969), Justice Harlan, writing for the Court, explained:

> "A patent, in the last analysis, simply represents a legal conclusion reached by the Patent Office. Moreover, the legal conclusion is predicated on factors as to which reasonable men can differ widely. Yet the Patent Office is often obliged to reach its decision in an *ex parte* proceeding, without the aid of the arguments which could be advanced by parties interested in proving patent invalidity."

Hence, a patent challenge in the courts permits a more informed decision regarding the merits of a particular patent.

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

CHAMBERS OF
JUSTICE SANDRA DAY O'CONNOR

April 28, 1983

No. 81-1661 General Motors Corp. v. Devex Corp.

Dear Thurgood,

Please join me.

Sincerely,

Sandra

Justice Marshall

Copies to the Conference