Draft November 3, 1972

IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1972

No. 72-626

UNIVERSITY OF ILLINOIS FOUNDATION,
Petitioner

vs.

BLONDER-TONGUE LABORATORIES, INC.,
Respondent

RESPONDENT'S REPLY IN OPPOSITION TO PETITION FOR
WRIT OF CERTIORARI

Respondent opposes the petition for a writ of certiorari to the United States Court of Appeals for the Seventh Circuit in this cause.

RESTATEMENT OF QUESTIONS PRESENTED

Petitioner's three questions are, in substance, really inquiring as follows:

Did the Supreme Court really mean to subject the petitioner to its unanimously enunciated doctrine and remand in the Blonder-Tongue decision?

Or, was petitioner to be an exception to the Blonder-Tongue doctrine such that:

(Questions 1 & 2) the lower courts were to review and pass on the standards of patentability applied in the earlier Eighth Circuit decisions; and

(Question 3) petitioner personally was to be excluded from the application of the estoppel doctrine of Blonder-Tongue.

Otherwise stated, the petitioner's questions really seem to ask if this Supreme Court will overrule itself.

REASONS FOR DENYING THE WRIT

This Supreme Court unanimously held that under the circumstances of this case, it was to be "remanded to the District Court for further proceedings consistent with this opinion".

The District Court meticulously reviewed and followed that opinion to the letter (A3-8 of Petition); to wit:

a) "The Court accordingly reversed and remanded the case to allow defendant to interpose a plea of estoppel based on the Eighth Circuit's decision in Winegard. Upon remand, defendant has accepted the invitation by moving to amend its answer to set up this newly authorized defense. Allowance of the amendment is dictated by the Supreme Court mandate, and plaintiff has not indicated any opposition. The motion is accordingly granted."

b) "Both parties have disavowed interest in offering evidence on the issue, and no factual issues are presented by the opposing motions. Thus the matter may be appropriately treated as a motion for summary judgment on the defense."

c) "When a new defendant is sued, the plaintiff will be entitled to relitigate the validity of his patent if he can demonstrate that the prior

action did not afford him "a full and fair chance" to litigate the issue, 402 U.S. 333, 91 S. Ct. 1434. Among the components of this standard are the convenience of the previous forum, plaintiff's incentive to litigate in the prior action, the identity of the issues raised and decided, and the plaintiff's opportunity to present all crucial evidence and witnesses. 402 U.S. 333, 91 S. Ct. 1434. Plaintiff in this Court has made no showing of any shortcomings in the Winegard proceedings in any of these respects. Procedurally, at least, plaintiff had a fair opportunity to pursue his claim the first time."

d) "Plaintiff asserts that the courts of the Eighth Circuit "wholly failed to grasp the technical subject matter" since they disagreed with the courts of this Circuit. It would demand arrogance so to conclude...While the technical subject matter involved in the litigation is complex, the Eighth Circuit opinion reveals a conscientious effort to apply the standards laid down in Graham v. John Deere Co., supra, and a careful evaluation of the issues. That court concluded that the patent was obvious and invalid as a mere xxxxxxxxxx combination of known elements. This Court had reached a different conclusion on the same issue, and this Court's opinion was before the Eighth Circuit. A mere difference in the conclusions reached in the application of a general standard such as obviousness under Section 103 of Title 35, United States

Code, does not demonstrate that either court "wholly failed to grasp the technical subject matter." As anticipated by the Supreme Court, instances warranting such a conclusion will be rare. 402 U.S. 333, 91 S. Ct. 1434."

e) "Under the factors mentioned by the Supreme Court, plaintiff has failed to make the requisite showing ~~thx~~ to escape the defense of estoppel and to entitle it to the benefit of relitigation. Beyond those factors, however, plaintiff urges ~~XXXX~~ that allowance of the defense would be unjust and inequitable because it has already incurred the costs and burdens of the second litigation, because this action was filed - but not decided - before the Winegard suit, because the Supreme Court denied certiorari to review the Eighth Circuit's decision, and because defendant did not plead the defense of estoppel, or urge its availability, in the courts of this Circuit. All these circumstances were before the Supreme Court, and with this record before it that Court directed that defendant be given an opportunity in this Court to raise the defense. This Court cannot evade the mandate by holding that such factors defeat the plea."

This careful following of the steps and considerations ordered by the Supreme Court in its Blonder-Tongue decision, was affirmed in toto by the Court of Appeals.

CONCLUSION

There is no basis ~~foxx~~ in terms of new evidence or public policy dictates, for the Supreme Court now belatedly reversing its unanimous Blonder-Tongue decision, or changing its mind as to the application of the same to petitioner -- the latter proposition, raised by petitioner's questions, indeed being res judicata.

Certainly there is no undecided issue of public moment warranting the granting of a writ of certiorari.

RHR/ch