

CASES ADJUDGED
IN THE
SUPREME COURT OF THE UNITED STATES
AT
OCTOBER TERM, 1965.

GRAHAM ET AL. v. JOHN DEERE CO. OF KANSAS
CITY ET AL.

CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR
THE EIGHTH CIRCUIT.

No. 11. Argued October 14, 1965.—Decided February 21, 1966.*

In No. 11 petitioners sued for infringement of a patent, consisting of a combination of old mechanical elements, for a device designed to absorb shock from plow shanks in rocky soil to prevent damage to the plow. In 1955 the Fifth Circuit held the patent valid, ruling that a combination is patentable when it produces an "old result in a cheaper and otherwise more advantageous way." Here the Eighth Circuit held that since there was no new result in the combination the patent was invalid. Petitioners in Nos. 37 and 43 filed actions for declaratory judgments declaring invalid respondent's patent relating to a plastic finger sprayer with a "hold-down" cap used as a built-in dispenser for containers with liquids, principally insecticides. By cross-action respondent claimed infringement. The District Court and the Court of Appeals sustained the patent. *Held*: The patents do not meet the test of the "nonobvious" nature of the "subject matter sought to be patented" to a person having ordinary skill in the pertinent art, set forth in § 103 of the Patent Act of 1952, and are therefore invalid. Pp. 3-37.

*Together with No. 37, *Calmar, Inc. v. Cook Chemical Co.*, and No. 43, *Colgate-Palmolive Co. v. Cook Chemical Co.*, also on certiorari to the same court.

Opinion of the Court.

383 U. S.

MR. JUSTICE CLARK delivered the opinion of the Court.

After a lapse of 15 years, the Court again focuses its attention on the patentability of inventions under the standard of Art. I, § 8, cl. 8, of the Constitution and under the conditions prescribed by the laws of the United States. Since our last expression on patent validity, *A. & P. Tea Co. v. Supermarket Corp.*, 340 U. S. 147 (1950), the Congress has for the first time expressly added a third statutory dimension to the two requirements of novelty and utility that had been the sole statutory test since the Patent Act of 1793. This is the test of obviousness, *i. e.*, whether "the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made." § 103 of the Patent Act of 1952, 35 U. S. C. § 103 (1964 ed.).

The questions, involved in each of the companion cases before us, are what effect the 1952 Act had upon traditional statutory and judicial tests of patentability and what definitive tests are now required. We have concluded that the 1952 Act was intended to codify judicial precedents embracing the principle long ago announced by this Court in *Hotchkiss v. Greenwood*, 11 How. 248 (1851), and that, while the clear language of § 103 places emphasis on an inquiry into obviousness, the general level of innovation necessary to sustain patentability remains the same.

II.

At the outset it must be remembered that the federal patent power stems from a specific constitutional provision which authorizes the Congress "To promote the Progress of . . . useful Arts, by securing for limited Times to . . . Inventors the exclusive Right to their . . . Discoveries." Art. I, § 8, cl. 8.¹ The clause is both a grant of power and a limitation. This qualified authority, unlike the power often exercised in the sixteenth and seventeenth centuries by the English Crown, is limited to the promotion of advances in the "useful arts." It was written against the backdrop of the practices—eventually curtailed by the Statute of Monopolies—of the Crown in granting monopolies to court favorites in goods or businesses which had long before been enjoyed by the public. See Meinhardt, *Inventions, Patents and Monopoly*, pp. 30-35 (London, 1946). The Congress in the

¹ The provision appears in the Constitution spliced together with the copyright provision, which we omit as not relevant here. See H. R. Rep. No. 1923, 82d Cong., 2d Sess., at 4 (1952); DeWolf, *An Outline of Copyright Law*, p. 15 (Boston, 1925).

exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose. Nor may it enlarge the patent monopoly without regard to the innovation, advancement or social benefit gained thereby. Moreover, Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available. Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must "promote the Progress of . . . useful Arts." This is the *standard* expressed in the Constitution and it may not be ignored. And it is in this light that patent validity "requires reference to a standard written into the Constitution." *A. & P. Tea Co. v. Supermarket Corp.*, *supra*, at 154 (concurring opinion).

Within the limits of the constitutional grant, the Congress may, of course, implement the stated purpose of the Framers by selecting the policy which in its judgment best effectuates the constitutional aim. This is but a corollary to the grant to Congress of any Article I power. *Gibbons v. Ogden*, 9 Wheat. 1. Within the scope established by the Constitution, Congress may set out conditions and tests for patentability. *McClurg v. Kingsland*, 1 How. 202, 206. It is the duty of the Commissioner of Patents and of the courts in the administration of the patent system to give effect to the constitutional standard by appropriate application, in each case, of the statutory scheme of the Congress.

Congress quickly responded to the bidding of the Constitution by enacting the Patent Act of 1790 during the second session of the First Congress. It created an agency in the Department of State headed by the Secretary of State, the Secretary of the Department of War

and the Attorney General, any two of whom could issue a patent for a period not exceeding 14 years to any petitioner that "hath . . . invented or discovered any useful art, manufacture, . . . or device, or any improvement therein not before known or used" if the board found that "the invention or discovery [was] sufficiently useful and important" 1 Stat. 110. This group, whose members administered the patent system along with their other public duties, was known by its own designation as "Commissioners for the Promotion of Useful Arts."

Thomas Jefferson, who as Secretary of State was a member of the group, was its moving spirit and might well be called the "first administrator of our patent system." See Federico, *Operation of the Patent Act of 1790*, 18 J. Pat. Off. Soc. 237, 238 (1936). He was not only an administrator of the patent system under the 1790 Act, but was also the author of the 1793 Patent Act. In addition, Jefferson was himself an inventor of great note. His unpatented improvements on plows, to mention but one line of his inventions, won acclaim and recognition on both sides of the Atlantic. Because of his active interest and influence in the early development of the patent system, Jefferson's views on the general nature of the limited patent monopoly under the Constitution, as well as his conclusions as to conditions for patentability under the statutory scheme, are worthy of note.

Jefferson, like other Americans, had an instinctive aversion to monopolies. It was a monopoly on tea that sparked the Revolution and Jefferson certainly did not favor an equivalent form of monopoly under the new government. His abhorrence of monopoly extended initially to patents as well. From France, he wrote to Madison (July 1788) urging a Bill of Rights provision restricting monopoly, and as against the argument that

limited monopoly might serve to incite "ingenuity," he argued forcefully that "the benefit even of limited monopolies is too doubtful to be opposed to that of their general suppression," V Writings of Thomas Jefferson, at 47 (Ford ed., 1895).

His views ripened, however, and in another letter to Madison (Aug. 1789) after the drafting of the Bill of Rights, Jefferson stated that he would have been pleased by an express provision in this form:

"Art. 9. Monopolies may be allowed to persons for their own productions in literature & their own inventions in the arts, for a term not exceeding — years but for no longer term & no other purpose." *Id.*, at 113.

And he later wrote:

"Certainly an inventor ought to be allowed a right to the benefit of his invention for some certain time. . . . Nobody wishes more than I do that ingenuity should receive a liberal encouragement." Letter to Oliver Evans (May 1807), V Writings of Thomas Jefferson, at 75–76 (Washington ed.).

Jefferson's philosophy on the nature and purpose of the patent monopoly is expressed in a letter to Isaac McPherson (Aug. 1813), a portion of which we set out in the margin.² He rejected a natural-rights theory in

² "Stable ownership is the gift of social law, and is given late in the progress of society. It would be curious then, if an idea, the fugitive fermentation of an individual brain, could, of natural right, be claimed in exclusive and stable property. If nature has made any one thing less susceptible than all others of exclusive property, it is the action of the thinking power called an idea, which an individual may exclusively possess as long as he keeps it to himself; but the moment it is divulged, it forces itself into the possession of every one, and the receiver cannot dispossess himself of it. Its peculiar character, too, is that no one possesses the less, because every other possesses

intellectual property rights and clearly recognized the social and economic rationale of the patent system. The patent monopoly was not designed to secure to the inventor his natural right in his discoveries. Rather, it was a reward, an inducement, to bring forth new knowledge. The grant of an exclusive right to an invention was the creation of society—at odds with the inherent free nature of disclosed ideas—and was not to be freely given. Only inventions and discoveries which furthered human knowledge, and were new and useful, justified the special inducement of a limited private monopoly. Jefferson did not believe in granting patents for small details, obvious improvements, or frivolous devices. His writings evidence his insistence upon a high level of patentability.

As a member of the patent board for several years, Jefferson saw clearly the difficulty in "drawing a line between the things which are worth to the public the embarrassment of an exclusive patent, and those which are not." The board on which he served sought to draw such a line and formulated several rules which are preserved in

the whole of it. He who receives an idea from me, receives instruction himself without lessening mine; as he who lights his taper at mine, receives light without darkening me. That ideas should freely spread from one to another over the globe, for the moral and mutual instruction of man, and improvement of his condition, seems to have been peculiarly and benevolently designed by nature, when she made them, like fire, expansible over all space, without lessening their density in any point, and like the air in which we breathe, move, and have our physical being, incapable of confinement or exclusive appropriation. Inventions then cannot, in nature, be a subject of property. Society may give an exclusive right to the profits arising from them, as an encouragement to men to pursue ideas which may produce utility, but this may or may not be done, according to the will and convenience of the society, without claim or complaint from any body." VI Writings of Thomas Jefferson, at 180–181 (Washington ed.).

Jefferson's correspondence.³ Despite the board's efforts, Jefferson saw "with what slow progress a system of general rules could be matured." Because of the "abundance" of cases and the fact that the investigations occupied "more time of the members of the board than they could spare from higher duties, the whole was turned over to the judiciary, to be matured into a system, under which every one might know when his actions were safe and lawful." Letter to McPherson, *supra*, at 181, 182. Apparently Congress agreed with Jefferson and the board that the courts should develop additional conditions for patentability. Although the Patent Act was amended, revised or codified some 50 times between 1790 and 1950, Congress steered clear of a statutory set of requirements other than the bare novelty and utility tests reformulated in Jefferson's draft of the 1793 Patent Act.

III.

The difficulty of formulating conditions for patentability was heightened by the generality of the constitutional grant and the statutes implementing it, together with the underlying policy of the patent system that "the things which are worth to the public the embarrassment

³ "[A] machine of which we are possessed, might be applied by every man to any use of which it is susceptible." Letter to Isaac McPherson, *supra*, at 181.

"[A] change of material should not give title to a patent. As the making a ploughshare of cast rather than of wrought iron; a comb of iron instead of horn or of ivory . . ." *Ibid.*

"[A] mere change of form should give no right to a patent, as a high-quartered shoe instead of a low one; a round hat instead of a three-square; or a square bucket instead of a round one." *Id.*, at 181-182.

"[A combined use of old implements.] A man has a right to use a saw, an axe, a plane separately; may he not combine their uses on the same piece of wood?" Letter to Oliver Evans (Jan. 1814), VI Writings of Thomas Jefferson, at 298 (Washington ed.).

of an exclusive patent," as Jefferson put it, must outweigh the restrictive effect of the limited patent monopoly. The inherent problem was to develop some means of weeding out those inventions which would not be disclosed or devised but for the inducement of a patent.

This Court formulated a general condition of patentability in 1851 in *Hotchkiss v. Greenwood*, 11 How. 248. The patent involved a mere substitution of materials—porcelain or clay for wood or metal in doorknobs—and the Court condemned it, holding:⁴

"[U]nless more ingenuity and skill . . . were required . . . than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which constitute essential elements of every invention. In other words, the improvement is the work of the skilful mechanic, not that of the inventor." At p. 267.

Hotchkiss, by positing the condition that a patentable invention evidence more ingenuity and skill than that possessed by an ordinary mechanic acquainted with the business, merely distinguished between new and useful innovations that were capable of sustaining a patent and those that were not. The *Hotchkiss* test laid the cornerstone of the judicial evolution suggested by Jefferson and left to the courts by Congress. The language in the case, and in those which followed, gave birth to "invention" as a word of legal art signifying patentable inventions. Yet, as this Court has observed, "[t]he truth is the word ['invention'] cannot be defined in such manner as to afford any substantial aid in determining whether a particular device involves an exercise of the inventive faculty

⁴ In historical retrospect, the specific result in *Hotchkiss* flows directly from an application of one of the rules of the original board of "Commissioners," n. 3, second rule, *supra*.

or not." *McClain v. Ortmyer*, 141 U. S. 419, 427 (1891); *A. & P. Tea Co. v. Supermarket Corp.*, *supra*, at 151. Its use as a label brought about a large variety of opinions as to its meaning both in the Patent Office, in the courts, and at the bar. The *Hotchkiss* formulation, however, lies not in any label, but in its functional approach to questions of patentability. In practice, *Hotchkiss* has required a comparison between the subject matter of the patent, or patent application, and the background skill of the calling. It has been from this comparison that patentability was in each case determined.

The 1952 Patent Act. IV.

The Act sets out the conditions of patentability in three sections. An analysis of the structure of these three sections indicates that patentability is dependent upon three explicit conditions: novelty and utility as articulated and defined in § 101 and § 102, and non-obviousness, the new statutory formulation, as set out in § 103. The first two sections, which trace closely the 1874 codification, express the "new and useful" tests which have always existed in the statutory scheme and, for our purposes here, need no clarification.⁵ The pivotal

⁵"§ 101. *Inventions patentable*

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title."

"§ 102. *Conditions for patentability; novelty and loss of right to patent*

"A person shall be entitled to a patent unless—

"(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

"(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in

section around which the present controversy centers is § 103. It provides:

"§ 103. *Conditions for patentability; non-obvious subject matter*

"A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made."

this country, more than one year prior to the date of the application for patent in the United States, or

"(c) he has abandoned the invention, or

"(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

"(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

"(f) he did not himself invent the subject matter sought to be patented, or

"(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other."

The precursors of these sections are to be found in the Act of February 21, 1793, c. 11, 1 Stat. 318; Act of July 4, 1836, c. 357, 5 Stat. 117; Act of July 8, 1870, c. 230, 16 Stat. 198; Rev. Stat. § 4886 (1874).

The section is cast in relatively unambiguous terms. Patentability is to depend, in addition to novelty and utility, upon the "non-obvious" nature of the "subject matter sought to be patented" to a person having ordinary skill in the pertinent art.

The first sentence of this section is strongly reminiscent of the language in *Hotchkiss*. Both formulations place emphasis on the pertinent art existing at the time the invention was made and both are implicitly tied to advances in that art. The major distinction is that Congress has emphasized "nonobviousness" as the operative test of the section, rather than the less definite "invention" language of *Hotchkiss* that Congress thought had led to "a large variety" of expressions in decisions and writings. In the title itself the Congress used the phrase "Conditions for patentability; *non-obvious subject matter*" (italics added), thus focusing upon "non-obviousness" rather than "invention."⁶ The Senate and House Reports, S. Rep. No. 1979, 82d Cong., 2d Sess. (1952); H. R. Rep. No. 1923, 82d Cong., 2d Sess. (1952), reflect this emphasis in these terms:

"Section 103, for the first time in our statute, provides a condition which exists in the law and has existed for more than 100 years, but only by reason of decisions of the courts. An invention which has been made, and which is new in the sense that the same thing has not been made before, may still not be patentable if the difference between the new thing and what was known before is not considered sufficiently great to warrant a patent. That has been expressed in a large variety of ways in decisions of

⁶ The corresponding provision in the preliminary draft was titled "Conditions for patentability, *lack of invention*" (italics added), Proposed Revision and Amendment of the Patent Laws, Preliminary Draft with Notes, House Committee on the Judiciary (Committee Print, 1950).

the courts and in writings. Section 103 states this requirement in the title. It refers to the difference between the subject matter sought to be patented and the prior art, meaning what was known before as described in section 102. If this difference is such that the subject matter as a whole would have been obvious at the time to a person skilled in the art, then the subject matter cannot be patented.

"That provision paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness. This section should have a stabilizing effect and minimize great departures which have appeared in some cases." H. R. Rep., *supra*, at 7; S. Rep., *supra*, at 6.

It is undisputed that this section was, for the first time, a statutory expression of an additional requirement for patentability, originally expressed in *Hotchkiss*. It also seems apparent that Congress intended by the last sentence of § 103 to abolish the test it believed this Court announced in the controversial phrase "flash of creative genius," used in *Cuno Corp. v. Automatic Devices Corp.*, 314 U. S. 84 (1941).⁷

⁷ The sentence in which the phrase occurs reads: "[T]he new device, however useful it may be, must reveal the flash of creative genius, not merely the skill of the calling." At p. 91. Although some writers and lower courts found in the language connotations as to the frame of mind of the inventors, none were so intended. The opinion approved *Hotchkiss* specifically, and the reference to "flash of creative genius" was but a rhetorical embellishment of language going back to 1833. Cf. "exercise of genius," *Shaw v. Cooper*, 7 Pet. 292; "inventive genius," *Reckendorfer v. Faber*, 92 U. S. 347 (1876); *Concrete Appliances Co. v. Gomery*, 269 U. S. 177; "flash of thought," *Densmore v. Scofield*, 102 U. S. 375 (1880); "intuitive genius," *Potts v. Creager*, 155 U. S. 597 (1895). Rather than establishing a more exacting standard, *Cuno* merely rhetorically restated the requirement that the subject matter sought to be patented must be beyond the skill of the calling. It was the device, not

It is contended, however, by some of the parties and by several of the *amici* that the first sentence of § 103 was intended to sweep away judicial precedents and to lower the level of patentability. Others contend that the Congress intended to codify the essential purpose reflected in existing judicial precedents—the rejection of insignificant variations and innovations of a commonplace sort—and also to focus inquiries under § 103 upon nonobviousness, rather than upon “invention,” as a means of achieving more stability and predictability in determining patentability and validity.

The Reviser’s Note to this section,⁸ with apparent reference to *Hotchkiss*, recognizes that judicial requirements as to “lack of patentable novelty [have] been followed since at least as early as 1850.” The note indicates that the section was inserted because it “may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.” To this same effect are the reports of both Houses, *supra*, which state that the first sentence

the invention, that had to reveal the “flash of creative genius.” See Boyajian, *The Flash of Creative Genius, An Alternative Interpretation*, 25 J. Pat. Off. Soc. 776, 780, 781 (1943); *Pacific Contact Laboratories, Inc. v. Solex Laboratories, Inc.*, 209 F. 2d 529, 533; *Brown & Sharpe Mfg. Co. v. Kar Engineering Co.*, 154 F. 2d 48, 51–52; *In re Shortell*, 31 C. C. P. A. (Pat.) 1062, 1069, 142 F. 2d 292, 295–296.

⁸ “There is no provision corresponding to the first sentence explicitly stated in the present statutes, but the refusal of patents by the Patent Office, and the holding of patents invalid by the courts, on the ground of lack of invention or lack of patentable novelty has been followed since at least as early as 1850. This paragraph is added with the view that an explicit statement in the statute may have some stabilizing effect, and also to serve as a basis for the addition at a later time of some criteria which may be worked out.

“The second sentence states that patentability as to this requirement is not to be negated by the manner in which the invention was made, that is, it is immaterial whether it resulted from long toil and experimentation or from a flash of genius.”

of the section “paraphrases language which has often been used in decisions of the courts, and the section is added to the statute for uniformity and definiteness.”

We believe that this legislative history, as well as other sources,⁹ shows that the revision was not intended by Congress to change the general level of patentable invention. We conclude that the section was intended merely as a codification of judicial precedents embracing the *Hotchkiss* condition, with congressional directions that inquiries into the obviousness of the subject matter sought to be patented are a prerequisite to patentability.

V.

Approached in this light, the § 103 additional condition, when followed realistically, will permit a more practical test of patentability. The emphasis on non-obviousness is one of inquiry, not quality, and, as such, comports with the constitutional strictures.

While the ultimate question of patent validity is one of law, *A. & P. Tea Co. v. Supermarket Corp.*, *supra*, at 155, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circum-

⁹ See *Efforts to Establish a Statutory Standard of Invention*, Study No. 7, Senate Subcommittee on Patents, Trademarks, and Copyrights, 85th Cong., 1st Sess. (Committee Print, 1958); Hearings, Subcommittee No. 3, House Committee on the Judiciary, on H. R. 3760, 82d Cong., 1st Sess. (1951).

stances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, these inquiries may have relevancy. See Note, Subtests of "Nonobviousness": A Nontechnical Approach to Patent Validity, 112 U. Pa. L. Rev. 1169 (1964).

This is not to say, however, that there will not be difficulties in applying the nonobviousness test. What is obvious is not a question upon which there is likely to be uniformity of thought in every given factual context. The difficulties, however, are comparable to those encountered daily by the courts in such frames of reference as negligence and scienter, and should be amenable to a case-by-case development. We believe that strict observance of the requirements laid down here will result in that uniformity and definiteness which Congress called for in the 1952 Act.

While we have focused attention on the appropriate standard to be applied by the courts, it must be remembered that the primary responsibility for sifting out unpatentable material lies in the Patent Office. To await litigation is—for all practical purposes—to debilitate the patent system. We have observed a notorious difference between the standards applied by the Patent Office and by the courts. While many reasons can be adduced to explain the discrepancy, one may well be the free rein often exercised by Examiners in their use of the concept of "invention." In this connection we note that the Patent Office is confronted with a most difficult task. Almost 100,000 applications for patents are filed each year. Of these, about 50,000 are granted and the backlog now runs well over 200,000. 1965 Annual Report of the Commissioner of Patents 13-14. This is itself a compelling reason for the Commissioner to strictly adhere to the 1952 Act as interpreted here. This would, we believe, not only expedite disposition but

bring about a closer concurrence between administrative and judicial precedent.¹⁰

Although we conclude here that the inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the requirements of § 103, it bears repeating that we find no change in the general strictness with which the overall test is to be applied. We have been urged to find in § 103 a relaxed standard, supposedly a congressional reaction to the "increased standard" applied by this Court in its decisions over the last 20 or 30 years. The standard has remained invariable in this Court. Technology, however, has advanced—and with remarkable rapidity in the last 50 years. Moreover, the ambit of applicable art in given fields of science has widened by disciplines unheard of a half century ago. It is but an evenhanded application to require that those persons granted the benefit of a patent monopoly be charged with an awareness of these changed conditions. The same is true of the less technical, but still useful arts. He who seeks to build a better mousetrap today has a long path to tread before reaching the Patent Office.

VI.

We now turn to the application of the conditions found necessary for patentability to the cases involved here:

A. *The Patent in Issue in No. 11, Graham v. John Deere Co.*

This patent, No. 2,627,798 (hereinafter called the '798 patent) relates to a spring clamp which permits plow shanks to be pushed upward when they hit obstructions

¹⁰ The President has appointed a Commission on the Patent System. Executive Order No. 11215, 30 Fed. Reg. 4661 (April 10, 1965). It is hoped that its studies may develop more efficient administrative procedures and techniques that will further expedite dispositions and at the same time insure the strict application of appropriate tests of patentability.

in the soil, and then springs the shanks back into normal position when the obstruction is passed over. The device, which we show diagrammatically in the accompanying sketches (Appendix, Fig. 1), is fixed to the plow frame as a unit. The mechanism around which the controversy centers is basically a hinge. The top half of it, known as the upper plate (marked 1 in the sketches), is a heavy metal piece clamped to the plow frame (2) and is stationary relative to the plow frame. The lower half of the hinge, known as the hinge plate (3), is connected to the rear of the upper plate by a hinge pin (4) and rotates downward with respect to it. The shank (5), which is bolted to the forward end of the hinge plate (at 6), runs beneath the plate and parallel to it for about nine inches, passes through a stirrup (7), and then continues backward for several feet curving down toward the ground. The chisel (8), which does the actual plowing, is attached to the rear end of the shank. As the plow frame is pulled forward, the chisel rips through the soil, thereby plowing it. In the normal position, the hinge plate and the shank are kept tight against the upper plate by a spring (9), which is atop the upper plate. A rod (10) runs through the center of the spring, extending down through holes in both plates and the shank. Its upper end is bolted to the top of the spring while its lower end is hooked against the underside of the shank.

When the chisel hits a rock or other obstruction in the soil, the obstruction forces the chisel and the rear portion of the shank to move upward. The shank is pivoted (at 11) against the rear of the hinge plate and pries open the hinge against the closing tendency of the spring. (See sketch labeled "Open Position," Appendix, Fig. 1.) This closing tendency is caused by the fact that, as the hinge is opened, the connecting rod is pulled downward and the spring is compressed. When the obstruc-

tion is passed over, the upward force on the chisel disappears and the spring pulls the shank and hinge plate back into their original position. The lower, rear portion of the hinge plate is constructed in the form of a stirrup (7) which brackets the shank, passing around and beneath it. The shank fits loosely into the stirrup (permitting a slight up and down play). The stirrup is designed to prevent the shank from recoiling away from the hinge plate, and thus prevents excessive strain on the shank near its bolted connection. The stirrup also girds the shank, preventing it from fishtailing from side to side.

In practical use, a number of spring-hinge-shank combinations are clamped to a plow frame, forming a set of ground-working chisels capable of withstanding the shock of rocks and other obstructions in the soil without breaking the shanks.

Background of the Patent.

Chisel plows, as they are called, were developed for plowing in areas where the ground is relatively free from rocks or stones. Originally, the shanks were rigidly attached to the plow frames. When such plows were used in the rocky, glacial soils of some of the Northern States, they were found to have serious defects. As the chisels hit buried rocks, a vibratory motion was set up and tremendous forces were transmitted to the shank near its connection to the frame. The shanks would break. Graham, one of the petitioners, sought to meet that problem, and in 1950 obtained a patent, U. S. No. 2,493,811 (hereinafter '811), on a spring clamp which solved some of the difficulties. Graham and his companies manufactured and sold the '811 clamps. In 1950, Graham modified the '811 structure and filed for a patent. That patent, the one in issue, was granted in 1953. This suit against competing plow manufacturers resulted from charges by petitioners that several of respondents' devices infringed the '798 patent.

The Prior Art.

Five prior patents indicating the state of the art were cited by the Patent Office in the prosecution of the '798 application. Four of these patents, 10 other United States patents and two prior-use spring-clamp arrangements not of record in the '798 file wrapper were relied upon by respondents as revealing the prior art. The District Court and the Court of Appeals found that the prior art "as a whole in one form or another contains all of the mechanical elements of the 798 Patent." One of the prior-use clamp devices not before the Patent Examiner—Glencoe—was found to have "all of the elements."

We confine our discussion to the prior patent of Graham, '811, and to the Glencoe clamp device, both among the references asserted by respondents. The Graham '811 and '798 patent devices are similar in all elements, save two: (1) the stirrup and the bolted connection of the shank to the hinge plate do not appear in '811; and (2) the position of the shank is reversed, being placed in patent '811 above the hinge plate, sandwiched between it and the upper plate. The shank is held in place by the spring rod which is hooked against the bottom of the hinge plate passing through a slot in the shank. Other differences are of no consequence to our examination. In practice the '811 patent arrangement permitted the shank to wobble or fishtail because it was not rigidly fixed to the hinge plate; moreover, as the hinge plate was below the shank, the latter caused wear on the upper plate, a member difficult to repair or replace.

Graham's '798 patent application contained 12 claims. All were rejected as not distinguished from the Graham '811 patent. The inverted position of the shank was specifically rejected as was the bolting of the shank to the hinge plate. The Patent Office examiner found these to be "matters of design well within the expected skill of

the art and devoid of invention." Graham withdrew the original claims and substituted the two new ones which are substantially those in issue here. His contention was that wear was reduced in patent '798 between the shank and the heel or rear of the upper plate.¹¹ He also emphasized several new features, the relevant one here being that the bolt used to connect the hinge plate and shank maintained the upper face of the shank in continuing and constant contact with the underface of the hinge plate.

Graham did not urge before the Patent Office the greater "flexing" qualities of the '798 patent arrangement which he so heavily relied on in the courts. The sole element in patent '798 which petitioners argue before us is the interchanging of the shank and hinge plate and the consequences flowing from this arrangement. The contention is that this arrangement—which petitioners claim is not disclosed in the prior art—permits the shank to flex under stress for its *entire* length. As we have sketched (see sketch, "Graham '798 Patent" in Appendix, Fig. 2), when the chisel hits an obstruction the resultant force (A) pushes the rear of the shank upward and the shank pivots against the rear of the hinge plate at (C). The natural tendency is for that portion of the shank between the pivot point and the bolted connection (*i. e.*, between C and D) to bow downward and away from the hinge plate. The maximum dis-

¹¹ In '811, where the shank was above the hinge plate, an upward movement of the chisel forced the shank up against the underside of the rear of the upper plate. The upper plate thus provided the fulcrum about which the hinge was pried open. Because of this, as well as the location of the hinge pin, the shank rubbed against the heel of the upper plate causing wear both to the plate and to the shank. By relocating the hinge pin and by placing the hinge plate between the shank and the upper plate, as in '798, the rubbing was eliminated and the wear point was changed to the hinge plate, a member more easily removed or replaced for repair.

tance (B) that the shank moves away from the plate is slight—for emphasis, greatly exaggerated in the sketches. This is so because of the strength of the shank and the short—nine inches or so—length of that portion of the shank between (C) and (D). On the contrary, in patent '811 (see sketch, "Graham '811 Patent" in Appendix, Fig. 2), the pivot point is the upper plate at point (c); and while the tendency for the shank to bow between points (c) and (d) is the same as in '798, the shank is restricted because of the underlying hinge plate and cannot flex as freely. In practical effect, the shank flexes only between points (a) and (c), and not along the entire length of the shank, as in '798. Petitioners say that this difference in flex, though small, effectively absorbs the tremendous forces of the shock of obstructions whereas prior art arrangements failed.

The Obviousness of the Differences.

We cannot agree with petitioners. We assume that the prior art does not disclose such an arrangement as petitioners claim in patent '798. Still we do not believe that the argument on which petitioners' contention is bottomed supports the validity of the patent. The tendency of the shank to flex is the same in all cases. If free-flexing, as petitioners now argue, is the crucial difference above the prior art, then it appears evident that the desired result would be obtainable by not boxing the shank within the confines of the hinge.¹² The only other effective place available in the arrangement was to attach it below the hinge plate and run it through a

¹² Even petitioners' expert testified to that effect:

"Q. Given the same length of the forward portion of the clamp . . . you would anticipate that the magnitude of flex [in '798] would be precisely the same or substantially the same as in 811, wouldn't you?

"A. I would think so."

stirrup or bracket that would not disturb its flexing qualities. Certainly a person having ordinary skill in the prior art, given the fact that the flex in the shank could be utilized more effectively if allowed to run the entire length of the shank, would immediately see that the thing to do was what Graham did, *i. e.*, invert the shank and the hinge plate.

Petitioners' argument basing validity on the free-flex theory raised for the first time on appeal is reminiscent of *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545 (1938), where the Court called such an effort "an afterthought. No such function . . . is hinted at in the specifications of the patent. If this were so vital an element in the functioning of the apparatus it is strange that all mention of it was omitted." At p. 550. No "flexing" argument was raised in the Patent Office. Indeed, the trial judge specifically found that "flexing is not a claim of the patent in suit . . ." and would not permit interrogation as to flexing in the accused devices. Moreover, the clear testimony of petitioners' experts shows that the flexing advantages flowing from the '798 arrangement are not, in fact, a significant feature in the patent.¹³

We find no nonobvious facets in the '798 arrangement. The wear and repair claims were sufficient to overcome

¹³ "Q. . . . Do you regard the small degree of flex in the forward end of the shank that lies between the pivot point and the point of spring attachment to be of any significance or any importance to the functioning of a device such as 798? A. Unless you are approaching the elastic limit, I think this flexing will reduce the maximum stress at the point of pivot there, where the maximum stress does occur. I think it will reduce that. I don't know how much.

"Q. Do you think it is a substantial factor, a factor of importance in the functioning of the structure? A. Not a great factor, no."

The same expert previously testified similarly in *Jeoffroy Mfg., Inc. v. Graham*, 219 F. 2d 511.

the patent examiner's original conclusions as to the validity of the patent. However, some of the prior art, notably Glencoe, was not before him. There the hinge plate is below the shank but, as the courts below found, all of the elements in the '798 patent are present in the Glencoe structure. Furthermore, even though the position of the shank and hinge plate appears reversed in Glencoe, the mechanical operation is identical. The shank there pivots about the underside of the stirrup, which in Glencoe is *above* the shank. In other words, the stirrup in Glencoe serves exactly the same function as the heel of the hinge plate in '798. The mere shifting of the wear point to the heel of the '798 hinge plate from the stirrup of Glencoe—*itself* a part of the hinge plate—presents no operative mechanical distinctions, much less nonobvious differences.

APPENDIX TO OPINION OF THE COURT.

Figure 1.—GRAHAM '798 PATENT

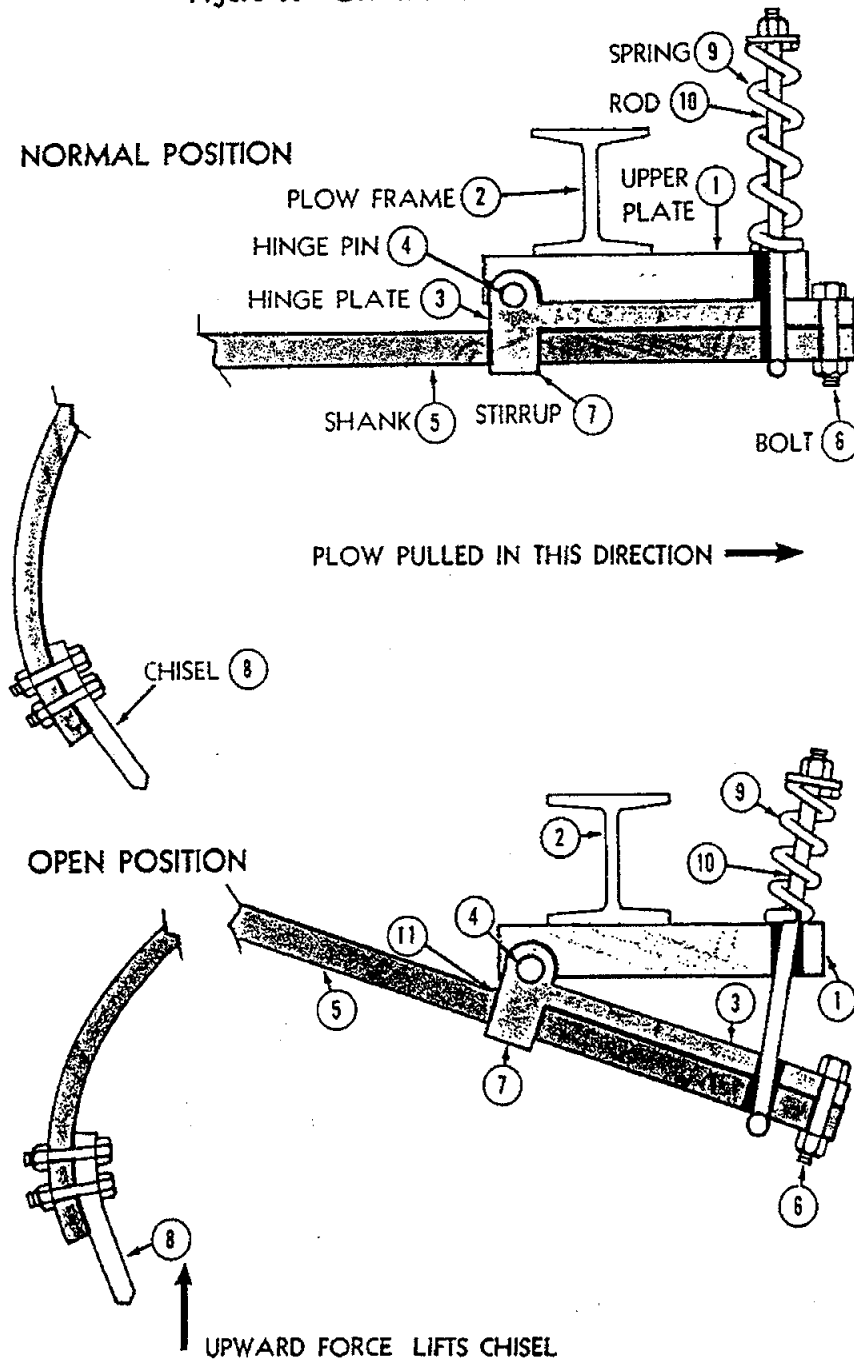
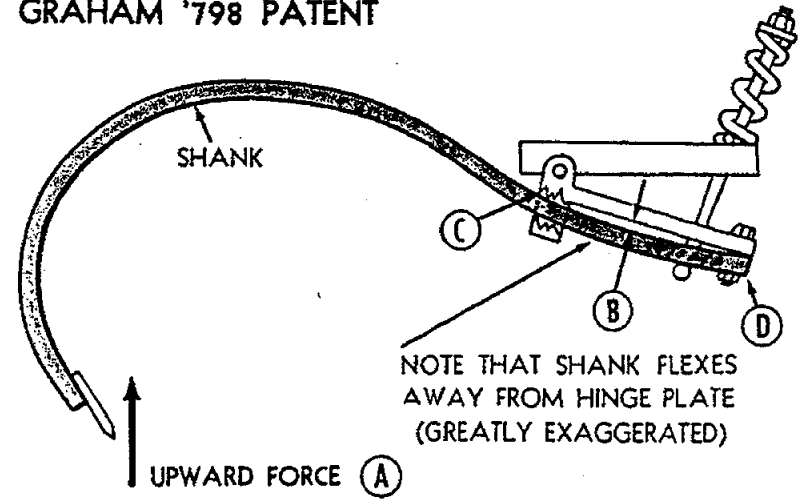


Figure 2.—FLEX COMPARISON

GRAHAM '798 PATENT



GRAHAM '811 PATENT

