85th Congress
1st Session

COMMITTEE PRINT

# EFFORTS TO ESTABLISH A STATUTORY STANDARD OF INVENTION

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## STUDY OF THE SUBCOMMITTEE ON PATENTS, TRADEMARKS, AND COPYRIGHTS

OF THE

## COMMITTEE ON THE JUDICIARY

UNITED STATES SENATE

EIGHTY-FIFTH CONGRESS, FIRST SESSION

PURSUANT TO

S. Res. 55

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STUDY NO. 7



Printed for the use of the Committee on the Judiciary

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UNITED STATES
GOVERNMENT PRINTING OFFICE
WASHINGTON : 1958

97082

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## FOREWORD

This study, by Victor L. Edwards of the Legislative Reference Service, Library of Congress, was prepared for the Subcommittee on Patents, Trademarks, and Copyrights as part of its study of the United States patent system, conducted pursuant to Senate Resolution 55 of the 85th Congress. It was prepared under the supervision of John C. Stedman, associate counsel for the subcommittee, and is one of several historical digests covering important and recurring congressional proposals for amending the patent laws. Others will be published shortly.

Efforts to formulate a definition of "invention" which the Patent Office and courts can use in determining whether a novel idea is patentable have occupied the Congress, the judiciary, and practitioners since the early days of the patent system, and especially since the 1850 decision in *Hotchkiss* v. *Greenwood*. From 1943 when the National Patent Planning Commission recommended an objective test based upon "advancement of the arts and sciences," until 1952, when the test of *Hotchkiss* v. *Greenwood* was written into the statutes, activity in Congress centered mainly in efforts to hit upon a satisfactory statutory definition or, alternatively, to decide what weight should be given Patent Office determinations of invention. Since 1952, the issue has been returned to the courts which are now in the throes of deciding what meaning shall attach to the 1952 enactment.

The present study pictures this struggle, giving especial attention to the legislative efforts to define "invention" and the legislative history surrounding the 1952 enactment. The recital is supplemented by selected annotations covering the court interpretations of the 1952 enactment and bibliography on the subject of "invention."

This study is presented as the result of the work of Mr. Edwards for the consideration of the members of the subcommittee. It does not represent any conclusion of the subcommittee or its members.

JOSEPH C. O'MAHONEY,
*Chairman, Subcommittee on Patents, Trademarks, and Copyrights,*
*Committee on the Judiciary, United States Senate.*

SEPTEMBER 9, 1957.

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No. 2. Frost, The Patent System and the Modern Economy (1956).
No. 3. Patent Office, Distribution of Patents Issued to Corporations, 1939–1955 (1956).
No. 4. Federico, Opposition and Revocation Proceedings in Patent Cases (1957).
No. 5. Vernon, The International Patent System and Foreign Policy.
No. 6. Palmer, Patents and Nonprofit Research.
No. 7. Efforts to Establish a Statutory Standard of Invention.

### Other Publications

Hearings, American Patent System, October 10, 11, and 12, 1955.
Hearings, Inventors' Awards, June 7, 1956.
Hearings, Patent Extension, May 4 and June 13, 1956.
Hearings, Wonder Drugs, July 5 and 6, 1956.
Report, Review of the American Patent System (S. Rept. No. 1464, 1956).
Report, Patents, Trademarks, and Copyrights (S. Rept. No. 72, 1957).

# EFFORTS TO ESTABLISH A STATUTORY STANDARD OF INVENTION

## I. EARLY PATENT ACTS

### A. THE PATENT ACT OF 1790

The first Patent Act was passed April 10, 1790. Section 1 of the act provided:

> Upon petition by any person * * * to the Secretary of State, the Secretary for the Department of War, and the Attorney General of the United States, setting forth that he * * * has *invented or discovered* any useful art, manufacture, engine, machine, or device, or any improvement therein not before known or used * * * it shall * * * be lawful * * * for the Secretary of State, the Secretary for the Department of War, and the Attorney General, or any two of them, if they deem the *invention or discovery* sufficiently useful and important * * * to issue a patent * * *.[1]

### B. THE PATENT ACT OF 1793

This act was superseded by a second Patent Act, passed February 21, 1793,[2] which provided for the issuance of a patent without an examination as to novelty. Compliance with the formal requirements of the law resulted in the routine clerical granting of the patent.

The act provided that any person who—

> invented any new and useful art, machine, manufacture or composition of matter, or any new and useful improvement thereon not known or used before the application—

and who met the formal requirements as to filing and disclosure, could obtain a patent.

### C. THE PATENT ACT OF 1836

A third Patent Act was passed July 4, 1836,[3] which provided for most of the features which we now understand as being fundamental to our patent system. It created a Patent Office with a Commissioner of Patents, and it gave to the Commissioner discretion to grant patents for inventions which he deemed to be "sufficiently useful and important." The act reintroduced the alternative concept of "invented or discovered" which had been dropped in the Patent Act of 1793, and retained the dual requirement that inventions or discoveries must be "new and useful."

Insofar as the establishment of a statutory standard of invention is concerned, the requirement that alleged inventions or discoveries

[1] 1 Stat. 109. [Italics added.]
[2] 1 Stat. 318.
[3] 5 Stat. 117.

be "new and useful" remained the sole test from 1836 until the latest revision and codification of the patent laws which became effective January 1, 1953.[4]

### D. THE REVISED STATUTES OF 1874

Before considering the bills introduced in an effort to establish such a standard, mention should be made of the general revision of the laws which resulted in the enactment, on June 22, 1874, of the Revised Statutes. Section 4886 of the Revised Statutes, as subsequently amended, reads:

> Any person who has *invented or discovered any new and useful* art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof, or more than one year prior to his application, and not in public use or on sale in this country for more than one year prior to his application, unless the same is proved to have been abandoned, may, upon payment of the fees required by law, and other due proceedings had, obtain a patent therefor.[5]

## II. THE NATIONAL PATENT PLANNING COMMISSION

In 1941 President Roosevelt appointed the National Patent Planning Commission to examine the patent system.[6]

### A. RECOMMENDATIONS

The Commission, headed by Charles F. Kettering, recommended:

> * * * the enactment of a declaration of policy that patentability shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the process by which the invention may have been accomplished. * * *
>
> One of the greatest technical weaknesses of the patent system [the report continued] is the lack of a definitive yardstick as to what is invention. To provide such a yardstick and to assure that the various courts of law and the Patent Office shall use the same standards, several changes are suggested. It is proposed that Congress shall declare a national standard whereby patentability of an invention shall be determined by the objective test as to its advancement of the arts and sciences.[7]

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[4] 35 U. S. C. 1 et seq.
[5] Italics added.
[6] Executive Order 8977, 1941; Federal Register 6441.
[7] Report of the National Patent Planning Commission, June 18, 1943, H. Doc. 239, 78th Cong., pp. 6, 10.

## III. LEGISLATIVE HISTORY OF BILLS INTRODUCED IN SUBSEQUENT CONGRESSES

A legislative history of bills introduced during subsequent Congresses in an effort to establish a statutory standard of invention follows:

### A. INVENTION DETERMINED OBJECTIVELY; "NATURE OF THE CONTRIBUTION" TEST

[H. R. 3694 (79th Cong., 1st sess.), Representative Hartley; H. R. 5248 (80th Cong., 2d sess.), Representative Hartley; H. R. 4798 (81st Cong., 1st sess.), Representative Bryson]

#### 1. TEXT OF PROPOSED BILLS

Each of these bills would have amended title 35, United States Code, section 31 [R. S. 4886] by adding to the end thereof:

> Patentability of inventions and discoveries, including discoveries due to research, and improvements thereof, shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the nature of the mental process by which the invention or discovery, or the improvement thereof, may have been accomplished.

#### 2. OTHER CHANGES

A second change was the substitution of the plural form of inventor, i. e., "any person or persons who has or have invented" for the singular form.

#### 3. LEGISLATIVE ACTION

##### a. H. R. 3694, H. R. 5248, H. R. 4798

H. R. 3694 received no action. Each of the other bills was given a hearing, but was not reported out of committee.

##### b. Hearings, H. R. 5248 [8]

Hearings on H. R. 5248 were held May 5, 7, and 12, 1948, before the House Subcommittee on Patents, Trademarks, and Copyrights.

Of those witnesses who presented personal testimony, 3 approved of the bill, either "as is" or with amendments, 1 approved in principle, and 1 was opposed.

(*1*) *Proponents of the bill*

(*a*) *Giles Rich, New York Patent Law Association.*—The testimony of Giles Rich, representing the New York Patent Law Association (hearings, pp. 46–49), sets forth the position of the proponents of the bill:

> The purpose of this bill is admirable * * *, but we recommend * * * taking out the words "objectively" and "subjectively" * * *. These words originated in the suggestion

[8] U. S. Congress. House Committee on the Judiciary. Contributory Infringement in Patents, Definition of Invention; hearings * * * on H. R. 5988, H. R. 4061, H. R. 5248, May 5–12, 1948.

> of the NPPC, but the more you think about them the less clear they are.
>
> Another difficulty is * * * "patentability of inventions" which leaves in the law possibly * * * the matter of defining invention.
>
> That is what we are trying to get away from. So long as invention is there they can say it isn't good enough to be an invention. What we are really concerned with * * * is some test for determining patentability * * *.

The New York Patent Law Association, speaking through Mr. Rich, favored substitution of the following language for the last sentence of the bill:

> The patentability shall be determined by the nature of the contribution to the advancement of the art not by the nature of the process by which such contribution may have been accomplished.

(*b*) *Others.*—Others agreeing with this position were Robert W. Byerly, chairman, committee on patents, Association of the Bar of the City of New York (hearings, p. 49), and Charles S. Wilson, chairman, patent committee, Aircraft Industries Association (hearings, pp. 49–51).

(*2*) *Opponents of the bill*

(*a*) *George E. Folk, patent adviser to the National Association of Manufacturers.*—Opposed passage of the bill as "wholly unnecessary" (hearings, pp. 51–52). The NAM felt that the proposed definition would add further complication to the question and increase confusion in the courts.

(*b*) *Robert C. Watson, Watson, Cole, Grindle & Watson.*—Mr. Watson submitted written objections in which he recommended that the present procedure be followed; namely, that the courts be permitted to continue to determine whether a patentee has made an invention (hearings, p. 82).

(*c*) *Chicago Patent Law Association.*—The position of the Chicago Patent Law Association was:

> * * * the proposed amendment * * * lacks one of the essential requirements of any statute—namely, definiteness and clarity—and it * * * would tend to confuse, rather than assist, the courts in passing on the question of patentability.
>
> * * * a conscientious judge attempting to follow the dictates of the proposed statute might well place undue emphasis on evidence of commercial success * * * no yardstick has yet been proposed for determining this issue by any method which would act as a substitute for the sound judgment of a court (hearings, pp. 52–53).

(*3*) *Others*

(*a*) *Department of Justice.*—Was of the view that—

> a study * * * of the subject * * * is a desirable one to be undertaken * * * and * * * if appropriate language can be drawn, it may * * * be desirable to amend * * * (hearings, pp. 65–69, 83–86).

The Department did not recommend passage of the pending bill.

c. Hearings, H. R. 4798

Hearings on H. R. 4798 were held June 15 and 22, 1949, before Subcommittee No. 4 of the Committee on the Judiciary of the House.

(*1*) *Proposed amendments to bill*

Various amendments to the bill were proposed during the course of the hearings. These proposals are set forth below, together with the identity of the person or group which recommended the change and a short statement setting forth their reasons.

(*a*) *New York Patent Law Association.*—It proposed substituting the following in lieu of the last sentence of the present bill:

> Patentability shall be determined by the nature of the contribution to the advancement of the art, not by the nature of the process by which such contribution may have been accomplished.

In support of its proposal, it urged that by thus eliminating the words "objectively" and "subjectively" emphasis would be placed upon the accomplishment, rather than upon the mental process of the inventor (hearings, pp. 1–7). It opposed eliminating the idea that invention must be found to exist;

> all we say is that invention shall be judged or tested by the objective result of what has been done and not by what went on in the man's mind when he created this new thing.

(*b*) *Aircraft Industries Association.*—Proposed amending the last sentence to read:

> Patentability of inventions and discoveries, including those due to research and improvement thereof, shall be determined objectively by the nature of the contribution to the advancement of the art, and not subjectively by the manner in which the invention or discovery or improvement thereof may have been accomplished.

The amendments proposed were designed (1) to include "inventions" due to research as well as "discoveries" and (2) to prevent a limited interpretation as to the type of act required to make an invention, substituting "manner" for "nature of the mental process" (hearings, pp. 11–21).

(*c*) *Fritz Lanham, National Patent Council.*—Proposed substituting the following in lieu of the last sentence:

> Patentable invention shall be presumed to be present if the invention or discovery for which application for patent is made, or upon which a patent is granted, is directed to patentable subject matter, is new and useful, and represents an advance in the art or science to which it appertains or most nearly appertains which would not be obvious to one skilled in such art or science at the time of conception thereof and irrespective of the manner in which or the circumstances under which such invention or discovery was conceived.

Language of this character, he contended, would tend to insure that—

> if the subject matter of an invention is patentable in the statutory sense * * * and represents an advancement of the

given art in such a way as not to be obvious to one skilled in that art at the time the invention was made, it should be patented and the patent should be respected in judicial proceedings and not be subjected to any judicial fancy concerning the circumstances under which the invention was made (hearings, pp. 41–49).

(*d*) *C. E. Beach, consulting engineer.*—Proposed substituting the following in lieu of the last sentence:

> Patentable invention shall be presumed to be presented, irrespective of the nature of the mental processes by which, or the circumstances under which, the invention or discovery or the improvement thereof was conceived or made, if the invention or discovery, or improvement thereof, for which application for patent is pending or upon which a patent is granted, is directed to new and useful subject matter and represents, in the art or science to which it appertains or most nearly appertains, an advance that would not be obvious, at the time of conception or discovery thereof, to one skilled in such art or science (hearings, p. 67).

(*2*) *Opponents of the bill*

Opposing passage of the bill were Drury W. Cooper (hearings, pp. 7–11), the American Patent Law Association (hearings, pp. 21–26), the Department of Justice (hearings, pp. 29–41), and the legislative committee of the Patent Law Association (hearings, p. 51).

(*a*) *American Patent Law Association.*—The position of the American Patent Law Association was based upon three grounds: (1) Setting up as a single test of patentability [the nature of the contribution to the advancement of the art] makes it difficult for the Patent Office to determine the question in those cases where the invention has not gone into commercial usage or enjoyed commercial success, since the question must be decided solely on the basis of the prior art; (2) the language of the test is indefinite, implying that commercial utilization might be the important factor; both the courts and the Patent Office might be inclined to put a premium on commercial utility and commercial success, whereas all that the first part of the statute requires is that the invention be new and useful; (3) the exclusion of the consideration of the nature of the mental process by which the invention may have been developed is objectionable in those cases where the real effort of the inventor was in exercising considerable ingenuity in finding out what a particular problem was and then finding a solution.

(*b*) *Department of Justice.*—Interposed a twofold objection to passage of the proposed bill: (1) The provision that patentability shall be determined objectively "by the nature of the contribution to the advancement of the art" is little more definite than the test furnished by the word "invention" itself; (2) by making this the sole test of invention, other factors that must be considered if the constitutional purpose of the patent system is to be carried out, are ignored.

> The test is a relative, not an absolute, one. It necessarily depends upon the state of the art at the time the particular improvement is made and the degree of ingenuity, intelligence, and imagination to be found in those working in the particular art.

The objective tests proposed—that invention is to be determined "by the nature of the contribution to the advancement of the art"—might be interpreted in either of two ways. If it merely means that the Patent Office and the courts must examine the applicant's contribution to determine whether it is something unique and unexpected, the test is little different from that presently applied. If it means that the Patent Office and the courts shall look only to the nature of the contribution in the sense of whether the applicant's improvement is a useful one, without regard to whether it would be obvious to one skilled in the art, it represents a doctrine which is inconsistent with the basic objectives of the patent system.

The test of invention is not whether the contribution is useful—utility is a sine qua non of patentability in any event—but whether it represents something which would not likely have become available to the public, at least for a long time, but for efforts inspired by the patent system and its rewards.

## B. INVENTION A QUESTION OF FACT; "LONG-FELT WANT" TEST

[H. R. 4061 (80th Cong., 1st sess.), Representative Gamble]

### 1. TEXT OF PROPOSED BILL

H. R. 4061 would amend Revised Statutes 4886 (35 U. S. C. 31) by adding:

When, in any proceeding before any tribunal having jurisdiction to determine the patentability of a claim in a patent application or the validity of a claim of an issued patent, the issue arises in respect to the question of whether the subject matter defined by such claim amounts to invention, that question shall be one of fact and all evidence, relevant, competent, and material concerning the question shall be admissible. If the preponderating weight of such evidence shows that the subject matter of the claim complies with the requirements previously set forth in this section and fills a long-felt want, such evidence shall be deemed sufficient to constitute proof that the subject matter of the claim amounts to invention, provided the preponderating weight of such evidence further shows that, prior to such invention, the skill of the art to which the invention appertains had not supplied such want and in its then state of development was unable so to do.

### 2. LEGISLATIVE ACTION

#### a. Hearings, H. R. 4061

Hearings were held May 5, 7, and 12, 1948, before the House Subcommittee on Patents, Trademarks, and Copyrights. It was not reported out.

(1) *Proponents of the bill*

Enactment of H. R. 4061 was urged by Joseph V. Meigs (hearings, pp. 35–44) and Charles S. Wilson, chairman, patent committee, Aircraft Industries Association (hearings, pp. 49–51, 90–92).

(*a*) *Joseph V. Meigs.*—Mr. Meigs, who assisted Representative Gamble in the drafting of the bill, explained the purposes of the bill in the following words (hearings, pp. 43–44):

> Many courts have said * * * that if a want has existed for a long time for a new product, and if that want has not been supplied, then the failure to supply that want * * * should be evidence that something more is required than the ordinary skill of the artisan * * *.
>
> * * * The purpose of H. R. 4061 is to establish a legislative rule that the question of invention shall whenever possible be determined on an objective, factual basis.

(*b*) *Aircraft Industries Association.*—It recommended that the following language be substituted for the last sentence of the bill:

> While not a present requisite thereto if the preponderating weight of the evidence shows that the subject matter of the claim fills a long-felt want which the skill of the art and its then state of development is unable to fulfill, then such evidence shall be deemed to constitute proof of the fact that such claimed subject matter does amount to invention.

(2) *Opponents of the bill*

Passage of the bill was opposed by George E. Folk, of the National Association of Manufacturers (hearings, pp. 51–53, 92–96), the Department of Justice (hearings, pp. 65–69, 83–86), Fritz Lanham (hearings, pp. 69–70), Giles Rich, of the New York Patent Law Association (hearings, pp. 46–49, 90), the Chicago Patent Law Association (hearings, p. 88), and Robert C. Watson, of Watson, Cole, Grindle & Watson (hearings, p. 82).

(*a*) *New York Patent Law Association.*—The opponents' position is best summarized by the following excerpts from the presentation of the New York Patent Law Association:

> The law is usually stated by saying that the "invention" must be something more than what would be expected of a "worker skilled in the art" (a fictitious person like the "ordinary reasonable man"). It is believed that fundamentally the bill leaves this rule untouched, because it says that the evidence adduced on the question of "invention" shall be sufficient proof thereof if it shows that the skill of the art had not supplied a long-felt want and was unable to do so. This seems to us no more than another way of stating that the alleged "invention" was shown by the evidence to be the product of something more than would be expected of a worker skilled in the art * * *
>
> The bill is objectionable for another reason. One of the traditional tests for "invention" is that when produced it filled a "long-felt want." This, however, is but a single test. Moreover, the test laid down in the bill is a strict one. To come within the test, applicant would have to prove the

existence of the want and both failure and inability of the skill of the art to fill it. Inability could not be proved without proof of continuing attempts to fill a generally recognized want. In the case of many highly useful inventions, worthy of patent protection, there is no provable long-felt want, unless such want is to be deduced from commercial success * * *

## C. "NOVELTY," "UTILITY," AND "ROUTINE SKILL" TESTS; PATENT OFFICE DETERMINATION FINAL

[S. 2518 (81st Cong., 1st sess.), Senator Wiley; H. R. 6436 (81st Cong., 1st sess.), Representative Church]

### 1. TEXT OF PROPOSED BILLS

These two bills would amend Revised Statutes 4886 (35 U. S. C. 31) by calling the present text subsection (a) and by adding at the end thereof a new subsection (b) to read:

> (b) There shall be no criteria of patentable invention or discovery other than novelty (beyond what is reasonably to be expected of the ordinary person exercising the mere routine skill of the art) and utility; and the existence of such novelty and utility to support patentability shall be facts to be determined by the Commissioner of Patents in the first instance, and such determination by the Commissioner of Patents shall be final in any action or proceeding involving an issued patent unless the determination is clearly erroneous in view of all the evidence in any such action or proceeding.

### 2. LEGISLATIVE ACTION

Neither of these bills had a hearing or was debated.

### 3. ANALYSIS OF THE BILLS

The bills were (1) an attempt to incorporate into the code the rule of *Hotchkiss* v. *Greenwood* (1850), 11 How. 250, to the effect that in order to find patentable invention something more than the skill and ingenuity possessed by an ordinary mechanic acquainted with the business must be present; and (2) to give the finding of patentability by the Commissioner of Patents a standing which it does not now possess; namely, finality, unless clearly erroneous in view of all the evidence presented in any action or proceeding involving the validity of an issued patent.

## D. PRELIMINARY DRAFT, "PROPOSED REVISION AND AMENDMENT OF THE PATENT LAWS"

With the foregoing background, Representative Bryson, chairman of Subcommittee No. 4 of the House Committee on the Judiciary, prepared and had printed a preliminary draft of a "Proposed Revision and Amendment of the Patent Laws" which was widely circulated in February 1950. Section 23 of the draft deals with the test of invention.

### 1. TEXT OF SECTION 23 OF THE "DRAFT"

Sec. 23. Conditions for patentability, lack of invention.

A patent may not be obtained though the invention is not identically disclosed or described in the material specified in section 22 of this title, if the differences between the subject matter sought to be patented and said material are such that the subject matter as a whole would be obvious to an ordinary person skilled in the art.

Patentability as to this condition shall be determined by the nature of the contribution to the advancement of the art, and not by the nature of the mental processes by which such contribution may have been accomplished.

### 2. REVISER'S NOTE RE SECTION 23

According to the reviser's note, the first paragraph was added for two reasons: (1) A specific statement in the statute of what is the test of *Hotchkiss* v. *Greenwood*, supra, might have some stabilizing effect; and (2) it serves as a basis for the addition of a provision defining or setting a standard of invention if such addition is considered desirable or necessary.

The second paragraph of section 23 relates to the establishment of an objective standard of invention, and the reviser cites the bills considered above.[9]

### 3. SUBSEQUENT HISTORY OF "DRAFT"

As a result of the comments received, the committee decided to eliminate numerous proposed changes from the bill and defer them for later consideration, and to limit the bill to the main purpose of codification and enacting title 35 into law, with the further object of making a number of minor procedural and substantially noncontroversial changes.

Numerous suggestions were received by the committee from the patent bar and the public. Taking into consideration the suggestions and criticisms and other comments which had been received by the committee, a bill was prepared and introduced in the 81st Congress, H. R. 9133 * * *.[10]

## E. "ORDINARY SKILL IN THE ART" TEST

[H. R. 9133 (81st Cong., 2d sess.), H. R. 3760 (82d Cong., 1st sess.), H. R. 7794 (82d Cong., 2d sess.)]

### 1. TEXT OF PROPOSED BILLS

#### a. H. R. 9133, section 103: Comparison to section 23 of the "draft"

Section 103 of H. R. 9133 corresponds in general to section 23 of the preliminary draft. It reads as follows:

[9] H. R. 3694 (79th Cong.); H. R. 4061, 5428 (80th Cong.); H. R. 4798 (81st Cong.).

[10] Testimony, Charles J. Zinn, in: U. S. Congress. House Committee on the Judiciary. Patent Law Codification and Revision, hearings before Subcommittee 3, 82d Cong., 1st sess., on H. R. 3760, June 13–15, 1951.

Sec. 103. Conditions for patentability, nonobvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described in the material specified in section 102 of this title, if the differences between the subject matter sought to be patented and said material 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.

Patentability as to this condition shall be determined by the nature of the contribution to the art, and shall not be negatived by the manner in which such contribution may have been accomplished.

The first paragraph of section 103 differs from section 23 of the preliminary draft only in that it requires that the subject matter "as a whole" of an alleged invention "would have been obvious at the time the invention was made" to a person having ordinary skill in the art, rather than that the subject matter "as a whole" of the alleged invention "be obvious to an ordinary person skilled in the art" without reference to the time that such obviousness was required.

The second paragraph eliminated any reference to the "nature of the mental processes" by which the contribution may have been accomplished, and omitted the words "advancement of the."

b. H. R. 3760, section 103

Section 103 of this bill pertains to the test of invention, it reads as follows:

Sec. 103. Conditions for patentability; nonobvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described in the prior art set forth in section 102 of this title, if the differences between the subject matter sought to be patented and that 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 negatived by the manner in which the invention was made.

2. LEGISLATIVE ACTION

a. H. R. 9133

H. R. 9133 was primarily intended for circulation among the patent bar and the public with the hope of stimulating further comment and general interest in the revision and codification of the patent laws. There were no hearings on the bill and no report was issued. Instead, a fresh bill, H. R. 3760, was introduced.

b. Hearings, H. R. 3760

Hearings on H. R. 3760 were held on June 13–15, 1951, before Subcommittee No. 3 of the House Committee on the Judiciary.[11]

[11] See note 10, supra.

(1) *Colloquy between I. J. Fellner, Dr. Salsbury's Laboratories, and Representative Bryson*

The apparent discrepancy between the wording of section 103 of H. R. 9133 and section 103 of H. R. 3760 was brought to the attention of the subcommittee by I. J. Fellner, manager, patent department, Dr. Salsbury's Laboratories, from whose testimony (hearings, pp. 123–124) the following is extracted:

> Mr. FELLNER. As far as section 103 is concerned, the old version in H. R. 9133 provided for objective criteria in evaluating the invention * * *. And I am asking myself whether this deletion again is to be understood as a mere revision of language or whether the committee thought that the original wording was too broad, and that actually the inventive standards should be set in accordance with, for instance, such type of decisions as those in the Great Atlantic case recently rendered in the Supreme Court * * *.
>
> The question now before the committee is, whether it is of the opinion that we should have a positively evaluative criterion for inventions. In other words, shall we say that evidence of invention is recognized in the fact itself that a new device or a new machinery satisfying a need of long standing is presented where the inventor is the first to recognize that need and has found the solution, though it be simple for it, and where the solution was readily accepted by the trade? Is that evidence of invention or not?
>
> I thought the committee was of that opinion when I read the original version in H. R. 9133, where it was specified that "patentability as to this condition shall be determined by the nature of the contribution to the art." In other words, evidence of invention is the readiness with which the novelty has been accepted; it is spelled out by the value which actually resides in the contribution to art. Under this definition we would not have to go into a particular inquiry with regard to the question of inventiveness or what has been called "inventive genius," which terms have been used by various Supreme Court decisions and in various other court opinions.
>
> Now, in the new bill, this positive criterion of evidence of invention has been omitted. Does that mean to repeal that part of the original concept according to which evidence of invention may actually be represented by the value of the thing that has been invented or has been found by the inventor? We thought it did.
>
> Mr. BRYSON. We think not.
>
> Mr. FELLNER. Maybe not?
>
> Mr. BRYSON. We think not * * *.
>
> Mr. FELLNER. Do you think that the sentence in the second paragraph "patentability shall not be negatived by the manner in which such invention was made" broadens, so to speak, the concept of invention so as to include the positive criteria as found in the original bill.
>
> Mr. BRYSON. I do.

(2) *Proposed amendments to H. R. 3760*

Many of the witnesses proposed substitutes for or amendments to section 103. The various proposals are set out below with a short statement of the reasons advanced in behalf of the proposed changes.

(a) *Coordinating Committee on Revision and Amendment of the Patent Laws of the National Council of Patent Law Associations.*—Proposed substitute:

> A patent may not be refused or declared invalid when the invention is not identically disclosed or described as set forth in section 102 of this title, unless the difference between the subject matter sought to be patented and that 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 negatived by the manner in which the invention was made.

No specific reasoning was advanced for this proposed change (hearings, p. 33).

(b) *Aircraft Industries Association.*—Proposed substitute:

> A patent may not be refused or declared invalid when the invention is not identically disclosed or described in the prior art set forth in section 102 of this title, if the differences between the subject matter sought to be patented and that prior art are such that the subject matter as a whole involved more than the ordinary skill of the art at the time the invention was made. Patentability shall not be negatived by the manner in which the invention was made.

The reasons given for this recommendation were as follows (hearings, p. 114): Since these conditions for patentability relate to a "patent" they must apply to the refusal of a patent by the Patent Office or the considerations of a judicial tribunal on validity or invalidity. The conditions should be the same in either case. The second change rearranges the thoughts expressed to qualify what "would have been obvious" is intended to mean.

(c) *Frank G. Campbell, Shepherd & Campbell.*—Proposed substitute:

> 103a. A case of patentability shall be deemed to have been established when the device of the application achieves a new and useful result, which no single prior device is capable of producing and which result goes beyond mere increased excellence of workmanship.
>
> 103b. A case of patentability shall also be deemed to have been established where a new assembly and relationship of parts accomplishes an old result in a markedly more facile economical and efficient way and especially where a marked saving in time or labor by the user results.

Mr. Campbell deemed it highly desirable to lay down some positive rule rather than a negative one, as to what rises to the dignity of invention (hearings, pp. 190–191).

(d) *Callard Livingston.*—Proposed substitute:

> A patent may be obtained provided the invention is not identically described or disclosed in the prior art set forth in section 102 of this title, and provided that the differences between the subject matter sought to be patented and said prior art are such that the subject matter as a whole could not be reproduced without modificaton of the prior art as it existed at the time the invention was made.

According to Mr. Livingston, the proposed amendment would tend to remove the purely subjective question of what is "mechanical skill" which, like "invention," is practically indeterminable and not susceptible of ultimate definition (hearings, p. 192).

(e) *G. Wright Arnold and Edward R. Walton, Jr.*—Proposed addition:

> Independently of and apart from the above [section 103 as set forth in H. R. 3760], a patent may be obtained for an invention and patentable novelty shall be found therefor, whenever there is established a new functional relationship between any of the factors which are required for rendering an invention in the industrial art practically operative.

This proposal would retain the obvious or nonobvious test of patentability as set forth in H. R. 3760, but, by adding the recommended paragraph, would also set up an objective or "new functional relationship" test which would compel issuance of a patent when it is established that there are new functional relations existing between the cooperating factors (hearings, pp. 193, 198).

(f) *Louis Robertson.*—Proposed substitute:

> A patent may not be obtained though the invention is not identically disclosed or described in the prior art set forth in section 102 of this title, if the differences between the subject matter sought to be patented and that prior art are such that the subject matter as a whole would have naturally occurred at about the time the invention was made to a person having only ordinary skill in the field to which said subject matter relates if he had knowledge of said prior art (all prior art readily available to persons in that field) [words in parentheses preferred] but had no guidance by its preselection, and said subject matter could have been worked out by such person with ordinary technical assistance as he would have been expected to call upon.

Mr. Robertson took the position that almost any inventive idea could be induced into the mind of a good mechanic by carefully selecting the right prior patents, placing them in front of him and saying, "What do these two patents together suggest to you?" Consequently, the test should be: Would the invention have occurred to him without such direction of his thoughts? (hearings, pp. 217–219).

(g) *F. R. Jenkins.*—Proposed amendment:

> Insert after the first sentence of section 103:
> "An applicant's own statement in his application may not be used against him in interpreting prior art."

The reasons given for this proposal were as follows: If, within a composition or machine, applicant states he may use an element A or B, and previously A has been similarly used, prior art rather than applicant's application should be relied on to teach the equivalence of A and B if the skilled person does not already know it (hearings, pp. 219–220).

(h) *Bar Association of the City of New York.*—Proposed substitute:

> 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 negatived by the manner in which the invention was made.

The purpose of these proposed changes was to make it clear that all prior art is here meant and not merely the prior art referred to in section 102 which is limited to anticipatory art (hearings, pp. 221–222).

## c. H. R. 7794

The committee, almost a year after the hearing, on May 20, 1952, in lieu of reporting H. R. 3760, introduced a fresh bill, H. R. 7794, which was approved and signed by the President, July 21, 1952.

Section 103 of the new bill, which became law without amendment, differed from section 103 of H. R. 3760 in that it incorporated the amendments proposed by the Bar Association of the City of New York, set forth above.

(1) *Colloquy between Senator McCarran and Senator Saltonstall*

Senator Wiley, in presenting the bill for consideration, stated:

> The bill simply constitutes a restatement of the patent laws of the United States.[12]

Later, Senator McCarran took up the bill and the following exchange occurred: [13]

> Mr. SALTONSTALL. Mr. President, will the Senator from Nevada tell us the purpose of the bill?
>
> Mr. MCCARRAN. The bill would codify the patent laws of the United States. It is under the able guidance of the Senator from Wisconsin, Mr. Wiley.
>
> Mr. SALTONSTALL. I am not a patent lawyer, but I know patents are a very technical subject. Does the bill change the law in any way or only codify the present patent laws?
>
> Mr. MCCARRAN. It codifies the present patent laws.

Following this, Senator McCarran asked and obtained permission to insert the following prepared statement:

> * * * This legislation has been in the process of study and consideration for a number of years. It has passed the House

[12] Cong. Rec. 98:9097 (1952).
[13] Cong. Rec. 98:9323 (1952).

> and has reached the Senate after lengthy hearings on the House side. The bill has the general approval of all parties concerned and represents a step forward in the codification of our laws, for it brings together in one package all of the laws relating to patents that were contained in the Revised Statutes of 1874 down to the present time. The bill is divided into three categories * * * Into these three categories the existing laws relating to patents have been codified. In view of decisions of the Supreme Court and others as well as trial by practice and error there have been some changes in the law of patents as it now exists and some new terminology used. All these matters * * * have been carefully gone over in hearings and the bill as it is now presented to the Senate represents, in the opinion of the committee, legislation of merit * * * [14]

Immediately following this exchange, the bill was passed.

(2) *House and Senate reports*

The following statements touching upon the meaning and intent of section 103 are found in both the House and Senate reports:

> Although the principal purpose of the bill is the codification of title 35, United States Code, and involves simplification and clarification of language and arrangement, and elimination of obsolete and redundant provisions, there are a number of changes in substantive statutory law. These will be explained in some detail in the revision notes keyed to each section which appear in the appendix of this report. The major changes or innovations in the title consist of incorporating a requirement for invention in section 103 and the judicial doctrine of contributory infringement in section 271.[15]
>
> 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 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.[16]

[14] Ibid.
[15] H. Rept. 1923, 82d Cong., 2d sess., p. 5; S. Rept. 1979, 82d Cong., 2d sess., p. 4.
[16] Id., H. Rept. at 7, S. Rept. at 6.

(3) *Revision notes*

The "Revision Notes" included as appendices in both House and Senate reports accompanying H. R. 7794 read as follows: [17]

> 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 negatived 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.

## IV. SELECTED ANNOTATION OF SECTION 103, PATENT ACT OF 1952

### A. UNITED STATES FEDERAL COURTS

#### 1. UNITED STATES DISTRICT COURTS

*Thys Co.* v. *Oeste* (N. D. Calif. 1953), 111 F. Supp. 665, 673–674:

> A careful study of this new patent code, however, convinces this court that Congress has not intended to change any of the classical norms by which invention shall be tested.
>
> The purpose of the new revision, as the reviser's note points out, is not to revolutionize but to "stabilize" existing law.

*Gagnier Fibre Products Co.* v. *Fourslides, Inc.* (E. D. Mich. S. D. 1953), 112 F. Supp. 926, 929:

> * * * this section, 103, of the new act [first clause] merely stabilized or gave statutory effect to what had been well recognized case law.
>
> [as to the second clause of section 103] This, we must admit is new, because in a Senate report that clause is clarified and it does change some phases of case law. * * * This wording officially not only rejects the "flash of genius" test of Cuno Engineering * * * but it goes farther. Today, one may have a patent if he just "stumbled" upon his invention or it might have even been the result of an accident.

*Joseph Bancroft and Sons Co.* v. *Brewster Finishing Co., Inc.* (D. N. J. 1953), 113 F. Supp. 714, 721:

> Legislative history indicates that Congress did not intend to formulate a new standard of invention: * * *

[17] Id., H. Rept. at 18, S. Rept. at 18.

*Channel Master Corp.* v. *Video Television, Inc.* (E. D. N. Y. 1953), 117 F. Supp. 812, aff'd, 209 F. 2d 511 (5th Cir. 1953):

> Hence, section 103 is merely a codification of the basic requirement that the subject matter of a patent must have invention and patentable novelty which the section expresses in terms of "obviousness" in view of the "prior art".

*Burt* v. *Bilofsky* (D. N. J. 1954), 120 F. Supp. 822, 830:

> The defendants contend that Sections 102 and 103 of the Patent Act of 1952, 35 U. S. C. A., provide a new test of patentability insofar as the issue of patentability in the instant case is concerned. This contention is without merit.

*Modern Art Printing Co.* v. *Skeels* (D. N. J. 1954), 123 F. Supp. 426, 432:

> Section 103 of the revision codifies decisional patent law.

*Hughes* v. *Salem Co-operative Co., Inc.* (W. D. Mich. 1955), 134 F. Supp. 572, 576:

> The new Patent Act of 1952 * * * did not change the basic tests for determining patentability, and the court must determine, within the meaning of the statute conferring patent monopoly, whether there is invention and patentability.

*Seismograph Service Corp.* v. *Offshore Raydist* (E. D. La. 1955), 135 F. Supp. 342, 350–351:

> The Congress has now * * * sought to define a standard of patentability. * * * This standard of patentability is apparently an effort to state in statutory form what the Supreme Court has held in many cases. If it is an effort, as has been suggested, to reduce the standard of invention as recognized by the Supreme Court, then that effort must fail for the reason that the Supreme Court is the final authority on the constitutional standard of patentability.

### 2. UNITED STATES COURTS OF APPEAL

*Wasserman* v. *Burgess and Blacher Co.* (1st Cir. 1954), 217 F. 2d 402, 404:

> Congress by the passage of the Patent Act of 1952 which enacted as a statutory condition of patentability that the proposed invention would not "* * * 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," merely codified the existing decisional law.

*Lyon* v. *Bausch and Lomb Optical Co.* (2d Cir. 1955), 224 F. 2d 530, 536–537, cert. den. 350 U. S. 911:

> * * * Section 103 only restores the original gloss, substantially in ipsissimis verbis; which has never been overruled; but on the contrary for 70 or 80 years had continued to be regarded as authoritative. Moreover—and this is the important consideration—although it may have ceased in

> practice to be followed, and had come to enjoy no more than lip service, there never has been the slightest intimation of any definite substitute; nothing more than an unexpressed and unacknowledged misgiving about the increased facility with which patents were being granted. * * * Certainly a legislature, whose will the courts have undertaken to proliferate, must be free to reinstate the courts' initial interpretation, even though it may have been obscured by a series of later comments whose upshot is at best hazy.

*Gentzel* v. *Manning, Maxwell and Moore* (2d Cir. 1956), 230 F. 2d 341, 344:

> The somewhat more lenient standard of patentability expressed in *Lyon* v. *Bausch and Lomb* * * * as required by the recently enacted statute * * * will not save this weak patent in a crowded field, since whatever advance plaintiff may have made over the prior art is both obvious and slight.

*Stanley Works* v. *Rockwell Mfg. Co.* (3d Cir. 1953), 203 F. 2d 846, cert. denied 346 U. S. 818 (1953):

> On its face section 103 is merely a codification of decisional patent law. The report of the Senate Committee on the Judiciary * * * leaves no doubt about this [p. 849].

*United Mattress Machinery Co., Inc.* v. *Handy Button Machine Co.* (3d Cir. 1953), 207 F. 2d 1, 5:

> Congress has made no attempt to define the term "invention," either under the older law or in the new Patent Act. * * * The district court * * * stated further that the button was unpatentable as not meeting the "flash of genius" test of Cuno Engineering Corp. * * * we do not find it necessary to decide what, if anything, is left of that much-discussed criterion of patentability since the enactment of the new patent statute, particularly the second sentence of section 103, * * * Cf. the second paragraph of the reviser's note following 35 U. S. C., sec. 103 * * *

*R. M. Palmer Company* v. *Luden's, Inc.* (3d Cir. 1956), 236 F. 2d 496, 499:

> It is, perhaps, rather strong language to say that the new act changed the law of patentability. The choice of language in the act indicates, as the legislative history discloses, an attempt to state what the law has been. As such, it is a codification. The difficulty always existed in the application of the law, because to a large extent the standards have been indefinite and subjective. And judicial attempts to improvise expressions covering that which has been said many times before account for numerous descriptive phrasings of an elusive concept. The act was intended to achieve the objective of stabilizing the law through legislative expression which becomes the touchstone of the decisions. Nor is it likely that a constitutional problem will arise so long as the expected interpretations of the statute come within the boundaries of long standing judicial declarations of the con-

tent of patentability. To what extent a change is wrought would seem to depend upon the preexisting views of a tribunal as to the standard upon which it has determined patentability. As pointed out * * * in *Lyon* v. *Bausch and Lomb Optical Co.* * * * despite adherence to the keystone cases, like *Hotchkiss* v. *Greenwood* * * * intangible elements have directed judicial attitudes to "misgiving about the increased facility with which patents were being granted."

We are inclined to accept the sensitive observations of Judge Learned Hand as to the judicial tendency of recent years, even within the language of the older decisions, to expect an indefinite "more" of the proffered invention. The act reaffirms the presumptive validity of patents (35 U. S. C. 1952 ed., sec. 282), and specifies patentability in terms with which all in the field are familiar. It would appear that in this context, and by this choice of terms, the intended stabilizing effect is sought to be achieved. Beyond this, the tribunal faced with an issue of validity is left to the struggle to determine upon which side of a vague boundary line it will place the alleged invention. * * * There is no longer any doubt that the "flash of genius" has been laid to rest.

*Plax Corp.* v. *Precision Extruders, Inc.* (3d Cir. 1957), 239 F. 2d 792, 794:

> * * * We enunciated our interpretation of section 103 in *R. M. Palmer Co.* v. *Luden's, Inc.* * * * and * * * *Newburgh Moire Co.* v. *Superior Moire Co.* We need not repeat in detail here what was said there. It is not necessary that an invention result from a "flash of genius". We think that Ferngren's work involved "more ingenuity * * * than the work of a mechanic skilled in the art". * * *

*Interstate Rubber Products Corp.* v. *Radiator Specialty Co., Inc.* (4th Cir. 1954), 214 F. 2d 546, 548–549:

> The rule [patentability of combination claims] applied by the majority of the Supreme Court in this case [Supermarket] was not changed by the revision of the patent statute by Congress in 1952. * * * the provisions of section 103 merely codified the law laid down by the courts during the past hundred years, and were added to the statute for purposes of uniformity and definiteness.

*General Motors Corp.* v. *Estate Stove Co.* (6th Cir. 1953), 203 F. 2d 912, 915–918, cert. denied 346 U. S. 822 (1953):

> * * * it would appear that the new act has done no more * * * than to adopt the test of so-called "obviousness" which has, in the past, been enunciated by the courts, and that it did not provide a new test differing from that which has been generally followed in the adjudication of patent cases. * * * We are, however, of the view that the principle stated in the Great Atlantic and Pacific Tea case is not modified by the new act, but continues to be the law, and is here controlling.

*Bobertz* v. *General Motors Corp.* (6th Cir. 1955), 228 F. 2d 94, 99:

> In *General Motors Corp.* v. *Estate Stove Co.*, 6 Cir., 203 F. 2d 912, 917, 918, Judge McAllister * * * expressed the view of this court.

*Helms Products* v. *Lake Shore Mfg. Co.* (7th Cir. 1955), 227 F. 2d 677, 683:

> While the quoted words from *Foster* v. *T. L. Smith* [7 Cir., 244 F. 946, 952] are not the exact words used in the statute, we think the words used in the amendment to the act described the same test for invention. An idea which would obtrude itself from the prior art would be "obvious" to the ordinary mechanic, and the ordinary mechanic is certainly descriptive of a person "having ordinary skill in the art to which said subject matter pertains."

*Pacific Contact Laboratories, Inc.*, v. *Solex Laboratories, Inc.* (9th Cir. 1954), 209 F. 2d 529, 532–533:

> That is, as we understand it, the Congress by enacting section 103 showed its fear that the meaning of the phrase "flash of creative genius" * * * would result in excluding from patentability most if not all mechanical advances derived from study and experimentation. We do not think that the phrase * * * implies, or was intended to imply, that patents or patentability spring from inspiration at the cost of reason. The phrase was used more for emphasis than as patent dogma, and the Supreme Court was emphasizing the principle that patentability implies more than mere mechanical skill and that a phase of discovery is necessary. * * * the phrase * * * did not change the law. * * * Thus, the phrase * * * as Congress understood it, was emasculated as to the validity of existing unexpired patents and made wholly ineffective as to future patents.

*Blish, Mize and Silliman Hdwe. Co.* v. *Time Saver Tools* (10th Cir. 1956), 236 F. 2d 913, 914–915:

> It is agreed that the statutory standards for invention are but the codification of the common law—some courts say, as it has existed for the past 100 years without recognition of any change in the inventive concept. *Interstate Rubber Products Corp.* v. *Radiator Specialty Co., Inc.*, 4 Cir., 214 F. 2d 546. Others say, as it existed at the time of codification. *Bobertz* v. *General Motors Corp.*, 6 Cir., 228 F. 2d 94; *General Motors Corp.* v. *Estate Stove Co.*, 6 Cir., 203 F. 2d 912; *Wasserman* v. *Burgess and Blacher Co.*, 1 Cir., 217 F. 2d 402; *Seismograph Serv. Corp.* v. *Offshore Raydist, Inc.*, D. C., 135 F. Supp. 342; *Burt* v. *Bilofsky*, D. C., 120 F. Supp. 822. Still another court says that the underlying legislative intent was to ameliorate the harshness of the inventive concept inherent in the authoritative cases of the past two decades. *Lyon* v. *Bausch and Lomb Optical Co.*, 2 Cir., 224 F. 2d 530, certiorari denied 350 U. S. 911, 76 S. Ct. 193. * * *
>
> Whatever shade of meaning we give to the codified common law, we know that at least since 1850, to be patentable an

improvement in the prior art must involve more ingenuity and skill than the work of an ordinary mechanic in the art. *Hotchkiss* v. *Greenwood*, * * * Some have said that to involve more than mechanical skill, the improvement must display the "flash of creative genius", *Cuno Engineering Corp.* v. *Automatic Devices Corp.* * * *; or "push back the frontiers of chemistry, physics, and the like". See Douglass concurring in *Great Atlantic and Pacific Tea Co.* v. *Supermarket Equipment Co.* * * * and cases cited there. At the same time, those concurring in nonpatentability prefer to place it on the ground that the combination or improvement, when considered as a whole, must in some way exceed the sum of its parts; or "add to the sum of useful knowledge" of the subject matter. [Cases cited.]

The last line of section 103 says that patentability "shall not be negatived by the manner in which the invention was made." That is to say, "it is immaterial whether it resulted from long toil and experimentation or from flash of genius." See Reviser's Notes following section 103. Commentators say that the language in the sentence was aimed directly at the "flash of genius" as exemplified in *Cuno Engineering Corp.* v. *Automatic Devices Corp.* * * *

It may well be that the Congress intended to roll back the philosophical standards of patentability typified by *Cuno Engineering Corp.* v. *Automatic Devices Corp.*, supra, and *Great Atlantic and Pacific Tea Co.* v. *Supermarket Equipment Co.*, supra. It did not and could not, however, intend to abandon the distinction between mere mechanical skill and "inventive genius" for that concept is inherent in the constitutional purpose "To promote the Progress of Science and useful Arts". Art. 1, sec. 8, Const. of United States. Indeed, the phrases "mechanical skill" and "inventive genius" have been used to mark the distinction between nonpatentability and patentability at least since before 1875. See *Reckendorfer* v. *Faber*, 92 U. S. 347, 23 L. Ed. 719. The concept was thus imported into the statute by the use of familiar and uncritical words, and it is our guide here.

And so, in the last analysis, we are brought back to the age-old test of whether the differences between what is old in the wood-boring art and what is wrought and claimed by the patented device when considered as a whole, would have been obvious to a person having ordinary skill in the art. The only new statutory word of significance is the word "obvious", and making application of it, the specific inquiry is whether the forward bending of the blade to form a curved cutting edge was obvious to the ordinary mechanic in the art.

*L–O–F Glass Fibers Co.* v. *Watson* (D. C. Cir. 1955), 228 F. 2d 40, 47:

> 14 * * * we may safely assume that the Patent Act of 1952, 35 U. S. C. A. 103, was intended to restore "the law to what it was when the Court announced the definition of invention."

*Application of O'Keefe* (CCPA 1953), 202 F. 2d 767, 771:

> The Patent Act of 1952 * * * has apparently neither raised nor lowered the standard of invention.

## B. SELECTED LISTING OF CASES CITING SECTION 103

### 1. CASES WHICH INFER THAT THE TEST OF INVENTION IS UNCHANGED

*Thys. Co.* v. *Oeste* (N. D. Calif. 1953), 111 F. Supp. 665.

*Gagnier Fibre Products Co.* v. *Fourslides, Inc.* (E. D. Mich. S. D. 1953), 112 F. Supp. 926.

*Joseph Bancroft and Sons* v. *Brewster Finishing Co., Inc.* (D. N. J. 1953), 113 F. Supp. 714.

*Channel Master Corp.* v. *Video Television, Inc.* (E. D. N. Y. 1953), 117 F. Supp. 812, aff'd. 209 F. 2d 511.

*Telechron, Inc.* v. *Parissi* (D. N. Y. 1953), 120 F. Supp. 235.

*Burt* v. *Bilofsky* (D. N. J. 1954), 120 F. Supp. 822.

*Modern Art Printing Co.* v. *Skeels* (D. N. J. 1954), 123 F. Supp. 426.

*DeBurgh* v. *Rindel Furniture Co.* (S. D. Mich. 1954), 125 F. Supp. 468.

*Hughes* v. *Salem Co-operative Co., Inc.* (W. D. Mich. 1955), 134 F. Supp. 572.

*Seismograph Service Corp.* v. *Offshore Raydist* (E. D. La. 1955), 135 F. Supp. 342.

*Fisch* v. *Gould* (D. N. J. 1956), 141 F. Supp. 2.

*Application of O'Keefe* (CCPA 1953), 202 F. 2d 767.

*Stanley Works* v. *Rockwell Mfg. Co.* (3d Cir. 1953), 203 F. 2d 846, cert. den. 346 U. S. 818.

*General Motors Corp.* v. *Estate Stove Co.* (6th Cir. 1953), 203 F. 2d 912, cert. den. 346 U. S. 822.

*In re Harding* (CCPA 1953), 205 F. 2d 171.

*Pacific Contact Laboratories, Inc.* v. *Solex Laboratories, Inc.* (9th Cir. 1954), 209 F. 2d 529, cert. den. 348 U. S. 816.

*Kwikset Locks, Inc.* v. *Hillgren* (9th Cir. 1954), 219 F. 2d 483.

*Tourneau* v. *Tishman and Lipp* (2d Cir. 1954), 211 F. 2d 240.

*Interstate Rubber Products Corp.* v. *Radiator Specialty Co., Inc.* (4th Cir. 1954), 214 F. 2d 546.

*Vincent* v. *Suni-Citrus Products Co.* (5th Cir. 1954), 215 F. 2d 305.

*Cole* v. *Hughes Tool Co.* (10th Cir. 1954), 215 F. 2d 924.

*Wasserman* v. *Burgess and Blacher Co.* (1st Cir. 1954), 217 F. 2d 402.

*In re Krogman* (CCPA 1955), 223 F. 2d 497.

*Cold Metal Products Co.* v. *Newport Steel Corp.* (6th Cir. 1955), 226 F. 2d 19.

*Pierce* v. *Muehleisen* (9th Cir. 1955), 226 F. 2d 200.

*Helms Products* v. *Lake Shore Mfg. Co.* (7th Cir. 1955), 227 F. 2d 677.

*Bobertz* v. *General Motors Corp.* (6th Cir. 1955), 228 F. 2d 94.

*Blaw-Knox Co.* v. *I. D. Lain Co.* (7th Cir. 1956), 230 F. 2d 373.

### 2. CASES WHICH INFER THAT THE TEST OF INVENTION HAS BEEN CHANGED

*Oxford Filing Supply Co.* v. *Globe-Wernicke Co.* (S. D. N. Y. 1957), 150 F. Supp. 35.

*Mazzella Blasting Mat Co.* v. *Vitiello* (S. D. N. Y. 1957), 150 F. Supp. 48.

*Lyon* v. *Bausch and Lomb Optical Co.* (2d Cir. 1955), 224 F. 2d 530, cert. den. 350 U. S. 911.

*L–O–F. Glass Fibers Co.* v. *Watson* (D. C. Cir. 1955), 228 F. 2d 40.
*Gentzel* v. *Manning, Maxwell and Moore* (2d Cir. 1956), 230 F. 2d 341.
*Welsh Mfg. Co.* v. *Sunware Products Co.* (2d Cir. 1956), 236 F. 2d 225.
*Brown* v. *Brock* (4th Cir. 1957), 240 F. 2d 723.

3. CASES EXPRESSING NO DEFINITIVE ASSERTION PRO OR CON

*Osborn Mfg. Co.* v. *Newark Brush Co.* (D. N. J. 1953), 111 F. Supp. 846.
*Helene Curtis Inc.* v. *Sales Affiliates* (S. D. N. Y. 1954), 121 F. Supp. 490.
*Alex Lee Wallau Inc.* v. *J. W. Landenberger and Co., Inc.* (S. D. N. Y. 1954), 121 F. Supp. 555.
*Torok* v. *Watson* (D. D. C. 1954), 122 F. Supp. 788.
*Hall* v. *Wright* (S. D. Calif. 1954), 125 F. Supp. 269.
*Anderson* v. *Phoenix Products Co.* (E. D. Wisc. 1954), 127 F. Supp. 732.
*Falcon Industries* v. *R. S. Herbert Co.* (E. D. N. Y. 1955), 128 F. Supp. 204.
*Monolith Portland Midwest Co.* v. *R. F. C.* (S. D. Calif. 1955), 128 F. Supp. 824.
*Metals Disintegrating Co.* v. *Reynolds Metals Co.* (D. Del. 1955), 130 F. Supp. 227.
*Carter Products* v. *Colgate-Palmolive Co.* (D. Md. 1955), 130 F. Supp. 577.
*McCashen* v. *Watson* (D. D. C. 1955), 131 F. Supp. 233.
*Wittlin* v. *Remco, Inc.* (E. D. Ill. 1955), 132 F. Supp. 57.
*Minn. Mining and Mfg. Co.* v. *Shugar* (D. Md. 1955), 132 F. Supp. 640.
*Hayes Industries, Inc.* v. *Watson* (D. D. C. 1955), 136 F. Supp. 339.
*Chun King Sales* v. *Oriental Foods* (S. D. Calif. 1955), 136 F. Supp. 659.
*Evans* v. *Watson* (D. D. C. 1956), 142 F. Supp. 225.
*Appleton Electric Co.* v. *Watson* (D. D. C. 1957), 148 F. Supp. 69.
*Carlson and Sullivan, Inc.* v. *Bigelow and Dowse Co.* (1st Cir. 1953), 202 F. 2d 654.
*New Wrinkle, Inc.* v. *Watson* (D. C. Cir. 1953), 204 F. 2d 35.
*United Mattress Machinery Co., Inc.* v. *Handy Button Mach. Co.* (3d Cir. 1953), 207 F. 2d 1.
*Sel-O-Rak Corp.* v. *Henry Hanger and Display Fix. Corp.* (5th Cir. 1956), 232 F. 2d 176.
*Wilson Athletic Goods Mfg. Co.* v. *Kennedy Sporting Goods Mfg.* (2d Cir. 1956), 233 F. 2d 280.
*Newburgh Moire Co.* v. *Superior Moire Co.* (3d Cir. 1956), 237 F. 2d 283.
*R. M. Palmer Co.* v. *Luden's, Inc.* (3d Cir. 1956), 236 F. 2d 496.
*Blish, Mize and Silliman Hdwe Co.* v. *Time Saver Tools* (10th Cir. 1956), 236 F. 2d 913.
*Hartford National Bank and Trust Co.* v. *E. F. Drew and Co., Inc.* (3d Cir. 1956), 237 F. 2d 594.
*Steffan* v. *Weber Heating and Sheet Metal Co.* (8th Cir. 1956), 237 F. 2d 601.

## V. SELECTED BIBLIOGRAPHY—PROFESSIONAL JOURNALS AND LAW REVIEWS [18]

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