

Graham v. John Deere Co. of Kansas City
(United States Supreme Court 383 U.S. 1, February 21, 1966)

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Case summary

In this case, the U.S. Supreme Court established that the element of non-obviousness must be assessed with the help of the following factors: (1) the scope and content of prior art, (2) the differences between the prior art and the claims at issue and (3) the level of ordinary skill in the concerned art. Furthermore, secondary considerations may be commercial success, long felt but unresolved needs or the failure of others to find a solution.

The facts

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The petitioner William T. Graham applied for a patent on a mechanical device designed to absorb shock from the plow shanks in rocky soil. The installed clamp prevented damage to the plow. In 1950, he obtained U.S. Patent No. 2,493,811 (hereinafter: '811 patent). In the following years, he improved his invention by changing the place of the hinge plate in order to minimize the outward motion of the shank away from the plate. He was granted another U.S. patent with the number 2,627,789 (hereinafter: '789 patent) for this improvement in 1953.¹ It was the latter patent that was at dispute in this case. The petitioner's patent had been upheld in a previous case before the U.S. Court of Appeals for the Fifth Circuit, but was found invalid by the U.S. Court of Appeals for the Eighth Circuit. The Supreme Court (hereinafter: the Court) granted *certiorari*² and ruled the case, No. 11, together with the cases No. 37, Calmar Inc. v. Cook Chemical Co. and No. 43, Colgate-Palmolive Co. v. Cook Chemical Co., both also on *certiorari* to the same court.

Calmar, Inc. v. Cook Chemical Co. and Colgate-Palmolive Co. v. Cook Chemical Co.

In those cases, Nos. 37 and 43, consolidated actions were brought before the U.S. District Court for the Western District of Missouri. The latter declared invalid a patent on a plastic finger sprayer with a hold-down lid used as a built-in dispenser for containers or bottles packaging liquid products, mainly for insecticides. The District Court then sustained the patent and the U.S. Court of Appeals for the Eighth Circuit affirmed. The manufacturers engaged in the insecticide business had for some time had problems developing sprayers that could be integrated with the containers or bottles in which the insecticides were marketed. The manufacturers used an unpatented finger-operated device furnished by Calmar. Eventually, Cook Chemical invented a shipper-sprayer in suit and was granted a patent in 1959. By 1958, Calmar had developed a shipper-sprayer much similar to the one patented by Cook Chemical and began marketing it. When the patent was issued, Cook Chemical sued Calmar for patent infringement. The District Court and the Court of Appeals both upheld the patent. The Supreme Court, however, reversed.

¹ See VI.A of the decision for a detailed description of the invention.

² Granting *certiorari* refers to the agreement by a higher court to review the decision of a lower court. "Certiorari" is Latin and stands for "to be made certain".

The legal issues

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The Court had to further clarify and define the requirement of non-obviousness, which was first added to the codified law with the title 35 U.S.C. §103 of the Patent Act of 1952. Prior to that, it had existed in case law, dating back to the case of *Hotchkiss v. Greenwood* in 1851. However, the concept had never been conclusively defined. The Court set out to describe the history of patent law. It outlined that in the past, the patentability test always included a "comparison between the subject matter of the patent, or patent application, and the background skill of calling".³ It went on to describe the conditions of patentability under the 1952 Patent Act (novelty, utility and non-obviousness) and highlighted that the condition of §103, non-obviousness, is the least established and least clear. However, it also set out that the condition of non-obviousness would be ascertained, case by case, by determination of the following aspects:

- (1) the scope and the content of the prior art;
- (2) the differences between the claimed invention and the prior art; and
- (3) the level of ordinary skill in the pertinent art.

Additionally, the secondary considerations that might be utilized are, for example, commercial success, long felt but unsolved needs and failure of others find a solution. The Court then applied the above to the case. It recalled that the '798 patent had originally been rejected by the patent examiner as being insufficiently distinguishable from the previous '811 patent. The Court confirmed that the only two elements in which the two patents differ are: (1) that the stirrup and the bolted connection of the shank to the hinge plate do not appear in '811 and (2) that the position of the shank is reversed, being placed in patent '811 above the hinge plate. Before the Court, the petitioner mainly relied on an argument which he did not raise before the USPTO: that in the new '798 design, the flexing of the plow shank was limited to the points between the spring clamp and the tip of the plow shank, absorbing the shock of hard objects on the ground more efficiently. The Court rejected this argument, precisely because the petitioner had not raised it before the USPTO. In addition, it found that the parts in the '798 patent served the exact same purposes as those in the previous patent and the prior art. The Court invalidated the '789 patent.

Calmar, Inc. v. Cook Chemical Co. and Colgate-Palmolive Co. v. Cook Chemical Co.

The dispute in these cases evolved around the scope and definition of the invention claimed in the patent in suit. The respondents contended that the invention encompassed a combination of old elements and that the patentability of the invention lied with the result produced. Cook Chemical stressed the long-felt need for and the inability of others to find the solution as well as the commercial success and held that the above highlight the non-obviousness of the invention at that time. Calmar, on the other hand, held the invention to be very similar to the one existing in the prior state

³ See III. of the decision.

of the art. The Court highlighted that Cook Chemical only obtained the patent after initial rejection by limiting its claims to just one element, namely the sealing arrangement, as the only patentable difference compared to prior art. The patentee thus only obtained the patent by accepting the limitations imposed by the Examiner. Patents like the one at hand, that were narrowed down in scope in order to be granted cannot later be construed to cover that which was previously eliminated from the patent. The Court went on to establish the patent obtained rests upon very small and nontechnical mechanical differences in a device that was old in the art. They found that the differences between the prior state of the art and the invention were minimal and obvious to a person reasonably skilled in the art. The patent was rejected.

Points of significance:

- The obviousness or non-obviousness of the subject-matter is determined in
 - light of the scope and content of prior art,
 - the differences between the prior art and the claims at issue, and
 - the level of ordinary skill in the concerned art.
 - Secondary considerations may be commercial success, long felt but unresolved needs or the failure of others to find a solution.
- The non-obviousness test as codified in §103 of the Patent Act of 1952 must be amenable to a case-by-case development.
- An invention is to be construed not only in the light of the claims, but also with reference to the prosecution history in the Patent Office.
- Long-felt need for and the inability of others to find the solution and the commercial success of an invention are subtests for the patentability and are more susceptible of judicial treatment than the technical facts often treated in patent litigation. They can potentially "tip the scales of patentability".
- With respect to patent infringement, the Court established that the scope of a patent, if narrowed down in order to meet the patent examiner's requirements, cannot later be construed to cover that which was previously eliminated from the patent. This concept was confirmed and refined, *inter alia* in the Supreme Court decision in *Festo Corp. v Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002) (see the summary available in this database).

Key words:

Patentability, non-obviousness, inventive step, construction of specification and claims, 35 U.S.C. §103, U.S. Supreme Court, mechanical skill.

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