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## Patents - Standard of Invention - Effects of Sections 103 and 282 of Patent Act of 1952

John F. Powell S.Ed.  
*University of Michigan Law School*

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PATENTS—STANDARD OF INVENTION—EFFECTS OF SECTIONS 103 AND 282 OF PATENT ACT OF 1952—Defendant counterclaimed for patent infringement in a declaratory judgment action. The trial court, holding the patent invalid for lack of “invention,” dismissed the counterclaim.<sup>1</sup> On appeal, *held*, reversed. The patent in question was valid, this conclusion being based on an independent study of the pertinent prior art and on the additional factors of industry acquiescence, commercial success, and the statutory presumption of validity of a duly issued patent. *Georgia-Pacific Corp. v. United States Plywood Corp.*, (2d Cir. 1958) 258 F. (2d) 124, cert. den. 27 U.S. LAW WEEK 3147 (1958).

Statutes prior to 1952<sup>2</sup> required that a patentable invention be “new and useful” but specified no necessary standard of invention. Such a standard was introduced in the early case of *Hotchkiss v. Greenwood*,<sup>3</sup> wherein the Supreme Court held that to qualify for a patent an invention must “have required more ingenuity and skill . . . than were possessed

<sup>1</sup> *Georgia-Pacific Plywood Co. v. United States Plywood Corp.*, (S.D. N.Y. 1956) 148 F. Supp. 846.

<sup>2</sup> 1 Stat. 109 (1790); 1 Stat. 318 (1793); 5 Stat. 117 (1836).

<sup>3</sup> 11 How. (52 U.S.) 248 (1850).

by an ordinary mechanic acquainted with the business. . . ."<sup>4</sup> This so-called "skilled artisan" test became the standard test by which the courts measured the element of "invention."<sup>5</sup> Although this test has never been formally repudiated, however, there is a widespread conviction among both writers<sup>6</sup> and lower courts<sup>7</sup> that Supreme Court decisions of the past three decades have noticeably tightened the applicable standard of invention.<sup>8</sup> Further, statistical studies showing the percentage of patents held valid in infringement litigation from 1940 through 1954<sup>9</sup> show a wide divergence among the circuits and indicate that these circuits either were applying different tests of patentability<sup>10</sup> or were applying the same test with widely varying degrees of strictness. It was to this rather unhappy judicial situation that Congress addressed itself in passing section 103 of the 1952 Patent Act.<sup>11</sup> Committee reports state that the section was intended to have a "stabilizing effect" and to "minimize great departures which have appeared in some cases."<sup>12</sup> By adopting the *Hotchkiss* rule, the language of this provision precludes the possibility that any test other than that of the "skilled artisan" will be applied; however, it leaves unanswered the question

<sup>4</sup> Id. at 267.

<sup>5</sup> For illustrations of its application see, e.g., *Dunbar v. Myers*, 94 U.S. 187 (1876); *Packing Company Cases*, 105 U.S. 566 (1881).

<sup>6</sup> *Dodds & Crotty*, "The New Doctrinal Trend," 30 J.P.O.S. 83 (1948); *Brumbaugh*, "Sustaining Patentability in United States Courts and Related Questions," 40 J.P.O.S. 35 (1958); *Cooper*, "Patent Law: Challenging the Court's View of 'Invention,'" 35 A.B.A.J. 306 (1949).

<sup>7</sup> *Picard v. United Aircraft Corp.*, (2d Cir. 1942) 128 F. (2d) 632, cert. den. 317 U.S. 651 (1942); *United States Gypsum Co. v. Consolidated Expanded Metals Companies*, (6th Cir. 1942) 130 F. (2d) 888, cert. den. 317 U.S. 698 (1943); *Alemite Co. v. Jiffy Lubricator Co.*, (8th Cir. 1949) 176 F. (2d) 444, cert. den. 339 U.S. 912 (1950), reh. den. 339 U.S. 939 (1950). *Contra*, *In re Shortell*, (C.C.P.A. 1944) 142 F. (2d) 292.

<sup>8</sup> Decisions pointed to include: *Great Atlantic and Pacific Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147 (1950), reh. den. 340 U.S. 918 (1951); *Jungerson v. Ostby & Barton Co.*, 335 U.S. 560 (1949), reh. den. 336 U.S. 915 (1949), reh. den. 336 U.S. 931 (1949); *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84 (1941). Justice Jackson, dissenting in the *Jungerson* case, at 572, remarked that "the only patent that is valid is one which this Court has not been able to get its hands on."

<sup>9</sup> *Lang and Thomas*, "Disposition of Patent Cases by Courts During the Period 1939 to 1949," 32 J.P.O.S. 803 (1950); S. Hearings before Subcommittee on Patents, Trademarks and Copyrights of the Committee on the Judiciary on the American Patent System, 84th Cong., 1st sess., p. 178 (1955).

<sup>10</sup> It has been stated that the reference to a "flash of genius" in *Cuno Engineering Corp. v. Automatic Devices Corp.*, note 8 *supra*, was the enunciation by the Supreme Court of a new test. *Wolf Bros. v. Equitable Paper Bag Co.*, (E.D. N.Y. 1943) 55 F. Supp. 832, *affd. per curiam* (2d Cir. 1944) 143 F. (2d) 660.

<sup>11</sup> "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 such subject matter pertains. Patentability shall not be negated by the manner in which the invention was made." 35 U.S.C. (1952) §103.

<sup>12</sup> H. Rep. 1923, 82d Cong., 2d sess., p. 7 (1952); S. Rep. 1979, 82d Cong., 2d sess., p. 6 (1952).

whether it is the original *Hotchkiss* test or the recent more stringent view which is incorporated by the statute. In *Lyon v. Bausch & Lomb Optical Co.*,<sup>13</sup> the Second Circuit held it to be the former. Such an interpretation has been generally approved by the commentators<sup>14</sup> and has been adopted in two other circuits.<sup>15</sup> The majority of appellate courts, on the other hand, have been content to say simply that section 103 represents a codification of prior law.<sup>16</sup> In view of the pre-existing inconsistency of approach among the several circuits and of the congressional intent that section 103 have a stabilizing effect, any court taking the position that the problem of interpretation can be solved merely by labeling the provision a "codification" appears to be adopting a rather ostrich-like attitude. Yet support for the *Lyon* view may be found in the impetus toward consistency which it would furnish and in the fact that persons close to the 1952 act have stated that the stabilization and elimination of great departures were hoped to be reached by a change in judicial attitude more favorable to patents.<sup>17</sup> Further, the "codification" analysis seems to relegate to a position of comparative unimportance the statutory presumption of validity now embodied in section 282.<sup>18</sup> Although such a presumption was at one time firmly established in the case law,<sup>19</sup> many recent opinions have given it little more than lip service<sup>20</sup> and a few have gone so far as to deny its existence.<sup>21</sup> This attitude undoubtedly stemmed from a judicial feeling that the Patent Office was applying a standard of invention lower than that which the

<sup>13</sup> (2d Cir. 1955) 224 F. (2d) 530, cert. den. 350 U.S. 911 (1955), reh. den. 350 U.S. 955 (1956).

<sup>14</sup> Brumbaugh, "Sustaining Patentability in United States Courts and Related Questions," 40 J.P.O.S. 35 (1958); Oppenheim, "Patents and Antitrust: Peaceful Coexistence?" 54 MICH. L. REV. 199 at 206 (1955); comment, 55 MICH. L. REV. 985 (1957); notes, 44 GEO. L. J. 100 (1955); 55 COL. L. REV. 1231 (1955).

<sup>15</sup> *Brown v. Brock*, (4th Cir. 1957) 240 F. (2d) 723; *L-O-F Glass Fibers Co. v. Watson*, (D.C. Cir. 1955) 228 F. (2d) 40.

<sup>16</sup> *Wasserman v. Burgess & Blacher Co.*, (1st Cir. 1954) 217 F. (2d) 402; *Vincent v. Suni-Citrus Products Co.*, (5th Cir. 1954) 215 F. (2d) 305, cert. den. 348 U.S. 952 (1955); *General Motors Corp. v. Estate Stove Co.*, (6th Cir. 1953) 203 F. (2d) 912, cert. den. 346 U.S. 822 (1953); *Borkland v. Pederson*, (7th Cir. 1957) 244 F. (2d) 501; *Muench-Kreuzer Candle Co. v. Wilson*, (9th Cir. 1957) 246 F. (2d) 624, cert. den. 355 U.S. 882 (1957), interpretation of §103 inferred from opinion. Several circuits have declined to interpret §103 as yet: *Steffan v. Weber Heating and Sheet Metal Co.*, (8th Cir. 1956) 237 F. (2d) 601; *Blish, Mize and Silliman Hardware Co. v. Time Saver Tools, Inc.*, (10th Cir. 1956) 236 F. (2d) 913, cert. den. 352 U.S. 1004 (1957).

<sup>17</sup> Federico, "Commentary on the Patent Act," 35 U.S.C.A. 1 at 23 (1952); Harris, "Some Aspects of the Underlying Legislative Intent of the Patent Act of 1952," 23 GEO. WASH. L. REV. 658 (1955).

<sup>18</sup> "A patent shall be presumed valid. The burden of establishing invalidity of a patent shall rest on a party asserting it. . . ." 35 U.S.C. (1952) §282.

<sup>19</sup> E.g., *R.C.A. v. Radio Engineering Laboratories, Inc.*, 293 U.S. 1 (1934), reh. den. 293 U.S. 522 (1934); *Mumm v. Decker & Sons*, 301 U.S. 168 (1937).

<sup>20</sup> *Jacuzzi Bros., Inc. v. Berkeley Pump Co.*, (9th Cir. 1951) 191 F. (2d) 632; *Philip A. Hunt Co. v. Mallinckrodt Chemical Works*, (E.D. N.Y. 1947) 72 F. Supp. 865, affd. (2d Cir. 1949) 177 F. (2d) 583.

<sup>21</sup> *Ginsberg v. Railway Express Agency, Inc.*, (S.D. N.Y. 1947) 72 F. Supp. 43.

courts were bound to observe and that, therefore, little if any weight could legitimately be given the presumption.<sup>22</sup> It is difficult to escape the conclusion that the drafters of the 1952 act, aware of the existing judicial attitudes, included section 282 to make the anticipated stabilization of the standard of invention more effective.<sup>23</sup> Thus the court in the principal case appears correct in considering that provision in conjunction with section 103.<sup>24</sup> Recognizing the weakness inherent in the "skilled artisan" test due to its necessary subjectivity, the court stated that it would hesitate to reverse the decision below were it not for several "additional" factors, one of which was the existence of the presumption.<sup>25</sup> It further stated that the expertness and experience of the Patent Office should be given especial weight where, as here, the particular prior art relied upon to show a lack of "invention" had been passed upon and rejected by that agency.<sup>26</sup> It left open, however, the question to what extent and in what manner the court intends to use the presumption in future cases. In the last analysis, the subjectivity of the section 103 test may well prevent certainty in the commercial valuation of many issued patents regardless of the interpretation given this provision. Nevertheless, if the *Lyon* view were accepted and the presumption given substantial weight, the courts would go a long way toward achieving the congressional goal of uniformity and a more favorable judicial attitude toward patents. Meanwhile, the existence of the present conflict among the circuits and the inherent difficulty in applying the section 103 test seem to call for further legislative guidance.<sup>27</sup> Perhaps this guidance should take the form of specific factors to be considered and the relative weight to be given them by the judge in deciding the ultimate question of what would have been "obvious" to a "person having ordinary skill in the art."

*John F. Powell, S.Ed.*

<sup>22</sup> See *Magnaflux Corp. v. Coe*, (D.C. Cir. 1943) 139 F. (2d) 531.

<sup>23</sup> See Harris, "Some Aspects of the Underlying Legislative Intent of the Patent Act of 1952," 23 *Geo. Wash. L. Rev.* 658 at 680 (1955).

<sup>24</sup> See Oppenheim, "Patents and Antitrust: Peaceful Coexistence?" 54 *Mich. L. Rev.* 199 at 208 (1955); note, 21 *Geo. Wash. L. Rev.* 575 (1953).

<sup>25</sup> Principal case at 132.

<sup>26</sup> Principal case at 133.

<sup>27</sup> Attempts have periodically been made in Congress to establish a statutory yardstick by which "invention" could more easily be measured. See Edwards, "Efforts to Establish a Statutory Standard of Invention," Study of the Subcommittee on Patents, Trademarks, and Copyrights of the Committee on the Judiciary of the Senate, No. 7, 85th Cong., 1st sess. (1958). The Reviser's note to §103 states that the provision was also "to serve as a basis for the addition at a later time of some criteria which may be worked out." 35 U.S.C.A. §103 (1952).