Obviousness I

Class Notes: February 6, 2003

Law 677 | Patent Law | Spring 2003
Professor Wagner
Today’s Agenda

1. Historical Obviousness

2. The Graham Framework
Historical Obviousness

*Hotchkiss v Greenwood* (1850)

- Prior art: metallic doorknobs with particular hole
- Invention: clay or porcelain doorknob, same hole
- Court: no patent; a patent requires “more ingenuity and skill” than that of a “simple mechanic”

Subsequent tests:

- “requirement for invention”
- “flash of creative genius” requirement

Is there a problem with this?
Obviousness History

1956 Patent Act Revisions:

35 U.S.C. § 103. - Conditions for patentability; non-obvious subject matter

(a) 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 *Graham Framework*

**Graham v John Deere (1966)**

Establishes the *Graham Framework* for obviousness analysis.

- The ultimate question of obviousness is one of law (for the court)
- The analysis requires three factual considerations:
  1. Scope and content of the prior art
  2. Differences between the prior art and the invention
  3. The level of ordinary skill in the pertinent art
The Graham Framework

Graham v John Deere (1966)
The Graham Framework

Graham v John Deere (1966)
The Graham Framework

Graham v John Deere (1966) (Colmar Patents)
The Graham Framework

Graham v John Deere (1966) (Colmar Patents)

Invention:

1. Use of a rib seal mechanism
2. An overcap whose lower edge does not touch the container cap.

Prior art:

Element 1: Livingstone
Element 2: Mellon, Lohse

Why does the Court reject the secondary considerations here?
The Graham Framework

U.S. v Adams (1966)

• What was the invention? Why was it significant?
• The Court notes that all elements of the Adams battery were present in the prior art. Why did the Court nonetheless conclude that the invention was nonobvious?
• What factors in particular led the Court to determine that the Adams invention was nonobvious? (Are these good evidence of nonobviousness?)
Next Class

*Obviousness II*

*The Scope & Content of the Prior Art*

*The PHOSITA*

*Secondary Considerations*