Obviousness and Double Patenting

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History

- *Hotchkiss v. Greenwood (*52 U.S. 248 (1851))
  - Conditioned the issuance of a patent upon the evidence of more ingenuity and skill than that possessed by an ordinary mechanic acquainted with the business
- 1952 Patent Act

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

History

In re Mehta, 52 C.C.P.A. 1615, Court of Customs and Patent Appeals (July 8, 1965)
"These decisions specifically hold that there is no invention in applying an old chemical reaction or process to another and analogous material where there is at least a reasonable expectation of success." At 1623. (citing *In re Larsen*, 49 CCPA [711]; 1961 C.D. 567; 772 O.G. 889; 292 F.(2d) 531; 130 USPQ 209; *In [sic] Novak et al*., 49 CCPA [1283]; 784 O.G. 1106; 306 F.(2d) 917; 134 USPQ 335; *Commonwealth Engineering v. Watson*, 127 USPQ 355; aff'd. 129 USPQ 338).

In re Novak, 49 C.C.P.A. 1267, Court of Customs and Patent Appeals (July 25, 1962)
"In the instant case it appears that at best applicants have merely applied an old process to another and analogous material with at least reasonable expectation of success. It is well settled that this does not constitute invention." At 1273.

History

Graham v. John Deere (383 U.S. 1, 148 USPQ 459 (1966)).

The Supreme Court noted that Congress intended to abolish the "flash of creative genius" test in the 1952 Patent Act which codified that

> 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 Court noted that a major distinction in the 1952 Act is that Congress emphasized "nonobviousness" as the operative test of the section, rather than the less definite "invention" language of the earlier *Hotchkiss v. Greenwood (52 U.S. 248 (1851))* that Congress thought had led to "a large variety" of expressions in decisions and writings. The Court also noted that in the title of the Act itself, Congress used the phrase "Conditions for patentability; non-obvious subject matter" thus focusing upon "non-obviousness" rather than "invention."

History

The Court further noted:

> 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).

Obviousness

- *In re Vaeck,* 947 F.2d 488, 493 (Fed. Cir. 1991):
  - Suggestion to combine and reasonable expectation from the art/knowledge of skilled person.
- *Allergan Inc v Apotex,* 754 F.3d 952, 966 (Fed. Cir. 2014)
  - Likelihood of success to meet the claimed limitations.

Title search: Obviousness and Double Patenting

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