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sounder view.³¹ *Prete v. Cray* is legally sound for there is no logical reason why an adjoining landowner should be made to suffer a loss merely because he has placed an improvement on his land which does not increase the lateral pressure. It should be noted that the rule in this case is applied only where it has been conclusively proven that such is the fact.³²

It is submitted therefore that the rule of *Prete v. Cray* is consistent with all principles of justice, is economically expedient and should be followed in New York.³³

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THE "FLASH OF GENIUS" STANDARD OF PATENTABLE INVENTION

In December, 1941, the President appointed the National Patent Planning Commission to conduct a comprehensive survey and study of the United States patent system, and to consider whether the system now provides the maximum service in stimulating the inventive genius of the people and in furthering prompt utilization of its fruits for the public good. The Commission published its first report in June, 1943.¹ The report contains a fitting tribute to the important role played by the American patent system in promoting industrial progress, improving the standard of living, and contributing to public safety and welfare.² The report also specifically denies adverse charges with respect to hindrance of the war effort by patents.³

The major part of the report is devoted to recommendations for modifying the patent laws and their administration in order to obviate certain aspects of their operation which have been the principal sources of criticism. A portion of the report relates to the establishment of a uniform standard of invention.⁴ Recognizing the destructive effect of uncertainty as to the validity of patents, the Commission proposes, as a measure for the elimination of divergence of standards of invention, as between the Patent Office and the various courts charged with the enforcement of patent rights, the establishment of a single Court of Patent Appeals to review decisions of the District Courts in patent cases, thus assuming the jurisdiction now exercised by the

31. See note to *Stearns' Ex'r. v. Richmond*, 29 Am. St. Rep. 758, 765 (1892).

32. The rule of *Prete v. Cray* has been adopted by the American Law Institute. RESTATEMENT, TORTS, c. 39, § 817 (2) and comment on Subsection 2.

33. *Supra*, note 16.

† Former Comment Editor, FORDHAM LAW REVIEW.

1. H. R. Doc. 239, 78th Cong., 1st Sess. (1943) 1.

2. *Id.* at I.

3. *Id.* at II.

4. *Id.* at V.

Circuit Courts,⁵ and re-examination by the Patent Office of the validity of a patent, whenever it is attacked in a proceeding before a District Court, by certification of the record to the Patent Office for a report of an advisory nature on the validity of the patent.⁶

In addition to matters of procedure, the Commission has recommended a declaration of national policy by Congressional enactment, 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."⁷

One entitled to a patent is now defined in the statute⁸ as "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." Thus in addition to novelty and utility, "invention" is essential to the patentability of any new or improved art, machine, manufacture or composition, and consequently, to the validity of a patent issued therefor.⁹ What constitutes invention is left to the determination of the Patent Office and the Courts.

In general, it may be said that patentable invention is the increment by which an inventor's contribution to the advancement of a given field of technology exceeds not only what was previously known in that field, but also such variations of prior knowledge as would be obvious to the average worker skilled in that art. Thus, it has been held that invention is a new display of ingenuity beyond the compass of the routineer,¹⁰ and must be judged by what was in the public demesne, as well in the inventor's favor as against him.¹¹ Where the improvement is found to be merely the work of a skillful mechanic,¹² to involve merely ordinary mechanical or engineering skill,¹³ or to constitute a display of the experienced skill of the calling involving only the exercise of the ordinary faculties of reasoning upon material supplied by a special knowledge and facility of manipulation resulting from habitual and intelligent practice,¹⁴ it is generally held that there is an absence of that degree of ingenuity which constitutes the essential element of every invention.

The nature of the result achieved by the inventor is an important considera-

5. *Id.* at V C.

6. *Id.* at V B.

7. *Id.* at V A.

8. 56 STAT. 1212, 36 U. S. C. A. 31 (1939).

9. *Thompson v. Boisselier*, 114 U. S. 1, 11, 5 Sup. Ct. 1042 (1885).

10. *Kirsch Mfg. Co. v. Gould-Mersereau*, 6 F. (2d) 793, 794 (C. C. A. 2d, 1925).

11. *E. I. Du Pont de Nemours & Co. v. Glidden Co.*, 67 F. (2d) 392, 395 (C. C. A. 2d, 1933).

12. *Hotchkiss v. Greenwood*, 11 How. 248 (U. S. 1851).

13. *Concrete Appliances Co. v. Gomery*, 269 U. S. 177, 185, 46 Sup. Ct. 42 (1925).

14. *Saranac Automatic Machine Co. v. Wirebounds Patents Co.*, 282 U. S. 704, 713; 51 Sup. Ct. 232 (1931).

tion in determining whether or not his contribution is patentable. It has been aptly said that a combination to be patentable must produce a different force, effect or result in the combined forces or processes from that given by their separate parts.¹⁵ In other words, the effect of a patentable combination must be something more than the mere sum of the effects of its separate parts. The mere application of devices old in other arts to similar uses is not invention meriting a patent.¹⁶

Practice in the Patent Office represents substantially the application of the principles just set forth. Each patent application is examined by an examiner specializing in the field of the art to which the application relates, who is familiar with the state of the art as reflected in prior patents and publications. The applicant is required to point out how his claims distinguish from the disclosures cited by the examiner, to restrict them to the truly inventive portion of his concept, and to convince the examiner that they define something more than an obvious variation of prior knowledge.

Decisions applying the foregoing principles, and the practice of the Patent Office, conform with the recommendation of the National Patent Planning Commission that patentability ought to 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 may have been achieved. The question whether or not the inventor's contribution is an obvious one or not necessarily involves a personal, and hence subjective, opinion¹⁷—a "value judgment"—but it was not this kind of subjective determination, by the Patent Office or by the Courts, which the National Patent Planning Commission intended to exclude. The reason for the recommendation of the Commission that such a policy be declared by Congressional enactment apparently is intended to overcome a "new doctrinal trend,"¹⁸ evidenced in a relatively recent line of decisions, particularly in the Circuit Court of Appeals for the Second Circuit, and in the decision of the United States Supreme Court in *Cuno Engineering Co. v. Automatic Devices Corp.*¹⁹

Within the last decade, a number of decisions in the Second Circuit have formulated a new test for invention, more restrictive than the principles applied by the Patent Office and by the courts in the decisions discussed above. The Second Circuit appears to hold, in effect, that advances in the art which result from purposeful research or experimentation do not constitute patentable invention. In the *Cuno* decision, the Supreme Court appears to have given a more positive expression to the restrictive test of the Second Circuit, holding that a new device, to be patentable, must reveal the "flash of creative

15. *Reckendorfer v. Faber*, 92 U. S. 347, Syllabus (1875).

16. See note 13 *supra*.

17. See note 10 *supra*.

18. *Picard v. United Aircraft Corp.*, 128 F. (2d) 632, 636 (C. C. A. 2d, 1942).

19. 314 U. S. 84, 62 Sup. Ct. 37 (1941).

genius." Thus, the standard of patentable invention represented by these decisions is apparently based upon the nature of the mental processes of the patentee-inventor by which he achieved the advancement in the art claimed in his patent, rather than solely upon the objective nature of the advancement itself, tested against the background of the prior art. In this respect, the new test or standard of invention of the Second Circuit and the Supreme Court is subjective.

Reference to a few decisions of the Second Circuit will indicate the application of the aforesaid restrictive test for invention. For example, in a decision involving a chemical patent,²⁰ the court recognized that much that is valuable has been discovered by a system of trial and error, but held that invention demands more than that; something more than routine testing of obvious combinations, some departure which required originality or independence of conception, some resumption of a line of experiments from which the art looked away was said to be required. The patent was held invalid as directed merely to one of those steps which demand only patient experiment. In another decision,²¹ the court recognized that happy solutions may be reached by testing out variants especially in the chemical and electrical field—merely by permutations of old elements—but held that the patent law does not protect such industrial achievements. Something more personal to the inventor which better measures his imaginative powers was said to be required. It was held unpatentable in another case²² to try out many forms, until what appeared to be the best was found. The court held that, as distinguished from sudden flashes of genius, the solution of a problem demanding no more than intelligent, well-turned and persistent experiments, in the light of the defects of past experience did not amount to patentable invention. Another patent was held invalid²³ as based merely upon the slow but inevitable progress of an industry through trial and error—upon the exercise of persistent and intelligent search for improvement. The court referred to the fact that the Supreme Court had for a decade or more shown an increasing disposition to raise the standard of originality necessary for a patent, and recognized therein a pronounced "new doctrinal trend" which the court proposed cautiously to follow and not to resist.

As it happens, it was in a reversal of a Second Circuit decision that the Supreme Court enunciated the "flash of genius" test. In *Automatic Devices Corp. v. Cuno Engineering Co.*, the Second Circuit Court of Appeals held the patent in suit valid and infringed, stating:

20. *Ruben Condenser Co. v. Aerovox Corp.*, 77 F. (2d) 266, 267 (C. C. A. 2d, 1935)

21. *Ruben Condenser Co. v. Copeland Refrigeration Corp.*, 85 F. (2d) 537 (C. C. A. 2d, 1936).

22. *General Motors Corp. v. Preferred Electric & Wire Corp.*, 109 F. (2d) 615 (C. C. A. 2d, 1940).

23. See note 18 *supra*.

"If patents are to go to those who contribute new appliances that are beyond the limited imagination of the ordinary skilled person, this invention seems to us to merit a patent."²⁴

The Supreme Court reversed this decision, stating:

"Since *Hotchkiss v. Greenwood* (11 How. 248, decided in 1851), it has been recognized that if an improvement is to obtain the privileged position of a patent more ingenuity must be involved than the work of a mechanic skilled in the art. . . . That is, to say, a new device, however useful it may be, must reveal the *flash of creative genius*, not merely the skill of the calling. If it fails, it has not established its right to a private grant on the public domain. . . . We cannot conclude that his skill in making this contribution reached the level of inventive genius which the Constitution (Art. I § 8) authorizes Congress to reward."²⁵

Thus, the "new doctrinal trend" to which the Second Circuit Court of Appeals referred, in a decision²⁶ subsequent to that of the Supreme Court in the *Cuno* case, apparently injects into the determination of what is patentable invention and what is not, the subjective mental processes by which the inventor arrived at his invention. If the inventor made his advance by purposeful experimentation, it is not invention; but if he arrived at it by a flash of genius; or flash of thought, he may be rewarded with a patent. It seems clear that the recommendation of the National Patent Planning Commission was directed principally against this trend, in suggesting legislation expressly rejecting a subjective test for patentable invention.²⁷

Earlier authorities support the application of an objective test. Thus, in an early decision,²⁸ Justice Story said:

"It is of no consequence whether the thing be simple or complicated; whether it be by accident or by long laborious thought, or by an instantaneous flash of mind, that it is first done. The law looks to the fact and not to the process by which it is accomplished. It gives the first inventor or discoverer of the thing the exclusive right, and asks nothing as to the mode or extent of the application of his genius to conceive or execute it."

An authoritative text on patent law²⁹ states that the law does not distinguish between creative faculties resulting from long consideration, study and experiment, and those attaining their end by sudden intuition, accident, or a flash of thought. Many decisions are to the same effect. An invention may be the

24. 117 F. (2d) 361, 364 (C. C. A. 2d, 1941).

25. *Cuno Engineering Co. v. Automatic Devices Corp.*, 314 U. S. 84, 90-91, 62 Sup. Ct. 37 (1941), italics added.

26. See note 18 *supra*.

27. Cf. Heard, *Uniform Standard of Invention* (1943) 25 JOURNAL OF THE PATENT OFFICE SOCIETY 676.

28. *Earle v. Sawyer*, 4 Mason 16 (C. C. D. Mass. 1825).

29. WALKER, PATENTS (Deller ed. 1937) § 114.

result of a flash of thought, or of long and abortive experiments and baffled attempts³⁰—a lucky casual thought, or the fruit of a lifetime devoted to the profoundest thought and the most ingenious experiments³¹—the revelation of a flash of thought or the result of long consideration.³² In *Wahl Clipper Corp. v. Andis Clipper Co.*,³³ the Seventh Circuit Court said:

“What is genius? What, an inventive genius? May only an inventive genius receive a valid patent? Instead of comparing the mental activities (and eccentricities) of genius, and the ‘mechanic skilled in the art,’ it would seem safer and more accurate to study the product itself. . . . if the improvement be unusual, or if there be doubt, and the public has given its tribute, the judge should accord to the creator of the article the title of inventor.”

The new doctrinal trend has not met with an entirely felicitous reception. In *Saltex Looms Inc. v. Collins & Aikman Corp.*,³⁴ a District Court remarked:

“To apply as a practical test the requirement of ‘flash of creative genius’ suggested in *Cuno Engineering Co. v. Automatic Devices Corp.* may not always be free of difficulty. Especially would this be so in appraising conceptions developed in research laboratories. However, each group of facts would determine its applicability.”

In *Wallace v. F. W. Woolworth Co.*,³⁵ it was said:

“Apparently, the restricted monopoly of patent rights is not to reward ‘the exercise of persistent and intelligent search for improvement!’ Such is not deemed to ‘reveal the flash of creative genius’ specified as required in *Cuno Engineering Co. v. Automatic Devices Corp.* . . . And yet it must be recalled that genius has once been defined as the infinite capacity for taking pains. The approved approach to most unsolved problems is the studious and often plodding one, and no reliable substitute has been suggested, even though a solution thereby accomplished is not judicially deemed to attain to the status of patentable invention.”

In the Sixth Circuit Court of Appeals, the *Cuno* decision was not interpreted as indicating anything more significant than that the quality of invention is something more than expected mechanical skill.³⁶ The Court remarked:

“Long experience with assailed inventions in trial and on review led us in humility to the conclusion that the inventive concept is an abstraction impossible to define, and so for that reason courts have sought for simple rules by which its presence may be detected, and while these have proved helpful, they are never absolute. . . .”

30. *Magic Ruffle Co. v. Douglas*, Fed. Cas. No. 8948 (C. C. S. D. N. Y. 1863).

31. *Middletown Tool Co. v. Judd*, Fed. Cas. No. 9536 (C. C. D. Conn. 1867).

32. *Snyder v. Fisher*, 1897 Commissioner's Decisions 254, 257 (C. C. A. D. C. 1897).

33. 66 F. (2d), 162, 164 (C. C. A. 7th, 1933).

34. 43 Fed. Supp. 914, 920 (S. D. N. Y. 1942).

35. 45 Fed. Supp. 465, 466 (E. D. N. Y. 1942).

36. *Trabon Engineering Corp. v. Dirkes*, 136 F. (2d) 24, 27 (C. C. A. 6th, 1943).

The Seventh Circuit Court of Appeals recognized³⁷ that standards of invention may grow more exacting, but rejected modification in meaning or definition of invention. The court said:

"If we examine the finished machine, apparatus, or process. . . is it understandable to say that there is patentable novelty if it results from a flash of genius, but not patentable invention if it is the result of long continued experimentation? We think not. . . . nearly all advance is made in laboratories where many experiments are made and discoveries result from the trial and error method."

In *Picard v. United Aircraft Corp.*,³⁸ (one of the Second Circuit Court of Appeals decisions holding a patent invalid, and referring to the new doctrinal trend of the Supreme Court, raising the standard of originality required for a patent), Judge Frank, in his concurring opinion,³⁹ suggests that the "flash of creative genius" of the *Cuno* decision is what, in some earlier decisions, was called a "flash of thought,"⁴⁰ and suggests that the so-called new attitude of the Supreme Court may be ascribed to the trend toward methods in research whereby discoveries are now usually made in group laboratories, such discoveries being precisely those which according to the test announced by Judge Learned Hand in the case do not amount to inventions. Judge Frank's opinion contains a review of what some of the critics of the patent system have contended.⁴¹ For example, it has been said that important advances arise nearly simultaneously at many points, and are the result of an advancing knowledge and technology, and the advent of a specific human need and common opportunity. The individual inventor in most cases could not hold his discovery a secret even if he wished, since it would not be long in these intense times before some other inventor would supply the necessary creative thought. The old justification for extension of exclusive monopoly no longer holds. However, Judge Frank quoted from *Scott and Williams Co. v. Wisnant*:⁴²

"After a new invention is completed, it is easy to see how it was accomplished. But such enlightenment resembling apparent simplicity, is the product of hindsight."⁴³

Referring to the majority decision holding the patent in suit invalid, Judge Frank remarks,⁴⁴ "If Judge Hand's yardstick is applied, a valid patent will, usually, be a function of judicial scientific ignorance."

37. *Chicago Steel Foundry Co. v. Burnside Steel Foundry Co.*, 132 F. (2d) 812 816 (C. C. A. 7th, 1943).

38. 128 F. (2d) 632 (C. C. A. 2d, 1942).

39. *Id.* at 641.

40. *Densmore v. Scofield*, 102 U. S. 375, 378 (1880).

41. *Picard v. United Aircraft Corp.*, 128 F. (2d) 632, 640-641 (C. C. A. 2d, 1942).

42. 126 F. (2d) 19, 22 (C. C. A. 4th, 1942).

43. *Picard v. United Aircraft Corp.*, 128 F. (2d) 632, 638-639 (C. C. A. 2d, 1942).

44. *Id.* at 641.

As a solution to this aspect of the situation, Judge Frank suggests that judges should consult thoroughly disinterested experts in applying tests for invention. He remarks⁴⁵ that such experts would probably find that only an infinitesimal percentage of so-called invention would measure up to Judge Hand's test, excluding what is discovered by trial and error, and the exercise of persistent and intelligent search for improvement.

On the other hand, Judge Frank states⁴⁶ that there seems to be room for some kind of patent monopoly which through hope of rewards to be gained will induce venturesome investors to risk the large sums needed to bring the invention to the commercially useful stage. If we do not need patents as a bait for inventors, we may still need them as a lure for investors. Judge Frank concludes⁴⁷ that it would seem unfair and unwise to apply so severe a test as that of Judge Hand as to render a patent invalid which would never have been developed commercially but for the protection afforded by the patent monopoly.

The report of the National Patent Planning Commission goes far to support the latter viewpoint of Judge Frank. The report states⁴⁸ that the American Patent system has

1. Encouraged and rewarded inventiveness and creativeness, producing new products and processes which have placed the United States far ahead of other countries in the field of scientific and technological endeavor;
2. Stimulated American inventors to originate a major portion of the important industrial and basic inventions of the past 150 years;
3. Facilitated the rapid development and general application of new discoveries in the United States to an extent exceeding that of any other country;
4. Contributed to the achievement of the highest standard of living that any nation has ever enjoyed;
5. Stimulated creation and development of products and processes necessary to arm the Nation and to wage successful war;
6. Contributed to the improvement of the public health and the public safety, and
7. Operated to protect the individual and small business concerns during the formative period of a new enterprise.

In its recommendation that appellate jurisdiction in patent suits be given exclusively to a single Patent Court of Appeals, and that provision be made for District Courts to submit records to the Patent Office for advisory action, the Commission seems to have answered the problem of overcoming the inadequacy of judicial experience to cope with highly technical matters arising in patent litigation. It can scarcely be doubted that a more competent and disinterested staff of experts could be found than in the Patent Office. Their advice, coupled

45. *Id.* at 640.

46. *Id.* at 642.

47. *Id.* at 643.

48. See note 2 *supra*.