

Isn't It Obvious?

The Constitutional Origin of Patent Law's Non-Obviousness Requirement

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Patents are prohibited from claiming inventions that would have been obvious to a person having ordinary skill in the art ("POSITA"). This non-obviousness requirement is an application of the Constitution's limitations on the scope and purpose of Congress' authority to grant patents.

Congress' power to award patent monopolies flows from Art. I, § 8, cl. 8 of the Constitution, which states: "Congress shall have Power ... to promote the Progress of Science and Useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries." "This clause is both a grant of power and a limitation" that "was written against the backdrop of the practices ... of the Crown in granting monopolies to court favorites in goods or businesses which had long been enjoyed by the public." *Graham v. John Deere*, 383 U.S. 1, 5 (1966). In other words, the Constitution forbids patents on obvious subject matter because they would not "promote the Progress of Science and the Useful Arts."

As *Graham* made clear, Clause 8's limiting language is no paper tiger:

Congress in the exercise of the patent power may not overreach the restraints imposed by the stated constitutional purpose. Nor may it enlarge the patent monopoly without regard to the innovation, advancement[,] or social benefit gained thereby. Moreover, Congress may not authorize the issuance of patents whose effects are to remove existent knowledge from the public domain, or to restrict free access to materials already available. Innovation, advancement, and things which add to the sum of useful knowledge are inherent requisites in a patent system which by constitutional command must 'promote the Progress of * * * useful Arts.' This is the standard expressed in the Constitution and it may not be ignored.

Id. (quoting U.S. Const., Art. I, § 8, cl. 8). Patent monopolies on obvious subject matter add no knowledge to the public domain, but rather remove existent knowledge, and undermine the Constitutional purpose of patents—promoting progress in the useful arts. *KSR Intern. Co. v. Teleflex*, 550 U.S. 398, 416 (2007).

While the first Patent Act, passed in 1790, did not contain any express requirement of non-obviousness, it did require that certain high-ranking government officials assess whether an invention was “sufficiently useful and important” to merit a patent. 1 Stat. 109-112, § 1 (Apr. 10, 1790). This examination criterion was intended to exclude frivolous and obvious patents. However, this requirement proved problematic because such officials lacked time to examine patents (resulting in a backlog). In 1791, Jefferson drafted a revised Patent Act dispensing with examination and the “sufficiently useful or important” criterion, substituting it with a provision for alleged infringers to challenge patents by proving them “so unimportant and obvious that it ought not to be the subject of an exclusive right.” *The Writings of Thomas Jefferson*, Vol. 5 at 279 (Feb. 7, 1791). However, Congress took no action on the draft bill that year, and upon resubmission the following year, the bill, after extensive revision, was passed as the Patent Act of 1793. This Act dispensed with examination¹ and the requirement that inventions be “sufficiently useful and important,” as Jefferson had proposed, but did not incorporate the provision for invalidating obvious patents.

Following enactment of the Patent Act of 1793, some courts rejected the idea that there was any requirement for patentability beyond novelty and usefulness. *See, e.g., Earle v. Sawyer*, 8 F.Cas. 254, 255 (D. Mass. 1825) (rejecting any prohibition on obvious patents). However, in 1850, in *Hotchkiss v. Greenwood*, the Supreme Court recognized that patentability required more than what the ordinarily skilled artisan could envision. *See* 52 U.S. 248, 267 (emphasis added):

unless more ingenuity and skill ... were required ... than were possessed by an ordinary mechanic acquainted with the business, there was an absence of that degree of skill and ingenuity which ***constitute essential elements of every invention***. In other words, the improvement is the work of the skillful mechanic, not that of the inventor.

The dissent asserted that the requirement lacked any basis in precedent². *Id.* at 268-69 (J. Woodbury, dissenting). However, *Hotchkiss*’ holding aligns with Clause 8’s requirements that patents promote the progress of the useful arts by requiring a patent to disclose something more than what was already within the knowledge or creativity of the field. Indeed, *Hotchkiss*’ reference to the ordinary mechanic’s “ingenuity,” makes clear that the Court was focusing on not only the ordinary mechanic’s knowledge and skills, but their creativity and what they could envision.

As the Supreme Court in *Graham* and *KSR* later found, the “premises [underlying Clause 8] led to the bar on patents claiming obvious subject matter established in *Hotchkiss* and codified in § 103.” *KSR*, 550 U.S. at 427. The non-obviousness requirement did not emerge from the judicial ether; it was contemplated from the start and needed to align the patent system with its Constitutional purpose.

¹ Patents were not substantively examined from 1793 until the Patent Act of 1836 and its creation of the Patent Office, at which point examiners only reviewed patent applications for novelty and usefulness; not obviousness.

² The test of whether an “ordinary mechanic could have made or devised [the claimed invention]” was previously used only as a test to determine if the claimed invention infringed an earlier patent. *Id.* at 268-69 (J. Woodbury, dissenting).