



10-1975

Sakraida v. Ag Pro, Inc.

Lewis F. Powell Jr.

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Reverse
summarily
if 4 other
Justices join.
O'Connor - Diss

The patent here sustained
by CA5 seems too "obvious"
to be patented.

But no new principle
involved.

DISCUSS

PRELIMINARY MEMORANDUM

Summer List 11, Sheet 4

Cert to CA5
(see facts)

No. 75-110

SAKRAIDA

Federal/Civil

v.

AG PRO, INC.

Timely

1. In this patent litigation, petr. contends that the combination patent upheld by CA5 is void for obviousness and "overclaim."

2. Facts: Resp sued petr for infringement of its combination patent. The patent provides for a dairy barn flushing system having the following elements: (1) a paved floor with downhill drains; (2) individual cow stalls

(Please see back.)
CRS

designed to allow cow excrement to accumulate on the paved floor; and (3) a "dam" which collects water uphill from the drains. The "dam" in fact consists of a simple tank with a hinged front. When the front is opened the collected water floods across and cleans the floor. Each element employed in the combination is concededly old. The claimed invention lies in the use of the tank and flooding to clean the floor, whereas hand-held hoses had previously been used. The combination of old elements allegedly achieves the "synergistic" effect of allowing a barn to be cleaned in minutes, while the prior art required hours of disagreeable hand labor.

This case has developed with the tortuousness characteristic of patent litigation. Petr originally secured a summary judgment of patent invalidity; CA5 (Rives, Simpson, Nichols -- Ct. of Claims) reversed. Petr then prevailed at trial; CA5 (Rives, Wisdom, Roney) reversed with leave for petr to move for a new trial on the ground of newly discovered evidence. Petr won a new-trial order; CA5 (Brown, Godbold, Clark) reversed. Thus the present posture of the case is that the patent has been declared valid; the case has been remanded to the trial court for trial of the infringement issue.

Other facts will be presented as the issues are delineated.

3. Issues: Petr claims that the combination patent is invalid because of lack of novelty and ~~non~~obviousness.

He contends that the decisions below conflict with such decisions of this Court as Graham v. John Deere Co., 383 U.S. 1.

Resp replies that CA5 applied the correct standards and that its combination has the synergistic effect required by cases such as John Deere. CA5 noted in support of its holding of validity that there was evidence that this combination surprised those knowledgeable in the field. (Cf. United States v. Adams, 383 U.S. 39.)

Petr also contends that the patent is void for "overclaim." His thesis is that the only claimed invention lies in the tank and flooding but that the patent covers such standard features of barn construction as sloping floors. The breadth of the patent, he argues, contravenes the prohibition against granting a patent on old elements which perform no new function in a combination. (Cf. Lincoln Eng. Co. v. Stewart-Warner Corp., 303 U.S. 545.)

Resp replies that the patent is not an overclaim because all the claimed elements are necessary to produce the synergistic result.

Petr also claims error on the basis of F. R. Civ. P. 52. He claims that the findings of the DC on patent invalidity were not clearly erroneous and that it was therefore error to reverse after trial. Resp replies that CA5 properly found clear error. Petr also makes a Rule 52 claim in connection with the reversal of the new-trial order. The "newly discovered" evidence allegedly justifying a new trial was

that other dairies had similar systems. CA5 held, however, that petr had not exercised due diligence in pursuing that evidence, since he had known of that possible prior art before the trial.

4. Discussion: CA5 was clearly correct in denying a new trial. The real question is whether it was correct in the earlier holding of patent validity. CA5 does not address the overclaim issue, which is subsidiary to the obviousness issue. On that issue the opinion on its face is a careful one, reciting the John Deere standards and discussing such relevant factors as surprise in the industry and commercial success of the patent. Nonetheless, CA5 seems to have displayed untoward solicitude for a patently obvious idea.

yes!
There is a response.

August 10, 1975

Schenker

Various opns in petn.

(Not v
Evidence)

File 75-110 AG Pro,



BOBTAIL MEMORANDUM

TO: Justice Powell

FROM: Greg Palm

DATE: February 4, 1976

No. 75-110 SAKRAIDA v. AG PRO, INC.

*

Reverse as to obviousness.

I have no doubt that the "invention" claimed here is "obvious" under Graham v. John Deere, 383 U.S. 1 (1966), and therefore not patentable. It is also clear that application of the concept of obviousness to any device is likely to lead to disagreement and nothing the Court will say in this case will resolve completely the uncertainty in this area of the law. The Court can, however, use this case as a forum for clarifying existing law. The Court should carefully delineate the role that so-called secondary factors

* None of the other issues need be reached if the Court reverses on the ground that the system was obvious. CA 5 was clearly correct as to the introduction of "new evidence" issue.

such as "commercial success" play in the assessment of obviousness and clearly indicate that the test of patentability is the same for all devices, whether viewed as combinations of "old" elements, or not.

There is really very little to be said about the merits of this particular case. The Court must simply apply the obviousness test contained in § 103. In John Deere this test was construed as a verbal reformulation of the "invention" requirement that was first developed in Hotchkiss v. Greenwood, 52 U.S. (11 How.) 248 (1851). 383 U.S. at . The John Deere standard is:

"While the ultimate question of patent validity is one of law, A & P Tea Co. v. Supermarket Corp., supra, at 155, the § 103 condition, which is but one of three conditions, each of which must be satisfied, lends itself to several basic factual inquiries. Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. As indicia of obviousness or nonobviousness, the inquiries may have relevancy."

Under that standard I think the "invention" here was obvious.

CA 5 recognized that each of the elements that make up the manure flush system are old in the art. Pet. Appx. 12a.

The question is thus whether it would be obvious to one "skilled in the art" to combine the old elements into the flush system.

It is apparent that the structural combination - i.e., use of drains and tilted floors or troughs to carry off manure - with one exception that CA 5 regarded as controlling, was known in the prior art. The difference between the manure flush system and prior methods was the use of the storage tanks so that water might be released in an even sheet across the angled floors. Prior systems generally in use apparently utilized high pressure hoses to deliver the water to the floor areas; the water would then flow off through a drainage system similar to that found here. I do not consider this change in method of water delivery to be nonobvious in the context of the "prior art." My initial reaction to the Ag Pro manure flush system was that it is nothing more than a stand up toilet. All that the "inventor" has really done is to apply on a larger scale the principle of water storage and release found in the typical human toilet. No patent should be granted for such a device. Analyzed in terms of the state of the art found in cow barns I similarly do not believe the substitution of the water release method found here for prior methods was nonobvious. I think that it may have been nonobvious that this system would work as well as it did, but that it was always obvious that water might be released (from storage vats) across a tilted barn floor and that would serve to carry away manure. It is possible that no one thought that this system would work any better than other methods (i.e., hoses) and for that reason no one bothered

to build a working model.

The only real problem in this case is the fact that petitioner did a poor job in the district court of building a record to demonstrate that the system was obvious. CA 5 emphasized in its opinion that "on the basis of the record before it" petitioner had not carried his burden of demonstrating that the Patent Office was in error in issuing the patent. I do think, however, that there is enough evidence to justify reversing CA 5. This is especially so given that the DC found the flush system to be obvious in the context of the prior art. The key evidence of obviousness is derived from the existence of certain prior patents issued for floor cleaning systems and the testimony of Robert Price, a dairy farmer. There apparently existed patented systems for removing cow manure which employed sloping floors or gutters and water, but which did not employ a "dam-release" mechanism. Pet. Appx. 15a n. 2. CA 5 found the fact that none of these systems employed a flooding technique based on stored water to be significant. Price similarly testified that certain elements of the Ag Pro flush system were known in the prior art: paved, sloped floors with downhill drains and raised stalls. Price also testified that he had seen pictures of the use of flowing sheets of water from diverted streams to clean barn floors. These pictures

were of foreign origin (Costa Rica), but he testified that he had heard that similar systems were used in this country. Appx. 90-91. CA 5 regarded his testimony as insufficient to rebut the strong case presented by respondent for patentability. CA 5 emphasized that Price admitted that he had never heard of a cleaning system that employed a tank of water to release a flood of water. I do not, however, view this latter admission as significant. If Price knew of prior systems in this country that employed stored water as does the Ag Pro system then its system likely would be unpatentable because it was not novel (§ 102). This is not to say, however, that it was not obvious for respondent to combine the stored water with the known use of sloping floors. My subjective judgment is that the combination was obvious.

Any opinion that is written (hopefully by another Chambers) will have to deal with respondent's evidence of nonobviousness. This consisted of expert testimony to the effect that the problem of efficiently removing cow waste products from barns had troubled dairy farmers for a long time; when first informed of the existenece and effectiveness of the Ag Pro system farmers and others in the industry expressed disbelief; and finally, the Ag Pro system constitutes a significant advance over prior methods known in the industry. The basic response to this evidence must be that while it is

certainly indicative of nonobviousness, it is insufficient. I would emphasize that while the potential effectiveness of the system may never have been appreciated, the system itself was an obvious advance over the prior art. The change from using water forced from hoses to water stored in tanks and released in sheets, alone does not justify the finding of nonobviousness. CA 5 concluded that the use of the tank and floor combination produced a "synergistic" result. I fail to see any such special result here. Water flowing across the floor removes the manure. There is nothing nonobvious about that. ** To be sure, consideration of commercial success and long felt but unresolved needs is also appropriate. But, as the Court correctly indicated in John Deere, see 383 U.S. at 17,

* In dealing with respondent's evidence based on the prior art I would also note that the narrow "art" of the field in which the device was developed is not the sole knowledge that is relevant to the issue of obviousness. If the proper inquiry were so limited, then patents might be granted in technologically backward industries for devices that would be considered "obvious" to those engaged in more technically sophisticated industries.

neither of these "secondary factors" is directly determinative of nonobviousness. *

Should we be tapped to write this case, there are two contributions to the law in this area that might be made. The first would be to clarify the role that so-called secondary factors such as commercial success and long felt but unresolved need play in the analysis. I agree with Amicus Curiae Bar Association of the District of Columbia that these factors should be considered in all cases. But I also believe that while relevant these factors must be accorded only a secondary role in the analysis. Amicus apparently would accord them a relatively significant weight in the analysis. I disagree since I think that such an approach would lead to the patenting of too many obvious devices; ** on the

* Commercial success, for example, may be an especially unreliable indicia of obviousness. In this case, the construction of the Ag Pro system likely would require a larger capital investment than a barn with sloped floors and outlets for hoses. Yet as labor costs increased over time, the Ag Pro system may have become the cheaper alternative. Without the rise in labor costs no one would have constructed the stored water flush system.

** Care must be taken not to imply that these factors should have a primary role in the analysis. Courts understandably would depend too heavily on this branch of the analysis since very often (unlike in this case) the technical inquiry is beyond their competence.

other hand, clearly nonobvious devices might be denied patents merely because market conditions were not such as to make the device a wide success. * Although the opinion in effect would merely be reiterating what was said in John Deere on the subject, such clarification would perhaps eliminate any uncertainty that exists in the lower courts as to the proper role of these factors. (In connection with my law review work I had the misfortune to do some work in the patent area and remember some articles on the subject.)

The other contribution would also be a clarification of existing doctrine. As Amicus District of Columbia Bar points out at great length there does appear to be some confusion in the literature and the lower courts as to whether there exists a special standard to be applied in the context of so-called combination patents. Amicus is, of course, correct that all devices - machines, chemical compounds, etc. - consist of a combination of elements. The most recent decision

* For example, many alternative energy source devices have been patented over the years, yet have not achieved any "commercial success" because of the relatively low price of fossil fuels. In the future, however, many of these same devices will be widely employed.

of this Court dealing with a combination patent - Anderson's Black Rock, Inc. v. Pavement Salvage Co., 396 U.S. 57 (1969) - unfortunately did employ some language derived from prior cases that apparently has created some uncertainty whether a special test is to be applied when assessing the patentability of devices that combine "old" elements. A careful reading of the Black Rock opinion indicates, however, that the same John Deere obviousness test is applicable in all cases. See id. at . In Ag Pro the Court should eliminate any uncertainty regarding this issue.*

Greg

* Amicus Bar Association of the District of Columbia is correct to the extent it argues that the inquiry in combination patent cases should not focus exclusively on the performance of the elements after combination but should also consider whether the particular combination of constituent parts was itself obvious.

75-110 SAKRAIDA v. AG PRO, INC. Cont. to CA5

Argued 3/3/76

Patent device: a dairy barn flushing
system.

CA5 sustained patent.

Q is whether patent fails the "obviousness"
tests set forth in 35 U.S.C. § 103, and
explicated in Graham v. John Deere, 383 U.S. 1

Tatum (for Petr)

Q as to whether a patent is valid
is Q of law - not fact.

Qs of "novelty" ~~ultimate Q~~ and
"obviousness" also are Qs of law.

Altho there was "after-discovered"
ev. (that Stewart ~~was~~ ^{was} never
considered by CAS), Tatum contends
that record (prior to discovery of
new ev.) is adequate to support
basic position of "obviousness"

Stewart ~~seems to~~ think we should
remand to CAS which has never
considered the new ev.

Kolish (Resk)

Best way, prior to this invention,
was by "power" (motor) - scraping
material into piles & then removing.
This was followed ~~to~~ by "hosing"
(water) to wash out the film of filth
~~so~~ left after scraping.

The invention here cleans a
bar in less than a minute -
as compared with hours ~~of~~ under
old system.

Kolish (cont.)

Two patents: ~~McCormack~~
McCormack & Bogart

Findings of "obviousness" are subject to Rule 52 - i.e. are findings of fact. (J. Stevens & J. White contradicted Kolish on this: law is settled that ultimate finding of "obviousness" is one of law.)

After discovered ev. (documents) ~~was~~ was improperly withheld from Kolish, & therefore motion to introduce this ev. should be denied. Pet. knew about this ev. prior to first trial & elected not to rely on. Ev. could have been discovered by due diligence. Pet. about Mission Dairy & could have found it.

Ask
Gale to
check
this
—

The Chief Justice. Reverse

3rd trial. CA 5 reversed DC, holding Petr. had not used d/diligence in presenting ev. as to prior art & obviousness. But Chief thinks we needn't reach these issues.

DC was right at first trial - device is obvious.

Patent is invalid.

Don't reach 62 (b) issue.

~~xxxxxxx~~ Stevens, J. Reverse

DC was right.

Brennan, J.

Reverse
Nothing patentable
- quite obvious.

Stewart, J.

Reverse
Don't need to reach motion under Rule 62.

Even assuming CA 5 was right as to exclusion of ev., the DC was right on merits.

Patent invalid on "obviousness"

But would not denigrate "combination" patents.

White, J.

Reverse

Marshall, J.

Reverse

Blackmun, J. Reverse

Clear unpatentable.

Could reverse on Graham
in a true sentence op.

Powell, J.

Reverse

Rehnquist, J. Reverse

Not as clear as
other justices think.

If the DC had
sustained patent, Bill
would agree

To: The Chief Justice
Mr. Justice Stewart
Mr. Justice White
Mr. Justice Marshall
Mr. Justice Blackmun
Mr. Justice Powell
Mr. Justice Rehnquist
Mr. Justice Stevens

From: Mr. Justice Brennan

Circulated: 4/1/76

Recirculated: _____

1st DRAFT

SUPREME COURT OF THE UNITED STATES

No. 75-110

Bernard A. Sakraida, }
Petitioner, } On Writ of Certiorari to the United
v. } States Court of Appeals for the
Ag Pro, Inc. } Fifth Circuit.

[April —, 1976]

MR. JUSTICE BRENNAN delivered the opinion of the Court.

Respondent Ag Pro, Inc., filed this action against petitioner Sakraida on October 8, 1968, in the District Court for the Western District of Texas for infringement of United States Letters Patent 3,223,070, entitled "Dairy Establishment," covering a water flush system to remove cow manure from the floor of a dairy barn. The patent was issued December 14, 1965, to Gribble and Bennett, who later assigned it to respondent.

The District Court's initial grant of summary judgment for petitioner was reversed by the Court of Appeals for the Fifth Circuit. 437 F. 2d 99 (1971). After a trial on remand, the District Court again entered a judgment for petitioner. The District Court held that the patent "does not constitute invention, is not patentable, and is not a valid patent, it being a combination patent, all of the elements of which are old in the dairy business, long prior to 1963, and the combination of them as described in the said patent being neither new nor meeting the test of non-obviousness." The Court of Appeals again reversed and held the patent valid. 474 F. 2d 167 (1973). On rehearing, the court remanded "with directions to enter a judgment holding the patent valid, sub-

Revised
LFP
John
4/1

ject, however, to . . . consideration of a motion under Fed. Rule Civ. Proc. 60 (b)(2), to be filed in the District Court by the [petitioner] Sakraida on the issue of patent validity based on newly discovered evidence." 481 F. 2d 668, 669 (1973). The District Court granted the motion and ordered a new trial. The Court of Appeals again reversed, holding that the grant of the motion was error, because "the record on the motion establishes that [petitioner] failed to exercise due diligence to discover the new evidence prior to entry of the former judgment." 512 F. 2d 141, 142 (1975). The Court of Appeals further held that "[o]ur prior determination of patent validity is reaffirmed." *Id.*, at 144. We granted certiorari 423 U. S. 891 (1975). We hold that the Court of Appeals erred in holding the patent valid and also in reaffirming its determination of patent validity. We therefore reverse and direct the reinstatement of the District Court's judgment for petitioner, and thus we have no occasion to decide whether the Court of Appeals properly found that petitioner had not established a case for a new trial under Rule 60 (b)(2).

Systems using water to clean animal wastes from barn floors have been familiar on dairy farms since ancient times.¹ The District Court found, and respondent con-

¹ Among the labors of Hercules is the following

"Hercules was next sent to Augeas King of Elis, who had immense droves of cattle. The stables usually occupied by these animals were in an incredibly filthy state, as they had not been cleaned in years; and now Hercules was given the task to remove the accumulated filth, and make a complete purification of the premises

"Close by these stables rushed a torrent, or rather a river, the Alpheus. Hercules, with one glance, saw the use he could make of this rushing stream, which he dammed and turned aside from

SAKRAIDA v AG PRO, INC.

cedes, that none of the 13 elements of the Dairy Establishment combination is new,² and many of those elements, including storage of the water in tanks or pools,

its course, so that the waters passed directly through the stables, carrying away all impurities, and finally washing them perfectly clean." Guerber, *Myths of Greece and Rome* 221 (1893).

²The District Court found as follows reflecting Claims 1 and 3, the only claims involved in the case:

"1 I find that the 'dairy establishment' as described in United States Letters Patent 3,233,070 is composed of 13 separate items, as follows

"(a) . . . a smooth, evenly contoured, paved surface forming a floor providing a walking surface. . . ."

"(b) . . . drain means for draining wash water from such floor opening to the top of the floor."

"(c) . . . said smooth, evenly contoured surface which forms such floor sloping toward said drain. . . ."

"(d) . . . multiple rest areas with individual stalls for each cow and with each of said stalls having a bottom which is also a smooth pavement. . . ."

"(e) . . . which is disposed at an elevation above the paved surface forming the floor. . . ."

"(f) . . . said stalls being dimensioned so that a cow can comfortably stand or lie in the stall, but offal from the cow falls outside the stall bottom and onto the floor providing the walking surface in the barn. . . ."

"(g) . . . said barn further including defined feeding areas having feeding troughs. . . ."

"(h) . . . a cow-holding area."

"(i) . . . a milking area."

"(j) . . . a transfer area all bottomed with the walking surface forming said floor in the barn. . . ."

"(k) . . . and floor washing means for washing the floor providing the walking surface in the barn where said floor bottom, said feeding, holding, milking and transfer areas operable to send wash water flowing over the floor with such water washing any cow offal thereon into the said drain means, said floor washing means including means located over a region of said floor which is uphill from said drain means constructed to collect water as a pool above said

appear in at least six prior patented systems.³ The prior art involved spot delivery of water from tanks or pools to the barn floor by means of high pressure hoses or pipes. That system required supplemental hand labor, using tractor blades, shovels, and brooms, and cleaning by these methods took several hours. The only claimed inventive feature of the Dairy Establishment combination of old elements is the provision for abrupt release of the water from the tanks or pools directly onto the barn floor, which causes the flow of a sheet of water that washes all animal waste into drains within minutes and requires no supplemental hand labor. As an expert witness for respondent testified concerning the effect of Dairy Establishment's combination, "water at the bottom has more friction than this water at the top and it keeps moving ahead and as this water keeps moving ahead we get a rolling action of this water which produced the

floor and operable after such collection of water as a pool to dispense the water as a sheet of water over said floor."

(l) A tank on a mounting, so that it can be tilted, and the water poured out to cascade on the floor to form a sheet.

"(m) A floor-washing means comprising a dam for damming or collecting water as a pool directly on the floor, which such dam abruptly openable to send water cascading as a sheet over the floor towards the drain.

"2 I further find that each of the items above-described were not new, but had been used in the dairy business prior to the time the application for the said Gribble patent, made the subject of this action, had been filed in the Patent Office of the United States on November 5, 1963."

'The District Court found

"that many of the items going to make up Plaintiff's claim for a patent were disclosed in prior patents, known respectively as the McCornack patent, the Holz patent, the Ingraham patent, the Kreutzer patent, the Bogert patent, and the Luks patent, and that the statements of the Examiner's opinions refusing to issue a patent are true as all items there stated to be covered in prior patents or publications."

cleaning action. . . . You do not get this in a hose. . . . [U]nless that water is continuously directed toward the cleaning area the cleaning action almost ceases instantaneously. . . .”⁴

The District Court found that “[n]either the tank which holds the water, nor the means of releasing the water quickly is new, but embrace tanks and doors which have long been known,” and further that “their use in this connection is one that is obvious, and the patent in that respect is lacking in novelty. The patent does not meet the non-obvious requirements of the law.” The District Court therefore held that Dairy Establishment “may be relevant to commercial success, but not to invention,” because the combination “was reasonably ob-

⁴ This witness testified that

“water has energy and it can be used in many different ways. In a hose the energy is used by impact, under pressure, external force that is applied to this pressure—to this water, whereas the water that comes down as a sheet or wall of water has built in energy because of its elevation and as this water is released it does the same thing water does in a flooded stream. As this water—I will try to make this clear, and I hope I can, on the surface of this pavement there are these piles of manure droppings. This pavement is smooth and this water moves down over this manure. The water at the bottom has more friction than this water on the top and it keeps moving ahead and as this water keeps moving ahead we get a rolling action of this water which produced the cleaning action. That is the key to this method of cleaning. You do not get this in a hose. You do not get it in a gutter as has been used in the past. I might just mention a little bit about the hose. This squirting water on a floor—probably have done it on our own sidewalks or walkways, and I just mention that, that unless that water is continuously directed towards the cleaning area the cleaning action almost ceases instantaneously. Now the movie that was shown earlier very dramatically illustrated that point. The cleaning action—as soon as the hoses moved to one side the cleaning action ceased here and that is why this hose was moved back and forth, to drive this stuff down to where we want it.”

vious to one with ordinary skill in the art.” Moreover, even if the combination filled a “long-felt want and . . . has enjoyed commercial success, those matters, without invention, will not make patentability.” Finally, the District Court concluded “that to those skilled in the art, the use of the old elements in combination was not an invention by the obvious-nonobvious standard. Even though the dairy barn in question attains the posture of a successful venture, more than that is needed for invention.”⁵ The Court of Appeals disagreed with the District Court’s conclusion on the crucial issue of obviousness.

It has long been clear that the Constitution requires that there be some “invention” to be entitled to patent protection. *Dann v. Johnston*, — U. S. — (1976). As we explained in *Hotchkiss v. Greenwood*, 11 How. 248, 267 (1851): “[U]nless 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.” This standard was enacted in 1952 by Congress in 35 U. S. C. § 103 “as a codification of judicial precedents . . . with Congressional directions that inquiries into the obviousness of the subject matter sought to be patented are a prerequisite to patentability.” *Graham v. John Deere Co.*, 383 U. S. 1, 17 (1966). Section 103 provides:

“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

⁵ The court also “conclude[d] that while the combination of old elements may have performed a useful function, it added nothing to the nature and quality of dairy barns theretofore used.”

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 negated by the manner in which the invention was made."

The ultimate test of patent validity is one of law, *A&P Tea Co. v. Supermarket Corp.*, 340 U. S. 147, 155 (1950), but resolution of the obviousness issue necessarily entails several basic factual inquiries, *Graham v. John Deere Co.*, *supra*, at 17.

"Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved." *Ibid.*

The Court of Appeals concluded that "the facts presented at trial clearly do not support [the District Court's] finding of obviousness under the three-pronged *Graham* test. . . ." 474 F. 2d, at 172. We disagree and hold that the Court of Appeals erroneously set aside the District Court's findings.

The scope of the prior art was shown by prior patents, prior art publications, affidavits of people having knowledge of prior flush systems analogous to respondent's, and the testimony of a dairy operator with 22 years experience who described flush systems he had seen on visits to dairy farms throughout the country. Our independent examination of that evidence persuades us of its sufficiency to support the District Court's finding "as a fact that each and all of the component parts of this patent were old and well-known throughout the dairy industry long prior to the date of the filing of the application for the Gribble patent. . . . [w]hat Mr.

§ SAKRAIDA *v.* AG PRO, INC.

Gribble referred to . . . as the essence of the patent, to-wit, the manure flush system, was old, various means for flushing manure from dairy barns having been used long before the filing of the application. . . .”⁶ Indeed, respondent admitted at trial “that the patent is made up of a combination of old elements” and “that all elements are individually old. . . .” Accordingly, the District Court properly followed our admonition in *A&P Tea Co. v. Supermarket Corp.*, *supra*, at 152: “Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements. . . . A patent for a combination which only unites old elements with no change in their respective functions . . . obviously withdraws what already is known into the field of its monopoly and diminishes the resources available to skillful men. . . .”

The Court of Appeals recognized that the patent combined old elements for applying water to a conventional sloped floor in a dairy barn equipped with drains at the bottom of the slope and that the purpose of the storage tank—to accumulate a large volume of water capable of

⁶ The court stated:

“I therefore find as a fact that each and all of the component parts of this patent as listed under the applicant’s claims set out in said patent, were old and well-known throughout the dairy industry long prior to the date of the filing of the application for the Gribble patent. I further find that what Mr. Gribble referred to in his deposition as the essence of the patent, to-wit, the manure flush system, was old, various means for flushing manure from the dairy barns having been used long before the filing of the application for the Gribble patent, the general idea in that connection being a hard surfaced sloping floor onto which the cows’ offal was dropped, and some system of introducing water in sufficient quantities and force onto said floor to wash the offal therefrom, with a ditch or drain to carry the offal so washed away from the barn, either into a manure container or otherwise.”

being released in a cascade or surge—was equally conventional. 474 F. 2d, at 169. It concluded, however, that the element lacking in the prior art was any evidence of an arrangement of the old elements to effect the abrupt release of a flow of water to wash animal wastes from the floor of a dairy barn. *Ibid.* Therefore, “although the [respondent’s] flush system does not embrace a complicated technical improvement, it does achieve a synergistic result through a novel combination.” *Id.*, at 173.

We cannot agree that the combination of these old elements to produce an abrupt release of water directly on the barn floor from storage tanks or pools can properly be characterized as synergistic, that is, “result[ing] in an effect greater than the sum of the several effects taken separately.” *Anderson’s-Black Rock v. Pavement Co.*, 396 U. S. 57, 61 (1960). Rather, this patent simply arranges old elements with each performing the same function it had been known to perform, although perhaps producing a more striking result than in previous combinations. Such combinations are not patentable under standards appropriate for a combination patent. *A&P Tea Co. v. Supermarket, etc. Co.*, *supra*, *Anderson’s-Black Rock v. Pavement Co.*, *supra*. Under those authorities this assembly of old elements that delivers water directly rather than through pipes or hoses to the barn floor falls under the head of “the work of the skillful mechanic, not that of the inventor.” *Hotchkiss v. Greenwood*, *supra*, at 267. Exploitation of the principle of gravity adds nothing to the sum of useful knowledge where there is no change in the respective functions of the elements of the combination; this particular use of the assembly of old elements would be obvious to any person skilled in the art of mechanical application. See *Dann v. Johnston*, slip op., at 11.

Though doubtless a matter of great convenience, producing a desired result in a cheaper and faster way, and enjoying commercial success, Dairy Establishment “did not produce a ‘new or different function’ . . . within the test of validity of combination patents.” *Anderson’s-Black Rock v. Pavement Co.*, *supra*, at 60. These desirable benefits “without invention will not make patentability.” *A&P Tea Co. v. Supermarket, etc. Co.*, *supra*, at 153. See *Dann v. Johnston*, *supra*, at — n. 4.

Reversed.

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE THURGOOD MARSHALL

April 1, 1976



Re: No. 75-110 -- Sakraida v. Ag Pro, Inc.

Dear Bill:

Please join me.

Sincerely,

T. M.

Mr. Justice Brennan

cc: The Conference

April 1, 1976

No. 75-110 Sakraida v. Ag Pro, Inc.

Dear Bill:

Please join me.

Sincerely,

Mr. Justice Brennan

lfp/ss

cc: The Conference

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE JOHN PAUL STEVENS



April 1, 1976

Re: No. 75-110 - Sakraida v. Ag Pro, Inc.

Dear Bill:

Please join me.

Respectfully,

Mr. Justice Brennan

Copies to the Conference

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE BYRON R. WHITE



April 2, 1976

Re: No. 75-110 - Sakraida v. Ag Pro, Inc.

Dear Bill:

Please join me.

Sincerely,

Mr. Justice Brennan

Copies to Conference

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE HARRY A. BLACKMUN

April 2, 1976

Re: No. 75-110 - Sakraida v. Ag Pro, Inc.

Dear Bill:

Please join me.

Sincerely,



Mr. Justice Brennan

cc: The Conference

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE POTTER STEWART

April 5, 1976

Re: No. 75-110, Sakraida v. Ag Pro, Inc.

Dear Bill,

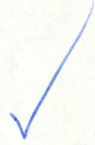
I am glad to join your opinion for the
Court in this case.

Sincerely yours,



Mr. Justice Brennan

Copies to the Conference



Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
JUSTICE WILLIAM H. REHNQUIST

April 6, 1976

Re: No. 75-110 - Sakraida v. Ag Pro

Dear Bill:

Please join me.

Sincerely,

Mr. Justice Brennan

Copies to the Conference

Supreme Court of the United States
Washington, D. C. 20543

CHAMBERS OF
THE CHIEF JUSTICE

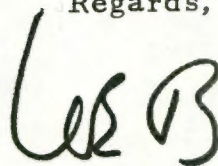
April 14, 1976

Re: 75-110 - Sakraida v. Ag Pro, Inc.

Dear Bill:

I join your April 1 circulation in this case.

Regards,

A handwritten signature in black ink, appearing to read "Lewis B. Powell". The signature is written in a cursive, somewhat stylized hand.

Mr. Justice Brennan

Copies to the Conference

