

# 50 Years: *Graham v. Deere*

AS TOLD TO HANNAH KIDDOO

This year marks the 50th anniversary of *Graham v. Deere*, 383 U.S. 1 (1966), the landmark U.S. Supreme Court case that set the framework for determining obviousness in patent law. Amarillo attorney Tom Morris represented John Deere Co. and argued the case before the Supreme Court. For 10 years leading up to *Graham v. Deere*, Morris litigated the *Graham* patents in Amarillo federal court; the U.S. Court of Appeals for the 5th Circuit; a Kansas City, Missouri, federal court; and the Court of Appeals for the 8th Circuit. Here, the 96-year-old attorney, who still goes to his office every day, talks about the case, its background, and its impact.

During the Dust Bowl in the Great Plains, the common method of plowing was with one-way or tandem disc plows that turned under the crop residue and left the surface of the land flat and subject to severe wind erosion. Implement manufacturers sought answers, and two in Amarillo—William T. Graham and Jeffroy Mfg. Inc.—developed chisel plows with spring shanks that broke up the soil and left residue on the surface. This method reduced wind erosion and was quite successful in the lower Great Plains states (Texas, Oklahoma, Colorado, Kansas, and Nebraska) but encountered severe problems in the northern Great Plains where many glacial rocks were buried. When the chisels encountered buried rocks, the chisels and shanks would break and plow frames would bend. Graham and Jeffroy sought to resolve those problems.

Graham obtained two patents, a brace device to reduce bending of the plow frames (US Patent No. 2,464,255 [255]) and a spring-loaded-hinge clamp that would permit the chisel and shank to ride over a rock and return to working position (US Patent No. 2,493,811 [811]). Jeffroy developed similar devices, and in 1951, Graham sued Jeffroy for infringement of both patents in the U.S. District Court in Amarillo.

Jeffroy brought the case to Gibson, Ochsner & Little, its local law office, for defense. Chicago patent attorneys were employed. I had just joined Gibson, Ochsner & Little, and Mr. Ochsner assigned the case to me to act as local counsel and assist the patent attorneys. At that time, I had less than three years of general trial experience and knew nothing about patents or patent law, but I learned a little bit as the case progressed. It was tried in 1952. Judge Dooley held that the brace patent (255) was invalid and the spring clamp



Amarillo attorney Tom Morris

patent (811) was valid and infringed. This was a disappointing loss for the Jeffroys. They promptly fired the Chicago attorneys and said to me: “Tom, you take over for the appeal.” I should have refused that assignment but did not. Over the next 60 days, I worked about 18 hours a day perfecting the appeal, preparing the record, and preparing the briefs. The 5th Circuit affirmed in *Graham v. Jeffroy*, 206 F.2d 769 (1953).

Jeffroy redesigned its spring clamp and Graham obtained another patent, No. 2,627,798 (798), titled “Clamp For Vibrating Shank Plows.” He never manufactured a device as shown and claimed in that patent, but he promptly sued Jeffroy again under the 811 patent and the 798 patent. I defended. Judge Dooley held

that Jeffroy’s new spring clamp infringed the 811 patent but that the 798 patent was invalid for lack of invention. The 5th Circuit reversed, holding that 811 was not infringed but that 798 was valid and infringed. Cert was denied. I had won some battles but lost the war for Jeffroy.

Graham also sued Cockshutt Farm Equipment in the Amarillo federal court, and I defended Cockshutt. Judge Dooley held that Cockshutt did not infringe and the 5th Circuit affirmed.

That brings us to *Graham v. Deere*. Graham sued Deere in the U.S. District Court for the Western District of Missouri for infringement of 798. I defended. The district court followed the 5th Circuit and held that 798 was valid and infringed. I appealed to the 8th Circuit and it reversed, holding 798 invalid.

We then had a direct conflict between the 5th Circuit and the 8th Circuit as to the validity of the Graham 798 patent. The time was ripe for a Supreme Court decision. Certiorari was granted in *Graham v. Deere* and two other cases. All three were set for argument on October 14, 1965.

In 1952, Congress had passed the 1952 Patent Act, which was the first real change in the patent statutes in more than 100 years. There had been only two statutory requirements for the issuance of a patent, i.e., novelty and usefulness, but the courts had added a third requirement, i.e., that there must be “invention.” There were literally hundreds of cases in the circuit courts and a few cases in the Supreme Court, with varying results. In *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U.S. 84 (1941), Justice Douglas stated that to constitute invention there must be a “flash of creative genius, not merely the skill of the calling.”

The 1952 Patent Act retained the requirements of novelty and usefulness in sections 101 and 102, but added section 103, providing as follows:

A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in section 102, if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.

The circuit courts had gone in many directions as to what section 103 meant, and the Supreme Court had not decided a single case under section 103. The Patent Bar of the United States was eagerly awaiting a Supreme Court decision on section 103. The courtroom was full, with attorneys standing along the walls. It goes without saying that the decision of the Supreme Court was going to be a landmark of extraordinary importance.

*Graham v. Deere* was the first case for argument and the arguments went my way. Graham's counsel argued in support of a function that had not been stated or argued in the patent office during the prosecution of the application and was minimized by his patent expert in the trial of the Jeffroy cases and the Deere case. That function was bending of the forward nine inches of the spring shank away from the hinge plate rather than against the hinge plate. I had hardly commenced my argument when Justice Black rose up in his chair and in effect said to me, "Mr. Morris, what difference does it make whether the shank bends away from the plate or against the plate?" I responded, "It makes no difference whatsoever," and Justice Black said, "That's what I thought." In view of that remark, I shortened my argument, and the court asked me very few questions. The 798 patent was held invalid as obvious.

The second patent case argued that day involved a plastic finger sprayer with a hold-down lid. The arguments presented no drama, and the Supreme Court held that patent invalid as obvious.

The third case, *United States v. Adams*, presented great drama. The patent was for a nonrechargeable electric battery, comprising

magnesium and cuprous chloride placed in a container of plain or salt water, which was effective under high pressure, such as in submarines, and under low pressure, such as in high-altitude airplanes. During World War II, the United States had effectively used thousands of such batteries but refused to pay Adams any royalties, contending that the patent was invalid. Adams sued in the U.S. Court of Federal Claims, which held the patent valid and infringed.

In the Supreme Court, Adams was represented by John A. Reilly, a distinguished patent attorney with extensive experience before the Supreme Court. He requested and obtained permission to make a demonstration during his argument and set up on the counsel table a battery, with wiring, a switch, and a light bulb. Before beginning argument, he stated to the court that if Adams was correct about validity of his patent, the light would come on before Reilly finished his argument. About 15 minutes into his argument, the light came on. The entire audience burst into applause, and all members of the court stood up to see the light. Needless to say, the court held that Adams's invention was novel, useful, and non-obvious. No one could explain how it worked, but it did.

This year is the 50th anniversary of *Graham v. Deere*. It has been cited more than 30,000 times and has been reaffirmed by the Supreme Court in *Anderson's Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57 (1969); *Sakraids v. Ag Pro, Inc.*, 425 U.S. 273 (1976), and *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). In *KSR*, the Federal Circuit, which has handled all patent appeals since 1984, attempted to apply a more rigid test that it called "teaching, suggestion, and motivation." The Supreme Court rejected that test as incompatible with its precedents and reaffirmed *Graham v. Deere*. I expect it to remain the law because it complies with Article I, Section 8, Clause 8 of the U.S. Constitution, which authorizes Congress "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," as explained in *Hotchkiss v. Greenwood*, 11 How. 248, 13 L.Ed. 683 (1850).

*Graham v. Deere* was a singular experience. From a beginning, with no knowledge of patent law, to a victory and establishment of law that has lasted for 50 years and promises to last indefinitely, there could be no greater achievement in the law. **TBJ**

## ⊕ TEXAS BAR BLOG

# WE NEED EXPERT BLOGGERS

THE TEXAS BAR BLOG SEEKS EXPERT BLOGGERS TO WRITE ABOUT TOPICS OF INTEREST FOR A SAVVY AUDIENCE OF LAWYERS. WE'RE LOOKING FOR EXCELLENT WRITERS WHO FUSE THEIR KNOWLEDGE OF THE LAW WITH THOUGHTFULLY CRAFTED PROSE.

Guidelines at  
[texasbar.com/bloggling](http://texasbar.com/bloggling)

Send your submissions to  
[tbj@texasbar.com](mailto:tbj@texasbar.com)