

governed by § 102(g) but by § 102(e), and that disclosure can be antedated by a showing of prior invention without resort to an interference proceeding. On the other hand, where the subject matter sought to be antedated is *claimed* in the reference U.S. patent, an interference must be had to determine priority.³³²

³³¹ *Sun Studs Inc. v. ATA Equip. Leasing Inc.*, 872 F.2d 978, 10 USPQ2d 1338 (Fed. Cir. 1989).

³³² *In re Zletz*, 893 F.2d 319, 13 USPQ2d 1320 (Fed. Cir. 1989). Thus, a losing party to an interference is entitled to claim subject matter other than that of the interference count, provided the requirements of patentability are met, and subject to those constraints that flow from the adverse decision in the interference. *Id.*

The court had held that prior work by another in the same company could be, consistent with § 102(g), applied as prior art under 35 U.S.C. § 103.³³³ Such holdings were obviated by a November 1984 amendment to § 103, which effectively removed commonly owned prior

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invention activities from the ambit of § 103 prior art.³³⁴ However, if the first inventor does not have an obligation to assign to the common employer, the prior invention may be prior art. In an unusual case, one employee had conceived the invention and worked toward an eventual commercialization of it, but filed no patent application. Another employee invented it independently later and filed an application that matured into the patent in suit, which was assigned to the employer. Although the first inventor may have lost the right to obtain a patent, his work was not thereby disqualified as prior art. The court felt that if a valid patent were to be obtained, the first inventor, who is favored by U.S. law, could not be cavalierly tossed aside in favor of a second inventor with whom the employer had more advantageous contract rights.³³⁵

³³³ *Kimberly-Clark Corp. v. Johnson & Johnson*, 745 F.2d 1437, 223 USPQ 603 (Fed. Cir. 1984).

³³⁴ *In re Longi*, 759 F.2d 887, 225 USPQ 645, 650 & n.7 (Fed. Cir. 1985). See also *E.I. duPont & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129, 1135 n.6 (Fed. Cir. 1988).

³³⁵ *Checkpoint Sys. Inc. v. United States ITC*, 54 F.3d 756, 35 USPQ2d 1042 (Fed. Cir. 1995). The court characterized the patent owner's arguments about abandonment, suppression, or concealment as "a new definition of 'chutzpah'."

§ 3.4(d)(iii) Corroboration of Prior Invention or Use

It is now well established that a party claiming his or her own prior inventorship must proffer evidence corroborating his or her testimony.³³⁶ In *Woodland v. Flowertree*, the court explained that there is a very heavy burden to be met by one challenging validity when the only evidence is the oral testimony of interested persons and their friends, particularly as to long-past events. Corroboration of oral evidence of prior invention is the general rule in patent disputes. In assessing corroboration, the court endorses the following criteria: (1) the relationship between the corroborating witness and the alleged prior user, (2) the time period between the event and trial, (3) the interest of the corroborating witness in the subject matter in suit, (4) contradiction or impeachment of the witness's testimony, (5)

the extent and details of the corroborating testimony, (6) the witness's familiarity with the subject matter of the patented invention and the prior use, (7) the probability that a prior use could occur considering the state of the art at the time, and (8) the impact of the invention on the industry and the commercial value of its practice. Such an analysis can be described as application of a "rule of reason" to the corroboration requirement. In this case the court was particularly concerned about the lack of any physical record of an alleged prior activity that was said to have begun 30 years prior, but only continued for a decade and was not reactivated until the defendant learned of the patentee's practices. It observed that early Supreme Court decisions reinforce the heavy burden when establishing prior public knowledge and use based on long-past events. The Supreme Court's view of human nature as well as human recollection, whether deemed cynical or realistic,

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retains its cogency. This view is reinforced, in modern times, by the ubiquitous paper trail of virtually all commercial activity. It is rare indeed that some physical record (e.g., a written document such as notes, letters, invoices, notebooks, or a sketch or drawing or photograph showing the device, a model, or some other contemporaneous record) does not exist. In this case, the court was impressed by the absence, despite the asserted many years of commercial and public use, of any physical record to support the oral evidence. The relationship of the witnesses and the fact that the asserted prior uses ended 20 years before the trial, and were abandoned until the defendant reportedly learned of the patentee's practices, underscored the failure of this oral evidence to provide clear and convincing evidence of prior knowledge and use.³³⁷

³³⁶ *Rosco Inc. v. Mirror Lite Co.*, 304 F.3d 1373, 64 USPQ2d 1676, 1681 (Fed. Cir. 2002).

³³⁷ *Woodland Trust v. Flowertree Nursery Inc.*, 148 F.3d 1368, 47 USPQ2d 1363 (Fed. Cir. 1998). The court was actually considering a defense of prior knowledge and use under 35 U.S.C. § 102(a). In *Finnigan Corp. v. United States ITC*, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999), the court expressly concluded that a witness's uncorroborated testimony is equally suspect as clear and convincing evidence if it relates to use of the invention in public before invention by the patentee (§ 102(a)), use of the invention in public one year before the patentee filed a patent application (§ 102(b)), or invention before the patentee (§ 102(g)).

Six months later, in *Thomson v. Quixote*, the court appeared to retreat slightly from the *Woodland* approach. It held that, in a case involving a prior invention defense under § 102(g), corroboration is required only when the testifying inventor is asserting a claim of derivation or priority of his or her invention and is a named party, an employee of or assignor to a named party, or otherwise is in a position where he or she stands to gain, directly and substantially, by his or her invention being found to have priority over the patent claims at issue. The court observed that the cases that discuss skepticism of uncorroborated inventor testimony directed to establishing priority over an opponent's patent claim involve situations where the inventor is self-interested in the outcome of the trial and is thereby tempted to "remember" facts favorable to his or her case. The clear and convincing standard of proof required to establish priority, along with the numerous methods in the Federal Rules of Civil Procedure and Evidence by which a party may test, challenge, impeach, and rebut oral testimony, normally protect patentees from erroneous findings of invalidity. Thus, the corroboration rule is needed only to counterbalance the self-interest of a testifying inventor against the patentee.³³⁸

³³⁸ *Thomson S.A. v. Quixote Corp.*, 166 F.3d 1172, 49 USPQ2d 1530 (Fed. Cir. 1999). The court rejected an argument that the corroboration rule was required here inasmuch as the testifying witnesses were involved in businesses that supplied goods and services to the defendant; this was not seen to rise to the level of self-interest required to justify triggering application of the corroboration rule.

A few months after *Thomson v. Quixote*, the court had another look at the question. This time, the panel, which included the author of *Quixote*, concluded that *Quixote's* facts “did not present the question of the necessity of corroboration *vel non*, but rather the sufficiency of the corroborating evidence, a distinct inquiry involving an assessment of the totality of the circumstances, including consideration of

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‘the interest of the corroborating witness in the subject matter of the suit.’” Thus, the court appeared to overrule *Quixote* sub silentio, holding that, while the level of interest of the testifying witness is an important consideration when such testimony is offered to corroborate another witness's testimony, corroboration is required of any witness whose testimony alone is asserted to invalidate a patent, regardless of his or her level of interest. In other words, the uncorroborated testimony cannot surmount the hurdle that the clear and convincing evidence standard imposes in proving patent invalidity.³³⁹

³³⁹ *Finnigan Corp. v. United States ITC*, 180 F.3d 1354, 51 USPQ2d 1001, 1011 (Fed. Cir. 1999). In *Oney v. Ratliff*, 182 F.3d 893, 51 USPQ2d 1697 (Fed. Cir. 1999), the court remanded a summary judgment of invalidity for prior invention because the district court failed to apply the *Woodland* corroboration factors.

More recently, in *Sandt v. Resco*,³⁴⁰ the court elaborated: a party claiming his or her own prior inventorship must proffer evidence corroborating his or her testimony. This rule addresses the concern that a party claiming inventorship might be tempted to describe his or her actions in an unjustifiably self-serving manner in order to obtain a patent or to maintain an existing patent. A rule of reason analysis is applied to determine whether an inventor's testimony has been corroborated. In applying the rule of reason test, all pertinent evidence is examined in order to determine whether the inventor's story is credible. Each corroboration case must be decided on its own facts with a view to deciding whether the evidence as a whole is persuasive, but the determination is not utterly unstructured. Rather, the court has provided considerable guidance on the standards by which to judge whether or not an inventor's testimony has been sufficiently corroborated. Documentary or physical evidence that is made contemporaneously with the inventive process provides the most reliable proof that the inventor's testimony has been corroborated. Because documentary or physical evidence is created at the time of conception or reduction to practice, the risk of litigation-inspired fabrication or exaggeration is eliminated. Circumstantial evidence about the inventive process, alone, may also corroborate. Additionally, oral testimony of someone other than the alleged inventor may corroborate an inventor's testimony. In contrast to contemporaneous documentary evidence, however, postinvention oral testimony is more suspect, as there is more of a risk that the witness may have a litigation-inspired motive to corroborate the inventor's testimony, and that the testimony may be inaccurate. The court articulated the following illustrative factors that may be useful in guiding the determination of whether a witness's testimony provides sufficient corroboration: (1) relationship between the corroborating witness and the alleged prior user; (2) time period between the event and trial; (3) interest of the corroborating witness in the subject matter in suit; (4) contradiction or impeachment of the

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witness's testimony; (5) extent and details of the corroborating testimony; (6) the witness's familiarity with the subject matter of the patented invention and the prior use; (7) probability that a prior use could occur considering the state of the art at the time; and (8) impact of the invention on the

industry, and the commercial value of its practice.

³⁴⁰ *Sandt Tech. Ltd. v. Resco Met. & Plas. Corp.*, 264 F.3d 1344, 60 USPQ2d 1091 (Fed. Cir. 2001). Physical, documentary, or circumstantial evidence, or reliable testimony from individuals other than the alleged inventor or an interested party, may corroborate. *Checkpoint Sys. Inc. v. All-Tab Security S.A.*, 412 F.3d 1331, 75 USPQ2d 1200, 1206 (Fed. Cir. 2005).

In dictum, a 2–1 panel recently placed great emphasis on the lack of corroboration for the testimony of six witnesses as to a prior use. In so doing, the panel majority adopted the CCPA's earlier list of factors for evaluating the credibility of oral statements: (1) delay between event and trial, (2) interest of witness, (3) contradiction or impeachment, (4) corroboration, (5) witnesses' familiarity with details of alleged prior structure, (6) improbability of prior use considering state of the art, (7) impact of the invention on the industry, and (8) relationship between witness and alleged prior user.³⁴¹

³⁴¹ *Juicy Whip Inc. v. Orange Bang Inc.*, 292 F.3d 728, 63 USPQ2d 1251, 1260 (Fed. Cir. 2002). The court had already decided that the elements of the claimed invention were not met by the alleged prior use. See *In re Reuter*, 670 F.2d 1015, 210 USPQ 249, 255 & n.9 (CCPA 1981).

§ 3.4(e) Admissions as Prior Art

Section 102 is not the only source of § 103 prior art. Valid prior art may be created by the admissions of the parties.³⁴² Such admissions are generally characterized by statements made during prosecution describing certain work as “prior art.”³⁴³

³⁴² *Riverwood Int'l Corp. v. R.A. Jones & Co.*, 324 F.3d 1346, 66 USPQ2d 1331 (Fed. Cir. 2003).

³⁴³ *Abbott Labs. v. Baxter Pharm. Prods. Inc.*, 334 F.3d 1274, 67 USPQ2d 1191, 1195 (Fed. Cir. 2003).

Where an applicant's attorney characterizes a patent as “prior art,” that explicit admission is sufficient to justify a district court holding that the patent is part of the prior art.³⁴⁴ However, an admission by an attorney that a reference in a prior art brochure was to a patented process did not serve as a vehicle whereby the patent on the process, otherwise too late, also became prior art. The key factor is whether the brochure itself contains an enabling disclosure of the process.³⁴⁵

³⁴⁴ *Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985).

³⁴⁵ *Reading & Bates Constr. Co. v. Baker Energy Res. Corp.*, 748 F.2d 645, 223 USPQ 1168 (Fed. Cir. 1984). The court also went on, in a puzzling dictum, to express doubt whether the admission of an attorney as to what is prior art could have any binding effect on the court. *Id.* But see *Tyler Refrigeration v. Kysor Indus. Corp.*, 777 F.2d 687, 227 USPQ 845 (Fed. Cir. 1985).