

IN *FINNIGAN'S* WAKE: RECENT CONFUSING CHANGES IN THE FEDERAL CIRCUIT'S REQUIREMENT FOR CORROBORATION OF WITNESS TESTIMONY DURING PATENT INFRINGEMENT LITIGATION

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INTRODUCTION

Imagine that Inventor obtains a lucrative patent for a new type of water sprinkler. Infringer begins making and selling Inventor's device, causing Inventor's profits to take a steep plunge. Infuriated by Infringer's activity, Inventor takes matters into his own hands and sets fire to Infringer's factory. At the inevitable trial of Inventor for arson, the Prosecution offers the uncorroborated testimony of Bishop, who testifies that he clearly saw Inventor planting incendiary devices outside Infringer's factory. Not surprisingly, Bishop is an utterly unimpeachable and highly credible witness. Even if Bishop's uncorroborated testimony was the only evidence that the Prosecution offered, it could support a jury verdict that Inventor was guilty of arson beyond a reasonable doubt.

Now imagine that instead of burning down Infringer's factory, Inventor sues Infringer for patent infringement in Federal District Court. Infringer knows that Inventor's patent is invalid because for many years before he applied for the patent, Inventor had publicly displayed the sprinkler system in his garden.¹ Because only a valid patent can support an infringement suit, Infringer uses this evidence as the basis for the affirmative defense of patent invalidity.² In order to succeed with this defense, Infringer must prove by "clear and convincing evidence" that Inventor has been publicly using the sprinkler sys-

1. See 35 U.S.C. § 102(b) (1994).

2. See *id.*

tem.³ At trial, Infringer calls Bishop, who testifies that he had seen Inventor give public demonstrations of the sprinkler many years before Inventor applied for his patent. Again, Bishop is an utterly unimpeachable and thoroughly credible witness. Despite the fact that the “clear and convincing” evidentiary standard is less rigorous than the “beyond a reasonable doubt” standard,⁴ Bishop’s uncorroborated testimony, standing alone, is now insufficient as a matter of law to prove Inventor’s prior public use by “clear and convincing” evidence.⁵

This rather exaggerated hypothetical illustrates an evidentiary quirk of patent infringement litigation: the requirement for corroboration of oral testimony of patent invalidity. Since the Federal Circuit decided *Finnigan Corporation v. United States International Trade Commission*,⁶ testimony offered to invalidate a patent can never be properly considered by the factfinder as “clear and convincing” evidence of invalidity without such corroboration. Before *Finnigan*, it seemed that the corroboration requirement applied only when a witness testified that she had invented the claimed invention before the patentee. But in 1999, two partially-overlapping panels of the Federal Circuit changed the corroboration requirements in conflicting ways. First, *Thomson S.A. v. Quixote Corp.*⁷ seemed to relax the requirements for corroboration when testimony of prior invention was offered to invalidate a patent. The *Thomson* opinion appeared to give the factfinder traditional deference to evaluate witness credibility without corroboration in certain circumstances.⁸ However, less than six months after *Thomson*, *Finnigan* effectively rejected the standard in *Thomson*. Moreover, the *Finnigan* court extended the corroboration requirement to all testimony offered to invalidate a patent, not just testimony of prior invention.⁹

This casenote discusses these recent changes in the requirements for corroboration of witness testimony proffered by

3. See *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed. Cir. 1993).

4. See *Buldex, Inc. v. Kason Indus., Inc.*, 849 F.2d 1461, 1463 (Fed. Cir. 1988).

5. See *Finnigan Corp. v. United States Int’l Trade Comm’n*, 180 F.3d 1354 (Fed. Cir. 1999).

6. 180 F.3d 1354 (Fed. Cir. 1999).

7. 166 F.3d 1172 (Fed. Cir. 1999), *cert. denied*, 119 S. Ct. 2395 (1999).

8. See *id.* at 1176.

9. See *Finnigan*, 180 F.3d at 1369.

defendants in support of their invalidity defenses. Part I of this casenote will introduce patent concepts and procedures followed during patent infringement litigation. Part II will explore the genesis of and rationale behind the corroboration requirement in patent disputes. Parts III and IV will then discuss the *Thomson* and *Finnigan* opinions. Part V will argue that, contrary to their assertions, the Federal Court's opinions in *Thomson* and *Finnigan* are truly irreconcilable and that *Finnigan* is essentially a covert overruling of *Thomson* after realization that the *Thomson* standard was unworkable. Part V will also argue that rather than merely restoring the requirement for corroboration to the pre-*Thomson* position, the *Finnigan* court unwisely has extended the corroboration requirement beyond its original bounds, making proof of patent invalidity more difficult.

I. THE RIGHTS CONFERRED BY A PATENT AND THE EXERCISE OF THOSE RIGHTS DURING PATENT INFRINGEMENT LITIGATION

A. *Patent Infringement Litigation In General*

The grant of a patent by the United States Patent and Trademark Office ("USPTO") confers upon the patentee and her assigns a twenty year right, running from the application filing date, to exclude others from making, using, offering for sale, or selling the claimed invention in the United States.¹⁰ The patentee may also exclude others from importing infringing articles into the United States.¹¹ In other words, a patent is an offensive weapon that can be used to pursue those who are engaging in infringing activity.¹²

When a patentee believes that someone is engaging in infringing activity, her first action is usually to send a series of

10. See 35 U.S.C. § 154 (1994). Patent applications are examined *ex parte* by the USPTO to determine if the claimed invention is new, useful, within the statutory subject matter, and non-obvious. See 35 U.S.C. §§ 101-103. The USPTO also examines the patent application to see that it contains an adequate description of the invention that would enable one "skilled in the art" to practice what the applicant considers to be the "best mode" of carrying out the invention. See 35 U.S.C. § 112 (1994). The patent claims themselves must "particularly point[] out and distinctly claim[]" what the inventor considers as the invention. See 35 U.S.C. § 112.

11. See *id.*

12. See 35 U.S.C. § 271 (1994).

increasingly-threatening "cease and desist" letters to the alleged infringer, often coupled with invitations to purchase a license to use the patent. Should that fail to stop the activity, the patentee's ultimate solution is to initiate a patent infringement action for damages and injunctive relief in federal district court.¹³

The defendant in a patent infringement action can assert a number of distinct affirmative defenses. First, the defendant can claim that the patent at issue is invalid for failure to comply with the statutory patentability requirements set forth in 35 U.S.C. §§ 100–112.¹⁴ Second, the defendant can claim that

13. Federal district court is the exclusive jurisdiction for patent infringement actions. See 27 U.S.C. § 1338 (1994). The court may first hold a "Markman Hearing" in which the precise scope of the patent claim(s) at issue is determined as a question of law. See *Markman v. Westview Instruments, Inc.*, 52 F.3d 967, 970–71 (Fed. Cir. 1995) (*en banc*), *aff'd*, 517 U.S. 370 (1996). In a Markman Hearing, the court will consider the claims in light of the written specification of the patent, and may also rely on extrinsic evidence provided by the parties. See *id.* A patent claim comprises a single sentence that "particularly point[s] out and distinctly claim[s] the subject matter which the applicant regards as his invention." 35 U.S.C. § 112 (1994). After the Markman Hearing, the factfinder will use the court's construction of the claims to determine if the patentee has proved by a preponderance of the evidence that the defendant has infringed one or more of the claims. See *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 626 (Fed. Cir. 1985). If each and every element of the patent claim exists in the defendant's article or process, then the factfinder will find that the defendant has "literally infringed" the claims. Alternatively, the factfinder may find that there is not literal infringement, but that the defendant has nevertheless infringed under the "doctrine of equivalents." See *Graver Tank & Mfg. Co. v. Linde Air Prods. Co.*, 339 U.S. 605 (1950). This doctrine permits a finding of infringement if the defendant's process or article "contain[s] elements equivalent to each claimed element of the patented invention." *Warner-Jenkinson Co., Inc. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 26 (1997). If infringement is found under the two theories, injunctive relief is permissible under 35 U.S.C. § 283 (1994). Damages can be awarded on the basis of lost profits, or absent a showing of such loss, on the basis of a "reasonable royalty" for the use of the invention. See 35 U.S.C. § 284 (1994). If the court finds that the defendant's infringement was willful, then the court is authorized under § 284 to award damages up to three times the amount claimed as "lost profits" or "reasonable royalty." See 35 U.S.C. § 284 (1994); see also *Modine Mfg. Co. v. Allen Group, Inc.*, 917 F.2d 538 (Fed. Cir. 1990).

14. The statutory requirements for patentability guide the examination of patent applications during the *ex parte* prosecution before the USPTO and during interference proceedings before the USPTO. An interference is an administrative proceeding conducted before the Board of Patent Interferences and Appeals of the USPTO when two pending applications both claim the same invention. The purpose of the interference is to determine which of the parties is entitled to the patent. See 35 U.S.C. § 135(a) (Supp. II 1996); 37 C.F.R. § 1.601(i)(1997). The decisions of the Board of Patent Appeals and Interferences can be appealed to the

the patent is not enforceable because the patentee engaged in inequitable conduct or fraud before the USPTO, misused the patent, or is subject to the doctrine of laches.¹⁵

Every claim of an issued patent is presumed to be valid.¹⁶ A defendant asserting the affirmative defense of statutory invalidity under 35 U.S.C. §§ 100–112 must therefore prove failure to comply with the statutory requirements by “clear and convincing evidence.”¹⁷

The affirmative defense of invalidity can be premised on a failure to comply with any of a number of provisions of 35 U.S.C. §§ 100–113. Three types of statutory invalidity defenses are routinely asserted. First, the patent can be held invalid for failure of the patent specification to comply with the disclosure requirements of 35 U.S.C. §§ 112–113.¹⁸ Second, the patented device or process may be “obvious” within the meaning of 35 U.S.C. § 103.¹⁹ Finally, the patent can be held invalid for lack

United States Court of Appeals for the Federal Circuit. See 35 U.S.C. § 141 (Supp. II 1996).

15. A claim of inequitable conduct is typically based upon an allegation that the patentee intentionally withheld, falsified, or misrepresented a material fact concerning the patentability of the invention during prosecution of the patent application before the USPTO. See *Refac Int'l, Ltd. v. Lotus Dev. Corp.*, 81 F.3d 1576, 1581 (Fed. Cir. 1996). Patent misuse may be found if the patentee tries to enforce the patent with improper regard for the breadth of the claims. See *Zenith Radio Corp. v. Hazeltine Research, Inc.*, 395 U.S. 100 (1969). The doctrine of laches may be asserted as a defense if the patentee delayed filing of the infringement action for an unreasonable length of time without excuse, and such delay harmed the defendant. See MICHAEL E. EPSTEIN, EPSTEIN ON INTELLECTUAL PROPERTY § 5.04[D][4] (1999).

16. See 35 U.S.C. § 282 (1994).

17. See *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed. Cir. 1993); see generally David W. Okey, *Issued Patents and the Standard of Proof: Evidence Clear and Convincing or Merely Ponderous*, 17 J. MARSHALL J. COMPUTER & INFO. L. 557 (1999) (discussing the derivation and practical significance of the “clear and convincing” standard in patent infringement litigation). The “clear and convincing” evidentiary standard is described as lying between proof “beyond a reasonable doubt” and proof “by a preponderance of the evidence.” See *Buildex, Inc. v. Kason Indus., Inc.*, 849 F.2d 1461, 1463 (Fed. Cir. 1988).

18. The patent specification comprises a written description of the invention, along with the claims. See 35 U.S.C. § 112 (1994). Drawings may be required if they are necessary for an understanding of the invention. 35 U.S.C. § 113 (1994). A patent specification must describe the invention in enough detail to enable a person of ordinary skill in the art of the invention to practice it. See *id.* In addition, the specification must disclose the “best mode” of carrying out the invention known to the inventor. See *id.*

19. A claimed article or process is invalid for obviousness:

[I]f the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have

of novelty based on "anticipation" of the claims under 35 U.S.C. § 102.²⁰ Of particular interest to this discussion are 35 U.S.C. §§ 102(a), (b), and (g).

B. The Defense of Statutory Invalidity under 35 U.S.C. § 102

Section 102 describes a number of different situations in which a patent is anticipated. Section 102(a) prohibits patenting if "the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent."²¹ This prohibition applies when the invention claimed in the patent at issue is anticipated by an invention already disclosed to the public. Hence, the inventor "has not contributed to the store of knowledge, and has no entitlement to a patent."²² Courts have interpreted § 102(a) to mean that a patent claim may be held invalid if the claimed invention was publicly known or used.²³ However, the requirement for public use or knowledge may be limited simply to mean that the inventor did not take action to conceal the invention from the public.²⁴

Section 102(b) prevents the patentee from patenting if "the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application [for

been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

35 U.S.C. § 103 (1994). Primary factors that are relevant in the court's determination of obviousness include the scope and content of the prior art, the level of ordinary skill in the art, and differences between the claims at issue and the prior art. *See Graham v. John Deere Co.*, 425 U.S. 219, 225-27 (1976). Examples of secondary factors include the commercial success of the claimed invention and the failure of others to produce the claimed invention. *See id.*

20. A claimed invention must be new or novel. *See* 35 U.S.C. § 102 (1994). An invention that is not novel is said to have been "anticipated." A claimed invention can be anticipated by any prior knowledge, publication ("prior art"), invention, sale or public use of an article or process that embodies each and every element of the claimed invention. *See id.*

21. *See* 35 U.S.C. § 102(a) (1994).

22. *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1369 (Fed. Cir. 1998).

23. *See, e.g., Carella v. Starlight Archery*, 804 F.2d 135, 139 (Fed. Cir. 1986).

24. *See* DONALD S. CHISUM, 3 CHISUM ON PATENTS § 3.05[2][a] at 3-74 (1998).

the patent].”²⁵ Although § 102(b) and § 102(a) appear similar, it is important to note that § 102(b) deals with activity attributed to the *inventor* that occurs *after* invention, whereas § 102(a) deals with the activity of *others* that occurs *before* invention. Section 102(b) effectively gives the inventor a one-year “grace” period to file a patent application following public use or sale²⁶ of the invention; after this one-year period, the inventor is statutorily barred from obtaining a patent. The purpose of the § 102(b) statutory bar provision is to encourage inventors diligently to seek patent protection for their inventions.²⁷

Section 102(g) establishes which of two competing inventors is entitled to a patent for the same claimed invention.²⁸ This rule reflects the major difference between the United States patent system and the patent system of almost every other country: rather than awarding priority on a “first-to-file” basis, priority in the United States system is established on a

25. 35 U.S.C. § 102(b) (1994).

26. The prohibition against patenting of articles that have been the subject of an offer for sale more than one year prior to the filing of a patent application is termed the “on sale” bar. See *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55 (1998). The Supreme Court held that an invention is “on sale” when it is the subject of a commercial offer for sale and is ready for patenting more than one year before the critical date. An invention is ready for patenting when it is reduced to practice; alternatively, an invention is ready for patenting when the inventor has prepared a description of the invention that would allow an artisan of ordinary skill to practice the invention. See *id.* at 67.

27. See CHISUM, *supra* note 24, § 6.02, at 6-4. The aim of the patent system is to encourage innovation by granting a limited monopoly to inventors in return for full disclosure of their invention to the public in the form of a patent. See U.S. CONST. art I, § 8, cl. 8. Three policies have been noted for encouraging the diligent filing of patent applications following commercial or public disclosure of an invention. First, diligent filing prevents the public from coming to rely on an invention that they believe they are free to copy and practice themselves. Second, diligent filing furthers the aim of the patent system by hastening the disclosure of useful inventions. Finally, because the patent system grants the patentee a limited duration monopoly, allowing the inventor to obtain patent protection years after commercial or public use would effectively extend this monopoly. See Note, *New Guidelines for Applying the ‘On-Sale’ Bar to Patentability*, 24 STAN. L. REV. 730, 732-35 (1972).

28. 35 U.S.C. § 102 states:

A person shall be entitled to patent unless—

(g) before the applicant’s invention thereof the invention was made in this country by another who had not abandoned, concealed or suppressed it. In determining priority of invention, there shall be considered not only the respective dates of conception and reduction to practice, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

"first-to-invent" basis.²⁹ Section 102(g) further complicates the matter, by drawing a distinction between "conception" of the invention, and the subsequent "reduction to practice."³⁰ Put simply, "conception" is the "mental" step of invention, whereas "reduction to practice" is the "physical" step of invention.³¹ An invention is conceived when a description of the invention would allow a person of ordinary skill to reduce the invention to practice without undue experimentation.³² Actual reduction to practice takes place when the inventor can demonstrate that the invention works in the manner expected.³³ Alternatively, an invention is constructively reduced to practice when it is the subject of a patent application.³⁴

Although § 102(g) was originally intended to determine the priority of invention during a patent interference proceeding, it has become a defense during patent infringement litigation, to show that a patentee's invention is invalid.³⁵ In this defensive application of § 102(g), the patentee's invention can be anticipated by the prior invention of another inventor who has not sought patent protection, provided that this other inventor has not "abandoned, suppressed, or concealed" her invention.³⁶

29. The Philippines also maintains a "first to invent" system for determining priority. See Sean T. Carnathan, *Patent Priority Disputes—A Proposed Re-Definition of "First-to-Invent,"* 49 ALA. L. REV 755, 757 & n.10 (1999).

30. See 35 U.S.C. § 102(g).

31. "Conception is the touchstone of inventorship, the completion of the mental part of invention." *Sewall v. Walters*, 21 F.3d 411, 415 (Fed. Cir. 1994). "The idea must be 'so clearly defined in the inventor's mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.'" *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996) (quoting *Burroughs Wellcome Co. v. Barr Labs, Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994)).

32. See *Sewall*, 21 F.3d at 415.

33. See *Scott v. Finney*, 34 F.3d 1058, 1062 (Fed. Cir. 1994) (holding that the reduction to practice of surgical implant demonstrated by a video tape showing the implanted device functioning successfully in anesthetized patient).

34. See *Hazeltine Corp. v. United States*, 820 F.2d 1190, 1996 (Fed. Cir. 1987).

35. See *Thomson S.A. v. Quixote Corp.*, 166 F.3d 1172, 1175 n.3 (Fed. Cir. 1999).

36. 35 U.S.C. § 102(g) (1994). See *Checkpoint Sys. Inc. v. United States Int'l Trade Comm'n*, 54 F.3d 756, 761 (Fed. Cir. 1995); *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1205 (Fed. Cir. 1991). One court has noted that the application of § 102(g) in infringement actions is sensible because:

[t]he first to invent who has invested time and labor in making and using the invention—but who might have opted not to apply for a patent—will not be liable for infringing another's patent on that same invention,

In summary, an alleged-infringer will make a 35 U.S.C. § 102(g) attack on validity by claiming that she, or some other person, invented the article or process at issue before the patentee. Sections 102(a) and (b) will be invoked when the alleged-infringer claims that the patentee's invention was known in some public sense before the patentee filed her patent application.

C. *The Role of Witness Testimony In Patent Infringement Litigation*

For each of these strategies for invalidating a patent under 35 U.S.C. § 102, witness testimony can be pivotal. Such testimony can be provided either by the defendant, or by a non-party retained by the defendant. The witness can testify, for example, that she was the first to invent under § 102(g), or that she saw the invention being used in public by another. Thus, the central question becomes one of the sufficiency of the witness's testimony. Specifically, the issue depends on whether the testimony of a single witness, and nothing more, can ever be clear and convincing evidence of a patent's invalidity under § 102. The Federal Circuit has recently made some confusing changes in its answer to this question.

II. APPROACHES TO WITNESS TESTIMONY IN THE FEDERAL CIRCUIT PRIOR TO *THOMSON S.A. V. QUIXOTE CORP.*

Prior to *Thomson*, uncorroborated testimony of prior invention could seldom, standing alone, satisfy the clear and convincing standard required to invalidate a patent under § 102(g). The discussion below reveals the genesis of this approach and its application in cases.

while the public will have benefited because the invention was not abandoned, concealed or suppressed.

Thomson S.A., 166 F.3d at 1175 n.3.

Even if the first inventor to conceive the invention is the last one to reduce it to practice, that inventor may still be entitled to priority under section 102(g). Section 102(g) gives priority to such an inventor if she can demonstrate that she pursued the reduction to practice with reasonable diligence during the period starting immediately before the other inventor's conception and ending at their later reduction to practice. See *supra* text accompanying note 12; see also *Griffith v. Kanamara*, 816 F.2d 624, 625-26 (Fed. Cir. 1987); *CHISUM*, *supra* note 24, § 3.05[4] at 3-95.

A. *Early Skepticism of Witness Testimony in Patent Disputes*

1. *The Barbed Wire Patent Case*

In *The Barbed Wire Patent Case* of 1892,³⁷ the Supreme Court indicated the suspicion with which it regarded testimony offered to invalidate a patent. At trial, the defendants challenged the validity of the patent asserted against them, based on the use of a barbed wire fence in public by a landowner named Morley prior to the plaintiff's 1874 patent application filing date.³⁸ Specifically, the defendants provided witnesses who testified that they had seen a panel of the "Morley Fence" exhibited at a county fair in Delhi, Iowa in 1858 and 1859.³⁹ One witness testified that he helped Morley put up the panel of fence for display; another witness testified that he had tied his horse up next to the fence, only to later find that the horse had bloodied its nose on the barbs.⁴⁰ A further witness testified that he had been thrown against the panel and had injured his face; apparently, the scars were still visible at the time of trial.⁴¹ In all, the defendants provided twenty-four witnesses who testified that they had seen a fence displaying the claimed features of the patentee's fence.⁴² Even though the plaintiffs provided witnesses who flatly contradicted some of this testimony, the district court concluded, in the face of this large volume of testimony, that it was unlikely that all of the defendants' witnesses were lying.⁴³ Therefore, the district court found that the patentee's fence was anticipated by the prior public use of the "Morley Fence," and held the patent invalid.⁴⁴

The patentees appealed directly to the Supreme Court, who reversed.⁴⁵ Generally, the Supreme Court viewed witness testimony with a great degree of skepticism because of the "for-

37. 143 U.S. 275 (1892).

38. *See* Moen Mfg. Co. v. Beat 'Em All Barbed-Wire Co., 33 F. 261, 267 (C.C.N.D. Iowa 1888).

39. *See id.*

40. *See id.* at 268.

41. *See id.*

42. *See id.* at 267-70.

43. *See id.* at 271-72.

44. *See id.* at 272.

45. *The Barbed Wire Patent Case*, 143 U.S. 275 (1892).

getfulness of witnesses, their liability to mistakes, [and] their proneness to recollect things as the party calling them would have them recollect them."⁴⁶ The Court further noted that "[w]itnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves are not usually to be depended on for accurate information."⁴⁷ Accordingly, the Court found that oral testimony would only very rarely constitute proof of invalidity that was "clear, satisfactory and beyond a reasonable doubt."⁴⁸ In this case, although it appeared that the witnesses' statements tended to corroborate one another, the Court nevertheless resolved their doubts about the invalidity in favor of the patentee.

2. *Eibel Process Co. v. Minnesota & Ontario Paper Co.*

In *Eibel Process Co. v. Minnesota & Ontario Paper Co.*,⁴⁹ the Supreme Court reconfirmed their suspicion of oral testimony in patent infringement litigation. In this case, the plaintiff had obtained a patent that claimed a simple method for dramatically increasing the rate at which paper milling-machines could be operated.⁵⁰ In his defense, the defendant presented witnesses who claimed that they had practiced this improvement before the plaintiff.⁵¹ The Court noted that, given the great value of the challenged patent, the witnesses may have been tempted to "remember" and convince themselves of their prior invention, especially given the simplicity and the value of the claimed method.⁵² As a result, the oral evidence of the witnesses was held insufficient to prove invalidity.⁵³ Thus, as in the *The Barbed Wire Patent Case*, the Supreme Court in

46. *Id.* at 284.

47. *Id.*

48. *Id.* Although this evidentiary standard seems to invoke the "beyond a reasonable doubt" standard used in criminal cases, it has been noted that in its application by the Supreme Court, this standard is the same as the modern "clear and convincing evidence" standard. See *Finnigan Corp. v. United States Int'l Trade Comm'n*, 180 F.3d 1354, 1366 n.8 (Fed. Cir. 1999).

49. 261 U.S. 45 (1923).

50. See *id.* at 46-50.

51. See *id.* at 52. Under the current patent statute, the witness testimony would probably have been offered to attack patent validity under section 102(a) and/or section 102(g).

52. See *id.* at 59-60.

53. See *id.* at 60-61.

Eibel treated oral testimony offered to invalidate a patent with a great deal of suspicion.

B. The Development of a Requirement for Corroboration of Witness Testimony of a Prior Invention

The skepticism with which oral testimony was treated during patent disputes led to the requirement for independent corroboration of such testimony.⁵⁴ In both patent infringement litigation and patent interferences,⁵⁵ an inventor who testifies to establish prior invention pursuant to § 102(g) must provide corroborating evidence of conception, reduction to practice, and reasonable diligence.⁵⁶ Without such corroboration, the inventor's oral testimony cannot alone stand as "clear and convincing" evidence of prior invention.

Rather than requiring that every single aspect of an inventor's testimony must be corroborated, the courts have determined the adequacy of corroboration using a flexible "rule of reason" analysis.⁵⁷ In essence, the "rule of reason" is simply a restatement of the goal of corroboration—to evaluate the credibility of the inventor's testimony by considering all the pertinent evidence.⁵⁸ In *Ethicon, Inc. v. United States*,⁵⁹ the Federal Circuit noted that "[c]orroborating evidence may take many

54. See, e.g., *Price v. Symsek*, 988 F.2d 1187, 1196 (Fed. Cir. 1993) (holding that testimony concerning reasonable diligence must be corroborated); *Lacotte v. Thomas*, 758 F.2d 611, 613 (Fed. Cir. 1985) (holding that testimony concerning actual reduction to practice must be corroborated); *Mergenthaler v. Scudder*, 11 App. D.C. 264, 278–79 (D.C. Cir. 1897) (holding that testimony of prior conception must be corroborated).

55. See *supra* note 14.

56. "[A]n inventor's testimony, standing alone, is insufficient to prove conception—some form of corroboration must be shown." *Price*, 988 F.2d at 1194 (citing *Amax Fly Ash Corp. v. United States*, 514 F.2d 1041, 1047 (Ct. Cl. 1975)). See also *Mahurkar v. Bard*, 79 F.3d 1572 (Fed. Cir. 1996) (holding that an inventor's oral testimony of prior conception during a patent infringement suit must be corroborated).

57. See *Coleman v. Dines*, 754 F.2d 353, 360 (Fed. Cir. 1985). See also *Reese v. Hurtz*, 661 F.2d 1222, 1225 (C.C.P.A. 1981) ("In recent years, this court, by adopting a "rule of reason," has eased the requirement of corroboration with respect to the evidence necessary to establish the credibility of the inventor."); *Cooper v. Goldfarb*, 154 F.3d 1321, 1330 (Fed. Cir. 1998) ("[An] actual reduction to practice does not require corroboration for every factual issue contested by the parties.").

58. See *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed. Cir. 1993).

59. 135 F.3d 1456 (Fed. Cir. 1998).

forms. Often, contemporaneous documents prepared by a putative inventor serve to corroborate an inventor's testimony. Circumstantial evidence about the inventive process may also corroborate. Additionally, oral testimony of someone other than the alleged inventor may corroborate."⁶⁰ In practice, the courts have defined a number of factors to consider in assessing whether testimony has been corroborated. For example, if the inventor offered witness testimony for corroboration, then that testimony is reconsidered by the appellate court, which takes the following factors into account: (1) the relationship between the corroborating witness and the alleged prior user; (2) the time period between the trial and the event; (3) the interest of the corroborating witness in the subject matter of the suit; (4) contradiction or impeachment of the witness 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.⁶¹

C. *An Extension of the Corroboration Requirement Beyond § 102(g) Testimony?: Woodland Trust v. Flowertree Nursery, Inc.*

In *Woodland Trust v. Flowertree Nursery, Inc.*,⁶² the Court of Appeals for the Federal Circuit appeared to extend the corroboration requirement and the "rule of reason" to § 102(a) testimony offered to invalidate a patent. The patent at issue was directed to a method of protecting plants from frost damage.⁶³ Hawkins, one of the owners of the defendant Flowertree, testi-

60. *Id.* at 1461 (citations omitted); see also *Cooper v. Goldfarb*, 154 F.3d 1321, 1330 (Fed. Cir. 1998) ("In order to corroborate a reduction to practice, it is not necessary to produce an actual over-the-shoulder observer. Rather, sufficient circumstantial evidence of an independent nature can satisfy the corroboration requirement."); see generally, Lisa A. Dolak, *Patents Without Paper: Proving a Date of Invention With Electronic Evidence*, 36 HOUS. L. REV. 471, 489-511 (1999) (describing types of corroborating evidence presented during patent interference proceedings).

61. See *Price*, 988 F.2d at 1195 n.3 (citing *In re Reuter*, 670 F.2d 1015, 1021 n.9 (C.C.P.A. 1981)).

62. 148 F.3d 1368 (Fed. Cir. 1998).

63. See *id.* at 1368-69.

fied pursuant to § 102(a) that he had publicly used the patented method more than twenty years before the plaintiff's application was filed.⁶⁴ In support of Hawkins's testimony, Flowertree presented witnesses who claimed that they had seen Hawkins use the claimed method, or had used it themselves, many years before the plaintiff filed its patent application.⁶⁵ One of the witnesses was the son of the owner of Flowertree Nursery, Inc.; two others were long-term acquaintances of the owner; the fourth witness was an employee of one of the acquaintances.⁶⁶ At trial, the District Court judge found that the patent was anticipated under § 102(a) based on the testimony of the witnesses.⁶⁷ The District Court judge stated of the witnesses that "each of them impressed me as a credible witness . . . [and] to discredit those witnesses in this case the court would be obliged to conclude that all four were deliberate perjurers."⁶⁸

On appeal, the Federal Circuit acknowledged that, as an appellate body, it was not in the best position to evaluate the credibility of witnesses.⁶⁹ The court then noted that, in disputes over prior invention, it was generally acknowledged that oral evidence must be corroborated using a "rule of reason."⁷⁰ Drawing attention to the fact that the witnesses were either persons interested in the outcome of the litigation or their friends, and that "despite the asserted many years of commercial and public use, . . . [there was an] absence of any physical record to support the oral evidence," the Court concluded that Hawkins's testimony could not be clear and convincing evidence of prior knowledge and use.⁷¹ Without saying so explic-

64. *See id.* at 1369-70.

65. *See id.*

66. *See Woodland*, 148 F.3d at 1369.

67. *See Woodland Trust v. Flowertree Nursery, Inc.*, 982 F. Supp. 478, 480 (M.D. Fla. 1997).

68. *Id.*

69. *See Woodland*, 148 F.3d at 1371.

70. "Throughout the history of the determination of the patent rights, oral testimony by an alleged inventor asserting priority over a patentee's rights is regarded with skepticism, and as a result, such inventor testimony must be supported by some type of corroborating evidence." *Id.* at 1371 (quoting *Price v. Symsek*, 988 F.2d 1187, 1194 (Fed. Cir. 1993)). Note that *Woodland Trust* deals with testimony given for the purposes of a § 102(a) attack on validity, whereas *Price* dealt with a patent interference proceeding under § 102(g).

71. *See Woodland*, 148 F.3d at 1373.

itly, the *Woodland Trust* court appeared to extend the corroboration requirement to cover § 102(a) testimony.

D. Corroboration prior to Thomson v. Quixote

The above discussion reveals that the Federal Circuit, and its predecessor courts of appeal,⁷² generally viewed oral testimony during patent disputes with great skepticism. At least when a witness offers invalidating testimony of prior invention under § 102(g), the courts manifest this skepticism by explicitly requiring independent evidence to corroborate the oral testimony of a party to the litigation.⁷³ Therefore, during a patent infringement trial in front of a jury, the court preferably should instruct the jury that it must not find that party's § 102(g) testimony alone sufficient to satisfy the "clear and convincing" evidence standard: rather, they must find that the testimony was corroborated.⁷⁴ On appeal, the adequacy of corroboration is reviewed taking into account the factors that have been developed to define the "rule of reason" analysis.⁷⁵

Two elements of the requirement for corroboration and the "rule of reason," when applied to patent infringement litigation, give cause for concern. First, it is rather unusual for a factfinder to be told that, as a matter of law, she cannot consider the testimony of a witness—no matter how credible that witness may appear—to be sufficient to satisfy an evidentiary burden. Like all bright-line rules, the per se rule for corroboration has as its attributes the ease of application and the certainty that it provides to parties involved in patent litigation.⁷⁶

72. The United States Court of Appeals for the Federal Circuit was created in 1982. See 28 U.S.C. § 1295(a) (1994).

73. See, e.g., *Woodland*, 148 F.3d at 1368.

74. But see *New Idea Farm Corp. v. Sperry Corp.*, 916 F.2d 1561 (Fed. Cir. 1990). In *New Idea*, the Federal Circuit held that failure to explicitly instruct the jury that it must find an inventor's testimony on conception to be corroborated was not an error requiring a new trial. Instead, the Court found that instructing the jury to "consider testimony or other pieces of evidence in light of all the other pieces of evidence and to seek clear and convincing evidence of conception" was adequate. *Id.* at 1567.

75. See *supra* Part II.B.

76. See *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 ("While perhaps prophylactic in its application given the unique abilities of the trial court judges and juries to assess credibility, the rule provides a bright line for both district courts and the [US]PTO to follow in addressing the difficult issues related to invention dates.").

These attributes come at the expense of holding that some credible witness testimony will be insufficient to prove invalidity. However, given the unique problems presented by patent infringement litigation—*e.g.*, the temptation to “remember” favorable facts to protect a patent or invalidate an adversary’s patent and the proof problems posed by the “mental” nature of the conception process—the requirement for corroboration seems sensible.⁷⁷

Secondly, and perhaps more problematically, these cases illustrate rare examples where an appellate body independently weighs evidence and considers the credibility of the witness. Axiomatically, weighing evidence and considering the credibility of witnesses is the function of the factfinder in the trial court. The factfinder has the chance to see the witnesses and hear how they respond to examination, whereas an appellate court deals with a paper record. However, acting under the guise of the “rule of reason,” the Federal Circuit in *Woodland Trust* reversed a judgment that depended on purely oral testimony. In *Woodland Trust*, the District Court found the oral testimony of the owner of the defendant company adequately corroborated by the testimony of four witnesses.⁷⁸ However, the Federal Circuit reversed the trial court’s judgment because it was concerned about the credibility of the witnesses.⁷⁹ Although *Woodland Trust* did not explicitly extend the corroboration requirement to § 102(a) testimony, it demonstrates that the Federal Circuit strongly disfavored the use of corroborating oral testimony, despite pronouncements to the contrary in *Ethicon, Inc. v. United States Surgical Corp.*⁸⁰ It was against this backdrop that the Federal Circuit in 1999 approached *Thomson S.A. v. Quixote Corp.*⁸¹

III. THE MOVE FROM A PER SE RULE TO A MORE FLEXIBLE STANDARD

Given the apparent acceptance of what seemed to be an across the board requirement for corroboration of oral § 102(g) testimony, the Federal Circuit’s opinion in *Thomson S.A. v.*

77. See *supra* Part III.A.1.

78. See *Woodland*, 982 F. Supp. at 480.

79. See *Woodland*, 148 F.3d at 1370, 1373.

80. See 135 F.3d 1456, 1461 (Fed. Cir. 1998).

81. 166 F.3d 1172 (Fed. Cir. 1999), *cert denied*, 119 S. Ct. 2395 (1999).

Quixote Corp. came as somewhat of a surprise.⁸² In a brief four-page opinion, the Federal Circuit appeared to return to the factfinder some discretion for assessing the credibility of § 102(g) witnesses in certain limited circumstances, without requiring corroboration of testimony.

A. *Prior Proceedings in Thomson S.A. v. Quixote Corp.*

Thomson S.A. was the assignee of a number of patents directed towards compact discs ("CDs") and other optical storage media.⁸³ Thomson sued Quixote Corporation, a manufacturer of CDs, for infringement of these patents.⁸⁴ Quixote, in an attempt to have the claims held invalid, alleged pursuant to § 102(g), that the claimed invention was anticipated by the prior invention of a non-party, MCA Discovision, Inc.⁸⁵ Specifically, Quixote claimed that a laser videodisc system was developed by engineers at MCA prior to August 25, 1972. MCA had never filed a patent application for this invention.⁸⁶ To support these allegations, Quixote provided as witnesses two engineers from MCA, Wilkinson and Canino, who had worked on the allegedly anticipatory device.⁸⁷ Quixote also provided other evidence comprising an expert's report and deposition testimony, expert exhibits, and MCA documents that had been reviewed by the expert.⁸⁸ The jury at trial found that Quixote had indeed infringed Thomson's patent, but then found that the patent was invalid because each of the claim limitations was anticipated by the MCA invention.⁸⁹ Hence, Quixote was not liable for patent infringement.⁹⁰

Thomson moved for judgment as a matter of law on the grounds that there was insufficient evidence to support the jury verdict of anticipation by the MCA device.⁹¹ The Dis-

82. *Id.*

83. *See id.* at 1173.

84. *See Thomson S.A. v. Quixote Corp.*, 979 F. Supp. 286, 288 (Del. 1997).

85. *See id.* at 288.

86. *See Thomson*, 166 F.3d at 1173.

87. *See Thomson*, 979 F.Supp. at 288.

88. *See id.*

89. *See id.* at 287.

90. *See id.*

91. *See id.* at 291 & n.6. In granting a motion for judgment as a matter of law, a court must find that "there is no legally sufficient evidentiary basis for a

trict Court denied the motion, stating that there was substantial evidence—in the form of the MCA engineers' testimony, an expert's report and deposition testimony, and MCA documents—from which a jury could reasonably have decided that Thomson's device was anticipated by MCA's.⁹²

B. The Federal Circuit's Opinion in Thomson S.A. v. Quixote Corp.

Thomson appealed the denial of its motion for judgment as a matter of law.⁹³ In its appeal, Thomson claimed that the jury verdict was based solely on the testimony of Wilkinson and Canino, and that the uncorroborated testimony of inventors is insufficient as a matter of law to invalidate under § 102(g).⁹⁴ Given the case history, it must have seemed certain to Thomson that the Federal Circuit would hold in its favor. However, a panel of the Federal Circuit assumed an activist position on the matter. The Court accepted for the purposes of the appeal that the jury verdict was based solely on witness testimony; the court also assumed that the witnesses were actual inventors, rather than just peripheral participants in the development of the MCA laser videodisc system.⁹⁵ These assumptions would seem to place the case squarely in the category of cases, along with *Price* and *Mahurkar*,⁹⁶ where corroboration of an inventor's testimony is explicitly required. Instead, the Court noted that the cases in which they had explicitly held that inventor testimony must be corroborated involved inventors who were

reasonable jury to find for that party on that issue." *Johns Hopkins Univ. v. Cell-Pro, Inc.*, 152 F.3d 1342,1353 (Fed. Cir. 1998).

92. *See Thomson*, 979 F. Supp at 299.

93. *See Thomson*, 166 F.3d at 1174.

94. *See id.* Thomson's argument apparently depended on their assumption that the testimony of each joint inventor could not corroborate the testimony of the other.

95. *See id.* at 1175. The District Court at trial concluded that only an inventor's testimony must be corroborated, and that Wilkinson and Canino were not the inventors of the MCA system. Instead, Wilkinson and Canino were among two dozen MCA engineers who had participated in the development of the MCA system. Hence, the District Court did not require corroboration of their testimony. *See Thomson*, 979 F. Supp. at 299-300 (citing *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed. Cir. 1993)).

96. *See Price v. Symsek*, 988 F.2d 1187 (Fed. Cir. 1993); *Mahurkar v. Bard*, 79 F.3d 1572 (Fed. Cir. 1996).

parties to the litigation.⁹⁷ Since Wilkinson and Canino were inventors who were not parties to the litigation, this was a situation in which the court had never explicitly held that corroboration was required.⁹⁸

The Court then remarked that the per se rule of corroboration appeared in cases in which testimony was offered by inventors *interested* in the outcome of the litigation.⁹⁹ Such interested inventors might then be tempted to “remember” facts that would help resolve the litigation in their favor.¹⁰⁰ Thus, the Court found that corroboration is only needed to act as a “counterbalance” for any self-interest in the outcome of the litigation that the testifying non-party inventor might have.¹⁰¹ In the Court’s opinion, adequate protection against mistaken findings of invalidity is provided by the Federal Rules of Civil Procedure and the Federal Rules of Evidence, and also by the rigorous “clear and convincing” evidentiary standard.¹⁰² Accordingly, the Court moved away from a rigid corroboration rule, and defined a more relaxed standard for inventor testimony where:

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, employee of or assignor to a named party, or is otherwise in a position where he or she stands to directly or substantially gain by his or her invention being found to have priority over the patent claims at issue.¹⁰³

Because Wilkinson and Canino were non-party inventors who testified about an invention that was never patented, the Court found that they were not the kind of interested witnesses

97. See 166 F.3d at 1175. The court held that *Woodland Trust* fit this pattern of cases, because it considered the defendant—who testified under § 102(a) concerning his prior use and knowledge of the claimed invention—to be an inventor. 166 F.3d 1175 n.4 (citing *Woodland Trust*, 148 F.3d at 1369–70).

98. See 166 F.3d at 1176 & n.5.

99. See *id.* at 1176 (citing *Barbed Wire Patent*, 143 U.S. at 284–85; *Price*, 988 F.2d at 1194). Note, that the court is mistaken in citing to *Barbed Wire Patent* for this proposition, because that case involved the testimony of *uninterested* witnesses. See *supra* Part II.A.1.

100. See 166 F.3d at 1176.

101. See *id.*

102. See *id.*

103. *Id.*

whose testimony must be treated with skepticism.¹⁰⁴ In the Court's opinion, the fact that they were now employed by companies that supplied goods and services to the defendant Quixote Corp. did not give them a high enough level of self-interest in the outcome of the litigation to warrant invoking corroboration of their testimony under this new standard.¹⁰⁵ Hence, the Court ruled that the jury verdict of invalidity could rest solely on the uncorroborated testimony of Wilkinson and Canino.¹⁰⁶

C. *The "Counterbalancing" Standard Announced by the Federal Circuit*

Thomson established a more relaxed standard for the evaluation of witness testimony, at least when that witness was claiming to be a non-party inventor of the claimed invention for the purposes of a § 102(g) attack on validity.¹⁰⁷ Rather than always requiring corroboration of an inventor's testimony, *Thomson* suggests that a court should determine the level of the witness's interest in the outcome of the litigation on an ad hoc basis. If the court finds the witness to be uninterested, then the factfinder is permitted to consider that person's testimony, in and of itself, as sufficient to satisfy the "clear and convincing" evidentiary standard.¹⁰⁸

In announcing this new corroboration standard, the *Thomson* court provided little guidance for a trial court endeavoring to apply it. The court defined three classes of testifying inventors whose testimony must be corroborated: (1) inventors who are named parties; (2) inventors who are employees or assignors of a named party; and (3) inventors who stand to gain "directly and substantially" from establishing their priority of invention.¹⁰⁹ The only guidance that the *Thomson* court provided for the application of the third class was that employees of a business that supplies the defendant with goods or services do not have the requisite level of interest in the litigation.¹¹⁰

104. *See id.*

105. *See id.*

106. *See id.*

107. *See id.*

108. *See id.*

109. *See id.*

110. *See id.*

IV. *FINNIGAN CORP. V. UNITED STATES INTERNATIONAL TRADE COMMISSION: THE REVIVAL AND EXPANSION OF THE PER SE RULE OF CORROBORATION*

A mere five months after *Thomson* was decided, a different panel of the Federal Circuit issued a conflicting opinion in *Finnigan Corp. v. United States International Trade Commission*.¹¹¹ This panel—sharing only one judge with the *Thomson* court¹¹²—made it clear that there are no circumstances under which uncorroborated testimony is sufficient to provide clear and convincing evidence of patent invalidity.¹¹³

A. *Prior Proceedings*

The patent at issue in *Finnigan* was concerned with a technique known as mass spectrometry.¹¹⁴ This technique is used in analytical chemistry to give information about the molecular composition of unknown samples.¹¹⁵ Finnigan believed that the American subsidiary of a German corporation, Bruker-Franzen Analytik GmbH, was importing an infringing device into the United States, and filed a complaint with the United States International Trade Commission.¹¹⁶ The complaint alleged that Bruker was in violation of § 337 of the Tariff Act of 1930, which prohibits the importation of foreign goods that infringe a valid United States patent.¹¹⁷ An Administrative Law Judge (“ALJ”) determined that the Bruker system did not infringe Finnigan’s patent claims; moreover, the ALJ also found

111. 180 F.3d 1354 (Fed. Cir. 1999).

112. The judge who sat on both pannels was Judge Giles Rich, who passed away on the day that the *Finnigan* opinion was issued by the Federal Circuit. See *Judge Giles Rich Dies*, THE RECORDER, Jul. 1999, at S5.

113. See *id.* at 1369.

114. See *id.* at 1356.

115. See *Academic Press Dictionary of Science and Technology* (visited Sept. 24, 2000) < <http://www.harcourt.com/dictionary/def/6/2/3/9/6239100.html>>.

116. See *id.* at 1359–60.

117. See 19 U.S.C. § 1337(a)(1)(B) (1994). The Tariff Act provides that alleged violations shall be investigated by the United States International Trade Commission (“USITC”). See *id.* § 1337(b). Following investigation, the USITC holds a hearing at which both parties may present evidence before an Administrative Law Judge (“ALJ”). See *id.* § 1337(c). If the USITC determines that there is a violation of the Tariff Act, it can order that the infringing articles be excluded from entry into the United States. See *id.* § 1337(d). The determinations of the USITC may be appealed to the United States Court of Appeals for the Federal Circuit. See *id.* § 1337(c).

that a number of the claims were anticipated and hence invalid under § 102(b).¹¹⁸ The ALJ based the determination of § 102(b) invalidity primarily on the testimony of a witness, Keith Jefferts, who testified that he had used the claimed invention in public in the United States before Finnigan had.¹¹⁹ The ALJ “noted that Jefferts’s testimony did ‘not appear to be open to any serious question’ because he was not an interested party,” and also that Jefferts’s use was sufficiently “public” to satisfy § 102(b).¹²⁰

The situation in *Finnigan* appears directly analogous to that encountered in *Thomson*, the only difference being that Jefferts testified for the purposes of § 102(b) invalidity,¹²¹ whereas the witnesses in *Thomson* testified for the purposes of § 102(g) invalidity.¹²² Applying the *Thomson* standard, it would seem that Jefferts’s uncorroborated testimony could be sufficient to serve as “clear and convincing” evidence of prior public use, because Jefferts was not interested in the outcome of the litigation. However, as described below, Federal Circuit used this case effectively to reject the *Thomson* standard.

B. *The Federal Circuit’s Opinion*

Finnigan appealed to the Federal Circuit,¹²³ arguing that Jefferts’s uncorroborated testimony about prior public use could not as a matter of law rise to the standard of “clear and convincing” evidence.¹²⁴ In consideration of this point, the Federal Circuit did not begin with a discussion of *Thomson*, but instead began with a detailed analysis of many of the key corroboration cases.¹²⁵ The court noted that it had, in the past,

118. See *In re Certain Ion Trap Mass Spectrometers and Components Thereof*, 63 Fed. Reg. 19,946 (Dep’t Commerce 1998) (final determination).

119. See *Finnigan*, 180 F.3d at 1361 (citing *In re Certain Ion Trap Mass Spectrometers and Components Thereof*, USITC Inv. No. 337-TA-393, at 74 (Dep’t Commerce Feb. 25, 1998)).

120. *Id.* (quoting *In re Certain Ion Trap Mass Spectrometers and Components Thereof*, USITC Inv. No. 337-TA-393, at 74 (Dep’t Commerce Feb. 25, 1998)).

121. See *id.* at 1366.

122. See *Thomson*, 166 F.3d at 1174.

123. See *supra* note 116.

124. See *Finnigan*, 180 F.3d at 1364.

125. See *id.* at 1366. The analysis included discussions of *The Barbed Wire Patent Case*, 143 U.S. 275 (1892), *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45 (1923), and *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368 (Fed. Cir. 1998).

required corroboration of oral testimony proving prior invention under § 102(g) and under other subsections of § 102 as well.¹²⁶ With respect to the interest of the witness in the outcome of the trial, the court stated that "the need for corroboration exists regardless [of] whether the party testifying is interested."¹²⁷ In support of this point, the court noted that the twenty-four witnesses in the *The Barbed Wire Patent Case* were uninterested in the outcome of that case, and yet the Supreme Court had required that their testimony be corroborated.¹²⁸

The court then addressed the acceptable level of interest of an inventor who is not a party to the litigation.¹²⁹ In a psychological aside, the court stated that non-party inventors who claim priority "can be expected to derive a sense of professional or personnel [*sic*] accomplishment in being the first in the field," even when they are not claiming an entitlement to the patent.¹³⁰ According to the court, such witnesses therefore can have sufficient interest in the outcome of the litigation to trigger the corroboration rule.¹³¹ In essence, this would seem to give *all* testifying inventors an interest in the outcome of the litigation sufficient to warrant corroboration. Rather than just restricting this requirement for corroboration to testifying inventors, the court concluded that "corroboration is required of any witness whose testimony alone is asserted to invalidate a patent, regardless of his or her level of interest."¹³² Hence, the court found that Jefferts's uncorroborated testimony of public use was "insufficient as a matter of law to establish invalidity of the patent."¹³³

V. THE CONFLICT BETWEEN *FINNIGAN* AND *THOMSON*

Finnigan flatly contradicts the opinion of the *Thomson* court. In *Thomson*, the Federal Circuit held that corroboration

126. See *id.* at 1367.

127. *Id.*

128. See *id.* at 1367-68 (citing *The Barbed Wire Patent Case*, 143 U.S. 275 (1892)).

129. See *Finnigan*, 180 F.3d at 1368.

130. *Id.*

131. See *id.*

132. *Id.* at 1369.

133. *Id.* at 1370.

is only needed to "counterbalance" the interest that the witness may have in the outcome of the litigation.¹³⁴ In that case, the court assumed that the witnesses were inventors claiming priority under § 102(g), but that they did not have the requisite self-interest in the outcome of the litigation to warrant corroboration.¹³⁵ By contrast, *Finnigan* says that such witnesses may be interested in the outcome of the litigation merely because of the sense of achievement they may gain from being recognized as "being the first in the field."¹³⁶ In any event, *Finnigan* makes it expressly clear that corroboration of witness testimony is always required.

The *Finnigan* court confronted this conflict head on, asserting that *Thomson* "is not to the contrary."¹³⁷ The court's reasoning is wholly unpersuasive. In particular, the *Finnigan* panel claimed that *Thomson* was really an opinion about the sufficiency of corroborating evidence, rather than the actual requirement for corroboration, because in *Thomson* there was other evidence of the prior invention of the claimed device by the non-party MCA.¹³⁸ Thus, the true *Thomson* holding, according to the *Finnigan* court, is that in evaluating the sufficiency of corroboration of Wilkinson's and Canino's testimony under the rule of reason, their lack of interest in the outcome of the litigation was a relevant factor.¹³⁹ This interpretation of *Thomson* simply cannot be squared with the language of that opinion. In particular, this analysis ignores the fact that the *Thomson* court explicitly assumed, for the purposes of the appeal, that the jury relied *exclusively* on the testimony of Wilkinson and Canino in finding invalidity.¹⁴⁰ *Thomson* was thus concerned with the sole question of whether non-party witness testimony, standing alone, must be corroborated. Hence, *Thomson* and *Finnigan* appear to be truly irreconcilable.

134. See *Thomson S.A.*, 166 F.3d at 1176.

135. See *id.*

136. *Finnigan*, 180 F.3d at 1368.

137. *Id.*

138. See *Finnigan*, 180 F.3d. at 1368-69.

139. See *id.*

140. See *Thomson S.A.*, 166 F.3d at 1174-75 ("Even if we accept Thomson's first assertion, [that the jury verdict rests upon mere testimonial evidence] and further assume that the MCA employees were acting as inventors in the laser videodisc project . . . this case does not present circumstances in which there is a need for corroboration . . .").

Finnigan appears to have been intended to reject the nascent standard enunciated in *Thomson*. Indeed, a recent Federal Circuit case cites *Finnigan* as standing for the proposition that witness testimony offered to invalidate a patent must always be corroborated, with no mention of the "counterbalancing" standard of *Thomson*.¹⁴¹

Furthermore, *Finnigan* goes beyond rejecting the *Thomson* standard. The pre-*Thomson* position was that party-inventor testimony provided for the purposes of attacking a patent's validity under § 102(g) must be corroborated.¹⁴² However, the Federal Circuit stopped short of expressly saying that all witness testimony, standing alone, is insufficient as a matter of law to provide clear and convincing evidence of patent invalidity. For example, *Woodland Trust* appeared to extend the corroboration requirement to § 102(a), but did not expressly so hold.¹⁴³ *Finnigan* removes any last doubts about the requirement for corroboration. *Finnigan* says that whenever a witness's testimony is given to invalidate a patent under § 102(a), § 102(b), or § 102(g), that testimony must be corroborated.¹⁴⁴ The requirement applies irrespective of that witness's interest in the outcome of the litigation.

At least in the case of inventor testimony offered for the purpose of proving prior invention under § 102(g), the rule seems well-suited to the traditional practices of inventors. Inventors typically keep notebooks detailing each day's experi-

141. See *Berry Sterling Corp. v. Pescor Plastics, Inc.*, No. 98-1381, 1999 WL 674514, at *4 (Fed. Cir. Aug. 30, 1999). The District Courts have followed suit. See, e.g., *K & K Jump Start/Chargers, Inc. v. Schumacher Electric Corp.*, 82 F. Supp. 2d 1012, 1018 n.7 (W.D. Mo. 2000) (stating that although a witness did not appear to have the requisite self-interest in the outcome of litigation under the *Thomson* standard to require corroboration, in light of *Finnigan* "the safer course at this stage is for the court to operate under the assumption that the corroboration requirement still exists.").

142. See, e.g., *Price v. Symsek*, 988 F.2d 1187 (Fed. Cir. 1994) (holding that party-inventor's testimony regarding prior conception must be corroborated).

143. See *supra* Part II.C.

144. See *Finnigan*, 180 F.3d at 1367. The court stated:

No principled reason appears for applying a different rule when other subsections of § 102 are implicated: a witness's uncorroborated testimony is equally suspect as clear and convincing evidence if he testifies concerning the 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 his patent (§ 102(b)), or invention before the patentee (§ 102(g)).

Id.

mental activity, and then have someone sign and witness the notebook whenever they wish to mark a particular event.¹⁴⁵ Such witnessed notebooks have been held to corroborate adequately an inventor's testimony regarding prior invention.¹⁴⁶ Given the ease with which such corroborating evidence can be generated, a court is justified in being highly skeptical of an inventor who can only provide oral testimony to establish her date of invention. In this sense, the *Thomson* case seems wrongly decided as the inventors who testified were unable to provide any such evidence other than their testimony.¹⁴⁷

Moreover, non-party inventors frequently will have an interest in the outcome of litigation that may tempt them to "remember" facts favorable to maintaining their priority. For example, if an inventor assigned an invention to the defendant in a patent infringement action, then that inventor has a direct financial interest in maintaining his priority of invention. Even when there is no connection between the defendant and the testifying inventor, the *Finnigan* court's "reputational interest" would seem to be a valid concern.¹⁴⁸

However, when the corroboration requirement is applied to witness testimony offered to prove anticipation through prior public use or through application of the on sale bar provided by § 102(b), the blanket prohibition of uncorroborated testimony seems less appropriate. Circumstances can be envisioned where there genuinely may be no independent evidence of an anticipatory invention. For example, a witness may testify for the purposes of establishing invalidity under Section 102(b) that he saw the plaintiff's article on sale more than one year

145. Author's personal experience.

146. See, e.g., *Kridl v. McCormick*, 105 F.3d 1446, 1450-51 (Fed. Cir. 1997). See generally Lisa A. Dolak, *Patents Without Paper: Proving a Date of Invention With Electronic Evidence*, 36 HOUS. L. REV. 471 (1999) (describing types of corroborating evidence presented during patent interference proceedings and the particular difficulties presented by the use of "electronic" notebooks by inventors). A number of publications and Internet sites provide guidelines for inventors in keeping documentary evidence of invention sufficient to prove a date of invention. See *id.*

147. Note, however, that the inventors in *Thomson* were testifying about their activities with their former employer. See *Thomson S.A. v. Quixote Corp.*, 979 F.Supp. 286, 288-90 (Del. 1997). In this case, the inventors may no longer have had access to the corporate records that would have provided corroborative evidence of their testimony.

148. See 180 F.3d at 1368.

before the plaintiff applied for a patent.¹⁴⁹ Even if such a witness has nothing whatsoever to gain from the defendant prevailing, and no matter how credible the factfinder may find that witness, under *Finnigan* his testimony standing alone is insufficient as a matter of law to invoke the on sale bar. In such cases, the comparatively relaxed standard of *Thomson* would seem suitable. If the court found the witness uninterested in the outcome of the litigation, the jury would be permitted to allow his testimony to stand alone as clear and convincing evidence of invalidity under § 102(b).

Despite pronouncements that witness testimony can be corroborated by the testimony of other witnesses,¹⁵⁰ the Federal Circuit seems strongly to disregard the worth of such corroborating oral testimony. For example, the Federal Circuit in *Woodland Trust*, under the guise of the rule of reason, reversed a finding of invalidity because of a lack of documentary evidence, despite the testimony of witnesses who arguably corroborated one another.¹⁵¹ In doing so, the Federal Circuit appears to be usurping a role that is expressly reserved for a trial court: determining the weight of evidence and the credibility of witnesses.

One likely reason for the Federal Circuit's rejection of the *Thomson* standard was its concern that it added yet another layer of complexity to patent disputes. Applying the *Thomson* standard would require a judge to determine the witness's level of self-interest in the outcome of the litigation, and to balance that self-interest against concerns of inaccurate testimony. This would detract considerably from the benefits that a bright-line rule of corroboration brings to patent dispute proceedings.¹⁵²

The expansion of the corroboration requirement by the *Finnigan* court to cover all invalidating activities will make it more difficult for an alleged infringer to use the defense of § 102 invalidity. It has been suggested by some commentators that in doing so, *Finnigan* is consistent with a general trend in the Federal Circuit to ameliorate the harsh effects on patentees

149. See *supra* Part II.B.

150. See *Ethicon, Inc. v. United States*, 135 F.3d 1456, 1461 (Fed. Cir. 1998).

151. See *Woodland Trust*, 148 F.3d at 1371, 1373.

152. See *supra* Part II.D. & n. 76.

of the public use and on sale bars.¹⁵³ In particular, *Finnigan* may have been intended to limit the harsh effects of the Supreme Court's on sale bar decision in *Pfaff v. Wells Electronics, Inc.*¹⁵⁴

The on sale bar has long been thought of as a particularly unfair "trap" for independent, uncounseled inventors, and as the "last refuge of the desperate infringer."¹⁵⁵ In determining whether the bar operated, the Federal Circuit applied a multi-factor "totality of the circumstances" test.¹⁵⁶ Application of this test required a court to consider all of the circumstances of the sale or offer to sell, including both the nature and developmental stage of the invention.¹⁵⁷ Then, these factors were to be weighed against the policies represented by § 102(b).¹⁵⁸ The "totality of the circumstances" test was adopted "to soften the harsh effects of application of the on sale and public use bars."¹⁵⁹ However, in *Pfaff v. Wells Electronics, Inc.*, the Supreme Court rejected the "totality of the circumstances" test as too vague, and adopted a "ready for patenting" test.¹⁶⁰ This new test has been criticized as less favorable to inventors than the "substantially complete" test.¹⁶¹ In its application by the District Courts, the *Pfaff* test has led to an increase in the number of findings of patent invalidity.¹⁶²

Perhaps the Federal Circuit, troubled at the increase in findings of patent invalidity post-*Pfaff*, used *Finnigan* as a convenient opportunity to restrict the application of the on sale bar. By expanding the requirements for corroboration, *Finnigan* restricts the application of the *Pfaff* on sale bar test to cases where the testimony concerning the on sale activity is

153. See William C. Rooklidge & Russell B. Hill, *The Law of Unintended Consequences: The On Sale Bar After Pfaff v. Wells Electronics*, 82 J. PAT & TRADEMARK OFF. SOC'Y 163 (2000). The authors note that "the courts, including the Federal Circuit, have bent over backwards to restrict application of the [public use and on sale] bars to the most egregious of situations." *Id.* at 176.

154. See *Pfaff v. Wells Electronics, Inc.*, 525 U.S. 55 (1998); see also *supra* note 26.

155. See Rooklidge & Hill, *supra* note 153, at 176.

156. See *Micro Chemical, Inc. v. Great Plains Chemical Co.*, 103 F.3d 1538, 1544 (Fed. Cir. 1997).

157. See *id.*

158. See *id.*

159. See Rooklidge & Hill, *supra* note 153, at 176.

160. See *Pfaff*, 525 U.S. at 67.

161. See Rooklidge & Hill, *supra* note 153, at 167.

162. See *id.*

corroborated. In doing so, the Federal Circuit may have concluded that the inevitable rejection of its *Thomson* standard was the necessary price to pay to protect patentees from increasingly easy applications of the on sale bar.

CONCLUSION

The Federal Circuit was created in order to establish uniformity in the decision of patent disputes.¹⁶³ However, as this casenote suggests, considerable diversity of opinion exists, even within this single circuit. With its opinion in *Thomson*, the Federal Circuit looked as though it was ready to relax its requirements for corroboration. But *Finnigan* seems instead to have settled upon an unambiguous and simple statement of the corroboration requirement that admits no exceptions. *Finnigan* has broadened the corroboration requirement beyond its original bounds, perhaps indicating a distrust of the ability of juries to evaluate the credibility of witnesses before them. Alternatively, *Finnigan* may represent an effort of the Federal Circuit to protect inventors from the increasingly harsh effects of § 102 bars. Whatever the motivation behind *Finnigan*, the lesson seems clear: a defendant in a patent infringement trial will need much more than oral testimony in order to prove that the asserted patent is invalid.

163. See 28 U.S.C. § 1295(a) (1994). See also Jack Q. Lever, *The New Court of Appeals for the Federal Circuit, Part I*, 64 J. PAT. OFF. SOC'Y 178 (1982); Jack Q. Lever, *The New Court of Appeals for the Federal Circuit, Part II (Conclusion)*, 64 J. PAT. OFF. SOC'Y 243 (1982).

