

THE FUTURE OF THE CORROBORATION REQUIREMENT IN PATENT LAW: WHY A CLEAR, STRICT STANDARD BENEFITS ALL

MIKE R. TURNER*

In patent law, when certain forms of oral testimony are provided by a litigant to prove inventorship or anticipation, that testimony must be corroborated by other evidence. However, determining whether and to what extent corroboration is necessary has been made extraordinarily difficult by recent Federal Circuit jurisprudence. This note examines the current ambiguity that lies in the Federal Circuit's interpretation of the corroboration requirement and recommends adoption of a clearer, stricter standard. The author begins by introducing the corroboration requirement, its historical development, and its applications in patent law. The author outlines several recent Federal Circuit decisions that have blurred the lines of the corroboration standard to the extent that patent litigants cannot accurately predict what form of corroboration, if any, will be needed to support the admission of certain evidence. To remedy this ambiguity, the author recommends that the Federal Circuit adopt a clear and strict standard requiring oral testimony intended to invalidate a patent based on prior use or invention be corroborated by contemporary physical evidence. By adopting the author's proposal, the corroboration requirement would allow litigants to more accurately weigh the adequacy of their evidence prior to entering into costly patent litigation. Moreover, a clear and strict corroboration standard would serve the interests of the judiciary and align with both legislative intent and Supreme Court precedent.

I. INTRODUCTION

In all areas of law, the rules of evidence work to ensure that testimony has some modicum of reliability if it is to be considered by a jury. However, the fear of false or inaccurate testimony is especially acute in

* J.D. 2008, University of Illinois College of Law; B.S. Mechanical Engineering, 1996, United States Military Academy; future Associate, Neal Gerber & Eisenberg, Chicago, Ill. I would like to acknowledge that this work was in fact a team effort. I spent the hours, days, and weeks in the library or hidden away in our study doing the research, writing, editing, and reviewing necessary to complete the paper. With nary a complaint, my wife Kelly took care of our little daughters allowing me the time to do so. Without question she had the harder portion of work. Thank you Kelly—I would be lost without you!

patent litigation, where cases typically last for years and have tremendous financial ramifications for the parties involved.¹ The Supreme Court has long since established a corroboration requirement for oral testimony used as evidence to invalidate a patent.² While initially a strict standard, it has been clouded and reduced by a number of Federal Circuit decisions.³ Some holdings have found sufficient corroboration in testimony of interested parties with little or no contemporaneous evidence in support, while others have rejected what seem to be diligent records supporting neutral party testimony.⁴

Patent cases are notorious for being very costly and lengthy. The ability to fully assess the adequacy of their evidence prior to leaping blindly into patent litigation would be of great benefit to potential litigants. Unfortunately, interpreting what courts require to satisfy the corroboration requirement as it stands today can be a guessing game. Part II of this note begins with an introduction to the corroboration requirement and its applications in patent law. This is followed by a history of the changes to the requirement over time, specifically highlighting the discrepancies created by modern case law.

Part III begins its analysis of the present state of the corroboration requirement by reviewing several recent Federal Circuit opinions on corroboration. This Part points out discrepancies in these cases and provides guidance as to what level of resistance litigants might expect given their supporting evidence. Specific attention is given to the Federal Circuit's different assessments of contemporary evidence, circumstantial evidence, and both third-party and interested-party testimony. Next, Part III discusses the burden of production inventors face, and how a strict corroboration requirement might affect their ability to create and retain the evidence needed to meet that burden. The note explores and discredits the arguments for a softer corroboration standard and analyzes the policy aspects of a stricter standard. Finally, Part III evaluates Congressional proposals for changes to the Patent Act and contemplates how these changes would affect applications of the corroboration requirement.

Ultimately, Part IV advocates that the Federal Circuit adopt a clear and strict corroboration standard requiring inventors and challengers to produce contemporary physical evidence in order to corroborate oral testimony offered to invalidate a patent based on prior invention or use. Such a rule would not only provide inventors with clear direction, it would align the corroboration standard with legislative intent, serve the interests of the judiciary, and comport with Supreme Court precedent.

1. See ADAM B. JAFFE & JOSH LERNER, *INNOVATION AND ITS DISCONTENTS: HOW OUR BROKEN PATENT SYSTEM IS ENDANGERING INNOVATION AND PROGRESS, AND WHAT TO DO ABOUT IT* 6–15 (2004).

2. See discussion *infra* Part II.C.1.

3. See discussion *infra* Part II.C.2.

4. See discussion *infra* Part II.C.3.

II. BACKGROUND

To fully appreciate the problem caused by ambiguities in the Federal Circuit corroboration case law, an introduction to the requirement and its applications in patent law is required. Additionally, a historical perspective of the requirement's origins is necessary to understand the discrepancies between Supreme Court precedent and the state of the law today.

A. *The Need for a Corroboration Requirement in Patent Law*

Law, in general, requires different levels of evidence depending on what claims are at issue. The three generally recognized standards of proof are "preponderance of the evidence," applied in most civil cases; "clear and convincing evidence," saved for particularly important interests in civil cases; and "beyond a reasonable doubt," generally reserved for criminal cases.⁵ To meet the preponderance burden, parties need only show that their claim is more likely than not to have occurred,⁶ whereas they must prove their claim to a near certainty to prove it beyond a reasonable doubt.⁷ The clear and convincing standard lies somewhere in the middle.⁸

Patent law is a civil matter, and, thus, the preponderance of the evidence burden applies to most of its claims and defenses.⁹ However, Congress has established that an issued patent is presumed to be valid,¹⁰ and courts have responded by requiring more than a mere preponderance to overcome this presumption.¹¹ Accordingly, the Federal Circuit requires clear and convincing evidence to invalidate an issued patent.¹² With respect to the evidence required to meet this burden, courts have long noted that fact testimony in patent cases, often requiring the conjuring of old memories to help distinguish minute details, is particularly untrustworthy.¹³ Thus, in order to satisfy the higher clear and convincing evi-

5. See *California ex rel. Cooper v. Mitchell Bros.' Santa Ana Theater*, 454 U.S. 90, 93 (1981).

6. See BLACK'S LAW DICTIONARY 1182 (6th ed. 1991).

7. *Id.* at 161.

8. For a general comparison of these three evidentiary burdens, see David W. Okey, Comment, *Issued Patents and the Standard of Proof: Evidence Clear and Convincing or Merely Ponderous?*, 17 J. MARSHALL J. COMPUTER & INFO. L. 557, 568-71 (1999).

9. See, e.g., *Falkner v. Ingles*, 448 F.3d 1357, 1362 (Fed. Cir. 2006) (noting that preponderance of the evidence is the proper burden in determination of enablement); 37 C.F.R. § 1.56(b)(2) (2007) (noting that the PTO uses a preponderance of the evidence standard in determining patentability in light of prior art during prosecution).

10. See 35 U.S.C. § 282 (2000).

11. See *Union Oil Co. v. Atl. Richfield Co.*, 208 F.3d 989, 994-95 (Fed. Cir. 2000).

12. *Id.*

13. See *Deering v. Winona Harvester Works*, 155 U.S. 286, 301 (1894) ("Granting the witnesses to be of the highest character, and never so conscientious in their desire to tell only the truth, the possibility of their being mistaken as to the exact device used, which, though bearing a general resemblance to the one patented, may differ from it in the very particular which makes it patentable, are such as to render oral testimony peculiarly untrustworthy.").

dentiary standard, all courts require some element of corroboration to support an inventor's oral testimony aimed at invalidating a patent.¹⁴

B. Applications of the Corroboration Requirement

As noted above, the clear and convincing evidentiary burden that triggers the corroboration requirement does not apply to all elements of patent law. In fact, there are only three scenarios within patent law where the requirement applies.¹⁵ By far, the heaviest application is in interference actions, also known as priority disputes, initiated under 35 U.S.C. § 102(g).¹⁶ An interference proceeding occurs when two separate inventors seek independent patents on the same invention. It may also occur when one patent has already issued, but another inventor claims rights to the invention the patent describes.¹⁷ Though the corroboration requirement applies in both cases, only the latter case presents a challenge to an issued patent, thus triggering the clear and convincing burden.¹⁸

The second most common application of the corroboration requirement occurs when a challenger tries to directly defeat an issued patent by proving the existence of some invalidating prior art. The challenger may accomplish this by proving that he or she or a third party invented the patented subject matter and publicly used or otherwise disclosed it within the United States prior to the patentee's date of inven-

14. See, e.g., *Price v. Symsek*, 988 F.2d 1187, 1194 (Fed. Cir. 1993) ("Throughout the history of the determination of 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.") (citation omitted). However, the Federal Circuit has stated that it only requires such corroboration when the inventor is a party to the litigation. See *Thomson, S.A. v. Quixote Corp.*, 166 F.3d 1172, 1176 (Fed. Cir. 1999). As discussed *infra*, *Thomson* is not consistent with other Federal Circuit holdings and appears to be an outlier.

15. This is not to suggest that the clear and convincing standard applies only to these three scenarios. Corroboration is required only when the pleadings attempting to invalidate a patent turn on a question of fact. The clear and convincing standard also applies to such pleadings that turn on a question of law, such as a pleading alleging indefiniteness under 35 U.S.C. § 112. See, e.g., *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 1347-48 (Fed. Cir. 2005). Corroboration, however, is irrelevant in such cases.

16. See *Lacks Indus., Inc. v. McKechnie Vehicle Components USA, Inc.*, 322 F.3d 1335, 1349 (Fed. Cir. 2003); see also *AMP, Inc. v. Fujitsu Microelectronics, Inc.*, 853 F. Supp. 808, 821 (M.D. Pa. 1994) ("[V]irtually all of the cases that require corroboration involve inventors attempting to claim an earlier date of conception than the filing date of a patent.").

17. 3A DONALD S. CHISUM, CHISUM ON PATENTS § 10.09[2] (2005); see 35 U.S.C. § 102(g) (2000).

18. When two pending applications are involved, the preponderance burden applies because there is no presumption of patent validity to overcome. See *Brown v. Barbacid (Brown I)*, 276 F.3d 1327, 1332 (Fed. Cir. 2002). However, as noted, the corroboration requirement still must be met. See *id.* at 1335. This seems to weaken the connection between the corroboration requirement and the clear and convincing burden, but it is an isolated scenario. As expected, the requirement is more easily met under the preponderance burden. However, multiple standards of evidence to the corroboration requirement ultimately lead to more confusion. For a discussion of the application of the corroboration requirement to interference actions as well as an analysis of such cases, see Michael F. Ciraolo, *Application of the Corroboration Requirement to Interference Proceedings and Other Sections of 102*, 84 J. PAT. & TRADEMARK OFF. SOC'Y 531 (2002).

tion.¹⁹ This would invalidate the patent under § 102(a).²⁰ The challenger may also succeed by proving that the patented item was offered for sale in the United States or was publicly disclosed anywhere, foreign or domestic, more than one year prior to the patentee's application date.²¹ This would invalidate the patent under § 102(b).²² In either case, the corroboration requirement would apply to the challenger's testimony.²³

The final application of the corroboration requirement is to correct alleged errors of inventorship under 35 U.S.C. § 256.²⁴ This occurs when a person alleges that he or she was a co-inventor but was left off the patent as a named inventor.²⁵ Though this does not affect the validity of the patent, it may have significant repercussions in that it requires the patent rights to be shared.²⁶ These cases do not arise often because usually inventors are included on the patent originally, or, if not, their desire to be included after the fact is not contested. However, when it is contested, testimony from the person claiming to be a co-inventor is subject to the corroboration requirement.²⁷

19. For an example where such a claim was made and issues of corroboration arose, see *Loral Fairchild Corp. v. Matsushita Elec. Indus. Co.*, 266 F.3d 1358 (Fed. Cir. 2001).

20. See 35 U.S.C. § 102(a) (2000).

21. For an example where such a claim was made and issues of corroboration arose, see *Lacks Indus.*, 322 F.3d at 1335. See also *Ciraolo*, *supra* note 18, at 534–35 (discussing how “corroboration has been extended” to 102(a) and 102(b) patentability bars).

22. 35 U.S.C. § 102(b).

23. Defeating a patent via prior art is not limited to §§ 102(a) and 102(b), but that is where almost every case requiring corroboration to substantiate a prior art claim under § 102 occurs. In theory, corroboration could be used to support a claim of abandonment under § 102(c) or a claim that the person purporting to be the inventor did not in fact make the invention under § 102(f). However, an extensive search produced no such cases. Interference actions under § 102(g) have already been discussed and do not involve prior art. The other subsections of § 102 require very specific prior domestic or foreign patent office filings. Records of these filings either exist or do not, so there is no need for corroboration. See 35 U.S.C. § 102(d)–(e). Finally, a few cases suggest application of the corroboration rule to allegations of obviousness under 35 U.S.C. § 103. However, a § 103 claim requires one or more elements of prior art as defined in § 102 in light of which the challenged invention is alleged to be obvious. See 35 U.S.C. § 103(a) (2000). Thus, the cases suggesting to apply corroboration to a § 103 claim are actually applying it to substantiate the underlying § 102 prior art. See, e.g., *Dow Chem. Co. v. Mee Indus., Inc.*, 341 F.3d 1370, 1378 (Fed. Cir. 2003) (applying the corroboration rule to reject an obviousness claim when the earlier § 102(b) prior art could not be substantiated); *Hewlett-Packard Co. v. Mustek Sys., Inc.*, 340 F.3d 1314, 1325–26 (Fed. Cir. 2003) (applying the corroboration rule to evaluate the legitimacy of § 102(a) prior art used by a jury to determine whether the subject invention was obvious).

24. 35 U.S.C. § 256 (2000); see *Hess v. Advanced Cardiovascular Sys., Inc.* 106 F.3d 976, 980 (Fed. Cir. 1997) (noting that the clear and convincing standard applies to questions of inventorship regarding an issued patent); *Sturtevant v. Van Remortel*, 38 U.S.P.Q.2d (BNA) 1134, 1137–38 (S.D.N.Y. 1995) (applying the corroboration requirement to an issue of inventorship to meet the clear and convincing standard).

25. See 35 U.S.C. § 256.

26. For an example of a contentious inventorship challenge, see *Ethicon, Inc. v. U.S. Surgical Corp.*, 135 F.3d 1456 (Fed. Cir. 1998). The typical scenario involves an infringing company finding someone who aided in the inventive process, but who was left off the patent. The accused infringer then purchases a retroactive license from that person and helps fund the person's claim as a co-inventor under § 256.

27. For an excellent analysis of the evidence put forth by an alleged co-inventor whose claim ultimately failed due to lack of corroboration, see *Chirichillo v. Prasser*, 30 F. Supp. 2d 1132, 1136–38 (E.D. Wis. 1998).

C. *A Historical Perspective*

The corroboration requirement has evolved over a long period of time. Though the Supreme Court never directly articulated it, there is no doubt that the genesis of the requirement came from early decisions of the high Court.²⁸ The Federal Circuit has since formalized the requirement and has arguably redefined it by referring to it as a bright line rule.²⁹ This section begins with a synopsis of Supreme Court precedent, followed by changes to the requirement made by the Federal Circuit.

1. *Supreme Court Precedent*

The confusion surrounding the corroboration rule today can be fully appreciated only by understanding the passion of its origins. Perhaps the first case establishing the high scrutiny of evidence proffered to invalidate a patent came in the 1873 *Coffin v. Ogden* decision.³⁰ This case involved an anticipatory challenge to a patent for reversible door hinges.³¹ Though the Court did invalidate the patent in this case, it noted that “every reasonable doubt should be resolved against [the challenger to a patent, for] . . . [t]he law requires not conjecture, but certainty.”³²

Nearly twenty years later, the Supreme Court more thoroughly reviewed the evidence and established an apparent floor to the challenger’s burden in a case that has come to be known simply as *The Barbed Wire Patent* case.³³ In this case, the defendant, charged with infringement, tried to invalidate a patent for a barbed wire fence by showing evidence that such a fence had been publicly displayed years before the 1873 application for patent.³⁴ The evidence included oral testimony of no fewer than twenty-four eyewitnesses who swore to the presence of the fence at a county fair in 1858.³⁵ Several of them had reason for a good recollection of the fencing due to injuries sustained from contact with it, and few, if any, stood to gain anything from the outcome of the case.³⁶ Though the Court agreed it was likely that some form of barbed wire fence was present at the fair, the justices were “far from being satisfied” that the evi-

28. Nearly every analysis of the corroboration requirement or cases involving it begins with a discussion of the *Barbed Wire Patent* case or related Supreme Court decisions. See, e.g., Woodland Trust v. Flowertree Nursery, Inc., 148 F.3d 1368, 1372 (Fed. Cir. 1998); Steven N. Hird, *In Finnigan’s Wake: Recent Confusing Changes in the Federal Circuit’s Requirement for Corroboration of Witness Testimony During Patent Infringement Litigation*, 72 U. COLO. L. REV. 257, 266–67 (2001).

29. Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1577 (Fed. Cir. 1996).

30. 85 U.S. 120 (1873).

31. *Id.* at 120–21.

32. *Id.* at 124. Note that this language suggests the Supreme Court required the even higher burden of “beyond a reasonable doubt” to overturn a patent. For an argument that early Supreme Court cases did require this burden to be met, see Okey, *supra* note 8, at 563–64.

33. 143 U.S. 275 (1892).

34. *Id.* at 285–87.

35. *Id.* at 287.

36. See *id.* at 286–87.

dence was enough to overturn a patent.³⁷ In oft-cited dicta, the Court explained its concern over oral testimony in the patent arena:

In view of the unsatisfactory character of such testimony, arising from the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury, courts have not only imposed upon defendants the burden of proving such devices, but have required that the proof shall be clear, satisfactory and beyond a reasonable doubt. Witnesses whose memories are prodded by the eagerness of interested parties to elicit testimony favorable to themselves are not usually to be depended upon for accurate information. The very fact, which courts as well as the public have not failed to recognize, that almost every important patent, from the cotton gin of Whitney to the one under consideration, has been attacked by the testimony of witnesses who imagined they had made similar discoveries long before the patentee had claimed to have invented his device, has tended to throw a certain amount of discredit upon all that class of evidence, and to demand that it be subjected to the closest scrutiny.³⁸

Thus, the Court showed serious distaste for all oral testimony proffered to invalidate a patent—regardless of the interest of the witnesses.

The *Barbed Wire* holding was not an extreme example of an ill-tempered court on a bad day. Decades later, and with all new members,³⁹ the Supreme Court again refused to allow such testimony to overturn a patent in *Eibel Process Co. v. Minnesota & Ontario Paper Co.*⁴⁰ *Eibel* dealt with a machine that increased the rate at which mills can produce paper.⁴¹ A patent on the machine had been set aside by the lower court based on oral testimony alleging prior invention by another.⁴² The Court noted that “oral evidence . . . falls far short of being enough to overcome the presumption of novelty from the granting of [a] patent.”⁴³

Though clearly unwilling to allow unsubstantiated oral testimony to overturn a patent, the Supreme Court was more willing to rely on contemporaneous evidence. In *Corona Cord Tire Co. v. Dovan Chemical Corp.*,⁴⁴ the Court allowed evidence of an invalidating prior sale from a

37. *Id.* at 289.

38. *Id.* at 284–85.

39. See SUPREME COURT OF THE U.S., MEMBERS OF THE SUPREME COURT OF THE UNITED STATES, <http://www.supremecourtus.gov/about/members.pdf> (last visited Mar. 7, 2008).

40. 261 U.S. 45, 60 (1923).

41. *Id.* at 45.

42. *Id.* at 53–54.

43. *Id.* at 60. Citing the *Barbed Wire Patent* case, the Court went on: “The temptation to remember in such cases and the ease with which honest witnesses can convince themselves after many years of having had a conception at the basis of a valuable patent . . . have properly led to a rule that evidence to prove prior discovery must be clear and satisfactory.” *Id.*; see also *Radio Corp. of Am. v. Radio Eng’g Labs., Inc.*, 293 U.S. 1, 7–8 (1934) (requiring the “clearest proof” from a defendant to invalidate a patent).

44. 276 U.S. 358 (1928).

sole witness to curtail the scope of a patent on a process for the vulcanization of rubber.⁴⁵ However, it was not the witness's testimony, but rather the papers he had published at the time of his invention that convinced the Court of the authenticity of his contentions.⁴⁶ Another example where a prior inventor met the stiff Supreme Court evidentiary burden required to invalidate a patent involved an improved method of incubating eggs referred to as "the Smith method."⁴⁷ Here, the alleged infringer Hastings, his former boss, and his boss's wife all testified that they had publicly used the Smith method years before it was patented.⁴⁸ Citing both the *Barbed Wire Patent* case and *Eibel*, the Court noted that "[t]his oral testimony . . . without corroboration . . . is insufficient to establish prior use, [thus] we turn to the documentary evidence."⁴⁹ The Court then analyzed a book Hastings wrote and an abandoned patent application he filed, each of which thoroughly described the major elements of the Smith method prior to Smith's conception of it.⁵⁰ This contemporaneous documentation was sufficient to satisfy the Court, regardless of whether the documents showed that Hastings "knew fully and precisely the scientific principles involved"⁵¹

To synthesize the Supreme Court precedent on this issue, one would logically conclude that, in order to establish the invalidity of a patent based on prior invention or use, one must produce contemporaneous documentation that corroborates present-day testimony. The Court's decisions make clear that oral testimony alone is not sufficient. Were the Supreme Court to have remained involved in patent law, that would likely have been the end of the history lesson. However, the number of patent cases granted certiorari by the Court dropped precipitously in the second half of the twentieth century, to the point that it averaged only one patent case per year.⁵² The Court seemed content to relegate patent matters to lower courts.⁵³ To fill the void left by the Supreme Court⁵⁴ and to clear up the rampant conflicts that had resulted between the various circuits,⁵⁵ Congress created the Court of Appeals for the Federal Circuit in 1982 and granted it jurisdiction over patent appeals from all districts, as well as appeals from patentability decisions made by the Patent and Trademark Office (PTO).⁵⁶ Like most areas of patent law, the Supreme

45. *Id.* at 381–82.

46. *Id.*

47. *Smith v. Hall*, 301 U.S. 216, 222 (1937).

48. *Id.*

49. *Id.*

50. *See id.* at 223–26.

51. *Id.* at 226.

52. *See* John F. Duffy, *The Festo Decision and the Return of the Supreme Court to the Bar of Patents*, 2002 SUP. CT. REV. 273, 275 (2002).

53. THE SUPREME COURT AND PATENTS AND MONOPOLIES, at xii (Philip B. Kurland ed., 1975).

54. *See* Duffy, *supra* note 52, at 276.

55. *See* MARTIN J. ADELMAN ET AL., CASES AND MATERIALS ON PATENT LAW 15 (2d ed. 2003).

56. *See* Federal Courts Improvements Act of 1982, 28 U.S.C. § 1295 (2000).

Court fell silent on the issue of corroboration, leaving the Federal Circuit to amend precedent as it saw fit.

2. *Changing Requirements Under the Federal Circuit*

The Federal Circuit soon displayed a willingness to redefine the evidentiary requirements to overturn a patent. The first major holding of the Federal Circuit on the issue of corroboration was the 1993 case of *Price v. Symsek*.⁵⁷ This case involved an interference action wherein the PTO had awarded Symsek rights to a heat management system despite Price's claims that he was the first to invent it.⁵⁸ On appeal, Price complained that the PTO had held him to the beyond a reasonable doubt standard, and the Federal Circuit agreed that this was too heavy a burden.⁵⁹ In a few short paragraphs, the court discussed and dismissed all of the Supreme Court and Circuit Court of Patent Appeals history suggesting that proof beyond a reasonable doubt was required to overturn a patent⁶⁰ and finally settled on the clear and convincing standard.⁶¹ In order to meet this standard, the Federal Circuit stated that "[o]nly the inventor's testimony requires corroboration," which suggests that other witness testimony can be accepted and weighed at face value without further support.⁶² *Price*, thus, sent a new signal from the Federal Circuit. The burden to corroborate had been lowered, and the court system has allowed the lower standard to remain.⁶³

The Federal Circuit has not only lowered the burden applied to corroboration, it has also confused the requirement considerably. For instance, the question that *Price* seemed to answer as to whose testimony requires corroboration has hardly gone away. Within a six-month period in 1999, the Federal Circuit came out with opinions seemingly at odds on this issue.⁶⁴ First, in *Thomson, S.A. v. Quixote Corp.*, plaintiff Thomson alleged infringement of its patent for a type of information storage device.⁶⁵ Quixote countered with a charge of invalidity and produced two inventors from a third-party company who testified as to their prior in-

57. 988 F.2d 1187 (Fed. Cir. 1993).

58. *Id.* at 1189–90.

59. *Id.* at 1190–91.

60. See *supra* text accompanying note 32.

61. See *Price*, 988 F.2d at 1191–94 (“The patent cases in which ‘beyond a reasonable doubt’ statements have been made were not in the context of a reasoned analysis . . .”).

62. *Id.* at 1195.

63. Though there is much confusion as to what constitutes corroboration, see *infra* Part III.A, the burden set by *Price* remains good law, and the Federal Circuit still cites the case favorably when issues of corroboration arise. See, e.g., *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1169 (Fed. Cir. 2006).

64. The cases are *Thomson, S.A. v. Quixote Corp.*, 166 F.3d 1172 (Fed. Cir. 1999) and *Finnigan Corp. v. International Trade Commission*, 180 F.3d 1354 (Fed. Cir. 1999). Much has been made of the disparity in these holdings. See Hird, *supra* note 28, at 274–80; Jessica R. Underwood, Article, *Impugning Finnigan and Realigning the Corroboration Standard for Uninterested Single Witness Testimony with Precedent and Policy*, 7 U. PITT. J. TECH. L. & POL'Y 6 (2007).

65. *Thomson*, 166 F.3d at 1173.

vention of the claimed subject matter.⁶⁶ Relying solely on this uncorroborated inventor testimony, a jury found the patent invalid.⁶⁷ Surprisingly, the Federal Circuit allowed the verdict to stand, explaining that the testimony did not require corroboration because the inventors were not party to the suit.⁶⁸ Though it appears to be the furthest departure from precedent to date, the opinion was written by Judge Rich, one of the foremost authorities on patent law who had been on the Federal Circuit since its inception and had, prior to that, served on the Circuit Court of Patent Appeals for twenty-six years.⁶⁹

Merely four months later, the Federal Circuit took up the matter anew in *Finnigan Corp. v. International Trade Commission*.⁷⁰ Plaintiff Finnigan had sued to enforce its patent for a mass spectrometer only to have the patent invalidated by the lower court based on testimony alleging prior public use from a neutral third party who had written a contemporaneous article on the technology.⁷¹ The Federal Circuit dismissed the article as not directly anticipating the patented technology⁷² and discounted the testimony as being uncorroborated, stating clearly that corroboration of oral testimony is required regardless of whether the witness is a party or has an interest in the litigation.⁷³ It is hard to imagine how *Finnigan* could be in concert with *Thomson*, yet the Court suggested that *Thomson* “[was] not to the contrary” because of additional corroborating evidence from the *Thomson* trial court record.⁷⁴ However, the Federal Circuit in *Thomson* reached its conclusion without consideration of this evidence.⁷⁵ Amazingly, Judge Rich was on the *Finnigan* panel as well, yet put forth no dissent.⁷⁶ As analyzed below, the question as to whether testimony from neutral parties requires corroboration remains open today.⁷⁷

66. *See id.* at 1174.

67. *Id.* There was other evidence involved, but Thomson argued that the district court jury verdict relied solely on the oral testimony and that was, thus, all the Federal Circuit considered on appeal. *See infra* text accompanying note 159.

68. *Thomson*, 166 F.3d at 1175–76.

69. Judges of the United States Courts, <http://www.fjc.gov/servlet/tGetInfo?jid=2002> (last visited Mar. 8, 2008). Judge Rich was ninety-five years old when he wrote this opinion, and he passed away a few months later.

70. 180 F.3d 1354 (Fed. Cir. 1999).

71. *Id.* at 1361.

72. *Id.* at 1365.

73. *Id.* at 1366–68 (“[T]he need for corroboration exists regardless whether the party testifying concerning the invalidating activity is interested in the outcome of the litigation (e.g., because that party is the accused infringer) or is uninterested but testifying on behalf of an interested party.”).

74. *Id.* at 1368–69.

75. *See Underwood, supra* note 64, at 6; *infra* text accompanying note 159. Despite the Federal Circuit’s defense of *Thomson*, many have recognized *Finnigan* as expressly rejecting it. *See, e.g., Hird, supra* note 28, at 278.

76. In fact, he died the day the opinion was issued. *See Hird, supra* note 28, at 277 n.112.

77. District courts have expressed frustration over the lack of clarity as to this question. *See, e.g., Engate, Inc. v. Esquire Deposition Servs., L.L.C.*, 331 F. Supp. 2d 673, 684 (N.D. Ill. 2004) (“[T]he Court cannot disregard *Thomson*, but . . . *Finnigan* has never been overturned. . . [t]hus the Court is faced with an intra-circuit split.”). The *Engate* court ultimately sided with *Finnigan*, noting that the

3. *Inconsistencies as to Sufficiency of Evidence*

Beyond the question of when corroboration is required lies the question of what constitutes sufficient corroboration. Not only has the Federal Circuit varied in its determination of this, it also has applied different standards to different legal arguments. Toward one extreme lies the finding of no corroboration in *Juicy Whip, Inc. v. Orange Bang, Inc.*⁷⁸ Juicy Whip and Orange Bang competed to provide beverage dispensers to the retail market.⁷⁹ In 1989, Juicy Whip filed for, and eventually obtained, a patent on a special type of beverage dispenser.⁸⁰ At trial, Orange Bang tried to show invalidity based on § 102(b) by presenting testimony from six witnesses, four of whom were nonparties, as well as sketches and contemporaneous sales receipts to support its contention that it had developed and sold the patented invention as early as 1983.⁸¹ This was enough to convince the trial court of invalidity, but the Federal Circuit felt that “no reasonable juror could have found” prior use based on this evidence.⁸² Instead of considering the evidence as a whole, the Court gave a detailed account of the *Barbed Wire Patent* case before proceeding to discount the testimony of each witness and each piece of documentary evidence separately.⁸³

Toward the other extreme are the findings of adequate corroboration in *Brown I*⁸⁴ and *Brown II*.⁸⁵ These cases dealt with different elements of an interference claim by the senior party Brown.⁸⁶ Brown and Barbacid both filed for patents and claimed priority to a certain biological assay to aid in fighting cancer.⁸⁷ To find conception, the Federal Circuit relied solely on Brown’s own notes, thus overruling the PTO’s initial demand for further corroboration.⁸⁸ However, in nearly the same breath,

vast majority of Federal Circuit cases have followed its precedent and ignored *Thomson*. See *id.* at 685; see also *K & K Jump Start/Chargers, Inc. v. Schumacher Elec. Corp.*, 82 F. Supp. 2d 1012, 1018 (W.D. Mo. 2000), *rev’d on other grounds*, 13 Fed. App’x 982 (Fed. Cir. 2001).

78. 292 F.3d 728 (Fed. Cir. 2002).

79. *Id.* at 733.

80. *Id.* at 731–32.

81. *Id.* at 734–35.

82. *Id.* at 738.

83. See *id.* at 740–41, 743.

84. *Brown v. Barbacid (Brown I)*, 276 F.3d 1327 (Fed. Cir. 2002). Again, note the temporal proximity to the *Juicy Whip* opinion by the same court.

85. *Brown v. Barbacid (Brown II)*, 436 F.3d 1376 (Fed. Cir. 2006).

86. To follow this case, a basic understanding of the elements of an interference action is required. The senior party is the inventor who first files an application. Invention requires both “conception” and “reduction to practice.” Generally, the party who can prove that he or she was the first to complete these two tasks earns priority and claim to the patent rights. However, if a challenger can show that he or she conceived of the invention first and showed “diligence” in his or her efforts to achieve reduction to practice, the challenger may prevail despite his or her opponent’s having been first to reduce the invention to practice. For a more thorough explanation, see 3A CHISUM, *supra* note 17, § 10.03[1].

87. *Brown I*, 276 F.3d at 1331.

88. See *id.* at 1335 (“This corroboration rule does not apply with the same force to proof of inventive facts with physical exhibits.”).

the court refused to allow this form of evidence, along with the testimony of a nonparty scientist, to establish reduction to practice without further corroboration and, thus, remanded the case to the PTO.⁸⁹ On remand, the PTO established the earlier conception date, but found that Brown failed to provide enough evidence to corroborate his claim of diligence in reducing to practice.⁹⁰ To show diligence, Brown relied merely on the oral testimony of his partner scientists and their lab notes.⁹¹ Here, the Federal Circuit found that “[u]nlike [in the case of] the legal rigor of conception and reduction to practice, diligence and its corroboration may be shown by a variety of activities” that apparently includes those shown by Brown’s evidence.⁹² Ultimately, the court again overruled the PTO’s finding of insufficient corroboration.⁹³ Thus, Brown prevailed in the interference by presenting no more than his own notes and the testimony of his partners.

From the holdings of the Federal Circuit discussed above, one can see that determining what constitutes corroboration or when it is required is no easy task. This note is not the first to recognize inconsistent holdings on corroboration in patent cases,⁹⁴ nor the first to recommend a change.⁹⁵ District courts have openly asked for a remedy to the conflict.⁹⁶ Even Donald Chisum’s treatise on patent law, probably the foremost reference authority on the subject,⁹⁷ recognizes that “Federal Circuit decisions . . . show some inconsistency as to [the corroboration requirement’s] application.”⁹⁸ It is against this historical backdrop that this note considers how courts apply the corroboration rule today, analyzes its merits and shortcomings, and evaluates its future under the proposed changes in patent law.

89. *Id.* at 1336–38.

90. *Brown II*, 436 F.3d at 1378. Note that if Brown could prove such diligence, he would receive priority because his earlier conception date had been established.

91. *Id.* at 1380–81.

92. *Id.* at 1380.

93. *Id.* at 1382.

94. See Ciralo, *supra* note 18, at 533–34 (giving examples of what courts have accepted as corroboration and suggesting mistakes have been made); Hird, *supra* note 28 (focusing on the inconsistency between *Finnigan* and *Thomson*).

95. See Okey, *supra* note 8, at 560–61 (advocating a reduction of all evidentiary burdens within patent law to the level of preponderance of the evidence); Underwood, *supra* note 64 (advocating for a much weaker corroboration standard in line with that promoted in *Thomson*). Though these recommendations may indeed cure the present confusion surrounding the corroboration requirement, both are out of line with Supreme Court precedent, legislative intent, and sound policy as illustrated herein.

96. See, e.g., *Engate, Inc. v. Esquire Deposition Servs., L.L.C.*, 331 F. Supp. 2d 673, 685 (N.D. Ill. 2004) (“One can only hope that the Federal Circuit will resolve the conflict created by its decisions on this issue.”).

97. Patent Exam’r, Chisum on Patents, <http://www.thepatentexaminer.com/Chisum.html> (last visited Mar. 8, 2008).

98. 1 CHISUM, *supra* note 17, § 3.05[2][c][iii].

III. ANALYSIS

A. *What Constitutes Corroboration Today?*

As indicated in Part II, the Federal Circuit has failed to provide district courts with a reliable answer as to what constitutes sufficient corroboration. However, some tools are applied consistently and some forms of evidence stand a better chance of meeting the corroboration burden than others. Before attempting to answer the above question through analysis of often inconsistent Federal Circuit opinions, a few consistent interpretations should be understood.

First, the corroboration rule applies only to oral testimony. “[P]hysical evidence . . . [does] not require corroboration to demonstrate the content of the physical evidence itself.”⁹⁹ The Federal Circuit is willing to let “[t]he trier of fact . . . conclude for itself what documents show, aided by testimony as to what the exhibit would mean to one skilled in the art.”¹⁰⁰ Second, if the oral testimony that a party wishes to corroborate is itself “facially deficient,” a court will not reach the question of corroboration.¹⁰¹ The Federal Circuit made this point in *Oakley, Inc. v. Sunglass Hut International* when analyzing the defendant’s testimony that suggested a third party had sold sunglasses like those in question.¹⁰² The court found the testimony to be “conclusory” and lacking any “quantitative assessment.”¹⁰³ Thus, the question of corroboration was moot because even if the testimony had been admitted it would have no value in furthering the defendant’s case.

Finally, Federal Circuit corroboration holdings must be considered in light of the lower court ruling. The notion that assessing witness credibility is a role typically left to the trial courts is not lost on the Federal Circuit.¹⁰⁴ Though historically the court has considered corroboration sufficiency to be a question of law,¹⁰⁵ the determination relies on the

99. *Brown v. Barbacid (Brown I)*, 276 F.3d 1327, 1335 (Fed. Cir. 2002).

100. *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577–78 (Fed. Cir. 1996).

101. *See Oakley, Inc. v. Sunglass Hut Int’l*, 316 F.3d 1331, 1343 (Fed. Cir. 2003).

102. *Id.*

103. *Id.*

104. *See, e.g., Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1371 (Fed. Cir. 1998) (“[A]n appellate court is indeed in a poor position to assess credibility . . .”); *Mahurkar*, 79 F.3d at 1577 (referring to the corroboration rule as “prophylactic in application given the unique abilities of trial court judges and juries to assess credibility”); *see also Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728, 747–48 (Fed. Cir. 2002) (Mayer, C.J., dissenting) (chastising the majority for second-guessing the finder of fact without having heard the witnesses).

105. *See, e.g., Sandt Tech., Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344, 1352–53 (Fed. Cir. 2001) (“[W]e conclude that as a matter of law, the evidence provides sufficient corroboration . . .”). However, a very recent decision calls even this into question. The opinion suggests that the need for corroboration is a matter of law, but its sufficiency “is a jury question.” *Adenta GmbH v. OrthoArm, Inc.*, 501 F.3d 1364, 1372 (Fed. Cir. 2007). To support this, the opinion cites *Woodland Trust*, even though the *Woodland* opinion seems to confirm that the appellate court *does* determine sufficiency. *See supra* text accompanying note 104. No one would argue that a jury must weigh the corroborative evidence to determine what weight to place on witness testimony, but the Federal Circuit has traditionally reviewed sufficiency of corroboration as a legal question. The confusion on this issue was ap-

evidentiary facts established at the trial level to make this legal determination.¹⁰⁶ Where the call on corroboration is close, case history suggests that the Federal Circuit will likely defer to the trial court's familiarity with the facts rather than overturn without having heard testimony first-hand.¹⁰⁷ This is evidenced by the relatively small number of opinions that have been overturned by the Federal Circuit on a basis of corroboration or lack thereof.¹⁰⁸

1. *The Rule of Reason*

Though "there is no final single formula that must be followed in proving corroboration,"¹⁰⁹ all Federal Circuit opinions suggest adherence to a "rule of reason," which originated in early decisions of its predecessor, the Court of Customs and Patent Appeals.¹¹⁰ This "rule" simply means that district courts are to review all of the pertinent evidence to determine the credibility of the witness's testimony.¹¹¹ The review is supposed to focus on eight factors first laid out in *In re Reuter*:¹¹²

- (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,

parent during the *Adenta* oral argument where one panel member even suggested there should have been a jury instruction on the issue of corroboration. See Recording of Oral Argument: *Adenta*, 501 F.3d 1364 (July 11, 2007), available at <http://www.ca9.uscourts.gov/oralarguments/mp3/2006-1571.mp3> (last visited Mar. 8, 2008).

106. The result of the corroboration determination often turns on these individual factual findings, which the Federal Circuit overturns only if it detects clear error. See *Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1171 (Fed. Cir. 2006). An example is *Cooper v. Goldfarb*, 154 F.3d 1321 (Fed. Cir. 1998), where the final determination relied on a piece of evidence the PTO Board of Patent Appeals and Interferences (BPAI) had accepted as fact. *Id.* at 1330. Because the Federal Circuit could not find this determination to be "clearly erroneous," it declined to disturb the corroboration finding. *Id.*

107. See, e.g., *Medichem*, 437 F.3d at 1171 ("[T]his court gives great deference to the district court's decisions regarding credibility of witnesses [because] only the trial judge can be aware of the variations in demeanor and tone of voice that bear so heavily on the listener's understanding of and belief in what is said.") (internal quotations omitted).

108. Of over twenty-five Federal Circuit cases involving a question of corroboration analyzed in detail for this note, only five were reversed on this basis. See *supra* Part II.C.2.

109. *Kridl v. McCormick*, 105 F.3d 1446, 1450 (Fed. Cir. 1997).

110. See, e.g., *Berry v. Webb*, 412 F.2d 261, 266 (C.C.P.A. 1969).

111. *Kridl*, 105 F.3d at 1450.

112. 670 F.2d 1015, 1021 n.9 (C.C.P.A. 1981).

- (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.¹¹³

The Federal Circuit has cited some form of these factors in nearly every case involving corroboration since.

Despite the Federal Circuit's diligence in mentioning these factors, its application of them leaves much to be desired. In fact, it often seems that the court focuses on a specific factor that favors its opinion and ignores the others. An example of this inconsistent application is displayed by comparing the Federal Circuit's opinions in *Juicy Whip* and *Price*. Both opinions begin their analysis of the corroboration rule by listing the eight *Reuter* factors,¹¹⁴ but the similarities end there. After introducing the factors, the *Juicy Whip* court gave a summary of three former cases where oral testimony had been refused before focusing in on the third factor: the interest of the testifying witnesses.¹¹⁵ Almost completely ignoring the other factors, the court spent considerable energy detailing the relationships of six separate witnesses to the matter at hand in order to discredit their otherwise relevant testimony.¹¹⁶ Though the court found the testimony uncorroborated, overturning the lower court and upholding the patent, the decision was not unanimous. In dissent, Chief Judge Mayer noted that "[w]hile the six witnesses . . . may have been interested in the outcome to varying degrees, the level of interest is only one of the eight factors set out in *In re Reuter*."¹¹⁷

In stark contrast, the *Price* court followed its introduction of the *Reuter* factors with a discussion of an affidavit from a party clearly interested in the outcome of the case.¹¹⁸ However, there was no mention of this level of interest whatsoever, and the court was satisfied with using the affidavit to corroborate the inventor's testimony regarding his date of invention.¹¹⁹ In fact, the court seemed to accept *Price*'s testimony, at least in part, because it felt his opponent Symsek lacked sufficient experience and understanding to have conceived of the invention inde-

113. *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1371 (Fed. Cir. 1998).

114. *See Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728, 741 (Fed. Cir. 2002); *Price v. Symsek*, 988 F.2d 1187, 1195 n.3 (Fed. Cir. 1993).

115. *See Juicy Whip*, 292 F.3d at 741–43. The Court did make a short reference to the second factor, noting that it had been eight to twelve years since the events in question had occurred. *Id.*

116. *See id.*

117. *Id.* at 747 (Mayer, C.J., dissenting).

118. *See Price*, 988 F.2d at 1195. In fact, the affidavit was that of an employee of the alleged inventor, Richard C. Price, who was attempting to claim priority. Furthermore, she had the dubious surname of none other than "Price." *Id.* Though there is no mention of it in the case, it is likely that Ms. Price was not only the corporate secretary, but also a relative of the plaintiff at the small Price Industries where they both worked.

119. *See id.* at 1195–96.

pently.¹²⁰ Notably, experience of the challenging party is not a factor on the *Reuter* list at all.

Though the *Reuter* factors are fairly basic and would seem relevant to nearly any conceivable case questioning the veracity of oral testimony regarding a prior invention or use, the Federal Circuit has never addressed the factors in turn or weighed the evidence of a certain case against each one. Additionally, it has provided little guidance as to how the separate factors should be weighed. Ultimately, the court appears to pick and choose from the list in order to build support for the conclusion it has already reached. Although this sounds inequitable, it is perhaps an irresistible temptation for courts when they are presented with so many potentially conflicting elements to apply.¹²¹ While the Federal Circuit continues to claim adherence to the “rule of reason” and list the *Reuter* factors, the court’s application of the rule provides little aid to inventors trying to assess the strength of their evidence prior to trial.

2. *The Strength of Contemporary Physical Evidence*

While the “rule of reason” provides little help in evaluating the merits of one’s case, inventors who take good notes and retain their records can take heart in Federal Circuit holdings. Though there are exceptions, the court has generally viewed physical evidence from the period during which the alleged invention or prior use occurred to be highly effective in corroborating oral testimony at trial. In *Sandt Technology, Ltd. v. Resco Metal and Plastics Corp.*, the Federal Circuit described such evidence as being “the most reliable proof that the inventor’s testimony has been corroborated . . . [because the] risk of litigation-inspired fabrication or exaggeration is eliminated.”¹²² The court went on to note that circumstantial evidence and oral testimony can also be corroborative in some cases; however, oral testimony is especially “suspect.”¹²³ In one case, the court even declared that it has “consistently required documentary corroboration of oral testimony . . . presented to invalidate a patent.”¹²⁴ While its record definitely does not support this assertion, the comment accurately notes the value the Federal Circuit generally places on physical evidence for use in corroborating oral testimony.

120. See *id.* at 1196 n.4. The Court seemed ultimately to agree with Price that Symsek was a “neophyte[] in the field and could only have derived the invention from him.” *Id.* at 1194.

121. This note is not the first source to accuse the judiciary of selective application. For example, this is a common criticism when the rules of statutory interpretation are applied. One book on the subject describes these rules as “a grab bag . . . from which a judge can choose to support his or her view of the case.” ABNER J. MIKVA & ERIC LANE, AN INTRODUCTION TO STATUTORY INTERPRETATION AND THE LEGISLATIVE PROCESS 25 (1997).

122. 264 F.3d 1344, 1351 (Fed. Cir. 2001).

123. *Id.*

124. *Lacks Indus. v. McKechnie Vehicle Components USA, Inc.*, 322 F.3d 1335, 1350 (Fed. Cir. 2003).

At first glance, it may seem unlikely that such physical evidence would be available and that the Federal Circuit expects too much from parties by weighting it so heavily.¹²⁵ After all, these claims often deal with events that occurred ten or twenty years in the past. However, the court has rightfully dismissed such concerns. In *Woodland Trust v. Flowertree Nursery, Inc.*, the court showed particular skepticism when a party claiming to have publicly operated an anticipatory device for nearly twenty years had no physical proof.¹²⁶ The *Woodland* court noted that “in modern times . . . [i]t 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.”¹²⁷

This raises the question as to what types of documentary evidence have proven most effective in corroborating oral testimony. There is no clear rule, but obviously the more detailed and descriptive the document, the more corroborative value it has. Probably the most descriptive example would be an abandoned patent application. These have almost always proven sufficiently corroborative in the past.¹²⁸ Other documentary evidence that has succeeded includes handwritten test reports,¹²⁹ diagrams or materials from a convention where the prior art was allegedly displayed,¹³⁰ invoices and offers for sale,¹³¹ and dated letters describing the invention.¹³² Many of the decisions that focused on these documents also included oral testimony to support the inventor’s contentions,

125. In fact, this note refutes that contention in Part III.B.2. Though the modern inventive process may start on the back of an envelope, it almost never ends there. Even the most simple of concepts requires drawings, prototypes, requisitions for supply, or other such acts that inevitably generate physical records. It is actually not atypical to retain all such things and would be even less so were a proper standard established.

126. See 148 F.3d 1368, 1373 (Fed. Cir. 1998). Actually, defendant-appellees did provide two undated photographs, but the court found that their “lack of detail and clarity can not have provided documentary support.” *Id.*

127. *Id.*

128. See, e.g., *Sandt*, 264 F.3d at 1351 (finding defendant’s corroboration burden met and affirming the district court’s invalidation of plaintiff’s patent on summary judgment). *But cf.* *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1217–18 (Fed. Cir. 2002) (finding that an abandoned patent application of a neutral third party did not corroborate the third party’s testimony regarding his prior invention). *Texas Digital* is a tough case to square with others. The district court seemed to refuse the testimony more on grounds that it might confuse the jury, per Federal Rule of Evidence 403, than on lack of corroboration. *Id.* at 1218. Still, the district court “expressly considered it for corroboration purposes” and found it insufficient. *Id.* In this case, the Federal Circuit did not feel that the district court had abused its discretion. *Id.* Perhaps this case is best explained by the hesitation of appellate courts to overturn these evidence-based district court holdings, as discussed in the beginning of Part III.A.

129. See *Knorr v. Pearson*, 671 F.2d 1368, 1375 (C.C.P.A. 1982) (affirming PTO’s finding of adequate corroboration and granting of priority).

130. See *Mitsubishi Elec. Corp. v. Ampex Corp.*, 190 F.3d 1300, 1304–05 (Fed. Cir. 1999) (accepting corroboration and affirming district court holding that patent was invalid).

131. See *Sandt*, 264 F.3d at 1351–52.

132. See *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1578–79 (Fed. Cir. 1996) (upholding district court’s finding of corroboration of prior invention).

but the Federal Circuit generally ignored this and focused on the more substantial contemporary evidence for corroboration.

Where contemporary documents failed to provide adequate corroboration of oral testimony, it was usually because they lacked the level of detail required to define the invention or failed to distinctly define the object of prior use. For instance, a brochure from an old trade show may depict a line of can openers and thereby corroborate the witness's testimony that the can openers were on display there (i.e., in public use). However, if the pictures and descriptions in the brochure do not positively identify the exact can opener being debated in court (i.e., the one covered under the patent in question), the Federal Circuit may find it has no corroborative value.¹³³ In the past decade, the court has rejected such things as meeting minutes that described a prototype but lacked specific detail,¹³⁴ an expert witness's prior article that "[did] not expressly disclose" a key feature of the design in question,¹³⁵ and a purchase order for parts allegedly used to construct an anticipatory device.¹³⁶

The good news here for inventors is that the most reliable type of evidence they could have to support their assertions is almost completely within their control. If inventors only document their work and maintain careful, detailed records, they should not run into an issue with corroboration.¹³⁷ Such documentation is also likely immune to hearsay excep-

133. In fact, this scenario is not at all uncommon. See, e.g., *Mitsubishi*, 190 F.3d at 1304. Here, the defendant claimed to have shown an invalidating piece of prior art at a trade show. *Id.* The plaintiff did not contest that such a device was there, but rather argued that it was not "as recited in the claims" of the patent at issue. *Id.* Thus, the defendant's burden was to show, through corroborative evidence, that its device did in fact encompass the claims of the challenged patent. *Id.*

134. See *Lacks Indus. v. McKechnie Vehicle Components USA, Inc.*, 322 F.3d 1335, 1350-51 (Fed. Cir. 2003) (affirming district court finding that defendant failed to corroborate his prior use claim).

135. *Finnigan Corp. v. Int'l Trade Comm'n*, 180 F.3d 1354, 1365 (Fed. Cir. 1999) (reversing the holding of the Commission that had invalidated plaintiff's patent based on a claim of anticipation that was not sufficiently corroborated).

136. See *Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728, 743 (Fed. Cir. 2002) (reversing district court's finding of invalidity based on prior use).

137. Of course, for every rule, there is the exception. Recall that there are three basic areas where corroboration is required. In cases of anticipation / prior use or inventorship, the inventor's contemporaneous documents should prove adequate to corroborate his or her testimony if sufficiently detailed and on point. However, in priority disputes, such records may not suffice unless witnessed or otherwise supported by a third party. The reason for this distinction lies with the need to prove reduction to practice. Simply stating in a lab notebook that a test was performed and was successful is not enough. See *Brown v. Barbacid (Brown I)*, 276 F.3d 1327 (Fed. Cir. 2002). In this priority dispute, the court supported the BPAI in holding that "an inventor's own *unwitnessed* documentation does not corroborate an inventor's testimony about inventive facts." *Id.* at 1335 (emphasis added). The Court was specifically referring to Brown's lab notebook. *Id.* The PTO had awarded Barbacid priority, refusing to consider evidence put forth by Brown. *Id.* at 1332. Though the Federal Circuit ultimately found sufficient corroboration of conception, it remanded the issue of reduction to practice. *Id.* at 1338. Perhaps the difference is most easily viewed in terms of motivation. An inventor honing in on a discovery already has a motivation to get there earlier than everyone else, and thus has an interest in falsifying records to make that case. Alternatively, a party displaying a good or an inventor who has no interest in patenting an invention would lack motivation to falsify records because he or she would have no reason at that time to anticipate a conflict.

tions that might hinder or limit the admission of oral testimony.¹³⁸ Though paperwork can be lost, in today's digital age almost every document is electronic in form and capable of being stored and backed up as needed.¹³⁹ Documentary evidence is thus clearly preferable when compared to the oral testimony of others that is very much out of the inventor's control. Having to rely on oral testimony from third parties to corroborate an inventor's own testimony presents inventors with numerous risks. No one can be certain what a third-party witness will say, how the jury or the judge will interpret his or her testimony, or how he or she will stand up to cross-examination. Plus, as noted above, the Federal Circuit has consistently favored documentary evidence in these matters. Of course, the bad news is that the inventor may not have the contemporaneous documents he or she needs, and there is no way to recreate them. In that case, the inventor must rely on other, less certain forms of corroboration.

3. *Oral Testimony and Noncontemporary Materials*

So what becomes of the inventor who lacks the documentary support necessary to corroborate his or her story? As mentioned above, the *Sandt* court noted that an inventor may fall back on circumstantial and testimonial evidence,¹⁴⁰ but the potential for success with this material is much harder to project given Federal Circuit case law.

Some parties have attempted to support their testimony by providing a physical demonstration of the prior art in court. This practice has met with mixed success. *Hewlett-Packard Co. v. Mustek Systems, Inc.* involved a Hewlett-Packard patent that claimed methods for optical scanning.¹⁴¹ Defendant Mustek raised anticipation as a defense against a charge of infringement, alleging that "the claimed methods had been publicly performed" by a prior art scanner.¹⁴² To show this, it brought the alleged scanner into the courtroom and physically demonstrated how it could scan using the claimed methods.¹⁴³ The Federal Circuit found this to be sufficient corroboration because "the device itself . . . was made contemporaneously with the [patented claims]."¹⁴⁴

138. The Federal Rules of Evidence provide a hearsay exception for memos, reports, and records made in the normal course of business. See FED. R. EVID. 803(6). Should the document be more than twenty years old, its admission will be nearly automatic. See *id.* at 803(16).

139. However, one must recall that such documents have no corroborative value if they are not dated or their date cannot be reasonably determined. This may present a problem to some forms of electronic documents where the origination date is unknown. The opposing party is likely to point out that they could have been typed up only recently and labeled with an older date.

140. See *Sandt Tech., Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344, 1350–51 (Fed. Cir. 2001).

141. 340 F.3d 1314, 1317 (Fed. Cir. 2003).

142. *Id.* at 1326.

143. *Id.*

144. *Id.*

In *Knorr v. Pearson*, the junior party (Pearson) used a physical sample remaining from a contemporaneous test to help corroborate his claim as to prior reduction to practice.¹⁴⁵ The appellate court noted that circumstantial evidence can satisfy the corroboration rule and seemed impressed with the detail of the test sample.¹⁴⁶ Though Knorr noted that Pearson had no proof the sample came from the test in question,¹⁴⁷ the court was satisfied with the “internal consistency” of Pearson’s evidence and the “absence of positive evidence . . . supportive of Knorr’s position.”¹⁴⁸

The *Juicy Whip* court took a different stance on circumstantial evidence. Here, one of the defendants claimed to have modified a contemporaneous product, thereby creating an anticipatory device.¹⁴⁹ To support this, he demonstrated the modification on a similar device in front of the jury.¹⁵⁰ Though the dissent was impressed with this, the majority discarded it in a footnote, pointing out that there is no *Reuter* factor that mentions such evidence.¹⁵¹ These holdings suggest that demonstrations involving physical exhibits that are themselves contemporaneous with the invention in question might have more value than those using present-day props. If inventors have failed to retain contemporaneous documents, however, it is doubtful that they would have kept such exhibits. In most cases, therefore, they will have to rely on the oral testimony of others to substantiate their case.

The Federal Circuit’s holdings make it nearly impossible to accurately predict how it will view the value of oral testimony in any given claim. In *Price*, the court held that “[o]nly the inventor’s testimony requires corroboration before it can be considered.”¹⁵² This suggests that testimony by a noninventor would not require further corroboration and could stand on its own. However, the court has also repeatedly held that “corroboration is required of *any witness* whose testimony alone is as-

145. 671 F.2d 1368, 1370 (C.C.P.A. 1982).

146. *See id.* at 1373. The sample was a portion of a door frame remaining after a fireproofing test. Though, in theory, it could have been created at any time, this would not be a simple thing to fabricate.

147. *See id.* at 1373. Pearson had been working closely with an associate named Rutkowski, who testified as to the authenticity of the sample. However, Rutkowski did not, himself, witness the test. *Id.*

148. *Id.* at 1374. In fairness, the court also considered other evidence offered as corroboration by Pearson, including the oral testimony of Rutkowski and a contemporaneous, though inconclusive, test report. *See id.* at 1370.

149. *Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728, 734 (Fed. Cir. 2002).

150. *Id.* at 746–47.

151. *Id.* at 743 n.2. The majority was equally unimpressed with sketches of the alleged prior art made by defendant witnesses at the time of trial, noting that both the sketches and the demonstration “[were] no more reliable than the oral testimony” of the witnesses. *Id.* at 743.

152. *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed. Cir. 1993) (placing considerable weight on the testimony of Price’s secretary which was not corroborated). Though *Price* is slightly dated, the Federal Circuit has continued to cite this language. *See, e.g.*, *Brown v. Barbacid (Brown I)*, 276 F.3d 1327, 1335 (Fed. Cir. 2002).

serted to invalidate a patent”¹⁵³ One district court recently noted that the concept suggesting “testimonial evidence can *never* be corroborated by testimonial evidence . . . is not wholly unsupported by case law.”¹⁵⁴ This leaves open the question as to whether oral testimony alone can be sufficiently corroborative of inventor testimony.¹⁵⁵ The Federal Circuit took up this question of “cross-corroboration” in *Lacks Industries, Inc. v. McKechnie Vehicle Components USA, Inc.*, finding that it was inadequate.¹⁵⁶ In dismissing the corroborative value of three witnesses, the court noted that “courts have consistently required *documentary* corroboration of oral testimony”¹⁵⁷ Unfortunately, Federal Circuit case law shows that such a requirement is not consistently applied. There are, in fact, cases where the court has found sufficient corroboration in the absence of any documentary evidence, in some cases relying solely on the oral testimony of others.¹⁵⁸

Thomson, S.A. v. Quixote Corp., discussed above, took *Price*’s limitation on the corroboration rule one step further:

We . . . hold that 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 *directly* and *substantially* gain by his or her invention being found to have priority over the patent claims at issue.¹⁵⁹

Though the Federal Circuit later attempted to qualify this statement,¹⁶⁰ *Thomson* was not overturned. Thus, the case law seems confused as to whose testimony even requires corroboration, let alone whether one wit-

153. *Dow Chem. Co. v. Mee Indus., Inc.*, 341 F.3d 1370, 1378 (Fed. Cir. 2003) (requiring further corroboration of the testimony of a nonparty witness) (emphasis added); *Texas Digital Sys., Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1217 (Fed. Cir. 2002) (same) (emphasis added); *Finnigan Corp. v. Int’l Trade Comm’n.*, 180 F.3d 1354, 1369 (Fed. Cir. 1999) (discussing testimony offered to corroborate another witness’s testimony) (emphasis added).

154. *Engate, Inc. v. Esquire Deposition Servs., L.L.C.*, 331 F. Supp. 2d 673, 685 (N.D. Ill. 2004) (emphasis added).

155. The Federal Circuit expressed confusion over this issue in its most recent oral argument on the subject. See *Recording of Oral Argument*, *supra* note 105.

156. *Lacks Indus., Inc. v. McKechnie Vehicle Components USA, Inc.*, 322 F.3d 1335, 1350 (Fed. Cir. 2003).

157. *Id.* (emphasis added).

158. See, e.g., *Cooper v. Goldfarb*, 154 F.3d 1321 (Fed. Cir. 1998). *Cooper* involved an interference dispute between the named parties. *Id.* at 1323. Admitting that “no direct evidence supported Goldfarb’s testimony,” the court found that it was sufficiently corroborated by the testimony of two neutral parties and ultimately affirmed the Board’s award of priority to Goldfarb. *Id.* at 1330.

159. *Thomson, S.A. v. Quixote Corp.*, 166 F.3d 1172, 1176 (Fed. Cir. 1999) (emphasis added).

160. See *Finnigan Corp. v. Int’l Trade Comm’n.*, 180 F.3d 1354, 1368–69 (Fed. Cir. 1999). *Finnigan* suggests that the *Thomson* quote referred to the “sufficiency of the corroborating evidence” and not the “necessity” of it, and notes that *Thomson* involved evidence other than just oral testimony, including “an expert’s report . . . [his] exhibits [and] documents.” *Id.* at 1368 (quoting *Thomson*, 166 F.3d at 1174). While there was such documentary evidence in *Thomson*, *Finnigan*’s comment rings hollow because the *Thomson* court expressly refused to consider this evidence in its opinion. See *Thomson*, 166 F.3d at 1176 (“[W]e do not reach *Thomson*’s argument that *Quixote*’s expert’s claim charts and expert report are entitled to no weight.”); see also Underwood, *supra* note 64, at 14–17 (detailing *Finnigan*’s failed attempt to reconcile *Thomson*).

ness's statements can corroborate another's. However, it is clear that a party should be leery of heading to court armed only with oral testimony.

Where oral testimony has proven successful in corroborating other testimony, it is usually in cases where the corroborating testimony is very thorough and fact specific.¹⁶¹ For example, the Federal Circuit has said that testimony intended to prove anticipation should come from "one skilled in the art" and must "identify each claim element, state the witnesses' interpretation of the claim element, and explain in detail how each claim element is disclosed in the prior art reference."¹⁶² If the court detects an element of ambiguity or vagueness in the supporting testimony, it is likely to demand further corroboration.¹⁶³ In fact, the court will ignore such testimony altogether if there is sufficient documentary corroboration to fall back on.¹⁶⁴ However, when the corroborating witness is clearly knowledgeable on the subject and his or her testimony is un rebutted, the court is likely to give the testimony more deference.¹⁶⁵ An example of valuable supporting oral testimony is that of the lab technician in *Brown II*. Recall that the court found her testimony and notes alone sufficient to corroborate the inventor's claims of diligence.¹⁶⁶ The court was clearly impressed with the detail of this testimony, dedicating two paragraphs to a description of its specificity.¹⁶⁷

Nevertheless, there are cases where the Federal Circuit admittedly had no problem with the credibility of the witnesses or the content of their testimony, yet still refused to grant it corroborative value based on precedent alone.¹⁶⁸ With such holdings in force, a party cannot feel comfortable relying on oral testimony alone to corroborate its story.

161. Note that this is the essence of the fifth *Reuter* factor, "the extent and details of the corroborating testimony." See *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1371 (Fed. Cir. 1998).

162. *Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d 1304, 1315–16 (Fed. Cir. 2002) (finding testimony of witness Dezmelyk to lack the detail required to prove defendant's case).

163. See, e.g., *Dow Chem. Co. v. Mee Indus., Inc.*, 341 F.3d 1370, 1378 (Fed. Cir. 2003) (noting the "vague" element of the witness testimony regarding key facts and ultimately quoting *Finnigan's* requirement that such testimony needs further corroboration).

164. See, e.g., *Mitsubishi Elec. Corp. v. Ampex Corp.*, 190 F.3d 1300, 1304–05 (Fed. Cir. 1999). The main testimonial evidence in this case came from a witness who could not recall key facts. *Id.* However, the Court ignored this and "conclude[d] that the documentary evidence itself could support a finding that the claimed invention was [invalid]." *Id.* at 1305.

165. See, e.g., *Sandt Tech., Ltd. v. Resco Metal & Plastics Corp.*, 264 F.3d 1344, 1352 (Fed. Cir. 2001) (distinguishing witness Horbach's testimony from that of the four witnesses in *Woodland Trust* by noting his lack of interest in the suit, his level of knowledge regarding the subject matter, and the fact that his testimony went unchallenged).

166. See *supra* text accompanying note 91.

167. See *Brown v. Barbacid (Brown II)*, 436 F.3d 1376, 1380–81 (Fed. Cir. 2006).

168. See, e.g., *Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728, 743 (Fed. Cir. 2002) ("We do not conclude that the witnesses below were not credible. Rather, with the guidance of precedent cautioning against the reliance on oral testimony alone, we hold that the evidence of record did not provide the clear and convincing evidence necessary to invalidate the patent for prior public knowledge."); *Finnigan Corp. v. Int'l Trade Comm'n*, 180 F.3d 1354, 1370 (Fed. Cir. 1999) ("This is not a judgment that [the supporting witness's] testimony is incredible, but simply that such testimony alone cannot surmount the hurdle that the clear and convincing evidence standard imposes in proving patent invalidity.").

4. *The Interest of the Witness*

Though the previous section cautioned against reliance on oral testimony, the Federal Circuit has given so much attention to one specific element of such testimony that it requires separate discussion. This element is the witness's level of interest in the outcome of the litigation, and a synopsis of what constitutes corroboration to today's Federal Circuit would not be complete without an analysis of this element. Though a witness's level of interest is only one of the eight *Reuter* factors,¹⁶⁹ the court seems to focus on it more than all of the others combined when evaluating corroborative testimony. Unfortunately, the court is in a poor position to evaluate this interest level because it has no opportunity to experience the witness testimony in person.

Federal Circuit decisions vary as to how much emphasis they place on the interest of a witness and on what level of interest they consider significant. The cases all agree that parties to the litigation are "interested" in its outcome and, thus, are of no value as corroborating witnesses. Even the *Thomson* court would have seemingly required further corroboration of testimony from witnesses standing to "directly and substantially gain" from the outcome of the case.¹⁷⁰ However, the *Thomson* court apparently saw no problem with basing the invalidation of a patent on testimony from two co-inventors employed by a company that served as a supplier to the defendant.¹⁷¹ In *Adenta GmbH v. OrthoArm, Inc.*, moreover, the Federal Circuit had no trouble accepting the lower court's finding that an independent sales representative of the plaintiff and a vice president of a company aligned with the plaintiff could testify as uninterested parties on the plaintiff's behalf.¹⁷² In these cases, the outcome of the litigation might not directly earn the witnesses substantial financial benefit, but it is easy to see how they might profit indirectly.

Although *Thomson* and *Adenta* seem to define "interest" in a strict sense, in many cases the Federal Circuit has discounted witness testimony based on a more indirect relationship to the parties or the outcome. In one such case, a company offered testimony from a former employee in an attempt to invalidate the patent of a competitor.¹⁷³ Without discussion, the Federal Circuit labeled her an interested party and found

169. In fact, it is the second one as listed in the actual case. See *In re Reuter*, 670 F.2d 1015, 1021 n.9 (C.C.P.A. 1981). However, when assessing the interest of a witness, the court seems to define "interest" more broadly than simply having a potential for monetary gain. Thus, it could also be said to encompass the eighth *Reuter* factor, "relationship between witness and alleged prior user." *Id.* If this relationship is significant enough, the witness might have an "interest" of a more personal nature. Thus, these two *Reuter* factors are intertwined.

170. *Thomson, S.A. v. Quixote Corp.*, 166 F.3d 1172, 1176 (Fed. Cir. 1999).

171. *Id.*

172. See 501 F.3d 1364, 1372 (Fed. Cir. 2007).

173. *Union Carbide Chem. & Plastics Tech. Corp. v. Shell Oil Co.*, 308 F.3d 1167, 1189 (Fed. Cir. 2002).

her testimony insufficient because it was uncorroborated.¹⁷⁴ The defendant in *Woodland Trust* offered testimony from four witnesses to corroborate its claim of prior use.¹⁷⁵ These witnesses included relatives, former employees, and “life-long” friends of the defendant.¹⁷⁶ Though none of these witnesses would see financial gain from the outcome of the case, the court emphasized the “relationship of the witnesses” to the defendant and found their testimony insufficiently corroborative.¹⁷⁷ In *Juicy Whip*, the court focused on the witnesses’ business relationships with the defendant, some of which were rather tenuous.¹⁷⁸ Nevertheless, the court found that “[n]one of [the witnesses could] be said to be disinterested.”¹⁷⁹

*Oney v. Ratliff*¹⁸⁰ gives an example of why such a broad definition of “interest” might be appropriate in patent cases. Plaintiff Oney had patented a style of novelty T-shirts and sued defendant Ratliff for infringement.¹⁸¹ As a defense, Ratliff claimed that he had sold such T-shirts prior to the plaintiff’s patent application.¹⁸² Ratliff obtained affidavits from two separate retailers confirming this, but their statements were based on sales records Ratliff provided them.¹⁸³ When it was discovered that these sales records were for a different style of shirt, one retailer immediately retracted her statement.¹⁸⁴ However, the other retailer claimed an “independent recollection” of the sale and maintained her affidavit in the face of almost certain falsehood.¹⁸⁵ The Court noted this latter retailer was a “longtime friend” of Ratliff and disregarded her statement.¹⁸⁶

Though the Federal Circuit has typically been skeptical of testimony from witnesses with a significant relationship to the parties, there are cases in which the court has overlooked such relationships. Brown succeeded through the testimony of his lab assistant.¹⁸⁷ Price won priority with the help of his secretary, who shared his name.¹⁸⁸ Goldfarb prevailed based on the testimony of a sales manager who supplied him the equipment for his design, yet the court didn’t even question the salesman’s level of interest.¹⁸⁹ These cases, however, are the exception and

174. *Id.*

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

176. *See id.*

177. *Id.* at 1373.

178. For instance, one witness knew the defendant only through a business relationship with the defendant’s brother-in-law. *See Juicy Whip, Inc. v. Orange Bang, Inc.*, 292 F.3d 728, 743 (Fed. Cir. 2002).

179. *Id.*

180. 182 F.3d 893 (Fed. Cir. 1999).

181. *Id.* at 894.

182. *Id.*

183. *Id.*

184. *Id.* at 895.

185. *Id.*

186. *Id.* at 897.

187. *Brown v. Barbacid (Brown II)*, 436 F.3d 1376, 1380–81 (Fed. Cir. 2006).

188. *Price v. Symsek*, 988 F.2d 1187, 1195–96 (Fed. Cir. 1993).

189. *Cooper v. Goldfarb*, 154 F.3d 1321, 1330 (Fed. Cir. 1998).

not the rule. Despite often having to rely on the trial court transcripts to assess witness credibility, the Federal Circuit has shown little hesitation in labeling witnesses as interested parties. In fact, the court has even suggested that *all* inventors are interested parties, simply based on the fact that proving they were first in the field would give them some sense of personal pride.¹⁹⁰ Thus, the court might find a testifying inventor to be an interested party even if the inventor has absolutely no relationship with the parties and no connection to the litigation.

B. *The Burden of Creating and Retaining Evidence*

Identifying what evidence is most likely to succeed in corroborating an inventor's testimony is helpful only to an inventor who has such evidence available. Obviously a party may not *recreate* contemporary evidence that they did not think to retain. Thus, before proposing a change to strengthen and clarify the corroboration standard, this note considers the burden of retaining evidence that such a proposal would create for inventors.

It is easy to look at cases in hindsight and suggest where evidence should have or could have been stronger. However, it would be very stressful for inventors to find themselves in situations where they need evidence but lack it. Imagine an inventor John Doe who created a technology before anyone else. He put the invention to commercial use but had no desire to patent it.¹⁹¹ Now another party has independently developed the same technology, patented it, and seeks to keep Mr. Doe from using it. Of course, Mr. Doe must only show the court that he used the technology in the United States before the patentee invented it to invalidate the patent,¹⁹² but he has nothing save his friend's hearsay to support him. If only he had kept those purchase orders

Having the desired contemporaneous documentary evidence to support an inventor's testimony at the time the inventor most needs it requires (1) that it be created in the first place; and (2) that it be retained, potentially for quite a long time.¹⁹³ Were the Federal Circuit to come to a consensus and clearly require such evidence to corroborate inventor testimony, the first reaction from critics would likely be to suggest

190. *Finnigan Corp. v. Int'l Trade Comm'n*, 180 F.3d 1354, 1368 (Fed. Cir. 1999) ("A witness who testifies to antedating the invention of the patent-in-suit can be expected to derive a sense of professional or personnel [sic] accomplishment in being the first in the field, and in this sense is not uninterested in the outcome of the litigation, even if that witness is not claiming entitlement to a patent.").

191. There are many reasons why inventors might choose not to patent a device. For instance, they may lack the funds to do so, they may have waited too long to submit an application, or they may wish to maintain it as a trade secret, which offers a low-cost solution and keeps the invention from the public. See 1 JOHN GLADSTONE MILLS III ET AL., *PATENT LAW FUNDAMENTALS* § 4.23 (2d ed. 2007).

192. See 35 U.S.C. § 102(a) (2000).

193. Though the life of a patent is twenty years from the date of filing, see 35 U.S.C. § 154(a)(2) (2000), there are many situations where this type of litigation relies on evidence from long before the patent was filed. See, e.g., *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1369 (Fed. Cir. 1998) (alleging prior use dating back almost forty years from the time of trial).

that it places too great a burden on the noncorporate inventor, or “small entity” as the Patent Office has classified them.¹⁹⁴

1. *Concern for the Small Entity*

To understand the significance of this concern, one must realize that the U.S. patent system predates corporations as they exist today and was utilized mostly by independent inventors as recently as the early twentieth century.¹⁹⁵ As business entities have increased filings,¹⁹⁶ the government has been careful to avoid shutting the door to the patent office on small entities.¹⁹⁷ Despite the trends toward globalization and large-scale research, small entities still have their advocates.¹⁹⁸ In fact, most recent proposals to modernize the U.S. patent system have first had to sustain a challenge from this community. One example was the move to allow publication of applications prior to patent grant.¹⁹⁹ Though this change to the patent laws survived the small entity challenge,²⁰⁰ others have yet to succeed. For instance, despite the strong impetus toward a first-to-file system,²⁰¹ concern for the little guy remains the primary reason given to justify maintaining the confusing and unique first-to-invent system.²⁰²

There is no doubt that corporate research and development departments have more resources at their disposal than do individual inventors. It follows that a corporation would have more means with which to document its inventions, record its sales, and generally warehouse information that might later prove useful in patent litigation. In fact, an entire industry has spawned to support corporations in their mis-

194. See 37 C.F.R. § 1.27 (2007).

195. J. Douglas Hawkins, *Importance and Access of International Patent Protection for the Independent Inventor*, 3 U. BALT. INTELL. PROP. L.J. 145, 148 (1995) (“Independent inventors accounted for about half of all patent filings in the United States around fifty years ago.”).

196. See *id.* at 147.

197. Illustrative of this is the fact that the PTO has created a separate fee schedule for small entities. See 37 C.F.R. § 1.17 (2007).

198. See Hawkins, *supra* note 195, at 146–48 (noting both the importance of the patent system to the individual inventor and the importance of the individual inventor to science).

199. See Len S. Smith, *Promoting the Progress of Science and America’s Small Entity Inventors: Inventing an Improved U.S. Patent Application Publication Provision out of the Prior Art*, 77 WASH. U. L.Q. 585, 597–98 (1999).

200. See 35 U.S.C. § 122(b)(1)(A) (2000). Though publications are now published after eighteen months, several concessions were made for small entities. For example, if the applicant agrees not to file the same subject matter in other countries, they may opt out of the publication rule. See *id.* § 122(b)(2)(B)(i). Thus, the goal of international harmonization was met while allowing the small entity to avoid early publication.

201. Doug Harvey, Comment, *Reinventing the U.S. Patent System: A Discussion of Patent Reform Through an Analysis of the Proposed Patent Reform Act of 2005*, 38 TEX. TECH L. REV. 1133, 1140–42 (2006).

202. See, e.g., Ned L. Conley, *First-to-Invent: A Superior System for the United States*, 22 ST. MARY’S L.J. 779, 782–83 (1991); Harvey, *supra* note 201, at 1138. All other major countries operate on a simpler first-to-file system. For a discussion of the complexities of our system, see Toshiko Take-naka, *Rethinking the United States First-to-Invent Principle from a Comparative Law Perspective: A Proposal to Restructure § 102 Novelty and Priority Provisions*, 39 HOUS. L. REV. 621, 630–45 (2002).

sion of data storage and document retention.²⁰³ However, establishing a clear requirement for contemporaneous documentary evidence to satisfy the corroboration rule will place small entities at no more of a disadvantage than they suffer under the current rule that often considers oral testimony. Corporations can afford to span the globe to find potential support for their case,²⁰⁴ while small entities quite often cannot even afford litigation to begin with.²⁰⁵

As is often the case with the small-entity argument, closer evaluation reveals that the change they fear may actually benefit them.²⁰⁶ This note has shown how parties have succeeded under today's corroboration rule in several cases by offering mere oral testimony as support.²⁰⁷ For a small entity seeking to invalidate a patent based on its prior use or invention or seeking to win a priority dispute, this may be a saving grace if it lacks documentary support. However, the rule works both ways. If the small entity holds the patent being challenged, oral testimony of the challenger's witness may be the small entity's downfall. The fact is, corporations will be more likely to produce that witness than small entities. A small entity may have a few witnesses willing to support its story, but those witnesses are more likely to be interested²⁰⁸ and, thus, of less corroborative value. In contrast, a corporation that develops technology in a team environment can call upon present and former employees, team members from other companies, or business associates that were related to the project. Furthermore, it can afford to search for some unrelated third party who might be able to provide invalidating testimony.²⁰⁹ This option is likely to be completely unavailable to small entities due to cost. Thus, requiring contemporaneous documentary corroboration may actu-

203. For example, the mission statement of one industry leader reads, in part, "To provide superior value to our customers by: Protecting and storing their information as if it were our own" Iron Mountain, <http://www.ironmountain.com/company> (last visited Mar. 8, 2008).

204. A good example of this is *Ethicon, Inc. v. United States Surgical Corp.*, 135 F.3d 1456 (Fed. Cir. 1998). Facing an infringement claim, U.S. Surgical Corp. located a potential co-inventor and paid him for a retroactive license so as to provide a defense to infringement. The company then helped him produce corroborative evidence of inventorship. *Id.* at 1459.

205. See Jeff A. Ronspies, Comment, *Does David Need a New Sling? Small Entities Face a Costly Barrier to Patent Protection*, 4 J. MARSHALL REV. INTELL. PROP. L. 184, 196 (2004).

206. This has been the case with other such arguments against change by small-entity advocates. See Takenaka, *supra* note 202, at 652 (explaining how a change to a first-to-file system might actually help small inventors); see also Gerald J. Mossinghoff, *The U.S. First-to-Invent System Has Provided No Advantage to Small Entities*, 84 J. PAT. & TRADEMARK OFF. SOC'Y 425 (2002) (analyzing data to prove the point suggested by the title).

207. See discussion *supra* Part III.A.3.

208. By definition, small entities are individuals, small business ventures, or nonprofit organizations. Such entities do not have significant commercial contacts that might be in a position to offer useful testimony or act as disinterested third-party witnesses. Furthermore, they do not have the means to conduct detailed searches for someone that might be able to give evidence of prior use. More likely, their witnesses are friends or family members.

209. See, e.g., *Dow Chem. Co. v. Mee Indus., Inc.*, 341 F.3d 1370, 1378 (Fed. Cir. 2003) (analyzing the testimony of witness Twombly that defendant produced to allege a prior use). Twombly appears to have had no relation to Mee Industries and was simply an independent inventor the company uncovered. See *Dow Chem. Co. v. Mee Indus., Inc.*, 264 F. Supp. 2d 1018, 1029 (M.D. Fla. 2002).

ally remove more ammunition from corporations than it would from small entities.

Small entities may also benefit from a more clear, strict corroboration rule because it would better allow them to weigh the merits of their cases prior to litigation. Ambiguity leads to litigation, whereas certainty leads to settlement. In other areas, patent law strives for clarity and certainty to give the public notice of what is and what is not covered by a patent.²¹⁰ The Supreme Court recently described this clarity as “essential to promot[ing] progress,”²¹¹ which was the goal of the Constitution in granting Congress the power to create a patent system in the first place.²¹² A similar goal of clarity would be served here by allowing parties to more clearly determine their chances of success at trial prior to pursuing litigation. The more uncertain a party’s case is heading into litigation, the higher its risk. For the small entity, this heightened risk caused by the present ambiguous corroboration standard may often be prohibitive.

2. *Assessing the Creation/Retention Burden*

Any decision to strengthen the evidentiary burden required to overturn a patent would likely have its opponents, as some already feel it is too high.²¹³ But asking inventors to keep detailed records of their work is nothing new.²¹⁴ Inventors pursuing a patent generally know of the requirement to prove conception and therefore keep detailed notebooks that are witnessed, signed, and dated by third parties in order to satisfy the requirement.²¹⁵ The burden is more likely to increase with a more strict corroboration requirement in the case of the unsuspecting inventor who has no desire to patent and, thus, has less reason to keep detailed records. However, it cannot be said that there is *no* reason for such a person to keep records, as is shown by the several cases discussed above

210. For instance, “the role of the claims is to give public notice of the subject matter that is protected.” *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d 916, 922 n.5 (Fed. Cir. 2004). Patented items must also be marked with the patent number so as to give the public notice. *See* 35 U.S.C. § 287(a) (2000). Without such a mark, damages for infringement are not generally available. *See id.*

211. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 730 (2002). The Court went on to say that “[a] patent holder should know what he owns, and the public should know what he does not.” *Id.* at 731.

212. U.S. CONST. art. I, § 8, cl. 8 (granting Congress the power “[t]o promote the progress of science and useful arts”).

213. *See* Okey, *supra* note 8, at 567 (“There should be only one standard of proof in patent litigation, a preponderance of the evidence.”).

214. It has long been customary for inventors to keep detailed records, and the risks of not doing so have been well advertised. *See, e.g.*, Dianne Callan, *Corporate Proprietary Procedures for Software*, 298 P.L.I./PAT. 549, 565 (1990) (Westlaw) (“At the risk of sounding like a broken you-know-what, the three most important things you can do to protect your inventions are to keep records, keep records, and keep records.”).

215. Sean T. Carnathan, *Patent Priority Disputes: A Proposed Re-Definition of “First-to-Invent,”* 49 ALA. L. REV. 755, 804 (1998).

where such evidence would have carried the day.²¹⁶ Even if inventors do not plan to patent their ideas, they still have incentive to keep records so as to defend against others who may do so and then seek to prohibit the inventor's use. Insisting on contemporaneous corroborative evidence would only highlight this incentive.

Though the burden of creating and retaining documentation may indeed increase, it is unlikely to present a great challenge. As discussed in Part III.A.2, courts have accepted all manner of contemporary documentation as corroborative. Sales receipts, photographs, letters from third parties, or even pamphlets from a trade show might suffice. Because these things are created in the course of business anyway, the burden is really more in retention. But even this is made easy in the digital age where the PTO and federal courts have agreed to admit electronic records.²¹⁷ Documents could simply be scanned in, placed in a database, and forgotten about until needed. The only remaining concern is for those that might be retroactively affected by a change in the corroboration requirement. While their opportunity for document retention may be gone, at least they will be able to more confidently assess their chances of success prior to entering litigation.

C. *Effects of Proposed Patent Act Changes on the Corroboration Rule*

Now that the ambiguities of the "bright line" corroboration rule have been exposed and concerns over clarifying the rule have been addressed, it is useful to assess the proposal for a clearer rule in light of anticipated changes to the Patent Act. Though no major changes have come to pass recently,²¹⁸ there is considerable domestic and international pressure to harmonize the U.S. patent system with those of other developed countries.²¹⁹ Congress has felt this pressure and has been involved in efforts to reform the Patent Act for several years. The first proposal was Congressman Berman's Patent Quality Assistance Act of 2004 in the House.²²⁰ After committee markup and industry input, this matured into the Patent Act of 2005, which was debated in separate bills on the floor of both the House and Senate.²²¹ Ultimately these bills stalled due to elections and other concerns, but they have resurfaced in the Patent Re-

216. See, e.g., *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368 (Fed. Cir. 1998). If defendants would have thoroughly documented the irrigation system they alleged to have used, the court would surely have given more weight to their testimony.

217. Lisa A. Dolak, *Patents Without Paper: Proving a Date of Invention with Electronic Evidence*, 36 HOUS. L. REV. 471, 472-73 (1999). There are many common objections to the veracity of electronic evidence, but generally the objections have failed. Dolak's article provides a good discussion of these objections and defends the use of electronic evidence in patent law. See *id.* at 485-88.

218. In fact, the last major update to the Patent Act was in 1952, and we are still operating under that version of the Act. See 1 CHISUM, *supra* note 17, at OV-12.

219. See Smith, *supra* note 199, at 593.

220. H.R. 5299, 108th Cong. (2004).

221. S. 3818, 109th Cong. (2006); H.R. 2795, 109th Cong. (2005).

form Act of 2007.²²² The effort now has bipartisan support and recently passed by a vote of 220 to 175 in the House.²²³ The Senate Judiciary Committee recently approved its version of the bill and is pressing the full Senate for a vote.²²⁴ The Senate version varies in several respects,²²⁵ and the Bush Administration has noted some lingering concerns with the House version of the bill.²²⁶ Nevertheless, reform efforts are moving ever forward, and it seems that major updates to U.S. patent laws are imminent.²²⁷

Neither the Senate nor the House versions of the act make reference to the corroboration rule, but they include some proposals that would have direct effects on when the corroboration rule would be required. Furthermore, moving to a strict, clear corroboration requirement aligns with some stated goals of the proposed legislation. Thus, these goals and proposals are reviewed at a high level.

1. *The Goal of Streamlined Litigation*

The media,²²⁸ academics,²²⁹ and leaders of industry²³⁰ have given considerable attention to Congress's recent attempts to reform the Patent Act. This is because the proposals for change are sweeping, the need for them has been mounting for over fifty years, and there are several different interests at stake. Some focus on the need to harmonize our patent system with those of other nations.²³¹ Others see the elimination of "patent trolling" as a key goal.²³² However, nearly all would agree that any new legislation should make attempts to reel in unwieldy patent litigation that burdens all players involved.

222. H.R. 1908, 110th Cong. (2007); S. 1145, 110th Cong. (2007).

223. 153 CONG. REC. H10307 (daily ed. Sept. 7, 2007).

224. Brendan Pierson, *Patent Reform Inches Closer to Passage*, IP LAW360.COM, Jan. 15, 2008, <http://ip.law360.com/Secure/ViewArticle.aspx?id=44076> (last visited Mar. 8, 2008).

225. For instance, it still contains the prior user rights expansion which the House removed to gain support. This will be further discussed *infra* Part III.C.3.

226. See OFFICE OF MGMT. & BUDGET, EXECUTIVE OFFICE OF THE PRESIDENT, STATEMENT OF ADMINISTRATION POLICY, H.R. 1908—PATENT REFORM ACT OF 2007 (Sept. 6, 2007), available at <http://www.whitehouse.gov/omb/legislative/sap/110-1/hr1908sap-r.pdf>.

227. See Brad Pedersen & Vadim Braginsky, *The Rush to a First-to-File Patent System in the United States: Is a Globally Standardized Patent Reward System Really Beneficial to Patent Quality and Administrative Efficiency?*, 7 MINN. J. L. SCI. & TECH. 757, 757–58 (2006).

228. See, e.g., Michelle Kessler, *Pressure Mounts for Reform of Patent System*, USA TODAY.COM, May 2, 2005, http://www.usatoday.com/money/companies/regulation/2005-05-02-patent-reform_X.htm; Tom Ramstack, *Firms Call Patent Reform Bill Too Weak*, WASH. TIMES.COM, Sept. 14, 2007, <http://washingtontimes.com/article/20070914/BUSINESS/109140048/1006>.

229. See, e.g., Donald S. Chisum, *Reforming Patent Law Reform*, 4 J. MARSHALL REV. INTELL. PROP. L. 336 (2005); James G. McEwen, *Is the Cure Worse than the Disease? An Overview of the Patent Reform Act of 2005*, 5 J. MARSHALL REV. INTELL. PROP. L. 55 (2005).

230. See, e.g., Robert A. Armitage, *The Conundrum Confronting Congress: The Patent System Must Be Left Untouched While Being Radically Reformed*, 5 J. MARSHALL REV. INTELL. PROP. L. 268, 268 (2006). Robert Armitage is a Senior Vice President at Eli Lilly and Company. See *id.*

231. See, e.g., Pedersen & Braginsky, *supra* note 227, at 758.

232. See, e.g., Robert E. Thomas, *Vanquishing Copyright Pirates and Patent Trolls: The Divergent Evolution of Copyright and Patent Laws*, 43 AM. BUS. L. J. 689, 721 (2006).

Patent litigation is notoriously lengthy and expensive. Many cases have circled the courts for more than a decade, often far outlasting any protection provided by the patent they seek to enforce or overturn.²³³ The costs of this litigation are, of course, tremendous, and often the company with the greater war chest will prevail over the company with the better technology.²³⁴ This can have stifling effects on innovation²³⁵ and ultimately drive up prices in the marketplace.²³⁶ Many look to patent reform as a key method to reduce this litigation burden.²³⁷ Senator Orin Hatch, who sponsored the Senate's 2005 version of the Patent Reform Act, addressed the concerns over patent litigation during his introduction of the bill on the Senate floor.²³⁸ Noting that "patent litigation has become a significant problem," Senator Hatch pointed at patent law as unjustifiably "driv[ing] up the cost and uncertainty of litigation."²³⁹ Such concerns have continued to be voiced from all sides of the debate.²⁴⁰ This cost hurts all parties involved, and any eventual patent reform will surely seek to streamline patent litigation.

This is noteworthy because promoting a consistent application of a clear corroboration requirement addresses this same goal. As discussed in Part III.B.1, parties may struggle to evaluate their evidence prior to litigation given the different holdings of the Federal Circuit. A reading of *Thomson*²⁴¹ or *Price*²⁴² might convince inventors to proceed with only oral testimony to support their contention, while a reading of *Finnigan*²⁴³ or *Juicy Whip*²⁴⁴ would encourage them to settle. Furthermore, it may be impossible for inventors to determine if a court will see their witnesses as interested given the different definitions of this concept gleaned from *Finnigan* and *Price*. Requiring contemporaneous evidence to satisfy the corroboration requirement would obviate these concerns. The requirement is court-made law and the legislature is unlikely to address it.

233. See, e.g., *Brown v. Barbacid (Brown II)*, 436 F.3d 1376, 1378 (Fed. Cir. 2006). This case dealt with an interference between two applications filed in the early 1990's. *Id.* The case had already been through one trip to the Federal Circuit and was back on a related issue. *Id.* In once again remanding to the Patent Board, the court noted that it "deplore[d] the lengthy pendency of [the] proceeding," but had no choice other than remand under present laws. *Id.* at 1383.

234. See JAFFE & LERNER, *supra* note 1, at 6–15.

235. See *id.* at 19–20.

236. See *id.* at 169.

237. See *id.* at 51.

238. 152 CONG. REC. S8830 (daily ed. Aug. 3, 2006) (statement of Sen. Hatch).

239. *Id.*

240. The recent House floor debate was replete with the need for H.R. 1908 to address excessive patent litigation. See, e.g., 153 CONG. REC. H10284 (daily ed. Sept. 7, 2007) (statement of Rep. Eshoo) ("Loopholes and shortcomings in the disposition of patent cases also allow baseless claims of infringement to create unnecessary litigation and extort nuisance settlements, sapping billions from economic growth, and creating a drag on real innovation.").

241. See *supra* Part II.C.2.

242. *Id.*

243. See *supra* note 190 and accompanying text.

244. See *supra* Part II.C.3.

However, were the Federal Circuit to clarify the standard, it would be acting in accordance with a key legislative intent behind patent reform.

2. *First-to-File Effects on the Corroboration Rule*

Though streamlining litigation is a clear goal of patent reform, it is not the only motivating factor. Global harmonization of patent law is another objective. Congressman Berman focused his introduction of the 2005 House bill on this topic, noting that the proposed act “contains a number of initiatives designed “to . . . harmonize U.S. patent law with those of foreign countries, thereby ensuring that patents are positive forces in the marketplace.”²⁴⁵ Namely, the “foreign countries” are Japan and the European Union, which, together with the United States, control the world’s key patent systems.²⁴⁶ If a corporation wants global patent rights on a technology, it must file independently with each of these three governments. This is obviously very costly and time consuming, which explains why such corporations have lobbied hard for harmonization between the three systems.²⁴⁷ Harmonization of “the big three” is a key step in the ultimate goal of having one system for global intellectual property rights.²⁴⁸

Probably the most glaring difference between the U.S. patent system and those of Europe and Japan is that the U.S. system grants patent rights to the first person to invent a technology²⁴⁹ (a “first-to-invent” system) while the others grant patent rights to the first person to file for a patent on the invention (a “first-to-file” system).²⁵⁰ Congressman Berman recognized this by following his introduction of the harmonization goal with a discussion of the bill’s move to a first-to-file system.²⁵¹ The Congressman further endorsed this move by suggesting that it will bring technology into the public domain more quickly.²⁵² The move to a first-to-file system remains as perhaps the most significant alteration in the Patent Reform Act of 2007.²⁵³ There are many positive and negative ramifications that would likely result from moving to a first-to-file sys-

245. 151 CONG. REC. E1160 (daily ed. June 8, 2005) (statement of Rep. Berman).

246. See Pedersen & Braginsky, *supra* note 227, at 764.

247. See *id.* at 765.

248. See *id.*

249. See 35 U.S.C. § 102(g) (2000) (listing one of the factors that bars a patent as being that another has previously achieved conception and reduction to practice).

250. See Pedersen & Braginsky, *supra* note 227, at 758. This has been labeled “the major patent harmonization issue remaining.” Kim Taylor, Note, *Patent Harmonization Treaty Negotiations on Hold: The “First To File” Debate Continues*, 20 J. CONTEMP. L. 521, 544 (1994).

251. 151 CONG. REC. E1160 (daily ed. June 8, 2005) (statement of Rep. Berman) (“Currently, the U.S. grants patents to whomever is ‘first to invent.’ The bill amends this standard so that the ‘first inventor to file’ is entitled to the ownership of a patent . . . [T]his modification will bring U.S. patent laws into harmony with the patent law in many foreign countries.”).

252. *Id.*

253. Both the Senate and the House versions of this Act feature a complete overhaul of 35 U.S.C. § 102 that eliminates the interference process of § 102(g) and replaces it with a first-to-file system. See H.R. 1908, 110th Cong. § 3(b) (2007); S. 1145, 110th Cong. § 3(b) (2007).

tem. Interested parties from all sides have considered this topic, and there is considerable literature both for and against the move.²⁵⁴ Though it is beyond the scope of this note to assess the merits of this proposal, its affect on the corroboration rule is important to mention.

One of the key benefits of a first-to-file system is its simplicity. The first inventor to file with the patent office would receive priority over all others.²⁵⁵ Gone would be the PTO's current complex interference procedure that evaluates factors such as conception, reduction to practice, and diligence in order to determine who was the first to invent.²⁵⁶ Of the corroboration rule's three applications discussed in Part II.B, this is by far the most frequent.²⁵⁷ It is also arguably the most complex application because the Federal Circuit applies different corroboration standards to different elements of an interference dispute.²⁵⁸ However, the corroboration requirement would still apply to attempts to overturn a patent or challenge inventorship, and, thus, good corroborating evidence would still have value. Unfortunately, eliminating the interference application would significantly reduce the incentive for inventors in the development stages to gather and retain such evidence because they would have much less foreseeable need for it.²⁵⁹ Because this contemporaneous material would not be retained, the logical result would be more reliance on oral testimony and circumstantial evidence should the need for corroboration eventually arise. In order to avoid the unpredictable and inconsistent outcomes that result when inventors rely upon such evidence, the incentive to retain records that would vanish in a first-to-file system must be replaced. Installing a clear requirement for such records to corroborate testimony would help restore that incentive.

Another aspect of a move to a first-to-file system is the message it would send regarding small entities. Small entities continue to argue that they will face inequities should a first-to-file system be adopted.²⁶⁰ Though this may be true, the fact that the House has already approved the adoption suggests that the corporate lobby seeking harmonization has obtained the upper hand. Yet, with respect to the corroboration requirement, moving to a first-to-file system will most likely help small entities because they would have less chance of running up against the re-

254. For a recent summary of this literature, see Pedersen & Braginsky, *supra* note 227, at 762 n.27.

255. See Takenaka, *supra* note 202, at 628–29.

256. *Id.* at 644–45. In fact, the proposed Patent Reform Act of 2007 would remove all reference to the term “interference” from Title 35. See H.R. 1908, 110th Cong. § 3(i)–(j) (2007).

257. See *supra* text accompanying note 16.

258. For instance, it takes much less to corroborate testimony attempting to show diligence than it does to corroborate testimony regarding conception or reduction to practice. See *Brown v. Barbacid (Brown II)*, 436 F.3d 1376, 1380 (Fed. Cir. 2006).

259. See Pedersen & Braginsky, *supra* note 227, at 761.

260. James E. White, *The U.S. First-to-Invent System, the Mossinghoff Conclusion, . . . and Statistics*, 85 J. PAT. & TRADEMARK OFF. SOC'Y 357, 362–64 (2003); see also Conley, *supra* note 202, at 782–83.

quirement. Small entities are often involved in interferences, and this most frequent application of the corroboration requirement would be no more. Thus, a move to a first-to-file system would tend to further weaken any argument small entities might have against a strengthening of the standard as discussed in Part III.B.1.

3. *The Effects of Prior User Rights Expansion*

Just as the proposal for a first-to-file system eliminates one of the three applications of the corroboration rule, a side effect of the proposal would most likely create a new one. An inherent problem with a first-to-file system is that the party who receives priority, and, thus, eventual patent rights, is quite possibly not the first to have invented or used the technology. Prior inventors may have been slower getting to the patent office due to resource constraints, or, alternatively, they may have opted to use the technology as a trade secret.²⁶¹ Without allowances, a first-to-file system would inequitably punish such inventors for their delay or their decision not to patent²⁶² because now they could be barred from the technology they were the first to invent.²⁶³ To counter this injustice, first-to-file patent systems typically make wide allowances for “prior user rights.”²⁶⁴

The prior user rights doctrine grants immunity to prior inventors and users so they may continue practicing their inventions notwithstanding the technology’s subsequent patent by another.²⁶⁵ Thus, under this doctrine, the prior use is a defense to infringement for the prior user, but the patent remains valid against all other infringers.²⁶⁶ Congress has realized the need for such an allowance in the event that it adopts a first-to-file system and has proposed to “expand[] the prior user defense to all categories of patents” should it do so.²⁶⁷ As suggested by this language, prior user rights already exist in U.S. patent law in limited form.²⁶⁸ Congress authorized the defense in 1999 exclusively for business method patents in response to concerns that such methods were not previously assumed to be eligible subject matter.²⁶⁹ As would be expected, Congress

261. See *supra* text accompanying note 190.

262. See F. Andrew Ubel, *Who’s on First? The Trade Secret Prior User or a Subsequent Patentee*, 76 J. PAT & TRADEMARK OFF. SOC’Y 401, 403–04 (1994).

263. Obviously, this is not a problem in a first-to-invent system because the fact that there was a prior inventor would invalidate the later inventor’s patent. See *Apotex USA, Inc. v. Merck & Co.*, 254 F.3d 1031, 1035 (Fed. Cir. 2001) (“[I]f a patentee’s invention has been made by another, prior inventor who has not abandoned, suppressed, or concealed the invention, § 102(g) will invalidate that patent.”).

264. See Pedersen & Braginsky, *supra* note 227, at 761; Taylor, *supra* note 250, at 544.

265. See Ubel, *supra* note 262, at 404.

266. *Id.* at 407.

267. See 152 CONG. REC. S8830 (daily ed. Aug. 3, 2006) (statement of Sen. Hatch); see also Patent Reform Act, S. 3818, 109th Cong. § 5(d) (2006).

268. See 35 U.S.C. § 273 (2000).

269. Because many people had been using these methods for years and assumed they were not eligible for patent, there was a large field of prior users in danger of infringement when the Federal

established the heightened clear and convincing burden to prove this defense²⁷⁰ because it essentially limits the value of an otherwise presumptively valid patent.

Despite the anticipated need for a prior user rights defense in the realm of business method patents, no court has yet interpreted the statute.²⁷¹ There has, thus, been no opportunity to apply the corroboration requirement to testimony offered in support of a prior user defense, but its use would seem very appropriate in this context.²⁷² One commentator suggests that succeeding in this defense would require “forceful documentation with dates that prove the method was developed independently and commercially used” more than one year prior to the offended patent’s application.²⁷³ In fact, the case for a strict corroboration rule to assert a prior user right is much the same as it is to assert a prior use novelty defense under § 102(a). While the novelty defense carries the additional threat of invalidating the patent at issue, both defenses essentially free the defendant from infringement liability and allow him or her to continue practicing the technology. Surely this outcome would elicit from witnesses the “proneness” and “temptation” the Supreme Court warned of long ago.²⁷⁴

It is not surprising that § 273 has seen little use given that business method patents are a rather obscure and new patent subject matter. However, if Congress adopts its proposal to expand prior user rights to all patent categories, the defense will certainly be used frequently and a new application of the corroboration rule will be born.²⁷⁵ Luckily, the rule should prove less onerous to parties asserting prior user rights than to those asserting other defenses requiring corroboration. Often in the case of a § 102(a) or § 102(b) defense, defendants are relying on the prior use, knowledge, or sale of a third party. Alternatively, they may be relying on their own activity that they have long since abandoned. In the

Circuit found business methods eligible in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1375 (Fed. Cir. 1998). See Matthew D. Thayne, *Business Method Patents, Franchises, and the First Inventor Defense Act: Something Must Give*, 2001 UTAH L. REV. 863, 863–65, 878–79 (2001).

270. See 35 U.S.C. § 273(b)(4).

271. A district court in 2006 labeled § 273 as a matter of first impression but ultimately decided to waive interpretation until better facts presented themselves. See *PB Farradyne, Inc. v. Peterson*, No. 05-03447, 2006 U.S. Dist. LEXIS 3408, at *14–15 (N.D. Cal. Jan. 13, 2006).

272. A prior user defense would clearly involve questions of fact, and, thus, the corroboration requirement should apply. See *supra* note 15.

273. See Thayne, *supra* note 269, at 882.

274. *The Barbed Wire Patent*, 143 U.S. 275, 284 (1892).

275. To appease industry and academic constituents, the Conyers Amendment removed the prior user rights expansion from the House version of the Patent Reform Act of 2007 just prior to its passage. See 153 CONG. REC. H10294 (daily ed. Sep. 7, 2007) (statement of Rep. Conyers). The House version now simply calls for a congressionally mandated study of the effects of prior user rights in other countries and promises to revisit the issue. See H.R. 1908, 110th Cong. § 5(b) (2007). However, the Senate version still includes a full prior user rights expansion. See S. 1145, 110th Cong. § 5(b) (2007). It remains to be seen how this will come out, but the more liberal Senate seems likely to insist on this protection.

case of a prior user assertion, defendants are seeking immunity from the patent so *they* may *continue* practicing the technology. They must simply prove that they reduced the technology to practice and have been commercially using it since before the filing date of the asserted patent.²⁷⁶ Assuming that it is something they are still in the business of doing, it seems highly likely they would have more than just oral testimony to support their case. There is likely to be physical evidence of current use that can be traced back as needed. Thus, it is unlikely that the adoption of a strict corroboration rule would cause undue burden on this potentially new application of the corroboration rule.

In summary, change is on the horizon in patent law, and it appears the changes proposed would well accommodate a more strict corroboration requirement. Not only would such a requirement serve many of the same goals as the proposed changes, some of the proposals themselves would reduce the instances where corroboration is necessary.

IV. RECOMMENDATION

The Federal Circuit describes the corroboration requirement as a “bright-line rule.”²⁷⁷ While the line may be bright in that potential litigants are aware of it, one could hardly call it straight after analyzing the court’s holdings over the past ten years. In some cases, parties have met the corroboration requirement solely via oral testimony, while in other cases the court has held that such testimony alone may never satisfy the requirement.²⁷⁸ The court has discredited testimony from third parties with no family or business relationship to the plaintiff as *interested*, while it has allowed testimony of family and friends in other cases.²⁷⁹ If the Federal Circuit is determined to evaluate evidence at the appellate level, as its corroboration rule rather uniquely requires, it must establish more concrete guidelines for analysis. Its case history sends a mixed signal to inventors as to what records they should retain and makes it nearly impossible for would-be litigants to predict outcomes.

Though there is no way to completely synthesize what Federal Circuit precedent requires for corroboration, the Court’s own holdings handicap its ability to clear the air. There are twelve judges on the Federal Circuit, but cases are typically heard by a three-judge panel.²⁸⁰ These panels are bound by the holdings of all prior Federal Circuit panels,²⁸¹ and, thus, are left with very little room to work in light of seemingly contrary decisions such as *Thomson* and *Finnigan*. However, there is a method whereby the court can straighten the “bright line” on corrobora-

276. See S. 1145, 110th Cong. § 5(b)(2)(A)(ii) (2007); see also 35 U.S.C. § 273 (2000).

277. *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996).

278. See discussion *supra* Part III.A.3.

279. See discussion *supra* Part III.A.4.

280. See *ADELMAN ET AL.*, *supra* note 55, at 16.

281. See *Newell Cos. v. Kenney Mfg. Co.*, 864 F.2d 757, 765 (Fed. Cir. 1988).

tion—the Federal Circuit *may* overturn its own precedent by hearing a case en banc.²⁸² This note recommends that the Federal Circuit choose the appropriate case and establish an en banc holding requiring contemporaneous physical evidence to corroborate oral testimony proffered by any party seeking to defeat the presumption of validity of a United States patent. The evidence should be specific enough to positively identify the technology in question. The factors analyzed in this note clearly support this recommendation.

A. Alignment with Legislative Intent to Decrease Patent Litigation

As noted in Part III.C.1, all sides are concerned with the rampant costs of patent litigation, and Congress has taken a special interest in reform aimed at system efficiency. One of the main reasons patent litigation is so costly and heavily litigated is that there are a considerable number of uncertainties and gray areas within the law. Add to this an often complex subject matter and it is no wonder that the Federal Circuit reversal rate of district court holdings is estimated to be nearly fifty percent.²⁸³ In such an environment, the district court proceeding becomes largely irrelevant, as there is an incentive to appeal every case given such a level of uncertainty. Even the Federal Circuit itself has recognized the problem.²⁸⁴ This uncertainty benefits no one except perhaps lawyers. The high cost of patent litigation ultimately lands on the consumer, as this cost must be recovered through higher pricing for technology.

Every effort to lower the uncertainty in patent law will help decrease the financial burden. If the Federal Circuit adopts the recommendation of this note, district courts will have clear guidance on whether or not the corroboration requirement has been satisfied and will not have to burrow through the current contradictory precedent opposing parties are sure to supply. This will result in fewer reversals on the subject, ultimately resulting in fewer appeals. Furthermore, the lower uncertainty will prevent some litigation altogether because parties will be able to review their evidence and better gauge their chances prior to filing suit or raising a defense. While conflicts will still arise, settlements will be more prevalent. It will not be easy to take uncertainty out of pat-

282. *Id.*

283. Actually, sources put this number at anywhere from thirty percent to more than fifty percent, depending on what cases they are considering. The average reversal rate across all patent cases is probably about thirty-five percent. See Marcia Coyle, *Critics Target Federal Circuit: Reversals Cast Patent Court in Harsh Light*, NAT'L L.J., Oct. 16, 2006, <http://www.law.com/jsp/article.jsp?id=1161162317072>. However, the reversal rate specific to claim construction is near fifty percent. See Steven B. Pokotilow & Charles E. Cantine, *File Early and File Often: A Pending Application is the Best Approach to Capturing Your Competitor's Product*, PAT. STRATEGY & MGMT., Jan. 2004, available at <http://www.stroock.com/SiteFiles/Pub252.pdf>.

284. *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1476 (Fed. Cir. 1998) (Rader, J., dissenting) (“[T]his reversal rate, hovering near 50%, is the worst possible. Even a rate that was much higher would provide greater certainty.”).

ent law given its complex nature, but straightening the corroboration rule seems to be an easy, low-risk first step.

B. Alignment with Supreme Court Precedent

Part II.C.1 reviewed the original Supreme Court holdings regarding corroboration in patent cases, and pointed out how the Federal Circuit lowered the standard over time. The Supreme Court has not addressed the subject in over fifty years, but it is hard to imagine how the Federal Circuit's decisions in *Oney*, in which the court relied on oral testimony of a close friend,²⁸⁵ or *Price*, in which it relied on the affidavit of a relative and coworker,²⁸⁶ comply with the standard set forth by the Supreme Court in the 1892 *Barbed Wire Patent* case, which criticized oral testimony in patent cases generally and refused to consider that of twenty-four separate witnesses.²⁸⁷ Times and technology have changed over the years, but the concerns the Supreme Court expressed over oral testimony regarding prior inventions remain equally valid today. Witnesses are still "prodded by the eagerness of interested parties" and people still "imagine[] they . . . made similar discoveries long before the patentee."²⁸⁸ There is no less of an argument for corroboration now than there was in 1892. In fact, there may be more because, as the *Woodland* Court noted, it is "rare indeed" in modern times "that some physical record . . . does not exist."²⁸⁹ Thus, the burden to produce the needed corroborating evidence is most likely less now than it was a century ago.

The Supreme Court has given great deference to the Federal Circuit since its creation in 1982. This has left the Federal Circuit as the final voice on almost all patent-related matters. However, there are indications that this era of deference is over. In 2002, the Supreme Court unanimously overturned an en banc Federal Circuit holding dealing with the presumption created when an inventor changes his patent application during the course of PTO review.²⁹⁰ Four years later, the Court rejected the Federal Circuit's longstanding practice of automatically granting permanent injunctions upon the finding of infringement.²⁹¹ Early in 2007, it retired a long-standing Federal Circuit doctrine that denied standing for licensees to challenge the licensed technology while continuing to pay royalties.²⁹² Then, four months later, the Court unanimously reversed a Federal Circuit decision on obviousness, questioning a component of the Federal Circuit's obviousness analysis that had been in place since the

285. See discussion *supra* text accompanying notes 180–86.

286. See *supra* note 118 and accompanying text.

287. For a discussion of *The Barbed Wire Patent* case, see *supra* notes 33–38 and accompanying text.

288. *The Barbed Wire Patent*, 143 U.S. 275, 284–85 (1892).

289. *Woodland Trust v. Flowertree Nursery, Inc.*, 148 F.3d 1368, 1373 (Fed. Cir. 1998).

290. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002).

291. *eBay Inc. v. MercExchange, L.L.C.*, 547 U.S. 388 (2006).

292. *MedImmune, Inc. v. Genentech, Inc.*, 127 S. Ct. 764 (2007).

1950s.²⁹³ Many agree that the Supreme Court appears to be taking back the reigns of patent law.²⁹⁴ In fact, the Court has sought review of more patent cases in the last two years than it did in the entire previous decade.²⁹⁵ As the Supreme Court returns to relevance in the world of patent law, the disparity between its precedent on corroboration and the holdings of some controlling Federal Circuit law will become ever more apparent. By adopting the recommendation proposed above, the Federal Circuit would return to the original precedent set by the Supreme Court, giving the High Court little reason to get involved. Though the Supreme Court could, of course, overturn its own century-old precedent, the principle of stare decisis and the arguments above as to why the Court's initial concerns are still valid would need to be overcome.

C. *Benefits to Entities Large and Small*

Few solutions are perfect and, should this recommendation be adopted, it is sure to cause grief to some. However, these will be isolated cases rather than large-scale discrimination against any one patent demographic. As already noted, the potential litigation savings and increased certainty benefit all classes of patentees. More specifically, the anticipated concerns of the small-entity class were dispelled in Part III.B.1. Small-entity concerns are further assuaged by the anticipated move to a first-to-file patent system that would eliminate the largest application of the corroboration rule and the one they most heavily utilize.²⁹⁶

Most importantly, the recommendation delivers to all players a clear standard—not only to decrease uncertainty in litigation, but also to alert them to the importance of record retention throughout the development process. Adoption of the recommendation would allow parties to easily determine what records they need to create and retain at the genesis of their invention in order to satisfy a court or a challenging party, should the need arise later. This incentive would be even more important if the current first-to-invent system and its interference procedure were abandoned, because the incentive inventors have in today's system would disappear. Finally, the recommendation indirectly supports the fundamental patent goals of disclosure and notice. If inventors decide to seek a patent, they must disclose their invention to the public in

293. See *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

294. See, e.g., Duffy, *supra* note 52, at 340–41.

295. This data was compiled from an independent search for Federal Circuit patent cases reviewed by the U.S. Supreme Court. During the 1990s, the average was only one such case per year. There were seven such cases in 2005 alone. See Patently-O, <http://www.patentlyo.com/> (Sept. 7, 2005) (last visited Mar. 8, 2008).

296. See discussion *supra* Part III.C.2.

exchange for a limited monopoly.²⁹⁷ If they choose not to patent, there is no disclosure requirement, but disclosure still advances technology. By creating a record through disclosure, whether via an email to a colleague stored on a central server or a thesis published in an international journal, inventors not only share the technology, but also create what would likely constitute physical contemporaneous corroboration that may be used if necessary.

V. CONCLUSION

The Supreme Court set a high standard for corroborative evidence of testimony offered to invalidate a patent. However, the Federal Circuit has been highly inconsistent in its application of this standard, resulting in confusion and excess litigation. From a review of relevant Federal Circuit holdings, it is not clear what constitutes sufficient corroboration, or even when corroboration will necessarily be required. Recent patent law reform efforts and continued advances in data creation and retention methods work to minimize any concerns with the original high corroboration standard. The time is right for the Federal Circuit to adopt a strict position on corroboration, signaling a realignment with Supreme Court precedent and requiring contemporaneous physical evidence that positively identifies the technology at issue. This will not only help streamline litigation, it will serve the fundamental patent goal of notice and deliver clear guidance to both inventors and litigants.

297. This is referred to as the “quid pro quo” of the patent system. See Guang Ming Whitley, Comment, *A Patent Doctrine Without Bounds: The “Extended” Written Description Requirement*, 71 U. CHI. L. REV. 617, 617 (2004).