INTRODUCTION

Congress enacted the patent laws to further the Constitutional purpose of promoting the progress of the useful arts and sciences. Under the United States patent laws, an inventor may obtain a patent for any useful, novel, and non-obvious process, machine, article of manufacture, or composition of matter. The inventor who secures a patent (“patentee”) for a particular invention is entitled to the exclusive right, for twenty years from the original patent application date, to make, use and sell the invention in the United States. A patentee may then be entitled to damages from anyone who makes, uses or sells a patented product or process in the United States during the term of the patent.

In the United States, a person who is the first to conceive of an invention has always been given priority over persons who conceive second, but file a patent application first. The grant of a U.S. patent, however, is not conclusive evidence that the patentee was the first to conceive of the invention claimed. This is true because the PTO, when considering whether or not a particular invention is worthy of a patent, is not in a position to consider every reference or piece of evidence that could be used to prove that the invention was actually conceived by another prior to the applicant. The PTO has limited resources, which are consumed, in part, by an increasing number of patent applications annually. More importantly, it is unreasonable to expect the PTO to be cognizant of every piece of art relating to the subject matter described in a patent application. In fact, “[a]s many as eighty percent of litigated patent
cases uncover prior art not previously examined by the PTO.” [9] Therefore, it is possible to receive a patent for an invention that was first invented by someone else.

The patent code mandates, however, that a person shall not be entitled to a patent for a particular invention if it was know or used by others in the United States prior to the date of that person’s invention. [10] Therefore, if a defendant in a patent infringement suit proves that the invention described in the patent-in-suit was known or used by others prior to the invention of the patentee, the accused infringer will avoid liability and a court will invalidate the patent. [11] Courts, however, presume that a patent is valid, and an accused infringer who attempts to escape patent liability by invalidating the patent based on prior knowledge or use, has the burden to prove invalidity with “facts supported by clear and convincing evidence.” [12]

Courts have struggled with the appropriate burden an accused infringer is required to carry in order to overcome the presumption of patent validity. [13] In particular, courts have disagreed on the level of credence that may be placed in the testimony of a witness who testifies to the prior use or invention of the subject matter claimed by a patent-in-suit. [14] As early as 1892, the Supreme Court indicated its reluctance to invalidate a patent based on oral testimony alone. [15] The Court noted several reasons why patent invalidating testimony may be suspect, including a witness’s “forgetfulness..., liability to mistakes, proneness to recollect things...” in favor of the party calling them, and outright temptation to perjury. [16] This concern has led courts to require independent corroboration of an inventor’s testimony in certain circumstances when the testimony is directed to establishing priority over a patent-in-suit. [17]

Courts are in agreement that independent corroboration is required when an inventor is asserting a claim of priority of his or her invention over the patent-in-suit, and the inventor stands to personally gain from a finding that his or her invention has priority. [18] The most likely example of this scenario occurs when the testifying inventor is a named party or “an employee of or assignor to a named party.” [19] In these cases, the testifying inventor has such
a direct interest in the outcome of the litigation that courts will not invalidate a patent based on inventor testimony without corroboration. It is the situation where the testifying inventor has no apparent interest in the outcome of the litigation that has caused division within the Federal Circuit. [20]

For example, if Chemist A invented a new type of compound, patented her invention, and later discovered that Chemist B was infringing her patent by making the same compound, A could sue B for patent infringement. One of B’s possible defenses is that he invented the compound first. If this is true, B’s activities invalidate A’s patent. [21] In this case, however, courts would require corroboration of B’s testimony (i.e. independent evidence of prior conception that is consistent with B’s testimony). B, as a party to the litigation has an inherent bias behind his testimony, because if he proves prior conception, he avoids infringement liability and invalidates A’s patent. Therefore, B’s word alone isn’t credible evidence.

Now, what about the case where B’s defense is based on the assertion that Chemist C (a 3rd party) conceived of the invention before A? Chemist C is not a party to the lawsuit, or involved in the lawsuit in any way, and therefore does not have the same bias behind her testimony concerning invention priority. Should the courts require corroboration of C’s testimony? On January 25th, 1999, in Thomson, Judge Rich, writing for a panel of the Federal Circuit answered “no.” [22] On June 9th, 1999, in Finnigan, Judge Lourie, writing for a panel of the Federal Circuit, which included Judge Rich, answered “yes.” [23]

This note will examine the law and policy related to the corroboration requirement applied to testimony directed to establishing priority over an invention claimed by a patent-in-suit. Section I will provide a brief background of the U.S. patent system and the policy concerns implicated by the corroboration requirement. Section II will study the history of the corroboration requirement, beginning with the oft-cited Supreme Court Barbed Wire Patent Case of 1892 and ending with the current inconsistency between Finnigan and Thomson. Section III will determine which of the opposing rules in Finnigan and Thomson are more consistent with patent law, rules of evidence, and the relevant underlying policies. Finally, Section III will conclude that the corroboration requirement should not be applied to disinterested witness testimony.

I. PATENT LAW BACKGROUND
The patent laws serve two main goals which further the constitutional purpose of advancing innovation: (1) promoting public disclosure of technological advances and (2) providing an economic incentive to reward inventors. The economic incentive encourages inventors to create, unhindered by the fear that others may pirate their inventions. The public disclosure goal provides society with a beneficial technological advance and contributes to the public’s “store of knowledge”, providing a basis for even further invention. Scholars and courts describe the two goals of the patent system as a contract, or quid pro quo, between the inventor and society, under which the inventor receives a patent in return for disclosing a socially beneficial invention to the public.

When an inventor decides to patent a new invention, he or she files a patent application with the United States Patent and Trademark Office (“PTO”). The inventor and the PTO then enter into a formalized negotiation, called patent prosecution, to determine if the invention meets the requirements of patentability. In order to be patentable, the subject matter of the invention must fall into one of the four statutorily defined categories of patentable subject matter: “any new and useful (1) process, (2) machine, (3) manufacture, or (4) composition of matter, or any new and useful improvement. . .” thereof. In addition, in order to be patentable, an invention must meet the statutory requirements of utility, novelty, and non-obviousness. In order to satisfy the utility requirement, an invention merely needs to be useful, or must "operate to achieve some minimum human purpose." Applicants typically do not have much difficulty meeting the utility requirement.

The novelty and non-obviousness requirements ensure that an applicant does not receive a patent for something that has already been invented or for something that is a colorable variation of a prior invention. The novelty provisions are of particular interest to the discussion in this note. The relevant novelty provisions (35 U.S.C. § 102 (a), (b), (f) & (g)) provide:
A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country . . . before the invention thereof by the applicant for patent. . .;

(b) the invention was . . . in public use or on sale in this country, more than one year prior to the date of the application. . .;

(f) he did not himself invent the subject matter sought to be patented; or

(g) . . . before the applicant’s invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. [35]

The prohibition in Section 102(a) applies when the claimed invention in a patent application is anticipated by an invention that has already been disclosed to the public. [36] In such a case, the patent applicant has not contributed to the public’s store of knowledge, and is therefore not entitled to a patent. [37]

Section 102(b) promotes public disclosure by encouraging inventors to apply for patent rights as soon as possible. If an inventor waits more than a year to file a patent application following the public use or sale of the invention in the U.S., the inventor is barred from obtaining a patent. [38]

Sections 102 (f) and (g) ensure that the appropriate inventor receives patent rights. Section 102(f) prevents an applicant from obtaining a patent claiming an invention appropriated from someone else. [39] Section 102(g) forms the basis for the United States’ unique “first-to-invent” system. It ensures, under certain circumstances, that the first person to conceive of an invention, gets the rights to patent that invention. [40] Originally, section 102(g) was enacted to determine the priority of invention in an interference proceeding, a dispute adjudicated by the PTO between two inventors asserting rights to the same invention. [41] However, section 102(g), like other
provisions in section 102, can also be used as a defense during patent infringement to invalidate the plaintiff’s patent. [42]

To further the purposes of the novelty provisions, the PTO, during patent prosecution, conducts a search of art relevant to the subject matter claimed in a patent application (“prior art”). Furthermore, a patent applicant has a duty to present to the PTO, any prior art which the applicant knows is relevant to the patentability of the claimed invention. [43] In fact, every inventor named in the application, each attorney or agent who prepares the application, and any other person who is substantively involved in the preparation of the application has a duty to disclose any information that is material to patentability. [44] “Failure to discharge these duties can result in an unenforceable patent.” [45]

If the PTO, during patent prosecution, obtains prior art that defeats the patentability of a claimed invention on grounds of novelty or obviousness, the applicant’s claims are rejected and no patent issues. As stated before, however, because the PTO is burdened with growing numbers of yearly applications and because it is unreasonable to expect the PTO to be aware of every piece of prior art, there are times when invalidating prior art goes undetected. In such cases, patents may be granted for inventions that do not meet the statutory patentability requirements for novelty. Courts correct this problem by allowing patent infringement defendants to prove that a patent which they are accused of infringing, is invalid for lack of novelty. [46]

As stated earlier, this Note examines the burden a patent infringement defendant has in proving the invalidity of a patent-in-suit based on a lack of novelty. One scholar outlined some of the policy concerns surrounding this burden of proof:

A high burden encourages early public disclosure by promising strong patent rights against invalidity allegations. Prompt disclosure furthers the purpose of patent law by enabling the public to benefit sooner from the patentee's work. An excessive burden, however, encourages a race to the PTO and threatens to deny rights to the true inventor. If a patent's presumptive validity is unreasonably strong, a true inventor that is late filing may be unable to present sufficient evidence to overcome the issued patent's validity. [47]
Furthermore, a high burden protects the patentee from frivolous claims of invalidity, while too high a burden creates a windfall for a patentee who was not the first to invent, and who therefore did not contribute anything of value to the public. These are the policy concerns that must be considered when deciding what level of credence a court should place in the testimony of a witness who testifies to the prior use or invention of the subject matter claimed by a patent-in-suit. This Note will now analyze the history of the law surrounding the corroboration requirement that led to the current inconsistency in the Federal Circuit.

II. From Barbed Wire to Finnegan

A. Barbed Wire Patent

In 1892, the Supreme Court dealt with a patent infringement suit concerning a patent for a particular type of barbed wire. The defendant attempted to invalidate the patent based on the oral testimony of witnesses who claimed to have seen a barbed-wire fence prior to the patentee’s invention date, which was of the same type claimed by the patent-in-suit, that belonged to a Mr. Morley (3rd party). “In all, some 24 witnesses were sworn on behalf of the defendants to the existence of . . . [Mr. Morley’s] fence.” The plaintiff, however, offered testimony to rebut the defendant’s claims. As the Court stated, the “plaintiff met this testimony with that of a large number of witnesses who had seen these fences . . . and who testified that there was no barbed wire connected with them.” The Court noted that the defendant had the burden to prove the existence of such patent invalidating devices, and that the proof should be “clear satisfactory, and beyond a reasonable doubt.”

Finally, after considering the evidence, the Court determined that the defendant had not met the burden of proof required to invalidate the patent for 4 reasons: (1) there was little evidence to show that Morley’s fence was constructed according to the plaintiff’s design and little chance that witnesses, 25 years after viewing Morley’s fence, could have remembered it in sufficient
detail; (2) if Morely had invented something valuable, he would have applied for a patent; (3) testimony given by the defendant’s witnesses was contradicted by testimony given by the plaintiff’s witnesses; and (4) Morely’s fence, if it ever existed, was abandoned. [54]

The *Barbed Wire Patent* case is regarded as a case that laid much of the groundwork for the law that developed concerning the burden a patent infringement defendant has to overcome to invalidate a patent based on prior use or invention. [55] Although CCPA and the Federal Circuit have since lowered the burden of proof from the “beyond a reasonable doubt” standard to require defendants to prove invalidity with “facts supported by clear and convincing evidence,” [56] courts confronted with testimony concerning prior invention, that is offered to invalidate a patent, still look to *Barbed Wire Patent* for guidance. [57]

It is not the holding of *Barbed Wire Patent*, however, that has given it notoriety. Prior to analyzing the actual testimony in the case, the Court offered a lengthy discussion on the weaknesses of oral testimony:

In view of the unsatisfactory character of 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. [58]

The Court then went on to state:

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. Indeed, the frequency with which testimony is tortured, or fabricated outright, to build up the defense of a prior use of the thing patented, goes far to justify the popular impression that the inventor may be treated as the lawful prey of the infringer. [59]
The reason this Note quotes these passages at length is to reproduce the language often cited by courts that consider testimony relating to prior invention that is offered to invalidate a patent. [60] The concerns about oral testimony highlighted in Barbed Wire Patent led courts to view such testimony with suspicion. [61] Over the years, courts developed several factors to consider when evaluating such oral testimony (“DuPont Factors”). Those factors include: (1) delay between event and trial, (2) interest of witness, (3) contradiction or impeachment, (4) corroboration, (5) witnesses’ familiarity with details of alleged prior structure, (6) improbability of prior use considering state of the art, (7) impact of the invention on the industry, and (8) relationship between witness and alleged prior user. [62]

Therefore, although unsupported oral testimony was suspect, the widespread view at the time was that it could be sufficient to invalidate a patent. [63] The patentee was protected by the presumption of patent validity, the high burden to overcome that presumption, and the factors through which a court was to skeptically evaluate patent invalidating oral testimony.

B. Corroboration Requirement

The Federal Circuit developed a rule requiring corroboration where a party attempts to prove prior conception through the oral testimony of an inventor. [64] One scholar notes that by creating the corroboration requirement, the Federal Circuit avoids a “comprehensive balancing test that weighs each of the factors” in cases where oral testimony by an alleged inventor is used to assert priority over a patentee’s rights. [65] In such cases the Federal Circuit enforces a “per se rule that the fourth factor, corroboration, is required. . . .” [66] The issue courts have struggled with, however, is in which specific scenarios the per se corroboration rule applies. Does it apply when the witness is a disinterested inventor? Does it apply when the witness is not an inventor, but is testifying to a prior invention by someone else? These are the questions that were recently posed to the Federal Circuit in the Thomson and Finnegan cases.

C. Thomson
Thomson, the assignee for a patent covering certain optical storage devices, i.e. compact discs ("CDs"), sued Quixote Corp., a CD manufacturer, for patent infringement. Quixote’s defense included a charge that the patent-in-suit was invalid in light of an unpatented laser videodisc, which was developed by MCA Discovision (3rd party) before Thomson’s invention. The court noted that the evidence supporting the invalidity claim came from “one or more sources: the live testimony of two people who had worked on the MCA laser videodisc project; an expert's report and portions of his deposition testimony, both of which were read into the record; the expert's exhibits; and certain MCA documents that the expert had reviewed.”

Thomson appealed the District Court’s denial of his motion for judgement as a matter of law following a jury verdict that invalidated his patent for lack of novelty. Thomson’s argument on appeal asserted that the jury verdict was based solely on the testimony of the two MCA employees who worked on the videodisc project, and that because their testimony was not corroborated, it was insufficient to invalidate the patent. Although the Court noted that other evidence accompanied the oral testimony, such as an expert’s exhibits, documents and deposition testimony; it performed its analysis based on the assumption that the jury verdict rested solely on the testimony of the two MCA employees. The Federal Circuit held that because the witnesses’ level of self interest in the matter did not rise to the point “required to justify triggering application of the corroboration rule,” the testimony offered was sufficient to invalidate Thomson’s patent.

The Federal Circuit’s reasoning in Thomson began with the admission that courts apply the corroboration requirement to patent invalidating testimony from defendants asserting the priority of their own inventions. Neither the Supreme Court nor the Federal Circuit, however, had ever directly held whether the corroboration requirement applied to patent anticipating testimony from non-party inventors. The Federal Circuit, in Mahurkar v. C.R. Bard, Inc., explained
that the corroboration requirement “arose out of a concern that inventors testifying in patent infringement cases would be tempted to remember facts favorable to their case by the lure of protecting their patent or defeating another's patent.” Therefore, if one were to analyze the DuPont factors in this context, the Federal Circuit requires corroboration (4th factor) when the self-interest of the testifying witness (2nd factor) reaches a certain level. Indeed, the Thomson Court indicated as such by stating that “the corroboration rule is needed only to counterbalance the self-interest of a testifying inventor against the patentee.” In furtherance of this reasoning, the Thomson court constructed a rule for when the corroboration requirement applies:

We therefore 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.

In situations where the testifying witness is not directly interested in the outcome of the litigation, there is no need for the corroboration requirement because the patentee is protected by the clear and convincing standard of proof, and the “numerous methods in the Federal Rules of Civil Procedure and Evidence by which a party may test, challenge, impeach, and rebut oral testimony.” Therefore, following Thomson, it seemed that the corroboration requirement did not apply to patent anticipating testimony, concerning inventive priority, from non-party inventors. Approximately four months later, however, the Federal Circuit decided the Finnegan case.

D. Finnigan

The Finnegan Corporation (“Finnegan”) owned a patent relating to a method for using a “quadrupole ion trap” to generate a mass spectrum of a particular sample of ions. A mass spectrum is useful for determining certain molecular or atomic characteristics of unknown samples. During the term of Finnegan’s patent, Bruker Analytical Systems (“Bruker”), among
others, were importing, into the United States, a spectrometer that operated in a similar manner to the invention covered by the Finnegan patent. [82] Because the patent statute prohibits importation of articles that "infringe a valid and enforceable United States patent", [83] Finnigan filed a complaint with the International Trade Commission ("ITC") to enforce its patent rights. [84] Bruker defended the charge, in part, by asserting that the Finnigan Patent was invalid because a third party, Mr. Jeffert’s, had publicly used the invention prior to Finnegan’s inventive activity. [85]

The ITC held that certain claims of Finnigan’s patent were invalid due to Mr. Jeffert’s prior use. [86] Finnegan appealed to the Federal Circuit alleging that Mr. Jeffert’s testimony was insufficient, absent other corroborating evidence, to invalidate patent claims. [87] The Federal Circuit reversed the ITC’s decision concerning invalidity and held that “corroboration is required of any witness whose testimony alone is asserted to invalidate a patent, regardless of his or her level of interest.” [88]

The Finnigan Court began its reasoning by quoting Barbed Wire Patent at length, and stating that the law has always been reluctant to invalidate a patent based on mere testimony. [89] The Court recited all of the often stated reasons for viewing witness testimony with skepticism and then suggested that testimony concerning invalidating activities should be viewed with further skepticism because inventive activity is usually supported with other tangible evidence. [90] While the Court admitted that application of the corroboration requirement usually occurred in priority disputes, where invalidating testimony comes from a party to the litigation, it noted that corroboration is required even when the testimony comes from a person who is not interested in the outcome of the litigation. [91]

1. Misreading the Barbed Wire Patent Case
In support of the proposition that disinterested witness testimony needs to be corroborated, the Finnigan Court relied on Barbed Wire Patent. The Court correctly noted that in Barbed Wire Patent, “some twenty-four witnesses, all apparently uninterested in the outcome of the case, testified on behalf of the accused infringer. . . .” The Finnegan Court then went on to state that although the witnesses were not interested in the litigation, that fact did not “immunize their testimony from the corroboration requirement.” In so stating, the Finnegan court implies that the Barbed Wire Patent Court applied the corroboration requirement to witness testimony. This is a mischaracterization of the Barbed Wire Patent Court’s analysis, which never refused to consider uncorroborated testimony.

As noted earlier, the Barbed Wire Patent Court initially explained the defendant’s burden of proof, while buttressing that burden by discussing the weaknesses of oral testimony. The Court then considered all of the oral testimony offered and ultimately concluded that the defendant had not met its burden. In doing so, the Court gave explicit reasons for its holding, some of which were directed to the inadequacy of the oral testimony. For example, the testimony (1) failed to show that the Morley fence was constructed according to the design of the patentee’s fence, (2) described events that were twenty-five years past, and (3) was contradicted by the plaintiff’s witnesses. If the Barbed Wire Patent Court had applied a corroboration requirement, it would not have needed to consider the testimony offered by the defendant if a lack of corroboration existed. But to the contrary of the Finnegan Court’s suggestion, the Court fully considered all of the testimony in the case and ultimately determined that it was not sufficient to invalidate a patent.

2. Distinguishing Thomson?

After relying on Barbed Wire Patent to support its conclusion that disinterested witness testimony needs corroboration, the Finnegan Court attempted to distinguish the Thomson holding. The Finnegan Court quoted the language from Thomson holding that
corroboration is only required when the testifying inventor is a named party, an employee of or assignor to a named party, or is in a position to “gain by his or her invention being found to have priority over the patent claims at issue.” [100] The Court then argued, however, that Thomson did not involve uncorroborated testimony of a _single_ witness, but instead the testimony of two witnesses, an expert’s report, deposition testimony, an expert’s exhibits, and other documents reviewed by an expert. [101] Therefore, the Finnegan Court suggests, _Thomson_ did not test whether or not corroboration was required, but instead tested the sufficiency of the corroboration presented. [102]

The _Finnigan_ Court’s characterization of _Thomson_ is incorrect. Although the _Thomson_ Court noted in its background section that evidence supporting anticipation of the plaintiff’s patent came from sources other than oral testimony, the case’s holding was based on the assumption that the jury’s verdict of invalidity rested “upon mere testimonial evidence.” [103] Thomson’s two assertions on appeal were that (1) the jury verdict rested solely upon oral testimony and (2) this evidence was insufficient because it lacked corroboration. The Court responded: “Even if we accept Thomson’s first assertion... Thomson's argument fails because this case does not present circumstances in which there is a need for corroboration...”

Furthermore, the Finnigan Court bases its distinction on the fact that _Thomson_ involved the testimony of more than one witness, yet the Court attempts to support its holding by relying on _Barbed Wire Patent_, a case that involved the testimony of twenty-four witnesses. Finally, contrary to the _Finnigan_ Court’s suggestion that _Thomson_ does not test whether or not the corroboration rule applies, but instead the sufficiency of the corroboration presented, the _Thomson_ holding was based on the fact that the testifying witness did not have the “level of self interest required to justify triggering application of the corroboration rule.” [104]

Therefore, the Thomson and Finnegan cases are at odds about whether a disinterested witness’s testimony requires corroboration. The two cases cannot be reconciled. This Note will
determine which rule is more consistent with patent law, rules of evidence, and the relevant underlying policies.

III. TO CORROBORATE OR NOT TO CORROBORATE?

A. Thomson is More Consistent with the Historical Development of Patent Law.

Courts did not develop the corroboration requirement to protect patentees from the testimony of disinterested witnesses. Indeed, the Federal Circuit in *Mahurkar* stated that the “requirement arose out of a concern that inventors testifying in patent infringement cases would be tempted to remember facts favorable to their case by the lure of protecting their patent or defeating another's patent.” [105] The Finnigan Court admits that the Federal Circuit applies the corroboration requirement most often in the case of priority disputes under section 102(g). [106] As stated earlier, section 102(g) priority disputes originally concerned interferences, not infringement litigation. [107] Interferences are priority disputes between two inventors claiming the same invention, and the corroboration requirement grew out of a concern that those inventors had too much interest in the dispute’s outcome for their testimony alone to provide a basis for priority. [108] The Finnigan Court correctly noted that the Federal Circuit had applied the corroboration requirement in circumstances involving other sections of 102. [109] but prior to Thomson, no court had ever directly held that the corroboration requirement applied to non-party inventor testimony. [110] Therefore, the Finnegan Court expanded the reach of the corroboration requirement to cover scenarios that do not pose the problems the corroboration requirement was initially intended to address.

B. Finnigan’s Per Se Corroboration Requirement Swallows the Analysis that it was Designed to Streamline.
Before the Federal Circuit developed the corroboration requirement, most courts held the view that although unsupported oral testimony had to be regarded with skepticism, it could be sufficient to invalidate a patent.\[111\] Over the years, courts honed their analytical tools for evaluating oral testimony offered to invalidate a patent for lack of novelty. One result, as explained earlier, was the evolution of the DuPont Factors. By analyzing the factors, a court could determine whether or not a witness was credible. For example, if a court were considering the uncorroborated testimony of a defendant inventor who was claiming conception of an invention five years ago, the second and fourth factors, (2) interest of the witness and (4) corroboration, would weigh against a finding of invalidity, while the first and fifth factors, (1) delay between event and trial and the (5) witnesses’ familiarity with details of the alleged prior structure, might weigh in favor of invalidity. The court could then make a determination based on its consideration of all the relevant factors.

The corroboration requirement developed as a per se rule for the situation when a patent infringement defendant offered testimony to invalidate the patent-in-suit. A court develops per se rules when particular circumstances or factors weigh so heavily in favor of one party that a lengthy balancing analysis is not necessary. For example, in antitrust litigation, in order to determine if a defendant engaged in certain anticompetitive activities, which would be a violation of section 1 of the Sherman Act, a court must perform a comprehensive economic analysis called the rule of reason.\[112\] However, if the defendant engaged in certain, more egregious anticompetitive activities, such as a boycott or a tying arrangement, a court could avoid applying the rule of reason and the defendant’s activity would be per se illegal.\[113\]

In the case of the corroboration requirement, courts streamlined the DuPont analysis for situations where the testimony came from an inventor who was an interested party. In such a case, the interest of the witness, the second DuPont Factor, was so great that courts considered the testimony, without corroboration, not credible per se. For situations when the testimony
came from an uninterested party, according to the rule adopted by Thomson, a court would consider the testimony in the manner suggested by DuPont. The Finnigan Court’s interpretation of the per se corroboration rule, however, swallows the DuPont analysis it was meant to streamline. Courts considered the DuPont factors when parties in patent litigation offered any oral evidence to invalidate a patent based on lack of novelty. The Finnigan Court adopted a rule that requires corroboration when the testimony comes from an interested or an uninterested witness, effectively removing from the courts, the discretion to consider the credibility of such testimony.

C. Courts Should Have the Discretion to Evaluate the Testimony of Disinterested Witnesses

The corroboration requirement prevents a court from evaluating certain types of evidence. Evaluating evidence is a court’s job. Indeed, a trial court must examine evidence “most critically and must bring to bear, upon that judgment of credibility, all of his training and experience and all of his knowledge of the propensities and vagaries of human beings.” Even the Federal Circuit questioned the necessity of the corroboration requirement by stating that the rule is “prophylactic in application given the unique abilities of trial court judges and juries to assess credibility.” “It is rather unusual for a factfinder to be told that, as a matter of law, she cannot consider the testimony of a witness--no matter how credible that witness may appear--to be sufficient to satisfy an evidentiary burden.”

Although the Finnigan corroboration requirement is a simplistic, bright line rule, it needlessly prohibits a trial court from evaluating evidence. Patentees are sufficiently protected by the strong skepticism with which courts view patent invalidating technology and a court’s ability to evaluate evidence with the guidance of the DuPont factors. The Finnigan rule swings the
pendulum too far in the favor of the patentee by potentially preventing a court from considering highly credible, unimpeachable patent invalidating testimony.

D. Most of the Finnegan Court's Concerns Regarding the Weaknesses of Oral Testimony are not Unique to Patent Law.

As noted earlier, Barbed Wire Patent articulated many of the concerns about patent invalidating oral testimony that courts cite today to support application of the corroboration requirement. For example, the Court in Barbed Wire Patent noted that a defendant attempting to invalidate a patent with oral testimony has a high burden of proof because witnesses are (1) forgetful, (2) liable to make mistakes, and (3) prone to recollect things in favor of the party calling them. [118] These concerns, however, are not unique to patent law. There is always the possibility that a witness, testifying in any legal matter, may be forgetful, mistaken, or prone to testify in favor of the calling party. If courts are justified in requiring corroboration of oral testimony based on these concerns alone, no oral testimony, regardless of the legal matter at issue, could ever be considered without corroboration.

The Barbed Wire Patent Court did offer another reason, unique to patent law, which could reasonably support some type of corroboration requirement. It explained that one of the problems occurring in patent litigation was the fact that patents were often attacked by testimony from witnesses who claimed to have made similar discoveries prior to the patentee’s invention date. [119] The Court then noted that because testimony offered to prove prior use was often tortured or fabricated, patentees often ended up being the “lawful prey of the infringer.” [120] Because acquiring patent protection is costly for inventors, and because strong patent protection encourages innovation, courts have a legitimate interest in preventing frivolous invalidity defenses. Assuming the desire to prevent fabricated testimony in patent cases is a legitimate reason for creating a corroboration requirement, the scope of the requirement should apply to testimony from witnesses who might have a motive to present inaccurate
testimony. The *Thomson* rule applies to people who may have such a motive. Requiring corroboration of testimony from disinterested witnesses, however, places too high a burden on infringement defendants attempting to prove a prior use.

The Finnigan Court attempted to support its broad corroboration requirement by suggesting that non-party testifying inventors may have the motive to present questionable testimony because an inventor known to be the “first in the field” of a particular invention “can be expected to derive a sense of professional or personal accomplishment.” [121] Any bias resulting from the lure of achieving a professional accomplishment, however, is comparatively weak to the bias inherent in a patent infringement defendant who attempts to invalidate the patent that is being used as a basis for the lawsuit. Furthermore, any bias resulting from a desire to achieve professional accomplishment pales in comparison to the biases inherent in some testimony that is considered in other types of legal disputes. For example, in a criminal trial, where a murder defendant’s mother provides an alibi for the accused, a court applies no corroboration requirement to the testimony.

This example may support an argument that courts are never justified in applying a corroboration requirement during patent litigation. While the abolishment of all corroboration requirements may be forcefully argued, this Note merely uses the example to show that courts should clearly not apply a corroboration requirement to disinterested witness testimony. There are very few corroboration requirements applied by courts today. Some courts, in the past, applied a corroboration requirement in certain rape cases to preclude convictions based solely on the victim’s testimony. [122] In such a case, the corroboration requirement was a minimum safeguard to protect against fabricated accusations. [123] All fifty states have since eliminated the corroboration requirement in rape cases. [124] Also, some courts require the corroboration of accomplice testimony, however, “[t]his evidentiary requirement has fallen into disfavor over the last decade, and many of the state statutes that had imposed it have been
repealed.” [125] The modern trend in evidence law is a move away from imposing barriers to testimony. [126] Corroboration requirements have been described as “anachronistic and, to the extent that they still exist,” are “on the wane.” [127] Furthermore, even though corroboration requirements are dying out, a court has greater justification in applying the corroboration rule to accomplice testimony than disinterested inventor testimony.

The Finnigan corroboration rule applies not only to inventors, but to “any witness whose testimony alone is asserted to invalidate a patent.” The Finnigan Court, however, fails to provide any possible motive, for a non-party, non-inventor, to provide fabricated or tortured testimony. Yet under the broad corroboration rule, testimony concerning prior public use of an invention, from a disinterested, highly credible, non-inventor, may not be considered absent corroboration.

For example, consider the hypothetical situation where Inventor Smith is an automobile mechanic who works at a repair shop. While repairing Toyota automobiles, Smith discovers that a particular seal in the Toyota engine often fails due to corrosion. Smith, while working in his garage, designs a new seal that does not corrode and installs it in his automobile. The new seal is an apparent success and Smith makes a few more for close friends and some customers. Smith, content with sharing his invention, never obtains a patent. Years later, Toyota learns about Smith’s invention and obtains a patent for a similar seal. [128] After learning that Ford is manufacturing the same seal, Toyota sues Ford for infringement.

According to the novelty provisions in patent law, Ford should be able to defend the infringement by proving that Smith invented or used the seal prior to Toyota’s invention date. Under the Finnigan rule, however, if Ford was unable to locate any corroborating evidence, a court could not even consider Smith’s testimony. Also, if Ford was only able to present testimony from a witness who had used the seal prior to Toyota’s invention date, a court could not consider the testimony without corroboration. If Ford is unable to invalidate Toyota’s
CONCLUSION

Courts should not require corroboration of testimony from a disinterested witness that is offered to invalidate a patent for lack of novelty. The corroboration requirement was created to counterbalance the self-interest of a testifying inventor. Therefore, a disinterested inventor’s testimony does not present the problems the corroboration requirement was designed to address. Furthermore, opponents of the parties who offer oral testimony are not without weapons to refute such testimony. In Thomson, the Federal Circuit recognized the “numerous methods in the Federal Rules of Civil Procedure and Evidence by which a party may test, challenge, impeach, and rebut oral testimony. . . .” [129] In addition, a patentee is protected by the presumption of patent validity, the clear and convincing burden of proof a defendant attempting to prove invalidity must overcome, and the skepticism with which courts view patent invalidating oral testimony. A broad corroboration rule swings the pendulum too far in favor of the patentee. The Federal Circuit should adopt a narrower corroboration rule, like the one outlined in Thomson.

[5] 3 Donald S. Chisum, Chisum on Patents § 10.03[1] (1999) (“The first person to conceive the subject matter in question is the first inventor provided he exercises reasonable diligence in reducing to practice from a time just prior to when the first person to reduce to practice enters the field.”)
References that may be used to prove that a patent applicant is not entitled to an invention because of a lack of novelty or non-obviousness are called prior art references. Timothy R. Holbrook, *The More Things Change, The More They Stay the Same: Implications of Pfaff V. Wells Electronics, Inc. And The Quest for Predictability in the On-Sale Bar*, 15 Berkeley Tech. L.J. 933, 963-64 (2000).


35 U.S.C. § 102(a) & (g); See Woodland Trust v. Flowertree Nursery, Inc., 148 F.3d 1368, 1370 (Fed. Cir. 1998). There are statutory bars, beyond those described in §§102(a) & (g), that prevent an applicant from obtaining a patent. See 35 U.S.C. §§ 102-103.

See Woodland Trust, 148 F.3d at 1370; Thomson v. Quixote Corp., 166 F.3d 1172, 1175 (Fed. Cir. 1999).


Gallo, supra note 6, at 129.

Compare Finnigan Corp., 180 F.3d at 1367; with Thomson, 166 F.3d at 1176.


Id.

See Finnigan Corp., 180 F.3d at 1367; Thomson, 166 F.3d at 1176.

See Finnigan Corp., 180 F.3d at 1367; Thomson, 166 F.3d at 1176.

Thomson, 166 F.3d at 1176.

Compare Finnigan Corp., 180 F.3d at 1367; with Thomson, 166 F.3d at 1176.

Provided that B has not abandoned, suppressed, or concealed his invention. 35 U.S.C. § 102(g).

Thomson, 166 F.3d at 1176 (Before Rich, Schall, & Gajarsa, Circuit Judges).

Finnigan Corp., 180 F.3d at 1370 (Before Lourie, Michel, & Rich, Circuit Judges).


Woodland Trust, 148 F.3d at 1370.


[29] Id.

[30] 35 U.S.C. § 102 (a), (e), (g) (date).


[32] “Three criteria determine whether an invention has utility. An invention must: (1) ’be operable and capable of use,’ (2) ’operate to achieve some minimum human purpose,’ and (3) ’achieve a human purpose that is not illegal, immoral or contrary to public policy.’” David Burke, Animal Legal Defense Fund V. Quigg: Renewed Challenge To Animal Patents, 59 UMKC L. Rev. 409, 437 n. 15 (1991) (quoting D. CHISUM, PATENTS: A TREATISE ON THE LAW OF PATENTABILITY, VALIDITY AND INFRINGEMENT §43.01, at 4-2 (1990).

[33] 35 U.S.C. § 102 (a), (e). (g).


[35] 35 U.S.C. § 102 (a), (b), (f), (g).


[37] Id.

[38] 35 U.S.C. § 102 (b).


[40] 35 U.S.C. § 102 (g).

[41] Thomson, 166 F.3d at 1175 n. 3.

[42] Id.

[43] 37 C.F.R. § 1.56(a).


[45] Id.

[46] See Woodland Trust, 148 F.3d at 1370; Thomson v. Quixote Corp., 166 F.3d at 1175. Infringement defendants may also assert affirmative defenses that the patent in suit is invalid for not meeting other statutory requirements, such as utility or obviousness.


[49] Id. at 287.

[50] Id.

[51] Id. at 288.

[52] Id.

[53] Id. at 284.

[54] Id. at 289. Interestingly, the reasons offered that don’t relate to witness credibility (reasons 2 & 4) no longer comport with modern patent law. The fact that Morely never applied for a patent would be irrelevant. An inventor has no duty to acquire a patent for an invention. Secondly, abandonment would not be good enough to overcome a 102 (a) or (b) rejection. After listing its four reasons, the Court then went on to consider further testimony offered by the defendant to prove the existence of other patent invalidating fences, aside from the Morley fence. The Court again refused to invalidate the plaintiff’s patent for similar reasons. See id. at 289-292.

[55] See Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1577 (Fed. Cir. 1996); Woodland Trust, 148 F.3d at 1371-72; Finnigan Corp., 180 F.3d at 1367-68.

[56] “The elucidation of the evidentiary showing that is required to overcome the presumed validity of a patent has evolved in a long judicial journey. While the stating of the rule has included words as strong as the criminal standard of “every reasonable doubt,” Judge Lourie, in Finnigan, recites the prevailing standard as clear and convincing, a standard that falls somewhere between those of “every reasonable doubt” and “a preponderance of the evidence.” The Federal Circuit had previously applied the clear and convincing evidence standard in Price v. Symsek, an appeal from an interference proceeding. In justifying this standard, a burden less strict than the stringent ‘beyond a reasonable doubt’ standard used previously by the Board of Patent Appeals and Interferences, Judge Nies outlined the components of Justice Harlan’s "social disutility" analysis: (1) the factfinder can rarely, if ever, acquire unassailably accurate knowledge of what happened—a belief of what probably happened is generally the best that can be achieved, and (2) the factfinder, even after the most diligent of efforts, will sometimes reach the wrong factual conclusion. . . . Because the standard of proof affects the comparative frequency of [the possible] erroneous outcomes, the choice of the standard to be applied in a particular kind of litigation should, in a rational world, reflect an assessment of the comparative social disutility of each.” Gallo, 15 Berkeley Tech. L.J. at 136-37 (citations omitted).

[57] See Mahurkar v. C.R. Bard, Inc., 79 F.3d 1572, 1577 (Fed. Cir. 1996); Woodland Trust, 148 F.3d at 1371-72; Finnigan Corp., 180 F.3d at 1367-68.


[59] Id. at 284-285.


[62] Id. at n. 20 (citing Deering v. Winona Harvester Works, 155 U.S. 286, 300-01 (1894)).

[63] Id. at 1261.


[66] Id. at 140.

[67] Thomson, 166 F.3d at 1173.

[68] Id. at 1174.

[69] Id.

[70] Id.

[71] Id.

[72] Id. at 1174-75 (“Thomson's core argument in support of reversing the district court's denial of its motion for JMOL is based on its assertions that (1) the jury verdict rests upon mere testimonial evidence by the two non-party MCA employees who worked on the videodisc project, and (2) this evidence is insufficient as a matter of law to support a holding of invalidity under subsection 102(g), because such testimonial evidence by inventors of their prior invention requires corroboration. Even if we accept Thomson's first assertion, and further assume that the MCA employees were acting as inventors in the laser videodisc project, Thomson's argument fails because this case does not present circumstances in which there is a need for corroboration, as hereinafter explained.”) (emphasis added).

[73] Id. at 1176.

[74] Id.

[75] Id.

[76] Mahurkar, 79 F.3d at 1577.

[77] Thomson, 166 F.3d at 1176.

[78] Id.

[79] Id.

[80] Finnigan, 180 F.3d at 1354.

[81] Id. at 1357.

[82] Id. at 1359.

[84] Finnigan, 180 F.3d at 1360-61.

[85] Id. at 1361.

[86] Id.

[87] Id.

[88] Id. at 1369.

[89] Id. at 1366.

[90] Id.

[91] Id. at 1367.

[92] Id. at 1368.

[93] Id. at 1367-68

[94] Id. at 1368.


[96] Id. at 288-89.

[97] Id.

[98] Id. at 289-90.

[99] Finnigan, 180 F.3d at 1368-69.

[100] Id. at 1368.

[101] Id.

[102] Id.

[103] Thomson, 166 F.3d at 1174.

[104] Id. at 1176.

[105] Mahurkar, 79 F.3d at 1577 (emphasis added).

[106] Finnigan, 180 F.3d at 1367.

[107] Thomson, 166 F.3d at 1175 n.3.

[108] See generally, Mahurkar, 79 F.3d at 1577.
However, some scholars have called for an end to or a redefining of, per se antitrust violations on the grounds that they are improperly applied. Thomas G. Krattenmaker, *Commentary, Per Se Violations in Antitrust Law: Confusing Offenses with Defenses*, 77 Geo. L.J. 165, 165-167 (1988).

See generally, EI. du Pont, 620 F.2d at 1261.


Hird, 72 U. Colo. L. Rev. at 271.


See id. at 318-19.

Id. at n.19.


Id. at n. 148.

Id. at 1217.

See generally Lough v. Brunswick Corp., 86 F.3d 1113 (Fed. Cir. 1996). The Lough case involve a boat mechanic who invented a seal for Brunswick boat motors. The inventor, Lough, installed the seal in his, and a few friends’ boats. Brunswick, after learning of Lough’s seal, began manufacturing a similar device. Lough patented his invention and sued Brunswick for infringement. Id.