

APPENDIX

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2 Lurking in this trial record is a legal issue the district judge wishes the Federal Circuit
3 would address in this case or some other case. The issue concerns the “presumptive date of
4 invention,” *i.e.*, the patent-application date, and specifically what burdens attach and to whom
5 when a patentee tries later in infringement proceedings to “swear behind” the presumed date.
6 There are unfair and unwarranted allocations of burdens in the current caselaw, at least
7 arguably. To rebut the presumed date of invention, the caselaw holds that the *accused infringer*
8 must prove any earlier date of invention by clear and convincing evidence. This is as it should
9 be. Sometimes, however, the shoe is on the other foot, *i.e.*, the *patent owner* attempts to “swear
10 behind” the presumed date. This is usually attempted after the defense introduces invalidating
11 prior art and the patent owner wishes to prove an even earlier invention date.

12 In an earlier era, the caselaw, as once stated by Judge Learned Hand, held that the
13 *patent owner*, to rebut the presumed date of invention, must also do so by clear and convincing
14 evidence. *See United Shoe Mach. Corp. v. Brooklyn Wood Heel Corp.*, 77 F.2d 263, 264
15 (2nd Cir. 1935) (“When the inventor’s date is to be carried back beyond his application, courts
16 regard the effort with great jealousy, and must be persuaded with certainty which is seldom
17 demanded elsewhere; quite as absolute as in a criminal case, in practice perhaps even more so”).
18 In this even-handed way, *anyone* who wished to swear behind the presumed date of invention
19 had to do so by clear and convincing evidence.

20 More recent caselaw, however, has disrupted this balance. *Innovative Scuba Concepts,*
21 *Inc. v. Feder Industries, Inc.*, 26 F.3d 1112, 1115 (1994), reversed a district court that had
22 instructed a jury that the patent holder had the burden of rebutting the presumed date of
23 invention by clear and convincing evidence, the appellate court stating: “While a patentee may
24 have the burden of going forward with rebuttal evidence once a challenger has presented a
25 prima facie case of invalidity, the presumption of validity remains and the ultimate burden of
26 proving invalidity remains with the challenger throughout the litigation.”

27 The jury instructions in our immediate case honored the holding of the Federal Circuit.
28 But it deserves to be said that there seems to be a good argument for at least requiring the patent

1 owner to demonstrate more than a modicum of evidence before the presumption is erased.
2 There are two reasons. *First*, the presumption of validity and the clear-and-convincing standard
3 flow from the regularity of the examiner reviewing the application and allowing the claims.
4 But applications very rarely involve any swearing behind the application date, so that there is
5 very rarely any occasion for an examiner to assess issues of actual conception and actual
6 reduction to practice by the applicant. Consequently, there is almost never any basis for
7 according any deference on this fact issue. Therefore, the presumed date of invention should,
8 one can respectfully suggest, apply equally to both sides in patent litigation, as Judge Hand
9 suggested.

10 *Second*, the challenger already has burden enough in overcoming the presumed date
11 of invention and should not also have to prove a negative, much less prove a negative by clear
12 and convincing evidence, namely that the patent owner did *not* invent before the prior art
13 established by the defense. The burden of proving a prior invention should rest on the party in
14 possession of the evidence and who has the affirmative on the issue. It should not be enough
15 for a patent owner to merely “indicate” he invented earlier and then place the burden on
16 the accused infringer to prove otherwise.

17 A later decision involving the problem was *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572
18 (Fed. Cir. 1996). There, the accused infringer, Bard, came forward with an anticipatory
19 publication dated before the filing date of Mahurkar’s patent. The patent owner was then
20 forced by the district court to show an earlier date of invention to swear behind the publication.
21 The question presented to the Federal Circuit was which party bore the burden on the issue
22 and by what standard. The decision stated:

23 Resolution of this point turns on procedural rules regarding
24 burdens of proof as well as several rules of law borrowed from
25 the interference context. Bard offered into evidence at trial a
26 document published about three months before the filing date of
27 Dr. Mahurkar’s patent disclosing each and every element of the
28 claimed invention. Dr. Mahurkar then had the burden to offer
evidence showing he invented the subject matter of his patent
before the publication date of the document. Had Dr. Mahurkar
not come forward with evidence of an earlier date of invention,
the Cook catalog would have been anticipatory prior art under
section 102(a) because Dr. Mahurkar’s invention date would have
been the filing date of his patent. However, Dr. Mahurkar offered

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evidence at trial to show that he invented the subject matter of the patent before publication of the Cook reference. He met his burden of production. . . Bard bears the burden of persuasion on the status of the Cook catalog as prior art. Bard must persuade the trier of fact by clear and convincing evidence that the Cook catalog was published prior to Dr. Mahurkar’s invention date.

Mahurkar thus seemed to hold that once the accused infringer proves anticipation, the patentee need only “offer evidence” of an even earlier invention date and the burden will fall on the accused infringer to prove the negative by clear and convincing evidence, that is, to prove that the patentee did *not* invent earlier than the anticipatory prior art. A subsequent decision states that the patentee need only produce the minimum evidence sufficient to defeat summary judgment to shift this burden to the accused infringer. *Apotex USA, Inc. v. Merck & Co., Inc.*, 254 F.3d 1031, 1037–38 (Fed. Cir. 2001).

A different line of decisions holds that anyone attempting to prove an earlier date of invention (*i.e.*, either side) must satisfy a corroboration requirement, at least as to conception. This line of decisions is even-handed and applies to both sides. *Mahurkar* at 1577.

It is true that the Patent Act presumes the validity of all issued patents and places the burden of invalidating them on the challengers. Once a challenger does so, however, it is respectfully submitted that the challenger should not have the further burden to disprove a patentee’s suggestion (based on merely enough evidence to defeat summary judgment) of an even earlier invention date, much less to prove the negative by clear and convincing evidence. Rather, once the challenger has proven, by clear and convincing evidence, the existence of anticipatory prior art earlier than the presumed date of invention (the filing date), the burden of persuasion should rest on the patentee to “swear behind” the anticipatory art.