Do Documents Generated by an Inventor Have to Be Corroborated?[1]

By

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Introduction

One of the weirdest doctrines of interference law[4] is that the testimony of an

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[4] The same issue (and the same inconsistencies discussed in this article) arises in determinations of priority in infringement actions. Contrast Thomson S.A. v. Quixoyte Corp., 166 F.3d 1172, 49 USPQ2d 1530 (Fed. Cir. 1999), discussed in Gholz, A Critique of Recent Opinion of the Federal Circuit in Patent Interferences, 82 JPTOS 296 (2000) at § IX.A., with Finnigan Corp. v. International Trade Commission, 180 F.3d 1357, 51 USPQ2d 1001 (Fed. Cir. 1999), discussed id. at § I.X.B. And see Mahurkar v. C.R. Bard, 79 F.3d 1572, 38 USPQ2d 1288 (Fed. Cir. 1996), discussed in Gholz, A Critique of Recent Opinion of the Federal Circuit in Patent Interferences, 79 JPTOS 271 (1997) at § VII.A., and Mycogen Plant Science, Inc. v. Monsanto Co., 252 F.3d 1306, 58 USPQ2d 1891 (Fed. Cir. 2001), discussed in Gholz, A Critique of Recent Opinion of the Federal Circuit in Patent Interferences, 84 JPTOS 163 (2002) at IX.B.

inventor concerning priority issues must be corroborated[5] by independent evidence.[6] As stated in the leading case of Reese v. Hurst v. Wiewiorowski, 661 F.2d 1222, 211 USPQ 936 (CCPA 1981):

> The principles of law involved in this case are clear and well-settled ***. The junior and intermediate parties…had the burden of overcoming Wiewiorowski's

[5] Of course, an inventor can also serve as an expert witness, and that kind of inventor testimony doesn't have to be corroborated--although its weight can certainly be attacked for bias. In re Reuter, 670 F.2d 1015, 1021, 210 USPQ 249, 256 (CCPA 1981) ("As to corroboration, the statement of an expert's opinion [in this case, an inventor named Poynter] set forth in an affidavit need not be corroborated."]

[6] Amazingly, the testimony of close family members is accepted as "independent" corroboration. See, e.g. Price v. Symsek, 988 F.2d 1187, 26 USPQ2d 1031 (Fed. Cir. 1993) (the testimony of inventor Price was "independently" corroborated by the testimony of the corporate secretary, Christine Price).

filing date with corroborated evidence.[7]

For purpose of this article, is should be noted that the Reese court drew no distinction among the various types of inventive acts--i.e., conception, classical diligence,[8] Peeler diligence,[9] and actual reduction to practice.

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[7] 661 F.2d at 1225, 221 USPQ at 940. See also 661 F.2d at 1225, 211 USPQ at 940 ("adoption of the 'rule of reason' has not altered the requirement that evidence of corroboration must not depend solely on the inventor himself."). The classic opinion on this point is Mergenthaler v. Scudder, 11 App. D.C. 264, 1897 C.D. 724 (D.C. Cir. 1897), quoted with approval by the Federal Circuit in Price v. Symsek, 988 F.2d 1187, 26 USPQ2d 1031 (Fed. Cir. 1993). In addition to Mergenthaler, the opinion in Price also cited Cislak v. Wagner, 215 F.2d 275, 281-82, 103 USPQ 39, 41-42 (CCPA 1954); Fields v. Knowles, 183 F.2d 593, 601, 86 USPQ 273, 279-80 (CCPA 1950); Amax Fly Ash v. United States, 514 F.2d 1841, 1047-48, 182 USPQ 210, 215 1041 (Ct. Cl. 1974); and Coleman v. Dines, 754 F.2d 353, 359, 224 USPQ 857, 865 (Fed. Cir. 1985), all leading opinions on the point that conception cannot be proved by an inventor's uncorroborated testimony. Many earlier opinions are discussed at 1 Revise and Caesar, Interference Law and Practice, pp. 381-388 (1940).

[8] Classical diligence is diligence during the period between just before one's opponent's conception to one's own reduction to practice (actual or constructive). The standards for classical diligence are very high.

[9] So called after Peeler v. Miller, 535 F.2d 647, 653-54, 190 USPQ 117, 122 (CCPA 1976) (Rich, J.). Peeler diligence is diligence during the period from one's own actual reduction to practice to one's own constructive reduction to practice, and it is really the

The fact that the testimony is that of an inventor doesn't simply mean that its weight can be attacked. The requirement for corroboration is like a go/no go valve. If the inventor's testimony as to inventive acts is not corroborated, it is simply entitled to no weight at all. As stated in Reese, "That Katz had no incentive to report to Reese and Rodger tests which were not actually conducted goes to the weight of the evidence in a rule of reason analysis, but does not satisfy the need for corroboration that is not dependent solely on Katz, as required even under the rule of reason."[10] Thus, uncorroborated inventor testimony might as well be inadmissible.

But, how about a pre-interference document generated by an inventor offered to prove a priority fact--i.e., a fact relating to conception, diligence (classical or Peeler), or actual reduction to practice?

Frilette v. Kimberlin

In Frilette v. Kimberlin, 412 F.2d 1390, 162 USPQ 148 (CCPA 1969), the subject matter at issue was related to a process using a new type of aluminosilicate catalyst for upgrading hydrocarbons. Frilette stated that the starting materials that was used were from bottles that were sitting on top of a file cabinet in co-inventor Weisz's office. He had no independent knowledge of what was in the bottles and had to refer to his notebook. The board found that there was insufficient corroboration to prove a reduction to practice, and the CCPA affirmed. The court said:

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absence of 35 USC 102(g) suppression or concealment. The standards for Peeler diligence are very low.

[10] 661 F.2d at 1233, 211 USPQ2d at 947.

> Neither Frilette nor any other witness offered any testimony that showed how they obtained the starting material which Frilette denominated Linde 13X molecular sieve. What Frilette stated was that "in Mr. Weisz's office he had some bottles of molecular sieves sitting on top of a file cabinet" and that he believed that those bottles contained "Linde 4A powder" and "13X powder." Apparently, those bottles were the source of the molecular sieve material used in the March and April tests for Frilette testified that "to the best of * * * [his] recollection" he got 4A sieve for certain tests from them and no other source was disclosed for the 13X material. Although Weisz testified, he did not state how or when the bottles and their contents were obtained, whether the bottles were sealed or unsealed and how and by whom they might have been labeled. Neither did Frilette nor anyone else. Frilette himself, who had no specific catalyst experience and no experience in the field of aluminosilicate catalysts prior to entering Mobil's employment on March 1, 1956, did not point out how he might have recognized that the materials in the bottles were what he said he believed them to be or that any labels that might have been on the bottles were correct.[11]

Note that there is no per se problem with relying on labels. Most scientists rely on the labels on containers bought from reputable supply houses. The problem with these labels was that there was no evidence of "how and by whom they might have been labeled." In fact, given their provenance, they might well have been labeled by co-inventor Weisz.

Mikus v. Wachtel

In Mikus v. Wachtel, 542 F.2d 1157, 191 USPQ 571 (CCPA 1976), Mikus relied for corroboration of an alleged actual reduction to practice on a "Record of Invention" prepared by co-inventor Shaffer and witnessed by two non-inventors who testified to having "read and understood" it on a given date. The court held that that was not good enough to corroborate the alleged actual reduction to practice:

[11] 412 F.2d at 1396-97, 162 USPQ at 154-55.

> These witnesses did not testify to having actually observed a preparation of a composition embraced by the count. While this document alone may supply evidence of conception,[12] it will not, without more, provide evidence of actual reduction to practice. The material contained therein is based on the inventor's unwitnessed notebook and test results performed by technicians who were unaware of what they were testing. The Record of Invention, therefore, fails to provide Mikus with the needed corroboration of a prior actual reduction to practice.[13]

Reese v. Hurst v. Wiewiorowski

In Reese v. Hurst v. Wiewiorowski, 661 F.2d 1222, 211 USPQ 936 (CCPA 1981), inventor Katz relied on the testimony of a non-inventor to whom Katz had sent a letter describing an alleged reduction to practice to prove that actual reduction to practice. However, the court held that that letter was not corroboration:

> the knowledge he [the alleged corroborator] gained…from reading the August 2, 1969, letter [from the inventor Katz] failed to corroborate an actual reduction to practice because it was dependent solely on what Katz told him.[14]

Schendel v. Curtis

However, in Schendel v. Curtis, 83 F.3d 1399, 38 USPQ2d 1743 (Fed. Cir. 1996) (opinion delivered by C.J. Lourie joined by C.J. Bryson; dissent by C.J. Newman)[15] reached a different result.

The count concerned a fusion protein. Dr. Schendel had given samples, which he

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[12] Of conception, yes, but not of the date of that conception!

[13] 542 F.2d at 1161, 191 USPQ at 575.

[14] 661 F.2d at 1233, 211 USPQ at 947.

[15] I have not given the names of the judges involved in the early cases. However, starting with this one I do so, since Judges Lourie, Bryson, and Newman are still on the court.

labeled as the fusion protein, to three of his corroborating witnesses, who tested them and obtained results consistent with what Dr. Schendel purported them to be. However, the Federal Circuit did not find their testimony sufficiently corroborative because the testers had no independent knowledge of the identity of the samples. They only knew what Dr. Schendel had written on the labels. The accuracy of the statements that Dr. Schendel had written on the labels had to be corroborated:

> conception by an inventor, for the purpose of establishing priority, can not be proved by his mere allegation nor by his unsupported testimony where there has been no disclosure to others or embodiment of the invention in some clearly perceptible form, such as drawings or model, with sufficient proof of identity in point of time. For otherwise such facile means of establishing priority of invention would, in many cases, offer great temptation to perjury, and would have the effect of virtually precluding the adverse party from the possibility of rebutting such evidence. Hence it has been ruled in many cases that the mere unsupported evidence of the alleged inventor, on an issue of priority, as to . . . conception and the time thereof, can not be received as sufficient proof of . . . prior conception.[16]

Singh v. Brake

In Singh v. Brake, 222 F.3d 1362, 55 USPQ2d 1673 (Fed. Cir. 2000) (opinion delivered by C.J. Lourie for a panel that also consisted of C.J.'s Schall and Gajarsa), the panel accepted as evidence corroborating Singh's alleged date of conception Singh's laboratory notebook entries although they "were witnessed several years after they were made..."[17] --which, not surprisingly, was also several years after Brake's filing date. The

[16] 988 F.2d at 1194-95, 26 USPQ2d at 1036; emphasis supplied.

[17] 222 F.2d at 1369, 55 USPQ2d at 1678.

court said that "those shortcomings [were] harmless,"[18] and it explained its reasoning as follows:

> While the witnessing of the laboratory notebooks fell far short of ideal, we do not agree that the belated witnessing undermines all corroborative value that these entries may possess. Under a "rule of reason" analysis, the fact that a notebook entry has not been promptly witnessed does not necessarily disqualify it in serving as corroboration of conception.[19] *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1378, 231 USPQ 81, 89 (Fed. Cir. 1986) (holding that notebook entries not witnessed until several months to a year after entry did not render them "incredible or necessarily of little corroborative value" under the circumstances and in view of other corroborating evidence). Indeed, *Hybritech* indicates that[,] in some cases, conception may be proved *solely* on the basis of laboratory notebook entries witnessed subsequent to their entry.[20] *See id.* ("The laboratory notebooks, *alone*, are enough to show clear error in the findings that underlie the holding that the invention was not conceived before May 1980.") (emphasis of "solely" and "alone" added).[21]

On remand, the board again held against Singh, saying that "Singh's entire case for conception rests on the order of a 24-mer and an uncorroborated notation in a notation in a corner of Dr. Singh's notebook."[22]

Singh appealed again, and, in Singh v. Brake, 48 Fed. Appx. 766, 65 USPQ2d 1641 (Fed. Cir. 2002) (non-precedential) (opinion delivered by C.J. Lourie for a panel that also consisted of S.C.J. Friedman and C.J. Prost), made precedential at 317 F.3d

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[18] *Id.*

[19] As of the date of the witnessing, not as of the date on the notebook entry!

[20] Again, the fact of conception, but not the date of the conception!

[21] 222 F.3d at 1369, 55 USPQ2d at 1678.

[22] 317 F.3d at 1342, 65 USPQ2d at 1646.

1334 (Fed. Cir. 2003), the panel said that:

> we note the Board's finding that, apart from attorney argument, "Singh's evidence of diligence primarily consists of various pages from Dr. Singh's laboratory notebook which are (i) unexplained as to content and relevance to the invention of the Count, and (ii) uncorroborated. Brake, Paper No. 199 at 88. We agree that Singh's activities completed on December 20, 1982, were the only relevant, corroborated activities performed by Singh prior to Brake 1's January 12, 1983, filing date, and, as a result, Singh failed to prove reasonable diligence toward reduction to practice by a preponderance of the evidence.[23]

The court explained that the laboratory notebook was not sufficiently corroborative because (1) a November 24, 1982 entry only "expressed the problem, it did not provide the solution"; (2) the entry cast doubt on the accuracy of Singh's statements that he ordered the proper material for a product encompassed by the count; and (3) there was "nothing in Singh's notebook that corroborates his testimony that the November 24, December 1, and December 21, entries were meant to be read together."[24] This result is not surprising, since the CCPA ruled long ago that corroborative evidence of classical diligence must be specific as to dates and facts.[25]

Cooper v. Goldfarb

Continuing its attack on the requirement for corroboration, a panel of the Federal Circuit in Cooper v. Goldfarb, 240 F.3d 1378, 57 USPQ2d 1990 (Fed. Cir. 2001) (opinion delivered by C.J. Schall for a panel that also consisted of C.J.'s Clevenger and

[23] 317 F.3d at 1343, 65 USPQ2d at 1647.

[24] 317 F.2d at 1342, 65 USPQ2d at 1646.

[25] Kendall v. Searles, 173 F.2d 986, 993, 81 USPQ 363, 369 (CCPA 1949).

Rader), distinguished Gianladis v. Kass, 324 F.2d 322, 139 USPQ 300 (CCPA 1963) (Rich, J.), on the ground that:

> Gianladis' uncorroborated laboratory notebooks indicated that he had conceived the invention before he sent the pertinent material for testing. Id. at 322, 139 USPQ at 302. Thus, ... [Gianladis did not] address[ ] a situation where the inventor had not conceived the invention before he sent for testing the material relied upon to establish reduction to practice.[26]

This statement suggests that an inventor's uncorroborated laboratory notebook can be used to prove that he or she conceived the invention.[27]

Nickles v. Montgomery

The foregoing should be contrasted with the opinion of a three judge panel of the board in Nickles v. Montgomery, 78 USPQ2d 1410 (PTOBPAI 2005) (non-precedential) (opinion delivered by APJ Lee for a panel that also consisted of APJs Schafer and Lane). Nickles makes it clear that at least those APJs still thinks that an inventor's laboratory notebook requires independent corroboration:

> the cited pages of Hawthorne's notebook have not been witnessed by any non-inventor[,] and whatever activity is reflected by the entries lacks independent corroboration. It is well established that an inventor's own testimony[28] requires independent corroboration. *See e.g., Cooper v. Goldfarb,* 154 F.3d 1321, 1329, 47 USPQ2d 1896, 1903

[26] 240 F.3d at 1384, 57 USPQ2d at 1993-94.

[27] Perhaps their Honors did not realize what they were saying. In any event, what they were saying was dictum. The court reached the same result that it would have reached if it had not so interpreted Gianladis.

[28] And, apparently, documents authored by an inventor.

(Fed.Cir. 1998).[29]

Comments

The goal of corroboration in the situation under discussion here is simply to establish that what is stated in the inventor-generated documents is true--both as to the asserted dates of those documents and as to what is stated in those documents--and that the documents were not altered after the date on which they were purportedly generated.[30] Corroboration as to an inventor's testimony is necessary because establishing a claim of derivation or priority of invention requires clear and convincing proof,[31] and named inventors are presumed to be liars until proven otherwise. Thus, the oral testimony of an inventor in isolation is insufficient to meet this requirement as to the substance of alleged inventive acts and as to the dates on which these inventive acts occurred.

Why should documents generated by an inventor be treated any differently?[32]

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[29] 78 USPQ2d at 1413.

[30] In Mr.Gholz's experience, that has been the most frequent problem. That is, after (sometimes long after) the date on the document, the inventor has filled in a blank spot with additional text.

[31] As stated in Reuter "[t]he credibility of…[Poynter's "statements regarding his alleged prior reductions to practice"] must be established by clear and convincing evidence." Reuter, 670 F.2d at 1021, 210 USPQ at 256.

[32] My colleague Robert Nissen has suggested one reason:

> there is one huge difference between documents and testimony. Documents can be dated fairly accurately via ink-drying experts. An ink-drying expert can't tell you if a

The basis for the corroboration requirement for inventor testimony is the suspicion that inventors are so personally biased that their testimony cannot be believed absent independent corroboration. If their testimony is per se unreliable during a perhaps-videotaped deposition during which they are subject to cross-examination under oath, how much more unreliable are their writings when they are alone in their labs, not under oath and not subject to hostile examination? Moreover, a familiar and time-tested legal maxim is falses en uno, falses en omnibus. If we think that an inventor would lie under oath, why would we think that he or she would tell the truth when not under oath?

The panel of the board in Nickles simply treated what the inventor had written in his notebook exactly as if it were the "inventor's own testimony." We like that--assuming, of course, that the requirement for corroboration is still with us as to an "inventor's own testimony."

> document was written in April or May 1996, but he can tell you if parts of the document were written at different times, and he can tell you if a document was written in 1995 or 2000. That is a huge difference from self-serving oral testimony.

True, but in interferences we do not routinely have access to the originals of our opponent's documents. Even to submit them to an examiner of questioned documents, we must prevail on a motion that makes a prima facie case that there is a reason to suspect that they have been altered.