

In re Garner

No. 07-1221, Federal Circuit (Rader, Schall, Moore*)

"[A]n inventor's testimony as to the facts of invention must be corroborated by independent evidence [that] may consist of testimony of a witness, other than the inventor, to the actual reduction to practice [or] evidence of surrounding facts and circumstances independent of information received from the inventor."

On December 5, 2007, the Federal Circuit affirmed the Board of Patent Appeals and Interferences decision that awarded priority to Quate (U.S. Patent No. 6,480,324) in an interference proceeding with Garner (U.S. patent application Serial No. 09/998,341), the count of which related to use of a micromirror to catalyze a chemical reaction on a substrate. The Federal Circuit stated:

Garner attempted to establish priority by showing that he actually reduced to practice an invention within the proposed count before the Quate patent's effective filing date. To this end, Garner submitted a declaration he executed on November 28, 2001 in the parent application (2001 Garner declaration). The declaration had originally been submitted under 37 C.F.R. § 1.131 in an attempt to overcome a prior art rejection in the parent application. The 2001 Garner declaration included: (i) photographs of a device he allegedly built before the filing date of that prior art reference; and (ii) lab notebook pages that allegedly showed that the device worked. To corroborate his claim that he had built the device depicted in his photographs, Garner also submitted a one-page declaration of John Fondon, executed on October 20, 2005 (Fondon declaration).

In response to a letter sent by the examiner that his 2001 declaration was "insufficient" to provoke an interference under 37 C.F.R. § 41.202(d) (Rule 202(d)), without any substantive changes, Garner retitled his 2001 Rule 131 declaration to be a "Rule 202(d) declaration" re-executed and filed it (2005 Garner declaration). . . . The Board found Garner's filing insufficient to establish a prima facie showing of priority. Per Rule 202(d), the Board declared an interference and issued an Order to Show Cause why judgment should not be entered against him. In response to the Board's Order to Show Cause, Garner relied on three items that he did not submit in his original Rule 202(d) filing to show priority: (i) a 37 C.F.R. § 1.131 declaration filed on September 2, 2003 in an attempt to overcome a prior art rejection (2003 Garner declaration); (ii) the specification of his provisional application; and (iii) the specification of his utility application. The Board found that these three items were "new evidence" that is not permitted under Rule 202(d) without a showing of good cause and that Garner had not attempted to show good cause for his belated reliance. Therefore, the Board issued judgment against Garner. . . .

We conclude that the Board's interpretation of "new evidence" is inconsistent with the regulation, as the Board interpreted Rule 202 in a way that requires it to consider the specification under (a), but not under (d), unless the applicant resubmits the specification. Since the specifications were already before the Board in the interference proceeding pursuant to Rule 202(a), they cannot be new evidence under Rule 202(d). Therefore we conclude the Board erred when it found that the specifications constitute "new evidence" under Rule 202(d).

Even with the patent specifications in evidence, Garner failed to establish a prima facie showing of priority. "In order to establish an actual reduction to practice, the inventor must prove that: (1) he constructed an embodiment or performed a process that met all the limitations of the interference count; and (2) he determined that the invention would work for its intended purpose." In addition, an inventor's testimony as to the facts of invention must be corroborated by independent evidence. "Independent corroboration may consist of testimony of a witness, other than the inventor, to the actual reduction to practice or it may consist of evidence of surrounding facts and circumstances independent of information received from the inventor." Sufficiency of corroboration is determined by using a "rule of reason" analysis, under which all pertinent evidence is examined when determining the credibility of an inventor's testimony.

Even with the specifications, Garner's submissions to the Board do not sufficiently corroborate his claim of actual reduction to practice. The Fondon declaration states that Fondon saw the device shown in the photographs in Garner's laboratory in November 1997. Fondon does not testify that the device operated or worked for its intended purpose. In fact, Fondon does not indicate that he ever saw the device operate. At most the Fondon declaration corroborates the existence of a device purportedly shown in the photographs.

While "the law does not impose an impossible standard of 'independence' on corroborative evidence by requiring that every point of a reduction to practice be corroborated by evidence having a source totally independent of the inventor . . . [,]" corroboration of the existence of the device is not sufficient in this case to establish corroboration of reduction to practice. It is also necessary to corroborate that the device worked for its intended purpose. The Board's ultimate holding regarding the insufficiency of the showing is supported by substantial evidence. Thus, the Board's failure to consider the specifications amounts to harmless error. For the foregoing reasons, the judgment of the Board is affirmed.

The previous statements are for information purposes only, and do not constitute legal advice. Questions regarding the matters discussed above, and any requests to be subscribed to the free electronic distribution of this publication, may be directed to Lawrence M. Sung, Ph.D., at +1 202.862.1025 or lsung@dl.com, or to any other Dewey & LeBoeuf LLP attorney with whom you regularly consult.

NEW YORK | LONDON MULTINATIONAL PARTNERSHIP | WASHINGTON, DC
ALBANY | ALMATY | AUSTIN | BEIJING | BOSTON | BRUSSELS | CHARLOTTE | CHICAGO | EAST PALO ALTO
FRANKFURT | HARTFORD | HONG KONG | HOUSTON | JACKSONVILLE | JOHANNESBURG (PTY) LTD. | LOS ANGELES
MILAN | MOSCOW | PARIS MULTINATIONAL PARTNERSHIP | RIYADH AFFILIATED OFFICE | ROME | SAN FRANCISCO | WARSAW