

No. 10-290

IN THE
Supreme Court of the United States

MICROSOFT CORPORATION,
Petitioner,

v.

14I LIMITED PARTNERSHIP AND INFRASTRUCTURES FOR
INFORMATION INC.,
Respondents.

On Writ of Certiorari to the
Supreme Court of the
United States

BRIEF OF *AMICUS CURIAE*
WILLIAM MITCHELL COLLEGE OF LAW
INTELLECTUAL PROPERTY INSTITUTE
IN SUPPORT OF PETITIONER

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INTEREST OF *AMICUS CURIAE*¹

The Intellectual Property Institute is an entity within William Mitchell College of Law. The mission of the Institute is to foster and protect innovation through education, research, and service initiatives. Among its activities, the Institute advocates for the responsible development and reform of intellectual property law, including patent laws and the patent system of the United States. A purpose of the Institute is to raise issues and arguments in light of the public interest and the best interests of the patent system as a whole. The Institute has no financial interest in any of the parties to the current action.

¹Pursuant to Supreme Court Rule 37.6, no counsel for a party authored this brief in whole or in part, and no counsel or party made a monetary contribution intended to fund the preparation or submission of this brief. No person other than *amicus curiae* or its counsel made a monetary contribution to its preparation or submission. Additionally, counsel for both parties have consented to the filing of this brief, and their consents have been filed with the Clerk of this Court.

SUMMARY OF ARGUMENT

This case presents the opportunity to clarify what has been a nettlesome problem in United States patent law. Invalidity is an affirmative defense to a charge of patent infringement.² As such, proof of it should be governed by the preponderance standard of proof that applies to civil actions generally.³ Instead, over the years proof of the overall defense, as well as particular issues within it, has been treated under an unwieldy amalgam of standards, under various theories.⁴ Inevitably, the theories have conflicted, leading to confusion.⁵

The Institute believes that this state of affairs would be materially improved by conforming the proof of

²See, e.g., 35 U.S.C. § 282.

³See, e.g., *Addington v. Texas*, 441 U.S. 418, 423 (1979); *Herman & MacLean v. Huddleston*, 459 U.S. 375, 389-390 (1983); *Grogan v. Garner*, 498 U.S. 279, 286 (1991).

⁴Compare, e.g., *Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U.S. 275, 284-85 (1892); *Alexander Milburn Co v. Davis-Bournonville Co.*, 270 U.S. 390 (1926); *Radio Corporation of America v. Radio Engineering Laboratories*, 54 S.Ct. 752 (1934); *Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350 (Fed. Cir. 1984).

⁵Compare, e.g., *Alexander Milburn Co v. Davis-Bournonville Co.*, 270 U.S. 390 (1926), with *Radio Corporation of America v. Radio Engineering Laboratories*, 54 S.Ct. 752 (1934).

Compare, e.g., *Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350 (Fed. Cir. 1984), with *In re Etter*, 756 F.2d 852 (Fed. Cir. 1985).

patent invalidity to the legal principles that govern the law of proof in civil actions generally. As such, the issue should be governed by a standard calling for a preponderance of the evidence.

ARGUMENT

A. Requiring All Invalidity Issues to be Proved by Clear and Convincing Evidence is Historically Anomalous

Respondent would have this Court understand that United States patent law has long settled on the rule that issues of patent invalidity be proved by clear and convincing evidence. This is not the case. The insistence on this requirement across all issues of invalidity is comparatively new, dating back only to the early years of the United States Court of Appeals for the Federal Circuit. More broadly, even the narrower formulation of the rule has never been truly settled.

1. The Rule Was Extended to Issues Not Before the USPTO Only Recently

The lightweight history of the rule subjecting invalidity to an elevated standard of proof can be seen in the extension of that rule to factual questions beyond those that were before the USPTO during prosecution. That extension occurred only in the 1984 decision of the United States Court of Appeals for the Federal Circuit,

*Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*⁶ Prior to that date the usual rule in the regional circuit courts of appeal was that an elevated standard of proof was not required for facts not before the agency.⁷

When viewed against the history of the patent system as whole, therefore, the rule in *Am. Hoist* is an upstart. Its pedigree is short; its inception is unconnected with any underlying development, save the transfer of a substantial portion of the jurisdiction over patent matters to a new court of appeals.⁸

2. The Rule Conflicts With the Judiciary's Primary Role in Determining Patent Eligibility

Insisting that patent invalidity be proven by an elevated standard of proof is also inconsistent with the

⁶*Am. Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350 (Fed. Cir. 1984).

⁷*See generally, e.g., Futorian Mfg. Corp. v. Dual Mfg. & Eng'g, Inc.*, 528 F.2d 941, 943 (1st Cir. 1976); *Baumstimler v. Rankin*, 677 F.2d 1061, 1066 (5th Cir. 1982); *Manufacturing Research Corp. v. Graybar Electric Co.*, 679 F.2d 1355, 1364 (11th Cir. 1982).

See also, e.g., Roeming, George C., Court Decisions as Guides to Patent Office, Study no. 25 of the Subcommittee on Patents, Trademarks, and Copyright of the Committee of the Judiciary of the United States Senate, 85th Cong., 2nd Sess., pursuant to S. Res. 236, 5-6 (1960).

⁸Federal Courts Improvement Act of 1982, Pub.L. 97-164, 96 Stat. 25 (1982).

basic structure of the patent system. Congress has given primary authority for determining whether individual inventions are eligible for patenting to the courts.⁹ Indeed, during the first decades of the system, Congress entrusted the task to the Judiciary entirely: the Executive's role in administering the patent grant was nominal; patents were to be granted to all applicants who met the necessary formal requirements, without any examination into substance.¹⁰

This early background puts the USPTO's examination function into proper context. When Congress initiated it, via the Patent Act of 1836,¹¹ the purpose was simply to relieve the courts of having to adjudicate the status of inventions that were clearly not patent eligible.¹² Pointedly, the purpose was not to

⁹35 U.S.C. §§ 281, 282.

¹⁰Patent Act of 1793, 1 Stat. 318 (1793).

See also Senate Report Accompanying Senate Bill No. 239, 24th Cong., 1st Sess. (April 28, 1836) (“The act 1793, which is still in force, gives, according to the practical construction it has received, no power to the Secretary to refuse a patent for want of either novelty or usefulness. The only inquiry is whether the terms and forms prescribed are complied with. The granting of patents therefore is but a ministerial duty. Every one who makes application is entitled to receive a patent by paying the duty required, and making his application and specification in conformity with the law.”).

¹¹Patent Act of 1836, 5 Stat. 117 (1836).

¹²*See, e.g.*, Senate Report Accompanying Senate Bill No. 239, 24th Cong., 1st Sess. (April 28, 1836) (“A power in the Commissioner of the Patent Office to reject applications for want

reorder the system so that the agency's initial granting decision was somehow superior; rather, the main adjudication of eligibility continues to be before the courts, when the issued patent is alleged to be invalid, either in defense to a charge of patent infringement or, more recently, as part of an effort to secure a declaratory judgment.

Various legal authorities over the years have affirmed this basic arrangement. It has long been settled, for example, that courts have the authority to hold issued patents invalid, even over art that has already been considered by the USPTO during prosecution.¹³ In addition, as recently as the late 1950's the USPTO operated under the so-called "rule of doubt," under which applications whose patentability

of novelty in the invention, it is believed, will have a most beneficial and salutary effect in relieving meritorious inventors, and the community generally, from serious evils growing out of the granting of patents for every thing indiscriminately, creating interfering claims, encouraging fraudulent speculators in patent rights, deluging the country with worthless monopolies, and laying the foundation for endless litigation.

See generally also Thompson v. Haight, 23 F.Cas. 1040, no. 13,957 (C.C.N.Y. 1826) (noting widespread assertions of questionable patent rights under Patent Act of 1793).

¹³*See, e.g., Andrews v. Hovey*, 124 U.S. 694, 717–18 (1888); *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348 (Fed. Cir. 2007) ("Our case law consistently provides that a court is never bound by an examiner's finding in an *ex parte* patent application proceeding."); *KSR Intern. Co. v. Teleflex Inc.*, 127 S. Ct. 1727 (2007).

was doubtful were allowed to issue.¹⁴ The express purpose of the rule was to preserve the right of the Judiciary to make the final determination of patent eligibility.¹⁵

Indeed, the USPTO itself has recognized that its examination function typically delves into only some potential grounds of ineligibility, and leaves many others unaddressed. The USPTO's records of prior technological activity consist largely of issued patents, and to a lesser degree, other printed publications in the English language. Yet under the statute, patent eligibility depends on whole other categories of information, such as prior public uses and sales,¹⁶ and the unpublished prior activities of other inventors.¹⁷ The agency has admitted that it typically does not

¹⁴*See, e.g.,* Roeming, George C., Court Decisions as Guides to Patent Office, Study no. 25 of the Subcommittee on Patents, Trademarks, and Copyright of the Committee of the Judiciary of the United States Senate, 85th Cong., 2nd Sess., pursuant to S. Res. 236, 2-4, 7-8 (1960).

See also, e.g., Geniesse, Eugene W., The Examination System in the U.S. Patent Office, Study no. 29 of the Subcommittee on Patents, Trademarks, and Copyright of the Committee of the Judiciary of the United States Senate, 85th Cong., 2nd Sess., pursuant to S. Res. 236 (1961).

¹⁵*See, e.g., In re Thompson*, 26 App. D.C. 419, 425 (1906).

¹⁶*See, e.g.,* 35 U.S.C. § 102(b).

¹⁷*See, e.g.,* 35 U.S.C. § 102(g).

address these issues of eligibility.¹⁸ Thus, there are entire areas, commonly addressed in validity litigation, that logically should not involve any deference to the USPTO.

3. Congress Did Not Specify an Elevated Standard of Proof in Section 282

This set of conclusions is not affected by section 282 of the patent statute.¹⁹ That section was enacted as part of the Patent Act of 1952.²⁰ It does contain the admonition that issued patents shall be presumed valid.²¹

¹⁸*See, e.g.*, Roeming, George C., Court Decisions as Guides to Patent Office, Study no. 25 of the Subcommittee on Patents, Trademarks, and Copyright of the Committee of the Judiciary of the United States Senate, 85th Cong., 2nd Sess., pursuant to S. Res. 236, 6-7 (1960) (“In most cases, patents are found invalid on the basis of evidence not in the Patent Office record. In some cases, the additional evidence is such that it is not available to the Patent Office, for example testimony as to prior use or knowledge, testimony pertinent to obviousness to one skilled in the art, and publications not in the Patent Office files.”).

See also, e.g., 35 U.S.C. § 301 (limiting reexamination of issued patents to questions of patentability raised on the basis of patents or printed publications).

¹⁹35 U.S.C. § 282.

²⁰Patent Act of 1952, Pub. L. No. 82-593, ch. 950, 82nd Cong., 2nd Sess., 66 Stat. 792 (July 19, 1952).

²¹35 U.S.C. § 282 (“A patent shall be presumed valid.”).

There is scant evidence, however, that Congress understood this provision at the time as cementing an elevated standard of proof. The associated reports, for example, do not mention a standard of proof.²² Nor does the contemporaneous Commentary of Pasquale J. Federico.²³

Those alive at the time, moreover, generally understood this language as function to allocate the burden of proof away from the patent owner, and onto the party who asserted invalidity.²⁴ Prior to that time

²²*See, e.g.*, Senate Report No. 82-1979, 82nd Cong., 2nd Sess (June 27, 1952) (“Section 282 introduces a declaration of the presumption of validity of a patent, which is now a statement made by courts in decisions, but has had no expression in the statute.”).

See also the Revision Notes (“The first paragraph declares the existing presumption of validity of patents.”).

The House Report is essentially a duplicate of the Senate Report.

²³Federico, Pasquale J., Commentary on the New Patent Act, reprinted at 75 JPTOS 161 (1993) (“The first paragraph of section 282 declares that a patent shall be presumed valid and that the burden of establishing invalidity of a patent shall rest on a party asserting it. That a patent is presumed valid was the law prior to the new statute, but it was not expressed in the old statute. The statement of the presumption in the statute should give it greater dignity and effectiveness.”).

²⁴*See, e.g.*, 35 U.S.C. § 282 (“The burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.”).

As originally enacted the first paragraph of section 282 read in its entirety as: “A patent shall be presumed valid. The burden of establishing the invalidity of patent shall rest on a party asserting it.” *See* Patent Act of 1952, Pub. L. No. 82-593, ch. 950, 82nd Cong.,

the law relating the burden of proof was relatively complex. The basic burden of establishing validity fell on the patent owner.²⁵ The issued patent, however, was usually considered to be *prima facie* proof on the point, so that entry of the patent into evidence shifted the burden to the challenger, to establish a rebuttal.²⁶

This rule was itself subject to exceptions, so that in some instances the issued patent was not considered sufficient to establish a *prima facie* case, and the burden of proving validity remained on the patent owner.²⁷ This was particularly true where the patent owner's success depended on her establishing a date of invention prior to her own date of filing, so that the accuracy and veracity of her own testimony was called into question.²⁸

2nd Sess., 66 Stat. 792 (July 19, 1952).

²⁵See, e.g., *Reckendorfer v. Faber*, 92 U.S. 347 (1875); *Miller v. Smith*, 5 F. 359 (C.C.R.I. 1880).

See also 3 Robinson, William C., *Treatise on the Law of Patents and Useful Inventions* § 1018 (1890) (stating rule and collecting authorities).

²⁶See, e.g., 3 Robinson, William C., *Treatise on the Law of Patents and Useful Inventions* § 1016 (1890) (stating rule and collecting authorities).

²⁷See, e.g., *Stoody Co. v. Mills Alloys*, 67 F.2d 807 (9th Cir. 1933) (collecting authorities); *American Lakes Paper Co. v. Nekoosa-Edwards Paper Co.*, 83 F.2d 847 (7th Cir. 1936) (collecting authorities); *Mershon v. Sprague Specialties Co.*, 92 F.2d 313 (1st Cir. 1937) (Wilson, J., dissenting).

²⁸See, e.g., *Alexander Milburn Co v. Davis-Bournonville Co.*, 270 U.S. 390 (1926) ("The date of the invention, on absence of evidence

Authorities from the time recognized this point as being in substantial controversy.

The better understanding of section 282, therefore, is that it does not necessarily represent Congress's adoption of any particular standard of proof. Rather, the section is easily read as intending to overturn this troublesome line of cases, and place the burden of establishing invalidity, by whatever standard, onto the patent challenger.

This view is confirmed by looking to other statutory provisions that Congress crafted around the same time. On numerous occasions Congress specified that particular factual issues were to be established by clear and convincing evidence.²⁹ This includes a statute enacted in the very same Congress as the Patent Act of

to the contrary, is presumed to be that on which the application was filed in the Patent Office, and where the date is carried back beyond the application, proof must be persuasive to a certainty, beyond a reasonable doubt.”).

²⁹An Act to Amend the World War Veteran's Act of 1924, ch. 849, 46 Stat. 991, 996 (1924); An Act to Protect the United States against certain un-American and subversive activities by requiring registration of communist organizations and for other purposes of 1950, ch. 1024, 64 Stat. 987, 1017 (1950); Compensation for Service-Connected Disability or Death of 1958, Pub. L. No. 85-857, 72 Stat. 1105, 1125 (1958); Labor-Management Reporting and Disclosure Act of 1959, Pub. L. No. 86-257, 73 Stat. 519, 531-32 (1959).

1952.³⁰ These other statutes demonstrate that Congress not only could, but actually did, specify an elevated standard of proof when it thought appropriate. Taken as a group, they argue persuasively that Congress did not intend an elevated standard of proof in section 282.

B. Insisting That Patent Invalidity Be Proved by Clear And Convincing Evidence Conflicts with General Legal Principles

This Court has recently restated the general legal principle, that the preponderance-of-the-evidence standard is “presum[ptively]” applicable in civil actions between private litigants.³¹ It is beyond question that patent infringement suits are a form of civil litigation between private litigants.³² Thus, the basic presumption is that patent invalidity should be decided under a preponderance standard, not clear and convincing.

Nor does an action for patent infringement fall into any of the applicable exceptions. For example, it does not call into question “particularly important individual

³⁰Nationality Through Naturalization of 1952, ch. 2, 66 Stat. 163, 258 (1952).

³¹*Grogan v. Garner*, 498 U.S. 279, 286 (1991).

³²See 35 U.S.C. § 281 (“A patentee shall remedy by civil action for infringement of his patent.”).

interests or rights.”³³ While one certainly can argue that patent rights are important, it is unlikely that they are appreciably more important than other interests already adjudicated in civil actions by a preponderance. Inevitably, approving an elevated standard for patent invalidity will lead to calls for non-patent causes of action to be treated similarly.

As another example, actions for patent infringement call for sharing the risk of decisional error equally, rather than favoring patent owners over accused infringers.³⁴ This Court has repeatedly stressed that the existence of rights under the patent system must be calculated against the public’s interest in accessing technology that is free to open competition.³⁵

Still further, it is of little import that issues of patent invalidity often call for the evaluation of oral testimony by persons asserting to be early inventors. One may accept for the sake of argument that this issue presents opportunities for proponents to offer assertions that are ill-founded and inaccurate.³⁶ But this is still

³³*Herman & MacLean v. Huddleston*, 459 U.S. 375, 389-390 (1983).

See also Grogan v. Garner, 498 U.S. 279, 286 (1991).

³⁴*See, e.g., Addington v. Texas*, 441 U.S. 418, 423 (1979).

³⁵*See, e.g., Lear, Inc. v. Adkins*, 395 U.S. 653 (1969); *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

³⁶*See, e.g., Washburn & Moen Mfg. Co. v. Beat 'Em All Barbed-Wire Co.*, 143 U.S. 275, 284-85 (1892).

insufficient. Under substantive patent law the party seeking to set up an earlier date of invention can be not only the party alleging invalidity, but the patent owner as well.³⁷ As a consequence, a rule that works always to the favor of the patent owner, and against the patent challenger, is logically unsound.

CONCLUSION

For the foregoing reasons, the Institute respectfully submits that issues of patent invalidity beyond those that were before the USPTO during prosecution of the underlying application need not be proved by an elevated standard of proof. Instead,

³⁷*See, e.g.*, 35 U.S.C. § 102(a), (e), (g).
See, e.g., Alexander Milburn Co v. Davis-Bournonville Co., 270 U.S. 390 (1926).

those issues should be provable by a simple preponderance. On that basis, it urges that the decision below be vacated.

Respectfully submitted,

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