

FLEMING v. ESCORT INC., Appeal No. 2014-1331, -1371 (Fed. Cir. December 24, 2014).
Before Taranto, Hughes and Bryson. Appealed from the D. Idaho (Judge Winmill).

Background:

Fleming sued Escort for infringement of two reissue patents directed to radar detectors for detecting police signals. As a defense, Escort asserted that an employee, Steven Orr, had invented the same device prior to Fleming. The district court found for Fleming on infringement and validity except that five of the claims in one reissue patent were invalidated. Fleming appealed the invalidity, arguing that (1) the testimony offered to establish invalidity was insufficiently specific to support the verdict; (2) there was insufficient corroboration of the prior invention relied on for the invalidity determination; and (3) the prior invention, if it existed, was abandoned, suppressed or concealed, disqualifying it from invalidating the claims. Escort cross-appealed stating that the reissue patents were invalid because Fleming's reason for seeking reissue did not meet the "error" precondition for obtaining reissue.

Issue/Holding:

Did the district court err in its holding of invalidity of the five claims? No. Did the district court err in holding that the reissue patents were valid? No. Affirmed.

Discussion:

In holding that the five claims were invalid, the court reviewed Fleming's three arguments. Fleming first argued that Escort's invalidity evidence based on Orr's testimony was not specific enough, because the evidence was based on general and conclusory testimony. The court held that the testimony offered to establish invalidity was specific enough to support the verdict, because it was based on inventor and expert testimony regarding both the Orr invention and other asserted prior art references.

Fleming also argued that there was insufficient corroboration of the prior invention relied on for the invalidity determination, because all of the testimony was not supported by other evidence. In response, the court held that the standard for determining whether corroborative evidence supports the inventor's story is based on the "rule of reason" and that the law does not require every point of reduction to practice be corroborated by independent evidence. The court held that the documentary evidence, which included data from GPS experiments, notes from a brainstorming session discussing the invention, and a letter from the company president discussing the significance of the invention, sufficiently corroborated Orr's testimony.

Fleming then argued that the prior invention, if it existed, was abandoned, suppressed or concealed, disqualifying it from invalidating the claims. The court found no evidence of suppression or concealment of the invention. Further, even if there was a delay, the delay was not unreasonable due to the bankruptcy of Orr's original company and the subsequent continuing efforts by Orr to work on the invention, and because Orr returned to working on the invention before Fleming started on his invention.

In the cross-appeal, Escort argued that the reissue patents are invalid because there was no "error" in the original patent, a prerequisite to obtaining a reissue patent. The court disagreed, stating that errors are not limited to "slips of the pen", but may also include failing to appreciate the full scope of the invention. Escort further argued that it was market developments that prompted Fleming to reassess the issued claims, and therefore, not error. The court disagreed, stating that market developments are common instances for an inventor to acknowledge errors in claims, and that it does not matter what triggers an inventor to recognize these errors.