

TRANSWEB, LLC v. 3M INNOVATIVE PROPERTIES CO., Appeal No. 2014-1646 (Fed. Cir. February 10, 2016). Before Wallach, Bryson, and Hughes. Appealed from D.N.J. (Judge Hochberg).

Background:

3M sued TransWeb for infringing claims of several of its patents and TransWeb countersued for a declaratory judgment of invalidity and non-infringement of 3M's patents directed to a filter.

At trial, TransWeb's founder, Kumar Ogale, testified that he handed out a filter product similar to 3M's asserted filter at a public exposition that occurred more than a year before 3M filed the patent applications. Based on this evidence, the jury found 3M's patents to be invalid based on TransWeb's prior public use of the filter. 3M appealed the district court's judgment of invalidity.

Issue/Holding:

Did the district court err in determining that there was sufficient corroborating evidence to support the finding of prior public use by TransWeb of 3M's patented filter? No, affirmed.

Discussion:

On appeal, 3M contested the district court's judgment of invalidity of its patents based on a purported lack of corroboration of Mr. Ogale's public use testimony. Specifically, 3M argued that TransWeb failed to provide independent evidence of all "material facts" of the purported invalidating public use because TransWeb provided no corroborating evidence that the patented filter was the type of filter that was distributed at the expo.

In consideration of 3M's argument, the Federal Circuit recognized that while oral testimony of an interested party generally does not suffice as clear and convincing evidence of invalidity, a "rule of reason" analysis used to determine the sufficiency of corroboration "does not require that every detail of the testimony be independently and conclusively supported." The Federal Circuit expounded that this "rule of reason" requires that independent evidence, taken as a whole, makes credible the testimony of the purported prior inventor with regard to conception and reduction to practice of the claimed invention.

In light of this, the Federal Circuit, reviewing the record at trial for clear error, found that although there was no direct evidence to corroborate Mr. Ogale's testimony that he handed out at the exposition a filter medium similar to that of 3M's asserted filter, the record provided other corroborating evidence showing that TransWeb filed a patent application for Mr. Ogale's filter at the time of the expo and that correspondences with a third party after the exposition demonstrated that TransWeb sent out samples that would invalidate 3M's patented filter. Because of this corroborating evidence, the Federal Circuit concluded that there was no clear error in the district court's determination and affirmed the district court's holding.