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Patent Rules of Evidence

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PATENT RULES OF EVIDENCE

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Abstract
The Federal Rules of Evidence apply to all proceedings in Federal District Courts, including patent cases. Unique evidentiary issues arise in patent cases because Title 35 of the United States Code contains restrictions that are tantamount to special rules of evidence. In some areas of patent litigation, courts and litigants also rely on judicial rulings as the dominant source of controlling authority. A notable example of the dominance of judicial rule making is the United States Supreme Court’s Markman v. Westview Instruments, Inc. decision and the large body of cases from the Federal Circuit applying the Markman decision. This article discusses the benefit to patent litigation that has resulted from authoritative judicial rule making. Using the Markman paradigm, this article discusses a similar benefit that would be gained from an articulation of the specialized rules of evidence that apply to patent cases and suggests examples of such an articulation.

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I. INTRODUCTION

The Federal Rules of Evidence ("FRE") apply to all proceedings in Federal District Courts. However, some of the provisions of the FRE apply exclusively to civil cases and some apply exclusively to criminal cases. In general, the FRE provisions that apply to civil cases apply irrespective of the substantive law in a particular case. However, there exist many exceptions in which the substantive law also controls the admissibility of evidence, such as the parol evidence rule of contract law. Under the parol evidence rule, otherwise admissible extrinsic evidence is not admissible to add or change the terms of a written contract. The substantive patent laws exert similar control over the admissibility of evidence.

A. Patent Rules of Evidence Derived From the Patent Statutes

District courts routinely apply the FRE in patent litigation to resolve issues common to all cases, such as relevance or hearsay. However, unique evidentiary issues arise in patent cases because Title 35 of the United States Code, which regulates the issuance of patents and provides mechanisms for their protection, contains restrictions that, as applied, are tantamount to special rules of evidence. A patent grants the patentee the right to exclude others from making, using, or selling the patented invention throughout the United States for a statutory term. The phrase "patented invention" restricts the admissibility of evidence by restricting infringement to the claims of the patent. Similarly, the words "making" or "using" operate as restrictions on admissible evidence by controlling what acts can

2. See, e.g., Fed. R. Evid. 301, "Presumptions in General in Civil Actions and Proceedings."
3. See, e.g., Fed. R. Evid. 404(a)(1)-(2), "Character of accused; Character of alleged victim."
5. See, e.g., Pac. Gas & Elec., 442 P.2d at 643-44.
8. Id.
constitute infringement. The phrase "without authority" speaks to admissibility of evidence by controlling who is potentially liable for infringement.

B. Patent Rules of Evidence Derived From Judicial Decisions

In our jurisprudence, judicial decisions construing the meaning and application of a federal rule are relied upon as authority in subsequent cases. Indeed, some judicial decisions are so authoritative that they have taken on the character of being rules themselves. For example, *Miranda v. Arizona* has become an established evidentiary rule, controlling the circumstances of admission into evidence of statements made by a person while in custody. Similarly, *Daubert v. Merrell Dow Pharmaceuticals, Inc.* has become, for all practical purposes, a rule of evidence with respect to the admissibility of expert opinion testimony.

Like all statutory enactments, the meaning and application of the FRE has been the subject of innumerable judicial decisions. In some areas of patent litigation, courts and litigants rely on judicial rulings as the dominant source of controlling authority. A notable example of the dominance of judicial rule-making is the United States Supreme Court’s decision in *Markman v. Westview Instruments, Inc.* and the large body of cases from the Federal Circuit applying the *Markman* decision.

This article highlights the benefit to patent litigation that has resulted from authoritative judicial rule making. Using as a paradigm the articulation of a set of definitive rules of claim construction that have emerged from judicial decisions following the *Markman* decision and the consequent benefit that this articulation has bestowed on patent litigations, this article discusses a similar benefit which would be gained from an articulation of the specialized rules of evidence that apply to patent cases and suggests examples of such an articulation.

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9. *Id.* For example, evidence that a defendant is performing a "repair" on an accused product might not be admissible to prove infringement.

10. *Id.*


12. *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 U.S. 579 (1993). *Daubert* requires the trial judge to decide under FED. R. EVID. 104(a) whether the expert is proffering testimony which is (1) scientific and (2) that will assist the trier-of-fact to understand or determine a fact in issue. If not, as gatekeeper, the trial judge may refuse to allow the witness to testify or limit the witness’ testimony. *Id.* at 592.

II. THE RULES OF CLAIM CONSTRUCTION

Like other areas of substantive law, judicial decisions interpreting the patent statutes play a significant role. The continuing relevance and viability of the patent statutes are sustained by frequent rejuvenation in the form of judicial decisions that apply the patent laws to new technology and subject matter. The decisions also refine and keep current the rules governing patent litigation. A case can be made that among the three constituents – the Federal Rules of Evidence, Title 35, and judicial decisions – judicial decisions are the dominant source of rules governing modern patent litigation.

One need go no further than Markman to illustrate the dominance of judicial decisions as a rule-making force. The Markman decision altered the legal landscape and shifted the center of decision-making power in patent cases from the jury to the Federal Circuit.14 It is commonplace for judges and litigants to refer to a hearing to decide the meaning of patent claim language as a Markman hearing. Pursuant to the mandate of the Markman decision, through its decisions, the Federal Circuit has promulgated a set of “rules” which district judges are advised, if not required to follow during the claim construction process.15 The process of initial construction by the district court followed by Federal Circuit de novo review16 has resulted in a well recognized, clearly articulated set of “Rules of Claim Construction.”

These judicially created Rules of Claim Construction are extremely helpful in regularizing the claim construction process. The rules of construction work so well that, among the many proposals for reforming the patent litigation process, there is no active proposal to formally codify them into statutory language.18 Recognizing the

14. Id. at 390-91.
15. Tegal Corp. v. Tokyo Electron Am., Inc., 257 F.3d 1331, 1341 (Fed. Cir. 2001) (“The district court construed this term in its Markman hearing approximately four months before trial . . . .”).
16. Claim construction by the district court is a matter of law, which the Federal Circuit or the Supreme Court reviews de novo. Kemco Sales, Inc. v. Control Papers Co., 208 F.3d 1352, 1359-60 (Fed. Cir. 2000).
17. Tegal, 257 F.3d at 1342 (“[W]e construe the term ‘electrode’ according to the normal rules of claim construction.”).
important role it has in formulating Rules of Claim Construction, the Federal Circuit has taken great care to articulate definitive rules.

A. Summary of the Rules of Claim Construction

The series of decisions pursuant to Markman have been distilled to produce well-known Rules of Claim Construction, including:

Rule 1. When construing a patent claim, the court should look first to the language of the claim.\(^1\)

Rule 2. Before adopting an interpretation, the court must consult the other intrinsic evidence.\(^2\)

Rule 3. Unless a particular meaning is given to claim language in the intrinsic evidence,\(^3\) there is a heavy presumption that the claim language should be given its ordinary and accustomed meaning to one of ordinary skill in the relevant art.\(^4\)

Rule 4. Although claim language should be construed with reference to other parts of the specification, a limitation from an

\(^1\) Phillips v. AWH Corp., 415 F.3d 1303, 1312 (Fed. Cir. 2005).

\(^2\) Teleflex, Inc. v. Ficosa N. Am. Corp., 299 F.3d 1313, 1324 (Fed. Cir. 2002). The Court must approach claim construction with an understanding that a person of ordinary skill in the art reading the intrinsic evidence would give consideration to whether the disputed word is one commonly used in lay language, a technical word, or a word coined by the inventor. Id. at 1325.

\(^3\) Even with a commonly used word, an inventor is free to act as lexicographer. Vtronics Corp. v. Conceptronic, Inc., 90 F.3d 1576, 1582 (Fed. Cir. 1996). When acting as a lexicographer the inventor can define commonly used words or phrases differently from their ordinary meanings. Id. If the inventor acts as a lexicographer, the court must examine the claim and other parts of the patent specification to determine if the inventor is using the words with a specialized meaning. Id.

If it is in evidence, the court examines the prosecution history of the patent for any specialized definition of a word used in a claim. Id. A statement made by the inventor in the prosecution of the patent application as to the scope of the invention may be considered as evidence of what meaning should be given to a word or phrase of a claim. Microsoft Corp. v. Multi-Tech Sys., Inc., 357 F.3d 1340, 1349 (Fed. Cir. 2004). A clearly stated specialized definition in the specification or during prosecution is normally adopted by the court as dispositive of the meanings of the word or phrase. Phillips, 415 F.3d at 1315.

\(^4\) The court must construe the patent claim in accordance with what a person of ordinary skill in the art would understand the claim to mean at the time of the invention. Phillips, 415 F.3d at 1313. The time of the invention is the effective filing date of the patent application. Id.
embodiment should not be read into the claim, unless the embodiment is described as the invention itself. 23

**Rule 5.** Claim language should be construed to encompass a disclosed embodiment. 24

**Rule 6.** The court may receive extrinsic evidence, but may not rely upon it if it contradicts the unambiguous claim language. 25

These are only a few of the Rules of Claim Construction. It is possible to distill a related set of rules specifically dealing with claims disclosed in means-plus-function format. 26 For example:

**Rule 7.** Construction of a means-plus-function limitation involves two steps. First, the court must identify the claimed function. 27

**Rule 8.** The court must construe the function to include the limitations contained in the claim language, and only those claim limitations. 28

**Rule 9.** After identifying the claimed function, the court must then determine what structure, if any, disclosed in the specification corresponds to the claimed function. 29

**Rule 10.** Rule 3 must be observed, i.e., the inquiry must be taken from the perspective of a person of ordinary skill in the art. 30

**B. Patent Rules of Evidence Derived From the Rules of Claim Construction**

Normally, the Rules of Claim Construction are invoked during pre-trial claim construction proceedings. However, they apply

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23. *Id.* at 1323.
24. *Id.* at 1323-24.
25. *Id.* at 1324. The court examines the specification and prosecution history for any such express or implied specialized definition. *Id.* at 1320. If no specialized definition is found, the court will adopt a definition that it determines would be given by a person of ordinary skill in the art. *Id.* at 1313. In arriving at a definition, the court may consult a technical art-specific dictionary or invite the parties to present testimony of experts in the field on the customary definition of the technical word. *Id.* at 1317. The court recognizes that it is able to consider a number of sources in any sequence it desires so long as it does not use these sources to contradict the meaning of a claim, which is unambiguous in light of the intrinsic evidence. *Id.* at 1324.
29. *Id.*
throughout the litigation when the meaning of claim language is at issue. During these latter stages of litigation, the Rules of Claim Construction become specialized rules of evidence; that is, the resulting construction becomes the law of the case. Thus, the court's construction must be applied any time a decision on the merits of a claim or defense is being considered. For example, when deciding a motion for summary judgment of infringement or non-infringement, the accused product must be assessed in relationship to the claims as construed by the court.31

Some district judges modify claim definitions during trial.32 To the extent claim construction might occur during trial,33 the Rules of Claim Construction control what evidence may be received during trial. The operation of the Rules of Claim Construction as rules of evidence can be seen in CytoLogix Corp. v. Ventana Medical Systems, Inc.34 In CytoLogix, the plaintiff alleged that the defendant infringed two patents in which it had been assigned rights.35 The patents claimed a slide stainer used to facilitate microscopic examination of tissue samples.36 The parties agreed, against the wishes of the district court, not to have a Markman hearing.37 Rather, the district court construed disputed claim terms at the close of trial and provided them to the jury in glossary format before closing arguments.38 The court did not explain its reasons for reaching these constructions.39 The parties also presented, by agreement, expert witnesses who argued conflicting claim constructions to the jury.40 The Federal Circuit held, inter alia, that:

This was improper, and the district court should have refused to allow such testimony despite the agreement of the parties. The risk

31. Although this article will focus on the trial, the Rules of Evidence also apply to pretrial proceedings such as motions for summary judgment. Therefore, citation will be made to cases discussing evidentiary issues arising on motions for summary judgment or in post-judgment motions.


33. As stated by the Federal Circuit, "[d]istrict courts may engage in a rolling claim construction, in which the court revisits and alters its interpretation of the claim terms as its understanding of the technology evolves." Id.


35. Id. at 1170.

36. Id.

37. Id. at 1172.

38. Id. at 1170.

39. Id.

40. Id. at 1172.
of confusing the jury is high when experts opine on claim construction before the jury even when, as here, the district court makes it clear to the jury that the district court's claim constructions control.\footnote{Id.}

Table 1 illustrates how the holding in \textit{CytoLogix} could be distilled and expressed as a Rule of Evidence for Patent Cases. For the sake of comparison, the proposed patent rule is displayed with a closely analogous provision of the FRE.

\textit{Table 1. FRE 104(a) and Rule of Evidence for Patent Cases 104-1}

<table>
<thead>
<tr>
<th>Preliminary Questions</th>
<th>Effect of Claim Construction Order</th>
</tr>
</thead>
<tbody>
<tr>
<td>Preliminary questions concerning the qualification of a person to be a witness, the existence of a privilege, or the admissibility of evidence shall be determined by the court, subject to the provisions of subdivision (b).\footnote{FED. R. EVID. 104(a).}</td>
<td>The meaning of words and phrases of the claims of a patent shall be determined by the court, subject to the United States Patent Law. Any evidence that conflicts with the court's claim construction order is inadmissible.\footnote{Since the \textit{CytoLogix} decision was issued, district courts have cited it for the proposition that a party may not present expert evidence at trial contradicting the court's claim construction. \textit{See, e.g.}, Informatica Corp. v. Bus. Objects Data Integration, Inc., No. C 02-03378 EDL (N.D. Cal. Mar. 21, 2007).}</td>
</tr>
</tbody>
</table>

\section*{III. AREAS FOR ARTICULATION OF PATENT RULES OF EVIDENCE}

As \textit{CytoLogix} illustrates, the Federal Circuit has articulated specialized rules of evidence, not denominated as such, for patent cases.\footnote{See generally \textit{CytoLogix} Corp. v. Ventana Med. Sys., Inc., 424 F.3d 1168 (Fed. Cir. 2005).} Unlike the Rules of Claim Construction, however, these patent rules of evidence have not been as carefully articulated, itemized and categorized. This section discusses cases that articulate specialized patent rules of evidence and suggests language for a formal articulation of Patent Rules of Evidence.
A. Expert Opinion Testimony

Two lines of cases have articulated rules of evidence for expert opinion testimony in patent cases. One set of cases focuses on the disclosure and qualification of experts; another set focuses on expert testimony on the ultimate issue.

1. Disclosure and Qualification

Federal Rules of Evidence 701-706 govern opinion testimony by experts and lay witnesses. Experts in scientific and other technical fields, commonly referred to as expert witnesses, play important roles in all aspects of patent litigation. Despite the complex technology involved in many patent cases, the Federal Circuit has not articulated a per se rule that expert opinion testimony is required; rather, its view is that expert testimony is "typically" necessary in patent cases involving complex technology. Expert witnesses are commonly allowed to express opinions on such matters as a reasonable royalty rate for an infringed patent. On some issues, the absence of relevant expert testimony might be regarded as a failure of proof.

Unique to patent trials is the requirement that evidence concerning certain factual determinations must be made from the perspective of a person of ordinary skill in the art. For example, patent infringement under the doctrine of equivalents is an issue of

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45. See Fed. R. Evid. 701-706.

46. As a matter of semantics, the term "expert witness" suggests that the witness is an expert at being a witness. The phrase should more appropriately be stated as "an expert expressing an opinion."

47. Patent cases are like many other areas of law, where courts have held that the matter is sufficiently beyond the comprehension of laypersons that relevant opinion testimony by experts is essential. See, e.g., Wills v. Amerada Hess Corp., 379 F.3d 32, 36-37 (2d Cir. 2004) (holding that expert opinion testimony on the cause of death was necessary in a case where the estate of the deceased claimed long-term exposure to toxic chemicals).


50. See generally Centricut, 390 F.3d 1361.

51. For example, the defendant must prove obviousness from the standpoint of other skilled persons working in the same field at the time of the invention. Envirotech Corp. v. Al George, Inc., 730 F.2d 753, 762 (Fed. Cir. 1984).
fact ordinarily presented to the jury. Further, the defendant must prove obviousness from the standpoint of other skilled persons working in the same field, while looking at the same problem at the time of the invention. Parties may present opinion testimony with respect to the viewpoint of a person of ordinary skill in the relevant art. Any such opinion testimony must be from a witness who is duly disclosed and qualified under Daubert. Table 2 suggests a formal articulation of this principle as a rule of evidence.

Table 2. FRE 702 and Exemplary Patent Rule of Evidence 702-1

<table>
<thead>
<tr>
<th>FRE 702</th>
<th>Exemplary Patent Rule of Evidence 702-1</th>
</tr>
</thead>
<tbody>
<tr>
<td>Testimony by Experts</td>
<td>Necessity of Disclosure and Qualification to Testify as Person of Ordinary Skill in the Relevant Art</td>
</tr>
</tbody>
</table>

If scientific, technical, or other specialized knowledge will assist the trier of fact to understand the evidence or to determine a fact in issue, a witness qualified as an expert by knowledge, skill, experience, training, or education, may testify thereto in the form of an opinion or otherwise, if (1) the testimony is based upon sufficient facts or data, (2) the testimony is the product of reliable principles and methods, and (3) the witness has applied the principles and methods reliably to the facts of the case.

If a party intends to offer opinion testimony from a witness as a person of ordinary skill in the art, the person must be disclosed as an expert under FRCP 26 and recognized as an expert pursuant to FRE 702.

53. 35 U.S.C. § 103(a); Envirotech Corp., 730 F.2d at 762.
57. See Fed. R. Civ. P. 26(a)(2); McGinley, 262 F.3d at 1357.
2. Opinion Testimony on the Ultimate Issue

Courts consider whether to allow an expert to state an opinion on the ultimate issue in many types of cases. In patent cases, the courts must consider whether to allow an expert to express an opinion that an accused device does or does not infringe the patent claim at issue. This issue is informed by FRE 704(a), which explicitly provides that "testimony in the form of an opinion or inference otherwise admissible is not objectionable because it embraces an ultimate issue to be decided by the trier of fact."\(^{58}\) However, Title 35 also affects the admissibility of such an infringement opinion, because it must be based on the claim interpretation issued by the district judge.\(^{59}\) Since FRE 704(a) allows an expert to state an opinion on the features of the accused product,\(^{60}\) it can be difficult to detect whether the expert’s testimony violates the restrictions of Title 35 or of \textit{Markman}. That is, experts are often allowed to explain why they believe features of the accused product do or do not practice the invention.\(^{61}\) Inherent in an expert’s explanation is an interpretation of the meaning of the patent claim. The line between permissible explanation and impermissible interpretation of the meaning of the claim can be difficult to draw.\(^{62}\)

Infringement is a mixed question of law and fact\(^{63}\) and \textit{Daubert} shifts the obligation of ensuring that the witness is qualified to express an opinion on infringement to the trial judge.\(^{64}\) A legitimate question exists with respect to what factual issue in an infringement analysis calls for "scientific knowledge."\(^{65}\) If the district judge allows the expert to express an opinion on infringement, FRE 705\(^{66}\) assigns

\(^{58}\) FED. R. EVID. 704(a).


\(^{60}\) See FED. R. EVID. 702; Snellman v. Ricoh Co., 862 F.2d 283, 287-88 (Fed. Cir. 1988) (discussing the admissibility of expert testimony explaining claims).

\(^{61}\) See, e.g., Amstar Corp. v. Envirotech Corp., 823 F.2d 1538, 1548 (Fed. Cir. 1987) ("The expert concluded that the redesigned unit was equivalent to the infringing units, and that their operation would, therefore, infringe the claims of the [] patent.").

\(^{62}\) See Snellman, 862 F.2d at 287-88.

\(^{63}\) See Tucker v. Spalding, 80 U.S. 453, 455 (1871).


\(^{65}\) Under \textit{Daubert}, when faced with expert opinion testimony, the district judge must assess the reasoning and methodology underlying the proposed testimony to determine whether it is scientifically valid using four factors: (1) whether the methodology can and has been tested; (2) whether the methodology is subject to peer review; (3) the potential rate of error; and (4) the general acceptance of the methodology. \textit{Daubert}, 509 U.S. at 593-94.

\(^{66}\) FED. R. EVID. 705.
to the cross-examiner the burden of eliciting the basis for the opinion, including any weakness in the analysis.

Finally, the Federal Rules of Civil Procedure can also affect the admissibility of expert testimony. For example, expert opinion may be ruled inadmissible if there has been insufficient disclosure or supplementation of disclosure.

This brief discussion highlights the benefit to be gained from a thorough articulation of the evidentiary rules with respect to expert witnesses in patent cases. An example of a Patent Rule of Evidence for expert opinion testimony on the ultimate issue of infringement is set forth in Table 3. In addition, another expert testimony issue in patent cases that would benefit from a specific rule of evidence is one that delineates whether a witness must be qualified as an expert in order to testify about comparisons between the patented invention and prior art references.

Table 3. FRE 704(a) and Exemplary Patent Rule of Evidence 704-1

<table>
<thead>
<tr>
<th>Rule 704(a)</th>
<th>Exemplary Patent Rule of Evidence 704-1</th>
</tr>
</thead>
<tbody>
<tr>
<td>Opinion on Ultimate Issue</td>
<td>Opinion on Ultimate Issue of Infringement</td>
</tr>
<tr>
<td>[T]estimony in the form of an opinion or inference otherwise admissible is not objectionable because it embraces an ultimate issue to be decided by the trier of fact.</td>
<td>A witness recognized by the court as competent to do so may express an opinion on the ultimate issues of infringement or non-infringement or any other matter to be decided by the trier of fact.</td>
</tr>
</tbody>
</table>

B. Witnesses

Patent trials are not characterized by large numbers of witnesses. Most evidentiary issues raised during patent trials concern the testimony of a small number of witnesses. FRE 601-615 cover the

69. The attorney who prosecutes a patent can explain why prior art references alone or in combination with each other do not satisfy a means-plus-function element of a claim. McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1353 (Fed. Cir. 2001). In McGinley, the vice president of marketing of the defendant corporation was found competent to testify about any differences between an asserted invalidating reference and the asserted claims. Id.
70. Fed. R. Evid. 704(a).
subject matter of witnesses. These provisions cover such areas as competency, impeachment, mode of examination, use of writings and prior statements.

1. Competency

The courts often consider the competence of a witness to testify about a broad range of subjects. Generally, this is a matter that can be decided under the established FRE.

In most patent jury trials, one or more parties will request the court to permit a witness to testify about the patent prosecution process. Given the importance of the issuance of the patent, parties claiming patent infringement may use this testimony to highlight the rigorous scrutiny given to a patent application. On the other hand, parties claiming non-infringement or invalidity may use the testimony to highlight the many opportunities for error during the prosecution process.

Some courts use a jury instruction, rather than witness testimony, to describe patent prosecution. To aid jurors in understanding patent

FED. R. EVID. 601-615.
FED. R. EVID. 601.
FED. R. EVID. 607.
FED. R. EVID. 611.
FED. R. EVID. 612.
prosecution, the Federal Judicial Center has produced a video for jurors to view at the commencement of a patent infringement trial.\textsuperscript{78}

Another alternative would be to allow the attorney who actually prosecuted the patent-in-suit to testify about its prosecution, thus educating the jury about the process. This allows litigants to be involved in explaining the patent prosecution process to the jury and potentially satisfies the court’s interest in a fair and accurate presentation of the process. Testimony by the prosecuting attorney would educate the jury about the specifics of the process (such as rejections and amendments), as applied to the patent-in-suit as opposed to a general description. During cross-examination, opposing counsel could highlight rejections and limitations of the patent. Table 4 illustrates how a Rule of Evidence for Patent Cases would recognize the competence of a witness to testify about the patent prosecution process.

Another area that would benefit from a clearer articulation of the evidentiary rules is whether an inventor’s testimony should be limited. Patent practitioners will often object to inventor testimony as “self-serving.” There are presently no recognized grounds for refusal to admit evidence on that basis. If a “self-serving” objection is an objection to the probative value of the inventor’s testimony, the proper objection is relevance.\textsuperscript{79}

\section{2. Impeachment}

FRE 607 provides that any party, including the party calling a witness, can attack a witness’ credibility.\textsuperscript{80} A witness’ past business relationship with a party may be received in evidence as probative of the witness’ credibility.\textsuperscript{81} In a patent case, the credibility of the testimony of a witness that the patent disclosure was sufficient to enable one skilled in the art to make the invention may be attacked by evidence that the witness had a past business relationship with the inventor.\textsuperscript{82} In addition, the patent laws impose a duty of candor on the part of an applicant.\textsuperscript{83} Failure to adhere to that duty may be regarded

\begin{thebibliography}{83}
\bibitem{79}See \textit{Fed. R. Evid.} 401, 402.
\bibitem{80}\textit{Fed. R. Evid.} 607.
\bibitem{81}U.S. v. Robinson, 530 F.2d 1076, 1079-80 (D.C. Cir. 1976).
\bibitem{83}Molins PLC v. Textron, Inc., 48 F.3d 1172, 1178 (Fed. Cir. 1995).
\end{thebibliography}
as inequitable conduct and result in the invalidation of a patent.\footnote{Id.} With respect to witnesses, if a patent examiner requests disinterested third-party declarations, an applicant is guilty of inequitable conduct if the applicant knowingly submits responsive declarations without disclosing that the declarant owns stock in the applicant’s company.\footnote{Paragon Podiatry Lab., Inc. v. KLM Labs., Inc., 984 F.2d 1182, 1191 (Fed. Cir. 1993).}

\begin{table}
\centering
\caption{FRE 601-602 and Exemplary Patent Rule of Evidence 601-1}
\begin{tabular}{|l|l|l|}
\hline
\textbf{FRE 601} & \textbf{FRE 602} & \textbf{Exemplary Patent Rule of Evidence 601-1} \\
\hline
\textbf{General Rule of Competency} & \textbf{Lack of Personal Knowledge} & \textbf{Competency of Prosecuting Attorney on Prosecution History} \\
\hline
Every person is competent to be a witness except as otherwise provided in these rules. However, in civil actions and proceedings, with respect to an element of a claim or defense as to which State law supplies the rule of decision, the competency of a witness shall be determined in accordance with State law.\footnote{FED. R. EVID. 601.} & A witness may not testify to a matter unless evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter. Evidence to prove personal knowledge may, but need not, consist of the witness’ own testimony. This rule is subject to the provisions of rule 703, relating to opinion testimony by expert witnesses.\footnote{FED. R. EVID. 602.} & An individual who participated in a patent’s prosecution is competent to testify about the prosecution history, including what prior art references were considered by the PTO during the application’s pendency and the applicant’s position with respect to why the invention was patentable over a prior art reference.\footnote{McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1352 (Fed. Cir. 2001).} \\
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C. Tangible Objects as Evidence in Patent Cases

One factor that makes patent litigation difficult is, of course, the invention itself. Patents are issued for inventions that are novel, useful and non-obvious. Such inventions may be complex—a complexity which is often shared with the accused device. Moreover, the language used in patent documents is complex for both judges and jurors. Therefore, skilled patent practitioners simplify the presentation of their cases using both tangible and demonstrative exhibits. 89

1. The Benefit of Offering Tangible Objects Into Evidence

The trial process is a human learning process. 90 Human beings learn through their sensory systems. Individuals differ in their sensitivities to the five basic sensory modalities: sight, sound, touch, taste, and smell. There are individuals who “can never forget a face,” or those who can detect the hint of a fragrance that is unnoticeable to others.

At the same time, social scientists have concluded that as information processors in formal learning environments, human beings share certain attributes of responsiveness to “change” in their sensory systems. 91 Change is a critical concept in learning, because change to the things perceived in the sensory world helps to recapture attention essential for learning in a pedagogic situation. 92 Social scientists have concluded that humans have the greatest responsiveness to and acuity for detecting change in visual stimuli. 93 For example, when people are instructed through the auditory modality alone, and recall is subsequently tested, they recall about 10 percent of what they heard, in contrast to recalling 85 percent of information presented orally with visual aids. 94

Given these findings, trial lawyers who spend the majority of courtroom time instructing fact-finders orally, such as witness

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91. HENRY GLEITMAN, BASIC PSYCHOLOGY 126 (W.W. Norton & Co. 1983) (“[S]ensory systems respond to change over time. . . . [T]he key word is change.”) (emphasis in original).

92. Id.


94. VINSON, supra note 93, at 40-41.
testimony or lengthy opening and closing statements, and who use visual aids sparingly, are depriving themselves and the fact-finders of an important tool for understanding the material being presented. By using effective demonstrative exhibits in the courtroom, lawyers can better capture fact-finders' attention, elevate comprehension of the subject matter, and increase the likelihood that the information will be recalled at a subsequent point in time, particularly during jury deliberations.  

2. Tangible Objects as Real Evidence in Patent Litigation

In many respects, the rules of evidence that control the use of tangible exhibits for patent cases are the same as for any complex civil case. However, judicial decisions interpreting substantive patent law are properly viewed as special rules of evidence governing the admission of tangible products in patent cases. Although not formally recognized by the FRE, evidence can be grouped under four types: real, demonstrative, documentary, and testimonial.

Real evidence is an object, the existence or characteristics of which are relevant and material because it was involved in the events that gave rise to the case. To be admissible, real evidence must be authenticated. In contrast, demonstrative evidence is not necessarily admissible in evidence; it is in aid of testimonial evidence.

At the center of a patent infringement case is the accused product, which is real (as opposed to demonstrative) evidence. Normally, authentication of the accused product is not an issue, because the parties usually authenticate the product during the pre-trial discovery process. A proposed rule of evidence that recognizes the admissibility of the accused product as real evidence is shown in Table 5.

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96. See FED. R. EVID. 901.
97. Demonstrative evidence may be excluded for the reasons stated in FED. R. EVID. 403.
Table 5. FRE 901 and Proposed Patent Rule of Evidence 901-1

<table>
<thead>
<tr>
<th>FRE 901</th>
<th>Proposed Patent Rule of Evidence 901-1</th>
</tr>
</thead>
<tbody>
<tr>
<td>Requirement of Authentication or Identification</td>
<td>The Accused Product</td>
</tr>
</tbody>
</table>

The requirement of authentication or identification as a condition precedent to admissibility is satisfied by evidence sufficient to support a finding that the matter in question is what its proponent claims.\(^\text{98}\)

An accused product or description of an accused process may be received in evidence if offered to prove or disprove infringement, upon a showing that it is (1) a product made, sold, or used; or (2) a process performed before the complaint (or a properly allowed amendment to the complaint) was filed.\(^\text{99}\)

3. Limitations on Commercial Embodiments

If the accused product is received in evidence, human nature might cause jurors to wish to compare the accused product to an embodiment of the patented invention — to compare "apples to apples," so to speak. However, the substantive patent law prohibits receiving an embodiment of the invention in evidence for that purpose; the asserted claims must be compared with the accused products or processes.\(^\text{100}\) It is improper to compare a commercial embodiment of the invention with the accused product to decide infringement, either literally or under the doctrine of equivalents.\(^\text{101}\)

The cases articulate good policy reasons for disallowing a product-to-product comparison to prove infringement. On the one hand, the patent claim is not necessarily limited to an embodiment of the claim.\(^\text{102}\) Thus, to admit a commercial embodiment risks an improper restriction on the scope of the patent. On the other hand, a

\(^{98}\) Fed. R. Evid. 901.


\(^{100}\) Johnson & Johnson Assocs., Inc. v. R.E. Serv. Co., 285 F.3d 1046, 1052 (Fed. Cir. 2002).

\(^{101}\) Id.

\(^{102}\) When there is no significant difference between a drawing in a design patent claim and the embodiment, it is not necessarily error to admit the embodiment into evidence and allow the fact-finder to compare the embodiment with the accused product. Lee v. Dayton-Hudson Corp., 838 F.2d 1186, 1189 (Fed. Cir. 1988).
commercial embodiment may contain features beyond those in the patent claim, such as color, size and material. If the same or similar features are present in the accused product, admitting the commercial embodiment in evidence risks allowing a broader claim than that to which the inventor is entitled as measured by the claim.

4. Circumstances Allowing Admission of a Commercial Embodiment

The patent law recognizes circumstances under which admission of a commercial embodiment of the invention would be proper. For example, an embodiment of the invention is admissible to prove or disprove loss of the patent right under the on-sale bar rule.

Under 35 U.S.C. § 102(b), an applicant loses a right to a patent if the invention was "in public use or on sale in this country, more than one year prior to" the application. Thus, inventors may lose their patent right if they fail to take certain steps to perfect a right to the invention in a timely matter. To invoke the on-sale bar defense, a defendant must prove that an embodiment of the complete claimed invention was sold or offered for sale before the critical date. If the defendant establishes this, the on-sale bar invalidates the patent. A tangible embodiment of what was sold is real evidence probative of the applicability of the on-sale bar.

Another example of a circumstance under which a tangible embodiment of the invention is admissible is to prove non-obviousness. Under substantive patent law, a patent is invalid for obviousness if "differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains." Obviousness is a question of law based on underlying factual inquiries including: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences

104. Id.
106. Id.
108. Id. at 861.
110. It is interesting to note that the meaning and scope of a prior art patent is regarded as a question of fact and therefore is a matter left for determination by the jury, while the scope of the patent claim is a question of law to be determined by the trial judge. In re Beattie, 974 F.2d
between the prior art and the claimed invention;\textsuperscript{112} and (4) the extent of any objective indicia of non-obviousness.\textsuperscript{113} In resolving the factual dispute, an embodiment of the invention is admissible to prove that the claimed invention has achieved commercial success.\textsuperscript{114} Indeed, this evidence has been characterized as objective indicia of non-obviousness and is often regarded as more probative than evidence with respect to prior art references.\textsuperscript{115}

Itemized and particularized rules of evidence with respect to the limited admissibility of tangible embodiments of the invention, such as those presented in Table 6, could be beneficial in articulating when a commercial embodiment is admissible. Having such a rule would require anticipation of the potential problem of requiring the jury to compartmentalize its consideration of the evidence – considering the embodiment when deciding the applicability of the on-sale bar or for non-obviousness but ignoring the embodiment when deciding infringement. The rule would require the court to give a limiting instruction.

Table 6. FRE 105 and Proposed Patent Rule of Evidence 105-1

\begin{tabular}{|c|c|}
\hline
FRE 105 & Patent Evidence Rule 105-1 \\
\hline
Limited Admissibility & Limited Admissibility of Commercial Embodiment of Patent \\
\hline
When evidence that is admissible as to one party or for one purpose but not admissible as to another party or for another purpose is admitted, the court, upon request, shall restrict the evidence to its proper scope and instruct the jury accordingly.\textsuperscript{116} & A commercial embodiment of the claimed invention may be received in evidence to prove nonobviousness. The Court must give an appropriate limiting instruction with respect to the limited purpose of admission. \\
\hline
\end{tabular}

\textsuperscript{110}9, 1311 (Fed. Cir. 1992). As a question of fact, expert witness testimony may be offered to prove the meaning of a prior art patent.

\textsuperscript{111} Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH, 139 F.3d 877, 881 (Fed. Cir. 1998).

\textsuperscript{112} Id.

\textsuperscript{113} Id.


\textsuperscript{115} Id. at 660, 663-64.

\textsuperscript{116} FED. R. EVID. 105.
IV. CONCLUSION

The Federal Rules of Evidence apply to patent litigation. However, greater control over admissibility is exerted by judicial decisions construing the substantive patent law. This article has given a few examples of specialized rules of evidence for patent cases that may be derived from the case law and discussed the benefits to be gained from a formal enumeration of those rules as Patent Rules of Evidence. A thorough treatment of this subject would yield numerous other examples of specialized rules of evidence that apply in patent cases.\textsuperscript{117}

One impediment to the utility of articulating a definitive set of Patent Rules of Evidence is the fact that unlike claim construction, which is the subject of de novo review, the Federal Circuit reviews the district court's decisions on the admission of evidence under a more deferential standard. A district court's decision to admit some evidence is reviewed for abuse of discretion or clear error.\textsuperscript{118} These different standards might produce results that are not as susceptible to definitive rules. In addition, while substantive analysis of a patent is conducted under Title 35 and the law of the Federal Circuit, the district courts are bound to follow the law of their respective regional circuits with respect to evidentiary matters.\textsuperscript{119} In other words, when reviewing the case on the merits, the Federal Circuit is bound to review evidentiary rulings under regional circuit law. Thus, Patent Rules of Evidence might vary in one regional circuit from another. On the other hand, in most cases there is such a close nexus between the substantive patent law and the evidentiary issue that it can be difficult

\textsuperscript{117} For example, there are special exclusionary rules applicable to patent cases. Whether a prior art reference is enabling is a question of law based upon underlying factual findings. Impax Labs., Inc. v. Aventis Pharms., Inc., 468 F.3d 1366, 1382 (Fed. Cir. 2006). When an accused infringer asserts that either claimed or unclaimed material in a prior art patent anticipates patent claims asserted against it, the infringer is entitled to a presumption that the allegedly anticipating material is enabled. \textit{Id.} However, if a patentee presents evidence of non-enablement that a court finds persuasive, the trial court must then exclude the particular prior art patent in any anticipation inquiry, for then the presumption has been overcome. \textit{Id.}

\textsuperscript{118} \textit{See} Conservolite Inc. v. Widmayer, 21 F.3d 1098, 1103 (Fed. Cir. 1994).

\textsuperscript{119} Advanced Cardiovascular Sys., Inc. v. Medtronic, Inc., 265 F.3d 1294, 1308 (Fed. Cir. 2001). Although the rule announced in \textit{Medtronic} seems to carry with it the potential for much conflict between the circuits, this does not appear to have occurred in practice. Federal Circuit cases considering district court evidentiary rulings primarily cite to circuit law to establish the appropriate standard of review, but then go on to apply Federal Circuit law in addressing the narrower question of admissibility. \textit{See}, e.g., Cook Biotech, Inc. v. Acell, Inc., 460 F.3d 1365 (Fed. Cir. 2006); Liquid Dynamics Corp. v. Vaughan Co., 449 F.3d 1209 (Fed. Cir. 2006); Sulzer Textil A.G. v. Picanoil N.V., 358 F.3d 1356 (Fed. Cir. 2004). \textit{See also} Chiron Corp. v. Genentech, Inc., 363 F.3d 1247 (Fed. Cir. 2004) (finding the choice of law ambiguous).
for a district court to clearly identify a line of demarcation between regional circuit evidentiary law and an evidentiary ruling mandated by Federal Circuit law. The influence of the substantive patent law is so strong that any difference in the standard of review or regional difference in how the FRE might be interpreted is overshadowed by Federal Circuit law. Or, as it would be expressed in language similar to FRE 403, any prejudice from differences regionally would be far outweighed by the benefit to be gained nationally from a clear articulation of Patent Rules of Evidence.