Is Plausible Enough After Brand v. Miller?[1]

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INTRODUCTION

It is, of course, a bedrock principle of law generally (not just interference law and not just patent law) that the party that has the burdens of proof and persuasion loses if it doesn't carry its burdens. Moreover, it is an equally bedrock principle that it doesn't take much more than one's opponent puts in to carry that burden if the weight of the burden of proof is merely the preponderance of the evidence.[4] But how do these two principles play out in the context of a patent interference after Brand v. Miller, 487 F.3d 862, 82 USPQ2d 1705 (Fed. Cir. 2007), discussed in Nissen and Gholz, Brand v. Miller Prevents Administrative Patent Judges From Using Their Common Sense in Inter Partes Proceedings, 90 JPTOS 321 (2008)?

WHAT THE BPAI HELD IN *STATE OF OREGON V. SLOAN-KETTERING INSTITUTE*

State of Oregon v. Sloan-Kettering Institute, Int. No. 105,537[5] was a chemical interference in which the only issue that the panel found it necessary to decide was whether the junior party (which really, despite the opinion's name, was Oregon State University, hereinafter referred to as "OSU") was entitled to the benefit of the filing date of an earlier application. That turned on the adequacy of the disclosure in the earlier application--and, specifically, whether it contained a teaching of how to make a specific chemical compound as of the filing date of that application.

Each party submitted the testimony of an expert witness--which, in each case, was a distinguished university professor. The panel (opinion by SAPJ McKelvey) found that each expert witness was "qualified as an expert in the field of synthetic organic chemistry."[6]

Not surprisingly, OSU's expert testified that, as of the filing date of OSU's priority application, persons of ordinary skill in the field of synthetic organic chemistry could have made the compound in question employing any one of three techniques described in general terms in OSU's priority application, whereas Sloan-Kettering's expert cast doubt as to whether persons of ordinary skill in the field of synthetic organic chemistry as of that date could have made that compound employing any of those techniques. However, Sloan-Kettering's expert did not actually testify that, in his opinion, such a person couldn't have done that. Each expert supported his opinion with lengthy and detailed testimony.[7]

What makes this opinion interesting is (1) that the panel found each expert's testimony "facially plausible"[8] and (2) that the panel did not indicate which expert's testimony it found more persuasive. Specifically, the panel found (1) that the testimony of OSU's expert was "just as plausible as the contrary testimony of… [Sloan-Kettering's expert]"[9] and (2) that it "f[ound] the respective positions of the witnesses to be equally plausible."[10]

SAPJ McKelvey began his discussion as follows:

> The ultimate burden of persuasion in a case where a party is under a burden to establish a fact by a preponderance of the evidence is only critical in a situation where the evidence is so evenly balanced that no preponderance emerges. In that event, the party having the burden of persuasion necessarily loses. *Yamaha Int'l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1580 n.11 (Fed. Cir. 1988). *See also Smith v. United States*, 557 F. Supp. 42, 51 (W.D. Ark. 1982) ("Preponderance of the evidence" means the greater weight of evidence. It is the evidence which, when weighed with that opposed to it, has more convincing force and is more probably true and accurate. If, upon any issue in the case, the evidence appears to be equally balanced, or if it cannot be said upon which side it weighs heavier, then plaintiff has not met his or her burden of proof).[11]

Then, having found that the testimony of the two experts was "equally plausible,"[12] the panel held that the junior part had failed to carry its burden of proof and, accordingly, entered judgment for the senior party.

However, what makes this opinion fascinating is the following dicta:

> For what it may be worth, we suggest that[,] in an unpredictable art, a "battle of experts" with no real data to support the conflicting opinions of experts runs the risk of an outcome which occurs in this case.[13]

COMMENTS

Why didn't the panel find that the testimony of one of the two experts was more persuasive that the testimony of the other? 35 USC 6 provides that "The administrative patent judges shall be persons of competent legal knowledge and scientific ability…." [Emphasis supplied.] Moreover, the three APJs on this panel (McKelvey, Torczon, and Tierney) are not known to be diffident.

Although SAPJ McKelvey did not cite Brand v. Miller, we suspect that it may have influenced the outcome of this case. In Brand, the BPAI was harshly chastised for "bas[ing] its factual findings on its expertise, rather than on evidence in the record."[14] In the article cited at the outset of this article, the authors argued that what the Federal Circuit mandated in Brand for APJs, who are Article I judges, was contrary to what the Supreme Court mandated in KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 82 USPQ2d 1385 (2007), for Article III judges. Prior to Brand, the APJs on this panel might well have applied their own very considerable expertise (and experience as judges) to deciding which expert's testimony they found more persuasive. After Brand, however, they simply called it a tie--and ties go to the party not having the burdens of proof and persuasion.

So, when does the "rule" of State of Oregon v. Sloan-Kettering Institute apply? If all that is required for that rule to apply is that both parties' positions are "plausible," does that mean that the rule applies unless one party's position is frivolous? If "plausible" on both sides is enough to create a tie, and if the parties' respective positions are not further evaluated on the merits,

then the authors foresee that more cases may result in "ties" in the future. However, in our opinion, "plausible" should not be enough. Rather, cases should be decided by evaluating the relative strength of the parties' evidence -- even if that evidence consists entirely of reasoning from basic principles, as opposed to laboratory evidence. As in baseball (where the rule is that ties go to the runner, but very few ties are found), the authors believe that actual ties are rare occurrences in contested cases. Accordingly, decisions about who wins and loses should rarely be based on a finding of a tie.

ENDNOTES

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4. See, e.g., Concrete Pipe & Products of California, Inc. v. Construction Laborers Pension Trust for Southern California, 508 U.S. 602, 622 (1993), cited by the BPAI in the opinion under discussion.
5. The authors of this article represented the State of Oregon.
6. Slip opinion at page 12 as to Sloan-Kettering's expert. Slip opinion at page 14 as to OSU's expert.
7. See generally, Gholz, Must an Expert Witness's Opinion Be "Supported by Cited Literature"?, 11 Intellectual Property Today No. 8 at page 12 (2004).
8. Slip opinion at page 15 as to OSU's expert. Slip opinion at page 15 as to Sloan-Kettering's expert.
9. Slip opinion at page 15
10. Slip opinion at page 16.
11. Slip opinion at pages 16-17.
12. Slip opinion at page 16.
13. Slip opinion at page 19.
14. Brand, 487 F.3d at 869, 82 USPQ2d at 1710.