BRIEF FOR AMICUS CURIAE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF REVIEWING PATENT AND TRADEMARK OFFICE FACT-FINDING UNDER THE CLEARLY ERRONEOUS STANDARD OF REVIEW

United States Court of Appeals

for the

Federal Circuit

Appeal No. 96-1258

(Serial No. 07/479,666)

IN RE MARY E. ZURKO, THOMAS A. CASEY, JR., MORRIE GASSER, JUDITH S. HALL, CLIFFORD E. KAHN, ANDREW H. MASON, PAUL D. SAWYER, LESLIE R. KENDALL, and STEVEN B. LIPNER

APPEAL FROM A DECISION OF THE BOARD OF PATENT APPEALS AND INTERFERENCES DATED JULY 31, 1995

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October 30, 1997

CERTIFICATE OF INTEREST

Counsel for the amicus curiae New York Intellectual Property Law Association certifies the following:

1. The full name of every party or amicus represented by me is: New York Intellectual Property Law Association.

2. The party represented by me as amicus curiae is the real party in interest.

3. The parent companies, subsidiaries (except wholly owned subsidiaries), and affiliates that have issued shares to the public, of the party or amicus represented by me are: None.

4. The names of all law firms and the partners or associates that appeared for the parties now represented by me in the trial court or agency or are expected to appear in this court are:

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STATEMENT OF INTEREST OF AMICUS CURIAE

The New York Intellectual Property Law Association ("NYIPLA") is an association of more than 1,100 attorneys whose interest and practice lies in the areas of patent, copyright, trademark, trade secret and other intellectual property law. Unlike attorneys in many other areas of practice, NYIPLA members, whether in private practice or employed by corporations, typically represent both plaintiffs and defendants in litigation. NYIPLA attorneys also regularly participate in proceedings in the Patent and Trademark Office, including representing parties in interferences, as well as representing applicants for patents.

Since its founding in 1922, the NYIPLA has been committed to maintaining the integrity of United States patent law, and to the proper interpretation and application of that law. Because of the practical experience of its members, and its non-partisan status, the NYIPLA believes that its views will aid this Court in its resolution of the issue raised in this in banc appeal concerning the standard of review applicable to United States Patent and Trademark Office ("PTO") fact-finding.

SUMMARY OF THE ARGUMENT

This Court should continue to review PTO fact-finding under the "clear error" standard of review. For nearly 70 years, the PTO has received searching and thorough judicial review of its fact-finding by this Court and by its predecessor under the clearly erroneous standard (also called manifest error). The plain language of the Administrative Procedure Act ("APA") permits the Federal Circuit to continue this practice. Specifically, 5 U.S.C. §provides that § 706 of the APA shall not limit additional requirements recognized by law before the enactment of the APA. The clear error standard of review was such an additional requirement over and above the minimum

standards of review subsequently set forth in 5 U.S.C. § 706. This Court should not adopt the more deferential "substantial evidence" standard now requested by the PTO, which would increase the likelihood that errors of the PTO remain uncorrected.

An erroneous decision by the PTO that a patent should not issue, or an erroneous decision awarding priority to a person who was not in fact the first inventor, can have a devastating impact on inventors, investors, the public, and the integrity of the patent system. Inventors and the companies for whom they work typically spend tremendous sums of money and time on research and development. In addition, particularly for individual inventors, the costs involved in searching the prior art and preparing and filing a patent application can be onerous. A decision by the PTO that rejects a patent application in error can make it impossible to recoup the ventured investments through the exclusivity provided by the patent laws. The public also may suffer from an incorrect decision of the PTO. After a patent application is rejected, inventors and investors may simply give up, never commercializing the invention, or they may maintain it as a trade secret. In either case, the public also has lost the disclosure of a possibly significant advance in the useful arts that would have been contained in the issued patent. In the case of interferences, an incorrect decision by the PTO not only harms the true inventor by denying him or her the right to a patent, but also creates a higher likelihood that a court will simply hold the patent invalid when it is subject to judicial scrutiny in patent litigation.

An incorrect decision of the PTO can have broader effects than on the particular individuals and inventions involved. When the underlying facts are intimately bound up with legal standards -- such as with the issue of obviousness -- an erroneous decision can create bad precedent for many cases to come.

The appeal in the present case does not require that the Court delve into abstract questions regarding the role the PTO should have in the executive-judicial landscape, nor whether the PTO is entitled to judicial deference due to its being an administrative agency whose employees may have expertise in certain areas. By expressly providing for the judiciary to play an active, substantive role in deciding whether patents should issue, Congress has already made plain that the PTO is not entitled to exceptional deference from the judiciary. Specifically, under 35 U.S.C. §decisions of the PTO are subject to de novo review in the District Court for the District of Columbia.

/Thus, regardless of how this Court decides the question presented here for in banc review, a suit in the District Court will still be available in which the PTO will receive close judicial scrutiny. But litigation in the District Court (followed by any appeal to this Court) can be far more expensive, complicated and time consuming than a direct appeal to this Court, and many inventors would like to rely on the patent expertise and experience of this Court. Moreover, the possible application of different standards of review to the same decision of the PTO on the same record could result in different outcomes depending solely on which forum was selected.

Thus, the real issue raised by this appeal is whether this Court will relinquish critical decision-making functions to the PTO and to the District Court by ceding its own long-standing practice of thorough review of PTO fact-finding. There is no good reason, in law or policy, which overcomes nearly 70 years of this Court's precedent and warrants change by the Federal Circuit

now from its clear error standard of review. If change is appropriate, it should come from Congress.

ARGUMENT

I. THE PATENT AND TRADEMARK OFFICE, SINCE BEFORE THE APA WAS ENACTED, HAS BEEN SUBJECT TO CLEAR ERROR REVIEW BY THE JUDICIARY

Before the Administrative Procedure Act was enacted in June 1946, the Court of Customs and Patent Appeals ("CCPA") uniformly applied a "clear error" or "manifest error" standard of review to factual determinations of the Patent Office.

/ Attached as an Addendum to this brief is a list of 90 cases spanning the years 1929-1946 in which the Court of Customs and Patent Appeals reaffirmed its well-established "clear error" and "manifest error" standard of review.

The "clear error" and "manifest error" standards meant the same thing and were used interchangeably by the CCPA. For example, in In re Bertsch, 107 F.2d 828, 831 (CCPA 1939), the CCPA stated that Patent Office findings would not be disturbed unless they were "manifestly erroneous," and cited In re Hornsey, 48 F.2d 911, 912 (CCPA 1931), which in turn held that findings by the Patent Office would be reversed only when it was "clear that they are erroneous." Conversely, in Joseph & Feiss Co. v. Joseph Kanner Hat Co., 337 F.2d 1014, 1015 (CCPA 1964), the CCPA stated the PTO's findings would not be disturbed unless they were "clearly erroneous," and cited Ranney v. Bridges, 188 F.2d 588, 596 (CCPA 1951), which in turn held that factual findings by the Patent Office would be reversed only when they were "manifestly wrong." The Federal Circuit has also used the manifest and clear error standards interchangeably. See Stock Pot Restaurant, Inc. v. Stockpot, Inc., 737 F.2d 1576, 1578 (Fed. Cir. 1984) (stating that the PTO's findings in a trademark case were reviewable to determine whether they are "'clearly' or 'manifestly' wrong or erroneous").

The fact that "manifest error" and "clear error" have been used interchangeably reflects the fact that the phrases are synonymous. See Black's Law Dictionary 962 (6th ed. 1990) ("manifest" is "synonymous with open, clear, visible, unmistakable, indubitable, evident, and self-evident"); see also Concise Oxford Dictionary of Current English 829 (9th ed. 1995) (defining "manifest" as "clear or obvious to the eye or mind"); and A New Dictionary On Historical Principles 122 (1908) (defining "manifest" as "clearly revealed to the eye, mind, or judgment").

Only a handful of cases decided before enactment of the APA have been found in which the CCPA diverged from the clear/manifest error standard. Specifically, in Townsend v. Smith, 36 F.2d 292, 294 (CCPA 1929), and Kreidel v. Parker, 97 F.2d 171, 179 (CCPA 1938), the CCPA apparently exercised de novo review over the Patent Office's fact-finding. In Clancy v. De Jahn, 36 F.2d 131, 132 (CCPA 1929), and Zublin v. Pickin, 70 F.2d 732, 733 (CCPA 1934), the CCPA reviewed for "material error." And in four other cases, the CCPA reviewed the decision in a manner similar to clear error review. Jardine v. Long, 58 F.2d 836, 836 (CCPA 1932) (the court will affirm unless "fully convinced" that the Patent Office's findings are "not in accord with the weight of the evidence"); In re Christmann, 107 F.2d 607, 609 (CCPA 1939) (reversing where "it

seemed proper" to do so); Mantz v. Jackson, 140 F.2d 161, 164 (CCPA 1944) (reviewing to determine whether appellant met a "heavy burden" of showing that the Patent Office decision was "erroneous"); Rodli v. Phillipi, 154 F.2d 139, 140 (CCPA 1946) (reviewing for "'cogent evidence of mistake and miscarriage of justice'"). In these few cases, the CCPA either applied a standard of review substantively the same as the "clear error" or "manifest error" standard, or gave an even more searching review of the Patent Office's fact-finding. These few cases in no respect warrant a conclusion other than that the uniform standard of review applied by the CCPA before the APA was enacted was "manifest error" or "clear error."

In applying the clear error standard of review, the Court of Customs and Patent Appeals had expressly analogized the Patent Office Board to a district court:

The board's responsibility in this case was analogous to that of a judicial trial tribunal, and, as an appellate tribunal, we are not at liberty to reverse its findings of fact unless convinced that such findings were clearly against the weight of the evidence.

Hamer v. White, 143 F.2d 987, 990 (CCPA 1944).

This Court too has analogized the PTO Board of Appeals to a district court. Specifically, this Court recently held that the Board must set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for appellate review, stating:

In light of this court's statutory mandate to 'review' decisions from the Board, we see no reason in law or logic to apply a less demanding version of fact finding standard to the Board's decisions any more than we would apply a lesser version of the clearly erroneous review standard.

Gechter v. Davidson, 116 F.3d 1454, 1459 (Fed. Cir. 1997).

Professor Field, in his brief amicus filed August 13, 1997, argues that clear error review years ago may have meant something different from the clearly erroneous standard of today. (Brief for Amicus Curiae, Thomas G. Field, Jr., at pp. 11-12.) But the cases themselves refute this assertion. Under current standards, clear error occurs when:

although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed.

SSIH Equipment S.A. v. United States Int'l Trade Comm'n, 718 F.2d 365, 381 (Fed. Cir. 1983) (Nies, J., additional views) (quoting United States v. Gypsum Co., 333 U.S. 364, 395 (1948)). The pre-APA case law listed in the Addendum shows that the CCPA reviewed the entire evidence of record and determined whether it firmly believed that the Patent Office's findings were mistaken, just as is done today.

Any possible doubt concerning whether courts were, in fact, reviewing PTO fact-finding under the "clear error" standard as it is defined today is resolved by the Supreme Court's decision in Morgan v. Daniels, 153 U.S. 120 (1894). In that case, the Supreme Court reviewed the record of the Patent Office to determine whether it "produce[d] a clear conviction that the Patent Office

made a mistake." Morgan, 153 U.S. at 129. In Fregeau v. Mossinghoff, 776 F.2d 1034, 1038 (Fed. Cir. 1985), this Court expressly concluded that this language defined substantively the same standard of review as the "clearly erroneous" standard currently used by appellate courts. Thus, courts have been using the current "clearly erroneous" standard in reviewing PTO fact-finding for more than 100 years.

In its brief in support of the in banc hearing in this appeal, the PTO does not dispute that the CCPA had a well-established "clear error"/"manifest error" standard of review prior to enactment of the APA. (Supplemental Brief For Appellee, filed Sept. 2, 1997.) Moreover, Professor Field agrees in his amicus brief (at page 11) that the "manifest error" standard of review was "typical of most . . . pre-1944 cases found using West key 291k113(7) (Presumption as to correctness of decision below.)."

While the PTO previously argued in its Petition for Rehearing In Banc in this appeal (filed June 5, 1997) that there was no clearly established pre-APA standard, the PTO apparently has dropped this argument. Specifically, the PTO previously argued (see Petition at page 5) that:

"[T]here was no established standard of review to impliedly adopt. Prior and subsequent to the enactment of the APA in June, 1946, the CCPA was not applying any clear standard of review to Office determinations. See Donald R. Dunner et al., Court of Appeals for the Federal Circuit: Practice & Procedure § 6.04, at 6-49 to 6-52 (Matthew Bender & Co. 1995) (discussing the numerous different standards that the CCPA used)."

As shown by the case law cited above and listed in the Addendum, this earlier argument by the PTO was inaccurate. Moreover, the PTO's citation does not support its assertion. Nowhere does the Practice & Procedure reference state that the CCPA was not applying any clear standard of review to PTO determinations. Rather it simply cites some eleven cases and the verbal formulations applied in those cases. In seven of the listed cases, the CCPA applied the clear error or manifest error standard.

/ Another case (decided after the APA) involved a matter of procedure within the discretion of the PTO which was reviewed for "obvious error." In re Bourdon, 204 F.2d 358 (CCPA 1957). The other three cases -- only one of which was decided before the APA -- involved a standard similar to clear error review. In re Kaufmann, 193 F.2d 331 (CCPA 1951) (PTO findings "would be persuasive, although not conclusive"); In re Noxon, 210 F.2d 835 (CCPA 1954) (PTO holdings entitled to "great weight"); Rodli v. Phillipi, 154 F.2d 139 (CCPA 1946) (reviewing for "cogent evidence of mistake").

Accordingly, there can be no dispute that the CCPA used "clearly erroneous" as its standard of review prior to the enactment of the Administrative Procedure Act. Pursuant to that standard, as seen in the case law, the CCPA thoroughly reviewed the prior art references and other materials of record in the Patent Office to determine whether the Patent Office's decision was clearly wrong.

II. THE PLAIN LANGUAGE OF THE APA PERMITS THIS COURT TO CONTINUE REVIEWING PTO FACT-FINDING FOR CLEAR ERROR

The PTO's argument that the enactment of the APA should be seen as limiting the preexisting additional legal requirement on the courts to review the PTO for clear error is contrary to the purpose of the APA and its plain language. Specifically, section 12 of the Administrative Procedure Act, 5 U.S.C. § 559, provides in pertinent part that "Chapter 7" of the Act, i.e., including 5 U.S.C. § 706:

do[es] not limit or repeal additional requirements imposed by statute or otherwise recognized by law.

According to the legislative history of this provision, section 12 was intended "to indicate that the act [i.e., APA] will be interpreted as supplementing constitutional and legal requirements imposed by existing law." S. Rep. No. 79-752, at 45 (1945), reprinted in Administrative Procedure Act, Legislative History, 79th Congress, 1944-1946, at 231 (USGPO 1946).

Thus, by its plain terms, 5 U.S.C. §preserves not only additional statutory requirements of law, but also preexisting requirements recognized in judge or agency made law. See also United Transportation Union-Illinois Legislative Board v. Interstate Commerce Comm'n, 52 F.3d 1074, 1079 (D.C. Cir. 1995) (§preserved the preexisting "inherent authority" of the Interstate Commerce Commission to issue declaratory judgment orders). Moreover, §can operate to impose additional requirements relating to judicial review beyond the minimum standards set forth in 5 U.S.C. § 706. See United States v. Menendez, 48 F.3d 1401, 1409 (5th Cir. 1995) (preexisting statutory requirement that court review agency findings "on the record considered as a whole" preserved the additional requirement that the agency file a certified copy of the administrative record with the district court).

There can be no doubt that the "clear error" standard of review which was required by judge-made law prior to enactment of the APA imposes an additional requirement on the reviewing court beyond the otherwise applicable standards of review subsequently set forth in the APA. Indeed, the very reason for this in banc appeal is the PTO's desire to avoid this additional requirement.

More specifically, the APA, by its terms, imposes minimum review requirements on the courts, stating in pertinent part that the reviewing court:

shall hold unlawful and set aside agency action, findings, and conclusions found to be -- (A) arbitrary, capricious, and abuse of discretion, or otherwise not in accordance with law; . . . (E) unsupported by substantial evidence in a case . . . otherwise reviewed in the record of an agency hearing provided by statute. . . .

5 U.S.C. § 706(2). The "substantial evidence" standard of review which the PTO now advocates "restricts an appellate court to a greater degree than 'clearly erroneous' review." SSIH Equipment, 718 F.2d at 382. The substantial evidence standard simply asks whether the record contains "such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." Id. (quoting Universal Camera Corp. v. NLRB, 340 U.S. 474, 477 (1951)). The distinction between "clear error" review and "substantial evidence" review is surely not trivial. As this Court has stated: "There is a significant difference between the standards of 'substantial

evidence' and of 'clearly erroneous,' and in close cases this difference can be controlling." Tandon Corp. v. United States Int'l Trade Comm'n, 831 F.2d 1017, 1019 (Fed. Cir. 1987).

The requirement recognized by law when the APA was enacted -- i.e., that the Patent Office decisions are subject to judicial review for clear error -- is an additional requirement over and above the standards set forth in 5 U.S.C. § 706, and the "clear error" standard is therefore preserved through 5 U.S.C. § 559. There is no reason to hold that the enactment in the APA of minimum standards of review that courts must apply limits the pre-existing, additional clear error review requirement that was well established for review of Patent Office decisions.

III. THERE ARE SOUND STRUCTURAL AND POLICY REASONS TO CONTINUE THIS COURT'S CLEAR ERROR REVIEW

The administration of the patent laws has traditionally been subject to close judicial scrutiny. The PTO readily admits this. In its brief in this appeal, the PTO emphasizes that its fact-finding is subject to de novo judicial review in the District Court pursuant to 35 U.S.C. § 145. (See Supplemental Brief for Appellees, at pp. 10 n.4, 15 n.7, 16.) Under that provision, an inventor can simply sue in the District Court to challenge the PTO's rejection of a patent application, and the District Court may adjudge that the applicant "is entitled to receive a patent for his invention . . . as the facts in the case may appear . . . ." 35 U.S.C. § 145.

The PTO relies on the existence of de novo review to avoid having to follow other sections of the APA. Specifically, the PTO states in its supplemental brief (pages 10 n.4, 15 n.7) that the "formal adjudication section" of the APA, 5 U.S.C. § 554, which includes a laundry list of procedural requirements not followed by the PTO, does not apply to the PTO because that section states that it does not apply "to the extent that there is involved -- (1) a matter subject to a subsequent trial of the law and the facts de novo in a court." 5 U.S.C. § 554(a)(1). If the PTO's decisions were not subject to trial "de novo," then §would apply. The PTO's argument that at least some portions of the APA (§ 554) do not apply to the PTO, and its recognition that the PTO's fact-finding is subject to close judicial scrutiny, thus casts serious doubt on its premise that the APA (§ 706) must be construed to apply to the PTO because it is an agency deserving of judicial deference and fully subject to all the provisions of the APA.

While this Court has judicially limited the scope of the § 145 de novo trial in Fregeau v. Mossinghoff, 776 F.2d 1034 (Fed. Cir. 1985), holding that the District Court is to review the record before the PTO under the "clearly erroneous" standard of review, and is to make de novo findings on any new evidence presented to the District Court on a disputed fact question, the sole authority for this judicially-created limitation was historical. The Court found that the pertinent language of 35 U.S.C. §existed since prior to the Supreme Court's decision in Morgan v. Daniels, 153 U.S. 120 (1894), and that in Morgan v. Daniels, the Supreme Court had reviewed the Patent Office's decision under the "clearly erroneous" standard of review. Fregeau, 776 F.2d at 1038. Thus, there is no basis, statutorily, historically or otherwise, for further limiting the District Court's review of PTO decisions under 35 U.S.C. § 145. Nor does the PTO even want to avoid review in the District Court.

Therefore, regardless of how this Court answers the question of whether it is bound to apply a substantial evidence standard, the law still clearly requires that the District Court review PTO decisions in §proceedings pursuant to limited de novo review. If the Federal Circuit adopts a substantial evidence standard of review for its own review of PTO fact- finding, it would be possible for the same decision of the PTO, on the same record, to be reviewed under different standards depending on whether an appeal was taken to the Federal Circuit under 35 U.S.C. §(substantial evidence review) or a suit was brought in the district court under 35 U.S.C. §(clear error review of PTO record). This is precisely the kind of result condemned in Fregeau. See 776 F.2d at 1038 ("a difference in result in this court is not logically justifiable, if the evidentiary record before the district court is the same as that before the board, simply because of the review route chosen").

Moreover, the District Court would be reviewing the PTO record more thoroughly than the Federal Circuit. The effect would be a channelling of appeals away from the Federal Circuit to the District Court. This result would be an anathema to this Court's core functions of reviewing PTO decisions and providing uniform standards for patent law.

Given the judiciary's longstanding role in making substantive determinations as to whether patents should issue, the historic practice of this Court and its predecessor to thoroughly review PTO fact-finding under the clear error standard, stare decisis principles which counsel that the practice be maintained, and the plain language of 5 U.S.C. §which permits this Court to continue that practice, the Federal Circuit should not now drop its standard of judicial review of PTO fact-finding to less than "clear error." If, from a policy standpoint, less thorough judicial review of PTO fact-finding is appropriate, that change should come from Congress. E.g., SSIH Equipment, 718 F.2d at 371 (In 1980, Congress specifically amended 19 U.S.C. §to change review of ITC fact-finding from the "clearly erroneous" standard previously applied by the courts to the APA's "substantial evidence" standard).

CONCLUSION

For the foregoing reasons, amicus curiae New York Intellectual Property Law Association requests that this Court hold that Patent and Trademark Office fact-finding will continue to be reviewed under the previously-applied "clearly erroneous" standard.

Respectfully submitted,

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**PRE-APA DECISIONS OF THE CCPA
APPLYING A "CLEAR ERROR" STANDARD**

In re Moulton, 38 F.2d 359, 360 (CCPA 1930)

In re Ford, 38 F.2d 525, 526 (CCPA 1930)

In re Walter, 39 F.2d 724, 724 (CCPA 1930)

In re Engelhardt, 40 F.2d 760, 764 (CCPA 1930)

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Reed v. Edwards, 101 F.2d 550, 552 (CCPA 1939)

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In re Kaplan, 110 F.2d 670, 672 (CCPA 1940)

In re Carlton, 111 F.2d 190, 192 (CCPA 1940)

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Hamer v. White, 143 F.2d 987, 990 (CCPA 1944)

Pinkerton v. Stahly, 144 F.2d 881, 885 (CCPA 1944)

In re Ruzicka, 150 F.2d 550, 553 (CCPA 1945)

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Stern v. Schroeder, 36 F.2d 518, 522 (CCPA 1929)

Janette v. Folds, 38 F.2d 361, 362 (CCPA 1930)

In re Demarest, 38 F.2d 895, 896 (CCPA 1930)

In re Banner, 39 F.2d 690, 692 (CCPA 1930)

In re Wietzel, 39 F.2d 669, 670 (CCPA 1930)

Pengilly v. Copeland, 40 F.2d 995, 996 (CCPA 1930)

In re Kochendorfer, 44 F.2d 418, 419 (CCPA 1930)

Thompson v. Pettis, 44 F.2d 420, 421 (CCPA 1930)

In re Dickerman, 44 F.2d 876, 877 (CCPA 1930)

In re McDonald, 47 F.2d 802, 804 (CCPA 1931)

In re Hermans, 48 F.2d 386, 387 (CCPA 1931)

In re Anhaltzer, 48 F.2d 657, 658 (CCPA 1931)

Bennett v. Fitzgerald, 48 F.2d 917, 918 (CCPA 1931)

In re Doherty, 48 F.2d 952, 953 (CCPA 1931)

Montgomery Ward & Co. v. Sears, Roebuck & Co., 49 F.2d 842, 843 (CCPA 1931) (trademark interference)

In re Murray, 53 F.2d 540, 541 (CCPA 1931)

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In re Taylor, 92 F.2d 705, 706 (CCPA 1937)

In re Adamson, 92 F.2d 717, 720 (CCPA 1937)

Bryson v. Clarke, 92 F.2d 720, 722 (CCPA 1937)

Adams v. Stuller, 94 F.2d 403, 406 (CCPA 1938)

Brand v. Thomas, 96 F.2d 301, 302 (CCPA 1938)

Ellis v. Maddox, 96 F.2d 308, 314 (CCPA 1938)

Creed v. Potts, 96 F.2d 317, 321 (CCPA 1938)

In re Cassidy, 97 F.2d 93, 95 (CCPA 1938)

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In re Bertsch, 107 F.2d 828, 831 (CCPA 1939)

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PROOF OF SERVICE

The undersigned hereby certifies that two copies of the foregoing BRIEF FOR AMICUS CURIAE NEW YORK INTELLECTUAL PROPERTY LAW ASSOCIATION IN SUPPORT OF REVIEWING PATENT AND TRADEMARK OFFICE FACT-FINDING UNDER THE CLEARLY ERRONEOUS STANDARD OF REVIEW, have been sent via Federal Express to:

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on this 30th day of October, 1997.

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Bruce M. Wexler

/ As discussed infra pages 14-15, this Court has held, based on Supreme Court precedent, that the statutory provision for de novo review is limited in that the district court must apply "clear error" review when reviewing the record before the PTO.

/ E.g., Berman v. Rondelle, 75 F.2d 845, 847 (CCPA 1935) ("under the well known rule this court will not reverse the decision of the board under such circumstances unless it is clearly erroneous"); In re Engelhardt, 40 F.2d 760, 764 (CCPA 1930) ("We think that, considering all the facts in the case disclosed by the record, it is clear that the Board of Appeals should have held that the" prior art did not disclose elements of the applicant's invention); Pengilly v. Copeland, 40 F.2d 995, 996 (CCPA 1930) ("It is the settled rule that this court will not reverse concurring findings of the Patent Office tribunals, except where the court can say the decisions are manifestly wrong. . . . This follows a long line of decisions of the Court of Appeals of the District of Columbia."); In re Batcher, 59 F.2d 461, 463 (CCPA 1932) ("when an appeal is taken to this court, the judges of which are not supposed to be, and do not profess to be, experts in the realm of mechanics, the burden rests upon the party appealing to make it clear that the findings of fact by such tribunals are manifestly wrong").

/ Daley v. Witshire, 293 F.2d 677 (CCPA 1961); In re Ubbelohde, 128 F.2d 453 (CCPA 1942); Israel v. Cresswell, 166 F.2d 153 (CCPA 1948); Societe Anonyme Marne et Champagne v. Myers, 250 F.2d 374 (CCPA 1957); In re Wietzel, 39 F.2d 669 (CCPA 1930); In re Bertsch, 132 F.2d 1014 (CCPA 1942); In re Stoll, 161 F.2d 241 (CCPA 1947).