

A Range of Possible Dates for Alleged Prior Art Does Not Satisfy Standard of Clear and Convincing Evidence for Proving Invalidity

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Addressing the standard for providing prior art by prior invention under 35 U.S.C. § 102(g), the **U.S. Court of Appeals for the Federal Circuit** reiterated that the standard is clear and convincing evidence and held that a range of *possible* dates for prior invention did not meet this standard. ***Amkor Technology, Inc. v. International Trade Commission***, Case No. 10-1550 (Fed. Cir., Aug. 22, 2012) (Linn, J.).

Amkor initiated an ITC investigation, alleging that certain respondents violated section 337 of the **Tariff Act of 1930** based on the importation of certain encapsulated integrated circuit devices that allegedly infringed Amkor's patent. The administrative law judge issued an initial determination finding that a third party (ASAT) conceived of the invention in a foreign country sometime during April or May and that Amkor's patented technology was conceived sometime during May through August, or on December 10, of that same year. The ALJ went on to conclude, however, that ASAT's alleged prior invention was not prior art under § 102(g)(2) because there was a failure of proof "by clear and convincing evidence that the April/May date of invention [for the ASAT invention] . . . is prior to the [May through August] date of invention accorded the asserted claims."

The Commission reversed and determined that Amkor's patent was invalid under § 102(g)(2). The Commission held that the ASAT invention is prior art under § 102(g)(2) because, according to the *Oka* rule, the patent must be accorded the last date in the range of possible conception dates, or December 10, which falls after the April/May date of invention for the ASAT invention. Amkor appealed.

The Federal Circuit reversed, explaining that the Commission applied an erroneous legal standard. The Federal Circuit noted that the *Oka* rule, applied in the context of interferences, does not apply to patents entitled to a presumption of validity in litigation, which can only be overcome by clear and convincing evidence. The Federal Circuit went on to find that the range of dates of possible prior invention "at best, establishes that the ASAT inventor might have conceived of the invention first. Evidence establishing that there might have been a prior conception is not sufficient to meet the clear and convincing burden needed to invalidate a patent."

Practice Note: A party trying to prove prior art, and in particular prior invention, would be better served in terms of persuasion by presenting—and is essentially legally required to present—a consistent story on the date of the prior art, rather than a range of possible dates for the prior art, particularly if part of that date range is after the conception of the patented invention.

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National Law Review, Volume II, Number 284

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