

To be sure, numerous courts of appeals in the years preceding the 1952 Act observed that the presumption of validity is “weakened” or “dissipated” in the circumstance that the evidence in an infringement action was never considered by the PTO. See *Jacuzzi Bros., Inc. v. Berkeley Pump Co.*, 191 F. 2d 632, 634 (CA9 1951) (“largely dissipated”); *H. Schindler & Co. v. C. Saladino & Sons*, 81 F. 2d 649, 651 (CA1 1936) (“weakened”); *Gillette Safety Razor Co. v. Cliff Weil Cigar Co.*, 107 F. 2d 105, 107 (CA4 1939) (“greatly weakened”); *Butler Mfg. Co. v. Enterprise Cleaning Co.*, 81 F. 2d 711, 716 (CA8 1936) (“weakened”). But we cannot read these cases to hold or even to suggest that a preponderance standard would apply in such circumstances, and we decline to impute such a reading to Congress. Instead, we understand these cases to reflect the same **commonsense principle** that the Federal Circuit has recognized throughout its existence—namely, that new evidence supporting an invalidity defense may “carry more weight” in an infringement action than evidence previously considered by the PTO, *American Hoist*, 725 F. 2d, at 1360. As Judge Rich explained:

“When new evidence touching validity of the patent not considered by the PTO is relied on, the tribunal considering it is not faced with having to disagree with the PTO or with deferring to its judgment or with taking its expertise into account. The evidence may, therefore, carry more weight and go further toward sustaining the attacker’s unchanging burden.” *Ibid.* (emphasis deleted)

See also *SIBIA Neurosciences, Inc. v. Cadus Pharmaceutical Corp.*, 225 F. 3d 1349, 1355–1356 (CA Fed. 2000) (“[T]he alleged infringer’s burden may be more easily carried because of th[e] additional [evidence]”); *Group One, Ltd. v. Hallmark Cards, Inc.*, 407 F. 3d 1297, 1306 (CA Fed. 2005) (similar).

Simply put, if the PTO did not have all material facts before it, its considered judgment may lose significant force. Cf. *KSR*, 550 U. S., at 427. And, concomitantly, the challenger’s burden to persuade the jury of its invalidity defense by clear and convincing evidence may be easier to sustain. In this respect, although we have no occasion to endorse any particular formulation, we note that a **jury instruction on the effect of new evidence can, and when requested, most often should be given. When warranted, the jury may be instructed to consider that it has heard evidence that the PTO had no opportunity to evaluate before granting the patent. When it is disputed whether the evidence presented to the jury differs from that evaluated by the PTO, the jury may be instructed to consider that question. In either case, the jury may be instructed to evaluate whether the evidence before it is**

materially new, and if so, to consider that fact when determining whether an invalidity defense has been proved by clear and convincing evidence. Cf., e.g., *Mendenhall v. Cedarapids, Inc.*, 5 F. 3d 1557, 1563–1564 (CA Fed. 1993); see also Brief for International Business Machines Corp. as *Amicus Curiae* 31–37. Although Microsoft emphasized in its argument to the jury that S4 was never considered by the PTO, it failed to request an instruction along these lines from the District Court. Now, in its reply brief in this Court, Microsoft insists that an instruction of this kind was warranted. Reply Brief for Petitioner 22–23. That argument, however, comes far too late, and we therefore refuse to consider it. See *Rent-A-Center, West, Inc. v. Jackson*, 561 U. S. ___, ___ (2010) (slip op., at 12); cf. Fed. Rule Civ. Proc. 51(d)(1)(B).