



NYSBA - Bright Ideas: Is the Presumption of Validity Dead for Substitute Claims Issued as a Result of Motions to Amend After PTAB Proceedings?

Author(s): Charles R. Macedo, *Christopher Lisiewski, and Sean Reilly

In a related White Paper published by Askeladden LLC's Patent Quality Initiative, we analyze the proper role of a the presumption of validity for claims that have been amended in post-issuance proceedings like Inter Partes Review (IPR) proceedings under the Smith-Leahy American Invents Act (AIA). A full copy of our paper is available [here](#). The following is taken from an excerpt published in the Winter 2018 edition of NYSBA Bright Ideas Vol. 27 No. 3 discussing the history of the presumption of validity and our conclusion that the presumption of validity should not apply to substitute claims, since such claims have never been fully examined and thus not entitled to the presumption that they were.

Introduction

Under Section 282 of the Patent Act of 1952, a patent “shall be presumed valid,” and “[t]he burden of establishing invalidity of a patent or any claim thereof shall rest on the party asserting such invalidity.” As Judge Rich, one of the authors of the 1952 Patent Act, explained, the rationale for this presumption is based on “the basic proposition that a government agency such as the [PTO] was presumed to do its job.” This presumption makes sense in the context of the statutory scheme of the 1952 Act, which first codified this presumption, where a patent application follows an “inquisitorial process between patent owner and examiner.” Thus, the examiner, acting on behalf of the government, can be presumed to have performed his or her job if and when patent claims issue.

However, in 2011, under the Leahy-Smith American Invents Act (“AIA”), unlike the original prosecution, or even traditional ex parte reexamination, “the petitioner is master of its complaint and nor-mally entitled to judgment on all of the claims it raises, not just those the decisionmaker might wish to address.” To the extent all the PTAB is performing is “a second look at an earlier administrative grant of a patent,” continuing to apply this presumption to claims that survive a PTAB proceeding (like an inter partes review) continues to make sense. After all, the government did its job in the first instance in the original inquisitorial examination, and a third party challenger was unable to demonstrate error.

However, since the Federal Circuit's decision in *Aqua Products, Inc. v. Matal* confirmed that the burden of persuasion on the patentability of amended claims in a motion to amend in an inter partes review proceeding (and presumably other post issuance PTAB proceedings) is placed on the petitioner, the theoretical rationale for Section 282(a)'s presumption of validity is



no longer present for such amended claims. In particular, there is no government agency that is tasked with performing the inquisitorial examination that gave rise to the original presumption. How can there be a presumption that the government agent charged with examining the patent claims did his or her job, when there is no such person assigned to perform that job?

Full article available [HERE](#).