



IPWatchdog

Is the Presumption of Validity Dead in Substitute Claims Issued as a Result of Motions to Amend After PTAB Proceedings?

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In a 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 an excerpt discussing our thesis and 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.

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.” 35 U.S.C. § 282 (2018). 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.” *American Hoist & Derrick Co. v. Sowa & Sons, Inc.*, 725 F.2d 1350, 1359 (Fed. Cir. 1984). 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.” See *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1353 (2018). Thus, the examiner, acting on behalf of the government, can be presumed to have performed his or her job if and when a patent claims issue.

However, in 2011, under the Smith-Leahy American Invents Act (“AIA”), unlike the original prosecution, or even traditional *ex parte* reexamination, “the petitioner is master of its complaint and normally entitled to judgment on all of the claims it raises, not just those the decisionmaker might wish to address.” *Id.* at 1355 ; see *id.* at 1356 (“[T]he petitioner’s petition, not the Director’s discretion, is supposed to guide the life of the [*inter partes* review] litigation.”). To the extent that all the PTAB is performing is “a second look at an earlier administrative grant of a patent,” [Oil States Energy Servs., LLC v. Greene’s Energy Grp.](#), 138 S. Ct. 1365, 1374 (2018) (quoting [Cuozzo Speed Techn. LLC v. Lee](#), 136 S. Ct. 2131, 2144 (2016)), 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.

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