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

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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." 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.

However, since the Federal Circuit's decision in Aqua Products, Inc. v. Matal confirmed that the burden of persuasion on a 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. 872 F.3d 1290 (Fed. Cir. 2017) (en banc). 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


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is no such person assigned to perform that job?

In Part I of this paper, we examine the historical roots of Section 282(a) and the presumption of validity and its rationale and applicability to claims that issued through original prosecution and traditional inquisitorial reexamination proceedings. In Part II, we examine how previously issued claims and amended claims presented in motions to amend in post issuance proceedings before the PTAB after Aqua Products are addressed and the procedures and duties of the relative participants with respect to testing each such claim. In Part III, we analyze the proper role of the presumption of validity for claims that issue in post issuance proceedings, both previously issued claims and amended claims.

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