

REVISITING THE PRESUMPTION OF PATENT VALIDITY*

Alan Devlin**

Abstract

This Article seeks to solve the seemingly intractable problem of the Patent Office ("PTO") routinely issuing patents of dubious validity. Some have convincingly argued that the PTO is justified in its "rational ignorance" because most patents are of nugatory value and the judiciary is better placed to perform an accurate screening function. Yet, the statutory presumption of patent validity markedly frustrates the efficacy of the foregoing process, given its reinforcement of erroneously granted patents.

The author supports a new form of prosecution in which applicants can elect two forms of review. Those electing a contemporary standard of review would have their applications considered by an examiner in much the same manner as today, but would be awarded a patent with a far lower presumption of validity. Potential infringers who later try to invalidate such patents would only have to prove invalidity on the balance of probabilities. However, a second—and far more scrutinizing—form of review would also be available to a prospective patentee. An applicant electing this route would be required to pay a significant filing fee, would be charged with providing a full, researched report on the prior art, and would be subjected to truly exhaustive scrutiny by the pertinent examiner. Those succeeding on this ground would receive a "gold-plated" patent enjoying an enhanced presumption of validity.

Nevertheless, there is good ground to believe that the prospect of such a presumption alone would lead to sub-optimal use of the "gold-plated" review process. In particular, submitting one's application to heightened review front-loads risk of rejection. Moreover, an obscure anticipatory reference may still elude the PTO, which would rationally expend less resources combing the prior art than an accused infringer for whom millions of dollars may be at stake. In the face of an explicit reference—elusive as it may have been—a presumption

* This Article arose from the author's discussions with Professor Mark Lemley concerning the proper role of the presumption of validity. Many thanks to Professor Lemley, both for his help with this Article and for his on-going guidance, and to Daniel Molina, Scott Mollett, and Lisa Iadevaia, whose insights helped enormously.

** Associate, Latham & Watkins LLP; BBL (Int'l), University College Dublin, Ireland; J.D., Stanford Law School; LL.M, J.S.D., University of Chicago Law School.