

# *Myths of Patent Examination and Invalidation*

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A conventional view exists about the relationship between ex ante patent examination and ex post patent invalidation, whether in district court litigation or administrative proceedings. On this view, the Patent Office examines patent applications to assure compliance with the statutory criteria of patentability. Ex post invalidation serves to correct errors made by the Patent Office in this task, whether the result of incompetence, time and resource constraints, or “rational ignorance” that limits the resources spent on examination because few patents will ever become relevant. This conventional view drives policy debates, including those related to the presumption of validity, new administrative proceedings to cancel issued patents, and the optimal level of investment in ex ante examination.

The conventional view, however, is a myth, and the realities of patent examination and litigation are much more nuanced. The American patent system is only partially a system of ex ante patent examination and, in significant respects, actually functions as a registration system whereby compliance with the statutory criteria patentability is left entirely to ex post patent invalidation in litigation and administrative proceedings. Specifically, ex post invalidity challenges often involve categories of prior art that are not capable of ex ante examination given the structural design of patent examination, such as invalidating sales, public uses, or non-traditional publications. Additionally, the Patent Office sometimes examines a patent based on then-existing information but the invalidity question subsequently changes based on ex post developments, such as stretching of the patent claims by the patent owner to cover new developments in technology or the market. In these circumstances, patent issuance follows more of a registration model than an examination model and ex post invalidation serves not as an error correction mechanism but rather as a first-instance review of patentability. This more nuanced view of patent examination and ex post invalidation sheds light on current debates over the presumption of validity, administrative patent cancellation, and investment in ex ante examination.