



Left to right Peter Thurlow, Judge  
Timothy Dyk

The Honorable Timothy B. Dyk, U.S. Court of Appeals for the Federal Circuit, spoke at the NYIPLA's luncheon and CLE program on Friday, December 10, 2004, on the topic of "The Federal Circuit, Administrative Law and the Patent Office." The topics discussed were, To what extent is the PTO similar to, or different from, other administrative agencies?; To what extent should administrative law doctrines such as Chevron deference apply to the PTO?; Should District Courts refer validity issues to the PTO?; and the Federal

Trade Commission's (FTC) proposed post-grant patent review procedures.

Judge Dyk discussed the issue of deference that courts give to PTO decisions in light of the Dethmers Manufacturing Co., Inc. case (Federal Circuit, Dec. 5, 2001). There, the court held, *inter alia*, that Claims 4-7 of a reissue patent were invalid as a result of a defective reissue declaration even though the PTO accepted a substitute reissue declaration and granted the subject reissue patent. The court's decision was based solely on a *de novo* review of the compliance of the reissue declaration with 37 C.F.R. § 1.175. The court accorded no deference to the PTO's own interpretation and application of the rule. Judge Dyk, in his presentation and in a dissenting opinion in the Dethmers' case, pointed out that Claims 4-7 should not have been held invalid, noting that the PTO's decision to accept the substitute declaration should have been given substantial deference. Judge Dyk noted that the rule of deference is not new, i.e., giving deference to agency interpretations of their own regulations has long been the rule. For example, Judge Dyk noted, in the seminal Supreme Court decision, Dickinson v. Zurko (119 S. Ct. 1816 (1999)), the Supreme Court held that the standards of the Administrative Procedure Act (APA) apply to the court's review of PTO's decisions. Thus, under the APA, the PTO was to be treated like any other agency. Judge Dyk noted that the PTO filed an amicus brief requesting that the court hear this case *en banc*, arguing that the Dethmers' decision be reversed, i.e., that the PTO should be given deference when making agency decisions. In addition, Judge Dyk urged the PTO to submit more amicus briefs in important cases involving patent law and procedures.

Judge Dyk also discussed the FTC's proposals for enacting a new post-grant review procedure for challenging the validity of a patent. The FTC proposal includes a provision that information used to invalidate a patent include not only patents and printed publications as permitted in reexaminations, but also written description, enablement, and utility issues. An administrative patent judge would preside over the review proceeding, cross examination of witnesses would be allowed, and carefully circumscribed discovery would be permitted. Judge Dyk discussed the presumption of validity of a patent claim under 35 U.S.C. § 282, the "clear and convincing" standard required to invalidate a patent claim in the federal courts and the FTC's proposal that a patent claim be invalidated based on information sufficient to satisfy a "preponderance of the evidence" standard.