

# Validity and Invalidity of Patent Claims

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## **Introduction**

An invalid patent claim cannot be infringed. This statement has far-reaching implications whether you are a patent owner or a party accused of infringement, albeit each situation involves very different analyses and results. As a patent owner, the validity or invalidity of patent claims provides a basis for whether the owner has any leverage in enforcing a patent against an infringer and negotiating or maintaining the terms of a license agreement.

However, this chapter will address validity or invalidity of patent claims in the context of finding yourself in the undesirable position of dealing with the possibility or even the reality of an infringement lawsuit naming your institution as a party.

Once issued, a U.S. patent is presumed valid, as mandated by the U.S. patent statutes (35 USC § 282). This means that courts will deem each claim of the patent as meeting the statutory requirements of novelty, nonobviousness, utility, written description, definiteness, enablement, and best mode, which places a heavy burden to overcome this presumption on those challenging issued patent claims.

It also means that each claim is presumed valid independently of any other claim, which, in most cases, means that, even if an independent claim is rendered invalid, a claim dependent therefrom may still be valid and enforceable. Thus, each claim of a patent requires a separate validity analysis.