

## Federal Circuit Holds Invalidity May Not be Based on "Improper Revival" of an Abandoned Patent Application

11-03-2008

By [Swope, Richard S.](#); [Isackson, Robert M.](#); [Cooper, Monte](#)

In *Aristocrat Techs. Australia Pty Ltd. v. Int'l Game Tech.*, No. 2008-1016 (Fed. Cir. Sep. 22, 2008), the Federal Circuit held that "improper revival" of an abandoned patent application may not be the basis for an invalidity defense. However, the court left open the possibility an "improper revival" might give rise to unenforceability for inequitable conduct.

In this case the Federal Circuit addressed whether a defendant could raise the fact that a patent initially declared abandoned was improperly revived, pursuant to 37 CFR 1.137(a), as a basis for an invalidity defense. This defense has been used with increasing frequency, such as when a patentee claims that it failed inadvertently and with excusable neglect to timely pay the filing fees on a patent application, and the defendant finds evidence that the abandonment actually had been intentional, thus turning the original application into a prior art publication, which almost certainly anticipates any patent that issues on a later continuation application.

In this decision, the Federal Circuit held that there is no such "improper revival" defense under 35 USC 282, because it is not specifically mentioned as a condition of patentability under Sections 101, 102 or 103. In particular, the Court held that "[s]ection 282(2), by virtue of its applicability to 'condition[s] for patentability,' relates only to defenses of invalidity for lack of utility and eligibility, novelty, and nonobviousness, and does not encompass a defense based upon the alleged improper revival of a patent application."

The Court did acknowledge that there might be occasions where "improper" revival became applicable in the context of inequitable conduct.

As a result, improper revival on its own is not sufficient to invalidate a patent. However, evidence of improper revival may be used, if one can prove the requisite balance of materiality and intent, to establish inequitable conduct leading to unenforceability in defense to a patent infringement claim.

[Intellectual Property](#)