Do Applicant Patent Citations Matter? Implications for the Presumption of Validity

Patent law imposes a duty of candor on patent applicants. They must disclose any prior art of which they are aware to the Patent and Trademark Office (PTO); failure to do so can render the resulting patent unenforceable. The idea is that applicants should help patent examiners decide whether an invention is patentable by submitting what is likely to be the most relevant information.

We study the use made of that submitted information by delving into the actual prosecution process in over a thousand different cases. We find, to our surprise, that patent examiners effectively ignore almost all applicant-submitted art, relying almost exclusively on prior art they find themselves. This is not simply because the applicant has “drafted around” the art they submitted; even late-submitted art is ignored by examiners. Either applicants submit uniformly weak prior art, or examiners simply don’t bother to read what they receive.

Our findings have significant implications for a number of important legal and policy disputes. First, if examiners pay attention only to art they find for themselves, we must rethink policy proposals that encourage outsourcing of search to applicants, third party searchers, or foreign patent offices. Second, it is far from clear that the law should presume a patent valid over art that the examiner has not given much consideration. Finally, our findings suggest that inequitable conduct is less of a problem than previously thought – not because applicants don’t try to deceive the PTO, but because any effort to do so seems wasted.