Regional Courts of Appeals Cases Applying
Lower Standard of Proof for Invalidity Defenses

First Circuit

Spound v. Mohasco Indus., Inc., 534 F.2d 404, 409 (1st Cir. 1976) ("Had such a burden been imposed upon defendant, it would have been appropriate to add defendant's requested qualification, viz., that to the extent there was relevant prior art not considered by the Patent Office, this burden was pro tanto weakened."), *abrogated on other grounds by Pioneer Inv. Servs. Co. v. Brunswick Assocs. Ltd. P'ship*, 507 U.S. 380 (1993).

Futorian Mfg. Corp. v. Dual Mfg. & Eng'g, Inc., 528 F.2d 941, 943 (1st Cir. 1976) ("[T]o the extent patent office attention has not been directed to relevant instances of prior art the presumption of validity arising from the issuance of a patent is eroded. . . . The presumption of validity having been weakened, it follows that while a burden still remained on the challenger, it would, as a practical matter, be less than the burden embodied in the 'clear and convincing' standard . . . .").

Boyajian v. Old Colony Envelope Co., 279 F.2d 572, 575 n.4 (1st Cir. 1960) ("A patent once issued is presumed valid. However, failure of a file wrapper to cite the prior art weakens this presumption.").

H. Schindler & Co. v. C. Saladino & Sons, 81 F.2d 649, 651 (1st Cir. 1936) ("While it is true that the granting of a patent by the Commissioner of Patents carries with it a presumption of validity, if the prior art is not adequately cited in the file wrapper, the presumption is weakened . . . .").

Second Circuit

Kahn v. Dynamics Corp. of Am., 508 F.2d 939, 942 (2d Cir. 1974) ("[T]hat presumption should not attach where there is evidence that the Patent Office has been misled as to the true import of prior art references.").

Julie Research Labs., Inc. v. Guildline Instruments, Inc., 501 F.2d 1131, 1136 (2d Cir. 1974) ("[T]he usual presumption of validity is weakened because the significant Diesselhorst ring was not considered by the Patent Office.").

Triax Co. v. Hartman Metal Fabricators, Inc., 479 F.2d 951, 954 (2d Cir. 1973) ("[I]nasmuch as neither of these pending applications is disclosed in the file wrapper of Chasar 994 the ordinary presumption in favor of the validity of a granted patent is severely undercut.").

Lemelson v. Topper Corp., 450 F.2d 845, 849 (2d Cir. 1971) ("[T]he failure of the Patent Office to actually cite patents that comprise, in part, the prior art further undercuts the weight of the presumption.").

Reeves Bros., Inc. v. U.S. Laminating Corp., 417 F.2d 869, 872 (2d Cir. 1969) ("While there is a presumption of patent validity, that presumption means no more than that reasonable doubts will be resolved in favor of the patentee. Courts have also recognized that failure of the Patent Office to consider certain relevant prior patents severely undercuts the presumption.").

Rains v. Niaqua, Inc., 406 F.2d 275, 278 (2d Cir. 1969) ("[The presumption of validity] has no independent evidentiary value; rather, it serves to place the burden of proof on the person who asserts invalidity. Reasonable doubt on the issue of validity must be resolved in favor of the patent holder, but in the usual case a preponderance of the evidence determines the issue.").

Cont'l Can Co. v. Old Dominion Box Co., 393 F.2d 321, 326 n.8 (2d Cir. 1968) ("The presumption of validity attaching to issued patents is substantially weakened by the failure of the Patent Office to consider important prior art . . . .").

Formal Fashions, Inc. v. Braiman Bows, Inc., 369 F.2d 536, 539 (2d Cir. 1966) ("It is of significance that the prior art reference[s] relied upon by Judge McLean were not before the Patent Examiner who approved appellant's application. This Circuit has repeatedly held that this fact detracts from the presumption of validity of a patent.").

Gross v. JFD Mfg. Co., 314 F.2d 196, 198 (2d Cir. 1963) (T. Marshall, J.) ("'We cannot properly allow decisions of [the PTO] to alter the preponderance of the evidence on the question of validity.'" (quoting *Lorenz v. F.W. Woolworth Co.*, 305 F.2d 102, 105 (2d Cir. 1962))).

Lorenz v. F.W. Woolworth Co., 305 F.2d 102, 105 (2d Cir. 1962) ("The presumption of validity relieves the patent holder of the burden of establishing that validity as a requisite for the successful maintenance of an infringement action, and places the burden of establishing invalidity on the alleged infringer who asserts it. . . . We cannot properly allow decisions of [the PTO] to alter the preponderance of the evidence on the question of validity."); *id.* at 105 n.7 ("[N]one of the particular patents evidencing prior art . . . were called to the attention of the patent examiner and there was no intervention in opposition to the issuance of the Schliephacke patent. Both of these factors tend to weaken or negate the presumption.").

Audio Devices, Inc. v. Armour Research Found. of Ill. Inst. of Tech., 293 F.2d 102, 107 (2d Cir. 1961) ("The usual presumption of validity from the grant of the patent is substantially weakened here by the failure of the examiner to consider much of the prior art . . . .").

Zoomar, Inc. v. Paillard Prods., Inc., 258 F.2d 527, 530 (2d Cir. 1958) ("[S]ince the Patent Office did not consider the Michel and Richter disclosures when it approved plaintiff's application, there can be no strong presumption of validity from its action.").

Gerald M. Friend, Inc. v. Walsh, 141 F.2d 180, 181 (2d Cir. 1944) ("Lear was not cited against the Walsh patent—a fact which weakens the presumption of validity arising from the grant of a patent.").

Cutler Mail Chute Co. v. Capitol Mail Chute Corp., 118 F.2d 63, 64 (2d Cir. 1941) ("This [invalidity] conclusion can be reached without doing violence to the usual presumption of validity arising from the grant of a patent, because the Teevan patent was not cited as a reference in the Patent Office.").

Nat'l Elec. Prods. Corp. v. Grossman, 70 F.2d 257, 258 (2d Cir. 1934) ("Since the Johnson patent was not cited against the patent in suit and the presumption of validity does not extend beyond the record before the Examiner, our prior adjudication is not conclusive as to this defendant . . . .").

R. Hoe & Co. v. Goss Printing Press Co., 30 F.2d 271, 274 (L. Hand, J.) ("Moreover, we are not faced with the presumption of validity in this respect because of the examiner's failure to find Gally as a reference; it is at least open to doubt whether, had Gally been discovered, the claims would have issued."), *mandate recalled and amended*, 31 F.2d 565 (2d Cir. 1929).

Third Circuit

N. Eng'g & Plastics Corp. v. Eddy, 652 F.2d 333, 337-38 (3d Cir. 1981) ("The presumption of validity that attaches to a patent issued by the U.S. Patent Office . . . is weakened when the party asserting obviousness comes forward with significant prior art not considered by the Patent Office.").

Aluminum Co. of Am. v. Amerola Prods. Corp., 552 F.2d 1020, 1024 (3d Cir. 1977) ("[W]hen relevant prior art has not been considered by the Patent Office, the presumption of validity is weakened or overcome.").

Allegheny Drop Forge Co. v. Portec, Inc., 541 F.2d 383, 384 n.3 (3d Cir. 1976) (per curiam) ("the existence of relevant prior art not considered by the Patent Office materially weakens the importance of the presumption of patentability").

Layne-N.Y. Co. v. Allied Asphalt Co., 501 F.2d 405, 407 (3d Cir. 1974) ("The fact that significant prior art not considered by the Patent Office was brought forth by the appellant weakens the patent's presumption of validity.").

Arrow Safety Device Co. v. Nassau Fastening Co., 496 F.2d 644, 646 (3d Cir. 1974) ("[T]he patent's presumptive validity was weakened because significant prior art not considered . . . by the Patent Office was brought forth by the appellee.").

U.S. Expansion Bolt Co. v. Jordan Indus., Inc., 488 F.2d 566, 569 (3d Cir. 1973) ("Since the defendants came forward with significant prior art not considered by the Patent Office, the presumption of validity attaching to plaintiff's patent in this case is weakened.").

Hadco Prods., Inc. v. Walter Kidde & Co., 462 F.2d 1265, 1272 n.33 (3d Cir. 1972) ("Where it is shown that pertinent items of the prior art have not been considered by the Patent Office, the presumption of validity attaching to the patent is weakened.").

Philips Elecs. & Pharm. Indus. Corp. v. Thermal & Elecs. Indus., Inc., 450 F.2d 1164, 1176 (3d Cir. 1971) ("Where relevant prior art is not considered by the patent office, the presumption of validity of the patent is weakened or overcome.").

Chem. Constr. Corp. v. Jones & Laughlin Steel Corp., 311 F.2d 367, 371 n.1 (3d Cir. 1962) ("This prior art was not considered by the Patent Office. Therefore the statutory presumption of validity ordinarily attaching to the patent grant is weakened.").

Scripto, Inc. v. Ferber Corp., 267 F.2d 308, 308 (3d Cir. 1959) (per curiam) ("the fact that a wealth of relevant prior art had not been called to the attention of the Examiner . . . detracted materially from the importance of the presumption").

Dole Refrigerating Co. v. Amerio Contact Plate Freezers, Inc., 265 F.2d 627, 629 (3d Cir. 1959) ("Where the patent office has not considered important portions of the prior art, the presumption of validity arising under 35 U.S.C. § 282 from the issuance of the patent is weakened.").

Elliott & Co. v. Youngstown Car Mfg. Co., 181 F. 345, 349 (3d Cir. 1910) ("Nor is the ordinary presumption to be indulged in favor of the patent, because of the action of the Patent Office in allowing it; the [other] patents, as it appears, not having been referred to, as they have been here.").

Am. Soda Fountain Co. v. Sample, 130 F. 145, 149-50 (3d Cir. 1904) ("[W]e think the force of that presumption is much diminished, if not destroyed, by the lack of any reference by the Examiner to, or consideration of, the 'Clark' patents.").

Fourth Circuit

Tenneco Chems., Inc. v. William T. Burnett & Co., 691 F.2d 658, 666 (4th Cir. 1982) ("Having upheld the district court's finding that Tenneco at least to some degree misled the patent office we further agree that the presumption of validity was destroyed . . . .").

Christopher J. Foster, Inc. v. Newport News Shipbuilding & Dry Dock Co., 531 F.2d 1243, 1245 (4th Cir. 1975) ("Though relevant, the St. John dock was not considered by the patent examiner, and therefore the statutory presumption of the Foster patent's validity is at least weakened.").

Blohm & Voss AG v. Prudential-Grace Lines, Inc., 489 F.2d 231, 244 (4th Cir. 1973) ("This court has held, along with others, that the statutory presumption of validity is weakened where pertinent prior art is not considered by the patent office.").

Blumcraft of Pittsburgh v. Citizens & S. Nat'l Bank of S.C., 407 F.2d 557, 561 (4th Cir. 1969) ("The prima-facie presumption of the patent's validity can be given little weight. The patent Office cited none of the ornamental railings found in the prior art.").

Marston v. J.C. Penney Co., 353 F.2d 976, 982 (4th Cir. 1965) ("This presumption [of validity] . . . is weakened or destroyed where relevant art was not cited or considered.").

Heyl & Patterson, Inc. v. McDowell Co., 317 F.2d 719, 722 (4th Cir. 1963) ("The presumption of validity can be weakened or destroyed where there has been a failure to cite prior art before the patent examiner.").

Universal Inc. v. Kay Mfg. Corp., 301 F.2d 140, 148 (4th Cir. 1962) ("We do not think as the plaintiff contends that an infringer must prove invalidity beyond a reasonable doubt. . . . [T]he presumption accorded by the statute is . . . weakened to some extent by the fact that the Patent Office did not have before it such prior art references as the Compin and Fryer patents.").

B.F. Goodrich Co. v. U.S. Rubber Co., 244 F.2d 468, 470 (4th Cir. 1957) ("The Killen and Wingfoot patents were not before the Patent Office, nor was reference made to the abandoned applications of Goodyear and McNeill & Eger, nor to the demonstrations and teachings of McGay. The presumption of validity arising from the issuance of the patent is accordingly very much weakened.").

Gillette Safety Razor Co. v. Cliff Weil Cigar Co., 107 F.2d 105, 107 (4th Cir. 1939) ("Neither of these earlier patents were cited by the Patent Office when the O'Malley application was pending, and since they unquestionably constitute a most important part of the prior art, the presumption of validity arising from the grant of the patent is greatly weakened.").

Int'l Flatstub Check Book Co. v. Young & Seldon Co., 284 F. 831, 832 (4th Cir. 1922) ("The presumption of validity from the issuance of the patent ought generally to have great weight, but in this case it is greatly weakened by the fact that the file wrapper does not contain any reference to the Loewenbach patent.").

Fifth Circuit

Farmhand, Inc. v. Anel Eng'g Indus., Inc., 693 F.2d 1140, 1143 (5th Cir. 1982) ("The impact of the presumption is measurably weakened when it is shown that the Patent Office, in making its decision on issuance, did not consider pertinent prior art.").

Union Carbide Corp. v. Dow Chem. Co., 682 F.2d 1136, 1140 (5th Cir. 1982) ("[T]he precedential effect this court would ordinarily attach to a decision of the CCPA is weakened here by Carbide's failure to present all the pertinent prior art to that court.").

Baumstimler v. Rankin, 677 F.2d 1061, 1066, 1068 (5th Cir. 1982) ("[W]hen the Patent Office has not considered all of the prior art in issuing the patent, this Circuit has made clear that the presumption of validity is weakened. . . . Given the introduction of evidence that the Patent Office failed to consider relevant prior art in the form of the Cavins tools, the standard of proof required of Laughlin to overcome the presumption of validity of the patents was not 'clear and convincing' but simply a preponderance of the evidence.").

Reed Tool Co. v. Dresser Indus., Inc., 672 F.2d 523, 526 (5th Cir. 1982) ("[The presumption] vanishes once the party attacking the patent demonstrates that the Patent Office failed to consider pertinent prior art at the time it made its evaluation.").

Arbrook, Inc. v. Am. Hosp. Supply Corp., 645 F.2d 273, 276 n.1 (5th Cir. 1981) ("The presumption [of validity] is seriously weakened . . . if the Patent Office has overlooked pertinent prior art.").

Ludlow Corp. v. Textile Rubber & Chem. Co., 636 F.2d 1057, 1059 (5th Cir. 1981) ("The presumption of validity . . . is weakened when pertinent art has not been considered by the Patent Office.").

Cont'l Oil Co. v. Cole, 634 F.2d 188, 195 (5th Cir. 1981) ("[I]f there is no evidence that the Patent Office considered a particular prior art, the presumption of validity is mitigated.").

John Zink Co. v. Nat'l Airoil Burner Co., 613 F.2d 547, 551 (5th Cir. 1980) ("[T]he presumption of validity . . . can be weakened when the patent office has not considered all the prior art.").

Cathodic Protection Serv. v. Am. Smelting & Ref. Co., 594 F.2d 499, 505 (5th Cir. 1979) ("[W]hen the defense of invalidity of the patent is raised on the ground that prior art was not submitted to the patent office, the foundation for the presumption vanishes, the presumption itself is severely weakened, and the court is required to scrutinize the patent more closely.").

Steelcase, Inc. v. Delwood Furniture Co., 578 F.2d 74, 77 (5th Cir. 1978) ("Although there is a statutory presumption of validity . . . , the failure of [the patent] office to consider pertinent prior art references will seriously weaken it.").

Parker v. Motorola, Inc., 524 F.2d 518, 521 (5th Cir. 1975) ("[W]hen a defendant in an infringement suit attacks the validity of a patent on the ground that it was issued without consideration by or presentation to the Patent Office of pertinent prior art, the reason for the presumption dissipates, and the presumption is weakened.").

White v. Mar-Bel, Inc., 509 F.2d 287, 291 (5th Cir. 1975) ("Of course, the presumption of validity is weakened upon a showing of pertinent prior art not considered by the Patent Office.").

Harrington Mfg. Co. v. White, 475 F.2d 788, 795 (5th Cir. 1973) ("Of course the statutory presumption of validity is diluted when the patent was not issued after a consideration of the prior art.").

Ingersoll-Rand Co. v. Brunner & Lay, Inc., 474 F.2d 491, 496 (5th Cir. 1973) ("This presumption of patent validity is weakened and may be overcome where the evidence discloses that the examiner did not have the best prior art before him during the prosecution of the application.").

Ag Pro, Inc. v. Sakraida, 474 F.2d 167, 172 (5th Cir. 1973) ("If it can be demonstrated that the Patent Office was not shown or did not consider additional pertinent prior art, the presumption of validity is weakened.").

Hobbs v. U.S., Atomic Energy Comm'n, 451 F.2d 849, 863 (5th Cir. 1971) ("[I]t is recognized that, when prior relevant patents are not considered by the Patent Office, the presumption of patent validity is weakened, if not totally destroyed.").

Beckman Instruments, Inc. v. Chemtronics, Inc., 439 F.2d 1369, 1374-75 (5th Cir. 1970) ("[W]hen the defendants in an infringement suit attack the validity of a patent on the ground that it includes prior art that has not been presented to the patent office, the basis for the presumption vanishes, the presumption is significantly weakened, and the Court is required to scrutinize the patent more closely.").

Stamicarbon, N.V. v. Escambia Chem. Corp., 430 F.2d 920, 926 (5th Cir. 1970) ("if it can be shown that the Patent Office was not shown or did not consider additional pertinent prior art, the presumption of validity is weakened if it does not disappear altogether").

Johns-Manville Corp. v. Cement Asbestos Prods. Co., 428 F.2d 1381, 1382 (5th Cir. 1970) ("[W]hen a defendant in a patent infringement suit attacks the validity of a patent on the ground that it was issued without a consideration of prior art not submitted to the Patent Office, the basis for the presumption vanishes, and the presumption is significantly weakened.").

Waldon, Inc. v. Alexander Mfg. Co., 423 F.2d 91, 93 (5th Cir. 1970) ("We note preliminarily that two prior relevant patents . . . were not considered by the Patent Office when it issued Waldon's patent. Therefore, the presumption of validity is materially weakened, if not destroyed.").

Am. Seating Co. v. Se. Metals Co., 412 F.2d 756, 760 (5th Cir. 1969) ("[T]he Patent Office did not have all the relevant prior art before it when the '344 patent was issued. In these circumstances, the presumption of validity otherwise attaching from the issuance of the patent is weakened, if not totally destroyed.").

Metal Arts Co. v. Fuller Co., 389 F.2d 319, 322 (5th Cir. 1968) ("It is true that if pertinent references were not considered by the patent office, then this presumption may be diluted or even extinguished.").

Zero Mfg. Co. v. Miss. Milk Producers Ass'n, 358 F.2d 853, 858 (5th Cir. 1966) ("[W]here the Patent Office has not considered pertinent prior art, the statutory presumption of validity is seriously weakened.").

Hahn & Clay v. A.O. Smith Corp., 320 F.2d 166, 172 n.15 (5th Cir. 1963) ("the presumption of validity does not attach as against pertinent prior art that was not considered by the Patent Office at the time that the patent in issue was being considered").

Murray Co. of Tex. v. Cont'l Gin Co., 264 F.2d 65, 69 (5th Cir. 1959) ("[W]here the Patent Office has failed to consider pertinent art, the statutory presumption of validity is greatly weakened.").

Cornell v. Adams Eng'g Co., 258 F.2d 874, 875 (5th Cir. 1958) ("[W]hen the Patent Office has not considered important contributions to the prior art, the usual presumption of validity otherwise attaching from the issuance of the patent is greatly weakened, if not completely destroyed.").

Fritz W. Glitsch & Sons, Inc. v. Wyatt Metal & Boiler Works, 224 F.2d 331, 335 (5th Cir. 1955) ("This is especially true in view of the prior art Foster-Wheeler and Lowe structures, both of which were highly pertinent references not even considered by the Patent Office, so that the usual presumption of validity which might otherwise attach from issuance is greatly weakened, if not completely disspelled [*sic*].").

Rosaire v. Baroid Sales Div., Nat'l Lead Co., 218 F.2d 72, 75 (5th Cir. 1955) ("This article was not considered by the Patent Office and the patents were therefore greatly weakened and they lack the presumption of validity that would otherwise exist.").

Sixth Circuit

Dollar Elec. Co. v. Syndevco, Inc., 688 F.2d 429, 432 (6th Cir. 1982) ("The fact that the patent office did not consider the applicable prior art which clearly existed as shown by the testimony of the inventor, greatly weakens and largely dissipates the statutory presumption of validity of the patent under 35 U.S.C. § 282.").

Universal Elec. Co. v. A.O. Smith Corp., 643 F.2d 1240, 1245 (6th Cir. 1981) ("It is firmly established that the presumption is weakened greatly where the Patent Office has failed to consider pertinent prior art.").

Park-Ohio Indus., Inc. v. Letica Corp., 617 F.2d 450, 453 (6th Cir. 1980) ("[T]he failure of the examiner . . . to cite such highly relevant prior art as Bardell and Hurtt in the patent file history seriously weakens this presumption.").

Saginaw Prods. Corp. v. E. Airlines, Inc., 615 F.2d 1136, 1140 (6th Cir. 1980) ("The patent was presumed to be valid because it was regularly issued by the Patent Office. . . . The burden of proof was upon the defendant to establish its affirmative defenses by a preponderance of evidence.").

Hanson v. Alpine Valley Ski Area, Inc., 611 F.2d 156, 159 (6th Cir. 1979) ("[W]here applicable prior art has not been considered by the Patent Office this presumption is greatly weakened.").

Eltra Corp. v. Basic Inc., 599 F.2d 745, 750-51 (6th Cir. 1979) ("In the typical case such as this, where the bulk of the evidence of the prior art is contained in documents, the party claiming obviousness need only do so by a preponderance of the evidence."); *id.* at 754 n.18 ("Although Basic entered this litigation with the benefit of the statutory presumption of validity . . . , it is axiomatic that its limited force can be weakened or destroyed where it is shown that the most relevant prior art was not disclosed to the patent examiner.").

Am. Seating Co. v. Nat'l Seating Co., 586 F.2d 611, 615 (6th Cir. 1978) ("In cases in which relevant prior art was not considered by the Patent Office, the presumption [of validity] is largely, if not wholly, vitiated.").

Reynolds Metal Co. v. Acorn Bldg. Components, Inc., 548 F.2d 155, 160, 162-63 (6th Cir. 1977) ("[W]here pertinent prior art was not considered by the Patent Office this presumption [of validity] is weakened. . . . [I]n this case the evidence supporting obviousness was not so unreliable as to require this Court to apply the strict standard of proving obviousness by clear and convincing evidence. Rather, in this case a preponderance of the evidence is sufficient to establish invalidity.").

Nat'l Rolled Thread Die Co. v. E.W. Ferry Screw Prods., Inc., 541 F.2d 593, 597 (6th Cir. 1976) ("[W]here pertinent prior art has not been considered by the Patent Office, the presumption is weakened.").

Bolkcom v. Carborundum Co., 523 F.2d 492, 498 (6th Cir. 1975) ("[W]here applicable prior art has not been considered by the Patent Office this presumption is greatly weakened.").

Dickstein v. Seventy Corp., 522 F.2d 1294, 1297 (6th Cir. 1975) ("We are therefore of the opinion that in this case, and in the usual patent case in which validity is proved with similar evidence, a preponderance of evidence is sufficient to establish invalidity.").

Sperberg v. Goodyear Tire & Rubber Co., 519 F.2d 708, 713 (6th Cir. 1975) ("This presumption has no independent evidentiary value . . . , but only serves to place the burden of proof on a party who asserts invalidity.").

Atlas Chem. Indus., Inc. v. Moraine Prods., 509 F.2d 1, 3 (6th Cir. 1974) ("Since the ground of invalidity asserted in the present case does not touch on any area of inquiry considered previously by the Patent Office, there are no balancing factors here which weigh in favor of the presumption in disposing of the motion for summary judgment.").

Schnadig Corp. v. Gaines Mfg. Co., 494 F.2d 383, 392 (6th Cir. 1974) ("We have stated repeatedly that the presumption of validity is weakened when the Patent Office has not considered pertinent and material prior art.").

Tee-Pak, Inc. v. St. Regis Paper Co., 491 F.2d 1193, 1196 (6th Cir. 1974) ("Even though this presumption may be weakened by the failure of the Patent Office to consider all pertinent art, the degree by which it is weakened depends on a balancing of the pertinence of the newly cited art with the pertinence of the art considered by the Patent Office.").

Dunlop Co., Ltd. v. Kelsey-Hayes Co., 484 F.2d 407, 413 (6th Cir. 1973) ("[W]here applicable prior art has not been considered by the Patent Office this presumption is greatly weakened.").

Shatterproof Glass Corp. v. Guardian Glass Co., 462 F.2d 1115, 1124 (6th Cir. 1972) ("[T]he failure of the Patent Office to consider pertinent prior art tends to weaken if not vitiate, the presumption of validity.").

Tapco Prods. Co. v. Van Mark Prods. Corp., 446 F.2d 420, 425-26 (6th Cir. 1971) ("The presumption of course is weakened if applicable prior art has not been considered by the patent office.").

Westwood Chem., Inc. v. Owens-Corning Fiberglas Corp., 445 F.2d 911, 916 (6th Cir. 1971) ("The failure of the Patent Office to consider pertinent prior art tends to weaken if not vitiate, the presumption of validity.").

Eisele v. St. Amour, 423 F.2d 135, 138-39 (6th Cir. 1970) ("Since the Heitzmann gauge was not before the Patent Office when the St. Amour patent was considered, there is clearly no presumption of validity of this patent applicable to this undisclosed portion of the prior art.").

B.F. Goodrich Co. v. Rubber Latex Prods., Inc., 400 F.2d 401, 405 (6th Cir. 1968) ("Although 35 U.S.C. § 282 creates a presumption that a patent is valid, it has long been held in this and other circuits that this presumption is weakened and largely dissipated when pertinent prior art . . . was not considered by the Patent Office during processing of the patent in suit.").

Kaiser Indus. Corp. v. McLouth Steel Corp., 400 F.2d 36, 43 (6th Cir. 1968) ("While it is well recognized that a patent will be presumed valid, that presumption of validity is not conclusive and will be weakened when pertinent prior art was not considered by the Patent Office.").

Popcorn-In-Oil Council, Inc. v. Wyndall's Super Market, Inc., 355 F.2d 372, 375 (6th Cir. 1966) ("The District Judge concluded that the presumption of validity accorded to the issuance of a patent by the Patent Office . . . [was] not binding upon him because much additional evidence was presented before him which was not before the Patent Office . . . . In this we believe he is supported both by this record and by sound precedent.").

Felburn v. N.Y. Cent R.R. Co., 350 F.2d 416, 421 (6th Cir. 1965) ("Where . . . what we consider to be pertinent prior art was not before the Patent Office, the presumption of validity does not apply with respect to such prior art.").

Tillotson Mfg. Co. v. Textron, Inc., Homelite, 337 F.2d 833, 837 (6th Cir. 1964) ("The presumption of validity which attends the issuance of a patent is weakened where relevant prior art was not considered by the Patent Office.").

Monroe Auto Equip. Co. v. Heckethorn Mfg. & Supply Co., 332 F.2d 406, 413 (6th Cir. 1964) ("The presumption of course is weakened if applicable prior art has not been considered by the patent office.").

Preformed Line Prods. Co. v. Fanner Mfg. Co., 328 F.2d 265, 271 (6th Cir. 1964) ("This Court has held that the statutory presumption is weakened if applicable prior art is not considered by the Patent Office.").

Holstensson v. V-M Corp., 325 F.2d 109, 121 (6th Cir. 1963) ("This presumption [of validity] is weakened if there is applicable prior art not considered by the patent office.").

Harvey v. Levine, 322 F.2d 481, 484 (6th Cir. 1963) ("[T]he presumption of validity is not conclusive and may be overcome by evidence demonstrating error in the patent office's determination. It has been held by this Court that this presumption is weakened if there is applicable prior art not considered by the patent office.").

Aluminum Co. of Am. v. Sperry Prods., Inc., 285 F.2d 911, 916 (6th Cir. 1960) ("This presumption is weakened if there is applicable prior art not considered by the patent office.").

Royal Patent Corp. v. Monarch Tool & Mfg. Co., 203 F.2d 299, 300 (6th Cir. 1953) ("The District Court held that the Summers Patent does not embody patentable matter over [two patents that] were not before the Patent Office when the application for the Summers patent was considered and allowed. The presumption of validity therefore does not exist. We think the judgment of the District Court was correct.").

O'Leary v. Liggett Drug Co., 150 F.2d 656, 664 (6th Cir. 1945) ("The issuance of a patent creates no presumption of validity sufficient to overcome a pertinent prior art reference which has not been considered in the patent office").

Wolverine Fabricating & Mfg. Co. v. Detroit Gasket & Mfg. Co., 148 F.2d 399, 402 (6th Cir. 1945) ("[T]he presumption of validity arising from the granting of the patent to Kreuz is weakened because the Board of Appeals did not have before it the most pertinent prior art.").

W. Auto Supply Co. v. Am.-Nat'l Co.,114 F.2d 711, 713 (6th Cir. 1940) ("[W]hen proof of anticipation consists of drawings and claims of actual patents and admittedly prior publications, invalidity may be confidently determined despite the fact that letters patent have been issued. Moreover, the presumption of validity is more easily overcome when pertinent prior art was not cited or considered by the patent examiner . . . .").

Lempco Prods., Inc., v. Timken-Detroit Axle Co., 110 F.2d 307, 310 (6th Cir. 1940) ("The Autocar prior use was not . . . before the examiner in the patent office, and no presumption of validity may overcome a pertinent prior art reference not there considered.").

France Mfg. Co. v. Jefferson Elec. Co., 106 F.2d 605, 608 (6th Cir. 1939) ("The usual presumption of validity arising from the granting of the patent in suit is weakened in this case, because it appears it was without reference to some of the pertinent prior art and uses . . . .").

Westinghouse Elec. & Mfg. Co. v. Toledo, P.C. & L.R. Co., 172 F. 371, 392 (6th Cir. 1909) ("It should be noted that it appears from the record that neither Wightman nor the Potter patent was cited to the examiner in the Patent Office and were overlooked by him. This circumstance affects the presumption in favor of the validity of the patent from its issuance.").

Seventh Circuit

Brunswick Corp. v. Champion Spark Plug Co., 689 F.2d 740, 748 n.9 (7th Cir. 1982) ("We agree with the district court that plaintiff's lack of candor before the patent office was sufficient to deprive the patent in suit of its statutory presumption of validity.").

Pate Co. v. RPS Corp., 685 F.2d 1019, 1023 (7th Cir. 1982) ("Even one prior art reference not considered by the Patent Office can suffice to overthrow the presumption.").

Med. Lab. Automation, Inc. v. Labcon, Inc., 670 F.2d 671, 673 (7th Cir. 1981) ("[T]he presumption and its commensurate level of proof is largely, if not wholly, dissipated when pertinent prior art is not considered by the Patent Office.").

Mooney v. Brunswick Corp., 663 F.2d 724, 732 (7th Cir. 1981) ("[T]he statutory presumption of validity which may be enhanced when prior art has been considered and rejected by the Patent Office is dissipated in Mooney's case with respect to the Kiekhaefer drawing and the Gale Products drawing.").

Deere & Co. v. Int'l Harvester Co., 658 F.2d 1137, 1145 (7th Cir. 1981) ("The basis for the requirement that invalidity be established by clear and convincing evidence is largely, if not wholly, dissipated when pertinent prior art is shown not to have been considered by the Patent Office. . . . [T]he result of a determination that the patent office would have been better informed had the three additional patents been before it is only a decrease in the level of proof.").

Saunders v. Air-Flo Co., 646 F.2d 1201, 1208 (7th Cir. 1981) ("A patent is to be presumed valid, but the presumption does not exist against evidence of prior art not before the Patent Office.").

Shemitz v. Deere & Co., 623 F.2d 1180, 1184 (7th Cir. 1980) ("[W]here, as here, the anticipating prior art was not before the Patent Examiner, there is no longer such a presumption.").

Dual Mfg. & Eng'g, Inc. v. Burris Indus., Inc., 619 F.2d 660, 665 (7th Cir. 1980) (en banc) ("[T]hat presumption [of validity] does not exist against evidence of prior art not before the Patent Office. Even one prior art reference not considered by the Patent Office can suffice to overthrow the presumption.").

Lee Blacksmith, Inc. v. Lindsay Bros., Inc., 605 F.2d 341, 342-43 (7th Cir. 1979) ("The presumption of validity . . . does not exist against prior art which was not considered by the Patent Office when the patent was issued.").

Republic Indus., Inc. v. Schlage Lock Co., 592 F.2d 963, 972 (7th Cir. 1979) ("presumption does not exist against evidence of prior art not before the Patent Office").

Centsable Prods., Inc. v. Lemelson, 591 F.2d 400, 402 (7th Cir. 1979) ("[T]he most important prior art was not before the patent examiner, so that there is no presumption of validity as to the Lemelson patent. ").

Allen Group, Inc. v. Nu-Star, Inc., 575 F.2d 146, 146 (7th Cir. 1978) (per curiam) ("The district court in this case correctly . . . found that two patents not cited by the Patent Office . . . were relevant prior art which largely, if not wholly, dissipated the presumption of validity under 35 U.S.C. § 282.").

Chi. Rawhide Mfg. Co. v. Crane Packing Co., 523 F.2d 452, 457 (7th Cir. 1975) (Stevens, J.) ("The basis for the requirement that invalidity be established by clear and convincing evidence is largely, if not wholly, dissipated when pertinent prior art is shown not to have been considered by the Patent Office.").

Henry Mfg. Co. v. Comm. Filters Corp., 489 F.2d 1008, 1013 (7th Cir. 1972) ("This presumption does not exist against evidence of prior art not before the Patent Office. Even one prior art reference not considered by the Patent Office can suffice to overthrow the presumption.").

Fredman v. Harris-Hub Co., 442 F.2d 210, 214 n.10 (7th Cir. 1971) (Stevens, J.) ("The law in this circuit is clear that there is no presumption of patent validity when the pertinent prior art was not before the patent examiner.").

Rockwell v. Midland-Ross Corp., 438 F.2d 645, 650 (7th Cir. 1971) ("We long have held that the presumption of validity does not exist as against evidence of prior art not before the patent office.").

Scott Paper Co. v. Fort Howard Paper Co., 432 F.2d 1198, 1203 (7th Cir. 1970) ("The presumption of validity of a patent . . . does not apply to prior art not cited to the Patent Office, and even one prior art reference not cited to the Patent Office can suffice to overcome the presumption.").

Deep Welding, Inc. v. Sciaky Bros., Inc., 417 F.2d 1227, 1234 (7th Cir. 1969) ("[T]he presumption of validity is largely, if not wholly, dissipated when pertinent prior art is shown not to have been considered during the processing of the patent application.").

Appleton Elec. Co. v. Efengee Elec. Supply Co., 412 F.2d 579, 581 n.4 (7th Cir. 1969) ("[T]he presumption is greatly weakened when prior art patents have not been cited or considered by the Patent Office.").

Globe Tool & Eng'g Co. v. Ram Tool Co., 403 F.2d 457, 461 (7th Cir. 1968) ("[T]he presumption of validity is of no benefit in view of the patents to Schulz, Pike and Wood, which were not cited in the Patent Office.").

Great Lakes Stamp & Mfg. Co. v. Reese Finer Foods, Inc., 402 F.2d 346, 352 (7th Cir. 1968) ("The statutory presumption has little, if any, force as against relevant prior art not shown to have been considered by the patent office.").

Howe v. Gen. Motors Corp., 401 F.2d 73, 78 (7th Cir. 1968) ("We acknowledge the statutory presumption of validity of a patent. It has little, if any, force as against relevant prior art not shown to have been considered by the patent office.").

Amphenol Corp. v. Gen. Time Corp., 397 F.2d 431, 437 (7th Cir. 1968) ("The British patents . . . and United States patents . . . , none of which was before the Patent Office examiner, thus weakening the presumption of validity of an issued patent[,] all disclose resilient escapements with freely journalled escape wheels and resilient drives.").

Leach v. Badger Northland, Inc., 385 F.2d 193, 196 (7th Cir. 1967) ("The presumption of validity arising from grant of a patent is weakened by pertinent prior art not before the patent office.").

Novo Indus. Corp. v. Standard Screw Co., 374 F.2d 824, 827 (7th Cir. 1967) ("Inasmuch as neither the Sciore patent nor the Francis patent was before the Patent Office, the statutory presumption of validity attaching to the issuance of a patent is of no aid to the plaintiff.").

Everest & Jennings, Inc. v. Colson Corp., 371 F.2d 240, 243 (7th Cir. 1967) ("While there is a presumption of validity arising from the grant of a patent, no such presumption exists as against prior art not before the patent office.").

Strzalkowski v. Beltone Elecs. Corp., 371 F.2d 237, 240 (7th Cir. 1966) ("The French patent was not before the patent office in either the Strzalkowski or the Holt patent. Thus the statutory presumption of validity attaching to the issuance of a patent is of no aid to the plaintiffs.").

T.P. Labs., Inc. v. Huge, 371 F.2d 231, 234 (7th Cir. 1966) ("The presumption of validity of a patent does not exist as against evidence of prior art not before the Patent Office, and even one prior art reference not considered by the Patent Office can suffice to overthrow this presumption.").

Skirow v. Roberts Colonial House, Inc., 361 F.2d 388, 390 (7th Cir. 1966) ("The statutory presumption has little, if any, force as against relevant prior art not shown to have been considered by the patent office.").

Townsend Co. v. M.S.L. Indus., 359 F.2d 814, 817 (7th Cir. 1966) ("Exhibit 4 manufactured in accordance with the claims of the patent in suit differs in no material respect from Exhibit 3 which completely anticipates the patent in suit but which was never brought to the attention of the Patent Office, thus destroying the presumption of validity of the patent.").

Simmons Co. v. Hill-Rom Co., 352 F.2d 886, 888 (7th Cir. 1965) ("Neither the Draper patent nor the devices manufactured thereunder were before the Patent Office. Consequently, the statutory presumption of validity attaching to the issuance of a patent is of no aid to the plaintiff.").

Milton Mfg. Co. v. Potter-Weil Corp., 327 F.2d 437, 439 (7th Cir. 1964) ("[T]he presumption is greatly weakened when prior art patents have not been cited or considered by the Patent Office.").

Kennatrack Corp. v. Stanley Works, 314 F.2d 164, 167 (7th Cir. 1963) ("With regard to the issue of validity, the District Court made detailed findings respecting the prior art, some of which had not been considered by the Patent Office, thus weakening the presumption of validity that would otherwise exist.").

A R Inc. v. Electro-Voice, Inc., 311 F.2d 508, 512-13 (7th Cir. 1962) ("[T]here is no presumption that a patent is valid as embodying bodying an invention over pertinent prior art not cited or considered by the Patent Office.").

Day-Brite Lighting, Inc. v. Sandee Mfg. Co., 286 F.2d 596, 597 (7th Cir. 1960) ("[Defendant] argues that the presumption of validity does not apply because pertinent prior art was not considered by the Patent Office and that as against such art the presumption does not exist. This Court has frequently so held.").

Crane Packing Co. v. Spitfire Tool & Mach. Co., 276 F.2d 271, 274 (7th Cir. 1960) ("[T]he presumption of validity arising from the grant of a patent does not exist as against prior art not before the Patent Office.").

Clapper v. Original Tractor Cab Co., 270 F.2d 616, 623 (7th Cir. 1959) ("[Prior art] include[s] a number of patents not cited by the Patent Examiner, thus weakening the presumption of validity which attaches to a patent by virtue of its issuance.").

Senco Prods., Inc. v. Fastener Corp., 269 F.2d 33, 34 (7th Cir. 1959) ("The statutory presumption has little, if any, force as against relevant prior art not shown to have been considered by the patent office.").

Am. Sign & Indicator Corp. v. Schulenburg, 267 F.2d 388, 393 & n.2 (7th Cir. 1959) ("[T]he Patent Examiner . . . did not see and consider TOM Co's prior control equipment," "[t]hus greatly weakening the presumption of validity.").

Hyster Co. v. Hunt Foods, Inc., 263 F.2d 130, 133 (7th Cir. 1959) ("[T]he presumption of validity of the Ehmann patent was overcome by the evidence that the Adde clamp, as modified, was never before the Patent Office.").

Hobbs v. Wisc. Power & Light Co., 250 F.2d 100, 105 (7th Cir. 1957) ("It has been held that the presumption of validity of a patent does not exist as against evidence of prior art not before the Patent Office . . . .").

Nordell v. Int'l Filter Co., 119 F.2d 948, 950 (7th Cir. 1941) ("[T]here can be no presumption of validity over this prior art which the Examiner did not note.").

Benjamin Elec. Mfg. Co. v. Bright Light Reflector Co., 111 F.2d 880, 882 (7th Cir. 1940) ("The ordinary presumption of validity is weakened by the fact that pertinent art appearing in this record was not considered by the examining officer.").

Johnson Labs. v. Meissner Mfg. Co., 98 F.2d 937, 943 (7th Cir. 1938) ("The file wrapper shows that the Patent Office . . . cited none of the prior art that is here relied upon . . . . Consequently the presumption of validity of either patent is greatly weakened. It cannot stand against pertinent art which was not considered by the examiner.").

Dickson Gasket Co. v. De Boer Motors, 97 F.2d 215, 216 (7th Cir. 1938) ("This [presumption] is substantially weakened by the fact that the Chrysler use, if proved, was not before the Patent Office when the claim was allowed.").

Moran v. Protective Equip., 84 F.2d 927, 929 (7th Cir. 1936) ("The presumption of validity which arises from the issuance of the patent can not be permitted to stand as against the pertinent prior art disclosed by this record, which was not before the patent office.").

Boynton v. Chi. Hardware Foundry Co., 77 F.2d 799, 801 (7th Cir. 1935) ("We are not unmindful of the presumption of validity which attaches to the patent by virtue of its issuance, but that presumption can not stand against pertinent art which was not considered by the Examiner.").

Eighth Circuit

Black & Decker Mfg. Co. v. Ever-Ready Appliance Mfg. Co., 684 F.2d 546, 548 (8th Cir. 1982) ("[T]he presumption of validity is weakened, if not completely destroyed, by proof of pertinent prior nonconsidered art.").

Bolt, Beranek & Newman, Inc. v. McDonnell Douglas Corp., 521 F.2d 338, 340 (8th Cir. 1975) ("The District Court found that there were several additional items of prior art which were not considered by the examiner, thus weakening the ordinary presumption of patent validity.").

Ralston Purina Co. v. Gen. Foods Corp., 442 F.2d 389, 390 (8th Cir. 1971) (per curiam) ("The presumption of validity normally afforded to a patent is weakened, if not completely destroyed, by proof of pertinent prior non-considered art.").

Imperial Stone Cutters, Inc. v. Schwartz, 370 F.2d 425, 429 (8th Cir. 1966) ("[O]f course, plaintiffs' presumption of validity is weakened if there is applicable prior art not considered by the Patent Office.").

Piel Mfg. Co. v. George A. Rolfes Co., 363 F.2d 57, 60 n.4 (8th Cir. 1966) ("Since the Assman patent was not a portion of the prior art considered by the Patent Examiner in processing Piel's application, the statutory presumption of validity accorded a patent by 35 U.S.C. § 282 (1964) is substantially weakened.").

Am. Infra-Red Radiant Co. v. Lambert Indus., Inc., 360 F.2d 977, 989 (8th Cir. 1966) ("With a showing that this most relevant of all prior art was not considered by the patent office, we believe the normal presumption of validity was greatly weakened if not completely destroyed. In fact it is difficult to imagine how a patent has any presumption of validity over pertinent prior art references when these references were not before the patent examiner. . . . In such a situation the defendants obviously do not have to bear the heavy burden necessary to overcome a presumption at its full strength.").

John Deere Co. of Kan. City v. Graham, 333 F.2d 529, 530 (8th Cir. 1964) ("the presumption of validity is a rebuttable one," "when substantial evidence attacking the validity of a patent is introduced, the question whether the patent constitutes an invention is for the court," and "the presumption of validity is weakened if applicable prior art is not considered by the Patent Office").

L.S. Donaldson Co. v. La Maur, Inc., 299 F.2d 412, 420 (8th Cir. 1962) ("The presumption of validity is weakened if there is applicable prior art not considered by the Patent Office.").

Butler Mfg. Co. v. Enter. Cleaning Co., 81 F.2d 711, 716 (8th Cir. 1936) ("The Fenton patent was not before the Examiner of the Hatfield application as a reference. For this reason the presumption attending the issue of the latter patent is further weakened.").

Ninth Circuit

Carpet Seaming Tape Licensing Corp. v. Best Seam Inc., 694 F.2d 570, 575 (9th Cir. 1982) ("[A]lthough a patent is ordinarily presumed valid, . . . where the obviousness of a patent is in issue and the applicant fails to disclose pertinent prior art, the presumption disappears, unless the undisclosed prior art is merely cumulative of the cited art.").

Penn Int'l Indus., Inc. v. New World Mfg., Inc., 691 F.2d 1297, 1300 (9th Cir. 1982) ("The presumption [of validity] is dissipated if the Patent Office examiner did not have the prior art before him in making his determination. In that case, the burden of proof with respect to non-obviousness shifts to the claimant under the patent.").

Bristol Locknut Co. v. SPS Techs., Inc., 677 F.2d 1277, 1281 (9th Cir. 1982) ("Where, as here, the obviousness of the patent is in issue, the presumption of a patent's validity will disappear if the applicant failed to disclose prior relevant art to the patent office.").

Smith Int'l, Inc. v. Hughes Tool Co., 664 F.2d 1373, 1376 (9th Cir. 1982) ("The statutory presumption of patent validity is dissipated only when the patent examiner is shown to have failed to consider pertinent prior art.").

Carson Mfg. Co. v. Carsonite Int'l Corp., 686 F.2d 665, 667 (9th Cir. 1981) ("[W]here the obviousness of a patent as compared to the prior art is in issue and the patent applicant fails to disclose relevant prior art, the presumption disappears.").

Hammerquist v. Clarke's Sheet Metal, Inc., 658 F.2d 1319, 1323 (9th Cir. 1981) ("Ordinarily, the existence of undisclosed prior art would mean that no presumption of validity could attach to the Hammerquist patent under 35 U.S.C. § 282.").

Del Mar Eng'g Labs. v. Physio-Tronics, Inc., 642 F.2d 1167, 1173 (9th Cir. 1981) ("[T]his presumption . . . does not apply where a defendant has shown that the patent office was not informed of the most relevant prior art.").

NDM Corp. v. Hayes Prods., Inc., 641 F.2d 1274, 1277 & n.6 (9th Cir. 1981) ("This presumption dissipates . . . by a showing that pertinent prior art was not cited to the patent examiners. . . . [T]he existence of some pertinent prior art references not cited to the examiner destroys the presumption.").

Tveter v. AB Turn-O-Matic, 633 F.2d 831, 833 (9th Cir. 1980) ("[The failure of the patent examiner to review relevant prior art] dissipated the presumption of validity. The burden of proof with respect to non-obviousness remained with [the patentees] as claimants under the patent.").

Photo Elecs. Corp. v. England, 581 F.2d 772, 775 (9th Cir. 1978) ("The presumption is dissipated when the patent examiner is shown to have failed to consider pertinent prior art.").

Santa Fe-Pomeroy, Inc. v. P & Z Co., 569 F.2d 1084, 1092 (9th Cir. 1978) ("the statutory presumption of validity is weakened when it can be shown that pertinent instances of prior art were not considered by the Patent Examiner before granting the patent").

Ceco Corp. v. Bliss & Laughlin Indus., Inc., 557 F.2d 687, 691 (9th Cir. 1977) ("[T]he defendant cannot rely on the presumption of validity of the Cunningham patent under 35 U.S.C. § 282 because the Erwin patent was seemingly unknown to the Examiner and was not cited by him during the prosecution of the original patent.").

Globe Linings, Inc. v. City of Corvallis, 555 F.2d 727, 729 (9th Cir. 1977) ("Even one prior art reference not considered by the patent office may be sufficient to overcome the presumption.").

Kamei-Autokomfort v. Eurasian Auto. Prods., 553 F.2d 603, 605 (9th Cir. 1977) ("A patent is presumed valid under 35 U.S.C. § 282 unless there is a showing that prior art was not brought to the attention of the patent examiners. Therefore, there is no presumption of validity here.").

St. Regis Paper Co. v. Royal Indus., 552 F.2d 309, 312 (9th Cir. 1977) ("Any such presumption [of validity] would disappear, or at least be weakened, when it is shown that all the prior art had not been brought to the attention of the patent examiner.").

Norwood v. Ehrenreich Photo-Optical Indus., Inc., 529 F.2d 3, 9 (9th Cir. 1975) ("[T]he statutory presumption of nonobviousness . . . is substantially dissipated where there is a showing that the patent examiner failed to consider the prior art.").

Alcor Aviation, Inc. v. Radair, Inc., 527 F.2d 113, 115 (9th Cir. 1975) ("A presumption of non-obviousness dissipates upon a showing that the prior art was not brought to the attention of the patent examiner.").

Deere & Co. v. Sperry Rand Corp., 513 F.2d 1131, 1132 (9th Cir. 1975) ("[W]hen a patent is attacked as obvious in light of prior art, the presumption dissipates upon a showing that the prior art was not brought to the attention of the patent examiners. . . . Hence, the presumption was insufficient in the face of the unconsidered prior art to shift the burden of proof on the validity issue to [the alleged infringer].").

Cool-Fin Elecs. Corp. v. Int'l Elec. Research Corp., 491 F.2d 660, 661 n.2 (9th Cir. 1974) ("The Dickinson patent was not considered by the Patent Office as a prior reference when it issued the IERC patent. Because we conclude that Dickinson in more pertinent than the prior art considered by the Patent Office, we consider the IERC patent without the aid of the usual presumption accorded issued patents.").

Mayview Corp. v. Rodstein, 480 F.2d 714, 718 (9th Cir. 1973) ("On the question of obviousness against the prior art, the presumption [of validity] dissipates when it is shown that the prior art was not brought to the attention of the patent examiners.").

Hewlett-Packard Co. v. Tel-Design, Inc., 460 F.2d 625, 628 (9th Cir. 1972) ("[T]his presumption of validity arising from the issuance of the patent by the Patent Office is insufficient in the face of pertinent prior art not before the patent examiners.").

Westinghouse Elec. Corp. v. Titanium Metals Corp. of Am., 454 F.2d 515, 516 n.2 (9th Cir. 1971) ("[T]he district court found as facts that the Patent Office had not cited or considered either the '828' process or certain other elements of the most pertinent prior art. The court concluded from these findings that the presumption of validity normally accorded to an issued patent under 35 U.S.C. § 282 had been overcome. We . . . think the district court was correct.").

Exer-Genie, Inc. v. McDonald, 453 F.2d 132, 135-36 (9th Cir. 1971) ("the presumption is insufficient in the face of pertinent prior art . . . not before the patent examiners").

Aerotec Indus. of Cal. v. Pac. Scientific Co., 381 F.2d 795, 803 (9th Cir. 1967) ("The presumption is insufficient in the face of pertinent prior art patents not considered by the Patent Office.").

Hensley Equip. Co. v. Esco Corp., 375 F.2d 432, 435 (9th Cir. 1967) ("Neither of the Mekeel patents was apparently considered by the Patent Office in the prosecution of the Baer patent. Consequently, the normal presumption of validity which arises on issuance of a patent is largely dissipated.").

Bentley v. Sunset House Distrib. Corp., 359 F.2d 140, 146 (9th Cir. 1966) ("[T]he file wrapper does not show that the Patent Office considered [certain] prior art references . . . . Consequently, whatever remains of the presumption is largely or entirely dissipated . . . .").

Monroe Auto Equip. Co. v. Superior Indus., Inc., 332 F.2d 473, 481 (9th Cir. 1964) ("The existence of but one pertinent example of unconsidered prior art is not only sufficient basis to dissipate the presumption of validity, but may render the patent invalid.").

Dresser Indus., Inc. v. Smith-Blair, Inc., 322 F.2d 878, 888 (9th Cir. 1963) ("Even one prior art reference, which has not been considered by the Patent Office, may overthrow the presumption of validity.").

Pressteel Co. v. Halo Lighting Prods., Inc., 314 F.2d 695, 696-97 (9th Cir. 1963) ("Appellees contend that neither the 1945 nor the 1947 fixtures of appellants or the National Electric Code were before the patent office and were not considered by it before allowance of the patent in suit. If this contention be true, . . . the usual presumption of validity which attaches to a patent is dissipated.").

Jaybee Mfg. Corp. v. Ajax Hardware Mfg. Corp., 287 F.2d 228, 229 (9th Cir. 1961) (per curiam) ("[E]ven one prior art reference which has not been considered by the Patent Office may overthrow this presumption. When the most pertinent art has not been brought to the attention of the administrative body the presumption is largely dissipated.").

Rohr Aircraft Corp. v. Rubber Teck, Inc., 266 F.2d 613, 618 (9th Cir. 1959) ("Even one prior art reference, which has not been considered by the Patent Office, may overthrow the presumption of validity, and, when the most pertinent art has not been brought to the attention of the administrative body, the presumption is largely dissipated.").

Jacuzzi Bros. v. Berkeley Pump Co., 191 F.2d 632, 634-35 (9th Cir. 1951) ("Even one prior art reference, which has not been considered by the Patent Office, may overthrow the presumption of validity, and, when the most pertinent art has not been brought to the attention of the administrative body, the presumption is largely dissipated.").

Gomez v. Granat Bros., 177 F.2d 266, 268 (9th Cir. 1949) ("[I]t is argued that the presumption of prima facie validity is greatly weakened if not destroyed when pertinent prior art is not cited or considered by the patent office, and this court has so held.").

McClintock v. Gleason, 94 F.2d 115, 116 (9th Cir. 1938) ("The strong presumption of validity arising from the granting of a patent is weakened when it appears that the patent is granted without reference to pertinent prior art . . . .").

Stoody Co. v. Mills Alloys, Inc., 67 F.2d 807, 810-11 (9th Cir. 1933) ("'[T]he force of that presumption is much diminished, if not destroyed, by the lack of any reference by the Examiner to, or consideration of, the [relevant] patents.'" (quoting *Am. Soda Fountain Co. v. Sample*, 130 F. 145, 149-50 (3d Cir. 1904))).

Wilson & Willard Mfg. Co. v. Bole, 227 F. 607, 609 (9th Cir. 1915) ("[The heightened standard] presupposes an adjudication by the Patent Office of every fact essential to the validity of the patent . . . . But where it appears that there has been no such adjudication by the Patent Office . . . . , the reason upon which the rule is founded ceases, and the rule ceases with it.").

Tenth Circuit

Plastic Container Corp. v. Cont'l Plastics of Okla., Inc., 708 F.2d 1554, 1558 (10th Cir. 1983) ("If the PTO failed to consider prior art that is relevant to the determination of patent validity, the basis for according deference vanishes.").

Lam, Inc. v. Johns-Manville Corp., 668 F.2d 462, 469 (10th Cir. 1982) ("By statute, a patent is presumed to be valid, but the presumption is considerably weakened if the patent examiner did not consider relevant prior art.").

Escoa Fintube Corp. v. Tranter, Inc., 631 F.2d 682, 691-92 (10th Cir. 1980) ("A recent decision of this court held that the introduction of highly relevant but unconsidered evidence of prior art requires a fresh assessment of all the art—new and old—to be carried out by the trier of the fact without presumption of validity.").

Norfin, Inc. v. IBM Corp., 625 F.2d 357, 363 (10th Cir. 1980) ("We agree that the strong presumption of validity attributable to a properly issued patent is greatly diminished when the patent office has failed to consider relevant prior art.").

Sidewinder Marine, Inc. v. Starbuck Kustom Boats & Prods., Inc., 597 F.2d 201, 205-06 & n.6 (10th Cir. 1979) ("When it is shown that a patent has issued without consideration of prior art not submitted to the Patent Office, the basis for the presumption vanishes, and the presumption is significantly weakened. . . . [O]nce any highly relevant but unconsidered prior art is introduced, a fresh assessment of all the art new and old must be carried out without benefit to the patentee of the presumption.").

M. B. Skinner Co. v. Cont'l Indus., Inc., 346 F.2d 170, 174 (10th Cir. 1965) ("And since neither the Hunter, Webber, Alsaker, nor Dixon patents were considered by the patent office, the presumption of patent validity is greatly weakened.").

Eleventh Circuit

Mfg. Research Corp. v. Graybar Elec. Co., 679 F.2d 1355, 1360-61 (11th Cir. 1982) ("The presumption of validity is severely weakened . . . when pertinent prior art was not considered by the Patent Office in its review of patent applications. In those instances, the burden upon the challenging party is lessened, so that he need only introduce a preponderance of the evidence to invalidate a patent.").

D.C. Circuit

Turzillo v. P & Z Mergentime, 532 F.2d 1393, 1399 (D.C. Cir. 1976) ("The statutory presumption of validity does not apply to prior art not cited to the Patent Office, and even one prior art reference not cited to the examiner overcomes the presumption.").

Corning Glass Works v. Brenner, 470 F.2d 410, 412 (D.C. Cir. 1972) ("The presumption of validity given to Patent Office findings . . . is weakened where an issue has not been the subject of a Patent Office finding, or an assumption underlying the patent office findings is demonstrably inaccurate in a material degree.").

Filmon Process Co. v. Spell-Right Co., 404 F.2d 1351, 1353 (D.C. Cir. 1968) ("the presumption of validity is weakened where the file wrapper references show that the examiner did not consider closely related prior art invoked by defendant to show obviousness").

Cal. Research Corp. v. Ladd, 356 F.2d 813, 819 n.14 (D.C. Cir. 1966) ("where prior art was not considered by the Patent Office, the statutory presumption of validity ordinarily attaching to the granting of a patent is weakened").

Stradar v. Watson, 244 F.2d 737, 739 (D.C. Cir. 1957) ("This proof . . . contained information which was not presented to the Patent Office. That being true, the District Court was not controlled by the presumption of correctness which attaches to Patent Office action, but was free to reach its own conclusion on the basis of the fuller information which was before it.").