David L. McCombs, Joseph Matal, and Eugene Goryunov ‘Why the USPTO Does not Receive Chevron Deference’

By David L. McCombs | July 6, 2021

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There is no disputing that the Federal Circuit has been parsimonious in its grants of deference to USPTO [U.S. Patent and Trademark Office] rulemaking. In its *en banc* Aqua Products decision, for example, a majority of the court held that the agency cannot create a burden of proof for *inter partes* review claim amendments without adopting a formal regulation that expressly addresses amendments. The agency had adopted a regulation that sets the burden of proof for all motions (including motions to amend) in AIA [America Invents Act] trials. But Judge Reyna’s swing-vote concurrence faulted the agency for not having “fully considered” the statutory framework for amendments and held that a new APA [Administrative Procedure Act] rulemaking was required. And a five-judge plurality went even further, questioning whether the statutory authorization to set “standards and procedures” for amendments is broad enough to allow the agency to establish a burden of proof for amendments.

Skepticism of USPTO rulemaking and interpretive authority was again on display in last year’s *Facebook, Inc. v. Windy City Innovations, LLC*. In “additional views,” the three-judge panel concluded that the AIA does not give the Director or the Board the power to interpret statutory provisions, and thus all legal conclusions reached by the agency must be reviewed de novo.

This lack of deference to the USPTO’s interpretation of statutes would likely come as a surprise to the other agencies that are under the Federal Circuit’s appellate jurisdiction. The Federal Circuit routinely defers to reasonable interpretations of the law that are adopted by the Department of Justice, the Treasury Department, the Office of Personnel Management, the Department of Veterans Affairs, Customs and Border Protection, and the Fish and Wildlife Service. Even other bureaus within the Commerce Department (the USPTO’s parent agency) and other agencies when addressing patent infringement questions receive Chevron deference. Why is the USPTO alone excluded from Chevron’s bounty?

Excerpted from *The Patent Lawyer*. To read the full article, click here. (See Page 20)

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