PREFACE TO THE FOURTH EDITION

In the preface to the Third Edition I began by observing the “extraordinary amount of activity in the patent law space” by the courts, Congress, and the USPTO. I could begin this preface in the same manner. On the heels of the 2013 America Invents Act (“AIA”) legislation, the Federal Circuit and Supreme Court continued to alter the landscape of American patent law. The Supreme Court’s influence can be seen in patent law’s disclosure requirements (Nautilus) and claim interpretation (Teva) jurisprudence and, most significantly, eligible subject matter law (Alice). As a defensive tool, the impact of Alice has been profound and its effect disruptive, particularly with respect to software and business-method patents. While the courts have been receptive to Alice, its effect has been most pronounced at the USPTO’s inter partes proceedings. Indeed, the pendulum has completely swung from the days of State Street Bank.

The Federal Circuit, patent law’s principal policy driver, has engaged the exhaustion doctrine and the role of contract, with its important en banc decision in Lexmark. The ability of the patentee to limit a party’s right to make and use the claimed invention after the sell or license of the invention remains one of patent law’s most controversial areas; and it is likely the Supreme Court may soon visit this issue. The appellate court also addressed, in important ways, issues relating to means-plus-function claims, in the Williamson case.

The USPTO’s Patent Trial & Appeals Board has also been quite active in inter partes review, as noted above, but also Covered Business Method (CBM) proceedings. Moreover, the agency saw 589,410 utility patent applications filed in 2015, and has worked diligently to reduce pendency periods. There were also 39,097 design patent applications in 2015, which have enjoyed greater attention in the light of the Apple-Samsung smartphone litigation.

With the understanding that students must be exposed to pre- and post-AIA doctrine, the Fourth Edition of The Law of Patents includes the aforementioned and much more, including detailed Comments, Comparative, Patent Reform, and Policy Perspectives. The relevant statutory sections remain in the back of the book, and a casebook website still resides at law.case.edu/lawofpatents/. This site provides PDFs of all of the patents-in-suit in the principal cases, relevant secondary material broken down by chapter, and links to important patent law/IP-related documents and websites.

As with the prior editions, I welcome the comments of adopters and others steeped in patent law at craig.nard@case.edu.

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