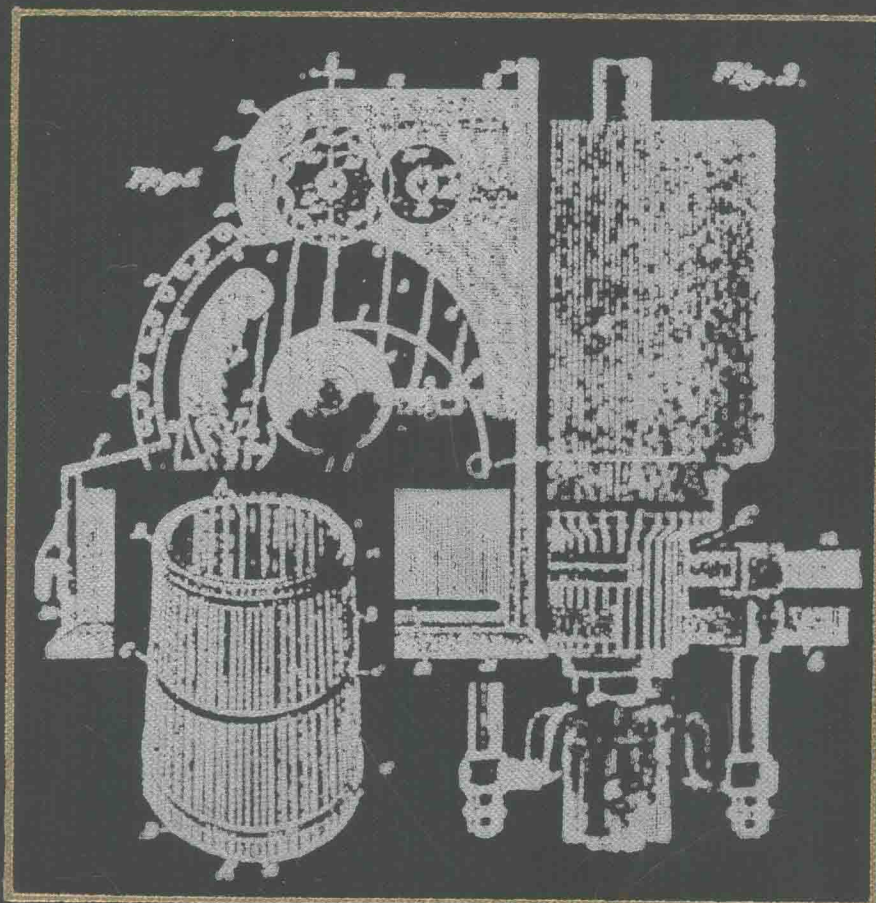


PATENT LAW FUNDAMENTALS

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Second Edition

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Second Edition

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This work is affectionately dedicated to the memory of my parents, Frederick and Martha Rosenberg, whose constant encouragement and unfaltering confidence in me—even during the darkest hours—were in no small measure responsible for making it a reality.

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Peter D. Rosenberg holds Bachelor of Arts and Bachelor of Chemical Engineering degrees from New York University. He received his Juris Doctor degree from New York Law School, and his Master of Laws in Patent and Trade Regulation Law from The George Washington University. Mr. Rosenberg is a member of the New York Bar, the American Bar Association, and the American Patent Law Association. He presently is a primary examiner in the U.S. Patent & Trademark Office and an Associate Professorial Lecturer at The George Washington University.

Preface to Second Edition

Next came the patent laws. These began in England in 1624, and in this country with the adoption of our Constitution. Before then any man might instantly use what another man had invented, so that the inventor had no special advantage from his invention. The patent system changed this, secured to the inventor for a limited time exclusive use of his inventions, and thereby added the fuel of interest to the fire of genius in discovery and production of new and useful things.

Abraham Lincoln, Lecture on 'Discoveries, Inventions and Improvements' (February 22, 1860)*

From the very beginning, invention has been an integral part of the American scene. The pioneering instinct of the early settlers had many manifestations. Though surrounded by a new and untamed environment, they were determined to progress beyond what had been left behind—to make two ears of corn grow where only one grew before. Buoyed by faith, they did not despair, they believed the promise: Seek and ye shall find.

Convinced that innovation contributed to the amelioration of society, the enlightened framers of the Constitution enshrined this conviction in that noble instrument, providing an appropriate reward for the followers of their creed, promising that one would not be suffered to reap where he had not sown. They envisioned an aristocracy founded not upon birth or social position, but upon one's own merit. The contributions of authors and inventors were, in their minds, worthy of special recognition.

The founding fathers built better than they knew. Innovation

* Lincoln was himself a patentee. U.S. Patent No. 6,469 was granted to him in 1849.

did not fade with the passing of the colonial era. It flourished to an extent that the framers of the Constitution could never have dreamed. America's hospitable climate not only nurtured indigenous inventors, but attracted many from less enlightened lands. Ericsson, Bell, Berliner, Pupin, and Tesla are but a few of the many who sought and found fame and fortune on this fecund soil. Some began inventing only after arriving here. Some had no formal scientific training. For those with imagination and initiative, invention and the patent system have been the epitome of the American dream.

But the public has reaped the greatest benefits. Convenience and comforts formerly unavailable even to monarchs and millionaires are now accessible to all. Invention has wrought greater, more fundamental, and more enduring social change than have war and revolution. The observation that James Watt made more law than all the judges of England is perhaps an understatement. Nor has our own generation remained immune from patented innovations. The transistor of Shockley, Bardeen, and Brattain not only freed electronics from dependence upon vacuum tubes, but made feasible such exotic things as space travel, satellite communication, and the cardiac pacemaker. The Xerox of Chester Carlson, himself a patent attorney, made copying on ordinary paper a reality.

By creating property in invention, the patent system has stimulated rapid, continuous, and steady technological progress, the fruits of which we enjoy today. And although the system directly rewards only applied science, patent profits do patronize pure scientific research, a dramatic example being the Nobel Prizes, made possible by the fortune derived by Alfred Nobel from his patents on dynamite. It should be remembered, too, that Albert Einstein, during some of his most fruitful years, supported himself by working as an examiner in the Swiss patent office.

Despite all the demonstrable benefits generated by the patent system there are those who cry it down, who label it an anachronism, who see it as begetting excessive economic concentration, as erecting barriers to market entry, and as condoning monopoly pricing. Such hostile attitudes, while disheartening, are not surprising in view of the general lack of appreciation of just what

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the patent system really protects; for many who malign the system do so out of ignorance.

Some who presume to speak with authority fail to grasp just how the patent system works. They are deceived because they think in terms of the generalities of the social sciences, when, in fact, the patent law demands a specificity peculiar to the physical sciences. Indeed, the level of appreciation of the patent laws among nonpatent lawyers today is perhaps comparable to the lay public's understanding of the laws of England before Blackstone. Contributing to the confusion is the fact that, for nearly the past two decades, there has not been a single book on the subject of patent law simple enough to be comprehensible, fundamental enough to be meaningful, and yet complete enough to be of value to the uninitiated. The desire to redress this condition motivated this author to embark upon the project of synthesizing the instant tome.

Conceived nearly eight years ago and reduced to practice over the following three, the seventeen chapters comprising the first edition of *Patent Law Fundamentals* were intended to fill the unsatisfied need for a comprehensive, one-volume exposition of patent law, and to present it in a readily comprehensible manner to those with no prior exposure to the subject, and yet contain enough information to be of substantial value to professional patent law practitioners.

Mythology would have us believe that perfection occurs instantaneously, just as the goddess Pallas Athene sprang full-grown from the head of Zeus. Religion teaches that perfection, at least in this world, is unattainable. History demonstrates that progress toward perfection, albeit a painstaking process, is possible. Technology offers one illustration of this evolutionary, trial-and-error phenomenon, the law another, at least in Anglo-American jurisdictions where the law develops case by case, the bulk of the law representing the accumulated wisdom of judges and counsel. Here, the law is generally allowed to evolve in bits and pieces very much like a coral reef, with cases corresponding to the microscopic organisms whose innumerable skeletons make up, in aggregate, the reef, and with legislative enactments providing no more than an overall framework. In Anglo-American jurisprudence the natural form of the law is opinions of judges in

court cases. Any attempt to transpose such law from its natural environment to the artificial confines of a legal text is at best an approximation which can be no more accurate than is a map or chart of geographic features of the globe. Consequently, any book which attempts to capture and convey the state of the law at a given historical point must of necessity be imperfect. *Patent Law Fundamentals* is no exception.

Lest the numerous non-lawyer users of this text be lulled into a false sense of security, a caveat must now be given. While most statements in the text are based upon case law, such must be qualified by significant facts and surrounding circumstances of the case, not all of which can always be presented in a text of limited length. Moreover, "the Law," particularly case law, is subject to modification by subsequent legislation and case law. Accordingly, the reader should not take as absolute and immutable any statement of law made in the text however dogmatically it may be couched. Such statements should rather be taken only as guideposts, indicating how a court has decided and may decide in the future.

Because the viability of any judicial pronouncement ultimately depends upon its wisdom, no attempt has been made in the text to indicate whether such is holding, i.e., whether it was essential to the determination of the case, or merely obiter dictum. For the same reason, pronouncements of trial courts, and even of administrative tribunals, are also included.

Non-lawyers, particularly those trained in the scientific method and attuned to investigation by experimentation, may not fully appreciate that definitive pronouncement of man-made law comes only from courts and legislatures. While any scientist is free to perform experiments at will to discern natural laws, at least in Anglo-American jurisprudence, definitive elucidation of man-made law comes only from courts and only in response to actual cases and controversies, for which reason Blackstone styled judges "the oracles of the law." Courts do not give advisory opinions and persons with only an academic interest lack standing to present a case for the purpose of gaining the court's interpretation of the law. However much such limitation on ascertaining the law may cause uncertainty and frustration, there exist compelling and overriding constitutional reasons for the policy. Any extra-judicial interpretation of statutory or case law, including that appearing in this text, is conjecture rather than

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law. It is hoped, however, that the force of the author's logic may, at least in time, find favor with the oracles of the law.

The present edition carries forward the basic format of the first edition. In addition to updating the law, there is much new matter. This falls into three categories: new topics; a reorganization and consolidation of existing topics; and a breakdown of other topics. Into the first category fall the new chapters on Trade Secrets, Trademarks, and Copyrights. Exemplifying the second category is the chapter on Patent Claims. The chapters on Priority of Invention and Patent Litigation exemplify the third category. Those with little prior knowledge of patent law should particularly appreciate the expansion of Chapter 1, as well as the following chapter, entitled "Some Popularly Held Misconceptions About Patents." For the professional, the coverage of nearly all topics has been significantly expanded; older precedents are included where they make a material contribution to the law.

Two obstacles that can assume awesome proportions in attempting to enlighten by written discourse are appropriate emphasis and interrelationship of topics. The extent of these obstacles is directly proportional to the complexity of the subject matter. In any subject there exists a hierarchy of importance. Exceptions and details, relatively unimportant but nevertheless necessary for completeness of coverage, may occupy more space than essentials. Where knowledge is conveyed by writing, there is a tendency for the key concepts to become buried and obscured in a morass of detail. A text, regardless of what it attempts to emphasize, imparts on the mind a sense of uniformity of importance of the information it conveys. A lecturer can omit detail and effectively interject emphasis. Topical breakdowns, while they facilitate written presentation, often artificially compartmentalize a subject and may actually impede the reader from gaining the overview and perspective that are so much a part of mastery of a subject. Chapter 2 points out key concepts, where possible, by building upon the reader's prior general notions. A conscious and determined effort to analogize, to correlate, and where appropriate to distinguish, topics is being carried out in the text in part through the extensive cross-referencing of sections. This progresses with each revision. In time, it is hoped that the cross-referencing will be as extensive and as rich as the overtones

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characteristic of a fine musical instrument or the bouquet of a fully aged wine. It is such controlled complexity that imparts character to a work.

It is fervently hoped that members of the general legal and scientific communities will glean from this work a genuine appreciation of the problems involved in translating a scientific conception into legally enforceable property rights, and that members of the patent bar will find here a coherent and meaningful exposition of the patent law. Although instruction in patent law has been sorely neglected in universities, it is generally agreed that patent law is truly an intellectual discipline, involving a unique blend of logic, law, and physical science.

To accommodate both the uninitiated and the seasoned professional, the whole of *Patent Law Fundamentals* reflects a concerted effort to relate those principles of patent law considered indispensable to grasping how the system works as well as its limitations and implications. Interrelationships among the various doctrines of patent law and, in turn, their relationships to principles of general law are stressed. Nevertheless, to the extent possible, each section of the text is presented as a self-explanatory entity which does not presuppose for its comprehension information contained in a subsequent section. Where information in another section is germane, an appropriate cross-reference appears. Nearly all statements are supported with case citations, which have been entirely relegated to footnotes in order not to interrupt the flow of the narrative. This work should thus serve as a tutor to the uninitiated and as a tool to facilitate the research of the seasoned professional.

An attempt has been made in this edition to avoid the legalisms that are so frustrating to the layman. Where, however, these were found to promote clarity and precision, rather than obscure it, they were not disturbed. The emphasis, particularly in the early chapters, is upon the more abstract and immutable aspects of patent law. As the work progresses, more frequent references are made to specific statutory implementation. While subject to change, the concreteness of the statute should reinforce the reader's grasp of the underlying principles.

The first edition of *Patent Law Fundamentals* was most enthusiastically received. Particularly gratifying is the apparent widespread

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use of the treatise by the judiciary; the book has been cited by numerous courts, including the United States Supreme Court. Also gratifying has been the response from those previously unfamiliar with patent law, some of whom assert that the work facilitated their entry into the profession.

The law has by no means stood still. Much has occurred in the interval between the book's first publication and the present edition. There is an entirely new Copyright Act which works fundamental changes in the scheme of copyright protection. Numerous new Rules of Practice have been put into effect. A plethora of court decisions has been generated, further defining and explaining the rights and duties of the public and patentees. Developments in the international arena have been even more dramatic and far-reaching—the European Patent Convention and the Patent Cooperation Treaty strongly support this assertion. No doubt some of these legislative and administrative changes will, at least in time, prove salutary. While there always will be room for improvement, unfortunately, not infrequently, that which is proffered in the name of "progress" or "reform" in practice has the diametrically opposite effect, particularly where the changes further complicate the law, place additional burdens upon suppliants, and divert precious professional time and clients' limited financial resources from the merits to formalities and peripheral issues. Reforms, however well intentioned, if too numerous or extreme, can sap the very vitality of the system they were intended to invigorate.

The author, too, has developed, having gained experience on both the technical and training fronts. Appointment to The George Washington University faculty—where the author conducts courses in patent law, both in the Continuing Engineering Education program and in the Graduate Department of Engineering Administration—has, through student input and feedback, placed many of the issues of patent law in a new perspective and heightened the author's awareness of other issues. It has also given the author some valuable insights into the learning process. It is to be hoped the experience gained thereby is reflected in this revised edition.

Although the author does not wish to be cast as an apologist for the status quo, he must confess his conscious effort to refrain
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from indulging in a discourse on what the law *should be*, the author being content to expose the law for what it is. No doubt, however, some of his own opinions have slipped into the text and he would, therefore, like to make it clear that this work is entirely his own doing and in no way represents the position of his employer. The author hopes this work will in some small measure serve to prevent letters patent from sharing the fate of letters of marque and reprisal, and to keep the flow of technological improvements coming.

Peter D. Rosenberg

Arlington, Virginia

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