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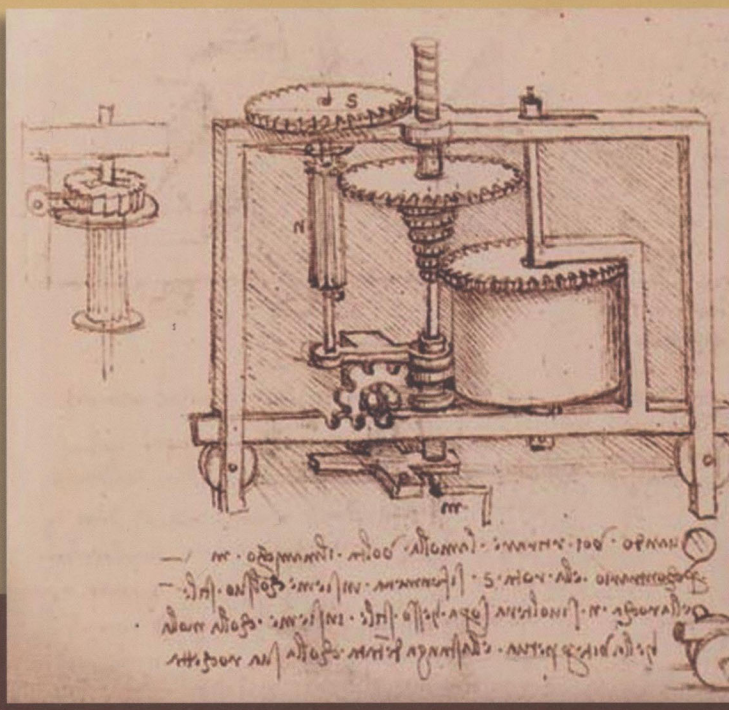
PATENT LAW

THIRD EDITION



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This book is dedicated to Judge Giles Sutherland Rich, 1904-1999, the consummate teacher whose passion for patent law and a life fully lived continues to instruct and inspire us all.

Preface

Preface to the Third Edition

One of the wonderful, if sometimes maddening, features of U.S. patent law is the speed at which it evolves. Driven by scientific and technological progress, public policy debate over the proper role of patents in our free market economy, intra-industry schisms regarding the need for legislative reform, and a steady stream of precedential decisions from the U.S. Court of Appeals for the Federal Circuit (having nationwide jurisdiction over appeals from virtually all patent decisions of the U.S. District Courts), U.S. patent law is never stagnant. The extensive new matter added to the third edition of *Patent Law* reflects this dynamic milieu.

In the three years following publication of the second edition, the rapidity of change in patent law has, if anything, escalated. The U.S. Supreme Court's grant of *certiorari* in several high-profile patent-related cases is undoubtedly the single most significant development. The decided trend of the Court's recent decisions has readjusted the balance of power away from patent owners and toward those who seek to challenge or avoid infringing patents. For example, in *eBay, Inc. v. MercExchange, L.L.C.*,[1] the Supreme Court clarified that the owner of a patent (like the owner of any other property right) is not automatically entitled to the remedy of permanent injunctive relief when infringement has been established. In *MedImmune, Inc. v. Genentech, Inc.*, [2] the Court expanded opportunities for challenging the presumptive validity and enforceability of issued patents under the Declaratory Judgment Act. In *KSR Int'l Co. v. Teleflex, Inc.*, [3] the Court eased the task of proving an invention's obviousness by rejecting inflexible applications of the traditional "teaching/suggestion/motivation" test for combining prior art teachings, highlighting the importance of "common sense" in evaluating an inventor's contribution, and elevating "foreseeability" as an additional criterion for consideration.

Among the hundreds of decisions rendered by the Federal Circuit in the past three years, *In re Seagate Tech., LLC* [4] undoubtedly carries the greatest practical impact, again tipping the balance of power in the

1 547 U.S. 388 (2006).
2 549 U.S. 118 (2007).
3 550 U.S. 398 (2007).
4 497 F.3d 1360 (Fed. Cir. 2007) (en banc).

patent system away from patent owners. The *en banc* court in *Seagate* raised the bar for establishing that an infringer's making or selling a claimed invention was willful, thus reducing the patentee's chances of recovering enhanced damages and attorney fees. Post-*Seagate*, the patent owner alleging willful infringement must establish that the infringer acted in an objectively reckless manner. In *In re Bilski*, [5] the *en banc* Federal Circuit attempted to resolve the continuing controversy over the patentability of business methods and establish a better-defined line between patentable process inventions and unpatentable abstract ideas or fundamental principles.

In contrast with the prodigious output of the Supreme Court and the Federal Circuit, Congress has twice failed to enact patent law reform bills in the period following publication of the second edition of this book. As the third edition goes to press, Congress has just introduced the Patent Reform Act of 2009 in both chambers, but prospects for its enactment remain uncertain. Internal contention between the technology and pharmaceutical/biotechnology sectors of the patenting community threatens once again to derail legislative reform efforts. More important, the need for sweeping legislative action is becoming increasingly less evident in the wake of judicial decisions dealing with many (if not all) of the contentious issues that have divided industry camps.

I am indebted to the many patent law students, academics, and practitioners whose feedback on the previous editions of this book has proved invaluable during the revision process. I gratefully acknowledge the research stipend support of the University of Pittsburgh School of Law and the outstanding research assistance of Helen Song (Pitt Law Class of 2009). Any errors are my own. Comments or questions concerning this book are welcome and should be e-mailed to the author at mueller2@pitt.edu.

Janice M. Mueller

March 2009

5 545 F.3d 943 (Fed. Cir. 2008) (*en banc*).

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