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Sixth Edition

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PATENT LAW AND POLICY: CASES AND MATERIALS

Sixth Edition

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MATTHEW  BENDER

PREFACE TO THE SIXTH EDITION

In the twenty-one years since the first edition of this casebook was published, the law of patents has undergone sweeping changes. Indeed, the pace of change seems to be getting even faster in recent years, as intellectual property becomes more important to the national and world economies, and as the fit between existing patent doctrine and modern business needs is reevaluated by a variety of judges, law yers, academics, and institutions.

Some of the forces of change were already at work when earlier editions of this book appeared. The preface to the First Edition stressed the importance of the Court of Appeals for the Federal Circuit, which has revolutionized and revitalized patent law. That court has continued to rise in importance and has now gained international stature as one of the preeminent institutions in the field. Later editions of this casebook also stressed the increasing international influence in the field. The 1994 adoption of the TRIPs agreement was a watershed that expanded the global reach of patent law and created a new framework for a transnational system of intellectual property. TRIPs has also created a focal point for international debate on the merits and demerits of patents in general. Though this textbook by its nature cannot capture the full scope of that debate.

The most important change since the publication of our prior edition in 2011 is of course the America Invents Act (AIA), the most important statutory change in patent law since the venerable 1952 Act. Our book has been comprehensively updated in light of the AIA. Highlights of the major changes include: (1) Detailed coverage of the new “first inventor to file” novelty rules, with analysis of new statutory provisions integrated into traditional case coverage under the 1952 Act; (2) Extensive discussion relating to the structure of the new AIA section 102, including categories of prior art under the AIA compared to the 1952 Act, as well as the critical (filing) date under the AIA versus traditional first to invent rules, and of course (3) The new AIA “public disclosure” grace period provisions, compared to the 1952 Act statutory bars.

We have also included in-depth description and discussion of all the major new administrative proceedings under the AIA: (1) Post-Grant Review; (2) The new Inter Partes Review (replacing inter partes reexaminations); (3) The Supplemental Examination (inequitable conduct “purging”) procedure; and (4) Derivation Proceedings.

The chapters of this book now also include concise discussions of many other features of the AIA. Examples include: the new prior commercial use (“prior user”) right, discussed in the section of Chapter 8 on Defenses to Infringement; the transitional Business Method Patent review proceeding, discussed in Chapter 2 on Patentable Subject matter; and the new virtual patent marking provision, integrated into Chapter 9, Damages.

Finally, we include coverage of new and recent Supreme Court cases, including *Mayo v. Prometheus* (section 101), *Globaltech v. SEB* (inducement to infringe), and *Stanford v. Roche* (patent ownership and the Bayh-Dole Act). Unfortunately, the important decision in *Association for Molecular Pathology v. Myriad Genetics, Inc.*, 2013 U.S. LEXIS 4540 (June 13, 2013) came out literally as we were going to press; an edited version of the case

PREFACE TO THE SIXTH EDITION

is included in the annual supplement emailed to all professors who teach from the book.

As with prior editions, we have strived to make patent law accessible to a wide audience of students and teachers. We have continued to include many diagrams and figures from the patent cases and, where possible, have selected cases involving relatively simple technologies. We have also provided concise explanations of the relevant legal principles and policies animating the various doctrines. Our philosophy has been to be as helpful as possible.

We also continue the tradition from prior editions of focusing attention on the underlying policies of patent doctrines. Patents have long been a subject of study among both legal scholars and economists. While this book is directed primarily toward a legal audience, it also covers the economic and other policy considerations that frequently control the direction of the law in the area. These policy discussions are intended both to serve a broader audience and to provide the book's core legal audience with a deeper understanding of forces shaping the law.

Finally we hope that, as with previous editions, this edition will imbue its readers with a love for the richness of this field. Patent law is directed to the ambitious goal of providing practical property rights in intellectual creation, and achieving that goal requires a society with sophisticated legal machinery. Not surprisingly then, patent law is still a young area — the entire field is no more than a few hundred years old — and like a new technology, it continues to evolve and become more intricate as it develops. Our aspiration is that this edition communicates some of the intricacy — and even beauty — of this fascinating and developing field.

In completing this book, we are indebted to many. Assistance was provided by a host of students, including Elliott Karr, Stefanie Lepore, James Holt, Alan Galloway, Prashant Thikkavarapu, and Margaret Ren Yi. For helpful comments and suggestions, we also thank Mark Lemley, Rebecca Eisenberg and Rochelle Dreyfuss.

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