FOREWORD

Irah Donner’s eighth edition of his *Patent Prosecution: Law, Practice and Procedure* is a timely reminder both of the need for a continuously updated source of guidance for patent prosecutors, as well as the substantial amount of change the America Invents Act has brought to the patent system. Irah’s prodigious efforts, reflected in this newest edition, address both the guidance needed, and the change imposed.

To say that *Patent Prosecution* is a comprehensive resource both for experienced patent practitioners, as well as new aspirants, is an understatement. This eighth edition continues to stay abreast of the many case law developments at both the Supreme Court and Federal Circuit levels, with appropriate ITC and district court law woven in. Additionally, Irah reaches beyond the case law that focuses on pure patent issues and integrates law from the other regional circuit courts to provide insight into how those courts are addressing patent concepts in related intellectual property doctrines such as trade secrets and copyrights. This makes it a well-organized, handy resource for prosecutors who know the ropes but simply need to put their hands on the latest law, efficiently.

For those new to the field, the complexities and nuances of the patent world can be daunting. Patent Prosecution speaks to these folks also, with an organization and coverage of case law that enable basic comprehension and entry at many points of Irah’s coverage.

Backing up all the new case law as well as the many historical cases and doctrines woven together with new developments in the courts, is the work of the U.S. Patent and Trademark Office. The USPTO, our nation’s innovation agency and keeper of the patent system, implements and applies the laws as announced by the courts. The USPTO makes public its work through its regulatory processes; the Manual of Patent Examining Procedure, and via various Guidelines and related documents. Irah’s eighth edition of Patent Prosecution encompasses all of these materials as well, with objective, fact-based explanation coupled with robust case law coverage. Integrating and organizing the range of actors and their actions bearing on the important tenets of patent practice, Irah’s treatise truly provides “one-stop shopping” covering the entire body of judicial and administrative pronouncements every practitioner must have.

As for change, it is fair to say we are now living, and practicing patent law in, the most dynamic period the U.S. patent system has ever seen.
That is a sweeping statement, but it is true, without exception, and without exaggeration. While a considerable amount of the recent change is attributable to the courts and to the USPTO as described above, it is without doubt that the passage of the America Invents Act in 2011, and its implementation through the most ambitious rulemaking exercise the USPTO has ever attempted during the subsequent 18 months, has driven the rate of change to an exponential level.

Again, enter Irah Donner and Patent Prosecution, Eighth Edition. Irah’s coverage of the AIA is both complete and comprehensive, with explanation of the new law and the USPTO’s implementing rules woven throughout the treatise in a fashion that provides the practitioner easy access to everything needed to counsel clients on patent prosecution strategies under the new AIA procedures, as well as in dealing with the new laws and rules to shepherd patent applications through the USPTO.

Thanks, Irah, for your continuing attention to this important work, and for your enormous undertaking in putting the eighth edition of Patent Prosecution in the hands of the patent community. Bravo!

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New York, NY
May 2013