PREFACE: NEW BEGINNINGS

This New Edition is current through April 2015, with selected additional developments through November 2015.

As we launch our Fourth Edition, we turn over a new leaf. While building on the legacy of our contributing authors and editors, we are also passing the reins to the next generation. We say “thank you” to Gary Hoffman, who has shepherded this book from its inception, and is now moving to Emeritus status. At the same time, we welcome our new contributors, who are adding valuable insight and analysis, and we thank the American Bar Association Section of Intellectual Property Law (ABA-IPL), which created and continues to support this treatise.

The past year has been one of orientation and adjustment for patent practitioners. The sweeping changes of the America Invents Act (AIA) and an interested Supreme Court have begun to settle in. Patent Trial Appeals Board (PTAB) challenges have become a new norm and practitioners have begun to acclimate and refine how these procedures can be used and how they interplay with district court litigation. In addition, the Supreme Court’s decisions regarding patentable subject matter, exceptional fee awards, claim construction, induced infringement and indefiniteness have begun to work their way through district courts across the land. Some of these changes (like exceptional fee awards) have wrought a sea change, while others (like definiteness) have had no significant effect on daily practice. This Fourth Edition addresses all of these legal developments and provides helpful suggestions for both patentees and accused infringers for navigating and utilizing these changes in law to their best advantage.

This Fourth Edition includes a new chapter devoted to biosimilars litigation (Chapter 9), which considers the rapidly-evolving case law regarding litigation under the Biologics Price Competition and Innovation Act (BPCIA) of 2009 to ensure that practitioners continue to adapt to new challenges. As this book goes to print, the Federal Circuit’s first substantive decision interpreting the BPCIA is still under review. In addition, this book includes an expanded chapter on biotechnology patent litigation (Chapter 10) and an updated chapter (Chapter 8) on Hatch-Waxman litigation from the Perspective of Pioneer Pharmaceutical Companies. This edition also includes a thoroughly new chapter (Chapter 35) on practice before the Patent Trials and Appeals Board (PTAB) to synthesize the learning and practical recommendations on the use of PTAB proceedings as an adjunct or alternative to patent infringement litigation.

This Fourth Edition has also been revised to reflect the new changes to the Federal Rules of Civil Procedure that are set to become effective on December
1, 2015 and the impact that those changes will have on practice (Chapters 14 and 25). Chapter 25 (The Judge’s Viewpoint) has also been significantly revised and updated to provide an interesting perspective on these new developments. Additionally, there are new and valuable updates on exceptional cases, induction of infringement, curbing abusive discovery, and Alice 101.

We are inspired by the enthusiasm and commitment of our ABA-IPL contributing authors to harness these changes into practical wisdom. For them, as for us, this book is a labor of love. We are mindful that this Fourth Edition is built on a strong foundation—the legacy of many authors and editors who came before us and to whom we owe a debt of gratitude. And, of course, we thank you, our readers, who make this possible and for whom this book exists. We hope that you find it useful and helpful and we welcome your thoughts for any suggestion or improvements. Happy reading.

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