

Preface

*This Third Edition is current through May 2018
with significant additional developments through June 2018.*

Drafting and prosecuting patent applications is a demanding profession. A successful patent practitioner must be intimately familiar with, and able to navigate, the complex statutes and rules that govern patent practice. But that is not enough. In recent years, the Supreme Court has shown little hesitation to accept patent cases and issue decisions that fundamentally change previous understandings of patent law. Even more frequently, the U.S. Court of Appeals for the Federal Circuit, which has appellate jurisdiction over patent cases, generates opinions that affect the impact of a practitioner's drafting and prosecution decisions. In sum, patent practice is full of traps for the unwary. To succeed, a practitioner must stay well-informed. This THIRD EDITION of DRAFTING PATENTS FOR LITIGATION AND LICENSING continues to provide practical guidance.

The THIRD EDITION explains and emphasizes techniques that produce patents that may have broader interpretations and strengthened validity, which may have more impact in litigation, and which may face less resistance by licensing targets. Chapters include real life examples taken from court decisions, especially those from the Federal Circuit, in which patents were interpreted, enforced, or licensed in a way that was either beneficial or detrimental to the patentee. Based on the lessons learned from those opinions, grouped into clearly identifiable principles and areas of technology, this book provides detailed advice for drafting patents so as to avoid problems and maximize leverage in litigation and licensing.

The THIRD EDITION contains analysis of key developments in patent drafting and licensing since publication of the SECOND EDITION, including:

- The U.S. Supreme Court's ruling in *Nautilus, Inc. v. Biosig Instruments*, which declared "reasonable certainty" to be the standard for judging whether a patent claim is definite;
- The Federal Circuit's and the U.S. Supreme Court's decisions in *Akamai Technologies, Inc. v. Limelight Networks, Inc.*, regarding what is required to establish direct infringement of method claims;

- *Williamson v. Citrix Online*, which made it easier to invalidate claims with means-plus-function clauses;
- How recent patent-eligibility decisions following the U.S. Supreme Court's decision in *Alice Corp. v. CLS Bank*, such as *Bascom*, *Enfish*, *Amdocs*, and *McRO*, can help with patent procurement and validity challenges; and
- Developments in Inter Partes Review and Covered Business Method Review proceedings including *Cuozzo*, *Shaw Industries*, and *Blue Calypso*.

New discussions added in 2018 include:

- Consideration of Supreme Court decisions on the PTAB's authority and scope of review (*Oil States Energy Services, LLC v. Greene's Energy Group, LLC*, confirming Congress's authority to create the PTAB trial system, and *SAS Institute Inc. v. Iancu*, rejecting the USPTO's argument that its practice of partial institutions was unreviewable);
- *Travel Sentry, Inc. v. Tropp*, where the Federal Circuit noted "the importance of correctly identifying the relevant 'activity' or 'benefit' that is being conditioned upon the performance of one or more claim steps"; and
- An expanded and updated discussion of harmonization of different national approaches to patents, the Unified Patent Court in Europe, and forum shopping when litigating in Europe.

Changes in the law need to be taken into account when drafting patents or when defending a patent during a reexamination proceeding before the USPTO. This THIRD EDITION aims to educate patent practitioners in meeting such challenges.

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