

Patent Law and Practice, Fourth Edition

By, Herbert F. Schwartz

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Introduction

The roots of Patent law are thousands of years old.¹ The founding fathers of the United States accepted the concept of patents incorporating it into the constitution.² Congress passed the first patent act in 1790. Since then patent law has undergone significant changes, and recently Congress and the courts made many revisions to the patent system in the United States, making it a complex area of the law today.

Before 1980, the Federal Circuit Courts suffered from a great lack of uniformity in administering patent laws.³ Congress addressed this problem in 1982 by creating the Court of Appeals for the Federal Circuit (CAFC). The CAFC and the Supreme Court have issued many important decisions affecting patent trial procedures and bringing some uniformity to patent law.

A book commissioned by the Federal Judicial Center in 1986 assists in bringing uniformity to Patent law. This book, written by Herbert F. Schwartz, has been very influential, informing Supreme Court Justices, Judges, and lawyers in the field of patent law.⁴ Law review and Journal articles are also greatly impacted by this book.⁵ This book

¹ Patent law and practice page 1 FN 2

² U.S. Constitution Art I. Sec. 8.

³ Patent law and practice page 4 Fn 20-21.

⁴ *Markman v. Westview Instruments Inc.*, 517 U.S. 370, 373-74 (1996).

in cited and used widely for several reasons. First, *Patent Law and Practice* is distributed to judges and law clerks by the Federal Judicial Center. Second, this book is easy to read as an overview of patent law litigation. Third, extensive footnotes accompany the text of the book, citing relevant cases on important aspects of patent law, and providing a valuable tool for lawyers preparing for patent litigation.

Analysis

The Fourth Edition of *Patent Law and Practice* covers the recent changes in patent law by the Supreme Court, and the Federal Circuit.⁶ The Supreme Court's rulings affected the areas of prosecution-history estoppel and federal subject matter jurisdiction for patent infringement counterclaims.⁷ The rulings from the CAFC affected many more areas of patent law and are discussed throughout the book.⁸

Many judges hearing patent cases are not scientists, and therefore patent litigation presents a large challenge with the complexity of patent law, often accompanied by complex technology. Judges needed a concise guide to patent law. Schwartz, in *Patent Law and Practice* fills this role very well. Schwartz, in the first two chapters, briefly covers the history of patent law, and the process of obtaining a patent. Chapter three covers civil procedure issues which relate to patent litigation. Then Schwartz gives an overview of the patent statute. The judicial interpretation of the patent statute is briefly discussed, to provide an understanding of what is patentable, and when it is patentable.

⁵ At least 30 articles in law reviews and journals rely on *Patent Law and Practice* as a source. *See e.g.*, William F. Lee & Anita K. Krug, *Still Adjusting to Markman: A Prescription for the Timing of Claim Construction Hearings*, 13 HARV. J.L. & TECH. 55, 72 (1999); Eric C. Harrell, Note, *Markman v. Westview Instruments, Inc.*, 23 OHIO N.U. L. REV. 1029, 1036 (1997).

⁶ *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722 (2002).

⁷ *Festo Corp.*, 535 U.S. 722; *Holmes Group Inc. v. Vornado Air Circulation Systems, Inc.*, 535 U.S. 826 (2002).

⁸ *See Patent Law and Practice*, pg 7.

In chapter five, Schwartz provides a current method for approaching Markman Hearings. In a Markman Hearing, the judge determines the meaning of the patent in dispute, and rules on the meaning of any disputed terms in the claims of the patent. This process can be very difficult because the judge determines the meaning of technical material, as viewed by a person with ordinary skill in the technology. In a Markman Hearing, the meaning of the claims in the patent are determined. The claims set the boundaries of the patent holder's exclusive right.

The next two chapters, six and seven, cover infringement of the patent, giving a brief overview of patent infringement charges, and the defenses to patent infringement. There are two main defenses to patent infringement charges, a defense that the claims of the patent are not infringed, and an attack on the patent to declare the claims of the patent invalid and unenforceable. Another set of defenses, if successful, make the patent unenforceable because of the conduct of the patent holder. These judicially created defenses are: inequitable conduct before the Patent and Trademark Office; patent misuse, laches, and estoppel. Schwartz discusses each of these equitable defenses briefly. When these defense are successful, the patent owner will not recover, even if the patent is held valid and infringed.

In chapter eight, Schwartz outlines the remedies available to the patent owner, and what is required to obtain the remedy. The patent owner is granted a limited exclusive right to the patented invention. With the patent as an exclusive right, the patent holder may seek an injunction against the infringing activity. Further the court may award damages of lost profits, or it may award damages in the form of a reasonable royalty. In some circumstances, however, to enforce this exclusive right, the patent holder must take

steps to give notice of the patent right by marking the product as patented. In other circumstances, where the intention of the infringer can be shown to be willful, the patent holder can recover triple the damages proved in court.

The final chapter of the book addresses jury trials in patent cases. The attorneys and judges in patent cases face a challenge to inform and instruct juries when the technologies in the case are complex. Schwartz in this chapter assembles a list of suggestions from experienced judges and commentators. The suggestions will aid judges when deciding the format of the case. Twenty-one of these suggestions are offered with comments, some of the suggestions are admittedly radical. One of these suggestions is to have the jury deliberate and discuss the evidence as the trial goes along. Although the involvement of juries in patent trials has been increasing, there is a debate of whether juries should be part of patent trials at all, and what role the juries should play in a patent trial. The author highlights these issues in his final chapter by offering the suggestions to judges. These suggestions, if followed would be a significant departure from the normal role of a jury.

Conclusion

Herbert F. Schwartz provides a useful tool to Judges and lawyers who will be involved in patent litigation. This book is also an excellent overview of patent law for the uninitiated student seeking to learn patent law. The extensive footnotes supplement an overview of patent law, giving comment and citations to recent cases on each and every issue discussed. This book is recommended to all who are looking for a primer on patent law and patent litigation.