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Introduction to the 2018–2019 Edition

Every edition of the Patent Law Handbook provides topical discussions of U.S. patent law issues. With respect to a particular consideration, any pertinent constitutional, statutory and/or regulatory authority is presented along with an overview of the corresponding jurisprudence. Where the U.S. Supreme Court and/or the U.S. Court of Appeals for the Federal Circuit has decided an appeal on a specific patent law issue during the period from June 2017 through May 2018, a detailed consideration of that decision is also provided as new material in this edition. In addition, certain regional circuit and state court opinions related to patent law issues are also presented.

In particular, during this past publication cycle, the U.S. Supreme Court decided three patent appeals from the U.S. Court of Appeals for the Federal Circuit from June 2017–May 2018. The U.S. Supreme Court decided a fourth case in June 2018. These decisions addressed issues including: remedies available under the Biologics Price Competition and Innovation Act of 2009 (BPCIA); the constitutionality of inter partes reviews under Article III and the Seventh Amendment; the scope of inter partes reviews that are instituted and the impropriety of the PTAB instituting only as to some but not all of the claims challenged; and entitlement to infringement damages based on sales of products overseas that were made in the United States and shipped abroad. These cases are discussed in the respective substantive chapters as well as collectively being presented in Chapter 10 under the Supreme Court section of that chapter.

Among the significant decisions of the U.S. Court of Appeals for the Federal Circuit were issues involving the jurisprudence pertaining to unenforceability, damages, exceptional cases, the on-sale bar, and further refinement of the law pertaining to patent venue following the Supreme Court’s decision in T.C. Heartland from the previous year. A robust jurisprudential development also continues with respect to procedural aspects of inter partes review and covered business method review including with regard to standing to appeal Board decisions, intervention by the U.S.P.T.O., and
burdens of proof and persuasion as to, for example, amend-
ments to patent claims under review. The Federal Circuit
also provided further discussion regarding substantive is-
ues relating to patentable subject matter and obviousness.
Decisions from the regional U.S. courts of appeals also helped
to further refine the law related to antitrust issues pertain-
ing to patent rights, particularly in the realm of pharmaceu-
tical patents.

In this edition, we have also added sections in Chapter 9
pertaining to patent issues litigated in the U.S. Tax Court
and the U.S. Federal Trade Commission.
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Jeff E. Schwartz is a Partner in the Washington, DC office of Fox Rothschild LLP, where he specializes in patent litigation, patent procurement and post grant proceedings and client counseling for mechanical and electrical systems, medical devices, and software systems. He also counsels clients on intellectual property issues implicated by government contracts. In addition to his law degree magna cum laude from Georgetown University, he holds an M.S. in Systems Management and a B.S. from the U.S. Military Academy (GO ARMY). He is a former judicial clerk to Senior Circuit Judge Daniel M. Friedman of the U.S. Court of Appeals for the Federal Circuit. He is also a retired Lieutenant Colonel from the U.S. Army and was an engineering manager with the Navy Sea Systems Command and a senior project engineer at Hercules Aerospace. Mr. Schwartz is a member of the adjunct faculty at William & Mary Law School, where he teaches an Advanced Patent Seminar regarding patent litigation and post-grant reviews. Mr. Schwartz has also taught at the University of Maryland School Of Law and as a visiting professor and guest lecturer at other universities. Mr. Schwartz is also a frequent public speaker and has published several articles concerning intellectual property and government contract law as well as general patent and intellectual property law topics. He has been named as one of Washington, DC’s Top AV Rated Lawyers for many years.

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The statements and inferences in this edition reflect the opinions of the authors alone, and none of the expressions or implications contained herein should be attributed to any other persons or entities.

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