

Preface

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. And beyond bare principles that can be gleaned from review of judicial opinions, statutes, and rules, there are many practical considerations that flow from experience in the profession. In sum, patent practice is full of traps for the unwary. To succeed, a practitioner must stay well informed. This fourth edition of *Drafting Patents for Litigation and Licensing* continues to provide practical guidance.

The fourth 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.

An astute reader will notice that many ideas and concepts are repeated throughout many chapters of this book. That is no accident, as the same law applies to patents across technological subject areas, and many basic principles transcend differences in technology. However, different technologies can impose different twists on how that law may be applied. Chapters of the fourth edition help to guide practitioners in that regard.

I want to sincerely thank all of the authors who have contributed to the fourth edition. Their efforts took place in the midst of a global COVID-19 pandemic that forced new working arrangements and uncertainties

on the profession as whole. The authors, who are themselves patent practitioners with a wealth of professional experience, have helped to keep this work relevant and helpful to colleagues everywhere. Some authors are new to the team for the fourth edition. Several of those new authors have assumed responsibility for Chapters 2 (Pitfalls in Patent Drafting), 5 (Mechanical Patents), and 6 (Electrical Patents) to build on the able work of their predecessors while also bringing a fresh perspective. In Chapters 7 (Software, E-Commerce, Internet, and Business Method Patents) and 12 (Drafting U.S. Patents with a View toward Europe), new co-authors are helping keep those chapters fresh and insightful.

Finally, I would like to thank Brad Wright, the editor in chief of the first two editions of this book and an author of chapters in the first three editions. In those roles, he helped define a framework for this book and set a high bar for content and quality. And as a law firm colleague during much of my career as a practicing patent lawyer, his guidance has been invaluable.

H. WAYNE PORTER
Banner & Witcoff, Ltd.
Washington, D.C.
May 2021