

**Interview with Professor Janice Mueller, John Marshall Law School
Conducted by JHTL Staff Member Kyle J. Paine, October 2003**

Professor Mueller is the author of An Introduction to Patent Law, Aspen Publishers Inc., 2003, ISBN 0735529213, \$48.00, pp. 398.

JHTL:*How has the reaction been from students who have read your book? Do you think the book has met your goal of helping to make patent law less mysterious? Why or why not?*

JM: I've had some very positive feedback from law students, both from my own law school and elsewhere. Some students have specifically mentioned that they found the book helpful in preparing for the USPTO bar exam. While my book does not substitute for the more procedurally-oriented and detailed materials that students would receive in a prep course specifically designed for that exam, *An Introduction to Patent Law* will explain the basic statutory and case law framework which those PTO regulations and policies implement. I've also had positive comments from non-lawyer engineers and scientists who regularly deal with patent issues on the job. Making patent law less mysterious and more straightforward was certainly one of my primary goals in writing the book. I tried to focus on first principles, used easy-to-follow explanations, and provided a glossary of terminology. As I often tell my students, half the battle in understanding patent law is getting a grip on its unique lingo.

JHTL:*In an interview with the Bimonthly Review of Books, you said that you thought the U.S. should move to a first-to-file approach to patents as opposed to first-to-invent. Why are such reforms important? What other reforms/approaches would you like to see?*

JM: The U.S. is currently the only country in the world that adheres to a first-to-invent system. Although it may be more fair to individual inventors with fewer resources than corporate patent applicants, our system necessitates an awfully byzantine system of determining priority of invention that is unknown anywhere else in the world. Is it really worth the cost? In a very great majority of cases, the party who was first to file her U.S. patent application winds up being adjudicated the first to invent, anyway. For the time being, it appears that the U.S. will retain its first-to-invent system. But if the rest of the world could agree to implement a U.S.-style pre-filing grace period¹, something which is under discussion in Europe and elsewhere, I would hope that the U.S. would seriously consider changing our system.

¹ See 35 U.S.C. § 102 (b) (2000 & Supp. 2003).

JHTL: *Is there an area of patent law that was too difficult or unchartered to include in your book? How do you go about teaching that topic to your students?*

JM: My book really only scratches the surface, which is by necessity given the page-length limitations for a single-volume softcover work. Certain more esoteric topics such as double patenting, design patents, prosecution procedures, and interference proceedings are not covered in any significant depth. I'm hoping that we'll get to add more depth to these and other areas in subsequent editions of the book. These are also topics that we usually don't have time to discuss in any detail in a basic 3-credit patent law class. Fortunately, at schools like John Marshall and Suffolk, which offer LLM programs in Intellectual Property, students can take additional course work in these more advanced areas of patent law.

JHTL: *What place do you think the topic of patent law has in the modern legal education?*

JM: Patent law is not (and likely never will be) on any state bar exams, but nevertheless it's a subject that has become a lot more "mainstream" and of interest to larger number of students than when I began teaching in 1995, and certainly than when I took patent law in the late 1980s. I now routinely have a number of students in my patent law classes who do not have a technical or scientific background, but who want to practice in the high technology economy and realize that having some basic grounding in intellectual property law, including patent law, is an integral part of that type of practice. Many more people are also becoming interested in patent law because of its international dimensions. Consider the current global debates on the enforcement of patented pharmaceuticals for the treatment of life-threatening illnesses such as HIV/AIDS, malaria, TB, and the like. The developing and least-developed countries have very different views about the role of patent protection in these crisis areas than do industrialized nations such as the U.S. It makes for very interesting policy debate as well as practical implementation disputes.

JHTL: *How have the theories, reasons and strategies behind teaching patent law changed since you taught at Suffolk University Law School in 1996 and 1997?*

JM: Today I make a concerted effort to include more international/comparative treatment of patent law topics than I did when I began teaching. My own experience in that area has been enhanced by spending time in Munich, Germany studying the European patent system. Patent law case books are now including more international material. Moreover, as our information economy becomes increasingly global, I think it's become much more important for students to

understand that our U.S. patent system is not the only way of doing things. We can see the weaknesses in our own system by comparing how things are done elsewhere. For example, many U.S. patent experts have advocated the adoption of a robust European-style post-grant opposition system.

JHTL: *Are there any issues currently being litigated that might help students with an interest in patent law?*

JM: A current “hot topic” that may be of interest to many students is the Federal Circuit’s treatment of willful patent infringement and the use of opinions of counsel. On September 26, 2003, the court surprised the patent community by *sua sponte* taking a case *en banc* in order to revisit what many thought was long-settled law concerning the drawing of adverse inferences, with respect to willful patent infringement, based on the actions of the party charged with infringement in obtaining legal advice, and withholding that advice from discovery. In particular, the court in *Knorr-Bremse v. Dana Corp*² has asked for briefing on the following issues:

1. When the attorney-client privilege and/or work product privilege is invoked by a defendant in an infringement suit, is it appropriate for the trier of fact to draw an adverse inference with respect to willful infringement?
2. When the defendant has not obtained legal advice, is it appropriate to draw an adverse inference with respect to willful infringement?
3. If the court concludes that the law should be changed, and the adverse inference withdrawn as applied to this case, what are the consequences for this case?
4. Should the existence of a substantial defense to infringement be sufficient to defeat liability for willful infringement even if no legal advice has been secured?

JHTL: *How would you characterize the change in types issues being litigated in patent law now as opposed to, say, ten years ago?*

JM: The U.S. Supreme Court has taken a renewed interest in patent law over the past ten years. For example, since 1996 we’ve had a trio of Supreme Court cases that have virtually revolutionized U.S. patent enforcement litigation: *Markman v. Westview*³, *Warner-Jenkinson v. Hilton Davis*⁴, and most recently *Festo v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*⁵ The Supreme Court has also

² 344 F.3d 1336 (Fed. Cir. 2003).

³ 517 U.S. 370 (1996).

⁴ 520 U.S. 17 (1997).

⁵ 535 U.S. 722 (2002).

granted cert. in areas where no one really thought they would: e.g., the on sale bar of 35 U.S.C. 102(b) (2000 & Supp. 2003) (*Pfaff v. Wells*⁶), and utility patents for plants (*JEM Ag v Pioneer HiBred*⁷).

JHTL: *What is the next writing project(s) you are working on?*

JM: I find patent law so interesting and exciting to write and research in because new issues constantly develop and areas of law we thought were well-settled are suddenly back in turmoil. There is never a shortage of topics. I think the willful infringement issues mentioned above are great fodder for scholarship. We've also had some recent case law development concerning the experimental/research use exception to patent infringement, another problematic area where the U.S. law is different from that of the rest of the world. The way in which the Federal Circuit is using dictionaries to interpret patent claims is a hot topic. The problem of patent protection on technology that becomes an "industry standard" is also a juicy one. I'll be teaching Antitrust Law starting spring 2004 so the intersection of the IP laws and antitrust is of great interest to me.

JHTL: *Can you recommend a book that would be a logical 'next step' to read after your introductory text?*

JM: The leading scholarly work on U.S. patent law is Chisum on Patents⁸. It's a 16-volume looseleaf treatise. For shorter works, I think Robert Harmon's Patents and the Federal Circuit⁹ is excellent. There are a number of great patent law and litigation case books on the market now, too, which can make very helpful references.

###

Janice Mueller can be reached at 7mueller@jmls.edu.

⁶ 525 U.S. 55 (1998).

⁷ 534 U.S. 124 (2001).

⁸ DONALD S. CHISUM, CHISUM ON PATENTS (Matthew Bender and Co., Inc. 1997).

⁹ ROBERT L. HARMON, PATENTS AND THE FEDERAL CIRCUIT (BNA Books 5th ed. 2001).