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Rethinking Assignor Estoppel

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Stanford Law School

Commentator:

Ed Fein

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THURSDAY, MARCH 24, 2016

THE CORONADO CLUB

919 Milam Street
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Reception 5:30 p.m.

Lecture 6:15 p.m.

One Hour of CLE Credit

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Prior Spring Lectures

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Jeanne Fromer, New York University School of Law
Should the Law Care Why Intellectual Property Rights Have Been Asserted?

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Julie E. Cohen, Georgetown University
Post-Industrial Property

2013

David McGowan, University of San Diego School of Law
The Unfallen Sky: Assessing the Relative Effectiveness of Legal and Market Adaptations to Technological Change

2012

R. Anthony Reese, University of California-Irvine, School of Law
What Does Copyright Law Owe the Future?

2011

Paul Goldstein, Stanford Law School
Copyright on a Clean Slate

2010

Douglas Lichtman, UCLA School of Law
Pricing Patents: The RAND Commitment

2009

William O. Hennessey, University of New Hampshire School of Law
Thirty Years (and More) of IP in China: A Personal Reflection

2008

Robert Merges, University of California Berkeley School of Law
The Concept of Property in the Digital Age

2007

Joel Reidenberg, Fordham University School of Law
The Rule of Intellectual Property Law in the Internet Economy

2006

Hon. Arthur J. Gajarsa, United States Court of Appeals for the Federal Circuit
Patents in a Changing Economy

2005

F. Scott Kieff, Washington University in St. Louis School of Law
Theory & Practice in Commercializing Innovation

2004

Jane Ginsburg, Columbia University School of Law
The Right to Claim Authorship



Mark Lemley is the William H. Neukom Professor of Law at Stanford Law School and the Director of the Stanford Program in Law, Science and Technology. He teaches intellectual property, computer and internet law, patent law, trademark law, antitrust, and remedies.

Professor Lemley is the author of seven books (most in multiple editions) and 146 articles on these and related subjects, including the two-volume treatise *IP AND ANTITRUST*. His works have been cited more than 200 times by courts, including 11 United States Supreme Court opinions, and more than 13,000 times in books and law review articles, making him one of the five most cited legal scholars of all time. He has published nine of the 100 most-cited law review articles of the last 20 years, more than any other scholar, and a 2012 empirical study named him the most relevant law professor in the country.

His articles have appeared in 22 of the top 25 law reviews and in multiple peer-reviewed and specialty journals. They have been reprinted throughout the world and translated into Chinese, Japanese, Korean, Spanish, Italian, and Danish. He has taught intellectual property law to federal and state judges at numerous Federal Judicial Center and ABA programs, has testified seven times before Congress, and has filed numerous amicus briefs before the U.S. Supreme Court, the California Supreme Court, and the Federal Circuit courts of appeals.

Professor Lemley clerked for Judge Dorothy Nelson on the United States Court of Appeals for the Ninth Circuit. He is a founding partner of Durie Tangri LLP, litigating and counseling clients in all areas of intellectual property, antitrust, and internet law. He also is a founder and board member of Lex Machina, Inc., a startup company providing data and analytics regarding IP disputes to law firms, companies, courts, and policymakers.

In his spare time, he enjoys cooking, travel, yoga, and feeding his addiction to video games (at this writing, *Witcher 3: Wild Hunt*).

Rethinking Assignor Estoppel

As patents have become increasingly important in society, we have focused more attention on the problem of bad patents. The Supreme Court and the Federal Circuit have repeatedly emphasized the public interest in testing the validity of patents, weeding out patents that should not have been issued. And Congress has created a number of new mechanisms to make it quicker and easier to identify and eliminate invalid patents.

But there is one important group of people the law systematically prevents from challenging bad patents. Curiously, it is the very group who may have the most insight into the problems with the patent: the inventors themselves. The century-old doctrine of assignor estoppel precludes inventors who file patent applications from later challenging the validity or enforceability of the patents they receive. The stated rationale for assignor estoppel is that it would be unfair to allow the inventor to benefit from obtaining a patent and later change her tune and attack the patent when it benefits her to do so. But the Federal Circuit has expanded the doctrine in a variety of dimensions and applied it even when the benefit to the inventor is illusory. Further, the doctrine misunderstands the role of inventor-employees in the modern world. And it interferes substantially with the goals of both employee mobility and the assessment of patent validity.

It is time to rethink the doctrine of assignor estoppel. The doctrine in its current expanded form is out of touch with the realities of both modern inventing and modern patent law, and it interferes with both the invalidation of bad patents and the goal of employee mobility. I explore whether the doctrine can and should be saved in a more limited form.

THE ANDREWS KURTH LECTURES

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