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Practice

Patents, Patent Litigation, Patent Settlement and Dispute Resolution, Licensing, Antitrust Matters involving Intellectual Property

Professional Experience

Luce, Forward, Hamilton & Scripps, 2006-2007
Gray Cary Ware & Freidenrich, 1997-2004
Fish & Neave, 1973-1976 (New York), 1994-1997 (Palo Alto)
Genentech, Inc., Associate General Counsel, 1980-1982
Townsend and Townsend, 1976-1980, 1982-1993

Bar Admissions

California, New York, U.S. District Courts for the Northern, Central, Eastern, and Southern Districts of California, U.S. Court of Appeals for the Federal Circuit, U.S. Court of Appeals for the Ninth Circuit, U.S. Supreme Court, U.S. Patent & Trademark Office

Education

J.D., Stanford Law School (1973)
B.A., Northwestern University (with highest distinction, chemistry major, 1969)

Books

Patent Law: Legal and Economic Principles, West Group (1992, Second Edition 2003, supplemented annually)

Settlement of Patent Litigation and Disputes: Improving Decisions and Agreements to Settle and License, ABA Publishing (2011)

Licensing Intellectual Property, Legal, Business and Market Dynamics, John Wiley & Sons (1996)

Licensing Intellectual Property, Antitrust Limits on Licensing in the United States, the European Union and Japan, John Wiley & Sons (1999)

Chapter VIII, Antitrust Issues Involving Intellectual Property: Patents, Copyrights, Trademarks and Trade Secrets, Antitrust Law Developments (Second) (1983 ed.), American Bar Association (principal author)

Chapter, Antitrust and Related Constraints on Patent Licensing Strategy, Inside the Minds: Antitrust Law Deal Strategies, Aspatore Books (Boston 2007)

Legal Articles

“Tying Arrangements Involving a Patent License,” Current Trends In Domestic and International Licensing of Technology, Practising Law Institute (No. 112, 1979)

“An Introduction to the Antitrust and Misuse Limits on Commercial Exploitation of a Patent,” Banbury Report 10: Patenting of Life Forms (1982)

“The Patent Arbitration Law: A New Procedure for Resolving Patent Infringement Disputes,” American Arbitration Association, The Arbitration Journal (1985)

“Judicial Regulation of Patent Licensing, Litigation and Settlement under Judicial Policies Created in *Lear v. Adkins*,” American Intellectual Property Law Association, Selected Legal Papers (1985)

“Some Thoughts on the Law And Economics of Government Regulation of Licensing Patent and Related Intellectual Property Rights in the United States, the EEC and Japan,” American Intellectual Property Law Association, Continuing Legal Education Institute, February 3-5, 1986

“A *Lear v. Adkins* Allegory,” 28 Journal of the Patent and Trademark Office Society 427 (1986)

“Some Thoughts on the Law and Economics of Licensing Biotechnology Patent and Related Property Rights in the United States,” Technology Licensing 1987 (Practising Law Institute 1987), pages 333-385, and 69 Journal of the Patent and Trademark Office Society 263 (1987)

“Comments on Reverse Engineering and Patents,” Reverse Engineering: Legal and Business Strategies (Prentice Hall, 1992)

“If Economic Welfare Is the Goal, Will Economic Analysis Redefine Patent Law?” 4 Journal of Proprietary Rights 12 (Prentice Hall, 1992)

“Department of Justice Antitrust Policy, Economic Growth, and Intellectual Property Licensing,” Intellectual Property/Antitrust 1993 (Practising Law Institute, 1993)

“Biotechnology and the Patent System: Patent Law and Procedures for Biotechnology, Health Care and Other Industries,” 4 University of Baltimore Intellectual Property Law Journal 121 (1996)

“Does Patent Law Make Sense? The Relationship between Patent Policies and Patent Statutes and Decisions,” American Bar Association, Patent, Trademark and Copyright Law: Litigation and Corporate Practice (1999)

“Measuring Patent Damages by the Market Value of Inventions Given Available Noninfringing Substitute Technology – The *Grain Processing*, *Rite-Hite* and *Aro* Rules,” 82 Journal of the Patent and Trademark Office Society 503 (2000)

“An Introduction to United States Antitrust and Other Legal Restraints on Exploitation of Patents and Other Intellectual Property Rights,” Federated Press (2001)

“The Law, History, and Policy of Prosecution History Estoppel in Patent Actions in the United States Supreme Court – Implications for *Festo*,” 84 Journal of the Patent and Trademark Office Society 581 (Part I) and 692 (Part II) (2002)

“Antitrust and Competition Law Limits on Licensing Practices in the European Union, Japan, and the United States,” Advanced Licensing Agreements 2004, Practising Law Institute, 2004)

“Antitrust Limits on Licensing in Japan,” Advanced Licensing Agreements, Practising Law Institute, (2006, 2007, 2008)

“Patent Licensing, What to Do after *Medimmune v. Genentech*,” 89 Journal of the Patent and Trademark Office Society 341 (2007)

“The New Patent Exhaustion Doctrine of *Quanta v. LG* - What It Means for Patent Owners, Licensees and Product Customers,” 90 Journal of the Patent and Trademark Office Society 758 (2008)

“Patent Damages, the Patent Reform Act and Better Alternatives for the Courts and Congress,” 91 Journal of the Patent and Trademark Office Society 19 (2009)

“The Supreme Court, *Bilski*, and Sensible Limits on Patents,” 91 Journal of the Patent and Trademark Office Society 523 (2009)

Scientific Article

“Synthesis of Bicyclo-5,4,0-Undecanones Via Olefin Cyclization,” Marshall, J.A., Andersen, N.H., Schlicher, J.W., Journal of Organic Chemistry, 35 (3) : 858, 1970

Awards and Honors

Phi Beta Kappa

Sigma Xi (national scientific research honorary society)

Phi Lambda Upsilon (national chemistry honorary society)

Joseph Rossman Memorial Award of the Patent and Trademark Office Society (2001, 2009)

Marple-Schweitzer Award of the Chemistry Department of Northwestern University

American Institute of Chemists Medal

Teaching and Lectures

Stanford Law School, Lecturer, 1993-1995 (patent law)

School of Law, University of California Berkeley, Lecturer, 1995, 1997-present (licensing strategy)

Biotechnology patents, international licensing, patent settlement, Stanford Law School, 1995, 2005, 2010

Various licensing and patent topics, Practising Law Institute, 1979, 1982, 1987, 1993, 2004, 2005, 2006, 2007, 2008

Antitrust and intellectual property, Conference Board, 1988, 1989, 1990, 1992

Patent litigation and patent damages, American Conference Institute, 2002, 2003

Patent policy, Science and Technology Advisory Board, National Academy of Sciences

Patents and economics, National Bureau of Economic Research

Patent settlement, American Bar Association, 2011

Testimony before Congress and Government Agencies

United States Patent and Trademark Office, Hearings on Patent Protection for Biotechnological Inventions (October 17, 1994)

Senate Judiciary Committee, Hearings on the National Productivity and Innovation Act, S. 1841, and the Patent Law Improvements Act, S. 1535 (S. Hrg. 98-1008, April 3, 1984)

Federal Trade Commission, Hearings on the Intellectual Property Marketplace (May 5, 2009)

Comments on Patent Damages, Injunctions, Recent Supreme Court Patent Decisions, and Other Issues Identified in the FTC Notice of Hearings on the Intellectual Property Marketplace (May 16, 2009)

Technical Work Experience

Syntex Corporation, Research Scientist, Palo Alto, California, 1969-1970

Stanford University, Research Fellow, PhD program, Department of Chemistry, 1969

Citations

Grain Processing Corp. v. American Maize-Products Company, 185 F.3d 1341, 1351 (Fed. Cir. 1999)(Rader, J.)("Moreover, only by comparing the patented invention to its next best available alternative(s) - regardless of whether the alternative(s) were actually produced and sold during the infringement - can the court discern the market value of the patent owner's exclusive right, and therefore his expected profit or reward, had the infringer's activities not prevented him from taking full economic advantage of this right.... John W. Schlicher, *Patent Law: Legal and Economic Principles* § 9.05[2][1] (1997)."), *aff'ing*, *Grain Processing Corp. v., American Maize-Products Co.*, 893 F.Supp. 1386 (N.D. Ind. 1995)(Easterbrook, J.)

Matter of Mahurkar Double Lumen Litigation, 831 F. Supp. 1354, 1384 (N.D.Ill. 1993)(Easterbrook, J.)("The correct way to compensate Firm #1 is to award it \$3 times the number of units it would have sold had there been no infringement - or to put it differently, the monopoly output times the monopoly profit, a profit made lawful by the patent. The patent holder does not receive the monopoly price times the competitive output. *See generally* John W. Schlicher, *Patent Law: Legal and Economic Principles* § 9.05 (1992). * *
* A patent conveys the right to exclude others from making, using, or selling the invention, and this right implies the propriety of an injunction enforcing exclusivity. The injunction creates a property right and leads to negotiations between the parties. A private outcome of these negotiations--whether they end in a license at a particular royalty or in the exclusion of an infringer from the market--is much preferable to a judicial guesstimate about what a royalty should be. The actual market beats judicial attempts to mimic the market every time, making injunctions the normal and preferred remedy. *See* Schlicher, *Patent Law: Legal and Economic Principles* §§ 1.14, 9.03[1]."), *aff'd*, 71 F.3d 1573 (Fed. Cir. 1995)

Hilton Davis Chemical Co. v. Warner-Jenkinson Co., 62 F.3d 1512, 1533 (Fed. Cir. 1995)(Newman, J. concurring)("No analysis is generally applicable to all fields of technology and all competitive relationships, as illustrated in the growing literature on the function of patent-type economic incentives. *See generally* John W. Schlicher, *Patent Law: Legal and Economic Principles* (1992).")

Intel Corp. v. ULSI System Technology, Inc., 995 F.2d 1566, 1571 (Fed. Cir. 1993)(Plager, J. dissenting)("The principle of 'first sale,' simply stated, is that when a patent owner (or the owner's authorized licensee) sells to another a product which incorporates the patented invention, the other may convey the product to third parties free of any claim of patent infringement. *See* John W. Schlicher, *Patent Law: Legal and Economic Principles* § 8.05[1] (1992). We are not here concerned with the question of whether and to what extent a patent owner may impose conditions on the sale which bind future transferees. *See id.*")

Cook Inc. v Boston Scientific Corp., 333 F.3d 737, 740 (7th Cir. 2003)(Posner, J.)("Thus a patentee can ordinarily be expected either to grant nonexclusive licenses in order to exploit the effect of competition in minimizing the licensees' margins or to grant an exclusive license in order to encourage the licensee to invest in the further development of the licensed process or product by protecting the licensee from the competition of other licensees, which might prevent the licensee from recouping his investment. John W. Schlicher, *Licensing Intellectual Property: Legal, Business, and Market Dynamics* 69-71 (1996). *** The second goal that

we have mentioned, that of encouraging investment by the licensee, is the relevant one in this case.”)

Professional Activities

Mediator, United States District Court for the Northern District of California

Chair, Patent, Trademark and Copyright Section, American Bar Association, Antitrust Committee

Vice-Chair, Antitrust Section, ABA, Patent, Trademark and Copyright Committee, 1990-94

Chair, American Intellectual Property Law Association, Antitrust Committee, 1984-86

Advisor to Office of Technology Assessment of the United States Congress on its report Commercial Biotechnology: An International Analysis

Advisor to the Antitrust Division, Department of Justice, on Guidelines on antitrust and licensing

Chair or Co-Chair, Federalist Society, Biotechnology Subcommittee

Additional Information

Retained as expert witness on patent and licensing in matters in the United States and Canada

Who's Who in American Law

Research Assistant to Professor William F. Baxter, Stanford Law School, 1972-1973