PREFACE TO THE 2025-2026 EDITION

Since the introduction of this latest edition of Walker on Patents, it seems appropriate to devote at least some space to the changes this edition incorporates and how this edition relates to other works in the field. United States patent law is not blessed at the present time with an abundance of reference works that are both detailed and comprehensive. Instead, the recent tendency has been to produce works of a more limited character, which either treat the entire field in a more summary fashion or focus on topics that are narrow. This edition of the Walker treatise, like its predecessors, is an exception to this trend. The Walker treatise is the oldest reference on United States patent law still currently in print, having originated with Albert H. Walker's first edition in 1883. Ever since that time, it has been a comprehensive reference that treats the entire field of patent law in depth. This edition continues this pattern. It is intended to treat the whole substantive law of patents in such detail that virtually all questions of current interest are addressed.

However, this edition does differ from other works, and earlier editions, in significant ways. Including the initial offering, Mr. Walker and others produced at least eight editions of his treatise. Only two of these changed or expanded the character of the immediately preceding edition substantially, these being John Lotsch's edition in 1926 and Anthony W. Deller's edition of 1938. This edition will have to be counted among this latter group. It extensively reorganizes and rewrites the immediately prior edition, with new legal analysis and legal research. As a result, it is hoped, this Walker will be drastically more useful to the bar, the bench and those interested in patents and patent law. This Walker hopefully will compare favorably to the best resources available to the profession.

In terms of overall outline, this Walker is arranged to deal with the most fundamental questions of patent law first, progressing through further topics in the sequence needed to understand the patent system thoroughly. Chapters 1-3 thus treat such foundational matters as the patent system's historical origins and general social purpose, the particular administrative structure employed in the United States, and the general nature of the patenting transaction before the United States Patent and Trademark Office.

With these initial matters examined, this Walker then turns to the actual substantive law of patents. This requires first an extended treatment of patent claims and the principles according to which such claims are used in United States practice. Thereaf-

ter, the various requirements of patentability are treated in roughly the order they are set out in the patent code, namely proper statutory subject matter, adequate utility, anticipation and, in a chapter to be shortly supplied, nonobviousness. In addition to these, the question of adequate disclosure is also treated, as will be the question of proper inventorship.

In discussing these issues this edition of Walker takes notice of certain major themes, or lines of analysis, that influence the United States law of patents. At least several, if not most of these, are presented in Walker for the first time. For the convenience of the reader, these organizational themes are summarized below.

Legal Realism, Legal Positivism. Since about the turn of the 20th Century, the United States legal community has considered law to be heavily influenced by the currently existing consensus views of society. This replaced a prior view that considered law to be mainly the product of reasoning from principles that were static. The change had many consequences, from the development of modern evidence law and its rigorous distinction between law and fact, to the rise of the Socratic method in law-school education. Additionally, and perhaps most important, it resulted in substantive areas of law being viewed as an evolving system, in which particular legal rules were the purposeful result of decisions to achieve particular social goals. Accordingly, an increasing amount of analytical emphasis was placed on the underlying justifications for legal rules that were in dispute.

Unfortunately, this development was not immediately reflected in the authorities and common wisdom in the law of patents. Perhaps this delay reflected patent law's traditional position as an offshoot, rather than a main stem of law generally. Perhaps it was because of the practicing patent bar's heavy exposure to science and engineering, whose underlying principles are in fact immutable and not responsive to changing social views. For whatever reason, for a considerable period most of the secondary authorities, if not the statutes and case law decisions, continued to express a conceptualization of patent law that emphasized the rules themselves, as opposed to the underlying rationale, and which did not sufficiently appreciate matters of historical development. Some part of this tendency still persists.

This edition of Walker is meant to break with this tradition. The intention is to pay consistent and thorough attention to patent law's underlying rationales in every instance where such observations can be profitably made. Users of this treatise will find, for example, that chapter 1 is devoted to the historical development and policy justifications for the patent system overall. Individual topics, moreover, are commonly treated with an initial discussion that sets out the historical development and policy justification of the particular issue as well. This approach

should result in the user receiving not only a more thorough understanding of the particular decisional rules that are then discussed; it should also permit one to predict more accurately how cases involving other, further rules will be decided when they arise. In addition, the discussions should highlight which arguments for future legal reform are likely to prove more fruitful than others.

Law and Economics. General legal scholarship now asserts that the design of individual legal rules is governed to appreciable degree by the goal of maximizing relevant economic factors. This school of thought, as applied to law generally, is usually considered to have arisen in about the early 1960s. It has had a significant impact on, for example, the areas of damages and antitrust.

The economic operation of patent law, however, has been a subject of study for many decades. Sources can even be found, in fact, that assert the literature to have been already highly developed by the middle third of the 1800s. Thus, the analytical interconnection between legal rule and economic effect in patent law is not new; rather it is very old.

Most of the overt analyses of this type, and certainly those that are most detailed, have been produced by economists and not legal scholars. Still, the development of patent law in Congress and the courts has proceeded with one eye on economic principles since an early time. As a result, much of the substantive law of patents can—and in some cases must—be understood in terms of the economic rationale behind the patent system and its particular principles of operation. Nearly the entire area of patentability and validity, in fact, can be accurately understood as a means of controlling the cost-benefit profile of the individual patenting transactions under consideration.

A major purpose of this edition of Walker is to set out plainly this connection between economic rationale and the substantive law of patents. The user will encounter a discussion of the overall economic justification for the patent system immediately, in chapter 1. In addition, reference to economic principles recurs throughout the work in connection with particular issues. Emphasizing these analytical connections will hopefully give the user a more complete understanding of the patent system's operation than can be obtained from the statutes and cases themselves; while none of the operative economic rationales are extremely difficult to understand, at least some are not necessarily intuitive. This is especially true if the general costs of patenting are not appreciated at the outset.

The Law of Property. The law of patents, as a branch of the law of intellectual property, is in fact largely a branch of the more comprehensive law of property generally. Many fundamental

aspects of patent law therefore can be reliably explained only by referring to concepts basic to the law of property. Without this reference, certain basic assumptions from which patent law proceeds risk appearing arbitrary or, at the least, more open to change than is truly the case.

Because of these concerns, this Walker draws on concepts from the law of property more heavily than the user will likely have encountered in other works. The concept of possession, for example, is a fundamental basis for the discussion of adequate disclosure in chapter 7, the technological requirements of anticipation in chapter 8, and, indeed, the basic function of the patent system in chapter 1.

Questions of time-wise priority and defining the act of invention, covered in chapter 8, are especially prominent examples of this type. While Congress improved the statutory statement of anticipation when it reorganized section 102 of the patent code in 1952, that reorganization was not optimal. The concept of first inventorship actually underlies all of paragraphs 102(a), 102(e), and 102(g).

This Walker attempts to provide the reader with a clearer understanding of how these paragraphs operate, and how they relate to each other, by treating them in a different order than they appear in the statute. Paragraph 102(g) is treated first, since it states the overall criterion of first-to-invent. Paragraph 102(e) treated next. Paragraph 102(a) is treated last in the sequence of priority-related provisions, because it is conceptually more complex than 102(e), and because the arrangement allows its treatment to be usefully juxtaposed with the treatment of novelty in paragraph 102(b). In addition, the entire topic of time-wise priority is introduced in a series of sections that treat the concept in a more global fashion.

Language and Linguistics. This edition is also noteworthy because of the extent to which its analyses center on how the substantive law of patents has been influenced by problems of language. Fundamentally, patent law incorporates the basic problem of defining and communicating the technological concept of the invention at issue. The tools for achieving this communication are of course words and the other aspects of language. Unfortunately, however, these words capture the intended concept only approximately; they are inexact and imprecise in ways that are unpredictable and not completely understood.

Patent law has suffered much because of the unreasonable, implicit assumption, held by some, that language has a much greater ability to deal with this problem than it really does. In truth, a great deal of the substantive law of patents must be understood as incorporating attempts by the system to maintain a useable body of law despite language's basic inadequacies. Ac-

cordingly, this edition makes reference to issues of language in a number of places that the reader may find unfamiliar. Chapter 3, for example, contains an extended discussion of the basic procedure by which patent law assigns meaning to the words used in the patent claim. In addition, language-related problems, particularly those imposed by the system of peripheral claiming, are discussed extensively in connection with practical utility in chapter 6, the new matter and description requirements in chapters 3 and 7, and the existence of priority, in chapter 8. In addition, a specialized question of language, that of hybrid-claiming, is discussed at length in chapters 4 and 5.

Noteworthy changes in this update include:

- Updates reflecting *Petrella v. Metro Goldwyn Mayer, Inc.*, and *SCA Hygiene Products Aktiebolag v. First Quality Baby Products, LLC*, including additional authorities (*Romag, John Bean, Medinol II & III*) and the rule that laches cannot bar legal damages within 35 U.S.C. § 286; delay may still bear on equitable relief and access to Equity. (see §§ 23:1, 23:5–23:6)
- Expanded treatment of prosecution laches synthesizing *Symbol Technologies, In re Bogese, Hyatt v. Hirshfeld (Hyatt I), and Hyatt v. Stewart (Hyatt II)*, and clarifying that prosecution laches survives *Petrella/SCA*. (see §§ 23:20, 23:1)
- Statute of limitations interplay and the continuing tort character of patent infringement, explaining the late nineteenth century advent of limitations in patent law and why limitations do not resolve all timeliness concerns. (see §§ 23:3; 23:5–23:20)
- Discussion on concerns highlighted in Supreme Court dissents (e.g., Justice Breyer) regarding prejudice from delayed enforcement after *SCA*, and identification of open questions about alternative defenses addressing undue delay. (see § 23:1)
- Chapter revisions include standardized citations, cross-references, and other editorial improvements.