Lemley on Metallizing Engineering, in Perspective

Esteemed Stanford University Law School Professor Mark A. Lemley joined by several dozen academic colleagues has produced an impressive amicus brief in Helsinn Healthcare S.A. v. Teva Pharmaceuticals USA, Inc., Fed. Cir. 2016-1284. Professor Lemley argues that Metallizing Engineering Co. v. Kenyon Bearing & Auto Parts Co., 153 F.2d 516 (2d Cir.1946), should be considered good law under the Leahy Smith America Invents Act.

Whither the Karshtedt Critique? Prof. Lemley’s amicus brief is consistent with his arguments published in the Texas Law Review last year. See Mark A. Lemley, Does “Public Use” Mean the Same Thing it Did Last Year, 93 Texas L. Rev. 1119 (2015), but does not fully respond to the critique of George Washington University Law School Professor Karshtedt. See Dmitry Karshtedt, The Riddle of Secret Public Use: A Response to Professor Lemley, 93 Texas L. Rev. See Also 159 (2015)(attached).

Whither the Harmonization Goal of the New Law? One may wonder why an isolationist position would be taken that the holding in Metallizing Engineering should be followed in the new law, given that Metallizing Engineering makes the United States the odd man out, when a prime goal of the new law is harmonization. The result of Metallizing Engineering would perpetuate disharmony, setting America apart from the global mainstream, as explained in the amicus brief of The Naples Roundtable, Inc. (attached).

Regards,

Hal