PROFESSOR ROBERT PATRICK MERGES

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7/2016

CURRENT POSITION

Associate Dean for Advanced Degree Programs and Global Outreach; Wilson Sonsini Goodrich & Rosati Professor of Intellectual Property Law, Boalt Hall School of Law, University of California, Berkeley, and Co-Director, Berkeley Center for Law and Technology, since 1997; Visiting Professor, Stanford Law School, Winter/Spring 2013; Visiting Professor, University of California at Davis School of Law, 2002-2003. Professor of Law, UC Berkeley, 1995-1997; Visiting Professor, Harvard Law School, Spring 1995; Professor, Boston University School of Law, 1992 - 1995; Associate Professor, 1988 -1992. I teach Intellectual Property and Contracts; my primary scholarly interest is in economic aspects of intellectual property rights, especially patents.

PUBLICATIONS

Measuring the Costs and Benefits of Patent Pools, forthcoming **76 Ohio St. L.J. (2016)** (with Michael Mattioli).

Copyright and Distributive Justice, forthcoming **Notre Dame L. Rev. (2016)** (with Justin Hughes).

Against Utilitarian Fundamentalism, forthcoming, St. John's Law Review, 2016.

Philosophical Foundations of IP Law: The Law and Economics Paradigm, June, 2015, forthcoming in the Research Handbook on the Economics of IP Law (Peter S. Menell, Ben Depoorter, and David Schwartz, eds.), (Vol. I -- Theory) (Edward Elgar Publishing, forthcoming 2016).

***Intellectual Property in the New Technological Age (with P. Menell and M. Lemley) (Berkeley: Clause 8 Publishing, 7th ed. 2016);* with Teacher's Manual, plus annual supplements.**

A Few Kind Words for Absolute Liability in Patent Law, **31 Berkeley Technology Law Journal 1 (2016).**

Economics of Intellectual Property Law, Chapter in the Oxford Handbook of Law and Economics (submitted January, 2015, published online late 2015).

The Path of IP Studies: Growth, Diversification and Hope (Symposium Introduction), 92 Tex. L. Rev. 1757 (2014) (with John M. Golden and Pamela Samuelson)

Foreword, **Selected Chinese Patent Cases** (Dongchuan Luo, ed.; Trans. by Haining Song and Seagull Haiyan Song: Wolters Kluwer, 2014)

Patent Law and Policy (6th ed. 2013), plus annual supplements.

Foundations and Principles Redux: A Reply to Professor Blankfein-Tabachnick, **101 Cal. L. Rev. 1361 (2013)**

The Relationship Between Foundations and Principles in IP Law, **49 San Diego L. Rev. 957 (2012)**

Priority and Novelty Under the AIA, **27 Berkeley Tech. L.J. 1023 (2012)**

Justifying Intellectual Property (Harvard Univ. Press, 2011)

Autonomy and Independence: The Normative Face of Transaction Costs, **53 Ariz. L. Rev. 145 (2011)**.

To Waive and Waive Not: Property and Flexibility in the Digital Era, **34 Colum. J.L. & Arts 113** (2011).

Operating Efficiently Post-Bilski by Ordering Patent Doctrine Decision-Making, **25 Berkeley Tech. L.J. 1673 (2011)** (with Dennis Crouch).

High Technology Entrepreneurs and the Patent System: Results of the 2008 Berkeley Patent Survey, **24 Berkeley Tech. L.J. 1256 (2010)** (with Stuart J.H. Graham, Pam Samuelson, and Ted Sichelman).

The Trouble With Trolls: Innovation, Rent-Seeking and Patent Law Reform, **24 Berkeley Tech. L. J. 1583 (2010)**.

Individual Creators in the Cultural Commons, **95 Cornell L. Rev. 793 (2010)** (comment on Michael J. Madison, Brett M. Frischmann & Katherine J. Strandburg, Constructing Commons in the Cultural Environment, 95 Cornell L. Rev. 657 (2010)).

Rules of the Road for Space? Satellite Collisions and the Inadequacy of Current Space Law, 40 Envt'l L. Rep. News & Anal. 10009 (2010) (with Glenn Reynolds).

An Estoppel Doctrine for Patented Standards, **97 Cal. L. Rev. 1-50 (2009)** (with Jeffrey

Kuhn).

The Concept of Property in the Digital Era, **45 Hous. L. Rev. 1239 (2008).**

Locke for the Masses, 36 Hofstra L. Rev. 1179 (2008).

The Economics of Intellectual Property Law (Editor) (Economic Approaches to Law Series, Edward Elgar Publishers, 2008), vol. 1 and 2.

Software and Patent Scope: A Report from the Middle Innings, 85 Tex. L. Rev. 1528 (2007).

Book Review of Zorina Khan, The Democratization of Invention: Patents and Copyrights in American Economic Development, 1790-1920, and Knut Blind et al., Software Patents: Economic Impacts and Policy Implications, 45 J. Econ. Lit. 452-460 (2007) (featured review).

Locke, Remixed ;-) , 40 U.C. Davis L. Rev. 1259 (2007).

Intellectual Property in the New Technological Age (with P. Menell and M. Lemley) (N.Y.: Aspen Law and Business [formerly Little Brown]) (4th rev. ed. 2007); **with Teacher's Manual.**

Software and Internet Law (with M. Lemley, P. Samuelson, P. Menell) (Aspen Law & Business) (3d ed. 2007); **with Teacher's Manual.**

Patent Law and Policy (4th ed. 2007) (with John F. Duffy) **with Teacher's Manual.**

Introductory Note to Brief Amicus Curiae *in eBay v. MercExchange*, 21 Berkeley Tech. L. J. 997 (2006).

Brief of Amicus Curiae *Yahoo!, Inc.*, 21 Berkeley Tech. L. J. 999 (2006) (with Joseph Siino, Lisa McFall, Christopher Wright, Timothy Simeone, and Bruce Gottlieb.

The Standard of Creativity and the Graham *Cases*, in **Intellectual Property Stories** (Rochelle Cooper Dreyfuss and Jane Ginsburg, eds., Foundation Press, 2006) (with John Duffy).

A Response to the Commentators, response to specially commissioned comments on Arora & Merges, 13 Ind. & Corp. Change 451-475 (2004), by five economists, **15 Ind. & Corp. Change (2006)**.

A Transactional View of Property Rights, **20 Berkeley Tech. L.J. 1477 (2005)**.

Foundations of Intellectual Property (with Jane Ginsburg, Columbia Law School) (NY: Foundation Press, 2004).

Incentives to Challenge and Defend Patents: Why Litigation Won't Reliably Fix Patent Office Errors and Why Administrative Patent Review Might Help, **19 Berkeley Tech. L.J. 943-970 (2004)** (with Joseph Farrell, Professor of Economics, U.C. Berkeley).

A New Dynamism in the Public Domain, **71 Chi. L. Rev. 183-203 (2004).**

Specialized Supply Firms, Property Rights, and Firm Boundaries, **13 Ind. & Corp. Change 451-475 (2004)** (with Ashish Arora); ***Notes and Comments: Special Section: Comments on Ashish Arora and Robert Merges,* "Specialized supply firms, property right and firm boundaries," 14 Industrial and Corporate Change 1195-1240 (2005)**.

Compulsory Licensing vs. the Three "Golden Oldies": Property Rights, Contracts, and Markets, Cato Institute, Cato Policy Analysis No. 508, Jan. 15, 2004.

The Uninvited Guest: Patents on Wall Street, 88 Fed. Res. Bk. of Atlanta Econ. Rev. 1 (2003), reprinted in ***Property Rights Dynamics: A Law and Economics Perspective (Donatella Porrini and Giovanni B. Ramello, eds., London: Routledge Publishers, 2007)***.

***Intellectual Property in the New Technological Age (with P. Menell and M. Lemley) (N.Y.: Aspen Law and Business [formerly Little Brown]) (3d ed. 2003);* with Teacher's Manual.**

***Software and Internet Law (with M. Lemley, P. Samuelson, P. Menell) (Aspen Law & Business) (2nd ed. 2003);* with Teacher's Manual.**

***Patent Law and Policy (3d ed. 2002) (with John F. Duffy)* with Teacher's Manual.**

"Institutions for Intellectual Property Exchange: The Case of Patent Pools," in **Intellectual Products: Novel Claims to Protection and Their Boundaries (Oxford Univ. Press, 2001) (Rochelle Dreyfuss, ed.)**.

One Hundred Years of Solicitude: Intellectual Property Law 1900-2000, **88 Cal. L. Rev. 2187 (2001)** (reprinted in The Political Economy of IP Rights, Christopher May, ed., Edward Elgar Publishing 2010).

Intellectual Property Rights and the New Institutional Economics, **53 Vanderbilt L. Rev. 1857 (2000)**.

The Proper Scope of the Patent and Copyright Power, **37 Harv. Journal on Legislation 45 (2000)** (with Glenn H. Reynolds).

The Law and Economics of Employee Inventions, **13 Harv. J. L. & Tech. 1 (1999)**.

As Many as Six Impossible Patents before Breakfast: Property Rights for Business Concepts and Patent System Reform, **14 Berkeley Tech. L.J. 577 (1999)**.

Letter Update, **R. Merges, Patent Law (2d ed. 1997)**: 60 page update of patent casebook to reflect recent developments, May, 1998.

The Control of Strategic Alliances: An Empirical Analysis of Biotechnology Collaborations, **46 Journal of Industrial Economics 125-156 (1998)** (previously reprinted as Nat'l Bureau of Econ. Res. Work. Pap. 6014, April, 1997) (with Josh Lerner).

Intellectual Property and Digital Content: Notes on a Scorecard, **47 Rivista di Diritto Industriale [Italia] 261 (1998)**.

Space Resources, Common Property, and the Collective Action Problem, **6 N.Y.U. Envt'l L.J. 101 (1997)** (with Glenn H. Reynolds).

The End of Friction? Property Rights and Contract in the "Newtonian" World of On-Line Commerce, **12 Berkeley Tech. L.J. 115 (1997)** (reprinted in Chinese translation, **Peking Univ. Law Review 1999**).

Contracting Into Liability Rules: Intellectual Property Transactions and Collective Rights Organizations, **84 California L. Rev 1293 (1997)**.

Patent Law and Policy: Cases and Materials (Michie Co.: Charlottesville, VA) (2d ed. 1997) (Now adopted by more than 65 law schools nationwide)

Patent Scope and Emerging Industries: Biotechnology, Software and Beyond in **Competing in the Age of Digital Convergence 301-324 (David B. Yoffie ed. 1997)** (with Josh Lerner).

Outer Space: Problems of Law and Policy (2d ed. 1997) (with Glenn Reynolds).

Intellectual Property and Digital Content: Notes on a Scorecard, **1 The CyberSpace Lawyer 15 (1996)**, forthcoming reprint in **Italian Review of Industrial Property Law**).

Property Rights Theory and the Commons: The Case of Scientific Research, **13 Soc. Phil. & Pol'y 145-167 (1996)**.

A Comparative Look at Intellectual Property Rights in the Software Industry, in **The International Computer Software Industry: A Comparative Study of Industry Evolution and Structure (Oxford Univ. Press 1996) (David Mowery, ed.)***, pp. 272-303.*

The Economic Impact of Intellectual Property Rights: An Overview and Guide, **19 J. Cultural Econ. 103 (1995)**.

Intellectual Property and the Costs of Commercial Exchange: A Review Essay, **93 Mich. L. Rev. 1570 (1995)**.

Intellectual Property Rights and Bargaining Breakdown: The Case of Blocking Patents, **62 Tenn. L. Rev. 75 (1995)**.

Opinion Letter As To The Patentability Of Certain Inventions Associated With The Identification Of Partial cDNA Sequences, **23 Am. Intell. Prop. L. Ass'n Q.J. 1 (1995)** (with Rebecca Eisenberg).

Of Property Rules, Coase, and Intellectual Property, Symposium: Toward a Third Paradigm in Intellectual Property, **94 Colum. L. Rev. 2655-2673 (1994)**.

On Limiting or Encouraging Rivalry in Technical Progress: The Effect of Patent Scope Decisions, **25 Journal of Economic Behavior and Organization 1 (1994)** (with Richard R. Nelson).

Are You Making Fun of Me? Notes on Market Failure and the Parody Defense in Copyright, **21 Am. Intell. Prop. L. Ass'n Q.J. 303 (1994)**.

Among the Tribes of Shasta County (Book Review of Robert Ellickson, ***Order Without Law****)*, **18 L. & Soc. Inquiry 299 (1993)**.

Uncertainty and the Standard of Patentability, **7 (Berkeley) High Technology Law Journal 1 (1993)**.

Patent Law and Policy: Cases and Materials (The Michie Co.: 1992). (Including Teacher's Manual and statutory supplement.)

Market Structure and Technical Advance: The Role of Patent Scope Decisions, in **Antitrust, Innovation and Competitiveness 185-232 (T. Jorde & D. Teece, eds. 1991) (Oxford U. Press)** (with Richard R. Nelson).

Rent Control in the Patent District: Observations on the Grady-Alexander Thesis, **78 Virginia Law Review 359 (1992)** (critique of the rent dissipation model of patent law).

A Brief Note on Blocking Patents and Reverse Equivalents: Biotechnology as an Example, **73 Journal of the Patent and Trademark Office Society 878 (1991)**.

Battle of Lateralisms: Intellectual Property and Trade, **8 B.U. Int'l L.J. 239 (1991)**.

On the Complex Economics of Patent Scope, **90 Columbia Law Review 839-916 (1990)** (with Richard R. Nelson).
Co-Ownership of Patents: A Comparative and Economic View, **72 Journal of the Patent and Trademark Office Society 586-599 (1990)** (with Lawrence Locke).

Economic Perspectives on Innovation: Commercial Success and Patent Standards, **76 California Law Review 803-876 (1988)**.

The Nature and Necessity of Law and Science, **38 Journal of Legal Education 315-330 (1988)**.

The Patentability of Higher Life Forms: Intellectual Property Rights and Controversial Technologies, **47 Maryland Law Review 1051-1075 (1988)**.

Reflections on Current Legislation Affecting Patent Misuse, **70 Journal of the Patent and Trademark Office Society 793-804 (1988)** (adapted from Congressional Testimony).

Towards an Industrial Policy for the Commercial Space Launch Industry, **29 Jurimetrics Journal of Law, Science and Technology 7-42 (1988)** (with Glenn Reynolds).

News Media Satellites and the First Amendment, **3 (Berkeley) High Technology Law Journal 1 (1988)** (with Glenn Reynolds).

Outer Space: Problems of Law and Policy (Boulder, Colorado: Westview Press, 1st ed. 1989).

Exclusive Remedies and Software Licenses, **4 Computer L. Rep. 478 (January, 1986)** reprinted in **Computer Law 1986** (1987), at 36-42.

Toward a Computerized System for Negotiating Ocean Bills of Lading, **6 J. L. & Commerce 23 (1985)** (with Glenn Reynolds).

Apple v. Franklin: *An Essay on Technology and Judicial Competence*, **2 Yale L. & Pol'y Rev. 62 (1983)**.

HONORS, AWARDS, ETC.

Named Guest Professor (honorary title), Renmin University Law School, Beijing, China.

Retrospective Conference in honor of an early paper: "Patent Scope Revisited: Merges & Nelson's 'On the Complex Economics of Patent Scope,' 20 Years After," Indiana University School of Law, October, 2010.

Many papers in Social Science Research Network (SSRN) "Top 10 Downloads" category in Intellectual Property.

Scholarship cited numerous times by the U.S. Supreme Court and lower courts.

Second most-cited scholar in Intellectual Property, in list compiled by Brian Leiter's Law School Reports, http://leiterlawschool.typepad.com/leiter/2007/09/most-cited-sc-1.html.

WORKING PAPERS & WORKS IN PROGRESS

"Transnational Intellectual Property Law," casebook, with Stefan Bechtold, ETU Zurich; and Haiyan (Seagull) Song, Loyola of LA Law School; forthcoming, Edward Elgar Publishers, 2016 (covering European, Chinese, and US IP Law).

Intellectual Property as a Fundamental Right, chapter in Oxford Handbook of Intellectual Property Law (Rochelle Dreyfuss and Justine Pila, eds., forthcoming 2015)

Economics of IP Law, chapter in the Oxford Handbook of Law and Economics (forthcoming 2015).

Named Series Editor, Research Handbooks on Intellectual Property Law Series, Edward Elgar Publishers (General Editor of 5 volume series in Intellectual Property Law).

" Back to the Shadows, or Onward and Upward? Current Trends in Patent Law," posted on "Patently-O" web blog, avail. at www.patently-o.com.

"Medieval Guilds Redux: Contemporary Institutions for Collective Invention," to be presented at Annual Meeting, Economic History Association, San Jose, CA, Sept. 10, 2004; and Legal Studies Institute, University of Wisconsin, Madison, November, 2004.

"Who Owns the Charles River Bridge? Intellectual Property and Competition in the Software Industry"

OTHER SCHOLARLY ACTIVITIES

Editor-in-Chief, Intellectual Property Abstracts, Social Science Research Network electronic abstracting service with over 2000 subscribers.

VISITING POSITIONS Visiting Professor, Boalt Hall School of Law, University of California, Berkeley, Spring 1995; Visiting Professor, Harvard Law School, Spring, 1994.

CONGRESSIONAL TESTIMONY Hearings on Prior User Rights, House Subcommittee on Intellectual Property, September 13, 1994.

Hearings on The Patent Harmonization Act of 1992, Joint Senate/House Hearings, April 30, 1992.

"The Public Interest and Private Patent Bills," Senate Hearings on Patent Extensions (Private Patent Bills), August 1, 1991.

Hearings on State Sovereign Immunity in Patent Infringement Suits, U.S. House of Representatives, February 8, 1990; testimony cited extensively by majority and dissent in *Florida Prepaid v. College Savings Bank*, U.S. Sup. Ct., case no. 98-531 (June 23, 1999).

Hearings on Patent Misuse, U.S. House of Representatives, May 11, 1988.

Hearings on Animal Patents, U.S. House of Representatives, July 22, 1987.

TALKS AND PRESENTATIONS

Invited lectures at National Taiwan University, National Tsinghua University (Taiwan), Intellectual Property Court of Taiwan, Renmin University School of Law, Beijing, Peking University, Seoul National University, Tsinghua University (Beijing), Yonsei University (Seoul), Tokyo University, Meiji University, the Japanese Patent Office, and the Judicial Research and Training Institute, Seoul; plus Samsung IP Law Department, Kim & Chang Law Firm, and other law firms in Shanghai, Beijing, Taipei, and Seoul.

Courts and Legislatures in Patent Law: Coordination Mechanisms, Asia Pacific IP Conference, Seattle, WA, Feb., 2016

"Creative Professionals and Online Content: An Uneasy Truce," inaugural Annual Intellectual Property Lecture, Hostra University Law School, March 4, 2015

"A Few Kind Words for Absolute Liability in Patent Law," presentation at the Intellectual Property Scholars Conference, August, 2014

Justifying Intellectual Property, Presentation to the Faculty and Students, National Taiwan University Law School, May 2014

Current Developments in US Patent Law, mini-course offered at the National Tsing Hua University Law School, Hsinchu, Taiwan, May 2014

Plenary Talk, Trans-Pacific IP Conference, Suzhou, China (Renmin University Law School campus), November, 2013.

Joint Program for Berkeley-Peking University and Koc University (Turkey): IP and Economic Development, Beijing, November, 2013.

Philosophical Issues in IP Law: Justifying Intellectual Property, University of San Diego Law School, June 2012.

Special Conference on Justifying Intellectual Property, April 2012, Notre Dame Law School: Keynote speaker and discussant.

"Justifying Intellectual Property," UCLA Entertainment, Media and IP Workshop, Los Angeles, Nov. 6, 2011.

"The America Invents Act: Overview," Cleveland IP Law Ass'n Quarterly Meeting,

Cleveland, OH, October 11, 2011.

"Justifying Intellectual Property," University of Akron Law School, October 11, 2011.

"Justifying Intellectual Property," 11th Annual IP Scholar's Conference, Chicago, Ill., Aug. 11, 2011.

"Justifying Intellectual Property," Oxford, England, Oxford University Law Faculty, June 15, 2010.

"Recent Trends in IP Rights and Business Models," International Association of Boalt Alumni, Annual Conference, London, England, June 17, 2010.

"Secondary Patent Markets," The Gathering 2.0, Silicon Valley law and business conference, March, 2011.

"Secondary Patent Markets: Theory and Practice," Los Angeles IP Law Ass'n, Feb. 25, 2011.

"Patent Scope Revisited: Merges & Nelson's 'On the Complex Economics of Patent Scope,' 20 Years After," Keynote Speaker at conference commemorating 1990 co-authored article, Indiana University School of Law, September 23-24, 2010.

"Property Rights in the Digital Era," 23rd Annual Horace Manges Lecture, Columbia Law School, April 5, 2010.

"Innovation, Rent-Seeking and Patent Reform," presentation at University of Arizona Law School, Tucson, AZ, May 1, 2009.

"Demsetzian Property Theory and the Future of Intellectual Property," presentation at Research Symposium on Property Rights Economics and Innovation," Northwestern University Law School, November 13, 2008.

"The Concept of Property in the Digital Age," Baker Botts Distinguished Lecture, University of Houston, April 1, 2008.

IP and New Business Models: Patent Quality and Reliable Assets, presentation at annual Almaden Institute, IBM, San Jose, CA, May 8, 2008.

Kant on Intellectual Property Rights: Concepts and Principles for the Digital Era, presentation at the Cardozo School of Law, New York, September 10, 2007.

Software and Business Method Patents: A Review and Update, presentation at the Intellectual Property Owners Annual Meeting, New York, September 10, 2007.

"IP Under Attack? Worldwide IP Issues in Perspective," Bay Area Meeting, Association

of Intellectual Property Professionals (AIPPI), Spring 2007.

China/US IP Issues: Software Patents and Interoperability: Presentation at SAP, Inc.

The Future of Property, Berkeley Alumni group presentation, Palo Alto, CA, May, 2007.

Patent Law presentation, Federal Judicial Center continuing education for federal judges, Berkeley, June 2007.

"IP and Economic Development," Day-long presentation, U.C. Berkeley U.S.-China High-level Policymakers's Conference, September, 2006.

"A Transactional View of Property Rights," presentation at the Conference on Commercializing Innovation, Washington University School of Law, St. Louis, Nov. 5, 2005.

"Patent Law: Basic Issues, New Developments," presentation at annual Judicial Conference of the U.S. Court of Appeals for the Fifth Circuit, October 4, 2005.

"A Transactional View of Property Rights," presentation at the Max Planck Institut for Intellectual Property and Tax Law, Munich, Germany, July 12, 2005.

"Legal and Economic Patent Law Scholarship in the U.S.," presentation at the University of Mannheim, ZEW Institute, Germany, July, 2005.

"Patent Law Reform: Perspectives and Predictions," presentation at the National Academies of Science, Patent Reform Conference, June 9, 2005.

Medieval Guilds and the History of Intellectual Property, Conference on the History of Intellectual Property, University of Wisconsin, Madison, Wisconsin, November, 2004.

From Medieval Guilds to Open Source Software: Informal Norms, Appropriability Institutions, and Innovation, Economic History Association Annual Meeting, San Jose, CA, September 10, 2004.

Principle Presenter, Conference on Intellectual Property and Entrepreneurship, Berkeley, CA, June, 2004

Featured Speaker, Heller Ehrman White & McCauliffe Firm Retreat, Aptos, CA, June, 2004

Invited Lecture, Cyberlaw course, Stanford Law School, April, 2004

Tutorial Lecturer and Featured Speaker, Conference on Patent Law Reform, U.C. Berkeley, April, 2004

Panel Speaker, Stanford-Berkeley Innovation Conference, October, 2003.

"Strategic Investments in the Public Domain," University of Chicago Intellectual Property Conference, June, 2003.

"The Uninvited Guest: Patents on Wall Street," presentation to Federal Reserve Bank of Georgia, Financial Markets Conference, Sea Island, Georgia, April 5, 2003.

"Intellectual Property: How Much is Too Much?," Law in the Information Age Lecture, U.C. Davis School of Law, January 31, 2003.

"Is There a 'Berkeley School' of Intellectual Property?," talk before Boalt Hall Alumni Association, Palo Alto, California, April, 2002.

Intellectual Property and Antitrust, Federal Trade Commission Hearings, Berkeley, California, March 5 and 7, 2002.

Intellectual Property Rights and the New Institutional Economics, principal presentation, Taking Stock: Conference on Recent Developments in the Law and Economics of Intellectual Property, Vanderbilt University, April 2-3, 2000.

Current Controversies in Patent Law, Talk at the Intellectual Property Conference, National Academy of Science, Science, Technology and Economic Policy Board, Feb., 2, 2000, Washington, D.C.

Patent Law Update, Ninth Circuit Judicial Conference, U.S. Court of Appeals for the Ninth Circuit, San Diego, California, August, 2000.

Biotechnology Patents in the U.S.: Address to the Conference on the European Biotechnology Directive, Milan, June, 1999.

"Who Owns the Charles River Bridge? Competition and the Software Industry," paper presented at conference on Innovation and Competition in the Software Industry, Carlsbad, CA, April, 1999 (featured in column by Boston Globe reporter David Warsh, June 20, 1999.

Intellectual Property Rights, Input Markets, and the Value of Intangible Assets, Oliver Williamson's "Institutions Seminar," U.C. Berkeley, Dec. 3, 1998.

Intellectual Property Rights, Input Markets, and the Value of Intangible Assets, talk given to Columbia Law School faculty workshop, Nov. 10, 1998.

Property Rights and Employed Inventors, talk given to the combined Economic History and Industrial Organization Workshops, UCLA, Nov. 2, 1998.

Presented paper on "Institutions for Intellectual Property Transactions: The Case of Patent Pools," NYU Law School Conference on Intellectual Products: Novel Claims to Protection and their Boundaries, June 25-28, 1998.

University Patenting and Licensing and the Biotechnology Industry, introductory address, Berkeley Conference on Biotechnology: New Perspectives on Public Access and Proprietary Rights, February, 1998.

Commentator, Panel on International Protection for Computer Software and Digital Information, Association of American Law Schools Annual Meeting, January, 1998.

"Property Rights Theory and the Employed Inventor," Law and Economics Workshop, University of Chicago, November 10, 1997.

"Employee Inventions Law and Employee Exit in High Technology Industries," paper presented at the Conference on Financing Innovation, Columbia Law School, December 7, 1997.

Panel Presentation on "Intellectual Property: Industry Associations, Standard-Setting & Dell Computer," 5th Annual Golden State Antitrust & Trade Regulation Institute, San Francisco, October, 1997.

The End of Friction? Property Rights and Contact in the "Newtonian" World of On-Line Commerce, presentation to Stanford Law and Economics colloquium, April, 1997.

"Institutions for Intellectual Property Transactions: The Case of Patent Pools," NYU School of Law, March, 1997.

Panel Member, Antitrust and Intellectual Property, The Conference Board Annual Conference on Antitrust, New York, N.Y., March, 1997.

"Cantilevered Commerce: Intellectual Property and the Modern Economy," Inaugural Lecture, Wilson Sonsini Professorship, Berkeley, February 1997.

"Intellectual Property After the GATT Uruguay Round," faculty presentation, Marquette Law School, Milwaukee, Wisconsin, May 8, 1996.

Panel Chair, Intellectual Property Session, American Law and Economics Association Annual Meeting, Chicago, May 9, 1996.

Presented paper on "Antitrust Review of Patent Acquisitions: Property Rights, Firm Boundaries, and Organization," Conference on Antitrust Policy, Canadian Department of Competition Policy, Ottawa, Canada, May 10, 1996.

"Current Issues in International Patent Law," presentation, Salzburg Seminar session on Intellectual Property Rights Internationally, Salzburg, Austria, August, 1995.

"The Economics of Intellectual Property Rights: An Overview and Guide, opening presentation, International Conference on the Economics of Intellectual Property Rights,

International Center for Art Economics, University of Venice, Italy, Oct. 6-8 1994.
"Contracting into Liability Rules (An Extension of the Calabresi and Melamed Framework)," Faculty Presentation, Harvard Law School, May 6, 1994.

"Comments on J. Reichman, *Toward a Third Intellectual Property Paradigm*," Columbia Law School Conference on Intellectual Property, April 22-23, 1994.

"Intellectual Property Policy Issues," presenter and participant, National Institute of Health Workshop on NIH's role in university-industry Sponsored Research Agreements, January, 1994.

"Is Biotechnology Unique? Lessons from Our Industrial Past," paper and talk presented at International Conference on Intellectual Property and the Future of the Biotechnology Industry, University of Washington School of Law, Seattle, Washington, October 21-23, 1993.

"Towards a Transactional View of Intellectual Property: Property Rules, Liability Rules, and Bargaining Breakdowns," paper and talk at Faculty Workshop, University of Michigan Law School, October 15, 1993.

Gave public talk to faculty, students, and patent judges on Patent Scope from an Economic Point of View, George Washington University School of Law, Washington, D.C., September 30, 1992.

Gave talk on "An Economic Rationale for Some Rules of Patent Infringement: The Doctrine of Equivalents and Related Issues," Stanford Law School, Law and Economics Workshop, October 22, 1992.

Gave talk entitled "An Economic Look at Recent Developments in the Law of the Biotechnology Industry," American Economic Association Annual Meeting, January 5, 1993, Anaheim, California.

Invited guest lecturer, Seminar on Technology and the Law, Boalt Hall School of Law, Berkeley, California, March 18, 1993.

Gave paper on "The Impact of Intellectual Property Rights on the Computer Software Industry," Berkeley International Conference on the Economics of the Software Industry, Berkeley, California, March 20, 1993.

Invited participant, Consortium on Competitiveness and Cooperation planning meeting for major new project on The Coevolution of Institutions and Industries, Palo Alto, California, April 16, 1993.

"Uncertainty and the Standard of Patentability," Interdepartmental Colloquium on Technical Change, Carnegie-Mellon University, Pittsburgh, September 16, 1992.

"Thoughts on Patents and Transaction Costs," Conference on the Economics of Intellectual Property, Columbia University, June, 1992.

"Introduction to the Legal Issues," Genome Patent Working Group, Public Forum on Patenting the Human Genome, National Academy of Sciences, May, 1992, Washington, D.C.

Spoke on "Teaching Patent Law," George Washington Law School Conference on Teaching Intellectual Property, May 1992.

"The (Uneasy) Case Against Software Patents," Massachusetts Software Council Annual Meeting, Boston, Jan. 27, 1992.

Presentation to science journalists, Congressional staff members, and scientists: "Patents in Biotechnology and Other Sciences," Banbury Center, Cold Spring Harbor Laboratory, Long Island, Jan. 24-25, 1992.
Gave talk on "The Economics of Property Rights and the Human Genome Initiative," Center for Science and International Affairs, Kennedy School of Government, Harvard University, Nov. 19, 1991.

Keynote Speaker, Boston Patent Law Ass'n Annual Meeting, December 5, 1991.

Panel Member, Franklin Pierce Law Center Biennial Patent Law Symposium, May 2-3, 1991.

Gave presentation on Intellectual Property issues at a Conference on Legal Issues in the Human Genome Project, Arizona State University School of Law, Phoenix, Arizona, March 15-17, 1991.

Presentation on "Economic Impact of Intellectual Property Rules on the Biotechnology Industry," before the Technology and Public Policy group at the Kennedy School of Public Policy, Harvard University.

Gave speech on "The Patent System: Prospects and Problems" at The Cooper Union for the Advancement of Science and Art, New York, January 22, 1991, in conjunction with the Union's retrospective exhibit and public forum on the 200th anniversary of Peter Cooper and the patent system.

Gave short presentation to the Biotechnology Committee of the American Intellectual Property Law Association at their mid-winter meeting in Boca Raton, Florida, January 24, 1991.

Commented on paper and made presentation at John M. Olin Foundation Conference on Intellectual Property, University of Virginia Law School, October 18-20, 1990.

Gave presentation and moderated panel at American Enterprise Institute

Conference on Intellectual Property, Washington, D.C., September 27, 1990.

Gave presentation on International Initiatives in Intellectual Property at Boston University International Law Journal Symposium on International Trade, September 25, 1990.

Moderated and gave speech at Tufts Medical School Conference on the Tenth Anniversary of the Chakrabarty Case, Boston, May 25, 1990.

Gave speech on Industrial Policy and the Biotechnology Industry, National Institutes of Health-Pharmaceutical Manufacturers Association Conference on Commercializing Biotechnology, March 1-2, 1990.

Presented Paper on "The Public Research Enterprise in the U.S.: Overview and Prospects," Conference on Legal Aspects of Scientific Research, sponsored by the Universities of Florence and Siena, Italy, June, 1989

.

Presented paper and gave talk on "Protecting Emerging Technologies, Especially Biotechnology" before the Annual Patent Conference sponsored by the Bureau of National Affairs, Washington, D.C., November 18, 1988.

Presentation on "Economic Approaches to the Problem of Software Patents," MIT Communications Forum, March 23, 1989.

Presentation on "The Intelligent Use of Animals in Research: Legal Issues," Harvard Medical School Genetics Training Research Grant Speakers Series, April 27, 1989.

Presentation on "Patent Misuse and Antitrust Defenses," Symposium on Intellectual Property and the Venture Capital Process, Stanford Law School, May 5, 1989.

Panel Discussion on "Software Copyright," Copyright Society of the United States Meeting, Boston, February 10, 1990.

GRANTS

Kauffman Foundation grant to study Intellectual Property and Entrepreneurship, awarded March, 2007 (co-Principal Investigator, with Pam Samuelson).

Department of Energy competitive grant for conference on Biotechnology: New Perspectives on Public Access and Proprietary Rights, Feb. 20-21, 1998.

Consortium on Competitiveness and Cooperation, Sloan Foundation, 1994- , to conduct an empirical study of the role of intellectual property rights in facilitating various transactions, from licensing technology to the formation of joint ventures, and the like. I will be conducting the research with Professor Josh Lerner of Harvard Business School.

Alfred P. Sloan Foundation Grant, 1989-1991, to organize and supervise research on Intellectual Property and the Biotechnology Industry. Administered four workshops during 1989-90 academic year.

Office of Technology Assessment Contract Research Award 1993, to study and report on policy issues raised by attempts to patent portions of the human genome.

TEACHING

Designed and co-taught course on IP Decisions, Models, and Strategies at the Haas School of Business, UC Berkeley, Spring 2010.

Taught a course on "Theoretical Foundations of Intellectual Property" at the Max Planck Institut, joint summer program with George Washington University, July, 2005.

First year contracts, one- and two-semester course, since 1988

Seminar in Advanced Topics in Intellectual Property, 1989-1994.

Patent Law, 1989 -

Introduction to Intellectual Property, 1994 – .

Intellectual Property Transactions: Law and Economics, 1994.

Law and Technology Seminar, U.C. Berkeley (Boalt Hall), 1995 – 1997.

Intellectual Property Strategy, 1997.

Intellectual Property in Historical Perspective, 2002 (at UC Davis School of Law).

In addition, I have organized and recruited adjunct faculty for numerous new intellectual property-related courses at Berkeley since 1995.

Contracts: Various years since 1989.

EDUCATION J.S.D., Ll.M., Columbia Law School

J.D., Yale Law School, 1985

B.S., History, Carnegie-Mellon University, 1981. Visiting Foreign Student, Trinity College, Dublin, Department of Modern Irish History, 1980-81.

FELLOWSHIPS From September, 1986 until June, 1988, I was the

& AWARDS

Julius Silver Fellow in Law, Science and Technology at Columbia Law School; organized and co-taught course on Legal Aspects of the Biotechnology Industry.

Greyhound Fellow and Affiliated Scholar, Center for the Study of Law, Science and Technology, Arizona State University School of Law, Winter 1988.

Coker Fellow (Assistant Instructor), Yale Law School, 1984-85.

Wells Fellow, Jonathan Edwards College, Yale University, 1984-85; coordinator for Wells Technology and Society Lecture Series.

Aley Scholarship, Yale Law School, 1984-85.

PROFESSIONAL ACTIVITIES

Co-founder and Co-Director, Berkeley Center for Law and Technology, a major force in intellectual property and other law and technology issues; rated the #1 IP program by US News and World Report 12 of the past 13 years.

Co-Founder and Managing Director, Ovidian LLC, an IP business and investment consulting firm in Berkeley, CA, in 2008. One of 5 original co-founders, served as Managing Director for two and one half years, until company was successfully acquired by Pendrell, Inc., of Bellevue, Washington. (Successful exit, company sale, in 2011.)

Frequent speaker to federal judges on various intellectual property-related topics, at programs offered by the Federal Judicial Center in conjunction with the Berkeley Center for Law and Technology (e.g., 200 judges, San Francisco, June, 1999; 40 judges, Berkeley, June, 1998; many years since then with similar crowds).

Organized and led Berkeley Roundtable on Software Protection, May, 1996 (125 attendees)

Organized and participated in the First Digital Content Symposium, November, 1996

Organized and participated in the conference, "Biotechnology and the Law: New Perspectives on Public Access and Proprietary Rights," Berkeley Center for Law and Technology, Berkeley California Feb. 20-21, 1998.

Recruited adjunct faculty, and helped organize, innovative new courses (IP Strategy, IP Transactions, Patent Law of Biotechnology and Chemical Industries, Patent Litigation, Entertainment Law, Trade Secrets, etc.)

Solidified student internship program, which includes internships at Netscape Communications, Lucas Digital, LucasFilm, and other leading companies

Conducted extensive fundraising (now roughly $400,000 annually) and acted as liaison with most prominent Bay Area intellectual property law firms

Special Consultant to the Antitrust Division of the Department of Justice on intellectual property issues, and Member of the Department's Task Force on Intellectual Property, 1994-1999

Consultant to the Director, National Institutes of Health, in the matter of NIH's decision to drop certain human genome-related patent applications

Consultant, U.S. Congress, Office of Technology Assessment, Human Genome Project Intellectual Property Study

Occasional consultant on intellectual property issues and policy for Howard Hughes Medical Institute, Genentech, and other firms; and to the U.S. Patent Office.

Consultant, Office of the United States Trade Representative, on intellectual property issues, 1989-1990

Organizer and Discussion Leader for four symposia on Intellectual Property Rights in the Biotechnology Industry, funded by the Alfred P. Sloan Foundation, 1987-1988

Research Assistant to Professor Richard Nelson, Henry Luce Professor in International Political Economy, 1987. Assembled empirical data on various aspects of industrial research and development for use in papers by Nelson and Merges.

Admitted, California, U.S. District Court for the Northern District of California and U.S. Court of Appeals for the Ninth Circuit, 1986.

Associate, Fenwick, Davis & West, Palo Alto, California, 1985-1986. Corporate associate with emphasis on intellectual property, especially technology licensing, and start-up companies.

Summer Associate, Fenwick, Davis & West, 1984.

Summer Associate, Brown & Bain, Phoenix, Arizona, 1983.

WORK EXPERIENCE

Senior Technical Writer, VisiCorp Personal Software, Inc., San Jose, California, 1981-82. I wrote user manuals for various software products, including an advanced version of the VisiCalc spreadsheet program.

Technical Writer, Intel Corporation Advanced Semiconductor Research Facility, Aloha, Oregon, Summer, 1980.

Technical Writing Intern, Intel Corporation, Santa Clara, California, Summer, 1979.

OTHER

Sunday School Teacher, Davis Community Church (Presbyterian USA), 2001- 2007; Adult Education leader, 2007-present. Elder since 2005.