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Inequitable Conduct and the Attorney-Client Privilege

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Inequitable Conduct and the Attorney-Client Privilege

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Overview

Inequitable conduct, a defense arising in the patent-litigation context, occurs when a patentee, his attorney, or anyone associated with the prosecution of a patent breaches his duty of candor and good faith by affirmatively misrepresenting or failing to disclose material information to the United States Patent and Trademark Office (PTO). A charge of inequitable conduct typically arises as a defense to patent infringement. A defendant will allege that a plaintiff's patent is unenforceable because of improprieties carried out during the patent's prosecution. A finding of inequitable conduct has potentially devastating consequences for a patentee, including (1) rendering the patent unenforceable, (2) forcing the patentee to pay the opponent's attorney fees in an infringement suit, and (3) leading to liability under the antitrust laws, Federal Trade Commission Act, or securities laws. It may also stigmatize the attorney (regardless of whether the claim of inequitable conduct succeeds) and may lead to disciplinary proceedings against the attorney at the PTO and before his or her state bar.

Because an inequitable conduct charge involves the patent attorney's intent, the patentee may wish to call the attorney who prosecuted the patent to testify at trial. Unfortunately, when the patent attorney testifies about his intent (or lack thereof) to deceive the PTO during the prosecution of the patent at issue, that testimony may waive attorney-client privilege. Attorney-client privilege waiver in the context of inequitable conduct is in a state of flux. Many district courts have come to incongruous results on which law to apply; even when the courts choose the right law for attorney-client privilege in inequitable conduct cases, they inconsistently construe the scope of the waiver. Litigants may potentially abuse the inconsistent nature of waiver of attorney-client privilege in inequitable conduct cases, using it as a litigation tactic to garner privileged information from their opponents.

Inequitable conduct charges appear in almost every patent case because inequitable conduct is the magic bullet, capable of destroying an entire patent in one fell swoop. Moreover, it creates negative equities, permitting the accused infringer to paint the patentee black. The natural consequence forces the patentee to decide how to defend the case; the patentee can pull his punches and preserve the privilege or waive privilege and pray the scope of the waiver is reasonable. Thus, the scope of attorney-client privilege waiver, and the scope of the compelled disclosure, raise substantial issues of fairness to the parties. Accordingly, the subject of attorney-client privilege waiver in the inequitable conduct context remains critical to establishing an educated litigation strategy.

About the Author

Alexis N. Simpson graduated from Georgia State University College of Law in December 2009. Currently, she works in the chemical/metallurgical practice group at **Finnegan, Henderson, Farabow, Garrett & Dunner, LLP**. While in law school, Ms. Simpson served as the Georgia State University Law Review Student Writing Editor, and was a 2009 National Finalist in the **Giles Sutherland Rich Memorial Moot Court Competition**, held at the U.S. Court of Appeals for the Federal Circuit and judged by Judges Raymond Clevenger, Sharon Prost, and Kimberly Moore. Before attending law school, Ms. Simpson graduated from the **Georgia Institute of Technology** with a Bachelor of Science in **Chemical & Biomolecular Engineering**. For more information about this bibliography, please contact Professor Nancy Johnson via e-mail at **njohnson@gsu.edu**.

Scope

This guide provides an overview of the law surrounding attorney-client privilege waiver in the inequitable conduct context. The resources provided in this guide include helpful laws, secondary materials, and internet resources on the topic attorney-client privilege waiver in inequitable conduct cases. However, to provide context to this specific patent law issue, some of the materials relate to the broad subject of general patent/intellectual property law. This research guide is intended to assist attorneys with little or no familiarity with this subject matter in gaining a better understanding of the relevant law. At the end of the guide you will find internet resources that may be used to locate many of the sources contained in the guide.

Disclaimer

This research guide is a starting point for a law student or an attorney to research the doctrine of inequitable conduct and its intersection with attorney-client privilege. This is a very active area of federal law, and it is imperative to Shepardize or KeyCite all cases and statutes before relying on them. This guide should not be considered as legal advice or as a legal opinion on any specific facts or circumstances. If you need further assistance in researching this topic or have specific legal questions, please contact a reference librarian in the Georgia State University College of Law library or consult an attorney.

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Primary Sources

U.S. Code

A couple of sections of the United States Code are relevant to the background issues of inequitable conduct. The United States Code can be found, free of charge, online from the Cornell Legal Information Institute.

35 U.S.C. § 282

This provision of the United States Code provides that all issued patents are presumed valid, and lists possible defenses that may challenge an issued patent when accused of patent infringement. Unenforceability is one such defense to patent infringement, and may arise from inequitable conduct.

35 U.S.C. § 285

This provision of the United States Code allows for the award of attorney fees in "exceptional cases." Some courts have found inequitable conduct to be an exceptional case, such that one found to have committed inequitable conduct may have to pay the attorney fees for the prevailing parties.

Legislation

Patent law reform bills have been introduced into Congress with great frequency in the last few years. The House and Senate have evinced growing support for such measures, and a patent law reform bill of some sort is likely to eventually pass into law. Many recent bills include specific provisions that would directly impact the doctrine of inequitable conduct. Examples of previously introduced (but not enacted) patent law reform legislation are listed below. More information on these bills can be found free of charge on the U.S. Government Printing Office (GPO) website, or on the Library of Congress's THOMAS website. Additionally, the final legislative piece below was enacted into law in 2008, adding a new rule of evidence that directly impacts the scope of attorney-client privilege waiver.

Patent Reform Act of 2007, H.R. 1908, 110th Cong. (2007).
This bill passed by the House of Representatives on Friday, September 7, 2007, by a vote of 220-175, in response to concerns raised by industry groups that intellectual property claims and resulting litigation have become a bottleneck for innovation and growth.

Patent Reform Act of 2008, S. 3600, 110th Cong. (2008).
This bill was proposed by Senate Minority Whip Jon Kyl (R-Az) in September of 2008, and offered specific ideas for reform in the area of inequitable conduct.

Patent Reform Act of 2009, S. 515, S. 610, H.R. 1260, 111th Cong. (2009).
The Patent Reform Act of 2009 contains provisions that would eliminate the need for patent filers to act in good faith in dealing with the Patent Office to later enforce their patents, a provision that could radically alter the "inequitable conduct" analysis. Senators Orrin Hatch and Patrick Leahy introduced a Senate bill, S. 515, on March 3, 2009. Representative John Conyers introduced the House version, H.R. 1260, the same day. Senator Jon Kyl introduced another bill, S. 610, on March 17, 2009. On April 2, 2009, the Senate Judiciary Committee voted 15-4 to bring S.515 before the full Senate. The Patent Reform Act of 2009 represents the third consecutive congressional session to attempt the first overhaul of the U.S. patent system since 1952.

A Bill to Amend the Federal Rules of Evidence, S. 2450, 110th Cong. (2008).
This bill added **Federal Rule of Evidence 502**, which directly addresses the scope of waiver of attorney-client privilege, and was enacted into law through Public Law No. 110-322 in 2008.

Rules and Regulations

Below is a sample of particularly relevant Federal Rules of Civil Procedure, Federal Rules of Evidence, sections of the Code of Federal Regulations, and United States Code provisions.

Federal Rules of Civil Procedure

A few Federal Rules of Civil Procedure are particularly noteworthy in the context of the cases mentioned above. *See* discussion *supra* Part II.a. All Federal Rules of Civil Procedure can be found, free of charge, online from the Cornell Legal Information Institute.

Fed. R. Civ. P. 11

Patent infringement suits may, at times, be filed as "an excuse to determine *everything* the opponent is pursing as far as obtaining patents," and "[a]ny willingness by a court to force production of technical information will only further this improper and unethical practice."

Fed. R. Civ. P. 30(b)(6)

Rule 30 of the Federal Rules of Civil Procedure governs depositions in general. Rule 30(b)(6) governs instances where a subpoena is directed toward an organization rather than

to a person. In that instance, the corporation designates a 30(b)(6) witness to speak on the corporation's behalf in deposition. Questions sometime arise as to whether testimony by that witness (especially if that witness is, in this context, a patent attorney or agent) waives attorney-client privilege, and if so, what is the scope of that waiver.

Fed. R. Civ. P. 37

This Federal Rule of Civil Procedure provides that an attorney can be sanctioned for abusive discovery practices, in addition to sanctions under Rule 11 (as discussed above), and accordingly can also play a key role in inequitable conduct cases.

Federal Rules of Evidence

The full text of the Federal Rules of Evidence can be found, free of charge, online from the Cornell Legal Information Institute.

Fed. R. Evid. 501

This Federal Rule of Evidence covers the general overview of privilege law, and provides that the law of privileges "shall be governed by the principles of the common law as they may be interpreted by the courts of the United States in light of reason and experience."

Fed. R. Evid. 502

This Federal Rule of Evidence was enacted in late 2008, and limits the waiver of attorney-client privilege for inadvertent disclosures and disclosures made in state proceedings, while giving teeth to court orders and party agreements governing the scope of the waiver in a given case. This Rule was enacted into law through Public Law No. 110-322. *See* discussion *supra* Part II.a (discussing A Bill to Amend the Federal Rules of Evidence, S. 2450, 110th Cong. (2008)).

Code of Federal Regulations

While only one section of the Code of Federal Regulations is listed below, it is vitally important to the analysis of inequitable conduct. The text of the Code of Federal Regulations can be found, free of charge, online from the Cornell Legal Information Institute.

37 C.F.R. § 1.56

This Federal Regulation governs the duty to disclose material information material to patentability to the United States Patent and Trademark Office. This rule forms the basis of the inequitable conduct doctrine; a violation of Rule 56 is inequitable conduct.

Case Law

Below are some of the most important cases impacting attorney-client privilege, inequitable conduct, or both.

Supreme Court Cases

Ashcroft v. Iqbal, 129 S. Ct. 1937 (2009).

Synopsis: While this Supreme Court decision does not address inequitable conduct or attorney-client privilege, it seems to heightens the pleading standard for all civil cases (and since patent cases are civil cases, this case would seemingly govern patent cases as well).

Resources: This Supreme Court case (and all Supreme Court cases from 1781 to the present) can be found for free on **LexisOne.com** (after completing a free registration process), for free on **Supreme.Justia.com**, and can also be found directly **here**. Oral arguments for the case (in mp3 or transcript) can also be retrieved from **Oyez.com**, free of charge.

Upjohn Co. v. United States, 449 U.S. 383 (1981).

Synopsis: This is a critical Supreme Court case, explaining the importance of the attorney-client privilege and defining its boundaries. The Supreme Court struck down a district court's test—basing availability of attorney-client privilege upon whether a corporation's officer played a "'substantial role' in deciding and directing the corporation's legal response"—because it was difficult to apply and caused "disparate decisions," revealing its unpredictability.

Resources: This Supreme Court case (and all Supreme Court cases from 1781 to the present) can be found for free on **LexisOne.com** (after completing a free registration process), or link directly to a free version of the case at **Supreme.Justia.com**. Oral arguments for the case (in mp3 or transcript) can also be retrieved from **Oyez.com**, free of charge.

Federal Circuit Cases

Below is a sampling of cases relevant to this topic, covering inequitable conduct ant attorney-client privilege waiver in various degrees. The cases are organized by date, with the most recent cases listed first. All federal cases in the last ten years can be found, free of charge, on **LexisOne**. They can also be found, along with older cases, on **Westlaw** or **LexisNexis**. Oral arguments can also be heard on for the cases on the Federal Circuit **website**.

AstraZeneca Pharm. LP v. Teva Pharm. USA, 583 F.3d 766 (Fed. Cir. 2009).

The court in this case held that showing of "high degree of materiality" by a party asserting inequitable conduct in prosecution of a patent does not mean that proportionally lesser showing of intent to deceive is necessary to establish requisite threshold level of intent, since evidence of mistake, negligence, or even gross negligence is not sufficient to support finding of inequitable conduct. This case shows the continual evolution of the intent standard in inequitable conduct litigation.

Exergen Corp. v. Wal-Mart Stores, Inc., 575 F.3d 1312 (Fed. Cir. 2009).

This case from the Federal Circuit appears to tighten the reins on inequitable conduct pleading, providing that whether inequitable conduct has been adequately pleaded is a question of Federal Circuit law because it pertains to or is unique to patent law. "Inequitable conduct, while a broader concept than fraud, must be pled with particularity" under Fed. R. Civ. P. 9(b). The court then specifically held that a pleading of inequitable conduct must state the who, what, when, where, and how of the alleged wrongdoing, and state enough facts to allow a court to reasonably infer both the knowledge and intent necessary for inequitable conduct.

Dippin' Dots, Inc. v. Mosey, 476 F.3d 1337 (Fed. Cir. 2007).

The patent disclosing a process for making a form of cryogenically frozen ice cream was rendered unenforceable because the applicant failed to disclose the public sale of goods produced by the patent more than one year before the patent was filed (and so the process was unpatentable under 35 U.S.C. § 102), and this constituted inequitable conduct. The court affirmed the jury's findings of noninfringement, unenforceability, and obviousness, but reversed the jury's finding that DDI violated the antitrust laws by asserting a patent that had been procured through inequitable conduct. Although the attorney who prosecuted the patent application testified at trial as to why he failed to disclose the above-mentioned information, the issue of attorney-client privilege was not raised.

Fort James Corp. v. Solo Cup Co., 412 F.3d 1340 (Fed. Cir. 2005).

Here, the court further clarifies ***In re Spalding Sports Worldwide*** and ***GFI Inc. v. Franklin Corp.***, synthesizing the rule regarding attorney-client privilege waiver analysis in inequitable conduct cases. The court held that the Federal Circuit "applies the law of the regional circuit . . . with respect to questions of attorney-client privilege and waiver of attorney-client privilege" in inequitable conduct cases; district courts still routinely misapply the law. *See* District Court Cases *infra.*

GFI Inc. v. Franklin Corp., 265 F.3d 1268 (Fed. Cir. 2001).

Demonstrating the Federal Circuit's choice-of-law framework, the court held that the Federal Circuit will apply regional circuit law to procedural issues that are not themselves substantive patent law issues so long as they do not (1) "intimately involve[] . . . enforcement of [a] patent right, . . . (2) bear an essential relationship to matters committed to [its] exclusive control by statute, or (3) clearly implicate the jurisprudential responsibilities of th[e] court in a field within its exclusive jurisdiction." *Id.* at 1272; *see also* ***In re Spalding,*** **203 F.3d at 803**. Accordingly, the court held that regional circuit law governed waiver.

In re **Pioneer Hi-Bred Int'l, Inc., 238 F.3d 1370 (Fed. Cir. 2001).**

In this 2006 case, the Federal Circuit discussed attorney-client privilege waiver in conjunction with **Rule 30(b)(6)**, but the case did not involve inequitable conduct. The court provided interesting language, however, noting that offering corporate counsel to testify as a **Rule 30(b)(6)** witness on factual matters would not waive privilege, because "counsel is often a fact witness with respect to various events, and may testify on deposition by the opposing party to such matters without waiver." *Id.* at 1376. But the court stated that a different result "might obtain if counsel were offered as a fact witness at trial by his client." *Id.* The court applied regional circuit law to determine waiver, but noted that "[i]n any event, we would reach the same result applying Federal Circuit law." *Id.* at 1374 n.3.

In re **Spalding Sports Worldwide, Inc., 203 F.3d 800 (Fed. Cir. 2000).**

This case is a key case for determining choice of law for privilege in the inequitable conduct context. After a lower court found attorney-client privilege waiver and ordered production of an invention record, patentee sought relief with the Federal Circuit. The Federal Circuit held the invention record subject to attorney-client privilege, which was neither waived nor pierced by the crime-fraud exception to attorney-client privilege waiver. In this case, the court articulated the appropriate standard for choice of law. The rule from this case is that whether privilege attaches to a communication in a case of inequitable conduct is governed by the law of the Federal Circuit because it touches on substantive issues of patent law. But, once the court determines whether a privilege attaches, regional circuit law governs whether that privilege was waived. *See* **GFI Inc. v. Franklin Corp., 265 F.3d 1268 (Fed. Cir. 2001)**.

Dorf & Stanton Commc'n, Inc. v. Molson Breweries, 100 F.3d 919 (Fed. Cir. 1996).

This case held that regional circuit law governs discovery orders and waivers (including waivers of attorney-client privilege). Whether a privilege applies at all, in a patent context like inequitable conduct, is a matter of Federal Circuit law, though. *See* ***In re*** **Spalding Sports Worldwide, Inc., 203 F.3d 800 (Fed. Cir. 2000)**.

Other Circuit Court cases

If regional circuit law applies to determine whether a privilege has been waived (as noted by the Federal Circuit in the cases above), then the law will vary from circuit to circuit. Once the court finds waiver of the attorney-client privilege, that waiver extends to "all communications pertaining to the subject matter of the [already disclosed] communications," and all courts recite this rule. However, what exactly constitutes "subject matter" can vary broadly from jurisdiction to jurisdiction, as can be seen in circuit court and district court cases. Below is a sampling of how the various circuits treat privilege waiver in general, which can be found on **LexisNexis** or **Westlaw**.

In re **Von Bulow, 828 F.2d 94 (2d Cir. 1987).**

In the Second Circuit, the courts have held (as in this case) that disclosing privileged communications does not waive the privilege "beyond those matters actually revealed." *Id. at 103.* This is an extremely narrow construction of waiver, and would likely be favorable for a patentee.

Chevron Corp. v. Pennzoil Co., 974 F.2d 1156 (9th Cir. 1992).

In the Ninth Circuit, the courts have held (as in this case) that disclosure of information resulting in a waiver of attorney-client privilege constitutes waiver "only as to communications about the matter actually disclosed." *Id.* at 1162. This is a narrow construction of waiver, but it is broader than the Second Circuit.

District Court Cases

Northern District of California

Below is a sampling of district court cases on a variety of topics that may be relevant to this topic. The cases are organized by district court (in alphabetical order by state), and can be found on **LexisOne** (if they were decided in the last ten years), or on **LexisNexis** or **Westlaw.**

Bd. of Tr. of the Leland Stanford Junior Univ. v. Roche Molecular Sys., Inc., 237 F.R.D. 618 (N.D. Cal. 2006).

In this case, the court ruled that by submitting declarations to the PTO to support a petition to correct inventorship of a patent, and in those declarations the patentee disclosed privileged communications with its prosecution patent counsel, the patentee had waived attorney-client privilege; the subject matter waiver extended to the entire subject of inventorship. *Id.* at 625. Applying Ninth Circuit law, the court displayed a desire to strictly construe attorney-client privilege in favor of broad discovery. The court held that when waiver turned on a patent applicant's submission of the material to the PTO, Federal Circuit law, rather than regional circuit law, would govern the analysis. This interpretation is not in line with Federal Circuit pronouncements on the topic (*see* ***supra***). This misinterpretation results in an interesting circular application of the law; if the district courts apply Federal Circuit law, but the Federal Circuit applies regional circuit law, whose law is really being applied?

Genentech, Inc. v. Insmed Inc., 234 F.R.D. 667 (N.D. Cal. 2006).

The court provides an excellent run-down of on the law of attorney-client privilege waiver in inequitable conduct cases.

Laser Indus. v. Reliant Techs., Inc., 167 F.R.D. 417 (N.D. Cal. 1996).

Here, the district court found no waiver when a prosecuting patent attorney made "a lengthy declaration" about his knowledge of prior art and denied any fraud or inequitable conduct.

Starsight Telecast, Inc. v. Gemstar Dev't Corp., 158 F.R.D. 650 (N.D. Cal. 1994).

The court found partial waiver of attorney-client privilege when the prosecuting patent attorney testified that he disclosed all material prior art he was aware of to the PTO. The court found it would be unfair to deny opposing counsel the opportunity to discover other relevant facts with respect to the same subject matter, and found the attorney's statements amounted to more than a mere denial of intent. The common thread between ***General Electric***, ***Martin Marietta***, and this case is that in each case, the courts found waiver of attorney-client privilege based on fairness to the party alleging inequitable conduct, finding it unfair to allow the prosecuting patent attorney to testify at length without allowing the opposing party to view the information tending to support or refute his statements.

District of Delaware

Praxair, Inc. v. ATMI, Inc., 445 F. Supp. 2d 473 (D. Del. 2006).

When a patent attorney (who prosecuted the patent at issue) testified in deposition about communication with inventors regarding the materiality of a prior art reference, the court found waiver of all communications between the inventors and practitioners. Express attorney-client privilege waiver was found because the attorney actually testified about the substance of the privileged communications, constituting a voluntary privilege waiver.

Gen. Elec. Co. v. Hoechst Celanese Corp., 15 U.S.P.Q.2d (BNA) 1673 (D. Del. 1990).

Here, a patent attorney (who prosecuted the patent a issue) testified about his intent (or lack thereof) to defraud the PTO. The court found that defendants could refute such testimony only by examining the allegedly privileged communications because "[i]n light of [plaintiff]'s affirmative representations regarding [the attorneys'] state of mind, and in light of the record reflecting contemporaneous communications between [the attorneys], fairness requires that defendants be allowed to uncover the foundations for [plaintiff]'s assertions." *Id.* at 1679-80. In this case, the prosecuting patent attorney offered testimony denying any recollection of the prior art at issue, and stated that even if he had remembered it, he would have considered it irrelevant. The court found partial privilege waiver because a party testifying about its state of mind at the time of the alleged privileged communications must allow the opposition to discover the privileged communications or point to non-privileged communications instead. The common thread between *Martin Marietta, Starsight*, and this case is that in each case, the courts found waiver of attorney-client privilege based on fairness to the party alleging inequitable conduct, finding it unfair to allow the prosecuting patent attorney to testify at length without allowing the opposing party to view the information tending to support or refute his statements.

Northern District of Illinois

Murata Mfg. Co. v. Bel Fuse, Inc., No. 03 C 2934, 2007 WL 781252 (N.D. Ill. Mar. 8, 2007).

After Murata claimed the prior art was "so immaterial to the patentability of the patent-in-suit that the inventors and Murata's attorney's never even considered disclosing it" in depositions and interrogatories, the court found no waiver occurred. The court found that non-privileged, publicly available communications between the PTO Examiner and Murata's attorneys provided sufficient evidence to opposing counsel to avoid waiver. The common thread between this case, ***Derrick***, and ***Laser*** is that in each case the courts focused on the unfairness in forcing a party to choose between defending itself against inequitable conduct and waiving privilege, or pulling its punches to avoid waiver.

Western District of Pennsylvania

Martin Marietta Materials, Inc. v. Bedford Reinforced Plastics, Inc., 227 F.R.D. 382 (W.D. Penn. 2005).

This court found waiver of attorney-client privilege because the plaintiff's attorney testified about his understanding of his duty to disclose, materiality of prior art, and the role attorney-client communications played in the decision not to disclose. The common thread between ***General Electric***, ***Starsight***, and this case is that in each case, the courts found waiver of attorney-client privilege based on fairness to the party alleging inequitable conduct, finding it unfair to allow the prosecuting patent attorney to testify at length without allowing the opposing party to view the information tending to support or refute his statements.

Southern District of Texas

Derrick Mfg. Corp. v. Southwestern Wire Cloth, Inc., 934 F. Supp. 813 (S.D. Tex. 1996).

No waiver of attorney-client privilege was found after an attorney denied recalling any discussion of prior art with the patentee during the deposition. The common thread between this case, ***Murata***, and ***Laser*** is that in each case the courts focused on the unfairness in forcing a party to choose between defending itself against inequitable conduct and waiving privilege, or pulling its punches to avoid waiver.

Eastern District of Wisconsin

Leybold-Heraeus Tech., Inc. v. Midwest Instrument Co., 118 F.R.D. 609 (E.D. Wis. 1987).

The court held that "[w]here patentee named two of its attorneys as witnesses, patentee waived attorney-client privilege with regard to documents which attorneys participated in, either as recipient of a communication or communicator as to prior art or as to good-faith belief and validity of patents in question and good faith in maintaining lawsuits." *Id.* at 609-10. On its face, this seems inconsistent with Federal Circuit precedent. *See* ***in re* Pioneer Hi-Bred Int'l, Inc., 238 F.3d 1370 (Fed. Cir. 2001)**.

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Secondary Sources

Manual of Patent Examining Procedure

The M.P.E.P. is a manual published by the United States Patent and Trademark Office, describing the laws and regulations that must be followed in the examination of U.S. patent applications in detail. The M.P.E.P. provides specific guidance on how to comply with the duty of disclosure in Chapter 2000 ("Duty of Disclosure"), a violation of which can lead to a finding of inequitable conduct. The full text of the M.P.E.P. can be found free of charge on the U.S. Patent and Trademark Office Website.

Treatises

- Chisum on patents : a treatise on the law of patentability, validity and infringement by Donald S. Chisum
  Call Number: KF3114.C47 1997
  ISBN: 0820515256
  http://www.lexisnexis.com/lawschoolThis is a comprehensive treatise on patent law, updated five times per year. The most relevant sections of this treatise for the purposes of this bibliography can be found in § 19.03 (exploring the doctrine of inequitable conduct). This treatise can be found on LexisNexis.
- Paul R. Rice, John B. Corr, David Drysdale by Attorney-Client Privilege in the United States
  http://lawschool.westlaw.com/This two-volume treatise provides essential information for advising clients on protecting the confidentiality of their internal communications. This treatise provides the history, theory, and purpose of the privilege, a comprehensive examination of court interpretations, and the procedures for asserting, establishing, resolving, and appealing privilege matters. This treatise can be found on Westlaw.

Books

- Ethical Issues in Intellectual Property, in IP Practice by Jerry CohenHere, the author highlights that "[a]ttorney-client privilege is compromised in several unique ways in intellectual property representation," discussing critical issues involving state-of-mind inquiries that pierce the privilege in certain instances and other attorney-client privileges arising inequitable conduct cases.
- Evidence: The Objection Method by Dennis D. Prater, et al.
  Call Number: KF8934.E945 2007This textbook provides a great reference for understanding the law on attorney-client privilege. Though not as thorough as the Paul Rice Attorney-Client Privilege Treatise above, it provides a great framework for understanding the essential elements of the privilege, and the major cases on point.
- Restatement (Third) of the Law Governing Lawyers § 68
  Call Number: KF300.R469 2000This Restatement summarizes the general principles of attorney-client privilege. Attorney-client privilege generally protects communications between attorneys and clients from compelled disclosure. It applies to any communication satisfying the following elements: it must be "(1) a communication (2) made between privileged persons (3) in confidence (4) for the purpose of obtaining or providing legal assistance for the client." Id.

American Law Reports

A.L.R. provides an objective, in-depth, analysis of many specific legal issues, together with a complete list of every case—in every jurisdiction—that discusses it. With thousands of attorney-authored articles covering the entire breadth of U.S. law, A.L.R. can save hours of research time when trying to quickly get familiar with an area of law. This series has been cited by more courts than any other secondary resource, and can be found on Westlaw or LexisNexis.

- Bruce I. McDaniel, Annotation, Situations in Which Federal Courts Are Governed by State Law of Privilege Under Rule 501 of Federal Rules of Evidence, 48 A.L.R. Fed. 259 (1980).
  This A.L.R. was originally published in 1980, but has been consistently updated to include new relevant case law. This article discusses general choice of law provisions, which are relevant to the scope of the attorney-client privilege waiver analysis.
- Eunice A. Eichelberger, Annotation, Fraud in Patent Procurement as a Violation of § 2 of the Sherman Act (15 U.S.C. § 2), 65 A.L.R. Fed. 408 (1983).
  This A.L.R. was originally published in 1983, but has been consistently updated to include new relevant case law. This article discusses inequitable conduct in the context of a violation of § 2 of the Sherman Act, highlighting yet another pitfall that a patentee may face if inequitable conduct is found
- Martin M. Heit, Annotation, Misconduct Related to Litigation as Rendering Patent Case "Exceptional" for Purposes of 35 U.S.C.A. § 285, 64 A.L.R. Fed. 175 (1983).
  This A.L.R. was originally published in 1983, but has been consistently updated to include new relevant case law. This article discusses inequitable conduct as a basis for exceptional circumstances (which can lead to an award of attorneys' fees to the prevailing party), highlighting another potential liability that a patentee may face if inequitable conduct is found.

Legal Encyclopedias

A few notable legal encyclopedia articles of relevance are listed below, and can be found on Westlaw or LexisNexis.

- 60 Am. Jur. 2d Patents § 893 (2009).
  This legal encyclopedia article provides a general overview of the defense of inequitable conduct.
- 69 C.J.S. Patents § 138 (2009).
  This legal encyclopedia article discusses the effects of a finding of inequitable conduct.

Law Review Articles and Other Periodical Sources

Below are notable law review and other periodic sources that contain relevant information to shed light on this topic. Those sources are organized by topic: (1) those sources discussing attorney-client privilege waiver in the patent law context; (2) those sources discussing inequitable conduct in general; and (3) miscellaneous sources. All of the below-mentioned articles can be found on LexisNexis, Westlaw, or HeinOnline for a fee.

Attorney-Client Privilege in the Patent Law Context Sources

Alexis N. Simpson, Note, *The Monster in the Closet: Declawing the Inequitable Conduct Beast in the Attorney-Client Privilege Arena*, 25 Ga. St. U. L. Rev. 735

(2009).

I wrote this Note as a second-year law student, when I first learned about the issue of attorney-client privilege waiver in the inequitable conduct arena. My research for that Note inspired me to prepare this bibliography. So, for more thorough analysis directly on point with this bibliography, this Note is probably a great starting point.

Jonathan Musch, Note, *Attorney-Client Privilege and the Patent Prosecution Process in the Post-*Spalding *World*, 81 Wash. U. L.Q. 175 (2003).

This Note takes a critical view of the courts' treatment of attorney-client privilege waiver in view of the key case *In re Spalding*. The author suggests that *In re Spalding* has not actually affected the scope-of-the-waiver analysis by courts, asserting that courts pay lip service to the standards articulated in *In re Spalding* but then interpret the scope of the waiver in the same manner that they had before *In re Spalding*.

Matthew R. Rodgers, Comment, *Patent Law: Attorney-Client Privilege in Patent Litigation: Did the Federal Circuit Go Far Enough with* In re Spalding Sports Worldwide?, 55 Okla. L. Rev. 731, 752-59 (2002).

This Comment discusses the scope of *In re Spalding*, where the Federal Circuit held that determining whether privilege attaches to a communication in a case of inequitable conduct is governed by the law of the Federal Circuit because it touches on substantive issues of patent law. The author ultimately concludes that the court could have gone further with its holding, and held that communications between a patent attorney and client were presumptively privileged, even if only conveying purely technical matters.

Arnold D. Litt et al., Comment, The Patent Practitioner Attains Majority: An Examination of the Attorney-Client Privilege and Work Product Rule as They Pertain to the Patent Attorney and Agent, 4 Seton Hall L. Rev. 531 (1972–1973).

In this Comment, the author explores the law regarding whether attorney-client privilege extends to patent agents (technically qualified non-lawyers who draft and prosecute patents before the United States Patent & Trademark Office, have passed the patent bar examination, and have obtained licenses from the U.S. Patent & Trademark Office). If the person accused of inequitable conduct is a patent agent (rather than a patent attorney), it may introduce additional complexity into the attorney-client privilege waiver analysis.

Inequitable Conduct Sources

Thomas L. Irving & Adriana Burgy, *The Inequitable Conduct "Plague" in U.S. Patent Litigation: Is it Over and Is The CAFC Moving Away From an Absolute Liability Standard?*, IP Law & Tech. Programme (2006) *available at* http://finnegan.com/thomasirving/ or http://www.finnegan.com/adrianaburgy/ (scroll to "Select Publications," and select article to view text).

This Article provides a broad overview of inequitable conduct, noting that "[f]or almost the last [twenty] years, 'the habit of charging inequitable conduct in every major patent case has [been] an absolute plague,'" but pointing to a new trend in Federal Circuit cases that could indicate a move away from an absolute liability standard for the intent prong of the doctrine of inequitable conduct. Such a shift in analyzing intent could conceivably decrease the frequency with which the inequitable conduct defense is used.

Andrea Kamage & Deborah Sterling, *The Patent Plague: Inequitable Conduct Findings Are on the Rise, with No End in Sight*, 5 IP L. & Bus. 8 (Aug. 2005).

This article discusses the trend (apparent in 2005) of the increased findings of inequitable conduct by the courts and the shifting of the intent prong of the inequitable conduct analysis, echoing the frustration of many patent practitioners at the time.

Lisa A. Dolak, *The Inequitable Conduct Doctrine: Lessons from Recent Cases*, 84 J. Pat. & Trademark Soc'y 719 (2002).

Discussing the doctrine of inequitable conduct in view the then-current case law, noting that inequitable conduct's "popularity as a litigation issue—some might say 'tactic'—should come as no surprise, given the advantages and potential dividends enjoyed by infringement defendants who raise inequitable conduct challenges." *Id.* at 719.

Glenn E. Von Tersch, Note, *Curing the Inequitable Conduct Plague in Patent Litigation,* 20 Hastings Comm. & Ent. L.J. 421 (1997–1998).

This Note explores the doctrine of inequitable conduct in depth, addressing problems with the then-current law (e.g., lack of clear standards, ease of raising the defense, collateral effects of unenforceability on licenses, and unavailability of a post-issue cure), and finally proposing solutions such as penalizing the party losing the inequitable conduct issue in litigation and allowing post-issue cure of inequitable conduct through reexamination and reissue of the patent.

Other Miscellaneous Sources

Sean M. McEldowney, Comment, *The "Essential Relationship" Spectrum: A Framework for Addressing the Choice of Procedural Law in the Federal Circuit*, 153 U. Pa. L. Rev. 1639 (2004–2005).

In this Comment, the author criticizes the Federal Circuit's lack of a "consistent conceptual framework" for choice of procedural law questions (and determining the scope of the waiver of attorney-client privilege falls into that category). This Comment covers a broader scope than just attorney-client privilege waiver, but it provides helpful commentary on the overall choice-of-law issues facing the Federal Circuit.

Rodger L. Wilson & Steve C. Posner, *Questions Beyond the Scope: Defending Against the Fed. R. Civ. P. 30(b)(6) Sneak Attack*, 26 Colo. Law. 87 (1997).

A patent attorney who prosecuted a particular patent application before the PTO may be called as a witness under Fed. R. Civ. P. 30(b)(6) to speak on the corporation's behalf on a limited set of issues. This Article discusses attorney-client privilege waiver in the context of a deposition of a 30(b)(6) witness, and concludes that if attorney-client privilege is invoked during a deposition in a Rule 30(b)(6) context, it is "frequently held to have been waived or inapplicable." *Id.* at 88. Fairness is a key consideration: "'[W]here invasion of the privilege is required to determine the validity of the client's claim or defense and application of the privilege would deprive the adversary of vital information,' the privilege has been held to have been waived." *Id.* at 89.

Blogs

Below is a select number of intellectual property law blogs. A more extensive list of popular patent law blogs can be found on IPWatchDog, in Gene Quinn's article "Top 25 Patent Blogs" from February 11, 2009.

- Patently-O
  http://www.patentlyo.com/
  "The Nation's Leading Patent Law Blog"
- Patent Baristas

http://www.patentbaristas.com/
A patent law blog focused primarily on bio/pharma issues.

- IPWatchdog
http://ipwatchdog.com/
A generalized patent law blog dating back to 1999.

- AwakenIP
http://awakenip.com/
A new, general patent blog created by Georgia State University College of Law Alumnus Jeffrey Kuester.

Courses, Audio, and Video Lectures

Relevant courses, audio, and video resources may be found in a variety of sources, including those below.

- Patent Resources Group (PRG)
http://www.patentresources.com
Patent Resources Group (PRG) was founded in 1969 by Professor Irving Kayton. The company has taught patent law and related courses to 40,000 patent attorneys, agents, engineers, and scientists since then. Approximately 3,000 professionals attend PRG programs every year. Patent Resources Group provides courses and publications in all aspects of patent practice, in both print and electronic formats, for professionals at all levels of experience. The company conducts patent training programs in major cities and destinations, over the Internet, and on-site at companies and law firms, with customers located on every continent.

- Practicing Law Institute (PLI)
http://www.pli.edu/product/by_groupID.asp?groupID=00JD&
Practicing Law Institute is a non-profit continuing legal education organization chartered by the Regents of the University of the State of New York, founded in 1933. PLI is dedicated to providing the legal community and allied professionals with the most up-to-date, relevant information and techniques that are critical to the development of a professional, competitive edge. To achieve those goals, PLI conducts annual seminars in locations across the United States, supplemented with, inter alia, treatises, audio CDs and DVDs, MP3s, live webcasts, and course handbooks. The patent-specific programs are by a faculty of judges and lawyers who have earned national reputations in patent litigation by trying a wide variety of bench and jury patent trials, and provide comprehensive coverage of every phase of a patent lawsuit.

- Audio of Oral Arguments at the U.S. Court of Appeals for the Federal Circuit
http://oralarguments.cafc.uscourts.gov/
Oral arguments (from 2006 to now) from the U.S. Court of Appeals for the Federal Circuit are posted in mp3 format on the Federal Circuit website.

Newsletters

- BNA Newsletters
http://www.bna.com/products/ip/
E-mail updates from the Bureau of National Affairs (BNA) are available from the BNA website. Free trials are available. BNA has multiple newsletter services to choose from, including a "Patent, Trademark, and Copyright Journal" newsletter, a "U.S. Patents Quarterly" newsletter, and a "Patent, Trademark, and Copyright Law Daily" newsletter.

- Law360 Newsletters
http://www.law360.com/newsletter
Law360 is a subscription service providing newsletters on a variety of legal topics, many relating to intellectual property issues. To view or sign up for a newsletter service, visit the Law360 website. For a particularly relevant article, see Cameron K. Weiffenback, Implications of Praxair v. ATMI, IP.Law360.com, http://ip.law360.com/print_article/79672 (Jan. 14, 2009) (highlighting the inconsistent and fluctuating application of inequitable conduct standards by the Federal Circuit in the latter part of 2008).

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Interest Groups and Associations

Federal Agencies

United States Patent & Trademark Office

The United States Patent & Trademark Office is the federal agency for granting U.S. patents and registering trademarks. In doing this, the USPTO fulfills the mandate of Article I, Section 8, Clause 8, of the Constitution that the Executive branch "promote the progress of science and the useful arts by securing for limited times to inventors the exclusive right to their respective discoveries." The USPTO registers trademarks based on the Commerce Clause of the Constitution (Article 1, Section 8, Clause 3). The USPTO also advises the President of the United States, the Secretary of Commerce, and U.S. Government agencies on intellectual property (IP) policy, protection, and enforcement; and promotes the stronger and more effective IP protection around the world. The USPTO furthers effective IP protection for U.S. innovators and entrepreneurs worldwide by working with other agencies to secure strong IP provisions in free trade and other international agreements. It also provides training, education, and capacity building programs designed to foster respect for IP and encourage the development of strong IP enforcement regimes by U.S. trading partners.

Interest Groups

Below is a sampling of interest groups in the area of patent law, with descriptions of the interest groups in their own words (taken directly from their publicly accessible website materials), along with direct website links to learn more about the groups.

Intellectual Property Owners Association (IPO)

IPO, established in 1972, is a trade association for owners of patents, trademarks, copyrights and trade secrets. IPO is the only association in the U.S. that serves all intellectual property owners in all industries and all fields of technology. The association advocates effective and affordable IP ownership rights and provides a wide array of services to members. It concentrates on: supporting member interests relating to legislative and international issues; analyzing current IP issues; providing information and educational services; and disseminating information to the general public on the importance of intellectual property rights.

National Association of Patent Practitioners (NAPP)

NAPP is a non-profit organization dedicated to supporting patent practitioners and those working in patent law in matters relating to patent law, its practice, and technological advances. NAPP actively advocates for patent law reform.

The Association of Patent Law Firms (APLF)

APLF is an international association of specialty law firms that devote a majority of their practice to patent law, trademark law, and copyright law. As an organization, APLF's role is to demonstrate the clear business advantage that is realized by retaining a specialist patent law firm. The mission of the Association of Patent Law Firms is to ensure that the IP boutique law firm is the preferred choice by clients, corporate in house decision makers and business owners for all IP legal matters.

The Patent Office Professional Association (POPA)

POPA is an independent union of professional employees formed in 1964. The Association represents all professionals in the Patent and Trademark Office excluding managers and trademark professionals. The Patent Office Professional Association is the legally recognized voice of approximately 4000 examiners, classifiers, computer scientists, and other patent professionals. The Association seeks to establish better working conditions and personnel policies, and an atmosphere of professionalism while enhancing the patent system's goal of encouraging invention. Our motto is "Professional Representation for Patent Professionals." The Association is directed by its membership and is responsive to the concerns, desires and opinions of the patent professionals it represents.

Patent and Trademark Depository Library Association

The Association was established September 1983. Its objectives are to discover the interests, needs, opinions, and goals of the Patent and Trademark Depository Libraries (PTDLs), and to advise the United States Patent and Trademark Office (USPTO) in these matters for the benefit of PTDLs and their users, and to assist the USPTO in planning and implementing appropriate services for the PTDL's, their staffs and patrons.

Generic Pharmaceuticals Association (GPhA)

Generic pharmaceutical companies understand that certain reforms to the U.S. patent process are desirable. However, GPhA is committed to ensuring that any patent reform legislation considered by Congress does not contain provisions that could impede the timely market entry of new generic medicines. GPhA vigorously opposes any attempts in patent reform to (1) limit applicability of current "inequitable conduct" language and (2) eliminate the "best mode" requirement, under which innovators must disclose the most efficient method known for producing the patented invention.

Public/Private Associations

Below is a sampling of patent-related associations in the United States. A brief description of each organization is included, along with a link to the organization's website (each of which includes a wealth of information and additional resources).

Intellectual Property Law Section of the American Bar Association

The ABA Section of Intellectual Property Law is the largest intellectual property organization in the world and the oldest substantive Section of the ABA. Since 1894, the ABA IP section has advanced the development and improvement of intellectual property laws and their fair and just administration. As the forum for rich perspectives and balanced insight on the full spectrum of intellectual property law, the Section serves as the ABA voice of intellectual property law-within the profession, before policy makers, and with the public.

American Intellectual Property Law Association

The American Intellectual Property Law Association (AIPLA) is a national bar association constituted primarily of lawyers in private and corporate practice, in government service, and in the academic community, with more than 17,000 members. The AIPLA represents a wide and diverse spectrum of individuals, companies and institutions involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

State of Georgia Bar, Intellectual Property Section

The Intellectual Property Section of the Georgia Bar was founded in 1964 to provide information about intellectual property law to its members and to the community. The Section provides networking and educational opportunities to its members. The Section also fosters networking and education for Intellectual Property attorneys and professionals nationwide, including co-sponsoring the annual IP Institute.

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