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PATENT ETHICS: PROSECUTION, by David Hricik & Mercedes Meyer. Oxford University Press, 2009. 392 pp. Paperback $225.

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In common parlance, the term "ethics" is most often associated with that branch of philosophy which seeks to address questions about morality; concepts such as good and evil, right and wrong, justice, and virtue. There is currently much debate over the morality of certain types of patents, particularly patents relating to genes and embryonic stem cells, as reflected in a number of recent books and articles on the subject, as well as attempts to strike down patents perceived by some to be immoral, both in the U.S. and abroad. But in the context of legal practice, the word is more often used to describe the rules of professional responsibility that govern the conduct of attorneys and other professionals, the violation of which can lead to severe and costly consequences for practitioners and their clients, and it is in this sense that PATENT ETHICS: PROSECUTION uses the term.

The book provides practical advice for patent practitioners to assist them in navigating the challenging professional responsibility environment in which they operate. This is not a philosophical inquiry; the focus is on managing risk and avoiding malpractice liability, and there is little if any discussion of truly moral considerations. That said, PATENT ETHICS does an excellent job of identifying the many potential “ethical” pitfalls confronting these practitioners, in a manner that is comprehensive, up-to-date and practical, filling an important niche that to my knowledge is not addressed in any other book. It also provides practical advice on best practices, along with exemplary language for use in written communications with clients and potential clients, and should be a welcome addition to the bookshelf of many patent prosecutors.

The book is co-authored by David Hricik, a law professor with substantial practice experience, and Mercedes Meyer, an attorney whose practice

focuses on patent prosecution in the area of biopharmaceuticals. As correctly noted by Stanford's Professor Mark Lemley on the book's back cover, "David Hricik is the nation's leading expert on patent ethics". He has written extensively on professional responsibility in patent practice, both prosecution and litigation related, and this book is in large part the product of a consolidation and updating of his previous publications in this area.

According to the authors, and I do not doubt that this is true, malpractice claims based on the alleged violation of the standards of professional responsibility or other errors in patent prosecution have increased dramatically in recent years, both in number and the severity of the consequences (p.2), making the book particularly timely. The book reports that firms practicing patent law have recently displaced securities law firms for the unenviable distinction of the highest cost for malpractice insurance (p.2). Law firms and practitioners are not the only ones at risk; ethical missteps by practitioners, inventors, and other individuals involved in patent prosecution can result in a finding of inequitable conduct, potentially rendering a valuable patent unenforceable. The stakes are high, and the book's succinct, thorough and up-to-date treatment of the subject provides much-needed guidance for practitioners seeking to minimize and manage the risk.

The authors begin by explaining the scope of authority granted to patent practitioners registered to practice before the U.S. Patent and Trademark Office (PTO), and perhaps more importantly, the limits on that authority, which if exceeded can constitute the unauthorized practice of law, an ethical violation. One aspect of patent prosecution that distinguishes it from other legal practices is the ability of non-lawyer patent agents to perform many of the legal tasks performed by patent attorneys. However, as non-attorneys, patent agents only have authority to represent applicants before the PTO "in the preparation and prosecution of patent applications," and thus assisting clients in related matters such as opinion work, licensing, or contracts can easily lead to the unauthorized practice of law by the patent agent. In 2008, the PTO issued formal guidance delineating a more narrowly circumscribed range of permissible prosecution-related activities for patent agents than many had previously assumed. The book summarizes the guidance, and discusses the important implications for patent agents and attorneys who work with patent agents.

In Chapter 3 the book identifies and summarizes the various state, federal, and model codes of professional conduct that can apply to patent practitioners. In some cases, there can be a conflict between the ethical

obligations dictated by state law and the PTO Code of Professional Conduct, potentially rendering it difficult if not impossible for a practitioner to satisfy both. Resolution of the conflict could depend on whether the PTO Code preempts state law, but unfortunately it is currently unclear whether courts will apply preemption in this context. The authors make a strong case for preemption, but conclude with the sound practical advice that a practitioner should seriously consider following the more stringent of the potentially applicable standards to avoid becoming the test case to address the issue (p.19).

The book also addresses problems a practitioner might encounter relating to client identity. For example, an inventor might assume that the practitioner is her lawyer, when in fact it is the inventor's employer, or perhaps another third party who has retained the practitioner, that is actually the client to whom the practitioner's allegiance must lie. The authors provide practical advice for clarifying the relationship between inventor and practitioner early on to minimize misunderstanding and a potential lawsuit (p.37).

Some of the thorniest issues facing patent prosecutors arise as a consequence of potential conflicts between duties owed to the client and to the PTO. For example, the PTO Code of Professional Conduct imposes a duty of candor on patent practitioners, which can conflict with the duties of loyalty and confidentiality set forth in the Model Code of Professional Responsibility, the Model Rules of Professional Conduct, and state disciplinary rules. Resolution of the conflict might vary from state to state, and could depend on whether the state standards of responsibility are preempted by the federal PTO code, and as pointed out in the book there currently is no clear answer. In fact, in some situations it might be impossible for a practitioner to maintain compliance with all of the rules. The authors effectively explain the nature of the conflict and provide advice to help practitioners deal with the situation should it arise or, better yet, avoid getting into the situation altogether.

When a patent is litigated, it has become common for the alleged infringer to accuse the patent owner of inequitable conduct in order to render the patent unenforceable. These claims are most often rooted in allegations of prosecution misconduct by the applicant and/or practitioner, such as a failure to comply with the duty of candor. If inequitable conduct is shown, the consequences can be severe, not only for the patent owner, but also for the practitioner who might become the subject of a malpractice lawsuit or professional sanctions. It is thus appropriate that a large part of the book is devoted to the duty of candor and inequitable conduct, running through

many of the various prosecution scenarios that have led to allegations of inequitable conduct, and providing guidance to practitioners for minimizing the risk.

The primary message I took away from reading the book is that patent prosecution is a professional responsibility minefield, and there are practices that raise the risk of stumbling upon a mine, but there are also practical strategies for minimizing the risk. For example, representing multiple clients attempting to patent inventions relating to similar subject matter can leverage the technical expertise of a practitioner or law firm, but also increases the potential for conflicts. Movement of attorneys from one firm to another, particularly when partners bring a large number of cases and clients to the new firm, likewise increases the potential for conflicts. A firm or attorney that chooses to both litigate and prosecute patents takes on additional risk, particularly in cases where the same firm that prosecuted a patent attempts to represent the client in an infringement litigation involving the same patent. The authors do a good job of explaining the risks, and providing recommendations of best practices for ameliorating risk.

Another point brought out by the book is that in many cases it would be impractical or cost prohibitive for a firm to adopt practices that would wholly eliminate the risk of creating an inadvertent conflict. The authors recognize the practical limitations on real-world legal practice, and identify the current prevalent practice by law firms (p.157), which is often less than optimal for avoiding conflict but which is all that is possible without becoming so costly that it would be too expensive for clients.

Although in my view the primary audience for this book will be practitioners, it will also be of interest to academics and judges seeking a concise treatise on the topic. The authors not only provide practical advice for dealing with the law as it currently stands, but also point out problems and policy concerns with the current state of the law, as well as some practical solutions. For example, some recent inequitable conduct decisions seem to adopt an overly expansive view of the duty to disclose, which not only overburdens the patent examiner but also increases costs for the clients (p.158). It also creates a Catch-22 for the patent applicant, who might one day be charged with disclosing too many references and thereby burying the key references. The book implies that judges on the Federal Circuit could do a better job of deciding inequitable conduct cases in a manner that creates the proper incentives for candid disclosure without unnecessarily imposing vague and onerous disclosure requirements on patent practitioners and their clients (pp.152-54).

Although overall the book will serve as a valuable resource for patent prosecutors, some sections provided little substantive value and struck me as unnecessary filler. For example, in Chapter 7 the authors explore the ethical duty of competency in the context of patent prosecution by addressing various substantive aspects of patent law and practice. Some of the observations in this chapter struck me as painfully obvious. For example, the authors state that "[a]lthough electrical engineers and mechanical engineers can frequently prosecute patents in each other's area, many biotechnology practitioners would not feel comfortable prosecuting applications directed to semiconductors or software" (p.77). Belaboring the point, they observe that "a mechanical engineer or electrical engineer might be no more competent in discerning the best ways to claim a stem cell and obviate the existing part, than a practitioner with a doctoral or masters degree in molecular biology necessarily would be in working on subject matter relating to microchip design or laser design" (p.79). The audience for this book is sophisticated enough not to need this sort of mundane advice.

The substantive aspects of patent law and patent prosecution extend well beyond the scope of a book such as this, which is focused on professional responsibility, and I think much of Chapter 7 could have been omitted. In some cases, the authors provide very specific advice on claim drafting, for example, where they assert that "stem cells today are better claimed in a product-by-process claim, as the full understanding of the subject matter defies ready description as a product" (p.78). But only a small fraction of readers will be drafting claims to stem cells, and those that are presumably have thought through the various alternate ways for claiming them, so why include this in the book? At the other extreme, the book provides cursory treatment to patent doctrines such as the definiteness and best mode requirements, which I also suspect most readers would find unhelpful. This book will be primarily of interest to patent practitioners, who are well aware of the basic doctrines of patentability, and for those who don't there are already fine treatises on patent law which provide extensive coverage of these topics.

Another section of the book I found to be unnecessary filler is Appendix 3, which provides a 26-page list of final decisions by the PTO Office of Enrollment and Discipline (OED). Anyone interested in looking at these decisions can access them online. The authors provide brief parentheticals characterizing the decision, e.g., "practitioner was excluded on consent from practice before the USPTO," or "practitioner was suspended for an

indeterminate period from practice before the USPTO," but without further analysis I don't see that the list provides any substantive value to readers.

While in my view some of the book's content could have been omitted, its inclusion is consistent with the authors' clear intent to provide a thorough, comprehensive, and up-to-date treatise on this important and timely topic. Overall, I see the book as a valuable contribution to the literature, filling an important need. In the future, when I have any question involving patent prosecution and professional ethics, I am sure that PATENT ETHICS will be the first place I turn.