

The IP Law Book Review

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PATENT ETHICS: LITIGATION, by **David Hricik**. Oxford University Press, 2010. 270 pp. Paperback \$225.00.

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Ethics in patent litigation is important to attorneys, not only for moral reasons, but also because of the possibility of extreme judicial sanctions. Many litigators know of the controversy in the high profile patent infringement lawsuit between Broadcom Corporation and Qualcomm Inc., which was heard in federal court in the Southern District of California. There, during the course of a jury trial, a witness's testimony revealed that relevant documents had not been produced to opposing counsel. Shortly thereafter, the magistrate judge referred six Qualcomm attorneys to the State Bar of California for disciplinary proceedings for the alleged non-production of documents. The legal press reported the story and patent litigators took note. After further proceedings, the sanctions were eventually lifted, but by that time, significant damage had already been inflicted upon the attorneys' reputations and careers. Given that many in the community are concerned about this issue, Professor David Hricik's book on ethics in patent litigation is extremely timely.

Professor Hricik is one of the leading scholars on patent ethics. The present book is the second of his two volume treatise on ethics. His previous book, **PATENT ETHICS: PROSECUTION** (co-authored with Mercedes Meyer), was [favorably reviewed](#) by Professor Christopher M. Holman of the University of Missouri - Kansas City School of Law.¹ In the first book, Professor Hricik addressed ethical issues related to practice before the United States Patent & Trademark Office. Now, Professor Hricik has turned his attention to practice in patent litigation, which mainly occurs in U.S. district courts. Both books are geared toward practitioners, not academics, which explains the somewhat hefty price of \$225 for each book.

In the current book, Professor Hricik steers the reader through many aspects of patent litigation. The book is well organized and thoughtfully arranged. The Table of Contents contains sufficient detail to enable a reader to quickly locate relevant sections of the book. There is also a useful and detailed Index, as well as a Table of Cases, both of which facilitate use of the book.

Additionally, the book is relatively thorough on each topic which it covers. For example, Chapter 3 of the book is devoted to conflicts of interest in litigation. The book reiterates the basics such as identifying who is the client and determining when an attorney-client relationship has been formed, and then explains the rules on conflicts of interest relating to former clients (pp.15-61). Of particular use, after discussing the “substantial relationship” test, the book provides a table with summaries of Federal Circuit decisions both finding a substantial relationship and not finding a substantial relationship (pp.50-53). The chapter concludes with an in-depth analysis of consents to conflicts, and of other reasons for denial of disqualification (pp.62-75).

The book also has a detailed discussion of pre-trial investigations. While many attorneys are familiar with the contours of Rule 11 in general, Professor Hricik explains the nuances of pre-filing investigations in patent litigation in Chapters 5 and 6. He recounts the Federal Circuit case law on what constitutes an adequate factual investigation of the accused product (pp.94-101). He also sets forth various ethical constraints with which attorneys may be less familiar. For example, most lawyers understand that they may not directly communicate with a represented party under ABA Model Rule 4.2; rather, they must interact with the party’s attorney (pp.107-109). But the book expands upon the basic understanding of the rule to identify gray areas in the law, such as how long before the filing of a lawsuit the rule applies (pp.109-111). Furthermore, common situations confronted in patent litigation, such as contacting current employees through web sites of the opposing party, are discussed (p.115).

Patent litigators rely heavily on expert witnesses. These witnesses testify about a range of issues including infringement, validity and inequitable conduct. The book provides straightforward information and advice about expert witnesses and reports. It then provides more detailed information about conflicts and disqualification of experts in Chapter 8. For instance, the book explains that disqualification may be warranted if a first party’s expert received confidential information from the opposing party, typically when the opposing party was considering engaging the expert (pp.154-165).

While most attorneys generally understand how to assist in preparation of an expert report, few understand the applicable rules on conflicts dealing with experts. Particularly practical, the book sets forth a checklist of best practices for dealing with experts (pp.174-77). These include ensuring that employee confidentiality agreements are broad, and asking the expert early in the engagement about prior work for the opposing party or counsel.

Many of the areas discussed in the book have not been directly addressed by Federal Circuit case law. For example, conduct during discovery is rife with potential ethical issues. The parties resolve most discovery disputes, often after considerable argument and discussion. Sometimes a disagreement lingers and is brought to the trial court's attention. Then, the district court judge (or the magistrate judge) must rule on a motion to compel, a motion for a protective order, or some other discovery motion. These orders and rulings generally are not immediately appealable as they are not final orders. Consequently, it is rare for these to ever make their way to the Federal Circuit. This explains why there is only a very small body of appellate case law relating to discovery in patent cases. Professor Hricik's book had the ability to make a significant dent in this lack of knowledge. However, I found his section on discovery slightly unsatisfying; it was less than ten pages (pp.182-89). I fully recognize that it is difficult to discuss and analyze the numerous potential discovery issues that can occur in patent litigation. However, because ethics play a significant role in discovery, more attention is warranted.

In some areas, the law has substantially developed in the brief time period (several months) since publication of Professor Hricik's book. For example, district courts have occasionally restricted access to lawyers involved in patent prosecution from certain highly confidential documents exchanged in patent litigation. These restrictions are located in protective orders and are usually called "prosecution bars." In May 2010, the Federal Circuit decided a case of first impression about this very issue, *In re Deutsche Bank Trust Co. of America*.² The *Deutsche Bank* case provides the first guidance on prosecution bars by the Federal Circuit, and was not yet issued at the time of the book's publication. Professor Hricik rightly notes the issue of prosecution bars in protective orders in Chapter 10, but given his study of the issue, it is unfortunate we do not have his interpretation of the case or his suggestions about how to approach prosecution bars in the future.

Finally, the book should spend more space on the relationship between opinion counsel and trial counsel. Opinion and trial counsel both represent the same client with similar goals. Because privilege is typically waived for

work performed by opinion counsel (and it is rarely, if ever, waived for work performed by trial counsel), much thought must be given as to how to structure and organize the relationship among the client, opinion counsel and trial counsel. Advice from Professor Hricik on this issue would have been helpful. While the book explains the Federal Circuit case law on this issue including a discussion of *In re Seagate* and *In re Echostar* in Chapter 10, and walks the reader thru the various ethical rules including the prohibition in some model ethical rules on lawyers acting as both witnesses and advocates, the book does not propose best practices or other guidelines for practicing attorneys.

While the book is not perfect, it is an important reference for patent litigators. Despite its minor shortcomings, some of which I have noted, the book is a significant and useful addition to the scant literature on patent litigation ethics. Not only is this book currently the best resource available on the topic, its thoroughness will make it essential to litigators for years to come.

ENDNOTES

¹ 1 *The IP Law Book Review* 40 (2010).

² *In re Deutsche Bank Trust Co. Ams.*, 605 F.3d 1373 (Fed. Cir. 2010).

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