Patent Litigation

Second Edition

Edited by Laurence H. Pretty

This release to Patent Litigation includes updates of four chapters, providing you with the information and strategies you need to litigate patent cases successfully. Contributors for this release are John M. Skenyon (chapter 2), Andrei Iancu and Amir Naini (chapter 3), Karen A. Jacobs, Megan E. Dellinger, and Eleanor G. Tennyson (chapter 5), and David W. Beehler, Munir R. Meghjee, and David A. Prange (chapter 12). With this release, Practising Law Institute welcomes Karen A. Jacobs, Megan E. Dellinger, and Eleanor G. Tennyson as contributors. The release adds new material on the following topics and others:

Investigation before suit—attorney fees under 35 U.S.C. § 285: The inadequacy of a pre-suit investigation has for some time been an important factor in finding a case “exceptional” and awarding attorney fees under section 285, but Federal Circuit precedents had limited the remedy. The Supreme Court’s 2014 decisions in Octane Fitness LLC v. ICON Health & Fitness, Inc. and Highmark, Inc. v. Allcare Health Management Systems, Inc. have made it much easier (at least theoretically) to obtain attorney fees under section 285 based on pre-litigation conduct. See § 2:1.1, at note 13.2.

Pleading direct infringement: There is a split among courts as to whether the model complaint for direct infringement set forth in Form 18 of the Federal Rules of Civil Procedure satisfies the Twombly standard for pleading direct infringement. In September 2014, the Judicial Conference of the United States approved rules changes that included abrogation of the appendix of forms in the Federal Rules. If approved by the Supreme Court, the elimination of Form 18 would resolve the split and presumably heighten the pleading requirements for direct infringement. See § 3:2.1, at note 15.1.

Discovery—scheduling orders: In addition to the relevant Federal Rules of Civil Procedure, individual districts may have scheduling practices unique to patent cases. For example, the Eastern District of Tex-
as has implemented an alternative case management procedure called “Track B” involving accelerated infringement and invalidity contentions, sales figures and alleged damages disclosures, and early claim construction. See § 3:6, at note 173.1.

Joint defense privilege: The joint defense privilege (or “common interest” privilege) allows attorneys representing different clients to share privileged information in furtherance of a joint effort. It is fundamental in infringement cases where multiple defendants (or plaintiffs) must collaborate. Particularly with the increasing prevalence of suits by non-practicing entities, many defendants now seek to coordinate a defense for common issues asserted against them and to shield that information from disclosure by asserting the joint defense privilege. Rather than being a standalone privilege, this privilege is more properly understood as an exception to the rule that disclosure to a third party ordinarily waives any claim of attorney-client privilege. See new § 5:2.4.


Subpoenas under Rule 45: Federal courts have generally made a smooth transition to the recent Rule 45 amendments, although there has been some disagreement regarding the amendments’ applicability to cases that were pending as of the December 1, 2013, effective date. See § 12:6.1[D], at note 41.

Expert witnesses at trial: Revised and updated discussion of experts focuses on key considerations in presenting the testimony of technical experts; technical and fact experts; legal experts; and damages experts. See § 12:6.3[A]–[D].

The Table of Authorities and the Index have also been updated.
FILING INSTRUCTIONS

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