

*This is your Release #6 (April 2015)*

# 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-

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1177 Avenue of the Americas  
New York, NY 10036  
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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.

**Work product immunity—inadvertent waiver:** As with attorney-client privilege, including provisions in the protective order agreeing that any inadvertent disclosure of work product be handled in accordance with Rule 502 of the Federal Rules of Evidence and Rule 26(b)(5)(B) of the Federal Rules of Civil Procedure can aid in preserving work product protection for inadvertently produced documents. See § 5:5.2, at note 332.1.

**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

## Patent Litigation

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