

Table of Contents

CHAPTER 1. INTRODUCTION TO PATENTS AND TRADE SECRETS

- § 1:1 Introduction to patents
- § 1:2 Introduction to trade secrets

CHAPTER 2. SUBJECT MATTER JURISDICTION

- § 2:1 Introduction
- § 2:2 Justiciability—Case or controversy; Mootness; Standing; Ripeness—Case or controversy
 - Mootness and advisory opinions
 - § 2:4 —Standing
 - § 2:5 —Ripeness
- § 2:6 28 U.S.C.A. § 1338(a)—Jurisdiction of federal district courts over civil actions relating to patents
 - § 2:7 —Arising under—The legal standard
 - § 2:8 —Application of § 1338(a)
- § 2:9 28 U.S.C.A. § 1338(b)—Jurisdiction of federal district courts over unfair competition claims
 - § 2:10 —Claim of unfair competition
 - § 2:11 —A substantial claim
 - § 2:12 —A related claim
- § 2:13 28 U.S.C.A. § 1331—Federal question jurisdiction
- § 2:14 28 U.S.C.A. § 1332—Diversity jurisdiction
- § 2:15 28 U.S.C.A. § 1367—Supplemental jurisdiction
- § 2:16 Declaratory judgment jurisdictional requirements
 - § 2:17 —Actual controversy
 - § 2:18 —Discretionary exercise of jurisdiction
 - § 2:19 —Potential or accused infringer suits
 - § 2:20 —Reasonable apprehension of suit
 - § 2:21 —Requirement of potentially infringing conduct or meaningful preparations therefor
- § 2:22 —Patentee declaratory judgment actions
- § 2:23 Federal appellate jurisdiction
- § 2:24 —Statutory basis of jurisdiction
- § 2:25 —Power to decide jurisdiction
- § 2:26 —Final decisions and interlocutory orders
- § 2:27 —Jurisdiction dependent on jurisdiction of lower court
- § 2:28 —Timeliness of appeal

APPENDIX 2-1. Reasonable Apprehension Checklist

CHAPTER 3. PERSONAL JURISDICTION

- § 3:1 Introduction

- § 3:2 Direct and derivative personal jurisdiction
- § 3:3 —Based upon relationship with another
- § 3:4 —Fiduciary shield doctrine
- § 3:5 Constitutional limitations on exercise of personal jurisdiction—Summary
- § 3:6 —Minimum contacts
- § 3:7 —Purposeful activity directed toward the state
- § 3:8 —“Arising out of” requirement for specific jurisdiction
- § 3:9 Rules relating to personal jurisdiction and service—General provisions
 - Waiver of service procedure
 - Method of service
 - § 3:12 —Service in a foreign country
 - § 3:13 —Service on governmental entities
 - § 3:14 Statutes relating to personal jurisdiction and service
 - § 3:15 Waiver of personal jurisdiction and insufficient service defenses
 - § 3:16 Application of state long-arm statutes
 - § 3:17 —Transaction of business within the state
 - § 3:18 —Commission of a Tortious Act within the state
 - § 3:19 —Use or possession of property within the state
 - § 3:20 —“Arising out of” requirement
 - § 3:21 —Long-arm statutes relating to general personal jurisdiction
 - § 3:22 Challenging personal jurisdiction and service of process—Personal jurisdiction
 - § 3:23 —Process and service of process

APPENDIX 3-1. Alter Ego Checklist

APPENDIX 3-2. Agency Checklist

APPENDIX 3-3. Minimum Contacts Checklist

CHAPTER 4. VENUE

- § 4:1 Introduction
- § 4:2 The general venue statute—Summary
- § 4:3 —28 U.S.C.A. § 1331(a)—Jurisdiction founded solely on diversity
 - Subdivision (a)(1)—District where any defendant resides, if all defendants reside in the same state
 - § 4:5 —Subdivision (a)(2)—District in which a substantial part of the events or omissions giving rise to the claim occurred
 - § 4:6 —Subdivision (a)(3)—Catchall venue provision
- § 4:7 —28 U.S.C.A. § 1332(b)—Suits where jurisdiction is not founded solely on diversity
 - § 1332(b)(1)—A judicial district where any defendant resides, if all defendants reside in the same state
 - § 4:9 —§ 1332(b)(2)—A judicial district in which a substantial part of the events or omissions giving rise to the claim occurred

TABLE OF CONTENTS

- § 4:10 —28 U.S.C.A. § 1391(c)—Definition of residence for corporations
- § 4:11 —28 U.S.C.A. § 1391(d)—Suits against aliens
- § 4:12 —28 U.S.C.A. § 1391(e)—Suits against the United States, or agencies, officers or employees of the United States in their official capacities
- § 4:13 —28 U.S.C.A. § 1391(f)—Suits against foreign states
- § 4:14 28 U.S.C.A. § 1400(b)—The patent venue statute—Summary
- § 4:15 —Where the defendant resides
- § 4:16 —Alternative basis for patent venue—Where the defendant has committed acts of infringement
- § 4:17 ——Where the defendant has a regular and established place of business
- § 4:18 Miscellaneous venue provisions
- § 4:19 Appellate review of venue orders

CHAPTER 5. TRANSFER AND REMOVAL

- § 5:1 Introduction
- § 5:2 28 U.S.C.A. § 1404 and Forum non conveniens—Forum non conveniens
- § 5:3 —28 U.S.C.A. § 1404(a)—Summary
- § 5:4 ——Where the action might have been brought
- § 5:5 ——Convenience of the parties and witnesses
- § 5:6 ——In the interest of justice
- § 5:7 —Review of 28 U.S.C.A. § 1404 transfer orders
- § 5:8 Dismissals and transfers under 28 U.S.C.A. § 1406
- § 5:9 Transfer for purposes of coordination of pretrial procedures
- § 5:10 Transfer under 28 U.S.C.A. § 1631
- § 5:11 Removal and remand

APPENDIX 5-1. Transfer Checklist

CHAPTER 6. JUDICIAL ADMINISTRATION OF MULTIPLE PROCEEDINGS AND MULTIPLE CLAIMS

- § 6:1 Introduction
- § 6:2 Conservation of judicial resources
- § 6:3 First-filed rule
- § 6:4 Stay of litigation—In general
- § 6:5 —Involving federal and state courts
- § 6:6 —Enjoining other litigation—In general
- § 6:7 ——Enjoining state litigation
- § 6:8 Stays involving a pending Patent Office proceeding—Summary
- § 6:9 —Reexamination proceedings
- § 6:10 —Proceedings on a reissue application
- § 6:11 —Interference proceedings
- § 6:12 Appellate review of orders

- § 6:13 Consolidation
- § 6:14 Separate trials and severance

CHAPTER 7. PARTIES AND IMMUNITIES

- § 7:1 Introduction
- § 7:2 Parties in general
- § 7:3 Joinder
 - Rule 19(a)—Necessary parties
 - § 7:5 —Rule 19(b)—Indispensable parties
 - § 7:6 —Necessary and indispensable parties in patent infringement litigation
 - § 7:7 —Other joinder rules
 - § 7:8 —Related rules
 - § 7:9 Intervention
 - § 7:10 Substitution of parties
 - § 7:11 Immunities—Introduction
 - § 7:12 —Federal sovereign immunity
 - § 7:13 —State sovereign immunity
 - § 7:14 —Foreign Sovereign Immunities Act

CHAPTER 8. PLEADINGS AND RELATED MOTION PRACTICE

- § 8:1 Introduction
- § 8:2 Generally applicable requirements
- § 8:3 Rule 11 obligations
- § 8:4 Defenses and objections: Rule 12 practice—In general
- § 8:5 —Rule 12(b)(6) motions to dismiss for failure to state a claim
- § 8:6 —Timing and effect of filing a Rule 12 motion
- § 8:7 —Treating certain Rule 12 motions as motions for summary judgment
- § 8:8 —Motion for more definite statement
- § 8:9 —Motion to strike
- § 8:10 —Effect of failing to raise specified defenses
- § 8:11 Counterclaims and cross-claims
- § 8:12 —Compulsory counterclaims
- § 8:13 —Permissive counterclaims
- § 8:14 —Adding counterclaims
- § 8:15 —Cross-claims
- § 8:16 —Adding parties for counterclaims or cross-claims
- § 8:17 Impleader claims
- § 8:18 Amending pleadings—In general
- § 8:19 —Amended contentions
- § 8:20 —Amendment of pleadings to conform to the evidence
- § 8:21 —Effective date of amended pleadings
- § 8:22 Supplemental pleadings
- § 8:23 Dismissals
- § 8:24 Default judgment

TABLE OF CONTENTS

CHAPTER 9. LIMITS ON JUDICIAL CONSIDERATION: LAW APPLIED AND PRECLUSION DOCTRINES; PREEMPTION

- § 9:1 Introduction
- § 9:2 *Stare decisis*
- § 9:3 Law applied
- § 9:4 *Res judicata*—Claim preclusion
- § 9:5 *Collateral estoppel*—Issue preclusion—In general
- § 9:6 —Mutuality of estoppel—*Blonder-tongue*
- § 9:7 Law of the case
- § 9:8 Judicial estoppel—Preclusion of inconsistent positions
- § 9:9 Preemption

CHAPTER 10. PRELIMINARY INJUNCTIVE RELIEF

- § 10:1 Introduction
- § 10:2 Temporary restraining orders
- § 10:3 Basics of preliminary injunctions
- § 10:4 Standards for preliminary injunctions in patent litigation
- § 10:5 —Reasonable likelihood of success on the merits
- § 10:6 —Irreparable harm
- § 10:7 —Balance of hardships
- § 10:8 —The public interest
- § 10:9 Standards for preliminary injunctions in trade secret litigation
- § 10:10 Federal Rules of Civil Procedure requirements

APPENDIX 10-1. Preliminary Injunctive Relief Checklist

CHAPTER 11. PRELIMINARY DEFENSES BASED UPON DELAY OR DEALINGS BETWEEN THE PARTIES: LIMITATION OF ACTIONS, LACHES AND ESTOPPELS

- § 11:1 Limitation of actions
- § 11:2 —35 U.S.C.A. § 286 Limitation on recovery of damages in patent litigation
- § 11:3 —Trade secret statutes of limitations
- § 11:4 Laches
- § 11:5 —Unreasonable and unexcused delay
- § 11:6 —Material prejudice
- § 11:7 —Presenting proof on laches
- § 11:8 Equitable estoppel
- § 11:9 Assignor estoppel

CHAPTER 12. DISQUALIFICATIONS

- § 12:1 Judicial disqualification
- § 12:2 —28 U.S.C.A. § 144

- § 12:3 —28 U.S.C.A. § 455 and Canon 3.E.
- § 12:4 —Judicial bias
- § 12:5 —Financial interest
- § 12:6 —Remedies
- § 12:7 Attorney disqualification—In general
- § 12:8 —Commonly applicable rules
- § 12:9 —Common disqualification situations
- § 12:10 —Waiver of attorney disqualification
- § 12:11 —Equitable considerations
- § 12:12 —Other relief
- § 12:13 Other disqualifications

CHAPTER 13. DISCOVERY

- § 13:1 Introduction
- § 13:2 Discovery in general
- § 13:3 Required disclosures
- § 13:4 —Initial disclosures
- § 13:5 —Disclosure of expert testimony
- § 13:6 —Pretrial disclosures
- § 13:7 Scope of discovery and limits—Relevance and related limitations on discovery
- § 13:8 —Court authority to limit and manage discovery
- § 13:9 —Discovery of trial preparation materials from experts
- § 13:10 —Privileged material and work product protection—Privilege—In general
 - § 13:11 —Application to corporations
 - § 13:12 —Waiver
 - § 13:13 —Crime or fraud exception
 - § 13:14 —Patent practice
 - § 13:15 —Patent acquisition
 - § 13:16 —Communications with patent agents
 - § 13:17 —Work product protection—In general
 - § 13:18 —Protection for materials pertaining to patent office proceedings
 - § 13:19 —Waiver
 - § 13:20 —Claiming privilege or work product protection
 - § 13:21 Protective orders—In general
 - § 13:22 —Trade secret and confidential information
 - § 13:23 Mechanics and timing of discovery—In general
 - § 13:24 —Stay of discovery
 - § 13:25 —Formal requirements
 - § 13:26 Depositions
 - § 13:27 —Rule 30. Deposition upon oral examination
 - § 13:28 —Notice
 - § 13:29 —Method of recording deposition testimony
 - § 13:30 —Person before whom taken and formal requirements
 - § 13:31 —Time and place of taking deposition
 - § 13:32 —Requests for production in connection with deposition of a party

TABLE OF CONTENTS

§ 13:33	—Depositions of organizations
§ 13:34	—Procedure at oral deposition
§ 13:35	—Objections
§ 13:36	—Objections relating to lay testimony on terms having legal significance
§ 13:37	—Limitations on time and impeding depositions
§ 13:38	—Motions to terminate or limit depositions
§ 13:39	—Reviewing the deposition and signing
§ 13:40	—Effect of noticing party's failure to attend or serve subpoena
§ 13:41	—Rule 31. Depositions on written questions
§ 13:42	—Depositions before action and pending appeal
§ 13:43	—Depositions before action
§ 13:44	—Depositions pending appeal
§ 13:45	—Depositions of patent examiners
§ 13:46	—Depositions taken in foreign countries
§ 13:47	Interrogatories—In general
§ 13:48	—Answers and objections
§ 13:49	—Production of business records in lieu of answering interrogatories
§ 13:50	Inspection and production of documents and things
§ 13:51	Requests for admissions—In general
§ 13:52	—Effect of admission
§ 13:53	Subpoena practice and ancillary discovery proceedings—Introduction
§ 13:54	—Service
§ 13:55	—Response
§ 13:56	—Ancillary discovery proceedings (domestic)
§ 13:57	—Ancillary discovery proceedings to assist foreign litigation
§ 13:58	Supplementation of discovery
§ 13:59	Discovery sanctions and Rule 37 practice—Introduction to discovery sanctions
§ 13:60	—Sanctions and practice under the discovery rules
§ 13:61	—Motions to compel disclosure or discovery
§ 13:62	—Motions to compel relating to Rule 26(a) disclosures
§ 13:63	—Motions to compel relating to traditional methods of discovery
§ 13:64	—Expenses and sanctions associated with a motion to compel
§ 13:65	—Sanctions for failure to comply with court order relating to discovery
§ 13:66	—Sanctions not involving disobedience to a court order
§ 13:67	—Discovery sanctions under 28 U.S.C.A. § 1927
§ 13:68	—Discovery sanctions under the inherent power of the court

APPENDIX 13-1. Federal Rules of Civil Procedure Appendix to the

Rules—Form 35: Report of Parties’ Planning
Meeting**CHAPTER 14. INFRINGEMENT**

- § 14:1 Overview
- § 14:2 Claim construction—In general
- § 14:3 —Patentee as own lexicographer
- § 14:4 —Sources of proof
- § 14:5 ——Claims
- § 14:6 ——Specification
- § 14:7 ——Means-plus-function and step-plus-function claims
- § 14:8 ——Prosecution history
- § 14:9 ——Other sources
- § 14:10 —Construction of product-by-process claims
- § 14:11 —Miscellaneous principles of claim construction
- § 14:12 —Transition phrases: “Comprising,” “consisting essentially of,” and “consisting of”
- § 14:13 —Claim format
- § 14:14 Literal infringement—In general
- § 14:15 —Infringement where claim includes “means plus function” limitation
- § 14:16 —Infringement where claim includes “Step Plus Function” limitation
- § 14:17 —Infringement of method or process patents
- § 14:18 —Importation, sale, or use of product made by patented process
- § 14:19 —ANDA Litigation—Technical infringement in connection with certain drug applications
- § 14:20 Claim construction—BPCIA: Biologics Price Competition and Innovation Act Infringement
- § 14:21 Doctrine of equivalents and prosecution history estoppel—In general
- § 14:22 —Scope of the doctrine of equivalents
- § 14:23 —Burden of proof
- § 14:24 —Infringement under the function/way/result test
- § 14:25 —Prior art restriction on the doctrine of equivalents
- § 14:26 —Pioneer patents vs. mere improvements
- § 14:27 —Prosecution history estoppel
- § 14:28 Contributory infringement—Domestic contributory infringement
- § 14:29 —Export of particular components of patented invention
- § 14:30 Inducing infringement—Inducing infringement domestically
- § 14:31 —Export of a substantial portion of components of patented invention for assembly abroad
- § 14:32 Design patent infringement
- § 14:33 Infringement relating to plants—Introduction
- § 14:34 —Plant patent infringement
- § 14:35 —Plant Variety Protection Act

TABLE OF CONTENTS

- § 14:36 —Utility patent protection for plants
- § 14:37 Defenses uniquely related to patent infringement—
 - Introduction
- § 14:38 —First sale or exhaustion
- § 14:39 —Reverse doctrine of equivalents
- § 14:40 —License
- § 14:41 —Bona fide purchaser
- § 14:42 —Shop rights and employer ownership of inventions
- § 14:43 —Repair vs. reconstruction
- § 14:44 —Limitations on damages for infringement of reissue patents and reexamined patents; Intervening rights
- § 14:45 —Regulatory compliance
- § 14:46 —Temporary presence in the United States
- § 14:47 Prior commercial use defense
- § 14:48 Experimental use defense
- § 14:49 Proof of infringement—In general
- § 14:50 —Marking estoppel
- § 14:51 —Relevance to infringement of patents on the accused product or process

APPENDIX 14-1. Infringement Checklist

APPENDIX 14-2. Design Infringement Checklist

Table of Contents

CHAPTER 15. VALIDITY AND ENFORCEABILITY

- § 15:1 Overview—Introduction
- § 15:2 —Burden of proof and burden of going forward
- § 15:3 —Presumption of validity
- § 15:4 —Notification of prior art
- § 15:5 —Effective filing date
- § 15:6 —Corroboration of testimony of invalidity
- § 15:7 Section 101 defenses: Patentable subject matter and utility—Patentable subject matter
 - Utility
- § 15:8 Anticipation and lack of novelty—In general
- § 15:9 —Anticipation under § 102(a)—In general
 - 35 U.S.C.A. § 102(a): Known or used by others in this country before the invention by applicant
 - 35 U.S.C.A. § 102(a): Patented or described in a printed publication before the invention by applicant
- § 15:10 —Anticipation under § 102(b)—In general
- § 15:11 —35 U.S.C.A. § 102(b): Patented or described in a printed publication in this or a foreign country more than one year prior to the date of the application for patent in the United States
 - 35 U.S.C.A. § 102(b): Public use or on sale in this country more than one year prior to the date of the application for patent in the United States—In general
- § 15:12 —Experimental use
- § 15:13 —Public use
- § 15:14 —On sale
- § 15:15 —35 U.S.C.A. § 102(c): Abandonment of the invention
- § 15:16 —Anticipation under 35 U.S.C.A. § 102(d): Patented in a foreign country on an application filed more than twelve months before U.S. application
- § 15:17 —Anticipation under 35 U.S.C.A. § 102(e): Described in application by another filed before invention by applicant
- § 15:18 —35 U.S.C.A. § 102(f): Derivation
- § 15:19 —Anticipation under 35 U.S.C.A. § 102(g): Prior invention by another who did not abandon, suppress or conceal the invention
- § 15:20 Obviousness—Overview
- § 15:21 —The scope and content of the prior art
- § 15:22 —Differences between the claimed invention and the prior art
- § 15:23 —The level of ordinary skill in the art

- § 15:28 —Combination patents
- § 15:29 —Synergism, flash of genius, and other apparitions
- § 15:30 —Commonly applied principles
- § 15:31 —Secondary considerations
- § 15:32 —Analogous and nonanalogous art
- § 15:33 Section 112 defenses—Overview
- § 15:34 —Written description of the invention
- § 15:35 —Enablement
- § 15:36 —Best mode
- § 15:37 —Indefinite claims
- § 15:38 New matter (35 U.S.C.A. § 132)
- § 15:39 Improper inventorship
- § 15:40 Inequitable conduct—In general
- § 15:41 —Requirements
- § 15:42 ——Materiality
- § 15:43 ——Intent
- § 15:44 —Summary judgments and inequitable conduct
- § 15:45 —Cases finding inequitable conduct
- § 15:46 Patent misuse
- § 15:47 Double patenting
- § 15:48 Patent disclaimer
- § 15:49 Design patents
- § 15:50 Reissue patents

APPENDIX 15-1. Patent Validity and Enforceability Master Checklist

APPENDIX 15-2. Experimental Use Checklist

CHAPTER 16. TRADE SECRET MISAPPROPRIATION

- § 16:1 In general
- § 16:2 Existence of a trade secret
- § 16:3 Wrongful acquisition or breach of confidence
- § 16:4 Use or disclosure of the secret without authorization
- § 16:5 Preemption

APPENDIX 16-1. Trade Secret Misappropriation Checklist

CHAPTER 17. SUMMARY JUDGMENT

- § 17:1 In general
- § 17:2 Patent cases found appropriate for summary judgment
- § 17:3 Patent cases found inappropriate for summary judgment
- § 17:4 Trade secret cases found appropriate for summary judgment
- § 17:5 Trade secret cases found inappropriate for summary judgment

CHAPTER 18. EVIDENCE

- § 18:1 Overview
- § 18:2 Judicial notice

TABLE OF CONTENTS

- § 18:3 Presumptions
- § 18:4 Relevant evidence and matters excluded
- § 18:5 Privileges
- § 18:6 Competency and credibility
- § 18:7 Orderly presentation of evidence and interrogation of witnesses
- § 18:8 Opinion testimony—In general
- § 18:9 —Court-appointed experts
- § 18:10 Hearsay—In general
- § 18:11 —Rule 803 hearsay exceptions: Availability of declarant immaterial
- § 18:12 —Hearsay exceptions where the declarant is unavailable
- § 18:13 —Hearsay within hearsay
- § 18:14 Authentication and identification
- § 18:15 Best evidence
- § 18:16 Use of discovery materials as evidence

CHAPTER 19. JURY PRACTICE AND POST-TRIAL MOTIONS

- § 19:1 Introduction and right to jury trial
- § 19:2 Jury instructions
- § 19:3 Form of verdict
- § 19:4 Judgment as a matter of law
- § 19:5 Motion for new trial
- § 19:6 Motion for relief from judgment—In general
- § 19:7 —Savings clause

CHAPTER 20. REMEDIES

- § 20:1 Introduction
- § 20:2 Injunctions in patent litigation
- § 20:3 Damages in patent litigation—In general
- § 20:4 —Lost profits
- § 20:5 —Lost profits on sales of unpatented accessory items
- § 20:6 —Reasonable royalty
- § 20:7 —Increased damages—Overview
- § 20:8 ——Willful infringement
- § 20:9 ——Copying or lack of copying by infringer
- § 20:10 ——Infringer's actions after becoming aware of patent
- § 20:11 ——Obtaining competent legal advice
- § 20:12 ——Failure to obtain an opinion
- § 20:13 ——Infringer's good faith or lack thereof
- § 20:14 ——Willfulness based upon commercial reasons
- § 20:15 ——Miscellaneous willfulness factors
- § 20:16 ——Bad faith justifying increased damages
- § 20:17 ——Amount of increase
- § 20:18 —Prejudgment interest
- § 20:19 —Marking/notice requirement for recovery of damages

§ 20:20 —Recovery of infringer's profit as remedy for design patent infringement

§ 20:21 Attorney's fees in patent litigation

§ 20:22 Injunctions in trade secret litigation

§ 20:23 Damages in trade secret litigation

§ 20:24 Attorney's fees in trade secret litigation

§ 20:25 False patent marking

§ 20:26 Award of costs

APPENDIX 20-1. Reasonable Royalty Checklist

APPENDIX 20-2. Proof of Copying Checklist

APPENDIX 20-3. Proof of Lack of Copying Checklist

APPENDIX 20-4. Competence of Legal Advice Checklist

APPENDIX 20-5. Willfulness Factors Checklist

APPENDIX 20-6. Increased Damages Discretion Checklist

CHAPTER 21. CONTEMPT AND NON-DISCOVERY SANCTIONS

§ 21:1 Introduction to contempt

§ 21:2 Criminal contempt

§ 21:3 Civil contempt

§ 21:4 Contempt in the context of patent litigation

§ 21:5 Contempt sanctions

§ 21:6 Non-discovery sanctions

§ 21:7 Rule 11

§ 21:8 —Improper purpose

§ 21:9 —Warranted by existing law or by nonfrivolous argument

§ 21:10 —Prefiling inquiry

§ 21:11 —Sanctions under Rule 11

§ 21:12 Sanctions under 28 U.S.C.A. § 1927

§ 21:13 Sanctions under the court's inherent power

§ 21:14 Appellate sanctions—In general

§ 21:15 —Rule 38 sanctions

§ 21:16 Cases holding sanctions inappropriate

§ 21:17 Cases imposing or upholding sanctions

CHAPTER 22. MALPRACTICE IN PATENT LITIGATION AND PROSECUTION

§ 22:1 Overview

§ 22:2 Elements of a tort malpractice claim

§ 22:3 Elements of a contract malpractice claim

§ 22:4 Existence of an attorney-client relationship

§ 22:5 Breach of fiduciary duty

§ 22:6 Negligence

§ 22:7 Fraud and fraudulent concealment

§ 22:8 Venue and choice of law

§ 22:9 Standard of care

TABLE OF CONTENTS

- § 22:10 State rules of ethics and Patent and Trademark Office rules relating to competent legal representation
- § 22:11 Time at which malpractice is assessed
- § 22:12 Damages
- § 22:13 Causation
- § 22:14 Case within a case
- § 22:15 Subject matter jurisdiction
- § 22:16 Personal jurisdiction
- § 22:17 Asserted malpractice
- § 22:18 Statute of limitations
- § 22:19 Failure to advise
- § 22:20 Standing and assignment of malpractice claims
- § 22:21 Professional judgment immunity
- § 22:22 Stay of malpractice actions
- § 22:23 Evidence

CHAPTER 23. USITC PROCEEDINGS

- § 23:1 Introduction
- § 23:2 Procedural overview
- § 23:3 The public interest
- § 23:4 Participants and responsive pleadings
- § 23:5 Preliminary (temporary) relief
- § 23:6 Discovery
- § 23:7 Confidential information
- § 23:8 Motions
- § 23:9 Default
- § 23:10 Claim construction
- § 23:11 Domestic industry
- § 23:12 Summary determination
- § 23:13 Hearing on violation and initial determination
- § 23:14 Commission review
- § 23:15 Remedies
- § 23:16 Appeals
- § 23:17 Sanctions
- § 23:18 Enforcement proceedings
- § 23:19 Proceedings based upon trade secret misappropriation

CHAPTER 24. AIA TRIAL PROCEEDINGS

- § 24:1 Introduction and Overview to AIA Administrative Trials
- § 24:2 Petitions
- § 24:3 Inter Partes Review (IPR)
- § 24:4 IPR Mandatory Notices
- § 24:5 Institution of IPR Proceeding
- § 24:6 IPR Trial Proceedings
- § 24:7 Derivation Proceeding

APPENDICES

APPENDIX A. Federal Rules of Civil Procedure

INTELLECTUAL PROPERTY LITIGATION

APPENDIX B. Annotated Federal Rules of Evidence

APPENDIX C. Title 35: Patents

APPENDIX D. State Civil Trade Secret Laws

Table of Laws and Rules

Table of Cases

Index