

# Patent Prosecution and Malpractice

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## History Repeats

Joint Development: Common Interest Privilege or Joint  
Clients?

Rule 56 or IPRC and/or versus Inequitable Conduct

## Shared Prosecution: Common Interest Privilege or Joint Clients?

Regional Circuit Law Applies.

## Common Cooperation Clause in Prosecution Contracts

- You're counsel (in-house or outside) for Client A.
- You're prosecuting applications for Client A.
- Client A & Party B have a shared prosecution agreement. (Joint development; license; other forms) which has this clause:  
“Client A shall manage and have the primary responsibility to file, prosecute, and maintain the patent applications, but Party B shall have reasonable opportunity to comment and advise on office actions, prosecution, and other filings.”
- Party B has its own lawyers representing it.

## You Do Your Job

- ▶ You send Party B's lawyers emails and updates, as required, and often you label them "privileged and confidential."
  - ▶ Common interest privilege allows for privileged communications to be shared with non-client if non-client shares a common "legal" interest.
- ▶ All is good.

## What's Everyone's(?) Goal?



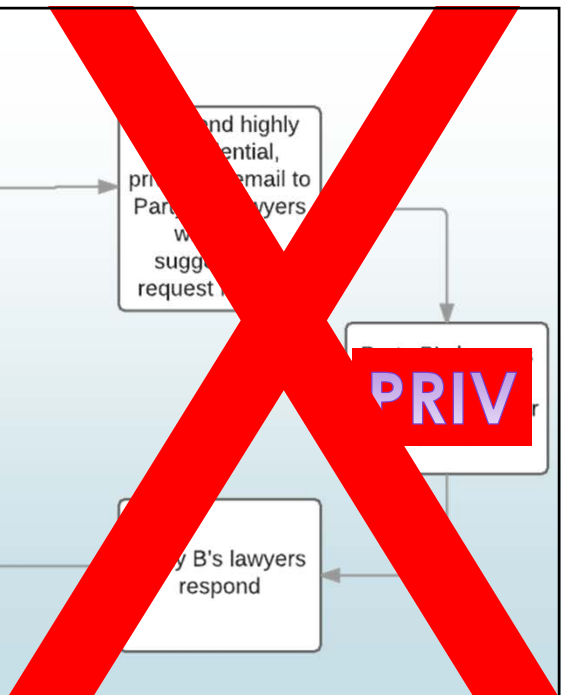
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