

Texas Intellectual Property Law Journal
Spring, 1994

Note

**DISCOVERY OF DRAFT PATENT APPLICATIONS: CONSIDERATIONS IN ESTABLISHING A DRAFT
RETENTION POLICY**

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Table of Contents

I.	Introduction	238
II.	Risks Associated with Draft Retention	239
	<i>A. Risks in Litigation</i>	239
	<i>1. Applicability of Attorney-Client Privilege to Drafts</i>	239
	<i>2. Privilege May be Waived by Voluntary Disclosures to Third Parties</i>	243
	<i>3. Work Product Immunity is Generally Inapplicable to Patent Prosecution Documents</i>	244
	<i>B. Risks in Interference are Mitigated by More Limited Discovery Rules</i>	244
III.	Evidentiary Use of Retained Drafts	246
	<i>A. Drafts as Evidence of a Pre-Filing Date of Invention</i>	246
	<i>1. Patentees Face the Heavy Burden of Proving Conception by Clear and Convincing Evidence</i>	247
	<i>2. Junior Parties in Interference May Face a Similar Burden of Persuasion</i>	248
	<i>3. Requirements for Proving Prior Conception are Typically Met by Draft Patent Applications</i>	248
	<i>B. Limitations on Alternative Sources of Evidence of Conception May Increase the Importance of Drafts</i>	250
	<i>C. Drafts are Overkill as Evidence of Attorney Diligence</i>	252
IV.	Legal and Ethical Issues Raised by Draft Retention	252
V.	Conclusion	253
VI.	Appendix - Proposed Draft Retention Policy	255
	<i>A. On Filing of the Patent Application</i>	255
	<i>B. On Patent Issue</i>	255
	<i>C. One Year After Patent Issue</i>	256

***238 I. Introduction**

Retention of draft patent applications after filing with the Patent and Trademark Office (PTO) creates two significant problems. First, preliminary commentary or speculative information contained in (or on) interim drafts can be obtained by adverse parties through discovery. To the extent that such a notation, or the draft itself, questions the viability of claims, fails to adequately distinguish prior art, or simply presents the invention in a limiting sense, it could be discovered and used against a client in litigation.¹

The second problem is purely practical. Taken together, the collections of drafts created in preparation for submission of patent applications represent a large commitment of space, personnel, and other resources to document storage and retrieval. Costs associated with these commitments support an argument for limitations in the retention period, although a quantitative treatment of these costs is beyond the scope of this note.

Given the above factors, it is legitimate to question the entire practice of draft retention. However, despite the risks, drafts may have some evidentiary value in establishing priority in interference or in countering a challenge to patent validity under sections 102(a), 102(e), or 102(g)² of the patent statute. As disclosures ostensibly meeting the enablement requirement of section 112,³ draft applications may be persuasive as evidence of a pre-filing date of conception. Drafts may be particularly desirable given the heavy burden on a party attempting to prove prior invention⁴ and to meet the corroboration requirements⁵ for inventor testimony. The risks and potential benefits of draft retention vary at each stage in the life of a prosecution or an issued patent. Therefore, an appropriate inquiry is whether, at each stage, the risk associated with discovery by an adverse party is outweighed by the potential evidentiary value of a given class of draft applications.

As a result of these variations in comparative risks and benefits, draft patent applications should be included in a systematized document destruction⁶ program. Legal and ethical considerations require that any draft retention/destruction program be conducted pursuant to consistent standards and to a policy motivated by business concerns.⁷ Ad hoc or selective destruction of drafts may expose the destroying party to sanctions and civil liability. The analysis which follows examines the risks and potential evidentiary benefits of retaining draft applications for use in interference or litigation. In addition, this note proposes a draft retention policy which attempts to balance these risks and benefits. The proposed draft retention policy is presented in an Appendix.

***239 II. Risks Associated with Draft Retention**

A. Risks in Litigation

The risks associated with draft retention are greatest when considered in the context of patent litigation, jury trials, and the discovery process. Under the Federal Rules of Civil Procedure, a party is permitted to discover any relevant matter that is not privileged.⁸ In addition, discovery sought need only appear reasonably calculated to lead to admissible evidence in order to be permitted.⁹ Therefore, unless a retained draft represents privileged matter, it is likely to be discovered by an opposing party in litigation. Ordinarily, the discovery of a draft application should not be damaging; however, a draft may include notes made by the patent attorney (or agent) concerning the scope of claims, distinguishability of the invention over the prior art, etc. Alternatively, a draft may contain preliminary characterizations of the invention which present the invention in a limiting sense or in an unfavorable light. These notes and preliminary characterizations, which would not appear in the final application submitted to the patent office, could be discovered and exploited by opposing counsel to paint an unfavorable picture for the jury.

1. Applicability of Attorney-Client Privilege to Drafts--

The level of protection afforded draft patent applications and other prosecution documents by attorney-client privilege is the subject of some disagreement among the courts. Two lines of cases dominate the opinions. The *Jack Winter, Inc. v. Koratron Co.*¹⁰ line of cases borders on a *per se* rule that excludes documents generated in connection with proceedings before the PTO from protection under the attorney-client privilege.¹¹ In contrast, the *Knogo Corp. v. United States*¹² line of cases views drafts generated in the course of prosecution as part of a dialog between patent attorney and inventor which is subject to attorney-client privilege.¹³ Disagreement between the opposing camps centers on fundamentally different perceptions of the relationship between the patent attorney and the inventor client, viewing the attorney as a mere conduit by the *Jack Winter*

camp and as a counseling attorney by *Knogo* and its progeny.

Courts following the *Jack Winter* line have excluded draft applications from protection under the attorney-client privilege relying on lists of non-privileged communications contained in *Jack Winter*:

(1) Client authorizations to file applications and take other steps necessary to obtain registration;

(2) Papers submitted to the Patent Office;

(3) Compendiums of filing fees and requirements in the United States and foreign countries for various types of applications;

*240 (4) Resumes of applications filed and registrations obtained or rejected (including dates and file or registration numbers);

(5) Technical information communicated to the attorney but not calling for a legal opinion or interpretation and meant primarily for aid in completing patent applications;

(6) Business advices such as that related to product marketing; and

(7) Communications whose confidentiality [has been] waived¹⁴ and *Detection Systems Inc. v. Pittway Corp.*¹⁵ which excluded the following prosecution documents:

[8] Communications which pass through an attorney who acts only as a conduit for a third party;

[9] Transmittal letters or acknowledgment of receipt letters devoid of legal advice or requests for such advice and disclosing no privileged matters . . . End]

[10] Patent disclosures, *draft patent applications*, technical legal material related to the final patent, or studies of the prior art.¹⁶

Although the *Jack Winter* formulation specifically includes technical documents calling for legal opinion or interpretation within the scope of attorney-client privilege,¹⁷ courts have interpreted *Jack Winter* in a manner that results in a *per se* exclusion of prosecution documents containing technical information. Courts following the *Jack Winter* line view the patent attorney as a mere conduit for factual information unprotected by attorney-client privilege.¹⁸ For example, the court in *Hewlett-Packard* held that “[i]n drafting a [prosecution] document . . . an attorney is . . . merely serving as a conduit for factual information. He is not acting primarily as a lawyer.”¹⁹ Denial of attorney-client privilege has also been justified based on an alleged duty to disclose all information in the patent application²⁰ and as unnecessary to promote full and open communication between attorney and client.²¹

*241 In contrast, the Court of Claims in *Knogo Corp. v. United States*²² considered the relationship between patent attorney and client to be cooperative and much more complicated than that envisioned by the *Jack Winter* line of cases.²³ The court recognized that technical discussions between attorney and client enable the attorney to extract one or more patentable inventions for which the attorney then drafts patent applications in accordance with federal statutes and regulations.²⁴ The fact that much of the technical information in one form or another finds its way into the patent application, to be made public when the patent issues, should not preclude the assertion of privilege over the communication in which that information was disclosed.²⁵

Following the reasoning of *Knogo* and rejecting that of *Jack Winter*, the court in *Advanced Cardiovascular Systems Inc. v. C.R. Bard Inc.*,²⁶ ruling on motions to compel production of draft applications, held that attorney-client privilege should attach, presumptively, even to those private communications from the inventor to counsel that consist primarily of technical information and that are made in connection with the preparation or prosecution of a patent application.²⁷ In contrast with the *Jack Winter* viewpoint, the court found that inventors and their patent attorneys often engage in “substantial private dialog as part of the process of shaping and focusing a patent application, and that it is reasonable for them to expect that dialog to remain confidential.”²⁸ Therefore, according to the court, the communications from inventor to patent lawyer, even those that are entirely technical, remain presumptively protected by the attorney-client privilege.²⁹

Several other recent decisions have addressed the discoverability of draft patent applications, relying on the reasoning of *Knogo* and *Advanced Cardiovascular Systems*.³⁰ In each case, the respective court recognized attorney-client privilege and

denied discovery motions to compel the production of draft patent applications.³¹ In *Rohm and Haas*, the court explained that: Drafts often contain information and communications relating to the subject matter of the document, including, for example, proposed material to be included, suggested additions and deletions, and comments on the contents, all of which are intended to be considered confidential between attorney and client and not intended for public disclosure.³²

*242 The court also found that notes made on a draft of the patent application by the attorney were part of this communication and therefore were also protected under attorney-client privilege.³³ Similarly, the court in *Laitram* found that a series of draft patent applications represented an ongoing dialog between the inventor and patent attorney concerning the scope of claims. As such, the court held that the draft applications were protected by attorney-client privilege.³⁴

However, some courts remain committed to a *per se* exclusion of draft patent applications from attorney-client privilege.³⁵ In *Burroughs Wellcome*, although the court announced that it was adopting the *Knogo* position,³⁶ the court indicated in dicta that “[attorney-client] privilege does not extend to drafts of patent applications.”³⁷ In *Stryker*, the court held several draft patent applications not protected by attorney-client privilege³⁸ while leaving open the option that the privilege might attach if the drafts were shown to be created in response to a solicitation of legal advice.³⁹ In *Santrade, Ltd.*, the court endorsed reasoning characteristic of the *Jack Winter* line⁴⁰ and held that attorney-client privilege did not extend to drafts of patent applications.⁴¹

It should also be noted that some courts may refuse to extend the attorney-client privilege to communications with a registered patent agent.⁴² On the other hand, courts have held that attorney-client privilege should be equally available to communications with registered U.S. patent agents and registered U.S. patent attorneys in order not to frustrate the Congressional scheme for providing registration of both.⁴³

In summary, draft patent applications may be protected from discovery by attorney-client privilege in those jurisdictions which follow the *Knogo* line of cases. However, a finding of privilege is not certain, particularly in those jurisdictions which continue to follow the reasoning of *Jack Winter* and its progeny. Furthermore, even in a jurisdiction which follows the *Knogo* line of cases, attorney-client privilege may be unavailable when the subject communication (e.g., in a draft application) is with a *243 registered patent agent rather than with an attorney. The result is privilege whose scope may vary dramatically depending on the forum selected.

2. Privilege May be Waived by Voluntary Disclosures to Third Parties--

Although the existence of attorney-client privilege protection reduces the risk that draft applications will be exploited by adverse parties in litigation, the implications of that privilege should also be considered in the context of potential evidentiary use. Introduction at trial of otherwise privileged drafts as evidence of a pre-filing date of invention raises an issue of waiver.

It is well settled that the client or an authorized representative of the client may waive privilege by voluntary disclosure of the privileged communication to third parties.⁴⁴ Voluntary disclosures that have led to waiver of the attorney-client privilege include the release of documents, testimony at a deposition, trial or hearing, representations in an affidavit, answers to interrogatories, and responses to a document subpoena without objection or through informal exchanges.⁴⁵ For example, in *Mushroom Associates v. Monterey Mushrooms, Inc.*,⁴⁶ declarations by a co-inventor and by the attorney who prosecuted the patent in suit, denying knowledge of the materiality of a foreign patent and denying any intent to deceive the Patent and Trademark Office, were held to have waived attorney-client privilege with respect to all documents related to prosecution of the patent in suit.⁴⁷ Such disclosures destroy not only the confidentiality of the communication disclosed but also the privileged status of related communications and documents.⁴⁸ In contrast, voluntary disclosure of nonprivileged documents has no such effect on related communications.⁴⁹ Consequently, the attachment of attorney-client privilege to draft patent applications under *Knogo* and *Advanced Cardiovascular Systems* raises the issue of waiver.

Voluntary disclosure of draft patent applications, for example as evidence of a pre-filing date of invention,⁵⁰ may result in the waiver of privilege in related communications. Alternatively, voluntary disclosure of the related communications may waive privilege in retained drafts. In either case, courts will not allow the attorney-client privilege to be used both as a sword and as a shield.⁵¹ The privilege holder may not selectively disclose part of a privileged communication, or some of a larger number of communications, that are favorable to the client’s position and then raise the privilege to prevent disclosure of the remaining portions.⁵² Consequently, the client must elect either to use a communication for evidentiary purposes, thereby waiving attorney-client privilege, or preserve confidentiality and the privilege by forgoing its evidentiary use. Courts have often required the client to make this election during pre-trial discovery.⁵³

***244 3. Work Product Immunity is Generally Inapplicable to Patent Prosecution Documents--**

In any discussion of attorney-client privilege, the work product doctrine of *Hickman v. Taylor*⁵⁴ should also be considered. Work product immunity is largely codified in Federal Rules of Civil Procedure and provides a qualified immunity from discovery for documents and tangible things prepared “in anticipation of litigation” by or for a party or its representative.⁵⁵ Unlike attorney-client privilege, work product is a qualified immunity that can be overcome on a showing of substantial need and inability to obtain substantially equivalent information without undue hardship.⁵⁶

In the vast majority of cases, patent prosecution documents are prepared without specific litigation in mind. As a result, work product immunity does not typically extend to prosecution documents prepared such as draft patent applications.⁵⁷ This is not to say that work product immunity is never available to documents prepared in the course of a prosecution.⁵⁸ For example, the general rule that *ex parte* prosecution documents are not prepared in anticipation of litigation and therefore excluded from work product immunity has been qualified with respect to reexamination proceedings,⁵⁹ and documents prepared in the context of protracted legal battles.⁶⁰ However, in evaluating candidate retention policies, it would be imprudent to expect that the circumstances surrounding preparation of a patent application would, in general, extend work product immunity to drafts.

B. Risks in Interference are Mitigated by More Limited Discovery Rules

Interference is an administrative proceeding authorized under 35 U.S.C. § 135⁶¹ to determine which of two or more applicants is the first inventor and thus entitled to a patent. The applicant first in time is called the senior party, and the other is designated the junior party. Interference may be declared between two pending applications or between a pending application and an issued patent, although interference with an issued patent can be declared only if a claim is copied to a pending application within *245 one year of the patent issue date,⁶² or the applicant has claimed substantially the same subject matter (as the issued patent) within the one-year period, or the applicant has claimed the invention all along (including during the one-year period) although seeking to provoke the interference after the one-year period.⁶³ As a result, while an interference must typically be provoked within one year of patent issue, it is possible for an interference to be provoked after the one-year period.

Risks associated with discovery of draft patent applications are more limited in interference for two reasons. First, there is no jury and hence less risk that notations or poorly chosen characterizations will be successfully exploited by opposing counsel to paint an unfavorable picture for the trier of fact. Compared to a jury, the Board of Patent Appeals and Interferences is a relatively sophisticated trier of fact and is more likely to recognize draft applications and marginalia for what they are: early, incomplete attempts to ascertain and describe the invention. Second, patent interference is governed by very different discovery rules than is litigation in the district court.

Whereas discovery under the Federal Rules is extremely liberal,⁶⁴ discovery under interference rules is not. Under interference rules, discovery of documents as a matter of right is limited to⁶⁵ those documents in the “possession, custody, or control” of a party “and upon which [that] party intends to rely at any deposition.”⁶⁶ In other words, in an interference between A and B, B has no right to discover a draft patent application unless A intends to rely upon the draft. This limitation on discovery as a matter of right is independent of any level of protection that may be afforded to drafts under attorney-client privilege.

In the absence of an agreement among parties, additional discovery may be ordered by the examiner-in-chief pursuant to 37 C.F.R. § 1.687, hereinafter Rule 687, and then only upon a showing that the “interest of justice so requires.”⁶⁷ Few reported cases cite Rule 687.⁶⁸ However, precedent interpreting the precursor rule, old Rule 287,⁶⁹ is instructive on two points, particularly in light of the PTO’s statement that “[s]ection 1.687 does not change the standard (‘interest of justice’) for obtaining [additional] discovery.”⁷⁰ First, the cases clearly establish that parties may not subvert Patent Office discovery rules by seeking additional discovery in the courts under 35 U.S.C. § 24.⁷¹ Second, as a general rule under old Rule 287, additional discovery was not viewed as within the “interest of justice” *246 exception unless the request was specified with some particularity,⁷² i.e., not simply a “fishing expedition,” and unless matters sought were relevant to an issue of priority or ancillary to priority.⁷³ A complex body of case law developed, establishing what was and was not ancillary to priority.⁷⁴

Under current PTO practice, the Board may decide questions of patentability as well as questions of priority.⁷⁵ The question of whether a matter is ancillary to priority no longer arises.⁷⁶ However, the requirements that a request for additional discovery be specified with some particularity and relate to specific documents relevant to the subject matter of the interference appear to remain under the new rules. In *Rivier v. Coy*, the Board granted, in the “interest of justice,” additional discovery for documents not included as exhibits to affidavits where the documents related to statements made in those affidavits.⁷⁷ In *Such v. Hoefle*, the court denied additional discovery which was directed to the identity of persons who “participated in the preparation” or “contributed to the preparation” of a patent application.⁷⁸ The Board found that such

discovery was not within the “interest of justice.”⁷⁹ Thus, it would appear that interference discovery under the new rules continues to be much more restrictive than that under the Federal Rules of Civil Procedure. As a result, an adverse party in interference is less likely to discover peripheral matters.

III. Evidentiary Use of Retained Drafts

A. Drafts as Evidence of a Pre-Filing Date of Invention

Despite the risks associated with their retention and subsequent discovery during litigation, draft patent applications may serve as important evidence of a pre-filing date of invention. The date of invention is deemed to be the filing date of a patent application which adequately discloses the subject matter of the invention.⁸⁰ Therefore, prior art under § 102(a), (e), or (g) which pre-dates the application *247 filing date may anticipate the invention⁸¹ or render it obvious⁸² unless the patentee (or applicant) can establish an earlier date.

A pre-filing date of invention is established in patent validity litigation according to the same rules that apply in determining invention priority in an interference between rival inventors.⁸³ Priority goes to the first party to reduce an invention to practice unless the other party can show that it was the first to conceive the invention and that it exercised reasonable diligence in later reducing that invention to practice.⁸⁴ Absent a pre-filing reduction to practice, a patentee may seek to establish a pre-filing date of invention by proving prior conception and diligent effort towards reduction to practice.⁸⁵ Diligence must be continuous from a date just prior to the reference date through the date of reduction to practice.⁸⁶ Draft applications may be persuasive evidence of conception⁸⁷ and, to a lesser extent, of attorney diligence.

1. Patentees Face the Heavy Burden of Proving Conception by Clear and Convincing Evidence--

During prosecution before the PTO, an applicant may swear behind a reference by filing a verified statement of facts establishing a date of invention prior to the reference date.⁸⁸ However, in litigation which challenges the validity of an issued patent, based on prior art having an effective date before the *248 patentee’s filing date, the patentee must prove up the elements of prior invention.⁸⁹ The burden of persuasion is a heavy one, requiring the patentee to prove, by clear and convincing evidence, that the invention was, *inter alia*, conceived before the application date.⁹⁰

2. Junior Parties in Interference May Face a Similar Burden of Persuasion--

In interference, the burden of persuasion rests on the junior party as to all issues of fact relevant to priority of invention.⁹¹ If the junior party filed his application before the senior party’s patent issue date, the burden is the normal civil burden, by a preponderance of the evidence.⁹² However, if the junior party filed his application after the senior party’s issue date, the burden is proof by clear and convincing evidence.⁹³ In *Price v. Symsek*, the Federal Circuit rejected a long line of cases requiring proof beyond a reasonable doubt in priority contests,⁹⁴ holding that clear and convincing evidence was sufficient to establish priority in interference with an issued patent.⁹⁵

3. Requirements for Proving Prior Conception are Typically Met by Draft Patent Applications--

Conception is the mental formulation of a definite and permanent idea of the complete and operative invention as it is thereafter applied in practice.⁹⁶ That idea must be of specific means, not just of a desirable end or result, and must be sufficiently complete so as to enable anyone of ordinary skill in the art to reduce the concept to practice.⁹⁷ Evidence of prior conception helps allow the applicant or patentee to establish a pre-filing date of invention; however, the date of invention cannot be carried back to that of the earliest mental conception.⁹⁸ Instead, an inventor is only entitled to priority as of a date when the complete conception was manifest or disclosed.⁹⁹

*249 Typically, conception must be proven by evidence of disclosure to another,¹⁰⁰ although there may be cases in which conception is established by other means.¹⁰¹ Under the *Mergenthaler* standard, a disclosed conception is complete if a worker of ordinary skill in the art can practice the invention.¹⁰² Chisum argues that the “worker of ordinary skill in the art” should be the same worker of ordinary skill used in deciding questions of enablement.¹⁰³ Such a worker is presumed to know only the well-known prior art.¹⁰⁴ Using this definition, the standard for proving conception is not essentially different from that required for demonstrating adequacy of support in a disclosure for a claim.¹⁰⁵

Invention disclosure documents prepared by the inventor and provided to the patent attorney may often be sufficient to

establish mental formulation by the inventor of a definite and permanent idea of the complete and operative invention as required by *Mergenthaler*. However, in some cases these documents may be inadequate as evidence of conception, either because the disclosure documents contain insufficient detail to enable one skilled in the art to practice the invention or because claimed features or limitations were not initially disclosed in the documents, but were instead conveyed to the patent attorney during subsequent discussions with the inventor.

Although each additional disclosure should be documented, it may often be the case that the content of such discussions is not preserved. Alternatively, the prosecuting attorney may have considered a particular feature or limitation revealed during such discussions to be known to one of ordinary skill in the art. The prosecuting attorney may testify to the disclosure, however such testimony may be unpersuasive. Given the large number of prosecutions which an attorney handles and the typical delays in going to trial, attorney recollections may be too attenuated to be persuasive in the absence of corroborating documentary evidence.¹⁰⁶ Instead, it may be preferable to rely on documentary evidence such as a draft application.

For the purpose of establishing disclosure of the conception, a draft application is no different from any other documentary evidence of disclosure, and as evidence of conception, a draft application must be judged according to the objective standard as to what it teaches a person of ordinary skill in the *250 art.¹⁰⁷ However, unlike other evidence, a draft patent application is, by its very nature, uniquely adapted to the job of demonstrating conception. After all, the fact that a draft is prepared by someone outside the inventorship entity, typically a patent attorney or agent, evidences disclosure. Furthermore, the patent attorney or agent is presumably a person of ordinary skill in the art and presumably drafts the application with knowledge of, and in an attempt to satisfy the requirements of 35 U.S.C. § 112, the enablement requirement. Perhaps as a result, the courts have routinely held draft patent applications to be persuasive evidence of conception.¹⁰⁸

B. Limitations on Alternative Sources of Evidence of Conception May Increase the Importance of Drafts

The importance of draft applications as evidence of prior conception may be enhanced by limitations on alternative sources of evidence. The most significant limitation on evidence of conception is the long-standing evidentiary rule that facts concerning conception -- including its content, its origin, and its date -- may not be established by the uncorroborated testimony of the inventor.¹⁰⁹ In *Price v. Symsek*, the Federal Circuit signaled the continuing vitality of the uncorroborated inventor testimony rule, holding that prior conception cannot be established by an inventor's mere allegation or by his unsupported testimony where there has been no disclosure to others or embodiment of the invention in some clearly perceptible form, such as drawings or a model, with sufficient proof of identity in point of time.¹¹⁰ "[O]therwise such facile means of establishing priority of invention would, in many cases, offer great temptation to perjury, and would have the effect of virtually precluding the adverse party from the possibility of rebutting such evidence."¹¹¹

Although most familiar in the context of interference proceedings, the uncorroborated inventor testimony rule is also applicable in infringement litigation which seeks to establish a pre-filing date of invention.¹¹² Even the more lenient "rule of reason" analysis which permits a reasoned examination, *251 analysis and evaluation of all pertinent evidence so that a sound determination of the credibility of the inventor's story may be reached "does not dispense with the requirement for some evidence of independent corroboration."¹¹³

While some courts had previously extended the uncorroborated inventor testimony rule outside the context of oral testimony by the inventor, rejecting as self-serving, documents prepared by the inventor such as diaries and notebooks,¹¹⁴ later cases have rejected this reasoning.¹¹⁵ Instead, only *oral testimony* and only that *of the inventor* need be corroborated.¹¹⁶ Though viewed with care, oral testimony of the inventor may be sufficient without supporting documentary evidence, if such testimony is corroborated by the testimony of other witnesses.¹¹⁷ However, the testimony of such a witness is insufficient to corroborate the inventor's prior conception if the testimony fails to show that the inventor communicated his completed conception in such clear terms as to enable one skilled in the art to make the invention.¹¹⁸ Furthermore, if the witness is himself a co-inventor, his testimony will not serve to corroborate the testimony of his co-inventor.¹¹⁹ Instead, it too is subject to the corroboration requirement.

In *Price v. Symsek*, the Federal Circuit clarified the relation between the uncorroborated inventor testimony rule and the burden of persuasion, explaining that "without some type of corroborating evidence, an alleged inventor's testimony cannot satisfy the 'clear and convincing evidence' standard."¹²⁰ Unfortunately, neither persuasive oral testimony from witnesses to the inventor's conception, nor a written description, drawing, or model prepared by the inventor and of unquestioned authenticity is always available as corroboration. Inventors often fail to adequately document their inventions. In such cases, a draft application may be the best, or only, available evidence to establish a pre-filing date of conception. Alternatively, testimony which is able to be corroborated by witnesses or by the inventor's documents may simply be insufficient to meet the clear and convincing burden of persuasion. Although conception can only be established as of the date of a draft application which *252 enablingly discloses it, even the ability to pre-date the application by a few days or a month may be

determinative of priority, or in litigation, of validity.

C. Drafts are Overkill as Evidence of Attorney Diligence

Reasonable attorney diligence can be shown if it is established that the attorney worked reasonably hard on the particular application in question during the continuous critical period, and reasonable diligence is all that is required of the attorney.¹²¹ Generally, the patent attorney must show that unrelated cases are taken up in chronological order, thus, the attorney has the burden of keeping good records of the dates when cases are docketed and the dates when specific work is done on the applications.¹²² Unlike proof of conception, for which the content of the disclosure is in issue, proof of attorney diligence requires no evidence of the actual content of a draft patent application. Instead, ordinary business records of the attorney's time and activities are sufficient as evidence of reasonable diligence¹²³ and retention of incremental drafts would be overkill.

IV. Legal and Ethical Issues Raised by Draft Retention¹²⁴

Destruction of documents may raise serious legal and ethical issues which should be considered when establishing any draft retention program. The two most serious mistakes which are made in document retention programs are ad hoc and selective destruction of documents.¹²⁵ Ad hoc destruction, which can occur when additional storage space is required for new files, may not destroy all copies of a document or may instead result in destruction of documents which should be, or must be, retained. Selective destruction, on the other hand, is typically triggered by an investigation or lawsuit and can expose the party destroying documents to civil, and theoretically criminal, liability.¹²⁶

Prohibitions on destruction of such documents include sanctions for obstruction of justice and contempt of court,¹²⁷ the spoliation inference,¹²⁸ and various rules of professional responsibility.¹²⁹ Sanctions for obstruction of justice¹³⁰ and discovery sanctions for contempt of court¹³¹ are typically *253 relevant only in the context of ongoing proceedings. However, courts may also rely on inherent powers to levy sanctions against parties responsible for causing prejudice "when the party knew or should have known that the destroyed documents were relevant to pending or potential litigation."¹³²

A proper draft retention program should preserve documents relevant to foreseeable investigations or proceedings.¹³³ In evaluating foreseeability, the proper inquiry appears to be whether, with knowledge that a lawsuit would be filed, a party willfully destroyed documents which it knew or should have known would constitute evidence relevant to the case.¹³⁴ A proper program should ensure that "destruction occurs pursuant to a standard policy developed for business reasons so that the company cannot be accused of deliberately destroying records,"¹³⁵ and it is essential that the program include provisions permitting destruction to be halted if and when litigation becomes foreseeable.¹³⁶

Another important issue is spoliation. The spoliation inference "allows the fact finder to draw an unfavorable inference against a litigant who has destroyed documents relevant to a legal dispute."¹³⁷ The inference can take the form of a rebuttable presumption that the documents destroyed by a party would establish an element of his adversary's case.¹³⁸ However, the existence of a document retention policy and regular destruction of documents in accordance with that policy may avoid or rebut the spoliation inference.¹³⁹ Rebuttal of the spoliation inference will likely be strongest when the retention policy is uniformly observed with respect to the documents of various clients. Conversely, failure to uniformly observe an existing draft retention policy may actually strengthen an inference of spoliation.¹⁴⁰

V. Conclusion

The preceding materials outline both the risks and potential evidentiary benefits associated with retention of draft patent applications. While the risks of discovery by an adverse party in litigation are greatly reduced in jurisdictions which follow *Knogo* and *Advanced Cardiovascular Systems*, a significant number of courts continue to apply the reasoning of *Jack Winter* and its progeny.¹⁴¹ As a result, the risks associated with draft retention must be taken seriously when considered in the context of potential litigation. In contrast, the risks of discovery and exploitation of draft applications are greatly reduced in interference.¹⁴² Of course, the client must choose between the use of a draft application as evidence of conception and the preservation of attorney-client privilege in that and related communications. There is no middle ground; the privilege holder may not selectively disclose only part of a privileged *254 communication.¹⁴³ However, the availability of attorney-client privilege under *Knogo* and *Advanced Cardiovascular Systems* does allow the client to defer this decision until the issue of pre-filing conception arises. In contrast, *per se* denial of privilege under the *Jack Winter* conduit theory forces an *a priori* election of either potential evidentiary use (coupled with certain disclosure) or early destruction (coupled with confidentiality).

Unlike the risks, potential evidentiary benefits are essentially the same in interference and in litigation which challenges the validity of an issued patent. In each situation, the requirements for proving a pre-filing date of invention are the same, and

limitations on alternate sources of evidence for proving conception are comparable.¹⁴⁴ Although some district courts may be inclined to consider uncorroborated inventor testimony,¹⁴⁵ the Federal Circuit has specifically reaffirmed the uncorroborated testimony rule.¹⁴⁶ In one sense, the significance of any persuasive evidence of conception appears greater in litigation since the stakes are likely to be higher. However, in another sense, failure to establish priority in interference may be the greater long term risk since it not only forecloses a potentially lucrative monopoly, but unlike a loss in litigation, awards to a potential competitor the right to exclude an inventor from making, using, and selling his creation.

In establishing a draft retention policy, the risks associated with retention of drafts must be balanced against potential evidentiary benefits during three distinct time periods in the life of a prosecuted and issued patent. During the first period -- after filing but before issue -- interference is the dominant issue. During the second period -- less than one year after patent issue -- both litigation and interference concerns shape the draft retention policy. Finally, during the third period -- more than one year after patent issue -- issues associated with litigation are the dominant concern.¹⁴⁷

A specific draft retention policy is proposed in an Appendix. Legal and ethical considerations dictate that a program implementing this, or any other draft retention policy, be conducted pursuant to consistent standards which are motivated by business concerns and include a mechanism for halting the destruction of documents related to on-going or anticipated litigation.¹⁴⁸ The policy proposed in the Appendix makes the judgment that before patent issue, the potential of prevailing in interference outweighs the minimal risk that an interfering party may meet the restrictive "interest of justice" requirement for additional discovery. On the other hand, after issue, the risk of discovery must be evaluated under the Federal Rules. Although the attorney-client privilege law advanced by *Knogo* and *Advanced Cardiovascular Systems* dramatically reduces the risk of involuntary disclosure, there is an intangible risk that the client may find himself in a *Jack Winter* court. The proposed draft retention policy makes the judgment that during the period less than one year after patent issue, this risk is offset by the potential of prevailing in interference. However, more than one year after patent issue, the balance of risks and benefits is less compelling. Until the Federal Circuit endorses the reasoning of *Knogo* and its progeny in a published opinion,¹⁴⁹ conservative judgment suggests that drafts not be retained beyond one year after patent issue.

***255 VI. Appendix - Proposed Draft Retention Policy**

The following material is a proposal for a draft retention policy which attempts to balance the risks associated with discovery of retained drafts against potential evidentiary benefits in interference and in patent validity litigation. The proposed draft retention policy strikes this balance during three distinct time periods: (1) after filing but before issue, (2) less than one year after patent issue, and (3) more than one year after patent issue. The proposed policy is envisioned as a series of actions to be performed by the responsible attorney.

A. On Filing of the Patent Application

The responsible attorney should review the file and all drafts contained therein. Minor drafts may be destroyed. However, any significant draft, and particularly drafts which in the responsible attorney's judgment contain significant additional disclosure material, should be retained. The date of each draft, including those destroyed, should be recorded in the file as evidence of attorney diligence.

Rationale: Risks at this stage are minimal. Discovery is extremely limited under interference discovery rules and there is no possibility of a jury misconstruing evidence. On the other hand, evidence of conception is important because an award of priority to the client-inventor may turn on evidence pre-dating a rival conception by as little as a day.

B. On Patent Issue

The responsible attorney should once again review the file and all remaining drafts contained therein. Only drafts which, in the responsible attorney's judgment contain significant additional disclosure material, should be retained. If inventor disclosure materials, including those received after the initial disclosure, disclose every claimed feature and limitation, retention of draft applications is unnecessary and none should be retained in the file. Patent issue, or alternatively, notice of allowance, represents a good opportunity to make this determination since it is the allowed claims for which evidence of pre-filing conception is important and since any decisions to file a continuation or continuation in part will necessarily have been made before patent issue. Alternatively, this determination could be performed on receipt of a notice of allowance.¹⁵⁰

In considering which, if any drafts to maintain, the responsible attorney should consider not only the content of the additional disclosure and date established by a given draft, but also whether the draft itself builds the case for attorney-client privilege.

Embedded questions addressed to the inventor may help to clearly establish that the draft is part of an ongoing dialog concerning matters of legal advice. This point may be controversial given the continued adherence of some courts to the *Jack Winter* view; as a result, it may be advisable to have the client agree to such a policy in advance. Clear evidence of an actual dialog between the inventor-client and the patent attorney may be enough to sway those *Jack Winter* adherents which afford some consideration to the *Knogo* view.¹⁵¹

***256 Rationale:** Risks at this stage are measurable. District court litigation, with its liberal discovery rules, is a possibility. Although the trend appears to be in the direction of *Knogo* and *Advanced Cardiovascular Systems* toward recognition that attorney-client privilege should attach, perhaps even presumptively attach, to draft applications, there is always the risk that an accused infringer may seek declaratory judgment in a court adhering to the reasoning of *Jack Winter*. On the other hand, during the first year after issue, interference proceedings remain a possibility. Potential evidentiary benefits in interference should also be considered as a factor since failure to establish priority in interference can result in the loss of patent rights and in addition can allow a competitor to exclude the client from making, using, and selling his own creation. On balance, a policy of draft retention is desirable, although this is a much closer call than either of the other two scenarios.

C. One Year After Patent Issue

All drafts of the patent application should be destroyed at this time.

Rationale: At this stage, there is no longer a significant probability of interference. Until *Jack Winter* is repudiated by a clear majority of courts or by a decision of the Federal Circuit, uncertainty in the law of attorney-client privilege creates risks that draft patent applications will be discovered and exploited by adverse parties in litigation. Although the magnitude of these risks is difficult to quantify, the potential value of a draft application at some indeterminate future point in time does not justify continued retention. Unlike the situation presented less than one year after patent issue, interference is unlikely and as a result there is little possibility that failure to establish priority will result in the client being excluded from making, using, and selling his own creation.

Footnotes

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¹ Of course, in certain circumstances such attorney notes may be the legitimate subject of discovery. This note makes a presumption of good faith and considers draft applications as a class of documents which tend to reflect thought processes in evolution, rather than an intent to deceive. These evolutionary thought processes may often be imprecisely or even inaccurately recorded in casual notes. Consider, for example, the not uncommon omission of the word “not” from a phrase, or the omission of the question mark at the end of an attorney’s note. Each might, and likely would, be paraded in front of the jury as weighty evidence of inequitable conduct. Discovery risks, as considered in this note, are those which result from the microscopic examination in litigation of these and other seemingly innocuous omissions or notations. Nothing in this note should be interpreted as an attempt to legitimize selective destruction of relevant evidence.

² 35 U.S.C. §§ 102(a), (e), and (g) (1988) (enumerating conditions whose occurrence before a person’s date of invention serve to bar issue of a patent).

³ 35 U.S.C. § 112 (1988).

⁴ See discussion *infra* parts III.A.1., III.A.2.

⁵ See discussion *infra* part III.A.

⁶ Stated more euphemistically, a document retention program.

⁷ See discussion *infra* part IV.

8 FED. R. CIV. P. 26(b)(1).

9 *Id.*

10 54 F.R.D. 44, 172 U.S.P.Q. (BNA) 201 (N.D. Cal. 1971).

11 *See, e.g.,* Quantum Corp. v. Western Digital Corp., 15 U.S.P.Q.2d (BNA) 1062 (N.D. Cal. 1990); Hewlett-Packard Co. v. Bausch & Lomb, Inc., 116 F.R.D. 533, 4 U.S.P.Q.2d (BNA) 1676 (N.D. Cal. 1987); McNeil-PPC, Inc. v. Procter & Gamble Co., 136 F.R.D. 666 (D. Colo. 1991).

12 213 U.S.P.Q. (BNA) 936 (Ct. Cl. 1980).

13 *See, e.g.,* Advanced Cardiovascular Sys., Inc. v. C.R. Bard, Inc., 144 F.R.D. 372, 25 U.S.P.Q.2d (BNA) 1354 (N.D. Cal. 1992); Laitram Corp. v. Hewlett-Packard Co., 827 F. Supp. 1242, 27 U.S.P.Q.2d (BNA) 1541 (E.D. La. 1993); Rohm and Haas Co. v. Brotech Corp., 815 F. Supp. 793, 26 U.S.P.Q.2d (BNA) 1800 (D. Del. 1993), *aff'd*, 1994 U.S. App. LEXIS 3102 (Fed. Cir. Feb. 18, 1994) (unpublished opinion); Ball Corp. v. American Nat'l Can Co., 27 U.S.P.Q.2d (BNA) 1958 (S.D. Ind. 1993).

14 *Jack Winter*, 54 F.R.D. at 47, 172 U.S.P.Q. (BNA) at 202.

15 96 F.R.D. 152, 220 U.S.P.Q. (BNA) 716 (W.D.N.Y. 1982).

16 *Detection Sys.*, 96 F.R.D. at 155, 220 U.S.P.Q. (BNA) at 717 (emphasis added).

17 *See Jack Winter*, 54 F.R.D. at 46, 172 U.S.P.Q. (BNA) at 202 (“[D] ocuments containing considerable technical factual information but which . . . nonetheless primarily [concern] legal guidance to the client were classified as privileged. In other words, doubts have been resolved in favor of the privilege.”).

18 *E.g.,* Quantum Corp. v. Western Digital Corp., 15 U.S.P.Q.2d (BNA) 1062, 1064 (N.D. Cal. 1990); Hewlett-Packard Co. v. Bausch & Lomb, Inc., 116 F.R.D. 533, 542, 4 U.S.P.Q.2d (BNA) 1676, 1682 (N.D. Cal. 1987); McNeil-PPC, Inc. v. Procter & Gamble Co., 136 F.R.D. 666, 669-70 (D. Colo. 1991); Howes v. Medical Components Inc., 7 U.S.P.Q.2d (BNA) 1511, 1512 (E.D. Pa. 1988).

19 *Hewlett-Packard*, 116 F.R.D. at 542, 4 U.S.P.Q.2d (BNA) at 1682; *see also* Hercules, Inc. v. Exxon Corp., 434 F. Supp. 136, 147, 196 U.S.P.Q. (BNA) 401, 408 (D. Del. 1977). *But cf.* Sperry v. Florida, 373 U.S. 379, 383 (1963) (where the Supreme Court considered preparation and prosecution of patent applications for others to constitute practice of law, stating “[s]uch conduct inevitably requires the practitioner to consider and advise his clients as to the patentability of their inventions under the statutory criteria.” The court went on to note that “[a patent application is] one of the most difficult legal instruments to draw with accuracy.”).

20 *Jack Winter, Inc. v. Koratron Co.*, 50 F.R.D. 225, 228, 166 U.S.P.Q. (BNA) 295, 298 (N.D. Cal. 1970) (“[T]he attorney exercises no discretion as to what . . . information must be relayed to the Patent Office. He must turn *all* such factual information over in full to the Patent Office pursuant to 35 U.S.C. § 112, and hence with respect to such material he acts as a conduit between his client and the Patent Office.”) (emphasis in original).

21 *McNeil-PPC*, 136 F.R.D. at 670-71 (“[Patent prosecution] is not a situation where the lack of attorney-client privilege would prevent disclosure or communications between attorney and client. . . . [T]herefore . . . such communications, if not for the purpose of giving legal advice outside the context of the patent application, should be discoverable . . . and the protections of the attorney-client privilege should not apply.”).

22 213 U.S.P.Q. (BNA) 936 (Ct. Cl. 1980).

23 *Id.* at 940-41.

24 *Id.* at 941.

25 *Id.*

26 144 F.R.D. 372, 25 U.S.P.Q.2d (BNA) 1354 (N.D. Cal. 1992).

27 *Advanced Cardiovascular Sys.*, 144 F.R.D. at 374, 25 U.S.P.Q.2d (BNA) at 1356:
[H]aving been made aware by counsel for plaintiff of the well-reasoned compelling line of authority best reflected in *Knogo, supra*, this court now reverses that portion of its earlier opinion that accepted the Jack Winter line of authority. . . . [W]e now reject the notion that the attorney-client privilege should not attach, presumptively, to private communications from inventor to lawyer that consist primarily of technical information related to an anticipated patent application. *Id.*

28 *Advanced Cardiovascular Sys.*, 144 F.R.D. at 378, 25 U.S.P.Q.2d (BNA) at 1359.

29 *Id.*

30 *See, e.g.*, *Rohm and Haas Co. v. Brotech Corp.*, 815 F. Supp. 793, 26 U.S.P.Q.2d (BNA) 1800 (D. Del. 1993); *Laitram Corp. v. Hewlett-Packard Co.*, 827 F. Supp. 1242, 27 U.S.P.Q.2d (BNA) 1541 (E.D. La. 1993); *Ball Corp. v. American Nat'l Can Co.*, 27 U.S.P.Q.2d (BNA) 1958, 1959 (S.D. Ind. 1993) (“This Court . . . joins with those others which have recognized that the attorney-client privilege attaches to draft patent applications.”).

31 *Rohm and Haas*, 815 F. Supp. at 797, 26 U.S.P.Q.2d (BNA) at 1803; *Laitram Corp.*, 827 F. Supp. at 1246, 27 U.S.P.Q.2d (BNA) at 1545; *Ball Corp.*, 27 U.S.P.Q.2d (BNA) at 1959.

32 *Rohm and Haas*, 815 F. Supp. at 797, 26 U.S.P.Q.2d (BNA) at 1802.

33 *Rohm and Haas*, 815 F. Supp. at 797, 26 U.S.P.Q.2d (BNA) at 1803.

34 *Laitram Corp.*, 827 F. Supp. at 1246, 27 U.S.P.Q.2d (BNA) at 1545.

35 *See, e.g.*, *Burroughs Wellcome Co. v. Barr Lab. Inc.*, 143 F.R.D. 611, 25 U.S.P.Q.2d (BNA) 1274 (E.D.N.C. 1992); *Stryker Corp. v. Intermedics Orthopedics, Inc.*, 145 F.R.D. 298, 24 U.S.P.Q.2d (BNA) 1676 (E.D.N.Y. 1992); *Santrade, Ltd. v. General Elecs. Co.*, 150 F.R.D. 539, 27 U.S.P.Q.2d (BNA) 1446 (E.D.N.C. 1993).

36 *Burroughs Wellcome*, 143 F.R.D. at 616, 25 U.S.P.Q.2d (BNA) at 1276 (noting that a patent attorney is not a mere conduit for technical information and although much of the technical information disclosed to the patent attorney finds its way into the patent application, that fact should not preclude assertion of attorney client privilege over communications in which the information was disclosed to the attorney).

37 *Id.* (citing *Detection Sys.*, 96 F.R.D. at 155).

38 *Stryker Corp.*, 145 F.R.D. at 303, 24 U.S.P.Q.2d (BNA) at 1678 (citing a long line of cases including *Quantum Corp.*, 15 U.S.P.Q.2d (BNA) at 1064, *Hewlett-Packard*, 116 F.R.D. at 542, and *Detection Sys.*, 96 F.R.D. 152).

39 *Stryker Corp.*, 145 F.R.D. at 303, 24 U.S.P.Q.2d (BNA) at 1678 (“Plaintiff has not sustained its burden of demonstrating that the [draft patent applications] were created in response to a solicitation for legal advice as opposed to either business advice or to amend certain technical information.”).

40 *Santrade, Ltd.*, 150 F.R.D. at 544, 27 U.S.P.Q.2d (BNA) at 1449 (“[D] ocuments do not contain protected ‘client confidences’ if they primarily relate to technical information compiled in connection with the prosecution of a patent application.”).

41 *Id.*

42 *See, e.g.*, *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1169, 184 U.S.P.Q. (BNA) 775, 788 (D.S.C. 1974) (“[N]o communications from patent agents, whether American or foreign, are subject to an attorney-client privilege”); *Burroughs Wellcome Co. v. Barr Lab., Inc.*, 143 F.R.D. 611, 616-17, 25 U.S.P.Q.2d (BNA) at 1277 (“Application of this rule is not rigid, however. Instead, the privilege may extend to communications with foreign patent agents related to foreign patent activities *if* the privilege would apply under the law of the foreign country and that law is not contrary to the law of the forum.”) (emphasis in original).

43 *In re Ampicillin Antitrust Litig.*, 81 F.R.D. 377, 393-94, 202 U.S.P.Q. (BNA) 134, 145-46 (D.D.C. 1978).

44 *See, e.g.*, *In re Horowitz*, 482 F.2d 72, 81 (2d Cir. 1973) (client allowed unrestricted access to privileged documents), *cert. denied*, 414 U.S. 867 (1973); *Smith v. Alyeska Pipeline Serv. Co.*, 538 F. Supp. 977, 980, 218 U.S.P.Q. (BNA) 468, 470 (D. Del. 1982) (disclosure of opinion letter in infringement negotiations), *aff’d*, 758 F.2d 668 (Fed. Cir. 1984), *cert. denied*, 471 U.S. 1066 (1985).

45 *See* PAUL R. RICE, ATTORNEY CLIENT PRIVILEGE IN THE UNITED STATES § 9:27 at 685-86 (1993).

46 25 U.S.P.Q.2d (BNA) 1304 (N.D. Cal. 1992).

47 *Id.* at 1309-10.

48 *In re Sealed Case*, 676 F.2d 793, 809 (D.C. Cir. 1982); *In re Int’l Harvester’s Disposition of Wis. Steel Litig.*, 666 F. Supp. 1148, 1153 (N.D. Ill. 1987); *see also* RICE, *supra* note 45, § 9:30 at 698.

49 *See, e.g.*, *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1191, 184 U.S.P.Q. (BNA) 775, 782 (D.S.C. 1975) (“[Voluntary disclosure] by a client, without limitation, of one or more nonprivileged documents passing between the same attorney and the same client discussing the same subject does not waive the privileged communications between the same attorney and the same client on the same subject.”) (emphasis omitted).

50 *See* discussion *infra* part III.

51 RICE, *supra* note 45, § 9:28 at 687.

52 *Id.*

53 *See, e.g.*, *W.L. Gore & Assoc., Inc. v. Tetratec Corp.*, 15 U.S.P.Q.2d (BNA) 1048, 1051 (E.D. Pa. 1989) (“Tetratec is free to choose to stand behind its attorney-client privilege and the work product immunity, and refuse to produce the opinions of its counsel. If privileged material is to be used at trial, however, the plaintiffs must be allowed to examine the privileged documents in order to conduct pre-trial discovery.”).

54 329 U.S. 495 (1947).

55 FED. R. CIV. P. 26(b)(3).

56 *See id.*

57 *See, e.g.,* Detection Sys., Inc. v. Pittway Corp., 96 F.R.D. 152, 155, 220 U.S.P.Q. (BNA) 716, 718 (W.D.N.Y. 1982); Baron v. Bausch & Lomb, Inc., 223 U.S.P.Q. (BNA) 25, 26-27 (W.D.N.Y. 1983) (ex parte prosecution documents not protected); *see also* Oak Indus. v. Zenith Elecs. Corp., 687 F. Supp. 369, 374-75, 7 U.S.P.Q.2d (BNA) 1867, 1871-72 (N.D. Ill. 1988) (mental impressions and legal theories of the drafting attorney as to the original application not protected).

58 Hercules, Inc. v. Exxon Corp., 434 F. Supp. 136, 152, 196 U.S.P.Q. (BNA) 401, 412 (D. Del. 1977) (“[A] responsible patent attorney always anticipates the possibility of future litigation involving the patent. It is possible that, during the ex parte prosecution, certain memoranda or recordings, etc. prepared by the attorney may reflect concerns more relevant to future litigation than to the ongoing prosecution. If the primary concern of the attorney is with claims which would potentially arise in future litigation, the work product immunity applies.”).

59 Hewlett-Packard Co. v. Bausch & Lomb, Inc., 116 F.R.D. 533, 543, 4 U.S.P.Q.2d (BNA) 1676, 1683-84 (N.D. Cal. 1987) (draft “reply” to an office action in reexamination held within work product protection); *see also* Oak Indus. v. Zenith Elecs. Corp., 687 F. Supp. at 374-75, 7 U.S.P.Q.2d (BNA) at 1871-72 (extending work product protection to patent attorney’s thoughts and legal theories developed in the course of reexamination proceedings).

60 Rohm and Haas Co. v. Dawson Chem. Co., 214 U.S.P.Q. (BNA) 56, 59 (S.D. Tex. 1981) (“In light of the protracted history of the patent in suit which includes the ex parte prosecution of the patent before the [PTO], the interference proceedings . . . and the litigation between [the] plaintiff in the case sub judice and [another party], the Court can reach no other result but to find that [documents involving communications between the prosecuting attorneys] were ‘prepared in anticipation of litigation.’”).

61 35 U.S.C. § 135 (1988).

62 35 U.S.C. § 135(b) (Supp. 1992).

63 MAURICE H. KLITZMAN, PATENT INTERFERENCE 88 (1984).

64 FED. R. CIV. P. 26(b)(1) (a party may discover any relevant matter not privileged subject to the minimal requirement that information sought appear reasonably calculated to lead to the discovery of admissible evidence).

65 *See* 37 C.F.R. § 1.601(a) (1993).

66 37 C.F.R. § 1.673(b) (1993).

67 *See* 37 C.F.R. § 1.687 (1993). Rule 687(c) when read in conjunction with Rule 687(a) and the absence of alternative means (in Subpart E - Interferences) for authorizing additional discovery indicates that a party may obtain additional discovery *only* by a showing that it is required *in the interest of justice*.

68 *See, e.g.,* Rivier v. Coy, 12 U.S.P.Q.2d (BNA) 1231 (Bd. Pat. App. & Int. 1989); Suh v. Hoefle, 23 U.S.P.Q.2d (BNA) 1321 (Bd. Pat. App. & Int. 1991).

69 37 C.F.R. § 1.287 (1984). Effective February 11, 1985, new rules for interferences (37 C.F.R. §§ 1.601 -- 1.688) were promulgated, replacing the old rules (37 C.F.R. §§ 1.201 -- 1.288).

70 *See* PTO Discussion following Rule 687, reproduced in KLITZMAN, PATENT INTERFERENCE, *supra* note 63, at 104 (Supp. 1985).

71 Frillette v. Kimberlin, 508 F.2d 205, 211-12, 184 U.S.P.Q. (BNA) 266, 269-71 (3d Cir. 1984) (*en banc*) (holding that § 24 authorizes district courts to enforce subpoenas only for materials that are discoverable under Patent Office discovery rules), *cert.*

denied, 421 U.S. 980 (1975); *Sheehan v. Doyle*, 513 F.2d 895, 898, 185 U.S.P.Q. (BNA) 489, 491-92 (1st Cir.), *cert. denied*, 423 U.S. 874 (1975), *after further proceedings*, 529 F.2d 38, 39, 188 U.S.P.Q. (BNA) 545, 545-46 (1st Cir.), *cert. denied*, 429 U.S. 870 (1976); *Brown v. Braddick*, 595 F.2d 961, 966, 203 U.S.P.Q. (BNA) 95, 100 (5th Cir. 1979).

72 *Harris v. Osada*, 191 U.S.P.Q. (BNA) 291, 291 (Bd. Pat. App. & Int. 1975) (“Requests for additional discovery under § 1.287(c) should relate to specific documents relevant to the subject matter of this interference whose existence is known and which cannot be otherwise obtained.”).

73 *See Poole v. Sugaya*, 182 U.S.P.Q. (BNA) 571 (Bd. Pat. App. & Int. 1974).

74 *See Tofe v. Winchell*, 645 F.2d 58, 64-65, 209 U.S.P.Q. (BNA) 379, 384-85 (C.C.P.A. 1981) (Markey, C.J., concurring).

75 35 U.S.C. § 135(a) (1988) (“The Board of Patent Appeals and Interferences shall determine questions of priority of the inventions and may determine questions of patentability.”); *see also Perkins v. Kwon*, 886 F.2d 325, 328, 12 U.S.P.Q.2d (BNA) 1308, 1311 (Fed. Cir. 1989).

76 *Dewez v. Schleimer*, 2 U.S.P.Q.2d (BNA) 1636, 1637 (Bd. Pat. App. & Int. 1987); *see also Perkins*, 886 F.2d at 328 n.3, 12 U.S.P.Q.2d (BNA) at 1310 n.3 (citing Cong. Rec. 28,065, 28,072 (1984), reprinted in 1984 U.S.C.C.A.N. 5827, 5837).

77 *Rivier v. Coy*, 12 U.S.P.Q.2d (BNA) 1231, 1232 (Bd. Pat. App. & Int. 1989).

78 *Suh v. Hoefle*, 23 U.S.P.Q.2d (BNA) 1321, 1326 (Bd. Pat. App. & Int. 1991) (quoting the Examiner-in-Chief’s reasoning denying the motion for additional discovery).

79 *Id.*

80 *Bates v. Coe*, 98 U.S. 31 (1878); *Grefco, Inc. v. Kewanee Indus., Inc.*, 499 F. Supp. 844, 848, 208 U.S.P.Q. (BNA) 218, 222 (D. Del. 1980), *aff’d*, 71 F.2d 495 (3d Cir.), *cert. denied*, 454 U.S. 1086 (1981). The same presumption applies in interference proceedings. 37 C.F.R. § 1.657 (1993) (“A rebuttable presumption shall exist that, as to each count, the inventors made their invention in the chronological order of the earlier of their filing dates or effective filing dates. The burden of proof shall be upon a party who contends otherwise.”).

81 In relevant part, Section 102 provides:

A person shall be entitled to a patent unless--

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, *before the invention thereof* by the applicant for patent, or . . .

(e) the invention was described in a patent granted on an application for patent by another filed in the United States *before the invention thereof* by the applicant for patent . . . , or . . .

(g) *before the applicant’s invention thereof* the invention was made in this country by another who had not abandoned, suppressed, or concealed it. 35 U.S.C. § 102 (1988) (emphasis added).

82 In relevant part, Section 103 provides:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious *at the time the invention was made* to a person having ordinary skill in the art to which said subject matter pertains. 35 U.S.C. § 103 (1988) (emphasis added).

83 *See In re Mulder*, 716 F.2d 1542, 1545, 219 U.S.P.Q. (BNA) 189, 193 (Fed. Cir. 1983) (requiring a showing of both prior conception and diligence in constructive reduction to practice to overcome a § 102(a)/ 103 rejection, but rejecting the notion that the prior art reference be treated as a hypothetical applicant); *see also In re Suska*, 589 F.2d 527, 529-30, 200 U.S.P.Q. (BNA) 497, 499 (C.C.P.A. 1979) (applying suppression and concealment doctrine from interference law to a § 102(g)/103 rejection).

84 *Price v. Symsek*, 988 F.2d 1187, 1190, 26 U.S.P.Q.2d (BNA) 1031, 1033 (Fed. Cir. 1993).

85 *See, e.g.,* Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1378, 231 U.S.P.Q. (BNA) 81, 89 (Fed. Cir. 1986) (“We therefore hold as a matter of law that Hybritech’s conception, which was before LJCRF conceived the claimed invention, coupled by diligence to its constructive reduction to practice . . . entitle Hybritech to priority over LJCRF. . . . The work of LJCRF is therefore not prior art.”), *cert. denied*, 480 U.S. 947 (1987); Lutzker v. Plet, 843 F.2d 1364, 1366, 6 U.S.P.Q.2d (BNA) 1370, 1371 (Fed. Cir. 1988).

86 *See* Brown v. Barton, 102 F.2d 193, 197, 41 U.S.P.Q. (BNA) 99, 102 (C.C.P.A. 1939) (stating the analogous rule in the context of an interference: “It is elementary that, where diligence is involved in reducing an invention to practice, diligence must be established at and immediately before the opposing party entered the field, and it must continue until there is an actual or constructive reduction to practice by the party claiming diligence.”).

87 *See, e.g.,* Burroughs Wellcome Co. v. Barr Lab., Inc., 828 F. Supp. 1208, 1213, 29 U.S.P.Q.2d (BNA) 1721, 1725-26 (E.D.N.C. 1993) (draft patent application sufficient to establish the formation of a definite and permanent idea of using AZT as a therapy for AIDS and to enable one of ordinary skill in the art to practice the invention).

88 37 C.F.R. § 1.131 (1993) defines the effect of a Rule 131 affidavit.

89 Freeman v. Minnesota Mining & Mfg. Co., 693 F. Supp. 134, 145, 9 U.S.P.Q.2d (BNA) 1111, 1122 (D. Del. 1988), *aff’d in part, vacated in part*, 884 F.2d 1398, 13 U.S.P.Q.2d (BNA) 1250 (Fed. Cir. 1989), *cert. denied*, 494 U.S. 1070 (1990); *see also* Messler v. United States Rubber Co., 148 F.2d 734, 736, 65 U.S.P.Q. (BNA) 145, 147 (2d Cir.), *cert. denied*, 326 U.S. 717 (1945).

90 *Freeman*, 693 F. Supp. at 145-46, 9 U.S.P.Q.2d (BNA) at 1122; *see also* Innovative Scuba Concepts v. Feder Indus., 819 F. Supp. 1487, 1505, 27 U.S.P.Q.2d (BNA) 1254, 1264 (D. Colo. 1993).

91 3 DONALD S. CHISUM, PATENTS § 10.03[1] (1993); *see also* Price, 988 F.2d at 1194, 26 U.S.P.Q.2d (BNA) at 1036.

92 Morgan v. Hirsch, 728 F.2d 1449, 1451, 221 U.S.P.Q. (BNA) 193, 194 (Fed. Cir. 1984); Linkow v. Linkow, 517 F.2d 1370, 1373, 186 U.S.P.Q. (BNA) 223, 225 (C.C.P.A. 1975) (junior party’s knowledge of senior party’s application does not trigger a higher standard); Cody v. Aktiebolaget Flymo, 452 F.2d 1274, 1277, 171 U.S.P.Q. (BNA) 206, 208 (D.C. Cir. 1971), *cert. denied*, 405 U.S. 990 (1972).

93 *Price*, 988 F.2d at 1194, 26 U.S.P.Q.2d (BNA) at 1036.

94 *Price*, 988 F.2d at 1192, 26 U.S.P.Q.2d (BNA) at 1034-35 n.2 (rejecting cases such as Wolter v. Belicka, 409 F.2d 255, 161 U.S.P.Q. (BNA) 335 (C.C.P.A. 1969) and Horwath v. Lee, 564 F.2d 948, 195 U.S.P.Q. (BNA) 701 (C.C.P.A. 1977) as rendered prior to the Supreme Court’s explanation of the difference between clear and convincing proof and proof beyond a reasonable doubt and as being in conflict with the court’s admonition against imposing a criminal standard in civil cases).

95 *Price*, 988 F.2d at 1193-94, 26 U.S.P.Q.2d (BNA) at 1036 (“[C]lear and convincing evidence . . . is the correct standard.”).

96 Mergenthaler v. Scudder, 11 App. D.C. 264, 276 (D.C. Cir. 1897); Standard Oil Co. v. Montedison, S.p.A., 494 F. Supp. 370, 407, 206 U.S.P.Q. (BNA) 676, 711 (D. Del. 1980), *aff’d*, 664 F.2d 356, 212 U.S.P.Q. (BNA) 327 (3d Cir. 1981), *cert. denied*, 456 U.S. 915 (1982); *see also* CHISUM, *supra* note 91, § 10.04.

97 CHISUM, *supra* note 91, § 10.04.

98 Kardulas v. Florida Mach. Prods. Co., 438 F.2d 1118, 1121, 168 U.S.P.Q. (BNA) 673, 675 (5th Cir. 1971); Minnesota Mining and Mfg. Co. v. Research Medical, Inc., 679 F. Supp. 1037, 1050, 6 U.S.P.Q.2d (BNA) 1401, 1410 (D. Utah 1988).

99 *Kardulas*, 438 F.2d at 1121, 168 U.S.P.Q. (BNA) at 675-76; Cislak v. Wagner, 215 F.2d 275, 279, 103 U.S.P.Q. (BNA) 39, 42

(C.C.P.A. 1954) (“Conception must include all the essential features of the invention . . . and must be manifested or proved by exterior acts or disclosures.”).

100 *See, e.g.,* Coleman v. Dines, 754 F.2d 353, 359, 224 U.S.P.Q. (BNA) 857, 862 (Fed. Cir. 1985) (Conception must be proved by corroborating evidence which shows that the inventor disclosed to others his completed thought expressed in such clear terms as to enable those skilled in the art to make the invention.).

101 *See* Peters v. Hopkins, 34 App. D.C. 141, 145, 1910 C.D. 278, 280 (D.C. Cir. 1909) (“An inventor might write a complete description of his invention and deposit the same in a sealed packet with another person for safe keeping, without making any disclosure of the contents. The production of the packet with proof of the date of the receipt would be sufficient evidence of the existence of the conception on that date.”), *cert. denied*, 217 U.S. 603 (1910).

102 CHISUM, *supra* note 91, § 10.04[3].

103 *Id.* § 10.04[3][a] (“On policy grounds it would seem that in determining completeness the enablement standard, which allows use of only ‘well-known’ prior art, should be adopted rather than the obviousness standard [[[of all the relevant prior art].”]).

104 *In re* Howarth, 654 F.2d 103, 106, 210 U.S.P.Q. (BNA) 689, 692 (C.C.P.A. 1981) (distinguishing common knowledge for the purposes of enablement under § 112 from prior art for anticipation under § 102).

105 *See* Spero v. Ringold, 377 F.2d 652, 660, 153 U.S.P.Q. (BNA) 726, 732 (C.C.P.A. 1967); *see also* Vanderkooi v. Hoeschele, 7 U.S.P.Q.2d (BNA) 1253, 1255 (Bd. Pat. App. & Int. 1987) (“The standard for proving conception is not essentially different from that required for proving sufficiency of disclosure under 35 U.S.C. § 112.”).

106 *See, e.g.,* Schwartz v. Graenz, 81 F.2d 767, 776 (C.C.P.A. 1936) (considering oral testimony in general: [W]e do not wish to be understood as questioning the honesty and good faith of appellant or the witnesses who testified for him . . . [However,] oral testimony, adduced 6 1/2 and 8 1/2 years after the happening of events to which it was directed, in the absence of any corroborative documentary evidence, is not sufficient to . . . [establish,] beyond a reasonable doubt [,] . . . prior invent[ion].). Presumably, such oral testimony would also be insufficient under the current clear and convincing standard.

107 *See Spero*, 377 F.2d at 660, 153 U.S.P.Q. (BNA) at 732.

108 *See, e.g., Spero*, 377 F.2d at 660, 153 U.S.P.Q. (BNA) at 731-32; Haskell v. Colebourne, 671 F.2d 1362, 1366, 213 U.S.P.Q. (BNA) 192, 194 (C.C.P.A. 1982); Walker v. Bailey, 245 F.2d 486, 488-89, 114 U.S.P.Q. (BNA) 302, 304 (C.C.P.A. 1957) (disclosure by inventor, used by his patent attorney to prepare a draft application, together with their testimony, was sufficient to establish conception as of date the draft was prepared); Smith v. Kliesrath, 120 F.2d 1015, 1017-18, 50 U.S.P.Q. (BNA) 82, 84 (C.C.P.A. 1941) (conception established at least as early as the date a draft of a patent application finished by a patent attorney on behalf of the inventor); King v. Young, 100 F.2d 663, 670, 40 U.S.P.Q. (BNA) 176, 183 (C.C.P.A. 1938) (conception established as of date application for patent, even though never filed, was signed by applicant and notarized).

109 *See* Mergenthaler v. Scudder, 11 App. D.C. 264, 278 (D.C. Cir. 1897).

110 Price v. Symsek, 988 F.2d 1187, 1194, 26 U.S.P.Q.2d (BNA) 1031, 1036-37 (Fed. Cir. 1993).

111 *Price*, 988 F.2d at 1194-95, 26 U.S.P.Q.2d (BNA) at 1037 (quoting *Mergenthaler*, 11 App. D.C. at 278).

112 *See, e.g.,* Mendenhall v. Astec Indus., Inc., 13 U.S.P.Q.2d (BNA) 1913, 1923 (E.D. Tenn. 1988) (“The uncorroborated testimony of an inventor is insufficient to establish a pre-filing date of invention.”), *aff’d*, 887 F.2d 1094, 13 U.S.P.Q.2d (BNA) 1956 (Fed. Cir. 1989) (unpublished opinion); Refac Elecs. v. R.H. Macy & Co., 9 U.S.P.Q.2d (BNA) 1497, 1502 (D.N.J. 1988), *aff’d*, 871 F.2d 1097 (Fed. Cir. 1989) (unpublished opinion); Kardulas v. Florida Mach. Prods. Co., 438 F.2d 1118, 1121, 168 U.S.P.Q. (BNA) 673, 676 (5th Cir. 1971); Rooted Hair, Inc. v. Ideal Toy Corp., 329 F.2d 761, 767, 141 U.S.P.Q. (BNA) 540, 545 (2d Cir.), *cert. denied*, 379 U.S. 831 (1964); Grefco, Inc. v. Kewanee Indus., Inc., 499 F. Supp. 844, 848, 208 U.S.P.Q. (BNA) 218, 223 (D. Del. 1980), *aff’d*, 71 F.2d 495 (3d Cir.), *cert. denied*, 454 U.S. 1086 (1981). But cf. Innovative Scuba Concepts, Inc. v. Feder

Indus., Inc., 819 F. Supp. 1487, 1505, 27 U.S.P.Q.2d (BNA) 1254, 1264 (D. Colo. 1993):

[T]he more ‘widespread view’ is that unsupported oral testimony can be sufficient but must be subjected to close scrutiny, with eight factors to be considered in determining its sufficiency: (1) delay between event and trial; (2) interest of witnesses; (3) contradiction or impeachment; (4) corroboration; (5) witnesses’ familiarity with details of alleged prior structure; (6) improbability of prior use considering state of the art; (7) impact of the invention on the industry; and (8) relationship between witness and alleged prior user. *Id.* (citing *E.I. DuPont de Nemours & Co. v. Berkley & Co.*, 620 F.2d 1247, 1261 n. 20 (8th Cir. 1980)).

In fact, *E.I. DuPont* addresses oral testimony to establish prior use, not uncorroborated inventor testimony as evidence of conception.

113 *Coleman v. Dines*, 754 F.2d 353, 360, 224 U.S.P.Q. (BNA) 857, 862 (Fed. Cir. 1985).

114 *See, e.g.*, *Jepson v. Egly*, 231 F.2d 947, 952, 109 U.S.P.Q. (BNA) 354, 358 (C.C.P.A. 1956); *Searle v. Glarum*, 179 F.2d 974, 976, 84 U.S.P.Q. (BNA) 454, 456 (C.C.P.A. 1950); *American Mach. and Foundry Co. v. Liggett & Myers Tobacco Co.*, 172 F. Supp. 12, 16, 121 U.S.P.Q. (BNA) 133, 136 (D.N.J. 1959).

115 *See Ritter v. Rohm & Haas Co.*, 271 F. Supp. 313, 320, 154 U.S.P.Q. (BNA) 518, 525 (S.D.N.Y. 1967).

116 *Ritter*, 271 F. Supp. at 320, 154 U.S.P.Q. (BNA) at 524-25 (inventor’s notebook, a document of unquestioned authenticity, sufficient to corroborate conception); *see also Price v. Symsek*, 988 F.2d at 1195, 26 U.S.P.Q.2d (BNA) at 1037 (“Unlike [the] situation where an inventor is proffering oral testimony [to establish] what was conceived and when it was conceived . . . corroboration is not necessary to establish what a physical exhibit . . . includes.”).

117 *Maxwell v. J. Baker, Inc.*, 805 F. Supp. 735, 738, 26 U.S.P.Q.2d (BNA) 1241, 1248 (D. Minn. 1992) (citing CHISUM, *supra* note 91, § 10.04[2]).

118 *Maxwell*, 805 F. Supp. at 738, 26 U.S.P.Q.2d (BNA) at 1248; *see also Coleman v. Dines*, 754 F.2d 353, 359, 224 U.S.P.Q. (BNA) 857, 862 (Fed. Cir. 1985).

119 *Larson v. Johanning*, 17 U.S.P.Q.2d (BNA) 1610, 1613 (Bd. Pat. App. & Int. 1990); *Desch v. Dickinson*, 99 U.S.P.Q. (BNA) 218, 223 (Bd. Pat. Int. 1950) (“[T]estimony of one from among joint inventors will not be received as corroboration of the others.”).

120 *Price*, 988 F.2d at 1194, 26 U.S.P.Q.2d (BNA) at 1036.

121 *Bey v. Kollonitsch*, 806 F.2d 1024, 1027-28, 231 U.S.P.Q. (BNA) 967, 969-70 (Fed. Cir. 1986).

122 *Bey*, 806 F.2d at 1028, 231 U.S.P.Q. (BNA) at 970.

123 *See, e.g., Ex parte Ovshinsky*, 10 U.S.P.Q.2d (BNA) 1075, 1077 (Bd. Pat. App. & Int. 1989) (finding that time records indicated that attorney worked diligently during the relevant time period on a series of closely related patent applications).

124 A detailed treatment of the legal and ethical issues raised by document destruction/retention programs is beyond the scope of this note. However, several excellent reviews exist in the literature. *See, e.g.*, John M. Fedders & Lauryn H. Guttenplan, *Document Retention and Destruction: Practical, Legal and Ethical Considerations*, 56 NOTRE DAME L. REV. 5 (1980); Lawrence Solum & Stephen Marzen, *Truth and Uncertainty: Legal Control of the Destruction of Evidence*, 36 EMORY L.J. 1085 (1987); Wayne F. Reinke, *Limiting the Scope of Discovery: The Use of Protective Orders and Document Retention Programs in Patent Litigation*, 2 ALB. L.J. SCI. & TECH. 175 (1992).

125 Fedders & Guttenplan, *supra* note 124, at 11.

126 *See generally Solum & Marzen, supra* note 124, at 1087-1125. Criminal sanctions, however, appear to be more theoretical than real for document destruction in civil litigation. *Id.* at 1106.

127 *See generally* Fedders & Guttenplan, *supra* note 124, at 19-34.

128 *See, e.g.,* Welsh v. United States, 844 F.2d 1239, 1247-48 (6th Cir. 1988); National Ass’n of Radiation Survivors v. Turnage, 115 F.R.D. 543, 556-58 (N.D. Cal. 1987). *See also* Solum & Marzen, *supra* note 124, at 1087.

129 *See, e.g.,* MODEL RULES OF PROFESSIONAL CONDUCT Rules 1.2(d), 3.3(a)(2), 3.4(a), 8.4 (1983).

130 *See* Fedders & Guttenplan, *supra* note 124, at 20-21.

131 Federal Rule of Civil Procedure 37 allows for motions for orders to compel discovery and for sanctions for failure to comply with such an order; however “Rule 37 does not, by its terms, address sanctions for destruction of evidence prior to initiation of a lawsuit or discovery requests.” *Capellupo v. FMC Corp.*, 126 F.R.D. 545, 551 n.14 (D. Minn. 1989); *see also* FED. R. CIV. P. 37.

132 *Capellupo*, 126 F.R.D. at 551 (emphasis added); *see also National Ass’n of Radiation Survivors*, 115 F.R.D. at 557.

133 *See* Fedders & Guttenplan, *supra* note 124, at 12.

134 *See* *Struthers Patent Corp. v. Nestle Co.*, 558 F. Supp. 747, 765-66, 211 U.S.P.Q. (BNA) 1023, 1038 (D.N.J. 1981); *Bomar Instrument Corp. v. Texas Instruments, Inc.*, 25 Fed. R. Serv.2d 423, 427, 196 U.S.P.Q. (BNA) 199, 202 (N.D. Ill. 1977).

135 Fedders & Guttenplan, *supra* note 124, at 14.

136 *Id.* at 17-18.

137 Solum & Marzen, *supra* note 124, at 1087.

138 *See, e.g., Welsh*, 844 F.2d at 1247-48 (negligent destruction of medical test results giving rise to a rebuttable presumption that the missing items would establish negligence and proximate cause).

139 Solum & Marzen, *supra* note 124, at 1085-86; Fedders & Guttenplan, *supra* note 124, at 13.

140 *See* Fedders & Guttenplan, *supra* note 124, at 13.

141 *See* cases cited *supra* notes 10-41 and accompanying text.

142 *See* discussion *supra* part II.B.

143 *See supra* notes 51-53 and accompanying text.

144 *See supra* part III.

145 *See, e.g.,* discussion of *Innovative Scuba Concepts*, *supra* note 112.

146 *See supra* text accompanying notes 113, 120.

- ¹⁴⁷ Although it is theoretically possible that interference could be provoked more than one year after patent issue, *see supra* text accompanying note 63, this analysis assumes that, for practical purposes, one year after patent issue marks the end of the interference period.
- ¹⁴⁸ *See* discussion *supra* part IV.
- ¹⁴⁹ In an unpublished opinion, *Rohm and Haas Co. v. Brotech Corp.*, 1994 U.S. App. LEXIS 3102 (Fed. Cir. Feb. 18, 1994), the Federal Circuit recently affirmed a *Knogo* decision. *See supra* notes 32, 33.
- ¹⁵⁰ Although patent issue aligns best with the timing of changes in the balance of risks and benefits, allowance may be the preferable milestone for the patent attorney who, on receipt of a notice of allowance, evaluates the prospects for, and can immediately consult with the client concerning, the filing of continuation applications.
- ¹⁵¹ *See, e.g.*, cases cited *supra* notes 36, 39; *but cf.* *Bio-Rad Lab., Inc. v. Pharmacia, Inc.*, 130 F.R.D. 116, 127, 14 U.S.P.Q.2d (BNA) 1924, 1932 (N.D. Cal. 1990) (finding no evidence that questions written on a draft were actually posed to the client and denying attorney-client privilege).