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COMMONWEALTH OF MASSACHUSETTS

SUPREME JUDICIAL COURT

No. SJC-11800

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CHRIS E. MALING & another,

PLAINTIFFS-APPELLANTS,

v.

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP  
& others

DEFENDANTS-APPELLEES.

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ON APPEAL FROM THE SUPERIOR COURT  
DEPARTMENT OF THE TRIAL COURT

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BRIEF OF *AMICI CURIAE* IN SUPPORT OF APPELLEES

PAUL A. STEWART  
*Admitted Pro Hac Vice*  
KNOBBE, MARTENS, OLSON & BEAR,  
LLP  
2040 Main Street, 14<sup>th</sup> Fl.  
Irvine, CA 92614  
Telephone: (949) 760-0404  
paul.stewart@knobbe.com

Sara E. Hirshon  
B.B.O. #662202  
Verrill Dana LLP  
One Boston Place,  
Suite 1600  
Boston, MA 02108-4407  
Telephone: (617) 309-2614  
shirshon@verrilldana.com

Dated: August 20, 2015

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## **I. STATEMENT OF INTEREST OF AMICI CURIAE**

The *amici curiae* subscribing to this brief are: (1) Knobbe, Martens, Olson & Bear, LLP, (2) Honigman Miller Schwartz and Cohn LLP, (3) Nixon & Vanderhye P.C., (4) Lewis Roca Rothgerber, (5) Schiff Hardin LLP, (6) Steptoe & Johnson LLP, (7) Snell & Wilmer LLP, (8) Barnes & Thornburg LLP, (9) Pillsbury Winthrop Shaw Pittman LLP, (10) Verrill Dana LLP, and (11) Morrison & Foerster LLP. Each of these *amici curiae* is a law firm with a significant practice in patent law. Each firm has a strong interest in clear and correct conflict of interest rules, particularly as those rules affect the practice of patent law.

## **II. ISSUE PRESENTED**

Whether, under Mass. R. Prof. Conduct 1.7, an actionable conflict of interest arose when, according to the allegations in the complaint, attorneys in different offices of the same law firm simultaneously represented the plaintiffs and a competitor in prosecuting patents on similar inventions, without informing the plaintiffs or obtaining their consent to the simultaneous representation.

## **III. FACTUAL BACKGROUND**

This is an action for alleged legal malpractice filed by Chris E. Maling against the law firm of

Finnegan, Henderson, Farabow, Garrett and Dunner, LLP, and three of its attorneys (collectively "Finnegan"). Maling alleges that he retained Finnegan on April 17, 2003 to prepare and prosecute patent applications relating to a screwless eyeglass hinge that he had developed. Appx. at 8 (Complaint ¶¶ 7-11). At that time, Finnegan was already representing another client, Masunaga Optical Mfg. Co. Ltd. ("Masunaga"), in connection with what Maling describes as a "similar" invention. Appx. at 9 (Complaint ¶¶ 16-17). As a result of these representations, Finnegan obtained four patents for Maling and one patent for Masunaga. See Supp. Appx. at 26-120.

Maling alleges in his Complaint that Finnegan's concurrent representation of himself and Masunaga created a conflict of interest. Appx. at 10-11 (Complaint ¶¶ 24-27). Maling does not contend that the concurrent representation resulted in inferior patents for him, or a superior patent for Masunaga. Nevertheless, he contends that the alleged conflict caused him to invest more money in his patent applications than he otherwise would have invested. Appx. at 11 (Complaint ¶ 27).

Finnegan moved to dismiss the Complaint in the Superior Court. Appx. at 17-20. The Superior Court



granted Finnegan's motion. Appx. at 21-24. As the Superior Court explained, Massachusetts Rule of Professional Conduct 1.7(a) prohibits a lawyer from representing one client "directly adverse" to another client. Appx. at 22. However, Maling and Masunaga were not adverse to each other. *Id.* Both were seeking patents, but "the Complaint does not allege any facts to suggest that Finnegan's representation of the plaintiffs in applying for the patents was in any way affected by the fact that it also represented Masunaga." *Id.*

Similarly, as the Superior Court held, Maling has not pled facts supporting an allegation that Finnegan's representation of him was materially limited by its representation of Masunaga, in violation of Rule 1.7(b). There is no "allegation that Finnegan's independent professional judgment was impaired as a result of the dual representation or that it otherwise failed to do something that it would have done had it not been representing Masunaga." Appx. at 23. Simply put, the Complaint "does not allege that conflict-free counsel would have represented the plaintiffs any differently or produced a different or better result." Appx. at 22.

Maling appealed the Superior Court's decision to the Court of Appeals. This Court *sua sponte* accepted this case for direct appellate review and invited *amicus* input on the issue presented.

#### **IV. PATENT LAW BACKGROUND**

The Court has solicited views on whether an actionable conflict of interest arises when a single law firm files and prosecutes patent applications for "similar" inventions on behalf of two different clients. To address this issue, it is helpful to have a basic understanding of some of the concepts and principles of patent law.

##### **A. Patent Applications And Patents**

The patent process begins with the filing of a patent application. A patent application consists of two essential parts relevant to the issue presented. See 37 C.F.R. § 1.51(b)(1). The first is the specification. The specification is "a written description of the invention, and of the manner and process of making and using it." 35 U.S.C. § 112 ¶ 1 (2006).<sup>1</sup> The purpose of the specification is to teach

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<sup>1</sup> As discussed below in Section IV(C), Congress significantly revised the patent laws in 2011. These revisions affect only those patent applications filed well after the enactment of the new law. The revisions do not affect the patents at issue in the case before this Court. Accordingly, unless otherwise indicated, all citations to patent statutes are to the

the public how to make and use the invention. *Id.* This allows the public to freely use the invention upon expiration of the patent. See *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 150-51 (1989).

The second essential part of a patent application is the claims. 35 U.S.C. § 112 ¶ 2 (2006). The claims are the numbered sentences at the end of the specification. The claims define the scope of the legal rights the inventor is seeking. See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) ("It is a 'bedrock principle' of patent law that 'the claims of a patent define the invention to which the patentee is entitled the right to exclude'."). Typically, a claim is a list of components or elements that make up the invention. For example, Thomas Edison's claim for his light bulb contained just two elements: (1) "a filament of carbon of high resistance," and (2) "metallic wires" connected to the filament. See U.S. Pat. No. 223,898 (Jan. 27, 1880).<sup>2</sup>

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pre-2011 version of the statutes, which governs the patent applications at issue here.

<sup>2</sup> All United States patents are available on the United States Patent and Trademark Office's website, [www.uspto.gov](http://www.uspto.gov).

The United States Patent and Trademark Office (PTO) reviews each patent application to determine whether the invention set forth in the claims is patentable. See 35 U.S.C. § 131 (2006); 37 C.F.R. § 1.104. This involves comparing the claim to earlier inventions described in prior patents and publications. The collection of all earlier patents, publications, and other publicly available inventions is known in patent law as "prior art." If the applicant's invention, as set forth in a claim, is the same as an invention described in the prior art, it is not patentable. See 35 U.S.C. § 102 (2006). Similarly, if the applicant's invention is merely a minor, obvious improvement over the prior art, it is not patentable. See 35 U.S.C. § 103 (2006); *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

In many cases, the PTO initially concludes that the claims in a patent application are unpatentable in light of the prior art. The applicant is then given an opportunity to amend his or her claims. This is often done by adding more elements to the claims or by modifying the existing elements of the claims, both of which serve to narrow or limit the scope of the claims. The amended list of claim elements is then compared again to the prior art by the PTO.

Eventually, the application may issue as a patent. When this occurs, the patent will include the same two basic parts as the original patent application: the specification and the claims. In fact, the patent is, for all relevant purposes, identical to the patent application, as that application has been amended by the applicant and the PTO.

When the patent issues, it provides the patent owner with the right to exclude all others from making, using, or selling the patented invention. 35 U.S.C. § 154(a) (2006); 35 U.S.C. § 271(a) (2006). As mentioned above, "the claims of a patent define the invention to which the patentee is entitled the right to exclude." *Phillips*, 415 F.3d at 1312. Accordingly, to determine whether a competitor has infringed a patent, the competitor's product is compared to the claims of the patent. Infringement occurs only if the competitor's product includes each and every element listed in one of the claims. *Ericsson, Inc. v. D-Link Sys.*, 773 F.3d 1201, 1215 (Fed. Cir. 2014).<sup>3</sup> Every limitation of a claim is

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<sup>3</sup> There is a narrow exception to this basic principle, known as the "doctrine of equivalents." Under this doctrine, a change to one of the claim elements that is trivial or "insubstantial" will not avoid infringement. See generally *Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17 (1997). Still, for infringement to be found, every element of

material, and the absence of even a single element avoids infringement. *Rohm & Haas Co. v. Brotech Corp.*, 127 F.3d 1089, 1092 (Fed. Cir. 1997). Thus, just as the claims are of central importance in the patent examination process, they are also of central importance in the patent enforcement process.

Edison's light bulb patent again provides a good example of the importance of the claims. Edison's patent provided him with the right to prevent others from making light bulbs that included "a filament of carbon of high resistance," connected to "metallic wires." If a competitor devised a light bulb that included only a filament of carbon of low resistance, or a filament of an entirely different substance such as silicon, the competitor would avoid infringement. This would be true even if the light bulb functioned just as well as Edison's light bulb. Edison's patent covered only light bulbs having the specific list of elements recited in the claims. The omission of a single element from the competitor's product thus avoids infringement.

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the claim must be present in the competitor's device, either literally or through an insubstantially different substitute. *Id.* at 29; *Function Media, L.L.C. v. Google Inc.*, 708 F.3d 1310, 1330 (Fed. Cir. 2013). The doctrine of equivalents is not relevant to the issues presented in this case.