

Lisa A. Dolak
Angela S. Cooney Professor of Law

Book Chapters

The Ethics of Patent Assertion: Does “Purpose” Matter?, in IP MONETIZATION AND INVESTMENT 2017: MAXIMIZE YOUR FINANCIAL AND STRATEGIC OPTIONS (2017).

Negotiation Ethics: Guidance for the Intellectual Property Practitioner, in IP MONETIZATION AND INVESTMENT 2017: MAXIMIZE YOUR FINANCIAL AND STRATEGIC OPTIONS (2017).

Don't Check Your Ethics at the Door: The Ethical Implications of Legal Service Outsourcing, (with Tyler Maulsby & Michael E. McCabe), in PATENT LAW INSTITUTE 2016 (10TH ANNUAL) (PLI Intellectual Property Course Handbook Series No. G-1268, 2016) and PATENT LAW INSTITUTE 2018: CRITICAL ISSUES & BEST PRACTICES (PLI Intellectual Property Course Handbook Series No. G-1362, 2018).

Patent Office Post-Grant Trials and the Duty of Candor, in USPTO POST-GRANT PATENT TRIALS 2013, at 465 (PLI USPTO Post-Grant Patent Trials Course Handbook Series No. G-1130, 2013).

Innovation & Intellectual Property Rights in China and India: Prospects and Strategies (with Bernard Arogyaswamy), in INTELLECTUAL PROPERTY, INNOVATION AND MANAGEMENT IN EMERGING ECONOMIES (Ruth Taplin & Alojzy Z. Nowak eds. 2010).

Inequitable Conduct: A Flawed Doctrine Worth Saving, in PATENT LAW INSTITUTE 2010 (4TH ANNUAL), at 877 (PLI Pat. Copyrights, Trademarks & Literary Prop., Course Handbook Series No. 997, 2010).

Ethical Intellectual Property Opinions (and it's all legal!), in PREPARING PATENT LEGAL OPINIONS 2004, at 519 (PLI Pat. Copyrights, Trademarks & Literary Prop., Course Handbook Series No. 802, 2004) *reprinted in* PREPARING PATENT LEGAL OPINIONS 2005, at 217 (PLI Pat. Copyrights, Trademarks & Literary Prop., Course Handbook Series No. 843, 2005).

Federal Circuit Treatment of the Inequitable Conduct Defense (with Steven C. Becker), in 16 SELECTED LEGAL PAPERS: A COLLECTION OF PAPERS BASED ON PRESENTATIONS AT AIPLA FUNCTIONS 175 (Thomas E. Smith ed., 1997).

Inequitable Conduct in the Presentation of Affidavits to the U.S. Patent and Trademark Office (with Michael L. Goldman), in AM. INT. PROP. L. ASS'N BASIC CHEMICAL AND BIOTECHNOLOGY PATENT PRACTICE SEMINAR COURSE BOOK (1996).

Prosecuting Patent Applications in the Face of Prior Art Rejections (with Michael L. Goldman), in AM. INT. PROP. L. ASS'N BASIC CHEMICAL AND BIOTECHNOLOGY PATENT PRACTICE SEMINAR COURSE BOOK (1994).

Law Review and Other Scholarly Articles

Patent Office Contested Proceedings and the Duty of Candor, 22 J. INTELL. PROP. L. 1 (2014).

Trial Lawyers in Trouble: Litigation Misconduct and Its Ethics Fallout, 52 U. LOUISVILLE L. REV. 225 (2014).

Litigating Inequitable Conduct After Therasense, Exergen, and the AIA: Lessons for Litigants, Options for Owners, 13 CHI.-KENT J. INTELL. PROP. 51 (2013).

America Invents the Supplemental Examination But Retains the Duty of Candor: Questions and Implications, 6 AKRON INTELL. PROP. J. 147 (2012).

Ethics in Intellectual Property Negotiations: Issues and Illustrations, 40 AIPLA Q.J. 197 (2012).

The America Invents Act: Target, the Eastern District of Texas, Panel, 15 SMU SCI. & TECH. L. REV. 471 (2012).

One Patent, Two Paths: Federal Circuit Review of Divergent USPTO and District Court Decisions, 4 LANDSLIDE 22 (Nov. – Dec. 2011).

Inequitable Conduct: A Flawed Doctrine Worth Saving, 11 WAKE FOREST J. OF BUS. & INTELL. PROP. L. 1 (2010–2011).

The Inequitable Conduct Gyre Widens, 50 IDEA 215 (2010).

Beware the Inequitable Conduct Charge! (Why Practitioners Submit What They Submit), 91 J. PAT. & TRADEMARK OFF. SOC'Y 558 (2009), *reprinted in* PATENT LAW INSTITUTE 2010 (4TH ANNUAL), at 895 (PLI Pat. Copyrights, Trademarks & Literary Prop., Course Handbook Series No. 997, 2010).

The United States Patent System in the Media Mirror (with Blaine T. Bettinger), 58 SYRACUSE L. REV. 459 (2008).

EBay and the BlackBerry®: A Media Coverage Case Study, 2 AKRON INTELL. PROP. J. 1 (2008).

Power or Prudence: Toward a Better Standard for Evaluating Patent Litigants' Access to the Declaratory Judgment Remedy, 41 U.S.F. L. REV. 407 (2007).

The Ethics of Delaying Prosecution, 53 AM. U. L. REV. 739 (2004).

Risky Business: The Perils of Representing Competitors, 30 AIPLA Q.J. 413 (2002).

The Inequitable Conduct Doctrine: Lessons from Recent Cases, 84 J. PAT. & TRADEMARK OFF. SOC'Y 719 (2002).

Recognizing and Resolving Conflicts of Interest in Intellectual Property Matters, 42 IDEA 453 (2002).

Clients, Their Confidences, and Internet Communications, 36 TORT & INS. L.J. 829 (2001).

Responding to Prior Art Rejections—An Analytical Framework (with Michael L. Goldman), 83 J. PAT. & TRADEMARK OFF. SOC'Y 5 (2001).

As If You Didn't Have Enough to Worry About: Current Ethics Issues for Intellectual Property Practitioners, 82 J. PAT. & TRADEMARK OFF. SOC'Y 235 (2000).

Patents Without Paper: Proving a Date of Invention with Electronic Evidence, 36 HOUS. L. REV. 471 (1999).

Conflicts of Interest: Guidance for the Intellectual Property Practitioner, 39 IDEA 267 (1999).

Declaratory Judgment Jurisdiction in Patent Cases: Restoring the Balance Between the Patentee and the Accused Infringer, 38 B.C. L. REV. 903 (1997).

Riding the Rapids: Financing the Leveraged Transaction Without Getting Wet (with Christian C. Day & Michael P. Walls), 41 SYRACUSE L. REV. 661 (1990).

Reports, News and Commentary

USPTO Post-Grant Proceedings and the Duty of Candor, KOR. BAR ASS'N NEWS (December 2013), available at <http://news.koreanbar.or.kr/news/articleView.html?idxno=10152>.

USPTO Contested Proceedings: New Challenges, New Opportunities, KOR. BAR ASS'N NEWS (September 2013) available at: <http://news.koreanbar.or.kr/news/articleView.html?idxno=9543>.

Ideology in the Supreme Court, THE WCNY MAGAZINE, at 8 (September/October 2013).

New USPTO Professional Conduct Rules Will Take Effect on May 3, Guest Post, Patently-O (April 3, 2013). Available at <http://www.patentlyo.com/patent/2013/04/guest-post-new-uspto-professional-conduct-rules-will-take-effect-on-may-3.html>.

Major Shift for U.S. Patent System, KOR. BAR ASS'N NEWS (March 2013).

USPTO Contested Proceedings: New Challenges, New Opportunities, KOR. BAR ASS'N NEWS (September 2013) Available at: <http://news.koreanbar.or.kr/news/articleView.html?idxno=9543>.

New USPTO Proposed Ethics Rules, Guest Post, Patently-O (Oct. 18, 2012). Available at <http://www.patentlyo.com/patent/2012/10/guest-post-new-uspto-proposed-ethics-rules-part-i.html>.

Supplemental Examination in Context: Risks, Alternatives and Opportunities (June 27, 2012), available at SSRN: <http://ssrn.com/abstract=2094497>.

Supplemental Examinations and the Client-Practitioner Relationship, Guest Post, Patently-O (Dec. 30, 2011). Available at <http://www.patentlyo.com/patent/2011/12/guest-post-supplemental-examinations-and-the-client-practitioner-relationship-.html>.

Ivory Tower at Westcott Center, SYRACUSE POST STANDARD, Nov. 1, 2012, at A4.

Misrepresenting the Client's "Bottom Line": Permitted Puffery? Or Prohibited Deceit?, PLI Patent Law Practice Center (Oct. 17, 2011). Available at <http://patentlawcenter.pli.edu/2011/10/17/misrepresenting-the-clients-bottom-line-permitted-puffery-or-prohibited-deceit/>.

Resolving Differences: How the Federal Circuit Treats Divergent USPTO and District Court Rulings, PLI Patent Law Practice Center (July 19, 2011). Available at <http://patentlawcenter.pli.edu/2011/07/19/resolving-differences-how-the-federal-circuit-treats-divergent-uspto-and-district-court-rulings/>.

Whose Rules Rule? Federal Circuit Review of Divergent USPTO and District Court Decisions (Feb. 23, 2011). Available at SSRN: <http://ssrn.com/abstract=1776189>.

Supplemental Examinations to Consider, Reconsider, or Correct Patent-Related Information, PLI Patent Law Practice Center (Jan. 3, 2011). Available at <http://patentlawcenter.pli.edu/2011/01/03/supplemental-examinations-to-consider-reconsider-or-correct-patent-related-information/>.

In the Wake of MedImmune: What We Have Learned, PLI Patent Law Practice Center (Sept. 14, 2010). Available at <http://patentlawcenter.pli.edu/2010/09/14/in-the-wake-of-medimmune-what-we-have-learned/>.

Lawyers Acting Badly, or Not? Misconduct in IP Litigation: Recent Examples and the Questions They Raise, PLI Patent Law Practice Center (July 14, 2010). Available at <http://patentlawcenter.pli.edu/2010/07/14/lawyers-acting-badly-or-not-misconduct-in-ip-litigation-recent-examples-and-the-questions-they-raise/>.

Recent and Proposed Patent System Reforms: Implications for Technology Commercialization (March 19 2009). Available at SSRN: <http://ssrn.com/abstract=1365439>.

Patent Reform: A Necessary Evil?, INNOVATION: AM. J. TECH. COMMERCIALIZATION, Feb.-Mar. 2008, at 9.

Professionalism: What's In It For In-House Counsel?, INSIDE (Corp. Couns. Sec. N.Y. St. B.A.), Summer 2003, at 9.

Negotiation Ethics: Not an Oxymoron, IPL NEWSL. (A.B.A. Sec. Intell. Prop. L.), Fall 2003, at 16.

Judges Increasingly Criticize Patent Counsel, PAT. STRATEGY & MGMT., Dec. 2002, at 5.

Pre-File Investigations: Look Before You Leap, PAT. STRATEGY & MGMT., March 2002, at 1.

E-Evidence: Proving Invention Dates with Electronic Records, PAT. STRATEGY & MGMT., Aug. 2001, at 1.

How to Educate Inventors about Inequitable Conduct, INTELL. PROP. STRATEGIST, Aug. 2000, at 1.

Evaluating Conflicts of Interest: Are You Cavalier, Confident, Cautious or Clueless? (A Quiz for the Intellectual Property Law Specialist), IPL NEWSL. (A.B.A. Sec. Intell. Prop. L.), Fall 1999, at 16.

The Inequitable Conduct Defense: Down, But Not Out (with Steven C. Becker), IPL NEWSL. (A.B.A. Sec. Intell. Prop. L.), Summer 1997, at 1.