# Table of Contents

**Introduction to the Guidebook**

**Chapter 1: Attorney-Client Privilege for the In-House Attorney**

I. The Corporation as Client—Who Holds the Privilege?  
   A. “Control Group” and “Subject Matter” Tests  
   B. “Upjohn Warnings”  
II. Legal Advice Versus Business Advice—What Communications Are Protected?  
   A. Privilege Protects Communications, Not Facts  
   B. Communication Must Be To or From an Attorney Acting in That Capacity  
   C. Communication Must Be for the Purpose of Securing or Providing Legal Advice  
III. Confidentiality of Communications  
IV. Asserting the Privilege  
V. Waiver  
   A. Corporation Is the Holder of the Privilege and Therefore Able to Waive It  
   B. Voluntary Waiver  
   C. Involuntary Waiver  
VI. Conclusion—“It’s Different In-House”  

**Chapter 2: Internal Corporate Investigations**

I. Subject Matters Involved in Corporate Internal Investigations  
   A. Employment  
   B. Cybersecurity and Theft of Intellectual Property  
   C. Securities  
   D. Corruption  
   E. Consumer Protection  
   F. Environmental
II. Ways Legal Departments Learn of Issues That May Warrant Investigation 24
   A. Whistleblowers 24
   B. Government Inquiry or Investigation 25
   C. Independent Auditors 25

III. Internal Investigations: The Mechanics 26
   A. Is an Internal Investigation Necessary? 26
   B. Should Corporate Counsel “Outsource” the Internal Investigation? 27
   C. Conducting the Investigation 31

IV. Self-Disclosure of Investigative Findings 36

V. Conclusion 39

Chapter 3: Conducting a Sexual Harassment Investigation:
A Practical Guide 41

I. Introduction 41

II. Applicable Law 42
   A. Quid Pro Quo Harassment 43
   B. Hostile Work Environment 44
   C. Defining Sexual Harassment 44
   D. Employer Liability 45

III. Essential Steps for Conducting Workplace Sexual Harassment Investigations 47
   A. Take Control Quickly 47
   B. Maintain Confidentiality 48
   C. Preserve, Collect, and Analyze Relevant Documents 48
   D. Know Your Internal Policies and Procedures 49
   E. Select an Investigator 49
   F. Create an Investigative Plan 50
   G. Interview Witnesses 50
   H. Ensure No Retaliation 50

IV. Creating a Harassment-Free Workplace 51

Appendix A: EEOC Sexual Harassment Checklists 53
Appendix B: Sample Document Hold Order 57

Chapter 4: Mediation and Arbitration: How to Prepare Your Company and Yourself 59

I. Introduction 59

II. Overview of Mediation 60
   A. What Is Mediation? 60
   B. The Mediator’s Role 60
   C. The Benefits of Mediation 61
   D. Additional Considerations Surrounding the Use of Mediation 63
   E. Best Advocacy Practices in Mediation 65

III. Overview of Arbitration 66
   A. The Arbitrator's Role 67
   B. The Benefits of Arbitration 67
   C. Additional Considerations Surrounding Arbitration 70
# Table of Contents

IV. Strategic Drafting of Dispute Resolution Clauses 71
   A. The Importance of a Well-Drafted Dispute Resolution Clause 71
   B. The Standard Arbitration Clause 72
   C. Key Drafting Considerations 74

V. Best Advocacy Practices in Arbitration 80
   A. Selecting the Best Arbitrator(s) 81
   B. Hiring Counsel Experienced in Arbitration 81
   C. Know the Rules 82
   D. Preparation for the Preliminary Hearing 82
   E. Prehearing 82
   F. Hearing 82

VI. Conclusion 83

## Chapter 5: Cybersecurity and Protecting Data Privacy 85

I. Threat Sources 89

II. Legal Framework 91
   A. Sampling of Industry-Specific Requirements 91
   B. Enforcement 94
   C. Cross-Border Issues 95

III. Building Corporate Resilience 97
   A. Develop, Implement, and Maintain a Culture of Security 97
   B. Interdisciplinary Approach 98
   C. Vendor/Supplier Due Diligence and Appropriate Contract Terms 99
   D. Considerations for Corporate Transactions 100
   E. Ensure Cyberinsurance Coverage Is in Place 101

IV. Preparing to Respond to a Breach—Develop, Test, and Update Incident Response Plan 102
   A. Incident Response Plans 102
   B. Responding to a Data Incident 105

V. Practice Tips/Recommendations 108
   A. Threat Sources 108
   B. Legal Framework 109
   C. Building Corporate Resilience 109
   D. Preparing to Respond to a Breach 109
   E. Resources 109

VI. Conclusion 110

## Chapter 6: Requests for Proposal and Alternative Fee Arrangements as an Effective Tool for Evaluating and Selecting Outside Counsel 113

I. Advantages of RFPs 114
   A. Level Playing Field 114
   B. Better Pricing 114
   C. Improving Diversity 115
   D. Assessment of Available Legal Service Providers 115
## Chapter 7: Managing Regional and National Litigation

### I. Introduction

#### A. Complaint Intake and Assessment

#### B. Determine the Availability of Insurance Coverage

#### C. Retention of Outside Counsel

#### D. Immediately Institute a Broad Litigation Hold

#### E. Developing a Public-Relations Strategy

#### F. Should You Expect Copycat or Related Cases?

#### G. Accounting Matters

### II. Early Case Management

#### A. Complaint Intake and Assessment

#### B. Determine the Availability of Insurance Coverage

#### C. Retention of Outside Counsel

#### D. Immediately Institute a Broad Litigation Hold

#### E. Developing a Public-Relations Strategy

#### F. Should You Expect Copycat or Related Cases?

#### G. Accounting Matters

### III. Conducting Internal Investigations

#### A. Internal Versus Independent Investigations

#### B. Internal Investigation in Aide of Litigation

#### C. Related Issue: Personnel Actions
IV. Initial Considerations in Responding to the Complaint
   A. Assessing Personal Jurisdiction 149
   B. Is Removal to Federal Court an Option? 150
   C. Assessing Venue 152
   D. Assessment of Claims and Defenses 154

V. Multidistrict Litigation and Coordination within a Single Jurisdiction 155
   A. Consolidation of Federal Cases 155
   B. Coordination of Related State Actions 157
   C. Management of Related Regulatory Actions 157

VI. Management and Coordination of Discovery 158
   A. Protecting Confidential Information 158
   B. Establishing a Realistic Discovery Schedule 159
   C. Managing Discovery of Electronically Stored Information 159
   D. Managing Depositions 161
   E. Managing Expert Discovery 162

VII. Summary Judgment and Trial 162

VIII. Settlement Discussions and Settlement 163

IX. Conclusion 165
   Appendix A: Sample Document Preservation Notice 166
   Appendix B: Sample Upjohn Warning Statement 169

Chapter 8: The Impact of the Automatic Stay 171

I. Filing Bankruptcy Invokes the Automatic Stay 172
II. Scope of the Automatic Stay 172
   A. Litigation Involving the Debtor 173
   B. Actions Against Property of the Estate 175
   C. Co-Debtor Stay 177

III. Statutory Exceptions to the Automatic Stay 178
   A. The Automatic Stay and Lessors 179
   B. Exception for Restitution under Section 362(b)(1) of the Bankruptcy Code 179
   C. Scope of the Police Power under Section 362(b)(4) of the Bankruptcy Code 180

IV. Duration of the Automatic Stay 181

V. Limitations on the Automatic Stay for Repeat Filers and Single-Asset Real Estate Cases 181

VI. Modification and Termination of the Automatic Stay 182
   A. Relief under Section 362(d)(1) of the Bankruptcy Code 182
   B. Relief under Section 362(d)(2) of the Bankruptcy Code 184
   C. Relief under Section 362(d)(3) of the Bankruptcy Code 185
   D. Relief under Section 362(d)(4) of the Bankruptcy Code 185

VII. Stay Stipulations in Lieu of Litigation 186

VIII. Violations of the Automatic Stay Have Serious Consequences 187
   A. Willful Violations of the Automatic Stay 187
   B. Actions Violating the Automatic Stay May Be Void 187
   C. Damages for Violations of the Automatic Stay 188
D. Damages under Section 362(k) of the Bankruptcy Code Are Available Only to Individual Debtors 189
E. Lack of Notice and Violations of the Automatic Stay 189

IX. Conclusion 190

Chapter 9: Managing Class Actions 191

I. What Is a Class Action? Overview of Class Actions 191
II. Can a Company Force Its Customers to Give Up the Right to Bring a Class Action? Arbitration Clauses and Class Action Waivers 192
IV. Ascertainability 197
V. What Happens When Multiple Class Actions Are Filed in Different Courts Stemming from the Same Facts? 197
VI. Practical Considerations in Managing a Class Action 199
VII. Standing of the Named Plaintiff 200
A. Article III's Injury-in-Fact Requirement 200
B. Does a Plaintiff Have Standing to Sue for Consumer Products or Securities the Plaintiff Did Not Purchase? 201
VIII. Settlement of Class Actions 202
A. Can a Defendant Simply Pay the Plaintiff to Eliminate the Possibility of a Case Proceeding as a Class Action? Mooting a Class Action Through Offers of Settlement 202
B. If a Defendant Wishes to Settle, Should Mediation Be Considered? 203
IX. Insurance Coverage Issues Related to Class Actions 204
A. Types of Coverage 204
B. Coverage Layers 205
C. Five Key Coverage Issues 205
X. Conclusion 207

Chapter 10: Electronic Discovery in Civil Litigation 209

I. Identification of Relevant ESI: Finding What Matters 211
A. Investigating and Identifying Potential Sources of Electronic Evidence 211
B. Custodian Questionnaires and Interviews 212
II. Preservation of ESI and Avoiding Claims of Spoliation of Electronic Evidence 213
A. The Duty to Preserve 213
B. Legal Holds 214
C. Documenting Preservation Efforts 216
III. Responding and Objecting to Written Discovery for ESI 217
IV. Negotiating ESI Discovery Requests and Responses: The Meet and Confer 219
A. Discovery Plan 220
B. Culling Methods 220
C. ESI Protocol 220
III. Acquiring Rights in Marks 286

IV. Federal Trademark Registration Benefits and Process 287
   A. The Principal Register 287
   B. The Supplemental Register 288
   C. The Registration Process 289
   D. Post-Application Considerations and Procedures 295
   E. Registration 297

V. Trademark Protection in the Digital Age: Protecting Trademarks from Cybersquatting 300
   A. The Anti-Cybersquatting Consumer Protection Act (ACPA) 300
   B. Uniform Domain Name Dispute Resolution Policy 301

Chapter 13: Patents 311

I. What Is a Patent? 312

II. What Does a Patent Allow? 312

III. Discussion of the Law 312

IV. Scope of Rights Conferred 313

V. U.S. Patents 314
   A. Types of Inventions 314
   B. What Qualifies as an Invention? 314

VI. Treaties and Foreign Patents 318

VII. How to Get a Patent 319
   A. Who Has the Rights to a Patent? (Inventor Versus Company) 319
   B. Types of Filings 320

VIII. Parts of an Issued Patent 321
   A. Summary Page 321
   B. Drawing Set 323
   C. Background of the Invention 325
   D. Brief Description of the Drawings/Brief Summary 325
   E. Detailed Description of the Invention 325
   F. Claims 325

IX. After the Application 327
   A. Maintenance Fees 327

X. Assignments and Licenses 327
   A. Recording of Assignments 328

XI. Infringement 328
   A. Marking Requirement 329
   B. All-Elements Test 329
   C. Doctrine of Equivalents 330
# Chapter 14: Copyright

## I. Introduction

### II. Legal Basis for Copyright Protection
- **A. Federal Law**
- **B. State Law**
- **C. Copyright Office**
- **D. International Protection**

## III. Copyrightable Subject Matter

## IV. Standards for Copyright Protection
- **A. Originality**
- **B. Fixation**

## V. Copyright Owner’s Exclusive Rights
- **A. Exclusive Rights**
- **B. Exceptions to the Copyright Owner’s Exclusive Rights**
- **C. Compulsory and Statutory Licenses**

## VI. Moral Rights

## VII. Copyright Ownership
- **A. Works Made for Hire**
- **B. Joint Authorship and Ownership**
- **C. Collective Works**

## VIII. Transfer of Copyright Ownership
- **A. Recording Transfer with the Copyright Office**
- **B. Termination Rights**

## IX. Duration of Rights

## X. Publication

## XI. Notice

## XII. Registration

## XIII. Mandatory Deposit

## XIV. Copyright Renewal

## XV. Infringement Claims, Defenses, and Remedies
- **A. Civil Claims—Direct and Indirect Infringement**
- **B. Criminal Copyright Infringement**
- **C. Defenses**
- **D. Remedies**

---

**About the Authors**

**Index**