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## CHAPTER 19

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# Attorney-Client Privilege and Work-Product Immunity in U.S. Patent Litigation

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\*The views expressed in this chapter are the personal opinions of the author alone and not those of the law firm Oblon, Spivak, McClelland, Maier & Neustadt, P.C., its attorneys, or its clients.

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### *I. Introduction and Overview*

The general legal principles governing attorney-client privilege and the somewhat related concept of work-product immunity are the same in patent cases as they are in other areas of the law. Unfortunately, the district courts' applications of those known principles to fact patterns that are largely unique to patent suits have resulted in decisions that are far from uniform. Since most privilege and work-product issues are, as a practical matter, resolved at the district court level without appellate review by the United States Court of Appeals for the Federal Circuit (which has exclusive appellate jurisdiction in all patent cases), litigants who seek the district court's intervention to resolve issues of privilege or work product in a patent case more often than not do so without the benefit of a clear legal roadmap of precedent to guide them. Depending upon which side of the issue one wishes to advocate, this general lack of binding precedent can be viewed as either a blessing or a curse. Indeed, a resourceful patent litigant can almost always find *some* authority to support a particular position on an issue of privilege. This lack of appellate authority on many privilege and work-product issues that normally arise during a patent case, coupled with the relatively high stakes of U.S. patent litigation, invariably leads to more disputes before the district courts over the applications, limits, and scope of discovery.

This chapter provides an overview of the current state of the law on attorney-client privilege and work-product immunity in patent cases. It is not intended to address all possible issues of privilege or work product that may arise in the context of a patent case. Rather, the discussion is limited to those particular privilege or work-product subjects that, in the author's opinion, seem to come up with greatest frequency during litigation.

### *II. General Rules on Privilege and Work Product in Patent Cases*

In patent cases, as in all other federal civil cases, the Federal Rules of Civil Procedure define the limits of discovery. Rule 26(b)(1) provides for relatively broad discovery of

any matter, not privileged, which is relevant to the subject matter involved in the pending action. . . . The information need not be admissible at the trial if the information sought appears reasonably calculated to lead to the discovery of admissible evidence.<sup>1</sup>

It is, of course, proper to withhold from discovery in a patent case documents or testimony that are properly protected by the attorney-client privilege or work-product immunity. In contrast to the discovery provisions allowing for generally broad discovery, the privilege limitation usually is restricted to its narrowest bounds<sup>2</sup> because an assertion of privilege is generally viewed by judges as an obstacle to the investigation of truth.<sup>3</sup>

### A. Attorney-Client Privilege

To sustain a claim of attorney-client privilege in a patent case, the withheld document or communication must meet a number of requirements. The requirements articulated by the district court's seminal decision in *United States v. United Shoe Machinery Corp.* are often used in patent cases as the yardstick against which courts tend to measure claims of attorney-client privilege:

The privilege applies only if (1) the asserted holder of the privilege is or sought to become a client; (2) the person to whom the communication is made (a) is a member of the bar of a court, or his subordinate and (b) in connection with the communication is acting as a lawyer; (3) the communication related to a fact of which the attorney was informed (a) by his client (b) without the presence of strangers (c) for the purpose of securing primarily either (i) an opinion on law or (ii) or legal services or (iii) assistance in some legal proceeding, and not (d) for the purpose of committing a crime or tort; and (4) the privilege has been (a) claimed and (b) not waived by the client.<sup>4</sup>

The central inquiry in determining whether a communication usually is privileged is whether the "communication" at issue (whether it is conveyed orally or in a document) is one that was made by a client to an attorney for the purpose of obtaining legal advice or services.<sup>5</sup> In addition, confidentiality is often a critical threshold for establishing privilege, and it is well established that once a party has made a voluntary disclosure of all or part of a privileged communication to a third party, the privilege is lost for all communications relating to the same subject matter.<sup>6</sup> The mere existence of an attorney-client relationship does not raise a presumption of confidentiality.<sup>7</sup>

The attorney-client privilege applies to communications to or from an attorney only to the extent that they reflect information obtained in confidence from the client for the purpose of obtaining legal advice, as opposed to business information.<sup>8</sup> To the extent that a communication by an attorney simply reveals the contents of public information or information from a third party, it is not protected by the attorney-client privilege unless it also contains legal advice or responds to a request for advice.<sup>9</sup> Furthermore, simply because an attorney may have been copied on a communication does not necessarily convert that communication into a privileged communication. Legal advice must have been sought or requested for the communication to be privileged.<sup>10</sup>

### B. Work-Product Immunity

The work-product immunity doctrine is a related yet distinct concept from the attorney-client privilege.<sup>11</sup> The work-product immunity doctrine protects from discovery materials developed in anticipation of litigation or for trial by an attorney, or on his behalf.<sup>12</sup> To be afforded protection under the work-product immunity doctrine, the document in question must have been prepared in anticipation of litigation or for trial.

Work product comprises the files and the mental impressions of an attorney reflected, of course, in interviews, statements, memoranda, correspondence, briefs, mental impressions, personal beliefs, and countless other tangible and intangible ways prepared in anticipation of litigation.<sup>13</sup> Work product is (1) a document or tangible thing, (2) that was prepared in anticipation of litigation and (3) that was prepared by or for a party, or by or for his representative.<sup>14</sup> Documents prepared in the ordinary course of business, or for any other nonlitigation purpose, generally will not qualify as being protected from discovery by the work-product immunity privilege.<sup>15</sup>

For a document to be considered work product, litigation need not have actually been commenced. All that is required is that a substantial probability of litigation existed when the document was created.<sup>16</sup> While it is typically not required that the work-product privilege pertain only to a specific litigation (normally the litigation in which the privilege is being asserted as a reason for withholding discovery),<sup>17</sup> the mere possibility of future litigation in and of itself is usually insufficient to evoke the work-product immunity privilege.<sup>18</sup> The work-product assessment is a fact-specific inquiry, and in making the determination as to whether a particular document was created in anticipation of litigation or for trial, the court must look at the circumstances of each case.<sup>19</sup> Like the attorney-client privilege, courts generally strictly confine the scope of the work-product exception within the narrowest possible limits consistent with the logic of its principle.<sup>20</sup>

### III. *Communications Relating to the Conception and Patenting of an Invention as Privileged or Work Product*

Accused patent infringers invariably wish to discover documents and communications relating to the creation and patenting of the invention that is the subject of their litigation. There are a number of specific types of communications that are commonly the subject of discovery requests in patent cases. For example, usually a patentee will possess documents and communications relating to the underlying technical problem that the inventors set out to solve. The inventors may investigate one or more solutions to that technical problem. As part of the invention process, inventors invariably will document their solutions and the tests they conducted. Additionally, inventors in a corporation often will communicate with coworkers, supervisors, and others inside (and perhaps outside) their organization about their discoveries.

Typically, at some point in the invention process, the inventors (or their bosses) will think about patenting their discovery. They may at some point communicate with either an in-house patent specialist (who may or may not be an attorney or registered patent agent) or an outside patent specialist (normally a patent attorney or patent agent). As part of the process, the inventors (or someone on their behalf) may research patents and other publications to evaluate if what has been discovered by the inventors is new. The inventors, or others in their organization, also may document the business reasons they believe support the cost of seeking patent protection. Finally, someone—the inventors themselves, in-house counsel, or outside counsel—will prepare a patent application. Eventually the inventors themselves (or, more commonly, their representative) will file a final version of their patent application in one or more countries.

The question often arises in patent cases whether and to what extent these various communications and associated documents regarding conception and patenting of an invention are privileged. The Federal Circuit's decision in *In re Spalding Sports Worldwide, Inc.*<sup>21</sup> provides the appropriate starting point for this analysis.

#### A. The Privilege Standard Set Forth by the *Spalding* Decision

In *Spalding*, the district court had ordered a patentee to produce an internal corporate "invention record" pertaining to the invention of what eventually became the patent-in-suit, concluding that such a communication was not privileged. An invention record is a standard form "generally used by corporations as a means for inventors to disclose to the corporation's patent attorneys that an invention has been made and to initiate patent action. They are usually short documents containing space for such information as names of inventors, description and scope of invention, closest prior art, first date of conception and disclosure to others, dates of publication, etc."<sup>22</sup> On appeal, the Federal Circuit vacated the district court's order to produce the invention record. The appellate court held that the corporation's invention record was privileged.

The Federal Circuit first determined that whether an invention record qualifies as a privileged document is a question unique to patent law because the invention record relates to an invention submitted for consideration for possible patent protection; it thus clearly implicates substantive patent law.<sup>23</sup> Applying its own law in this case of first impression, the court held that "an invention record constitutes a privileged communication, as long as it is provided to an attorney 'for the purpose of securing primarily a legal opinion, or legal services, or assistance in a legal proceeding.'"<sup>24</sup> The court in *Spalding* concluded that the corporation's invention record was privileged because it "was prepared and submitted primarily for the purpose of obtaining legal advice on patentability and legal services in preparing a patent application."<sup>25</sup>

The fact that the invention record document included technical information did not change the Federal Circuit's conclusion that the document was privileged. The Federal Circuit explained that:

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 the privilege over the communication in which that information was disclosed to the attorney.<sup>26</sup>

*In dicta*, the court addressed the so-called *Jack Winter*<sup>27</sup> line of district court decisions. These prior lower court decisions had held that the transmission of technical information to an attorney, and documents relating to patent prosecution, were not privileged because the attorney was acting merely as a "conduit" between the client and the U.S. Patent and Trademark Office.<sup>28</sup> The Federal Circuit distinguished *Jack Winter* and its progeny as not deal[ing] specifically with invention records and found that, in any event, those cases were not binding on this court.<sup>29</sup> The Federal Circuit concluded that the better rule regarding privilege "was the one articulated in this case."<sup>30</sup>

### B. District Court Cases Applying *Spalding*

The *Spalding* case does not stand for the blanket proposition that all invention and patent prosecution-related communications are privileged. Strictly speaking, the Federal Circuit's holding was limited to invention records submitted to patent counsel for the purpose of obtaining legal advice on patentability. Nevertheless, the court's choice of law analysis and its criticism of the "conduit" theory has resulted in a general strengthening of a patent applicant's right to withhold as privileged a number of different types of documents and communications that are commonly created in the course of inventing and patenting an invention.

For example, in *Martin Marietta Materials, Inc. v. Bedford Reinforced Plastics, Inc.*,<sup>31</sup> the district court applied *Spalding* in concluding that communications between a client and counsel regarding prior art and the duty to disclose material information to the U.S. Patent and Trademark Office was privileged.<sup>32</sup> The privileged communications included "relevant technical information" that was required to "evaluate patentability and/or to prepare a patent application."<sup>33</sup>

Similarly, in *Innogenetics, N.V. v. Abbott Laboratories*,<sup>34</sup> the district court refused to limit its interpretation of the *Spalding* decision to invention disclosures. The district court held that "if it appears that a document was conveyed from [in-house patent department personnel] to one of [plaintiff's] outside patent lawyers for the purpose of obtaining legal advice concerning the preparation of the priority or patent applications at issue, or was prepared by the outside patent lawyers in response to such a request, then I will deem it privileged."<sup>35</sup>

In *Softview Computer Products Corp. v. Haworth, Inc.*,<sup>36</sup> the court observed that [t]he *Spalding* court relied in part on *Knogo Corp. v. United States*. The line

of cases that follow *Knogo* stand for the proposition that the attorney-client privilege *may* attach to communications regarding patent prosecution, so long as those communications meet the other criteria of the privilege.<sup>37</sup> The district court in *Softview* applied the *Spalding* standard for privilege to all of the withheld documents at issue relating to the patentee's U.S. patent application.<sup>38</sup>

Likewise, in *McCook Metals L.L.C. v. Alcoa Inc.*,<sup>39</sup> the district court applied *Spalding* in concluding that a variety of prosecution-related documents, including draft patent applications, invention control reports, inventor questionnaires, and a duty of disclosure reminder form, were privileged.<sup>40</sup> With regard to draft patent applications in particular, the district court in *McCook* acknowledged that other (pre-*Spalding*) courts had refused to extend the privilege to such documents on the grounds that much of the information contained in the drafts eventually were placed in the public domain by means of a successful patent prosecution.<sup>41</sup> The court in *McCook* disagreed with the rationale of those contrary cases because they failed to recognize the legal importance that a first-rate patent attorney adds to the legal protection afforded the client by the proper legal draftsmanship of an airtight patent that is successfully and properly prosecuted.<sup>42</sup>

### C. The Limits of the *Spalding* Decision

As seen in the examples above, district courts have applied *Spalding* beyond invention records to a host of other communications and documents that typically are created in the course of patenting an invention, including documents that contain only technical information. Regardless of how the communication is labeled, however, to qualify as privileged, the communication ordinarily must still meet each of the other *United Shoe* requirements for the privilege to apply.<sup>43</sup>

Thus, even under the *Spalding* standard, for privilege to apply, the purpose of the communication must be primarily for obtaining legal advice or legal services.<sup>44</sup> The invention record at issue in *Spalding* was submitted by the inventors to *Spalding's* corporate legal department for the purpose of making a patentability determination.<sup>45</sup> If, on the other hand, an attorney is merely directing or transmitting documents or communications between the client and a governmental agency (such as the U.S. Patent and Trademark Office or a foreign patent office), without any request, or response to request, for legal advice or services, then a court could conclude that no privilege attaches to such communications.<sup>46</sup> There are no per se rules in determining whether a particular document constitutes a request for legal advice. In making such an assessment, courts usually look to the overall tenor of the document to determine if such a request was either expressed or implied.<sup>47</sup>

In addition, under the *Spalding* test for privilege, the attorney-client communication must still be confidential to qualify for any protection.<sup>48</sup> To the extent that a communication by an attorney is based on a nonconfidential source—for example, public information or information from a third party—it may not qualify as protected by the attorney-client privilege.<sup>49</sup>

The privilege also does not generally apply to documents relating primarily to business matters rather than those providing or responding to requests for legal advice.<sup>50</sup> Whether a communication or document is "primarily" relating to business or is "primarily" relating to legal matters is often not easy to decide. For example, a communication reporting an official action to a client is not, without more substance, privileged, since the communication is neither confidential information nor legal advice.<sup>51</sup> One district court, applying *Spalding*, concluded that a client's authorization to file a patent application, a memorandum of a conference with a patent examiner, a status report regarding a patent application, a memorandum regarding a patent search, and a notification that the client's patent was about to issue and instructions to mark its device with the patent number were not privileged because none of those documents contained confidential information or legal advice.<sup>52</sup>

Whether the results of a prior-art search are privileged in the aftermath of *Spalding* still is not entirely clear. Before the Federal Circuit's decision in *Spalding*, a number of district courts had held that prior-art searches and prior-art studies in general were not privileged because they did not contain or reflect information obtained in confidence from the client.<sup>53</sup> In *Spalding*, the accused infringer similarly argued that a portion of Spalding's invention record that included a list of prior art was not privileged because that portion of the record did not request legal advice.<sup>54</sup> The Federal Circuit rejected this argument, finding that it was unnecessary to dissect the document to separately evaluate each of its component.<sup>55</sup> According to the court in *Spalding*, it is enough that the overall tenor of the document indicates that it is a request for legal advice or services.<sup>56</sup> Based upon the broad standard set forth in the *Spalding* decision, a document containing a prior-art search would probably be considered privileged if the primary purpose of conducting the prior-art search were either to evaluate patentability or to aid counsel in the preparation of a patent application.<sup>57</sup>

Finally, the *Spalding* decision and its choice of Federal Circuit law has no application when the communications in question are not unique to patent law, or are not affected by substantive patent law. Thus, for example, when the communication or document in question relates to patent licenses or similar types of contractual issues, the law of the regional circuit, and not the Federal Circuit, should be applied in determining whether the communication is privileged.<sup>58</sup>

#### D. Patent Prosecution Documents as Work Product

In litigation, patentees sometimes try to withhold from discovery documents prepared in connection with patent prosecution activities on the basis of work-product immunity. Courts have not reached a consensus on whether documents prepared in the normal course of patent prosecution qualify for protection under the work-product immunity doctrine.



Some district courts have held that the work-product immunity doctrine does not extend to preparation for ex parte proceedings, such as patent proceedings.<sup>59</sup> Those courts that reject an immunity theory for prosecution documents reason that the mere fact that a document is prepared when litigation is foreseeable does not mean that the document was prepared in anticipation of litigation.<sup>60</sup> To qualify as work product, the document must be prepared *because of* the prospect of litigation when the preparer faces an actual claim or a potential claim following an actual event or series of events that reasonably could result in litigation.<sup>61</sup> Patent prosecution documents thus *ordinarily* cannot be protected as work product because they are not typically created in anticipation of litigation.<sup>62</sup>

For example, the district court in *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*<sup>63</sup> rejected the proposition that patent prosecution documents are work product. The court reasoned that documents relating to or in furtherance of the prosecution of a patent application are not work product because the primary motivating purpose behind the performance of the work is to obtain a patent.<sup>64</sup> The court further held that patent prosecution documents are not created in anticipation of or concerning litigation.<sup>65</sup> A patent prosecution is not adversarial, but rather proceeds ex parte.<sup>66</sup> Since the purpose of the work-product privilege is to protect the adversarial process,<sup>67</sup> normally there is no basis for extending this form of privilege to patent prosecutions.

On the other hand, there have been a number of district courts that have extended the work-product immunity privilege to documents prepared in connection with patent prosecution activities if it is shown that the work was also performed in anticipation of litigation.<sup>68</sup> In *In re Minebea Corp.*,<sup>69</sup> for example, a patentee sought work-product protection for prosecution-related documents that were created before the patent issued. The district court upheld the immunity claim and explained:

Generally, work performed by an attorney to prepare and prosecute a patent application does not fall within the parameters of the work-product protection . . . since the prosecution of a patent application is a non-adversarial, ex parte proceeding . . . This rule does not, however, preclude application of the work product protection to work performed to prosecute a patent application if it was also performed in anticipation of or concerning litigation.<sup>70</sup>

The court in *Minebea* concluded that information pertaining to the patent prosecution was subject to work-product immunity if it was prepared on or after the date that the patentee anticipated litigation, regardless of the fact that the patent did not issue for almost one year later.<sup>71</sup> According to some courts, the crucial date for applying work-product immunity is the date upon which the party asserting the work-product doctrine anticipated litigation regarding the patent, not when the patent was actually issued.<sup>72</sup>

#### IV. *Communications with Domestic and Foreign Patent Agents and Foreign Counsel as Privileged*

##### A. *Communications with U.S. Patent Agents*

The attorney-client privilege applies to communications between an *attorney* and his or her client. Of course, in the United States, patents may be obtained by someone other than an individual who is admitted to practice before the bar of a state or federal court. Indeed, in the United States, a nonattorney can be registered to practice before the U.S. Patent and Trademark Office. Once registered, the individual (a "registered patent agent") is authorized to practice law before the U.S. Patent and Trademark Office.<sup>73</sup> A U.S. registered agent is thus permitted by law to prepare, file, and prosecute patent application before the U.S. Patent and Trademark Office in the same manner as a U.S. attorney who is also similarly registered to practice before the Patent Office. The issue sometimes arises in patent cases whether communications between a client and a U.S. patent agent are privileged.

##### 1. *Courts Not Recognizing U.S. Patent Agent Privilege*

The greater weight of authority strictly, and literally, interprets the "attorney" prong of the attorney-client communication requirement. Although, in the author's opinion, such as strict constriction of the rule conflicts with the purpose of the privilege, some courts have found nevertheless that there is *no* U.S. "patent agent-client" privilege. The courts that have adopted this view reason that because a U.S. patent agent is not a member of the bar of any court, communications between a patent agent and a client are not privileged.<sup>74</sup>

Notwithstanding this general rule, the privilege may still apply to communications between a U.S. registered patent agent and his or her client provided that the patent agent is working under the supervision and control of an attorney—which is normally the case when the registered U.S. patent agent is employed in a corporate intellectual-property department or law firm.<sup>75</sup> In such cases, the attorney-client privilege technically does not apply to the registered U.S. patent agent in the agent's own right. Rather, the privilege still exists because of the attorney's role in supervising or controlling the agent's activities and communications.<sup>76</sup> In this respect, the attorney-client privilege applies (assuming all other elements of the test are met) to the client's communications with a U.S. registered patent agent the same way that it applies to communications between a client and a paralegal, secretary, or other nonattorney specialist working at the direction and control of an attorney.<sup>77</sup>

##### 2. *Courts Recognizing U.S. Patent Agent Privilege*

Some district courts do recognize a form of attorney-client privilege for patent agents in their own right (that is, not based on a theory of supervision and control).<sup>78</sup> Those courts that have found a privilege for U.S. patent agent-client communications normally rely upon the rationale set forth in the deci-

sion of the United States Supreme Court in *Sperry v. Florida*,<sup>79</sup> a disciplinary case over whether a registered patent agent violated Florida law by practicing patent law without a state law license. In concluding that the agent was permitted to practice patent law in Florida, the Supreme Court explained that "[t]he preparation and prosecution of patent applications for others constitutes the practice of law."<sup>80</sup> In *Sperry*, the Supreme Court characterized the attorney-like function of patent agents as follows:

Such conduct inevitably requires the practitioner to consider and advise his clients as to the patentability of their inventions under the statutory criteria as well as to consider the advisability of relying upon alternative forms of protection which may be available under state law. It also involves participation in his drafting of the specification and claims of the patent application which this Court long ago noted constitute[s] one of the most difficult legal instruments to draw with accuracy. And upon rejection of the application, the practitioner may also assist in the preparation of amendments which frequently requires written argument to establish the patentability of the claimed invention under the applicable rules of law and in light of the prior art.<sup>81</sup>

Some district courts have reasoned that the recognition of a "U.S. patent agent privilege" is simply a logical extension of the *Sperry* decision. For example, in *In re Ampicillin Antitrust Litigation*,<sup>82</sup> the district court held that a "patent agent-client" privilege exists, and explained as follows:

Where a client, in confidence, seeks legal advice from a registered patent agent who is authorized to represent that client in an adversary process that will substantially affect the legal rights of the client, which thereby necessitates a full and free disclosure from the client to the representative so that the legal representation may be effective, the privilege will be available.<sup>83</sup>

### 3. Limits on U.S. Patent Agent Privilege

In those courts that have recognized a "U.S. patent agent-client privilege," the privilege is strictly limited. A patent agent's registration before the U.S. Patent and Trademark Office "does not authorize the general practice of patent law, but sanctions only the performance of those services which are reasonably necessary and incident to the preparation and prosecution of patent applications."<sup>84</sup> Consequently, "[n]o case provides blanket attorney-client privilege between a USPTO recognized non-lawyer patent agent and his client over all intellectual property matters."<sup>85</sup> In fact, those courts that have recognized a U.S. patent agent privilege have limited the scope of that privilege to encompass only those services that such agents are legally licensed to perform: representation in preparing and prosecuting patent applications before the U.S.

Patent Office.<sup>86</sup> No special protections are afforded a U.S. patent agent who goes beyond that limited role. As one district court explained:

A patent agent's claim to attorney-client privilege has its foundations in the USPTO's limited authorization to non-lawyer patent agents to practice law. Essentially, the authorization provides the individual with the status of an attorney, but only for a limited purpose, i.e., the purpose for which the USPTO registered the non-attorney as an agent to practice before it. Thus, by definition, communications between a patent agent and a client beyond that limited purpose are not privileged.<sup>87</sup>

For patent agents who are not acting under the supervision and control of an attorney, this limitation on the scope of privilege makes perfect sense. This express limitation is nothing more than an extension of the general rule that the attorney-client privilege does not apply to communications with an attorney who is acting in a nonlegal capacity.<sup>88</sup> For example, communications between a client and a U.S. patent agent concerning the licensing or enforcement of an issued patent would not ordinarily be privileged if the patent agent is not also acting under the supervision or control of an attorney since the PTO bar membership would not extend to such post-issuance activities.

#### **B. Communications with Foreign Patent Agents and Foreign Attorneys**

In many foreign countries, it is common for an individual who meets a U.S. practitioner's definition of a "patent agent" (i.e., a nonattorney technical specialist who is not a general attorney at law but who is nonetheless licensed to prepare and prosecute patent applications before the Patent Office of a foreign country) to be referred to as a "patent attorney."<sup>89</sup> One issue that is frequently raised in patent litigation is whether communications with such *foreign* (that is, non-U.S.) "patent agents" or "patent attorneys" are privileged. Neither the Federal Circuit nor any other circuit court to date has issued a published decision that has discussed the scope or applicability of a foreign patent agent or foreign patent attorney privilege in U.S. litigation.

Determining whether the attorney-client privilege applies to communications including clients and foreign patent agents or foreign attorneys "has not always been simple or consistent."<sup>90</sup> Under Federal Rule of Evidence 501, courts generally look to federal law to determine whether an evidentiary privilege may be invoked.<sup>91</sup> While there are a few district courts that have refused to recognize an attorney-client privilege for foreign patent agents under any circumstances,<sup>92</sup> most federal courts that have published decisions on this issue have applied a two-part test to the analysis.

First, the district court determines whether it should apply U.S. law or foreign law to the communication. Second, if the district court determines that foreign law applies, the court then decides whether the particular foreign law in

question recognizes an evidentiary privilege for the patent professional (agent or attorney) in question. Generally speaking, if the district court concludes that an attorney-client privilege exists in that foreign country, and the communication meets the foreign country's test for privilege, then the district court should treat the communication as privileged from disclosure in a U.S. legal proceeding.<sup>93</sup>

#### 1. Whose Law to Apply

The "choice of law" rule that district courts have applied in their analysis of the foreign agent or foreign attorney privilege question has been determined to date by regional circuit law only and not by the Federal Circuit. As a result, there is to date no uniform set of choice of law rules that apply to patent cases considering the foreign privilege issue.

Some district courts follow the "touch-base" rule.<sup>94</sup> The touch-base approach has been described as follows:

[C]ommunications by a foreign client with foreign patent agents relating to assistance in prosecuting patent applications in the United States are governed by American privilege law whereas communications relating to assistance in prosecuting patent applications in their own foreign country or rendering legal advice. . . . on the patent law of their own country are, as a matter of comity, governed by the privilege law of the foreign country in which the patent application is filed, even if the client is a party to an American lawsuit.<sup>95</sup>

Those courts that apply the touch-base approach look to the foreign law of privilege only where those communications relate solely to activities outside of the United States.<sup>96</sup> Under this general approach, "[i]f a communication with a foreign patent agent involves a foreign patent application, then as a matter of comity, the law of that foreign country is considered regarding whether that law provides a privilege comparable to the attorney-client privilege."<sup>97</sup> Under a strict interpretation of the touching-base approach, however, even a minimal amount of contact with the United States would preclude the application of foreign law to the question of privilege.<sup>98</sup>

A number of district courts have criticized the touching-base approach as too rigid. Those courts have observed that under the touch-base standard, a document could touch base with the United States if it merely emanated here or if it simply mentioned a United States patent.<sup>99</sup>

Other district courts have applied a traditional "balancing test" to the choice of law question.<sup>100</sup> Under the traditional approach, the district court attempts to ascertain which country has the most dominant interest in the communication, considering such interests as the parties to and substance of the communication, the place where the relationship was centered at the time of the communication, the needs of the international system, and whether the application of foreign privilege law would be clearly inconsistent with important policies

embedded in federal law.<sup>101</sup> Some district courts view the traditional approach as being more consistent with the *Restatement (Second) of Conflicts*.<sup>102</sup> More recently, the "traditional" approach has been described as looking to the law of the country that has "'the most direct and compelling interest' in whether [the] communications should remain confidential."<sup>103</sup>

Finally, some district courts have endorsed a combination of the touching base and traditional tests. Under the "combination" approach, the district court applies a touching-base analysis to those communications that have no connection, or only an incidental connection, to the United States, and it applies the traditional approach to those communications that have more than an incidental connection to the United States.<sup>104</sup>

## 2. Determining Privilege Under Foreign Law

Assuming that the district court decides that the question of foreign agent or foreign attorney privilege should be decided as a matter of foreign law, the court next decides (1) whether the law of the applicable foreign country recognizes a privilege for communications with such foreign patent attorney or agents; and (2) if the foreign law does recognize such a privilege, whether all of the requirements for asserting the privilege under the law of that foreign country have been shown by the party seeking to assert the privilege.<sup>105</sup> In every case, "[t]he burden is on the party asserting the privilege to provide the court with the applicable foreign law, and [to] demonstrate that the privilege applies to the documents it seeks to exclude from discovery."<sup>106</sup>

Some district courts have gone so far as to hold that the party seeking to establish the privileged nature of foreign patent agent communications involving multiple countries must show that the privilege is recognized "for each and every country for which it claims the privilege."<sup>107</sup> Normally, to meet this burden, the party asserting the privilege will need to "provide affidavits from legal experts in the laws of these countries stating the applicable law of the attorney-client privilege, and demonstrating that the law supports the privilege asserted."<sup>108</sup> A number of courts that have addressed this issue have also explained that the privilege for foreign patent agents, like privilege in other contexts, is "strictly construed, and all doubts should be resolved in favor of disclosure."<sup>109</sup>

Even if the party seeking to withhold documents shows that patent agent communications are eligible for privilege protection under the law of the applicable nation, it must still show that each document it has withheld satisfies the requirements of that country's privilege law. Thus, for example, some countries do not provide any protection to documents intended to be filed with the foreign patent office, or information reporting on actions taken by the foreign patent office, since that information would not be considered confidential.<sup>110</sup>

While the issue may have been resolved under U.S. law as to whether the conduit theory applies, as a matter of foreign law, that issue still remains in some countries. Consequently, the same prosecution documents that may be privileged under U.S. law may not necessarily be privileged under foreign

law. If such documents are in the possession of a litigant's foreign agent, they may have to be produced during discovery in U.S. litigation.

Determining whether a particular country's law recognizes an evidentiary privilege for patent agent communications can be a difficult, time-consuming, and expensive task. Furthermore, as some of the following cases illustrate, the results can be uncertain: Indeed, district courts attempting to ascertain the law of the *same* foreign country have reached *different* conclusions as to whether or not a privilege is recognized for patent agents. In large part, the differences in the district court decisions seem to be based on the adequacy, or inadequacy, of the evidence of foreign law put on by the party seeking to prove the existence of the privilege.

#### A. JAPAN

A number of district courts have considered whether Japanese law recognizes an evidentiary privilege for communications with Japanese patent agents (*benrishi*) or Japanese attorneys (*bengoshi*) that is similar to the attorney-client privilege in the United States. Prior to 1998, most of the United States district courts that considered this issue and issued published decisions concluded that there was no privilege that covers communications with either a Japanese patent agent or patent attorney.<sup>111</sup>

In 1998, Japan amended its Code of Civil Procedure. In particular, the law expressly changed the privilege that was extended to Japanese *benrishi* and *bengoshi*.<sup>112</sup> The change to the Code retroactively applied to documents that were created before the 1998 amendment, as well as to subsequent documents.<sup>113</sup> District courts that have interpreted the *revised* law of Japan (i.e., post-1998) and that have issued published decisions have concluded that Japanese law *now* recognizes an evidentiary privilege for confidential communications between a client and a *benrishi* or *bengoshi*.<sup>114</sup>

For example, in *Eisai Ltd. v. Dr. Reddy's Laboratories, Inc.*,<sup>115</sup> the district court concluded that an attorney-client privilege exists under Japanese law because *benrishi* may refuse to testify about facts they should keep secret and the holder of documents can refuse to produce them.<sup>116</sup> Moreover, those district courts that have considered this issue under Japanese law have concluded that the changes made to the Code of Civil Procedure of Japan do not offend fundamental principles of American justice or public policy and that they should, therefore, be embraced as a matter of comity in a U.S. patent litigation.<sup>117</sup>

#### B. FRANCE

Whether France recognizes an attorney-client privilege for communications with French patent agents has been the subject of differing views.<sup>118</sup> In *Bristol-Meyers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*,<sup>119</sup> the Southern District of New York, after a thorough analysis of competing expert testimony on the issue, concluded that French law does not recognize an attorney-client privilege for patent agents.<sup>120</sup>

Other federal district courts, however, have found that French law recognizes an evidentiary privilege for confidential communications between a client and a French patent agent.<sup>121</sup> For example, in *Duplan Corp. v. Deering Milliken, Inc.*,<sup>122</sup> the district court held that, as a matter of French law, communications to or from French patent agents who are acting as patent counsel in France are protected from discovery in the United States by the attorney-client privilege. The district court in that case concluded that the attorney-client privilege protects communications with French patent agents who "are rendering legal advice to foreign corporate control group members, their representatives, or foreign attorneys on the patent law of their own country."<sup>123</sup>

#### C. GERMANY

Several district courts have issued published decisions concluding that an evidentiary privilege applies under German law comparable to that accorded to U.S. attorneys. Those district courts have thus found that confidential communications between German patent agents and their clients are privileged.<sup>124</sup> At least one district court reached the opposite conclusion. However, it appears that in that one case, the patentee had failed to present sufficient evidence of German law, and thus, that particular court held that there was no German patent agent privilege.<sup>125</sup> These cases emphasize the importance of providing adequate evidence—normally expert testimony or affidavits—on the substance of foreign law in order to establish whether that foreign law recognizes an evidentiary privilege for patent agent communications.<sup>126</sup>

#### D. UNITED KINGDOM

Whether communications between British patent agents and their clients are privileged under the law of the United Kingdom has been the subject of a number of published decisions.<sup>127</sup> Those decisions uniformly have held that there is such a privilege recognized under U.K. law.

For example, in *In re Rivastigmine Patent Litigation*,<sup>128</sup> the patentee withheld communications between it and its U.K. law firm regarding the prosecution of a foreign counterpart patent. According to the district court, the patentee provided evidence sufficient to demonstrate that U.K. law recognizes a privilege for communications regarding patent matters between a client and a patent agent (also referred to as a patent attorney) registered in the United Kingdom, a patent agent registered with the European Patent Office, or a partnership of patent agents and attorneys.<sup>129</sup> At least one district court has limited such a privilege "only to patent agent communications concerning formal patent proceedings before the appropriate British tribunals."<sup>130</sup>

#### C. General Remarks on the "Foreign Agent Privilege" Determination

The often "mechanical" analysis by district courts of foreign patent agent/foreign attorney privilege to U.S. patent cases often appears to ignore the



underlying purpose of the privilege in the first instance. The attorney-client privilege was created primarily to encourage clients to come to their attorneys for frank communications with them about their legal concerns. This holds true regardless of whether the communication occurs on U.S. or foreign soil—clients should feel free to consult with their counsel about their legal problems so that they may then be better equipped to conform their conduct to the requirements of the law. From a practical standpoint, it makes little sense for a court to conclude that a communication between a foreign company and its foreign legal counsel should *not* be privileged when the same discussion would be treated as privileged in the U.S.

### V. Waiver of Privilege or Immunity

In patent cases, a voluntary waiver of one or more privileged documents reflecting communications between an attorney and the client in discussing certain subject matter generally waives the privilege as to all contemporaneous communications between that attorney and that client on that subject matter.<sup>131</sup> When a client voluntarily waives the privilege as to some documents that the client considers not damaging and asserts the privilege as to other documents that the client considers damaging, the client may be compelled to produce all documents relating to the matter. The rationale for this rule is that a client cannot be allowed, after disclosing as much as he or she pleases, to withhold the remainder. The client may elect to withhold or to disclose, but after a certain point the election remains final. Voluntary disclosure of privileged communications or work product to an adversary generally waives the privilege as to other communications on the same subject.<sup>132</sup>

#### A. Waiver by Disclosure

The attorney-client privilege may be lost in a patent case, as in other types of cases, through an inadvertent waiver. These situations typically arise if the party seeking to maintain the privilege (usually but not always a corporate entity) is not careful in maintaining the confidentiality of its privileged documents. In litigation, a party may also waive the privilege inadvertently such as by error resulting from a careless document production procedure.<sup>133</sup>

According to the Advisory Committee Notes to the 2006 revisions to Rule 26(b)(5):

The Committee has repeatedly been advised that the risk of privilege waiver, and the work necessary to avoid it, add to the costs and delay of discovery. When the review is of electronically stored information, the risk of waiver, and the time and effort required to avoid it, can increase substantially because of the volume of electronically stored information and the difficulty in ensuring that all information to be produced has in fact been reviewed.<sup>134</sup>

The district courts have not uniformly or consistently treated whether an “inadvertent” production waives the attorney-client privilege. Some district courts have held that an inadvertent production is never a waiver; to be sure, some district courts have held that it is always a waiver; still other district courts have held that it is only a waiver if, in the totality of circumstances, adequate measures were not taken to avoid the disclosure.<sup>135</sup> In fact, some district courts subscribe to all three views.<sup>136</sup>

In a patent litigation that can typically involve the production of tens if not hundreds of thousands of pages of paper and electronic documents, there is a reasonably good chance that at least *one* privileged document will be inadvertently produced. A litigant can be wise to deal with the possibility of such an inadvertent production with its discovery at the commencement of the case. For example, most patent cases include protective orders to protect confidentiality. One tool that patent litigants may use to mitigate the potential harm caused by a possible inadvertent production of a privileged document is to include a provision on inadvertent disclosure in the protective order. In fact, the protective order solution is specifically addressed in the Advisory Committee Notes to Rule 26(b)(5)(B). When parties have stipulated to such a provision and the district court has entered the parties’ agreement as an order of the court, the terms of the protective order should control whether an inadvertent production waives privilege.<sup>137</sup>

Regardless of whether a protective order controls the issue, the burden rests on the producing party to establish that its disclosure was truly inadvertent.<sup>138</sup> Some district courts have required parties seeking the return of a privileged document allegedly produced inadvertently to act “timely.”<sup>139</sup> Moreover, if the producing party is found to have engaged in purposeful or grossly negligent acts in allowing the production of privileged documents, the district court might very well conclude that their production was not “inadvertent.”<sup>140</sup> Indeed, some district courts have also refused to order the return of a privileged document if it was produced because of a mistake of counsel or counsel’s exercise of poor judgment, conducting that such conduct was “advertent” and not “inadvertent.”<sup>141</sup>

### **B. Waiver by Reliance on Opinion of Counsel**

According to a recent survey, more than 90 percent of patent cases include an allegation that the infringement was willful.<sup>142</sup> Where an accused infringer is alleged to have acted willfully, the advice of the accused infringer’s lawyer may be relevant to whether the accused party acted with the requisite willful state of mind. At trial, an accused infringer may, but is not required to, rely upon an exculpatory opinion of its legal counsel as part of its defense to willfulness.

Once an accused infringer has elected to rely on an opinion of counsel defense to willful infringement, it waives the attorney-client privilege to some extent.<sup>143</sup> The issues of how extensive the waiver is (both in terms of the subject

matter of the waiver and its temporal scope), and whether that waiver extends to work product (including trial counsel work product), have been the source of much litigation. Two relatively recent decisions by the Federal Circuit have addressed, at least in part, some of these waiver issues.

### 1. *The EchoStar Decision*

In *In re EchoStar Commc'n Corp.*,<sup>144</sup> an accused infringer relied on an exculpatory opinion from in-house counsel as a defense to willful infringement.<sup>145</sup> After commencement of the litigation, the accused infringer obtained, but chose not to rely upon, an opinion from outside legal counsel.<sup>146</sup> The district court held that the accused infringer waived the attorney-client privilege and work-product immunity by relying on the advice of its in-house counsel, and that the waiver extended to both in-house and outside opinion counsel. The district court ordered the accused infringer to produce all presuit and postsuit communications relating to the opinions it received. In addition, the district court ordered production from the outside opinion counsel of any attorney work product regarding the opinions—even if such work product was not communicated to the accused infringer.

The Federal Circuit affirmed in part the district court's order. The appeals court held that by relying on advice of its in-house counsel, the accused infringer (EchoStar) waived the attorney-client privilege with respect to any communications involving the same subject as the opinion. The waiver included communications with in-house counsel as well as the outside law firm. However, the Federal Circuit reversed that part of the district court's decision that had ordered production of attorney work product that was *not* communicated from the outside opinion counsel to its client.<sup>147</sup>

In sum, the Federal Circuit in *EchoStar* identified three different categories of work product that it found to be potentially relevant in addressing the opinion of counsel defense:

- Documents embodying communications between the client and attorney pertaining to the subject matter of the case, such as an opinion letter;
- Documents analyzing issues but not communicated to the client reflecting an attorney's mental impression with respect to the subject matter of the case; and
- Documents not communicated between the client and attorney but that discuss communications relating to the subject matter between the client and attorney.<sup>148</sup>

The court further concluded that the second category, uncommunicated work product, was not subject to the waiver, as it has little or bearing on the state of mind of the accused infringer.<sup>149</sup> The court affirmed the district court regarding the scope of the waiver of privilege with respect to the first and third categories of work product.

The *EchoStar* decision did not expressly address whether the waiver extended to work product of *trial* counsel. Nevertheless, in a footnote, the court stated that the waiver extended to advice and work product communicated *after* the litigation commenced.<sup>150</sup> This statement by the Federal Circuit led to much litigation over whether the scope of the waiver should be extended to the accused infringer's trial counsel.

One district court, for example, applying *EchoStar*, concluded that the waiver extends to trial counsel in respect to privileged and work-product documents that contain advice central and highly material to the advice given by opinion counsel.<sup>151</sup> Other district courts have extended the waiver to trial counsel's communications that question or contradict the opinion provided by the counsel that authored the opinion.<sup>152</sup> Still other district courts have construed the waiver even more broadly, holding that any communications with trial counsel concerning the subject matter of infringement should be produced.<sup>153</sup>

## 2. The Seagate Decision

In August 2007, the Federal Circuit issued a highly anticipated decision in *In re Seagate*,<sup>154</sup> an en banc decision that reviewed a district court order compelling an accused infringer to produce all communications between it and any counsel, including its trial counsel, on the issues of infringement, invalidity, and enforceability of the patents-in-suit. In a landmark decision, the Federal Circuit revisited its precedent on willfulness and clarified whether a waiver resulting from reliance on advice of counsel extended to trial counsel. The court's decision was significant in several respects.

*First*, the Federal Circuit in *Seagate* held that proof of willful infringement requires "at least a showing of objective recklessness," which means "an objectively high likelihood that [the infringer's] actions constituted infringement of a valid patent."<sup>155</sup> The court in *Seagate* thus overruled the "affirmative duty of care" standard of proof for willfulness that had governed patent cases since that standard was first announced, in 1983, in *Underwater Devices, Inc. v. Morrison-Knudsen Co.*<sup>156</sup> The court in *Seagate* explained that "[b]ecause we abandon the affirmative duty of due care [standard], we also reemphasize that there is no affirmative obligation to obtain [an] opinion of counsel."<sup>157</sup>

*Second*, the Federal Circuit in *Seagate* held that, as a general rule, where the opinion authoring attorney and trial attorney are different, the waiver of privilege caused by reliance on an opinion of counsel defense to willfulness does *not* constitute a waiver of the attorney-client privilege for the client's communications with its trial counsel.<sup>158</sup> The court explained that this rule was not absolute, and that it was possible for district courts in "unique" circumstances (such as when a party or its counsel engages in what the court referred to as "chicanery") to extend the waiver of attorney-client privilege to its trial counsel.<sup>159</sup>

*Third*, the Federal Circuit in *Seagate* held that, absent exceptional circumstances, the waiver resulting from an accused infringer's reliance on an opinion of counsel defense to willfulness does not extend to trial counsel's work product.

The court explained that "trial counsel's mental processes . . . enjoy the utmost protection from disclosure."<sup>160</sup> As it did with the issue of privilege, the court in *Seagate* left open the possibility that a situation might arise in which the waiver of work-product immunity could be extended to trial counsel. However, as a general rule, there is no waiver of trial counsel work product absent an unusual circumstance, such as when a party or its counsel engages in "chicanery."

Apart from any issue of waiver of work product, the court in *Seagate* reiterated the general standard for discovery of attorney work product. Under this general rule, which is not unique to patent cases, "nonopinion" work product is not discoverable unless the party seeking the discovery makes a showing of substantial need for the materials and undue hardship without it. Furthermore, discovery of "opinion work product" (*i.e.*, the mental impressions, thought, processes, analyses, and conclusions of counsel) are generally *not* discoverable absent "extraordinary circumstances."<sup>161</sup> Thus, the general standards for discovery of attorney work product in patent cases have not been altered by the *Seagate* decision.

It remains to be seen what impact the Federal Circuit's decision in *Seagate* will have in future patent cases. For example, what type of conduct constitutes "chicanery"? What other circumstances, in addition to "chicanery," will justify a waiver of trial counsel's privilege or work product? These issues presumably will need to be addressed in future cases.

### VI. Piercing the Patentee's Privilege Based on Fraud

Issues of intent in patent cases are not limited to the accused infringer's state of mind. In many patent cases, the accused infringer alleges that the patent-in-suit is unenforceable because the patentee committed inequitable conduct before the U.S. Patent and Trademark Office. Inequitable conduct involves the alleged violation of the U.S. Patent and Trademark Office "Rules 56" duty of disclosure, coupled with deceptive intent. An assertion of inequitable conduct places into issue the state of mind of the inventor, prosecuting attorney, and/or in-house personnel who were substantially involved in the prosecution of the suit patent. When inequitable conduct is an issue, the alleged infringer may also attempt to pierce the patentee's attorney-client privilege under what is commonly referred to as the crime-fraud exception. This exception addresses communications made by the client to his attorney in furtherance of an ongoing or future crime or fraud.<sup>162</sup>

Although they are closely related and often rely upon the same evidence, common law fraud and inequitable conduct are legally distinct concepts.<sup>163</sup> The Federal Circuit has explained that inequitable conduct is a broader, more inclusive concept than is common law fraud.<sup>164</sup> To invoke the crime-fraud exception, a showing of inequitable conduct is insufficient. The party challenging the privilege must make a *prima facie* showing that the communication was made in furtherance of a crime or [common law] fraud.<sup>165</sup>

To establish a fraud, the party challenging the privilege must show (1) a misrepresentation of a material fact, (2) with intent to deceive, (3) reliance upon the misrepresentation by the party deceived, and (4) resultant injury.<sup>166</sup> Common law fraud includes both affirmative misrepresentations of a material fact, as well as a failure to disclose a material fact.<sup>167</sup>

In establishing the fraud necessary for an accused infringer to attempt to pierce the patentee's privilege in a patent infringement case, the most difficult areas usually involve making the requisite *prima facie* showings of deceptive intent and detrimental reliance. Rarely is there a smoking gun that unequivocally establishes an intent to deceive the U.S. Patent and Trademark Office.<sup>168</sup> Thus, proof of deceptive intent normally must be inferred from the facts and circumstances surrounding the applicant's conduct.<sup>169</sup> While there must be a factual basis for a finding of deceptive intent,<sup>170</sup> the withholding of a material prior-art reference can, in some cases, warrant the inference of an intent to deceive the Patent Office.<sup>171</sup> Evidence of a state of mind reckless as to the consequences of a non-disclosure or misrepresentation to the Patent Office also can be considered the equivalent of an intent to deceive.<sup>172</sup>

Courts are split on the question of whether, in addition to meeting the common law standard for fraudulent intent, the party seeking to invoke the crime-fraud exception must also establish that the U.S. Patent and Trademark Office relied on the misrepresentation. Some district courts have held that reliance need not be proven.<sup>173</sup> Other district courts have reached the contrary conclusion.<sup>174</sup> In *Nobelpharma*, for example, the district court held that the fact misrepresented must be 'the efficient, inducing, and proximate cause, or the determining ground' of the action taken in reliance thereon.<sup>175</sup> Although it is *dicta* in that case, the Federal Circuit's decision in *Spalding* also contains language suggesting that proof of reliance is necessary to pierce privilege.<sup>176</sup>

In deciding whether the requirements of the crime-fraud exception have been satisfied in a particular case, the district court may review the disputed documents *in camera*.<sup>177</sup> Some courts hold that an *in camera* review is required before the court can order the production of documents that would otherwise be privileged.<sup>178</sup> The evidentiary showing that is necessary in order to justify *in camera* review is less than the showing necessary to actually overcome the privilege.<sup>179</sup> All that is required to justify *in camera* review is a factual basis adequate to support a good faith belief by a reasonable person that [the court's] review of the materials may reveal evidence to establish the claim that the crime-fraud exception applies.<sup>180</sup>

## VII. Summary

There have been many published decisions on the subject of privilege and immunity in patent cases. Unfortunately, very few of those decisions are from the Federal Circuit, which has exclusive appellate jurisdiction in patent cases. Consequently, it can be difficult in any particular patent case to draw

a bright-line rule or to know with reasonable certainty how a district court likely will rule on a particular privilege or work-product issue. Because of this uncertainty, parties who anticipate litigating patent rights would be wise *not* to assume that documents they thought might be privileged will, in fact, be treated that way by the district court judge. As a general rule, parties should be careful not to make potentially embarrassing written admissions or concessions on critical issues, such as patent scope validity or infringement, as such admissions may be discoverable. Finally, parties should also be cautious in the way that they handle and disseminate legal advice, and they would be wise to institute practices to strictly limit the disclosure of such advice and to take measures that protect its confidentiality.

### Notes

1. FED. R. Civ. P. 26(b)(1).
2. *Hickman v. Taylor*, 329 U.S. 495, 506 (1947).
3. *In re Horowitz*, 482 F.2d 72, 81 (2d Cir. 1973).
4. *United States v. United Shoe Mach. Corp.*, 89 F. Supp. 357, 358–59 (D. Mass. 1950). Although in some instances in patent cases the scope of the attorney-client privilege is governed by the Federal Circuit's standards and not by the law of the regional circuit, *see In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 804 (Fed. Cir. 2000), there does not appear to be any material difference between the *United Shoe* definition of the test for privilege and the definition applied by the Federal Circuit. *See, e.g., Shearing v. Iolab Corp.*, 975 F.2d 1541, 1546 (Fed. Cir. 1992).
5. *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 805 (Fed. Cir. 2000).
6. *Detection Sys., Inc. v. Pittway Corp.*, 96 F.R.D. 152, 156 (W.D.N.Y. 1982) (citations omitted).
7. *Id.* at 154.
8. *See, e.g., Am. Standard, Inc. v. Pfizer, Inc.*, 828 F.2d 734, 745 (Fed. Cir. 1987); *United States v. (Under Seal)*, 748 F.2d 871, 874 (4th Cir. 1984); *In re Grand Jury Subpoena Duces Tecum Dated Sept. 15, 1983*, 731 F.2d 1032, 1037 (2d Cir. 1984).
9. *See, e.g., Hickman*, 329 U.S. at 508 (attorney-client privilege does not cover information attorney learns from witnesses); *Boling v. First Util. Dist. of Knox County*, No. 3:97-CV-832, 1998 U.S. Dist. LEXIS 21157, at \*11 (E.D. Tenn. Oct. 5, 1998) (correspondence from counsel to plaintiff that is based on information learned from any person outside the plaintiff's organization is not privileged).
10. *In re Grand Jury Subpoena*, 599 F.2d 504, 511 (2d Cir. 1979) ("Participation of the general counsel does not automatically cloak the investigation with legal garb."); *Abb Kent-Taylor, Inc. v. Stallings & Co., Inc.*, 172 F.R.D. 53, 57 (W.D.N.Y. 1996) ("The mere fact a communication is made directly to an attorney, or an attorney is copied in on a memorandum does not mean that the communication is necessarily privileged.") (citation omitted); *accord McCook Metals L.L.C. v. Alcoa Inc.*, 192 F.R.D. 242, 260 (N.D. Ill. 2000); *U.S. Postal Serv. v. Phelps Dodge Ref. Corp.*, 852 F. Supp. 156, 160 (E.D.N.Y. 1994).

11. *Hickman*, 329 U.S. 495.
12. FED. R. CIV. P. 26(b)(3). While the Federal Rules of Civil Procedure permits discovery “regarding any matter, not privileged, which is relevant to the subject matter involved in the pending action,” Rule 26(b)(3) affords qualified protection to documents and tangible things . . . prepared in anticipation of litigation or for trial by a party or a party’s representative.
13. *In re Pfohl Bros. Landfill Lit.*, 175 F.R.D. 13, 26 (W.D.N.Y. 1997) (quoting *Hickman*, 329 U.S. at 510–11).
14. *Pfohl*, 175 F.R.D. at 26.
15. *See, e.g.*, *Martin v. Bally’s Park Place Hotel & Casino*, 983 F.2d 1252, 1260 (3d Cir. 1993).
16. *See, e.g.*, *Weil Ceramics & Glass, Inc. v. Work*, 110 F.R.D. 500, 505 (E.D.N.Y. 1986).
17. *United States v. Int’l Bus. Machs. Corp.*, 71 F.R.D. 376, 378 (S.D.N.Y. 1976).
18. *Detection Sys., Inc. v. Pittway Corp.*, 96 F.R.D. 152, 155 (W.D.N.Y. 1982).
19. *Id.*
20. *In re Grand Jury Proceedings*, 604 F.2d 798, 802–03 (3d Cir. 1979); *In re Pfizer Inc. Secs. Litig.*, 90 Civ. 1260, 1994 U.S. Dist. LEXIS 7454, at \*5 (S.D.N.Y. June 6, 1994).
21. 203 F.3d 800 (Fed. Cir. 2000).
22. *Id.* at 803 n.2.
23. *Id.* at 804.
24. *Id.*
25. *Id.*
26. *Id.* at 806. *See also* *Carl Zeiss Jena GMBH v. Bio-Rad Labs., Inc.*, 98 Civ. 8012, 2000 U.S. Dist. LEXIS 5825, at \*3 (S.D.N.Y. May 3, 2000) (finding *Spalding* “directly on point” and concluding that plaintiff’s invention disclosure documents were protected by the attorney-client privilege).
27. *Jack Winter, Inc. v. Koratron Co.*, 50 F.R.D. 225, 228 (N.D. Cal. 1970).
28. *Spalding*, 203 F.3d at 806 n.3 (citing *Jack Winter*, 50 F.R.D. at 228, among other cases).
29. *Id.*
30. *Id.*
31. 227 F.R.D. 382 (W.D. Pa. 2005).
32. *Id.* at 394.
33. *Id.* The district court subsequently determined that the client had waived the privilege.
34. 05-C-0575-C, 2006 U.S. Dist. LEXIS 57560 (W.D. Wis. Aug. 14, 2006).
35. *Id.* at \*10.
36. 97 Civ. 8816, 2000 U.S. Dist. LEXIS 4254, at \*8 (S.D.N.Y. Mar. 31, 2000).
37. *Id.* at \*30–31.
38. *Id.* Unfortunately, the district court’s opinion does not describe the precise nature of the prosecution documents it considered.
39. 192 F.R.D. 242, 251 (N.D. Ill. 2000).
40. *Id.* at 252–53.
41. *Id.* at 253 (citing *Applied Telematics, Inc. v. Sprint Comm’ns Co.*, No. 94-4603, 1996 U.S. Dist., LEXIS 13782 (E.D. Pa. 1996)); *Sneider v. Kimberly-Clark Corp.*, 91 F.R.D. 1, 5 (N.D. Ill. 1980).



42. 192 F.R.D. at 253.
43. *McCook Metals*, 192 F.R.D. at 255 (rejecting privilege assertion for technical drawings, sketches, tables, and test results produced from the inventors and sent to in-house patent counsel, on the basis that the documents themselves contain no request for legal advice, nor is any given, and thus fall outside the ambit of the privilege.).
44. *See Spalding*, 203 F.3d at 805.
45. *Id.*
46. *See, e.g.*, *Softview Computer Products Corp. v. Haworth, Inc.*, 97 Civ. 8815, 2000 U.S. Dist. LEXIS 4254, at \*29 (S.D.N.Y. Mar. 31, 2000) (transmittal letters, cover sheets, and other documents relating to patent prosecution not privileged); *McCook Metals*, 192 F.R.D. at 253–54 (transmittal letters and cover sheets, and communications from third party, are not privileged).
47. *Spalding*, 203 F.3d at 806.
48. *Id.* at 805 (citing *Sharing v. Iolab Corp.*, 975 F.2d 1541, 1546 (Fed. Cir. 1992) (The privilege protects a client's confidential communications to an attorney necessary to obtain legal counseling.)).
49. *See, e.g.*, *Hickman v. Taylor*, 329 U.S. 495, 508 (1947) (attorney-client privilege does not cover information attorney learns from witnesses); *McCook Metals*, 192 F.R.D. at 253–54 (attorney-client privilege does not apply to a summary of patent applications, patents, and invention reports).
50. *See, e.g.*, *Itoba Ltd. v. LEP Group PLC*, 930 F. Supp. 36, 43 (D. Conn. 1996); *In re Brand Name Prescription Drugs Antitrust Litig.*, 94 C 897, 1995 U.S. Dist. LEXIS 16523, at \*13–16 (N.D. Ill. 1995); *AMP, Inc. v. Fujitsu Microelectronics, Inc.*, 853 F. Supp. 808, 830 (M.D. Pa. 1994), *appeal dismissed*, 47 F.3d 1180 (Fed. Cir. 1995); *Baxter Travenol Labs. v. Abbott Labs.*, No. 84-C-5103, 1987 U.S. Dist. LEXIS 10300, at \*12 (N.D. Ill. June 17, 1987); *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1167 (D.S.C. 1974).
51. *United States v. (Under Seal)*, 748 F.2d 871, 875 (4th Cir. 1984), *vacated on other grounds*, 757 F.2d 600 (1985) (since patent examiner is a third party to whom the eventual communication will be disclosed, the communication is not intended to be privileged and therefore is not privileged); *P. & B. Marina, L.P. v. Logrande*, 136 F.R.D. 50, 56 (E.D.N.Y. 1991), *aff'd*, 983 F.2d 1047 (2d Cir. 1992) (Drafts of letters or documents to third parties lack the requisite confidentiality to be protected under the attorney-client privilege.).
52. *Softview*, 2000 U.S. Dist. LEXIS, at \*33.
53. *E.g.*, *Glaxo, Inc. v. Novopharm Ltd.*, 148 F.R.D. 535, 540 (E.D.N.C. 1993); *Baxter Travenol Labs.*, 987 U.S. Dist. LEXIS 10300, at \*34–35.
54. 203 F.3d at 806.
55. *Id.*
56. *Id.*
57. *See id.* at 806 (an attorney cannot evaluate patentability or prepare a competent patent application without knowing the prior art and obtaining relevant technical information from the inventors); *see also Martin Marietta Materials, Inc. v. Bedford Reinforced Plastics, Inc.*, 227 F.R.D. 382, 394 (W.D. Pa. 2005) (prior-art search was privileged).
58. *Spalding*, 203 F.3d at 804 (citing *In re Regents of the Univ. of Cal.*, 101 F.3d 1386 (Fed. Cir. 1996)). *See also McCook Metals L.L.C. v. Alcoa Inc.*, 192 F.R.D. 242, 251

- (N.D. Ill. 2000) (applying Seventh Circuit law to whether licensing and contractual documents are privileged).
59. *Bulk Lift Intern Inc. v. Flexcon & Sys., Inc.*, 122 F.R.D. 482, 491 (W.D. La.), *aff'd*, 122 F.R.D. 493 (1988) (quoting *Choat v. Rome Indus., Inc.*, 462 F. Supp. 728, 732 (N.D. Ga. 1978)); *but see* *Hewlett Packard Co. v. Bausch & Lomb, Inc.*, 116 F.R.D. 533 (N.D. Ca 1987).
  60. *Softview Computer Prods. Corp. v. Haworth, Inc.*, 2000 U.S. Dist. LEXIS 4254, at \*15–16 (S.D.N.Y. Mar. 31, 2000); *Stryker Corp. v. Intermedics Orthopedics, Inc.*, 145 F.R.D. 298, 302 (E.D.N.Y. 1992) (“This court rejects the theory that litigation is a possibility in every patent application.”).
  61. *Nat’l Union Fire Ins. Co. v. Murray Sheet Metal Co.*, 967 F.2d 980, 984 (9th Cir. 1992).
  62. *Bristol-Myers Squibb Co. v. Rhone-Poulenc Rorer, Inc.*, 95 Civ. 8833, 1998 U.S. Dist. LEXIS 12, at \* 13–14 (S.D.N.Y. Jan. 6, 1998) (holding that patent prosecution is not work product); *Stryker Corp. v. Intermedics Orthopedics, Inc.*, 145 F.R.D. 298, 302, 304 (E.D.N.Y. 1992) (same).
  63. *Bristol-Myers*, 1998 U.S. Dist. LEXIS at \*17.
  64. *Id.*, at \*13–14.
  65. *Id.*; *see also* *Burlington Indus., Inc. v. Rossville Yarn, Inc.*, 95-CV-0401, 1997 U.S. Dist. LEXIS 10347, at \*6 (N.D. Ga. June 2, 1997); *Stryker Corp. v. Intermedics Orthopedics, Inc.*, 145 F.R.D. 298, 302, 304 (E.D.N.Y. 1992).
  66. *Bristol-Myers*, 1998 U.S. Dist. LEXIS, at \*14.
  67. *Hickman v. Taylor*, 329 U.S. 495 (1947).
  68. *See, e.g., Elkay Mfg. Co. v. Ebco Mfg. Co.*, 93 C 5106, 1995 U.S. Dist. LEXIS 473, at \*35 (N.D. Ill. Jan 13, 1995) (given that there is precedent for extending work-product immunity to draft patent applications prepared in anticipation of litigation, it is not unreasonable to extend the benefit of the immunity to the applications themselves.)
  69. 143 F.R.D. 494, 500 (S.D.N.Y. 1992).
  70. *Id.* at 499.
  71. *Id.* at 501.
  72. *Softview*, 2000 U.S. Dist. LEXIS 4254, at \*40 (holding that certain prosecution documents were properly withheld as work product where the patentee alleged that competitors introduced competing model one week after it filed the patent application, and the patentee showed that it believed those models would infringe its patent once issued. The court held that “the challenged documents . . . reflect that counsel’s claim drafting and prosecution of the patent application were informed by Haworth’s anticipation of litigation against its competitors once the 798 patent issued”).
  73. “U.S. patent agent” refers to an individual who is licensed to practice before the U.S. Patent and Trademark Office. 35 U.S.C. § 31; 37 C.F.R. § 10.6(b).
  74. *See, e.g., In re Rivastigmine Patent Litig.*, 237 F.R.D. 69, 111–12 (S.D.N.Y. 2006) (declining to extend the attorney-client privilege to communications between clients and U.S. patent agents); *Santrade, Ltd. v. Gen. Elec. Co.*, 150 F.R.D. 539, 546 (E.D.N.C. 1993) (Generally, communications with patent agents, American or foreign, are not subject to privilege in the United States); *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 143 F.R.D. 611, 616–17 (E.D.N.C. 1992) (same); *Detection Sys., Inc. v. Pittway Corp.*, 96 F.R.D. 152, 155 (W.D.N.Y. 1982) (same); *Sneider*

- v. Kimberly-Clark Corp., 91 F.R.D. 1, 5 (N.D. Ill. 1980) (Notwithstanding the quasi-legal service patent agents render, courts have declined to extend the privilege to the patent agent.); Mead Digital Sys., Inc. v. A.B. Dick Co., 89 F.R.D. 318, 320 (S.D. Ohio 1980) (There can be no doubt that if Rouse were a domestic patent advisor and had communications to a domestic client through the documents at issue, then no attorney-client privilege could be asserted by the client because Rouse is not a member of the bar of any court.); Duplan Corp. v. Deering Milliken, Inc., 397 F. Supp. 1146, 1169 (D.S.C. 1974) (The federal courts have refused to extend the attorney-client privilege to encompass *American* patent agents).
75. *E.g.*, Saxholm AS v. Dynal, Inc., 164 F.R.D. 331, 337 (E.D.N.Y.).
  76. The weight of authority holds that the attorney-client privilege applies to confidential communications with patent agents acting under the authority and control of counsel. Cuno, Inc. v. Pall Corp., 121 F.R.D. 198, 204 (E.D.N.Y. 1988); *accord* Stryker Corp. v. Intermedics Orthopedics, Inc., 145 F.R.D. 298, 304 (E.D.N.Y. 1992).
  77. *See, e.g.*, United States v. Alvarez, 519 F.2d 1036, 1045–46 (3d Cir. 1975) (privilege applies to communications with psychiatrist assisting attorney); United States v. Cote, 456 F.2d 142, 144 (8th Cir. 1972) (privilege applies to communications with accountant assisting attorney).
  78. *See, e.g.*, Foseco Int'l Ltd. v. Fireline, Inc., 546 F. Supp. 22, 25 (N.D. Ohio 1982) (Communications between a patent agent and a client may be privileged, however, where the patent proceeding is before the United States Patent Office and the patent agent is registered with that office.); *In re Ampicillin Antitrust Litig.*, 81 F.R.D. 377, 393 (D.D.C. 1978); Hercules, Inc. v. Exxon Corp., 434 F. Supp. 136, 146 (D. Del. 1977); Vernitron Med. Products, Inc. v. Baxter Labs., Inc., 186 U.S.P.Q. 324 (D.N.J. 1975).
  79. 373 U.S. 379, 383 (1963).
  80. *Id.*
  81. *Id.*
  82. 81 F.R.D. 377, 393 (D.D.C. 1978).
  83. *Id.* at 394.
  84. Sperry v. Florida, 373 U.S. 379, 386 (1963).
  85. John Labatt Ltd. v. Molson Breweries, 898 F. Supp. 471, 475 (E.D. Mich. 1995).
  86. *Id.* (internal citations omitted).
  87. *See id.*
  88. *See, e.g.*, *In re Lindsey*, 158 F.3d 1263, 1270 (D.C. Cir. 1998).
  89. *See, e.g.*, Willemijn Houdstermaatschaap BV v. Apollo Computer Inc., 707 F. Supp. 1429, 1444 n. 21 (D. Del. 1989) (“Virtually all patent attorneys in Europe have only a technical or scientific background and, with rare exceptions, have no legal training and are not members of the bar.”).
  90. Golden Trade, S.r.L v. Lee Apparel Co., 143 F.R.D. 514, 518 (S.D.N.Y. 1992).
  91. *Id.* at 517 (citing United States v. Goldberger & Dubin, P.C., 935 F.2d 501, 505 (2d Cir. 1991)).
  92. *See, e.g.*, Duttile v. Bandler & Kass, 127 F.R.D. 46, 52 (S.D.N.Y. 1989); Burlington Indus. v. Exxon Corp., 65 F.R.D. 26, 40 (D. Md. 1974); *accord* Status Time Corp. v. Sharp Elects. Corp., 95 F.R.D. 27, 32–33 (S.D.N.Y. 1982).
  93. *See, e.g.*, McCook Metals L.L.C. v. Alcoa Inc., 192 F.R.D. 242, 256 (N.D. Ill. 2000).

94. *See, e.g.*, *Odone v. Croda Intern. PLC*, 950 F. Supp. 10, 12–13 (D.D.C. 1997); *In re Ampicillin Antitrust Litig.*, 81 F.R.D. 377, 391 (D.D.C. 1978); *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1169 (D.S.C. 1975).
95. *Golden Trade*, 143 F.R.D. at 520 (quoting *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1170 (D.S.C. 1975)). *See also* *VLT Corp. v. Unitrode Corp.*, 194 F.R.D. 8, 15 (D. Mass. 2000).
96. *See Golden Trade*, 143 F.R.D. at 520 (citing cases).
97. *In re Rivastigmine Patent Litig.*, 239 F.R.D. 351, 356 (S.D.N.Y. 2006); *Softview Computer Product Corp. v. Haworth, Inc.*, 2000 U.S. Dist. LEXIS 4254, at \*36–37 (S.D.N.Y. Mar. 31, 2000) (quoting *Bristol-Myers Squibb v. Rhone-Poulenc Rorer, Inc.*, 1998 U.S. Dist. LEXIS 4213, at \*2 (S.D.N.Y. Apr. 2, 1998)); *see also* *Advertising to Women, Inc. v. Gianni Versace S.p.A.*, No. 98 C 1553, 1999 U.S. Dist. LEXIS 12263 (N.D. Ill. Aug. 4, 1999).
98. *VLT Corp. v. Unitrode Corp.*, 194 F.R.D. 8, 15 (D. Mass. 2000).
99. *Id.*
100. *Id.*; *see also* *Smithkline Beecham Corp. v. Apotex Corp.*, 193 F.R.D. 530, 536 n.6 (N.D. Ill. 2000); *Golden Trade*, 143 F.R.D. at 521.
101. *VLT*, 194 F.R.D. at 15. *See also* *Bayer AG v. Barr Labs. Inc.*, 92 Civ. 0381, 1994 U.S. Dist. LEXIS 17988 (S.D.N.Y. Dec. 16, 1994); *Golden Trade*, 143 F.R.D. at 521.
102. *VLT*, 194 F.R.D. at 15 (quoting RESTATEMENT (SECOND) OF CONFLICT OF LAWS § 139(2) (1988 Rev.) (when the sovereign with the most significant relationship with the communication recognizes a privilege not recognized in the forum state, the communication should be disclosed under the policy of the forum state unless the foreign state’s interest overrides)).
103. *Astra Aktiebolag v. Andrx Pharm. Inc.*, 208 F.R.D. 92, 98 (S.D.N.Y. 2002).
104. *VLT*, 194 F.R.D. at 15 (applying a combination approach).
105. *See In re Rivastigmine Patent Litig.*, 237 F.R.D. 69, 75 (S.D.N.Y. 2006) (analyzing privilege claims under the laws of various countries); *Saxholm AS v. Dynal, Inc.* 164 F.R.D. 331, 337–38 (E.D.N.Y. 1996) (“[P]laintiffs here have similarly failed to provide evidence that the attorney-client privilege applies to communications with their foreign patent agents regarding Danish patent applications, and this court accordingly finds that their claims of privilege are not substantiated.”); *Santrade, Ltd. v. Gen. Elec. Co.*, 150 F.R.D. 539, 546 (E.D.N.C. 1993) (“The burden, therefore, rests upon Sandvik to show, as to each country, that the attorney-client privilege extends to patent attorneys and/or patent agents and that the communications were intended to be confidential and not merely passed on to a patent examiner.”) (quoting *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 143 F.R.D. 611, 617 (E.D.N.C. 1992)).
106. *Smithkline Beecham Corp. v. Apotex Corp.*, 193 F.R.D. 530, 536 (N.D. Ill. 2000); *McCook Metals L.L.C. v. Alcoa Inc.*, 192 F.R.D. 242, 256 (N.D. Ill. 2000).
107. *McCook Metals*, 192 F.R.D. at 256.
108. *Id.*; *see also* *Burroughs Wellcome*, 143 F.R.D. at 617 (“The burden rests upon BW Co. to establish that, as to each country, the attorney-client privilege extends to patent attorneys and/or patent agents and that the communications were intended to be confidential and not merely passed on to a patent examiner.”).
109. *McCook Metals*, 192 F.R.D. at 256.

110. *Id.* at 257; *see also Burroughs Wellcome*, 143 F.R.D. at 616; *Baxter Travenol Labs., Inc. v. Abbott Labs.*, 1987 U.S. Dist. LEXIS 10300, at \*21 (N.D. Ill. 1987); *Foseco Intern. Ltd. v. Fireline, Inc.*, 546 F. Supp. 22, 25–26 (N.D. Ohio 1982); *Mendenhall v. Barber-Greene Co.*, 531 F. Supp. 951, 954 (N.D. Ill. 1982).
111. *Santrade*, 150 F.R.D. at 547 (no privilege for either Japanese patent agent or attorney); *Burroughs Wellcome*, 143 F.R.D. at 623–24 (no privilege for Japanese patent agent); *Alpex Computer Corp. v. Nintendo Co.*, 86 Civ. 1749, 1992 U.S. Dist. LEXIS 3129, at \*5–7 (S.D.N.Y. Mar. 9, 1992) (no privilege for Japanese patent agent); *Detection Sys., Inc. v. Pittway Corp.*, 96 F.R.D. 152, 156 (W.D.N.Y. 1982) (no privilege for Japanese patent agent).
112. *OKI Am. Inc. v. Advanced Micro Devices, Inc.*, No. C04-3171CRB(JL), 2006 U.S. Dist LEXIS 66441, at \*9–10 (N.D. Cal. Aug. 31, 2006); *Murata Mfg. Co. v. Bel Fuse Inc.*, No. 03C2934 2005, U.S. Dist. LEXIS 37774, at \*5–6 (N.D. Ill. Feb. 3, 2005); *Knoll Pharm. Co. v. Teva Pharm. USA, Inc.*, No. 01C1646, 2004 U.S. Dist. LEXIS 24057, at \*11 (N.D. Ill. Nov. 19, 2004).
113. *See Eisai Ltd. v. Dr. Reddy's Labs. Inc.*, 406 F. Supp. 2d 341, 345 (S.D.N.Y. 2005).
114. *VLT Corp. v. Vicor Corp.*, 194 F.R.D. 8 (D. Mass. 2000) (the court believes that Japanese law would treat the [document in question] as privileged.)
115. 406 F. Supp. 34 (S.D.N.Y. 2005).
116. *Id.* at 343.
117. *Id.*
118. *McClarín Plastics, Inc. v. LRV Acquisition Corp.*, 1999 U.S. App. LEXIS 15491 (Fed. Cir. July 12, 1999) (declining to decide whether communications with French patent agents are or are not privileged) (unpublished disposition).
119. 188 F.R.D. 189, 200 (S.D.N.Y. 1999).
120. *See also In re Rivastigmine Patent Litig.*, 237 F.R.D. 69, 92 (S.D.N.Y. 2006) (no privilege found where plaintiff failed to present evidence of French law).
121. *See McCook Metals L.L.C. v. Alcoa, Inc.*, 192 F.R.D. 242 (N.D. Ill. 2000) (privilege applies for communications between French patent agents and their clients); *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1146, 1170 (D.S.C. 1975); *see also Baxter Travenol Labs., Inc. v. Abbott Labs.*, 84-C-5103, 1987 U.S. Dist. LEXIS 10300 (N.D. Ill. June 17, 1987) (recognizing privilege for confidential communications between French patent agents and client) (*dicta*).
122. 397 F. Supp. 1146, 1170 (D.S.C. 1975).
123. *Id.* at 1171.
124. *See Astra Aktiebolag v. Andrx Pharms.*, 208 F.R.D. 92, 99–100 (S.D.N.Y. 2002) (client communications with German patent agent privileged); *McCook Metals*, 192 F.R.D. 242 (privilege applies for communications between German patent agents and clients); *Softview Computer Products Corp. v. Haworth, Inc.*, 2000 U.S. Dist. LEXIS, at \*37 (S.D.N.Y. Mar. 31, 2000) (German law protects communications between a patent agent and his or her clients.); *Santrade, Ltd. v. Gen. Elec. Co.*, 150 F.R.D. 539, 547 (E.D.N.C. 1993) (same); *Golden Trade, S.r.L. v. Lee Apparel Co.*, 143 F.R.D. 514, 524 (S.D.N.Y. 1992) (same).
125. *Baxter Travenol Labs.*, 1987 U.S. Dist. LEXIS 10300, at \*22–23. In that case, however, it seems clear that the court based its decision on the patentee's failure to present sufficient evidence of German law.

126. See *2M Asset Mgmt., LLC v. Netmass, Inc.*, No. 2:06-CV-215, 2007 U.S. Dist. LEXIS 14098, at \*10 (E.D. Tex. Feb. 28, 2007); *Astra Aktiebolag*, 208 F.R.D. at 99–100.
127. See, e.g., *Smithkline Beecham Corp. v. Apotex Corp.*, 193 F.R.D. 530, 536 (N.D. Ill. 2000) (Communications with patent agents have been deemed to be privileged under British law since 1968. At that time, the Civil Evidence Act extended the privilege to communications with patent agents.); accord *In re Ampicillin Antitrust Litig.*, 81 F.R.D. 377, 391 (D.D.C. 1978); *Duplan Corp. v. Deering Milliken, Inc.*, 397 F. Supp. 1169–70 (D.S.C. 1974).
128. 237 F.R.D. 69 (S.D.N.Y. 2006).
129. 237 F.R.D. at 109.
130. *Mead Digital Sys., Inc. v. A.B. Dick Co.*, 89 F.R.D. 318, 320–21 (S.D. Ohio 1980).
131. *Duplan Corp. v. Deering Milliken*, 397 F. Supp. 1146, 1161 (D.S.C. 1974).
132. See *United States v. Nobles*, 422 U.S. 225, 239 (1975).
133. See, e.g., *VLT Corp. v. Unirode Corp.*, 194 F.R.D. 8, 11 (D. Mass. 2000).
134. FED. R. CIV. P. 26(b)(5) Advisory Committee Notes (2006).
135. *VLT*, 194 F.R.D. at 11.
136. *Id.*
137. See, e.g., *United States v. Pepper's Steel & Alloys, Inc.*, 742 F. Supp. 641, 644–45 (S.D. Fla. 1990) (refusing to order production where the protective order provided that there would be no waiver of any privilege); *Eutectic Corp. v. Metco, Inc.*, 61 F.R.D. 35, 52 (E.D.N.Y. 1973) (same).
138. *VLT*, 194 F.R.D. at 12 n. 2 (quoting *Harmony Gold USA, Inc. v. FASA Corp.*, 169 F.R.D. 113, 116 (N.D. Ill. 1996)).
139. *Transonic Sys., Inc. v. Non-Invasive Med. Tech.*, 192 F.R.D. 710, 715 (D. Utah 2000).
140. See *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 190 F.R.D. 287, 292–93 (D. Mass. 2000) (mistaken production of 200 privileged documents constituting thousands of pages not inadvertent).
141. *Transonic Sys.*, 192 F.R.D. at 715–16; *Vakharia v. Swedish Covenant Hosp.*, 90-C-6548, 1993 U.S. Dist. LEXIS 11411 (N.D. Ill. Aug. 16, 1993).
142. Kimberly A. Moore, *Empirical Statistics on Willful Patent Infringement*, 14 FED. CIR. B.J. 227, 232 (2005). This high percentage is likely to be reduced somewhat based on the strict standards for willfulness set forth in the Federal Circuit's *en banc* decision in *In re Seagate*, 497 F.3d 1360 (Fed. Cir. 2007).
143. *F & G Scrolling Mouse, L.L.C. v. IBM Corp.*, 190 F.R.D. 385, 391 (M.D.N.C. 1999).
144. 448 F.3d 1294 (Fed. Cir. 2006).
145. *Id.* at 1297.
146. *Id.*
147. *Id.* at 1303–04.
148. *Id.* at 1302.
149. *Id.* at 1302–04.
150. *Id.* at 1302 n.4.
151. *Informatica Corp. v. Bus. Objects Data Integration, Inc.*, C 02-2378JSW, 2006 U.S. Dist. LEXIS 58976 (N.D. Cal. Aug. 9, 2006).

152. *Intex Recreation Corp. v. Team Worldwide Corp.*, 439 F. Supp. 2d 46 (D.D.C. 2006).
153. *See Convolve, Inc. v. Compaq Computer Corp.*, 224 F.R.D. 98 (S.D.N.Y. 2004).
154. Misc. Docket No. 830, 2007 U.S. App. LEXIS 19768 (Fed. Cir. Aug. 20, 2007).
155. *Id.* at
156. 717 F.2d. 1380 (1983).
157. 2007 U.S. App. LEXIS 19768, at \*22.
158. *Id.* at \*27–28.
159. *Id.* at \*32.
160. *Id.* at
161. *Id.* at \*36–37.
162. *United States v. Zolin*, 491 U.S. 554, 563 (1989); *Clark v. United States*, 289 U.S. 1, 15 (1933); *In re Antitrust Grand Jury*, 805 F.2d 155, 162 (6th Cir. 1986).
163. *Nobelpharma AB v. Implant Innovations, Inc.*, 141 F.3d 1059, 1070–71, 1072 (Fed. Cir. 1998).
164. *Id.*
165. *In re Spalding Sports Worldwide, Inc.*, 203 F.3d 800, 807 (Fed. Cir. 2000).
166. *Id.*
167. *See, e.g.*, RESTATEMENT (SECOND) OF TORTS § 551(1).
168. *See Paragon Podiatry Lab. v. KLM Labs.*, 984 F.2d 1182, 1189–90 (Fed. Cir. 1993); *LaBounty Mfg., Inc. v. U.S. Int’l Trade Comm’n*, 958 F.2d 1066, 1076 (Fed. Cir. 1992).
169. *Molins PLC v. Textron, Inc.*, 48 F.3d 1172, 1180–81 (Fed. Cir. 1995).
170. *Hebert v. Lisle Corp.*, 99 F.3d 1109, 1116 (Fed. Cir. 1996) (citing *Kingsdown Med. Consultants v. Hollister, Inc.* 863 F.2d 867 (Fed. Cir. 1988)).
171. *Baxter Int’l Inc. v. McGaw Inc.*, 149 F.3d 1321, 1330 (Fed. Cir. 1998) (affirming district court’s determination that withholding highly material prior art manifested a culpable state of mind sufficient to warrant a finding of an intent to deceive the PTO.).
172. *Nobelpharma*, 141 F.3d at 1069–70.
173. *Manville Sales Corp. v. Paramount Sys., Inc.*, No. 86-4157, 1987 U.S. Dist. LEXIS 10400, at \*15 (E.D. Pa. Sept. 19, 1987); *Synair Corp. v. Am. Indus. Tire, Inc.*, 645 F. Supp. 1080, 1085 (S.D. Tex. 1986).
174. *E.g.*, *Domestic Sales Corp. v. Intertherm, Inc.*, No. S87-81, 1988 U.S. Dist. LEXIS 19362, at \*34, \*36–37 (N.D. Ind. 1988); *Research Corp. v. Gourmet’s Delight Mushroom Co.*, 560 F. Supp. 811, 820 (E.D. Pa. 1983).
175. 141 F.3d at 1070 (quoting *Norton v. Curtiss*, 433 F.2d 779, 794 (CCPA 1970)).
176. *Spalding*, 203 F.3d at 806–07.
177. *Zolin*, 491 U.S. at 565–70.
178. *Antitrust Grand Jury*, 805 F.2d at 168–69.
179. *Zolin*, 491 U.S. at 570–72.
180. *Id.* at 572 (internal quotes and citation omitted).